

VI. RULES COMMON TO ALL PROCEEDINGS

A. The principle of the protection of legitimate expectations

1. General issues

A general principle well-established in European Community law, and one generally recognised in the EPC contracting states and board of appeal case law, is that of the protection of legitimate expectations. This principle is applicable having regard to the good faith existing between the EPO and its users. Its application to procedure before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of parties to such proceedings (**G 5/88**, **G 7/88**, **G 8/88**, OJ 1991, 137). Some decisions also use the term "good faith" to describe this concept (eg **J 10/84**, OJ 1985, 71). A recent key decision on this issue is **G 2/97** (OJ 1999, 123), which is broadly based on the previous case law (see point 2).

According to the case law of the boards of appeal, the principle of the protection of legitimate expectations governing procedure between the EPO and applicants requires that communications addressed to applicants must be clear and unambiguous, ie drafted in such a way as to rule out misunderstandings on the part of a reasonable addressee. A communication from the EPO containing erroneous information which leads the applicant to take action causing the refusal of his patent application is null and void in its entirety (**J 2/87**, OJ 1988, 330). An applicant must not suffer a disadvantage as a result of having relied on a misleading communication (**J 3/87**, OJ 1989, 3). On the contrary, if his actions were based on a misleading communication he is to be treated as if he has satisfied the legal requirements (**J 1/89**, OJ 1992, 17).

A number of cases illustrate the application of this principle that the party misled must be treated as having fulfilled the necessary requirements. For example, in **T 124/93** the opposition division had wrongly changed the date of its decision, giving it a later one which had misled the parties about the time limit for filing the notice of appeal and statement of grounds. Applying the principle of the protection of legitimate expectations, the board ruled that the appeal was to be considered as filed in due time. In **T 343/95**, concerning the automatic debiting procedure for fee payments, the reply by the EPO's employee was not misleading in itself, but the fact that it was not followed by the action expected by the appellant (namely that its application be added to the list of its applications subject to the automatic debiting procedure) had the same effect and had therefore to be considered in the same way. In **J 18/96** (OJ 1998, 403) the board also accorded a filing date to protect an applicant's legitimate expectations, although he had not fulfilled a requirement under Art. 80 EPC. By issuing a communication under R. 85a EPC, the Receiving Section had given him the impression that his application was validly filed (see also **J 5/89**).

A number of specific cases can also be cited in which the boards applied the principle of the protection of legitimate expectations or held that it was not relevant.

The Enlarged Board observed in **G 2/97** that the notice sent by the registry of the boards of

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appeal was a standard form, nothing more than an administrative notice to inform the parties on the reference number of the appeal proceedings. It has no legal consequences ; it is not a "communication" within the meaning, eg, of Art. 110(2) EPC. Such a notice cannot be considered to give rise to any misunderstanding.

The board decided in **J 17/98** (OJ 2000, 399) that the principle of protection of legitimate expectations according to which communications of the European Patent Office, including official forms, must be clear and unambiguous, did not extend so far as to require comprehensive legal advice to be contained in such forms. While, on the one hand, forms must be clear and unambiguous, they need not, on the other hand, contain detailed explanations of the law. This was especially true for legal issues which directly follow from the provisions of the Convention (see also **T 778/00** (OJ 2001, 554).

Consequently, the Board did not share the view of the appellants that EPO form 1004 (General Authorisation) should have informed the users of the difference between filing a general authorisation and appointment of a representative. This difference resulted directly from the Convention itself. Thus, the fact that EPO form 1004 did not contain such information did not render it ambiguous or misleading.

In the same vein, the board in **J 29/97** emphasised that an examiner could not be treated as a legal adviser of the appellant who had to consider what possible action the appellant might wish to take. The principle of the protection of legitimate expectations did not extend that far.

In **J 15/92** the Legal Board of Appeal held that "in the case of a request whose true nature is uncertain (ie it is unclear whether this is a request for re-establishment or a request for a decision), the EPO should clarify the matter by asking the requester". It would have been sufficient in the case in point for the EPO to invite the applicant to define his request more precisely. For the EPO to interpret the request arbitrarily constituted an error rendering the impugned decision null and void (see also **J 25/92**).

In **J 27/94** (OJ 1995, 831) the board decided that if a declaration which was subject to a condition and, therefore, invalid, was treated as a valid procedural act by the EPO, the EPO was not allowed later to go back on its own earlier conduct which served as a basis for the applicant's decision on how to proceed because this would have represented "venire contra factum proprium" and thus offended against a generally recognised legal maxim.

Similarly, several decisions have specified the **sources** of legitimate expectations. In **T 905/90** (OJ 1994, 306, Corr. 556) the board held that specific communications or other actions within the framework of particular proceedings and official statements such as guidelines were not the only sources of legitimate expectations; these could also properly arise from the actual general conduct or established practice of organs of the EPO. All changes in these practices should be officially announced at the earliest possible moment in order to avoid misleading the parties. In **J 25/95** (and similar decisions given the same day, namely **J 14/95**, **J 15/95**, **J 16/95**, **J 17/95** and **J 24/95**) the board drew up a list of these sources in the light of the case law. It was pointed out that the source of legitimate expectations must be confined to some categories of information: information by the EPO in the framework of individual cases, information contained in official statements of general

applicability and published by the EPO, eg in the OJ, established practice of departments of the EPO, and decisions of the Enlarged Board because of its special role. The users' confidence in the continuity of a practice based on a decision of the Enlarged Board might be considered particularly legitimate since all boards of appeal were expected to follow the Enlarged Board's interpretation of the EPC. In **J 25/95** the board also stressed that, whereas the appellant submitted, inter alia, that the Receiving Section be obliged to follow **J 11/91** (OJ 1994, 028) because this decision had been published in the OJ as well as in the "Case law of the boards of appeal of the EPO", the publication of **J 11/91**, in the board's view, did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. There was no case in which legitimate expectations, justifying a deviation from the law in its correct interpretation, had been accepted only on the basis of the publication of a single decision of a board of appeal. Moreover, the board observed that decisions of the boards were not published because the EPO wanted to announce that its users could rely on them in the future cases, but just because the **boards** themselves considered them to be of general interest in respect of the development of the case law. If there was any doubt whether established practice in this respect existed, it was up to the appellants to seek clarification by means of an enquiry to the EPO which would have revealed quickly in this case that the first instance did not apply **J 11/91**.

Relating to the application of the principle, the board, in **T 160/92** (OJ 1995, 35), made it clear that all procedural actions - whether formal or informal - taken by EPO employees vis-à-vis parties to proceedings were governed by the principle of the protection of legitimate expectations (including telephone calls, for example, which were not part of the formal procedure). The answer to the disputed question of whether the applicant was misled about the possibility of imminent refusal of the application by a telephone call was to be sought by focusing on the procedurally relevant content of the file.

In **T 428/98** (OJ 2001, 494) the board held that an appellant may rely on information which the board's registrar can be proved to have provided by telephone concerning the method for calculating a time limit the appellant has to observe before the board if the point of law on which that information is based has at that time not yet been clarified in the case law of the boards of appeal (reasons 2.2).

A number of decisions confirmed that proof was required where the EPO was allegedly in breach of legitimate expectations.

In **T 321/95** the board of appeal stated that the alleged oral agreement was not mentioned anywhere in the communications between the primary examiner and the appellant and was not derivable from the content of the file either. Thus, arguments supporting the alleged violation of good faith could only be considered as the appellant's personal opinion, which did not convince the board because there was no derivable evidence that there had been any agreement in the sense mentioned by the appellant, but only a "miscommunication" between the primary examiner and the applicant.

In case **T 343/95**, dealing with the content of a telephone call on which the appellant based its allegation in respect of principle of good faith, the board was of the opinion that even if it was not possible to establish beyond any reasonable doubt a posteriori the call's content, in

a case like the present one it was sufficient that the board was satisfied on the basis of a balance of probabilities (ie that one set of facts was more likely to be true than the other). There were indeed many circumstances in favour of the submission by the appellant, among them the fact that the appellant had had a similar problem in a parallel case where he reacted immediately. The board could find no logical reason, especially taking into account the fact that his interest in the file had made him contact the EPO, why he would not have made the payment, had he known it was not to be processed automatically. The board held that the conditions for the application of the principle of legitimate expectation were fulfilled.

In **T 460/95** (interlocutory decision of 16.7.96) the board stated that for applicants to be able to claim that they had relied on incorrect information, in accordance with the principle of good faith, it had to be established that the erroneous information from the EPO had been the direct cause of the action taken by the applicants and objectively justified their conduct. Whether or not this was the case would therefore depend on the individual circumstances of each case.

Decision **T 923/95** ruled explicitly that the principle of protection of legitimate expectations applied to both ex parte and inter partes proceedings. In **T 161/96** (OJ 1999, 331) the board explicitly stated that the requirements in connection with the principle of good faith to be observed by the EPO were the same vis-à-vis all parties involved in proceedings before the EPO, be they applicants, patent proprietors or opponents.

2. Obligation to draw attention to easily remediable deficiencies

In **G 2/97** (OJ 1999, 123) the Enlarged Board of Appeal considering the question of law raised by **T 742/96** (OJ 1997, 533) concluded that the principle of good faith does not impose any obligation on the boards of appeal to notify an appellant of a missing appeal fee when the notice of appeal is filed so early that the appellant could react and pay the fee in time, if there was no indication - either in the notice of appeal or in any other document filed in relation to the appeal - from which it could be inferred that the appellant would, without such notification, inadvertently miss the time-limit for payment of the appeal fee.

The Enlarged Board, on the basis of the established case law of the boards of appeal, saw in **G 2/97** no justification for the suggestion that the principle of good faith imposes on a board an obligation to warn a party of deficiencies within the area of the party's own responsibility. The appellant's responsibility for fulfilling the conditions of an admissible appeal cannot be devolved to the board of appeal. There can be no legitimate expectation on the part of users of the European patent system that a board of appeal will issue warnings with respect to deficiencies in meeting such responsibilities. To take the principle of good faith that far would imply, in practice, that the boards of appeal would have to systematically assume the responsibilities of the parties to proceedings before them, a proposition for which there is no legal justification in the EPC or in general principles of law. The Enlarged Board explained that the decision in **T 14/89** (OJ 1990, 432) concerned the particular circumstances of that case - involving a request for re-establishment of rights - and that there was no generally applicable principle to be derived from it (**G 2/97**, Reasons, point 3.4).

On the other hand, the Legal Board of Appeal in **J 13/90** (OJ 1994, 456) decided that if,

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having regard to the principle of good faith, the applicant could expect to receive a communication warning him of an impending loss of rights, but that communication was not issued in due time, the EPO must set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time.

The obligation on the EPO to draw attention to easily remediable deficiencies in procedural acts has been pointed out in numerous decisions in due time.

The principle of legitimate expectations was applied in **J 11/89** where the Receiving Section failed to take any particular action upon the receipt of Japanese patent documents intended to be considered as priority documents, but whose priority was not claimed in the request for grant.

Decision **T 460/95** (interlocutory decision of 16.7.96) also found that in the case in point the irregularity was obvious and easy to identify, and the appellant could easily have put it right during the time remaining, because the registrar, when he received the request for an extension, could and indeed should have seen that it was based on a misunderstanding during a telephone conversation.

In **J 18/96** (OJ 1998, 403) the board found that in the circumstances the appellants had been deprived of an opportunity to remedy the deficiency. Since, by issuing the communications under R. 85a EPC and R. 69 EPC, the EPO had for an entire year left the appellants in the legitimate belief that the application had been validly filed, and since the correction under Art. 90(2) EPC and R. 39 EPC of the easily remediable deficiency was expressly ruled out, the board found that the appellants were to be protected in their legitimate assumption that their application had been accorded a date of filing which was the date of filing of the deficient documents. The applicants were not to be in any way disadvantaged by the EPO's conduct, which was misleading and partly irregular.

Missing or insufficient fee payments, in particular, have given rise to decisions on the principle of good faith.

In **J 15/90** of 28.11.1994 the Legal Board of Appeal held that an insufficient payment of a fee did not result in a loss of rights if the error occurred 18 days before the period expired and the EPO failed to inform the applicant (see **J 13/90**, OJ 1994, 456).

In **T 923/95** a sum of DEM 1 200 instead of DEM 2 000 was mentioned in the fee payment voucher annexed to the notice of appeal filed by the appellants (opponents). In the board's view, the EPO, which had acknowledged receipt of the notice of appeal before the final date for payment of the appeal fee, could at the same time easily have notified the appellants by fax that the amount of DEM 800 was still outstanding. The board referred to **T 861/94** (see page 249) where it was held that Office departments were not to assume responsibilities of the parties and had to observe their obligation to remain neutral. It stated, however, that the present case, **T 923/95** was quite different, as the appellants had clearly intended to pay the appeal fee, and the underpayment could easily have been noticed. The board said it was clearly contrary to the principle of good faith, which should govern relations between the EPO and the parties, if in circumstances of this kind the Office remained passive and allowed a

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time limit to expire (in this case, one week later), where the consequence of failure to observe the time limit was that the appeal was considered not to have been filed.

In **T 296/96**, only 50% of the appeal fee was paid before the expiry of the time limit under Art. 108 EPC, first sentence. However, since the Formalities Officer invited the appellant to pay the remainder of the appeal fee and accepted its subsequent payment without comment, the appellant could assume in all good faith that the appeal was deemed to have been filed (Art. 108 EPC, second sentence) and that, as a consequence, it was not necessary to file an application for restitutio in integrum. The appellant should thus have been invited by the EPO to file an application for restitutio in integrum before the expiry of the one-year time limit under Art. 122(2) EPC, third sentence. Since there was no such invitation, the appellant, who was misled by the action of the Formalities Officer, must, in accordance with the principle of the protection of legitimate expectations, be treated as having paid the appeal fee in time. The appeal was thus deemed to have been filed.

In **T 690/93** the board held that the request for restitutio was inadmissible because the fee had not been paid in time. The board saw no justification for the suggestion that the legitimate expectations principle imposed on a board an obligation to warn a party of deficiencies within the area of the party's own responsibility. Once a case was within the jurisdiction of the board, the latter had to avoid any action that could undermine the absolute impartiality it had to maintain between applicant, opponent and public in all proceedings.

In **T 861/94** the same board confirmed this position in ruling that the parties could only cite failure to meet their "legitimate expectations" if they were able to furnish evidence to the effect that the EPO (here the board of appeal) had not exercised the due care required by the circumstances. Parties to legal proceedings could not reasonably expect the court dealing with the action to take over their responsibilities. The said parties must, on the contrary, expect from the court that it would by its actions or inaction attempt to discharge its duty to maintain strict neutrality.

In **T 161/96** (OJ 1999, 331) the board came to the conclusion that in the case before it, following the ratio decidendi of **T 690/93**, there was no basis for assuming an obligation on the part of the EPO to warn the party of an impending loss of rights relating to an underpayment of the opposition fee of 40 %. Even if the principles expounded in **J 13/90** (OJ 1994, 456) were applied, the requirements for the very existence of such an obligation would imply that (i) the formalities officer of the opposition division had received a payment sheet, indicating said underpayment, from the cash and accounts department within the opposition period, (ii) the payment of the amount lacking by the opponent on his own initiative before the end of the opposition period had objectively to be excluded, and (iii) the opponent could still have paid the amount lacking within the opposition period.

In **J 41/92** (OJ 1995, 93) the board pointed out that the users of the EPC could not, by merely asking the EPO to warn them of any deficiency that might arise in the course of the proceedings, shift their own responsibility for complying with the provisions of the EPC to the EPO.

J 2/94 involved a letter comprising a request without the necessary payment. According to

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the board the appellant could not have expected to be informed of the missing fee. Referring to **J 41/92**, the board in this case held that a party could not expect a warning in respect of any deficiency occurring in the course of the proceedings. There had been no evident indication in the appellant's submission which made a clarification or reminder necessary. Indeed, as emphasised by the board, in practice the EPO could often establish whether a specific fee had been paid only after the relevant time limit had expired, once the complete data on all payments made during that period was available.

As pointed out by the board in **J 12/94**, it is incumbent on both parties to act in good faith. In particular, a PCT applicant who received a R. 85a(1) EPC notice could be expected to exercise a high standard of care in responding thereto. In this case it was the applicant's responsibility to take all necessary steps to avoid a loss of rights, particularly since re-establishment was not available as a remedy in respect of failure to meet time limits for entry into the regional phase. The board considered that in the case at issue the EPO had no duty to contact the applicant to warn it of the impending loss of rights because the EPO had been proceeding on the assumption that the categorical statement by the applicant that the PCT Chapter II procedure had been requested was correct. The formalities officer could not have been expected to identify the impending loss of rights, even if there was no trace of a demand for international preliminary examination at either WIPO or the UK IPEA. The EPO could not be expected in each such case to query and double check such statements. What the EPO did do was check why it had not yet been notified of its election. And that is what it had done in the case at issue.

In **J 8/95**, the appellants referred to the principle of good faith, in accordance with which the EPO had to draw attention to the time limit for submitting grounds since such time limit was allegedly not obvious from the German version of Art. 122 EPC. The board, however, held that in this case the EPO had no cause to issue such a warning since the then representative had himself announced in his application for re-establishment of rights that the grounds for the application would follow "in a few days".

In **J 4/96**, the applicants had filed a divisional application approximately three months after indicating their approval of the text in which the parent application was to be granted. The Receiving Section refused the divisional application as inadmissible. Approximately seven months before indicating their approval of the text notified, the applicants had responded to the objection that the parent application lacked unity by indicating that they wished to retain the possibility of filing a divisional application. The applicants had argued, *inter alia*, that the EPO, in view of its relationship of trust with applicants, was under an obligation to invite them to comment on their statement reserving the right to file a divisional application. The board did not share this view. During the proceedings concerning the previous application, the EPO had drawn the applicants' attention to the possibility of filing divisional applications. Whether the applicants availed themselves of this possibility and, if so, whether they performed the act in due time, was a matter for decision by them alone, and was entirely their responsibility. The relationship of trust between EPO and applicant did not extend so far as to relieve applicants of their responsibilities.

J 7/97 concerned a European patent application filed with the EPO by fax. One page of the description was missing, however, whilst another was transmitted twice.

The board took the view that a single page missing from a lengthy description was not an "obvious error" under the case law, at least in the circumstances of this particular case. The applicant could not in good faith expect the Office to check application documents for completeness on the very day it received them. Nor could any such obligation be inferred from the President's decision on fax transmissions (OJ 1992, 299). Art. 3 of that decision required the filing office to notify the sender as soon as possible "Where a document transmitted ... is illegible or incomplete". However, the latter adjective clearly referred to the transmission rather than the actual document. The Office did have to notify the sender if transmission failed eg because the line was cut off. In the present case, however, transmission had been problem-free, and - as the filing office employee had confirmed - all pages transmitted had arrived in legible form. No further-reaching obligation on the part of the filing office was inferable from the provision in question. The board therefore ruled that the missing page was not part of the application as filed.

In **T 445/98**, the board considered that, because the department which cashed the fee was not the same as the one which received the notice of appeal, the deficiency was not easy to identify and the time between payment of the appeal fee and expiry of the unobserved two-month time limit for filing the notice of appeal was too short, so that the opponent could not expect a warning. Moreover, the board pointed out that the principle of the protection of legitimate expectations did not extend so far as to relieve parties of their responsibilities, as already stated in many decisions of the boards of appeal (confirmed by **T 778/00** (OJ 2001, 554) following **G 2/97**).

3. Courtesy services performed by the EPO

The principle of the protection of legitimate expectations also applies to courtesy services provided by the EPO where these are not worded so as to rule out any misunderstanding on the part of a reasonable addressee. However, an applicant cannot rely on the EPO systematically providing certain courtesy services and therefore is not entitled to base a claim on their omission (**J 12/84**, OJ 1985, 108, **J 1/89**, OJ 1992, 17, and **J 27/92**, OJ 1995, 288).

In **J 1/89** the board held that the applicant was entitled to rely on the accuracy and completeness of information provided as a courtesy service. He could not, however, rely on courtesy services not required by the EPC being systematically provided. An example cited was the due date for a renewal fee. If an applicant paid a renewal fee late as a result of a misleading reminder, he had to be treated as if he had paid in time.

In **J 34/92** the fifth-year renewal fee had not been paid in full. The professional representative did not however receive the communication the EPO usually issues drawing attention to the fact that late payment of the renewal fee was possible upon payment of an additional fee. Furthermore, the communication under R. 69(1) EPC was sent out so late that a request for re-establishment of rights could no longer be submitted within the one-year absolute time limit under Art. 122(2) EPC. The Legal Board of Appeal referred to its consistent jurisprudence according to which the EPO may subsequently grant applicants a time limit sufficient to allow them to perform acts they had been unable to perform previously because of the EPO's failure to exercise due care; but this was only applied to non-absolute time limits, as an **absolute time limit**, by definition, was non-extendable.

In **J 14/94** (OJ 1995, 825) the facts were quite different. The applicant had failed to pay the third renewal fee. Nevertheless, the EPO continued the examination procedure for several years without informing the applicant of any loss of rights. The board held that if, during a long period of time, the EPO by its conduct led the parties and the public to the legitimate belief that no loss of rights had taken place, the EPO could not later refer to a loss of rights which occurred several years previously as this would constitute "venire contra factum proprium" and therefore contravene the principle of legitimate expectations. In such circumstances, the late payment of a renewal fee might - by way of exception - be considered as having been made in time, if the EPO had not informed the applicant of the outstanding payment, had accepted later renewal fees without objection and had continued the examination proceedings for several years.

In **J 27/92** (OJ 1995, 288) the appellant had raised the question of whether European representatives were entitled to rely on the advice given by the Information Office. A representative maintained that he had been misled by information voluntarily given to him on the **telephone** by an officer of the EPO with regard to the amount of the examination fee payable. The board pointed out that parties to proceedings before the EPO - and their representatives - were expected to know the relevant provisions of the EPC, even when such provisions were intricate. Where such a service had been rendered, however, an applicant was entitled to rely upon its content if the communication from the EPO was the direct cause of the action taken and, on an objective basis, it was reasonable for the appellant to have been misled by the information. These principles applied not only to written communications but also to **oral communications** from the EPO.

4. Departure from previous case law and the legitimate expectations principle

This chapter deals with the question of when a new decision which deviates from existing practice to the detriment of an applicant becomes generally applicable and how the legitimate expectations of users of the EPO are protected. In three decisions (**G 5/88**, OJ 1991, 137, concerning an administrative agreement, **G 5/93** OJ 1994, 447 and **G 9/93**, OJ 1994, 891) the Enlarged Board of Appeal reached the conclusion that decisions overturning earlier rulings would not be applied up to the date on which they were made available to the public.

According to **G 5/93** the EPO was bound, by its own interpretation and practice, to admit the possibility of Euro-PCT applicants having their rights re-established with regard to the time limit for paying the national fee provided for in R. 104b EPC (now R. 107 EPC) in all cases where re-establishment of rights was applied for before decision **G 3/91** (OJ 1993, 8) was made available to the public (see also **J 9/93**).

In **G 9/93** (OJ 1994, 891) the Enlarged Board of Appeal overturned its earlier ruling in decision **G 1/84** and held that a European patent cannot be opposed by its own proprietor (see also VII. C.1.3). The Enlarged Board held that where purely procedural matters are concerned there may be reasons of equity for not applying the new interpretation of the law to pending cases. As to the referred question of the admissibility of self-opposition, obviously patent proprietors in cases then pending before the EPO had had every reason to expect that such an opposition would be considered as admissible, relying on the decision in **G 1/84**, which had been followed for many years. In the view of the board, it would be inequitable to

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prevent them from continuing the proceedings, which they had embarked on in good faith and which could not adversely affect the rights of any third party.

In **J 27/94** (OJ 1995, 831) the board stated that there might be cases in which the public had a legitimate expectation that the department of first instance would not deviate from the established case law. This might apply if the relevant case law had become enshrined in the consistent practice of the department of first instance, and in particular if this had been made known to the public in published Guidelines, Legal Advice or Notices from the EPO. In such a situation, an applicant might legitimately expect that a practice allowing or even recommending a particular way of proceeding would not be changed without appropriate advance information. The facts of **J 27/94** differed substantially from those of **G 5/93**, in which the EPO had expressly drawn the applicants' attention to the opportunity provided by the case law to have the application restored after certain losses of rights. In the case in point the applicant argued that **J 11/91** (OJ 1994, 28) was binding on the department of first instance on the basis of the principle of legitimate expectations. However, the headnote of **J 11/91** was published in the same issue of the OJ as the referral of this point of law to the Enlarged Board of Appeal. Taking this information into account, there was no reason to believe that the department of first instance would follow **J 11/91** in future cases. On the contrary the Guidelines remained unchanged, which fact gave reason to expect that the practice based on them would likewise not be changed. The department of first instance was therefore not obliged by the principle of the protection of legitimate expectations on the basis of decision **J 11/91** to allow the filing of a divisional application after the approval of the text intended for grant until opinion **G 10/92** (OJ 1994, 633) was made available to the public.

The Legal Board confirmed this view, inter alia in **J 25/95** where it faced the same problem. It pointed out that previous decisions showed that the source of legitimate expectations was confined to the categories of information mentioned above (see VI.A.1). However, there was no case in which legitimate expectations had been accepted only on the basis of the publication of a single decision of a board of appeal. The board observed, furthermore, that decisions of the boards were not published because the EPO wished to announce that its users could rely on them in future cases, but because the **boards** themselves considered them to be of general interest in respect of the development of case law.

In **T 716/91** the board came to the conclusion that **G 4/93** (corresponding to **G 9/92**, OJ 1994, 875) had also to be applied to pending cases. In the case in point an appeal against the interlocutory decision of the opposition division maintaining the patent in an amended form was only filed by the opponent. The respondent (patent proprietor) requested that the patent be maintained as originally granted. In **G 4/93** the Enlarged Board of Appeal stated that under such circumstances the patent proprietor is primarily limited to defending the amended version as accepted by the opposition division. Therefore, in view of **G 4/93**, the board rejected the main request of the respondent in spite of his argumentation that it was uncertain until the publication of **G 4/93** whether it was allowable for the patentee to maintain a request based upon the originally granted claims and that contrary case law existed on this issue. The board pointed out that **G 4/93** did not contain any indication limiting the applicability of the law as interpreted therein to pending cases. Therefore this case was not analogous to the situation in **G 9/93** (see above). On the contrary, following the arguments of the respondent itself that "contrary case law" existed, the respondent should have taken the appropriate

procedural steps (here by filing an appeal) to ensure he could still request the maintenance of the patent as granted, instead of taking the risk of the other possible interpretation being followed by the present board.

B. Right to be heard

1. Introduction

Under Art. 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This important procedural right is intended to ensure that no party is caught unawares by reasons given in a decision turning down his request on which he has not had the opportunity to comment.

These "grounds or evidence" under Art. 113(1) EPC are to be understood as meaning the essential legal and factual reasoning on which the EPO has based its decision (**T 532/91**, **T 187/95**). In **T 951/92** (OJ 1996, 53) the board ruled that the term "grounds or evidence" should not be narrowly interpreted. In the case in point, which related to examination proceedings, the board held that the term was to be understood as referring to the legal and factual reasons leading to refusal of the application, and not in the narrow sense of a requirement of the EPC (reasons, point 3(v)). It was essential that a party affected by a decision, given either at first instance or by the board of appeal, be afforded an opportunity to present its comments concerning the basis on which such a decision had been given (**T 105/93**, **T 951/92** (OJ 1996, 53)).

A decision which failed to take into account arguments submitted by a party and which was based on a ground on which the party had had no opportunity to present its comments, represented a contravention of Art. 113(1) EPC and a substantial procedural violation (see **J 7/82** (OJ 1982, 391)).

In **J 20/85** (OJ 1987, 102) the board pointed out that Art. 113(1) EPC was of fundamental importance for ensuring a fair procedure between the EPO and a party to proceedings before it, especially when issues of fact arose. A decision against a party to proceedings on such an issue of fact could only properly be made by the EPO after all the evidence on which such decision was to be based had been identified and communicated to the party concerned. Furthermore, in **J 3/90** (OJ 1991, 550) the Legal Board of Appeal held that where the EPO had examined the facts, Art. 113(1) EPC was not complied with unless the parties concerned had been fully informed about the enquiries made and the results and then given sufficient opportunity to present their comments before any decision was issued.

In **T 663/99** the board decided that the patent proprietor's right to be heard was violated if the time limit fixed under R. 57(1) EPC for presenting comments on the opposition had not expired by the date of handing over a revocation decision to the EPO's internal postal service.

In **T 385/97** the board held that if first instance departments and/or parties had failed to take account of highly relevant matter which was clearly available in the EPO file and which

related to a ground of opposition, the board's competence extended to rectifying the position by consideration of that matter, provided that the parties' procedural rights to fair and equal treatment were respected. The board appreciated that, in the exceptional circumstances of the case, the parties had to have sufficient opportunity to consider a document which, although mentioned in the patent description, had not been considered during examination and opposition proceedings, so that its "re-introduction" by the board of appeal without adequate time for the parties to give full instructions to their representatives might amount to "surprise". The case was therefore remitted.

In **T 201/98** the board said it was unfortunate that the Guidelines were worded in such a way as on the one hand to lead the applicant or its representative to expect a warning before rejection after a single communication and on the other hand to impute moral culpability for rejection. The board accepted that, in this case, the appellant's response to the single communication had been a bona fide attempt to deal with the examining division's objections. However, an examining division did not exceed its discretionary power by an immediate refusal, provided that the decision was based on grounds on which the appellant had had an opportunity to present comments (see also **T 120/99**)

In **T 296/96** the applicant did not submit convincing arguments in his reply to the first communication. The Examining Division refused the application on the basis of the objections mentioned in the only communication, instead of repeating the objections in a second one. Since, however, the main arguments for refusing the application were a mere repetition of those mentioned in the only communication, the contested decision was based on grounds on which the Applicant had an opportunity to present his comments and, consequently, Art. 113(1) EPC was not contravened. In **T 821/96**, the Board added that according to the established case law, it is left to the Examining Division's discretion to decide whether to issue a further invitation to present comments under Art. 96(2) EPC. A further invitation would only be appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent.

In **T 685/98** (OJ 1999, 346), in the board's judgement, the phrase "fails to reply in due time to any invitation under ... paragraph 2" in Art. 96(3) EPC has to be construed in the light of the purpose of the invitation pursuant to Art. 96(2) EPC and R. 51(2) EPC, which is to afford the applicant an opportunity to exercise his right to present comments in accordance with Art. 113(1) EPC. Hence a letter from the applicant which neither exercises nor waives that right is not a reply for the purposes of Art. 96(3) EPC.

In the present case, the examining division believed that the applicant, by making a simple procedural request by return of post, had somehow forfeited his right to present comments during the remainder of the 4-month term set for reply. Such a view would seem to imply that any letter the applicant sent after receipt of the R. 51(2) EPC communication was to be treated as his definitive reply even if the time limit set for reply had not expired. However, on a proper interpretation of the letter of the applicant, he had neither exercised nor waived his right under Art. 113(1) EPC to present comments on the substantive issues. Nor, as the time set for reply had not expired, could he have forfeited this right. Thus the precipitate refusal, while there were still some two months of the term for reply unexpired, did indeed contravene Art. 113(1) EPC by depriving the applicant of an opportunity to present such comments (see

also chapter "examination procedure", Nr. 3.8).

Art. 113(1) EPC is also important in connection with the right to oral proceedings provided for in Art. 116(1) EPC. In **T 209/88** the board stated that non-compliance with a request for oral proceedings deprived the party of an important opportunity for presenting his case in the manner he wished and using the possibilities open to him under the EPC. By virtue of his request for oral proceedings, the party could rely on such proceedings being appointed before the issue of an adverse decision and therefore had no reason to submit further arguments in writing. In this respect, Art. 116 EPC was considered to represent an essential part of the requirement under Art. 113(1) EPC that the party must be given sufficient opportunity to present his comments on the grounds for the decision (reaffirmed by the same board in **T 560/88**).

In **T 1022/98** the examining division in its last communication expressly informed the appellant that discussion on novelty and inventive step was deferred until the objection under Art. 123(2) EPC had been overcome. The appellant was therefore entitled to assume that it would still be given an opportunity to comment on these issues. It could not anticipate immediate refusal on the ground of lack of novelty or inventive step of the application on the basis of the set of claims filed after the examining division's last communication. Thus the refusal of the application for lack of novelty, without previously giving the appellant a further opportunity to comment on this issue, constituted an infringement of Art. 113(1) EPC.

In **T 1101/92** the board held that previous communications sent to the appellants by the examining division did not refer to the passage in the closest prior-art document on which the examining division had relied when concluding in its decision that a certain additional feature lacked novelty. Thus the applicants had been deprived, before the decision was taken, of the opportunity of presenting their comments on the grounds on which their application was refused. There had therefore been a violation of the right to be heard and, consequently, a substantial procedural violation.

In **T 921/94** the board held that the appellant's bona fide submissions and the technical information provided by its test report substantially changed the points at issue, and that the examining division had a legal obligation under Art. 96(2) EPC and Art. 113(1) EPC to inform the appellant of the objections under the EPC arising in the new situation and to invite it to file further observations before issuing a decision to refuse the application.

Due process of law as required by Art. 113 EPC has not been observed if a decision to refuse an application is based essentially on documents which, though supplied by the applicant in support of his case, are used against him to produce an effect on which he has not had an opportunity to make observations (see **T 18/81** (OJ 1985, 166)). This principle also guarantees that grounds put forward are taken into consideration, and it is contravened if a translation, subsequently filed in an official language, of a Japanese document cited in due time is disallowed (**T 94/84** (OJ 1986, 337)).

In **T 195/84** (OJ 1986, 121) the representative objected at the oral proceedings that new grounds were being presented, challenging the existence of an inventive step, to which he had not previously had an opportunity to reply. The board could not share this opinion as the

representative had been aware that such prior art existed, and he had thus had sufficient time to consider it in full. Furthermore, he had not requested any additional time to examine this art in greater detail and had not asked for an adjournment.

In **T 643/96** an examining division relied in its decision on a document for which it gave only incomplete bibliographic data. The board held that the examining division's failure in the case at issue to provide the applicant with a copy of said document did not amount to a substantial procedural violation, having regard to the right to be heard, because the said document added nothing to the case, since it listed something already listed in another document and thus contained only information already known to the appellant/applicant (reasons for the decision, point 4.2.3.4).

In **T 405/94** the board held that a party which, although made aware by at least one letter from another party that an objection had been raised about the availability to the public of the content of a thesis, did not react before the oral proceedings at which a decision could be taken, or which provided for the first time at the oral proceedings information which was found to need confirmation, had had sufficient opportunity to comment on the objection and did not need to be given a further opportunity for providing such confirmation.

The case law concerning the specific aspects of the right to be heard which arise in examination proceedings where a patent application is refused following a single communication without a further invitation to submit comments is discussed in detail in chapter VII.B.3. The problem, relating to the right to be heard in opposition proceedings, as to when an invitation to file observations under Art. 101(2) EPC must be issued is also discussed in the section on opposition proceedings, chapter VII.C.2.

2. Right to be heard in oral proceedings

A number of decisions have been issued on the subject of enabling the parties to exercise their right to be heard in oral proceedings when a new claim, relevant document or new argument is introduced.

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) EPC to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92**, OJ 1994, 149; see also **T 484/90**, OJ 1993, 448; see "Late submission" (VI.F.4), **T 330/88** and **T 356/94**).

In **T 253/95**, the board referred to **G 4/92** and found that the principles concerning the basis of decisions in case one party was absent in oral proceedings also applied when the other party was present: new arguments could be used in the reasons for the decision as long as they did not rely on new facts, since they did not constitute new grounds or evidence and did not distort the factual framework, but were reasons based on facts and evidence already put forward. Indeed in **T 253/95**, during the oral proceedings, the board raised the question of the admissibility under Art. 123(2) EPC of the weight range for the rubber component(s) present in claim 1 as granted. The respondent (proprietor) protested against this issue being raised as it had not been discussed earlier in the proceedings. Thus it had to be determined in which

of the categories of grounds, facts, evidence and arguments the objection against the introduction of the weight range for the rubber component(s) fell. The board came to the conclusion that it was neither a new ground since an objection under Art. 123(2) EPC had been raised by the opponent at the outset, nor a new fact or likewise new evidence since the facts of the issue - that is claim 1 as originally filed, claim 1 as granted and the disclosure in the original description including the examples (the basis of the amendment was allegedly to be found in the examples) - had all been present at the beginning of the opposition proceedings. Therefore, the objection to the introduction of the weight range could at most constitute a late argument, which according to **G 4/92** could always be raised by an opponent and hence a fortiori by the board.

In **T 783/89** the opposition division had presented the parties at the start of the oral proceedings with a new version of the main claim, giving them ten minutes to consider it. The board ruled that this had taken the appellants by surprise. Nor had the time given been enough to establish whether the amendments were allowable.

In **T 1071/93** late-filed document 5 only reached the patent proprietor thirty days before the date set for oral proceedings. The patentee accordingly requested postponement of the oral proceedings. The opposition division rejected the request, one reason being the briefness of D5 (two pages of a brochure). The board, however, agreed with the patentee that one month was not sufficient time to prepare a response, or at least not necessarily so, particularly in a case where the opponent's communication had to be translated and notified to the Japanese patent proprietor.

In **T 248/92**, the examining division had based its decision on arguments submitted for the first time during oral proceedings. The board held that the examining division's decision had not been taken contrary to Art. 113(1) EPC. Although one of the purposes of oral proceedings was to settle as far as possible all outstanding questions relevant to a decision, they did not have a constraining effect in the sense of requiring an **immediate** decision to be taken at the end of those proceedings. If the appellant had felt the need for further reflection, he could have asked for the oral proceedings to be adjourned or the proceedings to be continued in writing so that he could study carefully the newly introduced arguments, which were obviously crucial to the decision.

In **T 476/96**, however, (Reasons, points 2.2.5 to 2.2.7) the board refused, in view of the particular circumstances of the case, to continue the proceedings in writing in order to expedite the handling of the case. At the oral proceedings, the board felt it had heard enough and declared the discussion closed.

In **T 484/89** the issues involved were similar. The board held that the opposition division was empowered under Art. 114(1) EPC to take account of and refer to all relevant documents cited. If it intended to do so it would normally issue a communication to that effect when appointing oral proceedings. In the case in question, however, the opposition division had considered it necessary to refer to the document during the oral proceedings. In such cases the parties should, at their request, be granted an adjournment or else new oral proceedings should be appointed to give them the opportunity to comment. Since no such request was made according to the decision or the record of the oral proceedings, no breach of Art. 113(1)

EPC had taken place.

In **T 411/92** the board introduced a relevant document during the oral proceedings. It granted the appellant/applicant two months to comment.

In **T 376/98** it was evident from the file that the examining division had referred to document D4 for the first time during the oral proceedings. The examining division interrupted the oral proceedings to give the applicant time for consideration. When the oral proceedings were resumed, the appellant requested a decision based on the documents on file.

Regarding the introduction of D4 at the oral proceedings, the board noted that no procedural limitations were placed upon the examining division to cite relevant documents during any stage of the examination procedure, as long as the applicant was given a fair chance to comment on the objections raised before a final decision was taken (see **T 1198/97**). In the board's opinion, the appellant's request for a decision could only be taken to mean that the appellant was not interested in a further debate about the relevance of D4 or its importance for the decision. In fact, the appellant's request left the examining division no other choice than to decide the case straight away and no procedural violation could be seen in the circumstances.

In **T 566/91** the opposition division, albeit inadvertently, based its decision to revoke the patent on a version of a citation which was more complete than the version which both parties present at the oral proceedings before the board had in their possession. In order to comply with Art. 113 EPC in the proceedings before the board, the board offered the parties a half-hour suspension of the proceedings to enable them to study the fuller version of the document with the help of the interpreters.

In **T 951/97** (OJ 1998, 440) the examining division introduced document D4 for the first time during oral proceedings. D4 had been mentioned in the European search report but had not been cited at any stage in the examination procedure prior to the oral proceedings; in particular, no reference had been made to it in the communication under R. 71a EPC. After a half-hour adjournment, the appellants filed a second auxiliary request which, in the examining division's view, was prima facie not admissible and not allowable. In response to this, the appellants submitted that a further opportunity for amendment should be granted, since a newly-cited document had been introduced by the examining division, changing the subject of the proceedings. In addition, the appellants should be given sufficient time to comment on D4. At the end of the oral proceedings, the application was refused under Art. 97(1) EPC.

The board found that half an hour was too short a period for an adequate analysis of the complex text of D4. It was clear that D4 was essential to the finding of the examining division in relation to inventive step; consequently, the decision was based on evidence on which the applicants did not have a sufficient opportunity to present their comments as required by Art. 113(1) EPC. The examining division had also decided under R. 71a EPC not to consider this second auxiliary request, on the ground that the subject of the proceedings had not changed. The board, however, held that the subject of the proceedings was changed within the meaning of R. 71a(1) and (2) EPC, inter alia where the examining division itself introduced

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a new document, which was **pertinent new material**, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC notification.

In **T 327/92** the appellants/patent proprietors alleged a substantial procedural violation consisting in the late mention by the opposition division at oral proceedings of document (8). Art. 113(1) EPC had not been complied with. The board disagreed with this view. Document (8) was first introduced in the statement of grounds filed in support of the opposition, so the appellants' attention had been drawn to it at the earliest opportunity. Moreover, although the document was specifically indicated as being relevant to claim 5, its subject-matter fell within the scope of claim 1 as filed, because claim 5 was dependent on claim 1. A document alleged to render claim 5 obvious would also render claim 1 obvious. Thus the document in question had always been part of the opposition. The patent proprietors had been given a further opportunity to consider the document at the oral proceedings. Finally, if the opposition division or the opponents were to be expected by a patent proprietor to consider sets of claims presented at or shortly before oral proceedings, then the patent proprietor must expect to be asked to defend the claims against objections raised at the oral proceedings based on all citations on file. Thus the requirements of Art. 113(1) EPC were met.

In **T 862/98** the decision of the department of first instance was signed by an opposition division different from that before which the oral proceedings had taken place, the second member having been replaced **after** the oral proceedings. The board decided that changes in the composition of an opposition division after oral proceedings should generally be avoided. This also applied to cases where no final substantive decision had been given orally. Where changes were unavoidable, new oral proceedings must in general be offered to the parties (see the analogous rule in Art. 7(1) RPBA). Such offers might be forgone in exceptional cases.

In the appellants' view, the opposition division had violated Art. 113 EPC by changing its provisional opinion after the oral proceedings without giving the appellants an opportunity to comment on the grounds, which had not been stated before, on which the contested decision was based. In **T 68/94** the board pointed out that provisional opinions were never binding. The purpose of oral proceedings was to summarise and discuss the parties' arguments. This meant that either party could present its comments on the other's counter-arguments, in accordance with the requirements of Art. 113 EPC. The respondents had already filed a letter setting out the arguments which the opposition division had then endorsed in the contested decision. All the arguments in the case had been known to both parties.

3. Non-appearance at oral proceedings and the right to be heard

Differing views have been expressed in some decisions of the boards of appeal concerning the extent to which a party forgoes its right to be heard by choosing not to attend oral proceedings. Drawing attention to **T 574/89** and **T 484/90** (OJ 1993, 448) the President of the EPO referred to the Enlarged Board of Appeal the question of whether, if one party chooses not to attend oral proceedings, the decision handed down against that party can be based on new facts, evidence and/or arguments put forward during those oral proceedings.

In **G 4/92** (OJ 1994, 149) the Enlarged Board of Appeal held that, in view of the right to

present comments, a decision against a party who had been duly summoned but who failed to appear at oral proceedings could not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings could not be considered unless it had been previously notified and it merely supported the existing assertions of the party which submitted it. However, new arguments could - in principle - be used in the reasons for the decision as they did not constitute new grounds or evidence, but were reasons based on the facts and evidence already put forward. This opinion related only to inter partes proceedings.

The way in which **G 4/92** is interpreted and applied in practice is illustrated in a number of decisions.

In **T 341/92** (OJ 1995, 373), together with a statement setting out grounds of appeal the appellants (patent proprietor) filed a main request and an auxiliary request with new claims. However, the appellants - having notified the board to that effect in advance - were not represented at the oral proceedings. During oral proceedings the question of whether the subject-matter of claim 1 in accordance with the main request infringed Art. 123(3) EPC was brought up by the board **for the first time**. The board concluded that the **main request** constituted an inadmissible extension of the protection conferred. At the end of oral proceedings it was announced that the patent would be maintained with the claims according to the **auxiliary request**. The board did not consider itself prevented by reasons of procedural law from taking the fact that Art. 123(3) EPC precluded the maintenance of the patent in this version as a basis for its decision on the main request in accordance with the outcome of the oral proceedings. It argued that the situation differed from **G 4/92** in that the extension to which objection had been made arose solely from a comparison of the wordings of the respective claims according to the granted patent and the main request before the board, and therefore not from facts that had only been introduced into the case during oral proceedings. At all events, it was possible to base a decision on a ground discussed for the first time during oral proceedings which would prevent the patent being maintained as amended, at least if the stage reached in the case was such that the absent - albeit duly summoned - patent proprietors could have expected the question to be discussed and were aware from the proceedings to date of the actual basis on which it would be judged.

In **T 133/92** the board concluded that considering and deciding in substance on the maintenance of the patent on the basis of claims as amended during oral proceedings in the absence of the appellants (opponents) did not conflict with the opinion of the Enlarged Board of Appeal in **G 4/92**. The board stated that the respondent's (patentee's) restrictions to the claims removed objections already raised by the appellants. In such a situation the appellants could not have been taken by surprise, because they had reasonably to expect that the respondent would try to overcome all objections. The submission of auxiliary requests was clearly not a "fact" within the meaning of **G 4/92**. Were it otherwise, no decision could ever be issued at the end of a hearing where, as is usually the case, auxiliary requests are filed and, as is also frequently the case, the opponent does not attend the hearing, thereby rendering such hearings pointless and a waste of time, as well as offending against the general principle of legal certainty, ie the general interest of the public in the termination of legal disputes. Likewise, the board held In **T 771/92** that the decision to maintain the patent on the basis of a set of claims amended during oral proceedings in the absence of the

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appellant did not conflict with the principles described in **G 4/92**. The submission of restricted claims was neither a fact nor could it be evidence. The appellant could not be taken by surprise by the amendment made, because he had reasonably to expect that the respondent would try to overcome the objections made. The amendments resulted from the novelty objection made by the appellant during the written procedure.

In cases **T 912/91**, **T 202/92**, **T 856/92** and **T 890/92**, which were based on similar facts, the board also concluded that Art. 113(1) EPC had been satisfied. In **T 1049/93** the board decided that, where a duly summoned opponent chose not to attend oral proceedings, a board of appeal could still consider prior art which might be an obstacle to the maintenance of the patent in suit. **G 4/92** should not be construed as extending or prolonging the rights of a voluntarily absent party. In case **T 414/94** the board concluded that there is no general prohibition on amending requests during a party's absence from oral proceedings as requested by the respondent. An absent party must expect reactions of the opposing party within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions.

In **T 501/92** (OJ 1996, 261), the board ruled that if a new ground for allowing the appeal based upon the facts set out in the file record was raised by an appellant for the first time as a new argument during oral proceedings from which the respondent was voluntarily absent, it would be contrary to Art. 113(1) EPC and contrary to the principles underlying **G 4/92** to decide to allow the appeal on the basis of this new ground without first giving the respondent an opportunity to comment. In the case in point the appellant (opponent) submitted at the oral proceedings that the failure by the proprietor to file a formal request for maintenance of the European patent should lead automatically to revocation of the patent.

In **T 892/94** (OJ 2000, 1) the respondents (proprietors), albeit duly summoned, not only failed to appear at the oral proceedings but had also notified the board in advance, before the oral proceedings were held, of their decision to take no further part in the proceedings.

In the board's view, the respondents' declaration that they would take no further part in the proceedings could, only be construed as an unequivocal decision to surrender, voluntarily, their rights according to Art. 113(1) EPC and to avail themselves no longer of the opportunity to present their comments on any objections, facts, grounds or evidence which could potentially be introduced into the proceedings by the appellants or the board and which could later turn out to be decisive for the revocation of the patent. The board was therefore of the opinion that, considering and deciding in substance on the revocation of the patent did not contravene the respondents' procedural rights as laid down in Art. 113(1) EPC, although the respondents did not attend the oral proceedings.

T 55/91 raised the principle of the right to be heard in ex parte proceedings when the applicants/appellants, who were duly summoned to attend oral proceedings, failed to take advantage of the opportunity presented. The board considered that the appellants had had an opportunity to present their comments on the novelty objection raised by the board, but had not availed themselves of this opportunity. On considering the case at the oral proceedings, duly held pursuant to R. 71(2) EPC despite the absence of the appellants, the board came to the conclusion that the subject-matter of claims 1 and 2 lacked novelty for

reasons already set out by the board.

See also **T 434/95** in the chapter on apportionment of costs.

4. Article 113(2) EPC

Under Art. 113(2) EPC the EPO may consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent.

In **T 32/82** (OJ 1984, 354) the board pointed out that when taking its decision a board of appeal (or department of first instance) had no authority to order the grant of a European patent containing claims which were different in their content or interdependency from those submitted by the applicant. Amendment of the text by the examining division represented a substantial procedural violation (**J 19/84**).

In **T 647/93** (OJ 1995, 132) the board pointed out that the provision of Art. 113(2) EPC was a fundamental procedural principle, being part of the right to be heard, and was of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, had, in principle, to be considered to be a substantial procedural violation. In any case, such violation occurred when, as in the case in point, the examining division did not make use of the possibility of granting interlocutory revision under Art. 109 EPC after the mistake had been pointed out in the grounds of appeal.

In **T 73/84** (OJ 1985, 241) the board held that the patent was to be revoked if the proprietor of a European patent stated in opposition or appeal proceedings that he no longer approved the text in which the patent was granted and would not be submitting an amended text.

In **T 237/96** the board explained that Art. 113(2) EPC could not be interpreted in the sense that the examining division was bound to accept any amendment which the applicant might propose, only to ensure that there was a version approved by him. In circumstances in which, as in the case in question, amendments proposed by the applicant after the R. 51(4) EPC communication were with good reason not allowed by the examining division by virtue of R. 86(3) EPC and the applicant did not give its agreement to any other version of the application documents, the established practice of the EPO, sanctioned by consistent case law, was to refuse the application on the ground that there was no version approved by the applicant within the meaning of Art. 113(2) EPC, on which a patent could be granted.

In **T 549/96**, the Board noted that an applicant must unambiguously indicate at the end of the proceedings, which text he proposed. Otherwise, the Examining Division would be unable to decide on the basis of which version it should proceed and the application would eventually have to be refused, since there would be no clear request at all. Thus, if an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests, the Examining Division could refuse the application under Art. 97(1) EPC (see also **T 976/97**).

In **T 666/90** the status of the requests on file was not clarified during oral proceedings before

the opposition division. This resulted in a disagreement in the period between oral proceedings and the drafting of the written decision. The board pointed out that in a case such as this the appropriate action to take was to request a written copy of the final version of the requests and clarification of the order in which they were to be ranked prior to the decision being issued. Failure to clarify the position was in breach of Art. 113(2) EPC and hence constituted a substantial procedural violation. In **T 552/97** the opposition division had taken no decision on the main request being under the incorrect impression that it was no longer in the proceedings. The board pointed out EPO instances should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings.

In **T 425/97**, the text of the single claim attached to the written decision of the opposition division was different from the text apparently held as patentable at the oral proceedings, in relation to many essential features of the claim. From the original minutes of oral proceedings, the history of the case and further circumstances, the board therefore concluded that the opposition division took a decision on the patent in suit on the basis of a text which was neither submitted nor agreed by the proprietor of the patent. This involved an infringement of Art. 113(2) EPC and had to be considered as a substantial procedural violation.

In **T 543/92** and **T 89/94** the opposition division unintentionally failed to take account of a document introducing amended claims. In both cases the patent was revoked. The board ruled that once an item of mail had been received at the EPO it had to be considered to have been received by the organ deciding the case. Responsibility for correct processing of mail thereafter lay with the relevant departments within the EPO. The decision under appeal was thus in breach of Art. 113(2) EPC.

C. Oral proceedings

1. Right to oral proceedings

The right of parties to oral proceedings in examination, opposition and appeal proceedings is enshrined in Art. 116 EPC, according to which oral proceedings take place either at the instance of the EPO if it considers this to be expedient or at the request of any party to the proceedings. The right to an oral hearing was an extremely important procedural right which the EPO should take all reasonable steps to safeguard (**T 19/87**, OJ 1988, 268, **T 663/90**, **T 808/94**). If a request for oral proceedings had been made, such proceedings had to be appointed. This provision was mandatory and left no room for discretion (**T 283/88**). The body concerned could not then issue any decision affecting the requesting party without first appointing oral proceedings (**T 19/87**, OJ 1988, 268, **T 93/88**, **T 663/90**). Considerations such as speedy conduct of the proceedings, equity or procedural economy could not take precedence over the principle of the right to oral proceedings (**T 598/88**).

The board applied this principle in **T 556/95** (OJ 1997, 205) specifying that the discretion of an examining division to allow amendments up to the decision to grant the patent did not mean that that department had discretion to refuse requested oral proceedings dealing with such amendments. The examining division had to exercise its discretion under R. 86(3) EPC in the case of amendments requested after a R. 51(6) EPC communication in such

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circumstances having regard to Art. 116(1) EPC. The board continued that the right to be heard in oral proceedings (Art. 116 EPC) subsisted so long as proceedings were pending before the EPO. Lastly, the board added that the Enlarged Board of Appeal - which in **G 7/93** (OJ 1994, 775) had given some guidance as to how an examining division should exercise such discretion (R. 86 EPC after R. 51(6) EPC) - could not limit the application of Art. 116(1) EPC by means of such guidance.

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

In **T 194/96** the examining division, suspecting an abuse of procedure, had refused the appellant's request for oral proceedings, but the board ruled that this refusal had not been justified. According to the board, the EPO could use its discretionary powers under Art. 116(1) EPC, second sentence, to reject a request for further oral proceedings before the same department only "where the parties and the subject of the proceedings are the same". Even if the examining division was right in assuming an abuse of procedure on the part of the appellant, it could not refuse such a request. The only criterion was whether the subject of the proceedings had changed since the first oral proceedings.

In **T 125/89** the board also emphasised that Art. 113(1) EPC and Art. 116(1) EPC were clearly not restricted to "new and substantial arguments". Parties also had the right to repeat known arguments or to stress arguments which had already been brought forward or to link such arguments in a specific combination or series.

In **T 1051/92** the board pointed out that the mere information, provided by the opposition division in its communication, to the effect that if the appellants did not submit new arguments at the oral proceedings they would - for this reason alone - run the risk of having to pay substantial costs incurred by the respondent, could not be considered a substantial procedural violation (see also **T 303/86**).

The failure of a party to submit new and substantial arguments at the oral proceedings does not as a rule lead to a different apportionment of costs pursuant to Art. 104 EPC. In certain cases, however, eg if a request for oral proceedings is withdrawn or postponement is requested, if a party does not turn up for the oral proceedings or if there is an abuse of the oral proceedings, a different apportionment of costs may be ordered in accordance with Art. 104 EPC (see VII.C.1.2.3).

2. Oral proceedings before the Receiving Section

Under Art. 116(2) EPC oral proceedings must take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application.

A case in which the Receiving Section had to decide whether the loss of a right had resulted from the EPC in accordance with R. 69(2) EPC was not a case in which the Receiving Section "envisages refusing the European patent application" within the meaning of Art. 116(2) EPC. The Receiving Section could therefore refuse an applicant's request for oral proceedings where it did not consider such proceedings expedient (**J xx/xx**, OJ 1985, 159). In **J 20/87** (OJ 1989, 67) the Legal Board added that a board, exercising powers within the competence of the receiving section under Art. 116(2) EPC in conjunction with Art. 111(1) EPC, could refuse a request for oral proceedings made by an applicant in the course of an appeal against a decision of the Receiving Section where the board did not consider such proceedings to be expedient and where it did not envisage refusing the European patent application.

3. Request for oral proceedings

A party's right to oral proceedings is subject to a clear and unconditional request for such proceedings (**T 299/86**, OJ 1988,88, **T 433/87**, **T 663/90**). The question whether a request for oral proceedings has been made must be decided on the individual facts of each case. If there is the slightest doubt, clarification should be sought from the party concerned. (**T 19/87**, OJ 1988, 268, **T 283/88**). Nevertheless, in **T 528/96**, the board explained that, although the opposition division might reasonably have been expected to query whether such a request was in fact intended, the fact that it failed to do so did not constitute a procedural violation, since the onus to make a clear request was on the party itself.

In **T 870/93** the board found that the appellant had merely stated an intention of awaiting a new communication from the opposition division before - possibly - requesting oral proceedings. It added that to be sure of oral proceedings, the opponent should have asked for them at an early stage. Alternatively, if his intention was to request oral proceedings only if certain conditions were not fulfilled, he should have filed an auxiliary request clearly setting out those conditions.

3.1 Wording of request

In **T 528/96**, the final paragraph of the patentee's response to the opposition - the last document on the file before the opposition division took its decision - read as follows: "Should the opposition division feel that further information is required, the patentee will be pleased to respond in due course, either in writing or during the oral hearing". The opposition division argued that this statement did not constitute a request for oral proceedings. The board endorsed this view. The statement did not constitute a formal request for oral proceedings.

In interlocutory decision **T 299/86** (OJ 1988, 88) a party made the following statement: "In the event, however, that the examining division is minded to refuse the application, I reserve my right to request oral proceedings under Art. 116 EPC". This was interpreted as meaning that the party had not yet decided whether to request oral proceedings (see also **T 263/91**).

In **T 433/87** the board interpreted the patent proprietor's request "to conclude the opposition proceedings and if necessary arrange oral proceedings as soon as possible" to mean that oral proceedings were requested only in the event of their being considered necessary by the

opposition division. The statement "If there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the examiner" could not be understood as a valid request for oral proceedings either (see **T 88/87**).

In **T 19/87** (OJ 1988, 268) the board considered that the request in the applicant's letter for "an interview as a preliminary to oral proceedings" could only be construed as both a request for an interview (which might or might not be granted) and a request for oral proceedings. In the case in question it was mandatory that oral proceedings should take place before the examining division (see also **T 283/88**).

In **T 668/89** the phrase "... applicant's representative claims his right to appear and argue the case orally" was deemed to be a valid request for oral proceedings.

3.2 Withdrawal of request

A party's request for oral proceedings can be withdrawn only by virtue of a clearly expressed intention not to proceed with the request, for example in the form of an unambiguous written statement to that effect on the file. If there was no unequivocal proof of the withdrawal of the request, it had to be assumed that the request, once submitted, continued to exist and therefore also existed at the time of the contested decision (see **T 283/88**, **T 663/90**, **T 879/92**).

In **T 3/90** (OJ 1992, 737) oral proceedings were appointed as a result of a party's request for such proceedings on an auxiliary basis. The party subsequently stated that it would not be represented at the oral proceedings. In its decision, the board stated that such a statement should normally be treated as equivalent to a withdrawal of the request for oral proceedings.

A party's silence in response to a communication inviting it to state whether it wishes to maintain its request for oral proceedings may not, in principle, be interpreted as a withdrawal of the request.

In **T 35/92** the board stated that while it was reasonable for the opposition division to expect a response to its communication, which was justified in the interests of keeping the proceedings as brief as possible, there were nevertheless no legal grounds whatsoever for interpreting silence on the part of the appellants as withdrawal of the subsidiary request for oral proceedings. A request within the meaning of Art. 116(1) EPC could only be withdrawn by a declaration to that effect. There was no basis in the EPC for believing that withdrawal could occur by virtue of inaction, ie mere silence. Art. 116 EPC, at any rate, did not provide for a party's silence to have such an effect, which was tantamount to its forfeiting a right.

In **T 686/92** the patent proprietors' silence following a communication from the opposition division, asking whether they maintained the request for oral proceedings, had also been interpreted by the opposition division as a withdrawal of that request. The board stated that in the case of an auxiliary request for oral proceedings by a party there was no room for discretion on the part of the opposition division. The board held that the opposition division had no power to issue a decision adversely affecting the party without first appointing oral proceedings. In a similar case (**T 795/91**) the board added that a withdrawal required an

unambiguous expression of the party's wish to withdraw (see also **T 766/90**, **T 879/92**).

3.3 Further oral proceedings

According to Art. 116(1) EPC, second sentence, the EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

In **T 194/96** the board stated that the discretionary power, given to the EPO by Art. 116(1) EPC, second sentence, to reject a request for further oral proceedings before the same department is limited to the case "where the parties and the subject of the proceedings are the same". In the case in question, after the first oral proceedings new citations were submitted which were more pertinent than the documents on file and which could and in fact did radically change the nature of the decision. The board held that in such a case the subject of the proceedings within the meaning of Art. 116 EPC could no longer be the same.

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

In the following cases a request for further oral proceedings was rejected.

In **T 748/91** the board considered that in the case in point no substantially new situation had arisen with regard to Art. 116(1) EPC, second sentence, to justify further oral proceedings (see also **T 692/90**, **T 755/90**, **T 25/91**, **T 327/91**). In **T 547/88** too the board rejected the request for further oral proceedings since the parties and the subject were the same. The purpose of continuing the proceedings in writing after the first oral hearing was merely to provide further clarification of the same facts.

In **T 614/90** the board did not consider further oral proceedings expedient. The opportunity to comment in writing on the board's reasons for refusing further oral proceedings was also rejected because the reasons for the refusal had been given to the respondent in a communication.

In **T 529/94** the board ruled that refusal had not constituted a procedural violation. Indeed, in the board's opinion as expressed in this case, the examining division, in exercising its discretionary power under R. 86(3) EPC, had considered newly filed claims 3 and 4 as inadmissible. The legal consequence of this was that claims 3 and 4 were never integrated into the text of the application and never became part of it. For this reason, denying a second oral proceedings intended to discuss the allowability of proposed amendments already judged as inadmissible could not constitute a procedural violation.

In **T 731/93** the board stated that where fresh evidence had been admitted into the

proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) EPC in all three official languages, could no longer be the same. In this case the refusal of a request for further oral proceedings constituted a substantial procedural violation.

3.4 Auxiliary request for oral proceedings

According to the established practice of the boards of appeal, a request for oral proceedings on an auxiliary basis is interpreted as a request for oral proceedings unless the board intends to decide the case in favour of the requesting party (see **T 3/90**, OJ 1992, 737).

In **T 344/88** the appellants requested that oral proceedings be held if the opposition division intended to maintain the patent in whole or in part. The opposition division rejected the opposition as inadmissible without appointing oral proceedings. The board found that while it was true that, in rejecting the opposition as inadmissible, no formal decision had been taken to maintain the patent, this was nevertheless the consequence of the decision. A party's auxiliary request for oral proceedings therefore should not be viewed solely in terms of its wording. In view of the particular importance of the right to present comments in the form of oral proceedings, if it could reasonably be assumed from the wording of the request that oral proceedings were desired, such proceedings should be appointed or, where there were genuine doubts, the extent of the auxiliary request should be clarified by consulting the requesting party.

Although boards repeatedly emphasised the absolute right to oral proceedings (see VI.C.1) a request for oral proceedings sometimes had been interpreted as a conditional one when the board intended to remit the case to the first instance.

In **T 924/91** the appellants requested oral proceedings if the patent was not to be granted on the basis of the written submissions. The board remitted the case to the department of first instance and stated that there was no need to appoint oral proceedings because remittal meant that the decision under appeal was being set aside, not that the application was being refused. The board emphasised that the appellants' conditional request for oral proceedings was a request in the current appeal proceedings and would have no effect in the further proceedings before the examining division. Likewise, in **T 166/91** the board stated that the decision to remit the case to the department of first instance was not to be considered as adversely affecting the appellants, so that no oral proceedings needed to be appointed (see also **T 808/94**).

In their statement of grounds of appeal the appellants in **T 494/92** made an unconditional request for oral proceedings. The board stated that in view of the positive conclusion it had reached regarding the question of inventive step, and in the absence of any other substantive and/or procedural issues, such oral proceedings would serve no purpose. The board thus treated the request as merely conditional.

3.5 Request for oral proceedings in further prosecution proceedings

In **T 892/92** (OJ 1994, 664), the appellants submitted that after the case had been remitted to the opposition division for further prosecution, the oral proceedings they had originally

requested had never taken place. The board considered the question whether the original request for oral proceedings had been revived on remittal and was therefore legally effective and stated that "further prosecution" proceedings on remittal by the board of appeal were to be regarded as a continuation of the original opposition proceedings, particularly where the original interlocutory decision had been set aside by the board and was therefore no longer legally effective. Consequently, the patent proprietors' original request, which had never been withdrawn or amended, became effective again after remittal, so that the opposition division should not have taken a decision adversely affecting the proprietors without giving them an opportunity to present their case orally (Art. 116(1) EPC).

4. Infringement of Article 116 EPC

If a party submits a written request for oral proceedings, the relevant department is obliged to set a date for such proceedings. If the request is ignored, the decision must be set aside as null and void (**T 19/87**, OJ 1988, 268, **T 560/88**, **T 663/90**, **T 766/90** (see above)).

In **T 93/88** an opponent's request for oral proceedings was not granted due to an oversight on the part of the opposition division. The board decided that the decision issued by the opposition division in written proceedings must also be set aside as null and void.

The refusal of a request for oral proceedings normally constitutes a violation of the right to present comments and justifies reimbursement of the appeal fee (see under "Reimbursement of the appeal fee", VII.D.15.4.2).

In **T 693/95**, however, the board emphasised that where several parties are involved, eg in opposition proceedings, the EPC provides only for oral proceedings to which all the parties are invited, so as to respect the principles of judicial impartiality and the equal rights of parties. No provision exists for a discussion of substantive issues between a single party and a member of either the opposition division or the board of appeal. In the case in question, oral proceedings had taken place before the opposition division, and the appellants had had an opportunity to present their comments, through one of their number who had been present. Thus there was no basis for their allegation that they had been denied the right to be heard.

5. Non-appearance at oral proceedings

5.1 Right to present comments and non-attendance of a party by choice

On the question whether a decision pronounced against a party who has chosen not to attend oral proceedings may be based on new facts, evidence and/or arguments introduced during those oral proceedings, see section "Non-appearance at oral proceedings and the right to be heard", VI.B.3.

5.2 Obligation to give notice if not attending oral proceedings

In **T 653/91** the board made the following statement: "If, having been summoned to oral proceedings, a party does not wish to attend such proceedings, both the board (through its Registrar) and any other parties to the proceedings should be notified in writing of this fact

as early as possible before the appointed day. Except in special circumstances, telephone communications concerning such matters are inappropriate, especially in inter partes proceedings".

Also in **T 930/92** (OJ 1996, 191) the board pointed out that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as it knew that it would not attend as summoned. This was the case whether or not that party had itself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings. If a party which had been summoned to oral proceedings failed to attend as summoned without notifying the EPO in advance that it would not attend, an apportionment of costs in favour of another party which had attended as summoned could be justified for reasons of equity in accordance with Art. 104(1) EPC; see VII.C.12.3.

6. Preparation and conduct of oral proceedings

6.1 Fixing or postponing the date for oral proceedings

Under the terms of a notice issued by the Vice-Presidents Directorates-General 2 and 3 dated 1 September 2000 (JO 2000, 456) the departments of first instance and the boards of appeal will fix one single date for oral proceedings without pre-announcement of the date by phone or fax. Oral proceedings appointed by the EPO will be cancelled and another date fixed at the request of a party only if the party concerned can advance serious reasons which justify the fixing of a new date (overruling **T 320/88** (OJ 1990, 359) in this respect).

In **T 275/89** (OJ 1992, 126) the board considered that the illness of a duly represented party was not sufficient reason for postponing appointed oral proceedings unless the ill party needed to be present. A request to change an appointment could only be allowed if unforeseen, exceptional circumstances had arisen, which either made oral proceedings impossible (such as a representative's or unrepresented party's sudden illness) or could have a decisive impact on the course of the proceedings (such as unforeseen unavailability of an important witness or expert).

Applying these principles in **T 37/97**, the board decided that the facts cited in support of the request were neither unforeseeable nor exceptional and therefore did not justify postponement. In cases such as this, where a new representative was appointed after the summons to oral proceedings had been duly issued, the said representative, before taking on the mandate, could be expected to make sure he was available on the appointed date or to arrange for alternative representation. In the present case that ought easily to have been possible, as the power of attorney was held by an association comprising four professional representatives, which meant that any other representative could easily have attended on the appointed date. Thus the unavailability of the newly appointed representative had not been unforeseeable. Furthermore, a professional representative could be expected to be able to prepare for oral proceedings with all due care within a month unless the case was exceptionally difficult, which it was not.

The circumstances in **T 881/95** were not comparable with **T 275/89**. The request for postponement was refused, because the evidence which could only have been provided later

was not such as to affect the decision.

In **T 392/97** the board ruled that the subsequent appointment of oral proceedings by a national patent court to take place on the same date as the previously appointed oral proceedings before the board was not in itself a sufficient reason for adjournment. A request to postpone an appointed and agreed date could only be allowed in the case of "unforeseen and exceptional" circumstances. "Exceptional" could be construed as meaning such circumstances which either made it impossible for the oral proceedings to take place or might have a material bearing on the course and outcome of the proceedings.

In the case in point, the representative involved could have been substituted by a colleague from his office. As to the question whether the presence of this representative might have had a material bearing on the decision which was to be taken, the board observed that it had been unable to ascertain circumstances which would have made it necessary for him to be present in person at the proceedings.

In **T 693/95** the board decided that it had waited patiently for two years to give the appellants time to find a legal representative of their choice. This they had failed to do. After such a long delay there was no valid reason for postponing oral proceedings; for reasons of equity, the board was obliged to take into account not only the appellants' interests but also those of the respondent and the public, which had an interest in knowing as soon as possible the exact extent of protection of the contested patent.

6.2 Curtailment of notice in the summons

Under R. 71(1) EPC, second sentence, the notice given in the summons to oral proceedings must be at least two months, unless the parties agree to a shorter period.

In **J 14/91** (OJ 1993, 479) the board ruled that a dispute about a third party's right to inspect the application dossier before publication must be decided promptly (ie before publication), otherwise Art. 128(2) EPC becomes null and void. If oral proceedings would facilitate a prompt decision, the summons under R. 71(1) EPC may give shorter notice - even without the other party's agreement - provided the parties are given enough time to prepare. The board referred to Art. 125 EPC and stated that in the case of a request for inspection of files to which the applicant objected, oral proceedings were the best way to give the parties a comprehensive and swift hearing. Although the EPC did not itself make any provision for urgent cases, it was a generally recognised principle of procedural law in the contracting states that notice could be curtailed in urgent cases. The degree of curtailment should be decided on a case-by-case basis.

In case **T 111/95**, the board stated that the examining division had no right simply to set a date for oral proceedings about two weeks after despatch of the summons. In the board's view, the onus of proving that such an agreement was reached lay with the examining division as the party making the claim. The board found that there was nothing on file to establish that the applicants' representative, at any time and unconditionally, accepted the date set. The board thus held that the summons was null and void, as were the actions following and resulting from it. The case was therefore remitted to a department of first

instance in a different composition for resumption of the proceedings at the stage preceding the invalid act.

6.3 Communication under Article 11(2) RPBA

Under Art. 11(2) RPBA the board may send with the summons to oral proceedings a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious, or containing other observations that may help concentration on essentials during the oral proceedings.

In **T 614/89** it was pointed out that a communication in accordance with Art. 11(2) RPBA preparatory to the oral proceedings, in which the board presented its provisional assessment of the facts, was by no means binding and ought not to be interpreted by any party as meaning that the proceedings were pointless. Rather, that party had an absolute right to have the case discussed at the oral proceedings. The communication in accordance with Art. 11(2) RPBA was a snapshot, intended to clear up certain points of controversy in advance and accelerate the proceedings, as well as to encourage the parties to come up with further and sounder arguments in order to provide a reliable basis for the decision.

By a decision dated 13.12.1994 the Administrative Council introduced a new R. 71a EPC concerning the preparation of oral proceedings (see OJ 1995, 9). The new rule provides as follows: "When issuing the summons, the EPO shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed...".

In **G 6/95** (OJ 1996, 649), on a referral in **T 276/93** (OJ 1996, 330), the Enlarged Board ruled that new R. 71a(1) EPC did not apply to the boards of appeal, which thus continued to have discretion as to whether or not to send a communication when issuing a summons to oral proceedings, as provided for in Art. 11(2) RPBA. The mandatory procedural requirements of R. 71a(1) EPC applied to the EPO's first-instance departments but not to the boards, because the Administrative Council could not amend the Implementing Regulations in such a way that the effect of an amended rule was in conflict with the RPBA adopted under Art. 23(4) EPC by the Presidium of the boards of appeal as the emanation of the boards' independence and approved by the Council.

6.4 Interpretation and application of Rule 71a EPC

R. 71a EPC stipulates, inter alia, that, when issuing the summons to oral proceedings, a final date for making written submissions in preparation for the oral proceedings must be fixed. New facts and evidence submitted after this date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed. The same is true for applicants or patentees invited under R. 71a(2) EPC to submit documents which meet the requirements of the EPC.

In **G 6/95** (OJ 1996, 649) the Enlarged Board of Appeal held that R. 71a(1) EPC did not apply to the boards of appeal.

VI.C.6. Preparation and conduct of oral proceedings

In **T 97/94** (OJ 1998, 467) the board ruled that R. 71a(1) EPC is binding on the parties. Thus, if a board decides to send the parties a communication under R. 71a(1) EPC, they are obliged to comply with it, particularly as regards the deadline for reply (Reasons, point 3.5.1).

Prior to **G 6/95**, it was decided in **T 39/93** (JO 1997, 134) and **T 885/93** that new R. 71a EPC should not be construed as an invitation to file new evidence or other material departing from the legal and factual framework of issues and grounds pleaded and evidenced throughout the proceedings prior to the hearing of the appeal.

In **T 476/96** the board found that the appellants had not revealed the full extent of their arguments and objections until one month before the oral proceedings - in this case, above all, on the last day of the period set by the board under R. 71a(1) EPC, ie nearly nine years after lodging the opposition.

The concept of due time within the meaning of Art. 114(2) EPC, which was not defined in the text of the EPC, was a matter for the boards' discretion. The principle of the right to be heard (Art. 113(1) EPC) required that the facts and evidence relied upon be presented in due time, ie early enough for the other side to have the time to examine them properly and draw the necessary conclusions for its defence. This principle allowed the boards to disregard evidence communicated to the other side by surprise, shortly before the oral proceedings. This was the case here, since (1) the experimental data had not been produced by the appellants until the last day of the period fixed by the board under R. 71a(1) EPC, although the board had invited them to present the data six months previously; (2) the quantity of data and the new problems raised clearly required more than a month to produce counter-examples; and (3) it had not been established that the appellants were not in a position to comply with the time limit set.

In **T 951/97** (OJ 1998, 440), the board considered the application of the rule to the examining division. It held that the subject of the proceedings was changed within the meaning of R. 71a(1) and (2) EPC, inter alia, where the examining division itself introduced a new document, which was pertinent new material, into the proceedings for the first time during oral proceedings convened following a R. 71a EPC notification.

In **T 452/96** the board emphasised that fixing a time limit under R. 71a EPC was not to be taken as an invitation to submit further evidence and therefore had no impact on the power to disregard late-filed documents. With its finding that the newly filed documents were less relevant than the material already in the proceedings at the time in question, the opposition division had acted in accordance with the principles established by case law.

In **T 712/97** the respondent (opponent) filed a report on comparative experiments on the last day of the period set for filing comments pursuant to R. 71a(1) EPC. The opposition division allowed this experimental report into the proceedings. The board did not see in this any procedural violation by the opposition division or any abuse of procedure by the respondent. It would in fact seem strange to deny the respondent the right to react to the opposition division's comments. However, the opposition division did not allow the appellant's experimental report, in response to the respondent's experimental report, into the proceedings.

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The board considered that admitting the respondent's experimental report into the proceedings meant that the subject of the proceedings had changed within the meaning of R. 71a(1) EPC. The board stressed the reasons for introducing R. 71a EPC, which stated that "new facts and evidence put forward after that date need only be taken into account if based on a change in the subject of the proceedings, for example because the other party has raised new material in his own preparatory papers" (see OJ 1995, p. 417-419). Thus the appellant's experimental report should have been admitted into the proceedings as a response to the respondent's experimental report. That the appellant's report would not affect the outcome of the proceedings was in these circumstances not a consideration that should have been taken into account when deciding on its admission into the proceedings. A party was entitled to know that its response was part of the documents admitted into the proceedings, even if it proved not to be decisive for the outcome before that instance.

In **T 755/96** (OJ 2000, 174) the board observed that R. 71a EPC gave the EPO a discretionary power. The Office's power to accept or refuse late-filed new facts or evidence was in fact governed by Art. 114(2) EPC, and the discretionary power to refuse new requests for amendments was governed by Art. 123 EPC and the corresponding Implementing Regulations.

As to the exercise of discretion under R. 71a EPC regarding amendments, the board said that the task of the EPO was to grant European patents which complied with the EPC. On the other hand, it was also desirable that the procedure before the EPO be as efficient as possible. It would not be conducive to this if the discretionary power conferred by R. 71a EPC was exercised in a purely formalistic way, so that the European Patent Office refused to consider new claims on the sole ground that they had not been filed by a final date stated in a summons to oral proceedings, even though the request in fact complied with all the requirements of the EPC and raised no new issues. This would lead to an appeal, in which the request would then be allowed into the proceedings and the matter referred back to the department of first instance.

In the board's view it was important to draw a **distinction** between the **application stage** and the **opposition stage**. Parties to opposition proceedings were often represented by professional representatives, who would need to consult their clients. Thus there could be good reasons to refuse material filed after the final date set under R. 71a EPC, or to postpone oral proceedings.

However, the same considerations did not apply to an examining division entrusted with substantive examination, since it had its own technical expertise and did not have to obtain instructions from third parties. If prepared for oral proceedings, it should normally, even in relation to requests filed at the oral proceedings, be in a position to assess whether a new request was clearly not allowable under the EPC and to decide on the basis of this finding not to admit such a new request into the proceedings. An examining division which in exercising such discretion does not admit amended claims must give the reasons therefor. The assessment that they were filed too late under R. 71a EPC did not represent adequate reasoning in accordance with R. 68(2) EPC.

In **T 484/99** the appellant (patentee) alleged that the refusal, under R. 71a EPC, by the

opposition division to consider or even look at amendments to the requests presented on the day of the oral proceedings before them amounted to a procedural violation.

The Board disagreed because it was clear from the wording of R. 71a(2) EPC, that submissions of the Proprietor presented after the final date needed not be considered. In the present case it was equally evident that a large number of attempts to amend the patent in suit had been permitted in earlier stages of the opposition proceedings.

The board in **T 1105/98** explained that R. 71a(2) EPC was applicable to proceedings before the boards of appeal.

In the case in question, the patent proprietor's auxiliary request with amended claims was presented at the start of the oral proceedings, ie after expiry of the time limit set in the summons to oral proceedings. The respondent (opponent) argued that the auxiliary request should be refused as out of time.

The board examined whether the auxiliary request could be refused as out of time on the basis of R. 71a(2) EPC, and decided that the latter provision also applied to the late submission of amended claims by way of an auxiliary request, even if the summons to oral proceedings had not contained an invitation to submit them. If the patent proprietor only submitted amended claims at the oral proceedings, the board could use its discretion to disregard them, particularly if the facts of the case had remained the same and further investigation was necessary to assess the lack of patentability alleged as ground of opposition.

6.5 Taking of minutes

In **T 642/97**, the board considered basic principles concerning the minutes which according R. 76 EPC should contain "the essentials of the oral proceedings ... and the relevant statements by the parties...". It stressed that this provision did not require that the minutes reflect the full arguments of the parties. It was within the discretion of the minute-writer what he considers "essential" or "relevant". Whereas it was required that the minutes contain the requests or similarly important procedural statements, most of the arguments concerning patentability are normally apparent from the previous written submissions or from the facts and submissions in the written decision and need not be contained in the minutes. Nevertheless, if a party was of the opinion that the minutes were incomplete or wrong since essential submissions were not reflected at all in the file it might request the opposition division to correct the minutes to preserve its rights (**T 231/99**). In absence of such a request, the allegation of a substantial procedural violation could not be justified.

In **T 212/97** the board explained that only decisions could be contested. Since the minutes of oral proceedings were neither a decision nor part of the decision, they could not be "annulled" by the board of appeal (as already established in **T 838/92**). The fact that the minutes did not record all the arguments presented by the parties could not be said to constitute a substantial procedural violation in drafting the minutes. Under R. 76(1) EPC only a summary record was required. It was up to the minute-taker, in the proper exercise of his discretion, to decide which aspects of the parties' arguments were "essential" or "relevant".

A procedural violation could only be said to have occurred if the limits of such discretion were overstepped, eg if a party's unambiguous statement of surrender were omitted from the minutes. **T 928/98** specified that what was particularly relevant were the specific requests and statements with an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter.

In **T 231/99** it was mentioned that the board's responsibility for the decision on the validity of the patent did not extend to deciding on the accuracy of the minutes of first-instance proceedings. The EPC made no provision for the correction of minutes (see also **T 1198/97**).

In **T 819/96** the board felt obliged to comment on the refusal of the appellants' request for correction of the minutes. The opposition division had refused this request, on the basis that the grounds for maintaining the patent had remained unchanged. However, this was not the appropriate criterion for deciding whether or not a correction of the minutes was justified. Instead, it would have been necessary to determine whether the minutes complied with the requirements of R. 76 EPC, considering in particular whether they accurately reflected the essentials of the oral proceedings (R. 76(1) EPC). Since the appeal proceedings had given the appellants an opportunity to present their views on the essentials of the oral proceedings before the opposition division, and to have those views placed on record, there was no reason to consider the issue of whether the response to the request for correction of the minutes had been substantively correct. Since this issue was no longer relevant, the question whether it could be considered in the context of the current proceedings could be left aside.

In **T 396/89** there was disagreement between the parties as to whether the appellant had or had not made a concession on a particular point before the opposition division. There was no record of this in the minutes of the proceedings. The board stated that if a clear concession was made during oral proceedings, the opposition division was entitled to base its decision on that concession, unless it was convinced that the facts conceded were not true. However, if an important matter of fact was conceded, that concession ought to be carefully recorded in the minutes of the hearing.

6.6 Interpreting costs during oral proceedings

Under R. 2(1) EPC, any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition either that such party gives notice to the EPO at least one month before the date appointed for such oral proceedings or makes provision for interpreting into the language of the proceedings.

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) EPC had not been observed because the EPO had failed to issue a corresponding invitation: they submitted that the EPO ought to have drawn their attention to the period of notice mentioned in R. 2(1) EPC. The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Obviously,

only the EPO could assess how much preparation time was needed. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month. A professional representative before the EPO was supposed to be familiar with both the EPC and its Implementing Regulations.

In **T 44/92** the board came to the conclusion that if a patent proprietor with several appointed representatives chose to use another official language for the oral proceedings in addition to the language of proceedings, the EPO would not bear the costs of interpreting (R. 2(1) and (5) EPC).

D. Time limits

1. Calculation of time limits

1.1 Calculation problems (Rule 83 EPC)

In **J 14/86** (OJ 1988, 85) the Legal Board of Appeal made the following ruling on the calculation of time limits under R. 83 EPC: the fact that R. 83(2) EPC fixed the point in time from which all the time limits ran and defined this point as the day following that on which the event giving rise to the time limit occurred, could not be interpreted as requiring the addition of a day to time limits expressed in years, months and weeks, hence the grant of an additional day for reasons of equity. The expiry date of time limits expressed in years, months or weeks was derived from R. 83(3) to (5) EPC. These paragraphs, in conjunction with paragraph 2 of the same rule, established unequivocally that the time limits were fixed in full years, months and weeks, without any possibility of their being reduced or extended (see also **J 9/82**, OJ 1983, 57).

The calculation of time limits under R. 80 PCT is identical, but its wording largely avoids the lack of clarity found in R. 83 EPC.

In **J 13/88** the Legal Board of Appeal gave an example of how to calculate time limits with reference to the above-cited case law. In the case in question the 12-month priority period had to be calculated. The event representing the point in time from which a time limit started to run was the filing date of the application in respect of which priority was claimed, which was 5.5.1986. The period referred to in Art. 87 EPC was expressed in months; it expired in the relevant subsequent month (ie in this case May 1987) on the day which had the same number as the day on which the said event occurred, which was 5.5.1987 (R. 83(2) EPC in combination with R. 83(4) EPC).

1.2 Public holiday in one of the filing locations under Rule 85(1) EPC

The amendment made to R. 85(1) EPC with effect from 1.8.1987 ensured that time limits would expire at the same time even where there was a public holiday in only one of the filing locations (Art. 75(1)(a) EPC). This rule relates both to the time limit for filing documents, cheques and debit orders and to payments not assignable to any particular filing location, such as, for example, payment by means of a bank transfer (for the legal position prior to

1.8.1987 see **J 1/81**, OJ 1983, 53 and **J 30/89**, Special edition of the Official Journal 1990 - Case Law, p.45).

1.3 Additional period for renewal fees under Article 86(2) EPC

In decision **J 4/91** (OJ 1992, 402) the Legal Board of Appeal laid down a new method for calculating the additional period for renewal fees. The board held that when calculating the six-month period for the payment of a renewal fee with additional fee under Art. 86(2) EPC, R. 83(4) EPC should be applied *mutatis mutandis* in the light of R. 37(1) EPC, first sentence. This meant that the six-month period did not end on the day of the subsequent sixth month corresponding "in number" to the due date according to R. 37(1) EPC, first sentence, but on the day which was equivalent to this due date by virtue of its being the "last day of the month". For the purposes of calculating the additional period under Art. 86(2) EPC, therefore, R. 83(4) EPC, in the context of R. 37(1) EPC, first sentence, resulted in a period running "from the last day of the month to the last day of the month".

The Legal Board then considered Legal Advice No. 5/80 (old version) on the "Calculation of aggregate time limits" (OJ 1980, 149, 152) as a possible breach of the "last day of the month" rule, since it mentioned in passing that the principles contained therein should also be applied to the additional period under Art. 86(2) EPC. The board held that Legal Advice No. 5/80 was not applicable to the start of the additional period under Art. 86(2) EPC. This meant that the additional period started on the last day of the month specified in R. 37(1) EPC, first sentence, even in the circumstances mentioned in R. 85(1), (2) and (4) EPC. It followed that the occurrence of such circumstances at the beginning of the period did not result in the end of the period being postponed beyond the end of the sixth month and into the seventh month. Legal Advice No. 5/80 was superseded by Legal Advice No. 5/93 rev. (OJ 1993, 229) which takes into account the amendments to R. 85a EPC, 85b EPC and 104b(1) EPC (now R. 107(1) EPC).

1.4 Period of grace for payment of fees under Rule 85a EPC

In **J 5/91** (OJ 1993, 657) the Legal Board of Appeal was asked to rule on how R. 85a EPC should be interpreted where the time limit under paragraph 1 for the subsequent payment of designation fees for the designation of contracting states in connection with a European application expired later than under paragraph 2. The new version of R. 85a(1) EPC, which came into effect on 1.4.1989, states that if the designation fees are not paid within the specified time limit the EPO must notify the applicants that they may still be validly paid within a period of grace of one month. The two-month period of grace without notification under R. 85a(2) EPC continues to apply to precautionary designations. The board therefore concluded that "In cases where the time limits for subsequent payment of designation fees under paragraphs 1 and 2 of R. 85a EPC ... expire at different times, all designation fees can still validly be paid up to the later date".

In **J 5/98** the board held that the occurrence of a national holiday on the last day of the period of grace for payment of designation fees pursuant to R. 85a(2) EPC did not have the effect of extending that period. Having examined all relevant provisions the board pointed out that the case was concerned with the expiry of a period of grace and not an initial time limit and

the law did not allow the extension of the expiry of a period of grace. The board observed that the period of grace, as its name indicates, exists to allow those who miss the initial time limit to comply belatedly, provided they pay a surcharge. To extend such periods of grace to allow for national holidays in contracting states would be to add a second period of grace to the first. That would be contrary to the intention behind the present R. 85a EPC which was to regularise the practice relating to payment of fees after expiry of the initial time limit.

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

2. Extension of time limits

2.1 Relevant criteria

In **T 79/99** the board noted that when asked for either extensions of time limits or postponement of oral proceedings, the board has to consider not only the interests of each of the parties but also the overall interest in the expeditious prosecution of appeals and the delays to other cases in the event of postponements. It decided that all interests would be best served in the case at issue by maintaining the date appointed.

The board took this opportunity to remind parties that, while some delay arising from the volume of pending appeals was inevitable, additional delays caused by parties themselves were often avoidable and were in principle undesirable. Such additional delays could affect not only the particular cases in which they occur but also other pending appeals the parties to which have complied with the usual time limits. It was also the case that most initial time limits under the EPC and the procedure of the boards (for example, four months for an appellant to file its Grounds of Appeal and four months for a respondent to reply thereto) were generous by comparison with corresponding provisions of the laws of many contracting states. Parties should not consider extensions of time as being available for the asking. Requests for extensions of time should only be made sparingly. Such requests should be made as soon as the possibility of the need for extra time becomes apparent and not at the last moment. Only the period of time actually and reasonably required should be sought. The more extensions a party seeks, or the longer the time sought for any one extension, the more important it is to provide reasons. It is also prudent to consult other parties to the appeal in advance - if they agree to an extension, the board is more likely to agree also; if they disagree, the board could then be made aware of their views. The board went on and pointed out that when considering requests for additional time, it would take into account not only any reasons put forward but also the number of previous extensions (if any), the views of the other party or parties (if known), the effect of delays on other appeals pending before it and the general principle that all delays are to be avoided where possible. Similar considerations apply to requests to adjourn oral proceedings.

2.2 Further processing - refusal of a request for extension of a time limit

Art. 121(1) EPC provides that applicants may request further processing of a European patent application if their application is to be refused, has been refused or is deemed to be withdrawn following failure to reply within a time limit set by the EPO.

In **J 47/92** (OJ 1995, 180) the Legal Board of Appeal stated that further processing under Art. 121 EPC was available only in respect of those time limits the **duration** of which was to be determined or set by the EPO. As regards the period of grace pursuant to R. 85b EPC the board noted that its duration was defined as one month by the rule itself and not by the EPO. Though it was true that the actual date of expiry of the period of grace depended on an action performed by the EPO, this fact did not imply that the time limit was set by the EPO, since the EPO did not thereby determine the **duration** of the time limit. The period of grace was therefore not open to further processing.

In **J 16/92** the examining division had issued a communication pursuant to R. 69(1) EPC after its first communication inviting observations had failed to elicit a response. The representative had thereupon applied for further processing of the application, requesting an extension of the time limit for filing observations concerning the first communication. The omitted act had, however, not been completed within the time limit laid down by Art. 121(2) EPC. The Legal Board of Appeal concluded that where the omitted act consisted in filing a reply in substance to a first communication, it was not completed by filing a request for a time limit for submitting that reply, since a request for a time limit was not equivalent to the act the party in question had proposed performing within the time limit requested.

In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal pointed out that the applicants could overcome a loss of rights under Art. 96(3) EPC resulting from the refusal of a request for a time-limit extension by requesting further processing in accordance with Art. 121 EPC. At the same time, they could request reimbursement of the fee for further processing. This secondary request had to be decided on in connection with the final decision. Under Art. 106(3) EPC, the decision on the secondary request could be appealed together with the final decision. The appeal could also be confined to contesting the decision on the secondary request.

3. Interruption of proceedings - Rule 90 EPC

3.1 Application of Rule 90 EPC by the EPO of its own motion

R. 90 EPC provides that proceedings before the EPO shall be interrupted

- of the death or legal incapacity of the applicant or patent proprietor (R. 90(1)(a) EPC);
- in the event of the applicant or patent proprietor or his representative, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the European Patent Office, in particular in the case of bankruptcy (R. 90(1)(b)(c)) EPC);
- in the event of the death or legal incapacity of the representative of the applicant or patent proprietor (R. 90(1)(c) EPC);

The EPO must apply this Rule of its own motion (**J ./87**, OJ 1988; **J 23/88**; **T 315/87**). The consequence of interruption of proceedings is that the time limits in force as regards the applicant or patentee at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings were resumed (cf. R. 90(4) EPC). However, the time limit for making the request for examination and the time limit for paying renewal fees are only

suspended (see below, 3.7 - Consequences of interruption of proceedings).

3.2 Concept of legal incapacity (Rule 90(1)(a)(c) EPC)

The EPC does not define the concept of "legal incapacity", which is assessed differently according to whether the person concerned is the applicant or patentee or a professional representative: In **J xx/xx** (OJ 1985, 159, point 9) and **J xx/87** (OJ 1988, 177, point 5) the Legal Board held that the capacity of the **applicant or patent proprietor** to carry out legal transactions relating to his application or patent must be determined in accordance with the relevant **national law** because the interest in the patent application or the patent is an interest in property (cf. Art. 74 EPC, Art. 2(2) EPC). See also **J 49/92**. On the other hand, **J xx/xx** (OJ 1985, 159, point 10) states that a **uniform standard** of judging legal incapacity of **representatives** shall apply in order to avoid differences in the application of R. 90(1)(c) EPC depending on the nationality of domicile of the representative.

3.3 Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 90(1)(a) EPC

In **J ..87** (OJ 1988, 177) the board ruled that a brief medical certificate attesting that the applicant had been in a state of physical and mental exhaustion and depression, was not sufficient to establish incapacity within the meaning of R. 90(1)(a) EPC since the certificate said nothing about the seriousness and duration of this condition.

In **J 49/92** the Legal Board of Appeal was again unable to conclude from the applicant's submission that he had been legally incapacitated in accordance with German law, which was relevant in that case. The board had no evidence - such as a medical certificate - to suggest that the applicant's condition had been such, according to German legal practice, as to exclude his exercising his will rationally, since he had still managed to transfer the fees for the application, even if they had been sent by mistake to the German Patent Office instead of the EPO.

3.4 Determining legal incapacity of the representative for the purpose of Rule 90(1)(c) EPC

In **J xx/xx** (OJ 1985, 159) the board noted that although there were differences in the national laws of Contracting States as to the concept of "legal incapacity" and as to its consequences, there seemed to be a broad agreement that a person of full age was legally incapacitated when he is suffering from such a disturbance of his mind that he was unable to form the necessary voluntary intention to carry out legal transactions which would be binding upon him, e.g. to make valid contracts. Such a disturbance of his mind could be recognised by national law even if it was temporary only (e.g. a disturbance caused by physical injury or by the influence of alcohol or other drugs) or occurs from time to time, as was the case with some mental illnesses in which the patient had lucid intervals. Disturbance of the mind causing legal incapacity is always recognised by law if it is of long duration, a fortiori if it is permanent and irreversible.

The board noted that although no definition of legal incapacity was given in the Rule or in the

Convention, the most that could possibly be deduced from R. 90 EPC itself was that the incapacity should be such that the appointment of a new representative was necessary or at least expedient: cf. R. 90(3) EPC. The relevant aspect of his legal incapacity for the purpose of R. 90(1)(c) EPC was that of his incapacity to carry out professional work on behalf of a client. Since there was a unified European profession of representatives before the European Patent Office, it was justified to consider that there should be a uniform standard of judging legal incapacity, in order to avoid differences in the application of R. 90(1)(c) EPC depending on the nationality or domicile of the representative. The matter was, of course, completely separate from any question of a representative's legal incapacity to manage his own personal affairs, which, in accordance with the relevant national law would be governed by his nationality or domicile. In these circumstances, the question of determining the legal incapacity of a representative for the purposes of R. 90(1)(c) EPC was one for the EPO, applying its own standards, developed in the light of experience and taking into consideration principles applied in the national laws of Contracting States.

In **J 7/99** the board noted that this uniform standard of legal incapacity had been determined by the board for the purpose of R. 90(1)(c) EPC taking into consideration the principles recognised in the national laws of the Contracting States. The basic consideration was whether the representative concerned was either in a fit mental state to do the work required of him at the material time or whether he lacked the capacity to make rational decisions.

In **J 5/99** the board cited that that meant carefully weighing up all reliable relevant information. Also indispensable was a reliable medical opinion taking account of all material facts.

The legal incapacity must be of a persistent nature (**J ../86**, OJ 1987, 528). For the purposes of R. 90(1)(c) EPC, the EPO must establish whether and if so when the representative was legally incapacitated, and in the light of its findings specify the time limits which may have been interrupted (**J ../87**, OJ 1988, 323).

In **J 7/99** the appellant's former representative explained during the oral proceedings, his mental block was restricted to just this single case in which his secretary failed to observe the time limit pursuant to Art. 91(5) EPC and, as a consequence, he himself failed to file the grounds of the request for restitutio in integrum within due time (Art. 122(2) EPC). In other cases he worked, as he pointed out, "automatically" so that no other failure to meet time limits or other mistakes occurred. The board found, however, that was not "legal incapacity" as it is understood for the purpose of R. 90(1)(c) EPC. Legal incapacity pursuant to this rule means a mental state in which the representative is so totally or nearly totally unable to take rational decisions that all his professional duties, and not just one isolated case, are affected by his mental state. It would be highly unreliable to assess a representative's legal capacity or incapacity by reference to only one case. Furthermore that approach would beg the question whether legal incapacity as regards one single case could or did affect other cases dealt with by the representative in question. Thus the board did not find that the appellant's former representative was legally incapable of dealing with the application at the material time and held that the main request must be refused.

In **T 315/87** of 14.2.1989 the board lent credence to the assertion that during the time in question the previous representative had found himself in the unusual situation described,

particularly as the circumstances (proceedings concerning professional conduct, the need to organise his office's work) had also been made known officially to the European Patent Office. It further accepted that he had been suffering from physical and mental disorders during that time. Indeed, the medical documents submitted by the previous representative himself pointed to a psychosomatic condition.

3.5 Legal incapacity of a representative from outside the Contracting States

In **J 23/88** the Receiving Section had disallowed the applicant's claim under R. 90(1)(a) EPC, holding that an American patent attorney was not covered by R. 90(1)(a) EPC, being neither the applicant nor the proprietor of a European patent, nor a person authorised by national law to act on his behalf. The decision was based on a strict construction of R. 90(1)(a) EPC, and in particular upon the premise that the relevant category in that Rule (persons authorised by national law) covered legal representatives of the applicant/proprietor but did not extend to a patent attorney authorised under the laws of a non-Contracting State, whose legal incapacity was, therefore, irrelevant to the operation of the above Rule. The board disallowed the applicant's claim under R. 90(1)(a) EPC.

The board however, of its own motion, considered whether or not such interruption had taken place under R. 90(1)(c) EPC (legal incapacity of the representative of an applicant for a European patent), a ground not specifically relied upon by the appellant. The board came to the conclusion that the US patent attorney in the case at issue was, at the relevant time, a legally incapacitated representative of the applicant within the meaning of R. 90(1)(c) EPC. This interpretation was fully consonant with the preparatory documents regarding the desirability of equal treatment of Applicants from Contracting and non-Contracting States. The board found that the difference in the wording of R. 90(1)(c) EPC from that of R. 90(1)(a) EPC was deliberately chosen so as to create equal treatment between applicants in the Contracting and in non-Contracting States (cf. Minutes of the 10th meeting of Working Party I of the inter-governmental conference for the setting up of a European system for the grant of patents, held in Luxembourg, on 22 to 26 November 1971, BR/144/71, § 71). The board observed that Art. 133(2) EPC provides a limited exception to the normal requirement for professional representation within the meaning of Art. 134 EPC in the case, and only in the case, of the filing of the European patent application. Such a filing could validly be made by the applicant himself or by any representative duly authorised by him. Thus, in effect, once the processing of the international application has properly started in the EPO, an American patent attorney would lose his entitlement to act under Art. 49 PCT by virtue of the combined effect of Art. 27(7) PCT, Art. 133(2) EPC and Art. 134 EPC. Once he lost his representative capacity, any interruption in proceedings occasioned by his death or legal incapacity would no longer be covered by R. 90(1)(c) EPC.

3.6 Interruption of proceedings because of insolvency (Rule 90(1)(b) EPC)

According to R. 90(1)(b) EPC proceedings before the EPO shall be interrupted in the event of the applicant for a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO.

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC (interruption of proceedings because

of insolvency) to be applied in the light of Art. 60(3) EPC and R. 20(3) EPC, the applicant entered in the Register of European Patents and the insolvent person (here a limited company) had to be legally identical; for the possibility of having rights re-established see p. 322.

In **J 26/95** (OJ 1999, 668) the board noted that, as could be derived from the legislative history of R. 90 EPC, it was not the name or formal qualification of an action against property that was decisive for the question of whether it interrupted proceedings under R. 90(1)(b) EPC. It was also not decisive whether the action served the purpose of satisfying all of the debtor's creditors. The decisive criterion for interruption was whether the action against the property was such as to make it legally impossible for the applicant to continue with proceedings. Being placed under Chapter 11 of the US Bankruptcy Code was an action taken against the property of the debtor. It did not, however, constitute a case where, as a result of such action, it was impossible for the debtor to continue the proceedings before the EPO. On the contrary, it was the very nature of proceedings under Chapter 11 that it was the debtor who continued to act for his business, even if he was subject to certain restrictions due to his obligation to preserve the interests of his creditors and due to his supervision by a trustee, if any. The board concluded that Chapter 11 bankruptcy proceedings were therefore not comparable to the cases which had been recognised in the case law of the boards of appeal as leading to interruption of proceedings, ie where parties had been placed under receivership under French law (**J 7/83**, OJ 1984, 211) or been declared bankrupt under German law (**J 9/90** unpublished). The board therefore concluded that, in the absence of specific circumstances having been shown in the case under consideration, proceedings against the applicant under Chapter 11, "Reorganization", of Title 11 - Bankruptcy - of the United States Code did not interrupt proceedings before the EPO within the meaning of R. 90(1)(b) EPC.

3.7 Consequences of interruption of proceedings (Rule 90(4) EPC)

R. 90(4) EPC, first sentence, states that the time limits in force as regards the applicant for or proprietor of the patent at the time of interruption of the proceedings shall begin again as from the day on which the proceedings are resumed. R. 90(4) EPC includes two exceptions in this respect, namely the time limits for making a request for examination and for paying renewal fees. R. 90(4) EPC does not however constitute an exception to the general principle that all time limits are interrupted. Its sole purpose is to specify how time limits are to be calculated when proceedings resume (**J 7/83**, OJ 1984, 211).

In **J 7/83** (OJ 1984, 211) the board held that in the event of proceedings for grant of a European patent being interrupted because the applicant company has gone into receivership (R. 90(1)(b) EPC), the period prescribed by Art. 94(2) EPC for payment of the **examination fee** is suspended as from the date on which payments were discontinued by court order up to the date on which proceedings for grant are resumed (R. 90(2) EPC). The period then resumes for the part remaining to elapse, or for at least the two months prescribed by R. 90(4) EPC, second sentence. In **J 1/87** (OJ 1988, 323) the board stated that such an interpretation could not be applied to **renewal fees** for which the EPC did not prescribe a time limit for payment but simply dates on which they fell due. The only time limit affecting renewal fees that might be suspended was the six-month period for paying the

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

4. Interruption in the delivery of mail

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

In **J 4/87** (OJ 1988, 172) the board reaffirmed that in the event of an unforeseeable postal delay causing non-compliance with a time limit, the EPO had no discretion to extend the time limit other than in the cases referred to in R. 85(2) EPC.

In **J 11/88** (OJ 1989, 433) the board interpreted R. 85(2) EPC as being so drafted that if a general interruption or subsequent dislocation in the delivery of mail within the meaning of the rule occurred, any time limit under the EPC which expired within the period of interruption or dislocation was extended by operation of law. Accordingly, if the President of the EPO did not issue a statement as to the duration of that period, because he did not have the relevant information at the right time, this could not affect the rights of a person adversely affected by the interruption or dislocation. The board furthermore stated that whether or not an interruption in the delivery of mail or subsequent dislocation qualified as a "general interruption" was a question of fact, which had to be decided in the light of any credible information available; in case of doubt, the EPO should make official enquiries of its own motion in application of Art. 114(1) EPC.

Following **J 4/87** and **J 11/88** the Legal Board of Appeal stressed in **J 3/90** (OJ 1991, 550), that R. 85(2) EPC was not restricted to **nationwide** interruptions. In this case the board had to consider whether or not a disruption of mail had affected those residing in an area in such a way as to render it of "general character" and decided that the limited geographical extent of the disruption did not disqualify the interruption from being general. Whether or not a representative had undertaken all possible measures to avoid the effects of a postal strike was not a relevant test under R. 85(2) EPC.

In **J 1/93** the Legal Board of Appeal again stated that for an interruption in the delivery of mail under R. 85(2) EPC to be considered general in character the public in general residing in an area of some magnitude, even if of limited geographical extent, had to be affected. The loss of a single mailbag might affect a number of individual addressees but not the public in general.

E. Re-establishment of rights

1. Applicability of re-establishment of rights under Article 122(1) EPC

1.1 The meaning of "time limit"

For re-establishment of rights to be possible, there must be a failure to meet a time limit vis-à-vis the EPO, ie a time limit given specifically to the applicant pursuant to the EPC or by an officer of the EPO within which he must accomplish a certain act.

In **J 3/83** the board explained that the concept of a time limit within Art. 122 EPC involved a period of time of a certain duration. In the case of designation of states, there was no such period. States had to be designated at a particular time, see Art. 79(1) EPC.

In **J 7/90** (OJ 1993, 133) the board found that the "time limitation" condition imposed under board of appeal case law, which required that, in general, a request for correction of the designation of a state or priority data had to be refused in the public interest if it was not made early enough to enable publication of a warning together with the European patent application, was not a "time limit" within the meaning of Art. 122(1) EPC.

In **J 21/96** the board held that the time restriction for filing a divisional application (R. 25(1) EPC) is not a time limit within the meaning of Art. 122(1) EPC. It merely identifies a point in the grant procedure after which a divisional application may no longer be filed. This point is decided upon by the applicant when he gives his approval pursuant to R. 51(4) EPC. Therefore, in the absence of a time limit to be observed, re-establishment of rights is not possible.

1.2 Loss of rights as a direct consequence by virtue of the EPC

Under Art. 122(1) EPC rights cannot be re-established unless they have previously been lost as a direct consequence of the non-observance of a time limit vis-à-vis the EPO.

In **J 1/80** (OJ 1980, 289) certified copies of priority documents had not been filed within the 16-month period provided for in R. 38(3) EPC. The Legal Board of Appeal found that, according to the EPC, there was a deficiency only if the priority documents had not been filed by the end of the period. It could only be said that there was a deficiency thereafter and the applicant should have been given an opportunity to remedy that deficiency within a further period. The board recognised that there could only be a loss of rights if the applicant did not then take advantage of this opportunity.

In **J 7/93** (see chapter PCT, p. 587) the EPO did not tell the appellant to ignore its previous communications issued in connection with a time limit supposed to be missed; this would have enabled the appellant to recognise that its request for re-establishment was unnecessary. Instead, the EPO continued the proceedings for re-establishment of rights and finally refused restitutio without taking into account the fact that these proceedings had been unnecessary from the very beginning. The board found that this amounted to a substantial procedural violation within the meaning of R. 67 EPC. The board held that it was equitable

to order reimbursement of the appeal fee, even though the appellant had not applied for this (**J 7/82**, OJ 1982, 391). The board held that since there was no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, had to be refunded to the appellant (see confirming **J 1/80**, **T 522/88**).

1.3 Omission of acts by applicant

Under Art. 122(1) EPC re-establishment of rights may be granted to both the applicant and the proprietor of a European patent.

In **G 1/86** (OJ 1987, 447) the Enlarged Board of Appeal admitted an exception to this principle in the following case: an **opponent as appellant** may have his rights re-established under Art. 122 EPC if he has failed to observe the time limit for filing the **statement of grounds of appeal**. The board first of all observed that in drafting Art. 122 EPC, the authors of the EPC intended only to exclude certain cases and time limits from restitutio in integrum, and not to restrict that facility solely to applicants and patent proprietors. The wording of Art. 122(1) EPC, the historical documentation relating to the EPC and a comparison of the national laws of member states suggested that opponents may not have their rights re-established in respect of the time limit for appeal. However, this did not answer the question raised with regard to the time limit within which the opponent has to file the statement of grounds for appeal because, when its authors decided to exclude opponents from restitutio in integrum, the draft EPC made no provision for a separate time limit for filing the statement of grounds of appeal, and consequently they did not rule on the matter.

The Enlarged Board considered that the reasons justifying the exclusion of opponents from re-establishment of rights in respect of the time limit for appeal - in particular the patent proprietor's interest in no longer being left uncertain as to whether an appeal had been lodged once this time limit had expired - could not be extended to the time limit for filing the statement of grounds of appeal, because this uncertainty no longer existed. Once the appeal had been filed, the legal process had begun and the patent proprietor had to comply with the procedural requirements like all the other parties and wait until the board of appeal arrived at a final decision on the appeal's admissibility.

On this basis the Enlarged Board applied the general legal principle recognised in the contracting states of the EPC that all parties to proceedings before a court must be accorded the same procedural rights, as a principle deriving from the general principle of equality before the law. Under this principle an opponent must not be treated differently from the patent proprietor as that would result in unjustifiable discrimination against him.

In **T 210/89** (OJ 1991, 433) the board ruled that an opponent/appellant was not entitled to have his rights re-established when he missed the two-month time limit for **filing an appeal** (Art. 108 EPC, first sentence). An opponent (appellant) seeking to have his rights re-established under Art. 122(1) EPC could not rely on the principle of "equality before the law" (applying Art. 125 EPC) where the appeal did not exist for procedural reasons (distinguishing **G 1/86**). The applicant or proprietor, having failed to set in motion his appeal, would find himself at the end of the legal road; by contrast, an opponent could, if he wished, seek revocation in the national courts into whose jurisdiction the European patent would have

passed (see also **T 323/87**, OJ 1989, 343, and **T 128/87**, OJ 1989, 406).

Referring to **G 1/86** the board stated in **T 702/89** (OJ 1994, 472) that a request for re-establishment of rights by an opponent who had failed to observe the nine-month time limit under Art. 99(1) EPC for filing the **notice of opposition** and paying the appropriate fee had to be rejected as inadmissible. In **G 1/86** the Enlarged Board of Appeal held that in appeal proceedings the legal process started when the appeal had been filed and the appropriate fee had been paid. For the same reasons, the board in **T 748/93** maintained that, in accordance with Art. 99(1) EPC, the legal process in opposition proceedings began when the notice of opposition was filed and the appropriate fee was paid.

In **J 3/80** (OJ 1980, 92) the board made it clear that if the **national industrial property office** concerned **failed to forward** a European patent application filed with that national office **to the EPO in time**, with the result that the application was deemed to be withdrawn (Art. 77(5) EPC), the applicant could not claim restitution of rights, since the EPC provided only for restitution of rights where there had been a failure to observe a time limit which it was for the applicant to observe.

2. Admissibility of applications for re-establishment of rights

2.1 Department competent to decide upon the application

The department competent to decide on the omitted act shall decide upon the application (Art. 122(4) EPC).

In **J 22/86** (OJ 1987, 280) the board stated in relation to the failure to pay grant and printing fees and to file translations that the examining division was in the first instance competent to decide upon such omitted act. However, in view of the special circumstances of this case, the board decided, pursuant to Art. 111(1) EPC, to exercise the power of the examining division to decide upon the application for restitutio (see also **J 9/86**).

In **T 26/88** (OJ 1991, 30) the appellant failed to comply with the request (pursuant to R. 58(5) EPC) to pay the printing fee and to file translations of the claims within three months of notification of the request. The patentee submitted the request that the board of appeal should examine and decide upon the application under Art. 122 EPC. The board found that the circumstances of decision **J 22/86** were quite different from the case at issue and justified its exercising exceptionally the power of the examining division to decide on the application for re-establishment (see **T 522/88**).

In **J 10/93** (OJ 1997, 91) the board noted that, according to Art. 20(1) EPC, the Legal Division was competent to decide on the appellants' request for recording the transfer of a patent application. However, the Legal Division not only decided on this request but also dealt with the appellants' application for re-establishment of rights which it rejected as inadmissible. In the case at issue, the omitted act was the applicants' failure to reply to a communication of the examining division issued pursuant to Art. 96(2) EPC. Consequently, the department competent to decide on the application for restitutio was the examining division (Art. 122(4) EPC). The board found that the Legal Division exceeded its powers. It stated that this could

not be justified by any need to decide on the request for restitutio as a preliminary issue to be answered before examining the request for registering the transfer. The board set aside the decision of the Legal Division on this ground alone and ordered that the request for restitutio be remitted to the examining division for examination.

In **J 23/96** the applicant applied for a decision under R. 69(2) EPC and, as an auxiliary request, asked for re-establishment of rights. The examining division issued a brief communication saying that the request for re-establishment would be decided once the decision under R. 69(2) EPC was final, or during any ensuing appeal. The board noted that auxiliary requests were filed in case the main request was refused; they then took its place and had to be dealt with in the same decision. The course taken by the examining division was at odds with procedural economy, and might also oblige the applicant to appeal twice. This amounted to a substantial procedural violation which meant setting the contested decision aside and referring the matter back, without considering the merits, for the division to decide on the two requests together. The board could not decide on the request for re-establishment because it was not the "competent department" within the meaning of Art. 122(4) EPC. That was the examining division in this case.

T 473/91 (OJ 1993, 630) was concerned with jurisdiction over the request for re-establishment of rights in respect of the time limit for filing a notice of appeal. The board noted that the admissibility of an appeal under Art. 109 EPC (interlocutory revision) only fell under the jurisdiction of the department of first instance when this question could be decided immediately on the basis of the appeal submissions themselves (notice of appeal and statement of grounds, date of payment of the appeal fee). Consequently, the appellate instance had exclusive jurisdiction over a request for restitutio in respect of a time limit relating to the appeal itself (Art. 108 EPC) (see also **T 949/94**). The board stated that in the system for appellate review by a separate higher instance, as foreseen by the EPC in accordance with the principle of devolutive legal remedy, a final decision (as distinct from a decision that was no longer appealable as a result of the time for appeal having lapsed) by a lower instance effectively severed the case from that instance, in so far as the decision had settled all pending issues on their merits. As an exception to the principle of devolutive legal remedy, Art. 109 EPC provided for rectification by the department of first instance. Being an exception to the system of devolutive appeals, this provision had, however, to be construed narrowly. The board held that since the outcome of the admissibility issue was dependent on the outcome of the issue of restitutio in integrum, the request for restitutio had to be decided by the board of appeal.

In **T 624/96** the board ruled that because no written statement setting out the grounds of appeal had been filed within the time limit under Art. 108 EPC in conjunction with R. 78(3) EPC, the appeal should be rejected as inadmissible under R. 65(1) EPC unless the appellant's request for re-establishment of rights was granted. The appellant had filed such a request. Under Art. 122(4) EPC the board was competent to decide on this request, because the omitted act concerned an appeal.

In **W 3/93** (OJ 1994, 931) the board stated that as the board had to decide on the protest, it was also competent to examine the request for re-establishment of rights (Art. 122(4) EPC).

2.2. Time limits for filing an application for re-establishment under Article 122(2) EPC

2.2.1 Two-month time limit from the removal of the cause of non-compliance

The application for re-establishment of rights must be filed and the omitted act must be completed within two months of the date of the removal of the cause of non-compliance with the missed time limit. According to the case law of the boards of appeal, the removal of the cause of non-compliance occurs on the date on which the person responsible for the application (the patent applicant or his professional representative) is made aware of the fact that a time limit has not been observed (**J 27/88**, **T 191/82**, OJ 1985, 189; **T 287/84**, OJ 1985, 333; **J 27/90**, 1993, 422).

In **T 191/82** (OJ 1984, 415) the board held that in a case in which non-compliance with a time limit leading to a loss of rights under the EPC was discovered by an employee of a representative, the cause of non-compliance, ie failure to appreciate that the time limit had not been complied with, could not be considered to have been removed until the representative concerned had himself been made aware of the facts, since it had to be his responsibility to decide whether an application for re-establishment of rights should be made and, if it was to be made, to determine the grounds and supporting facts to be presented to the EPO (see also **J 7/82**, OJ 1982, 391, **J 9/86**, **T 381/93**).

In **J 27/88** the board held that the responsible person in the present case was neither the appellant nor the European representative but the US patent attorney who was the authorised agent of the appellant and was duly empowered to take all necessary measures. The date of removal of the cause of non-compliance was the date on which the US patent attorney became aware of the omission. In this decision the board stated that the effective date of removal of the cause of non-compliance was not necessarily the date on which the omission had been discovered but the date on which it ought to have been discovered if all due care had been observed (see also **T 315/90**).

As stated in **J 29/86** (OJ 1988, 84), in most cases the "cause of non-compliance with the time limit" involved some error in the carrying-out of the party's intention to comply with the time limit. The party did not then realise that the error had occurred, and that the time limit had not been complied with, until this fact had been brought to his attention, commonly by means of a communication from the EPO. In such cases, the cause of non-compliance with the time limit could not generally be removed until the communication was received. The cause of non-compliance with the time limit, and therefore its removal, was a matter of fact which had to be determined in the individual circumstances of each case. In the case of an error of facts the removal occurred on the date on which any person responsible for a patent application should have discovered the error made. This was not necessarily the date of receipt of the communication under R. 69(1) EPC (see **T 315/90**). If, however, such a communication had duly been served, it could, in the absence of circumstances to the contrary, be assumed that the removal was effected by this communication (**J 7/82**, OJ 1982, 391; **J 27/90**, OJ 1993, 422).

In **J 27/90** (OJ 1993, 422) the applicant, a US company, properly appointed a European professional representative as its agent by referring to a general authorisation (R. 101(2)

EPC). For the payment of renewal fees the appellant used a computerised service firm, a so-called "renewal fee payment agency". In a communication under R. 69(1) EPC received by the professional representative, the appellant was informed that the application was deemed to be withdrawn because the renewal fee and additional fee had not been paid in due time. The board held that in the absence of circumstances to the contrary a communication under R. 69(1) EPC to the professional representative removed the cause of non-compliance. This applied also when parties instructed the (European) professional representatives via their (national) patent attorney. The appointment of an independent service firm for the payment of renewal fees did not constitute such circumstances to the contrary.

In **T 840/94** (OJ 1996, 680) the board noted that according to the established case law of the boards of appeal, the removal of the cause of non-compliance occurred on the date on which the applicant or his representative should have discovered the error. The board also observed that the EPO had notified the European representative as prescribed in R. 81(1) EPC. If a party instructed the authorised representative not to pass on any further communication from the EPO, it could not then rely on the fact that information notified to the European representative and necessary for continuing the proceedings was lacking. The board therefore considered that the request for re-establishment was not filed within the time limit pursuant to Art. 122(2) EPC.

In **T 900/90** the board emphasised that in all cases in which the receipt of the notification under R. 69(1) EPC could be regarded as the removal of the cause of non-compliance it had to be clearly established that neither the representative nor the applicant was aware that the application had been deemed to be withdrawn before the receipt of that notification.

In **J 7/82** (OJ 1982, 391) the board held that the provisions of R. 78(2) EPC, last sentence, which deemed postal notifications to have been made when despatch had taken place, did not apply in a case in which the receipt of a notification under R. 69(1) EPC was relevant to the question of when the cause of non-compliance with a time limit had been removed, for the purposes of Art. 122 EPC. In such a case the significant date was the date of actual receipt by the applicant. Likewise, in **J 22/92** the communications under R. 69(1) EPC and R. 85a(1) EPC had been correctly made under the provisions of R. 78(2) EPC, the applicant having neither residence nor principal place of business within the territory of one of the contracting states. Notwithstanding that, the board held that the removal of the cause of non-compliance took place thereafter, through a telephone conversation between the newly appointed professional representative and the EPO. The board emphasised that the removal of the cause of non-compliance was a matter of fact and therefore had to be established beyond any reasonable doubt. This was not the case where under R. 78(2) EPC the notification was only deemed to have been made when despatch had taken place and when the receipt of the letter could not be proved. Thus, the board considered the date on which the responsible representative of the appellant first became aware of the missed time limit to be the date on which the removal of the cause of non-compliance with the time limit had occurred (see **T 191/82**, OJ 1995, 189).

In **T 428/98** (OJ 2001, 485) it was stated that where a communication from the Office notifies an applicant that he has missed a time limit, the cause of failure to complete the omitted act within the meaning of Art. 122(2) EPC, first sentence, is as a rule removed on the date when

the applicant actually receives the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under R. 78(3) EPC (in the version in force until 31 December 1998) has no effect on the date of removal of the cause of non-compliance, even if this works against the applicant because the actual date of receipt of the communication precedes the date calculated according to R. 78(3) EPC.

G 1/90 (OJ 1991, 275) concerned the particular case of the revocation of the patent by a decision in the event of failure to meet formal requirements where the patent was maintained as amended. The Enlarged Board of Appeal observed that a decision on an application for re-establishment of rights in the event of failure to observe the time limits under Art. 102(4) and (5) EPC was no more complicated than where other time limits were not observed. The board held that the patent proprietor could file an application for re-establishment of rights following the removal of the cause of non-compliance with the time limit even if the decision to revoke had not yet been delivered. Depending on the circumstances of the case, he might even be obliged to do so in order to comply with the time limit under Art. 122(2) EPC.

2.2.2 One-year time limit under Article 122(2) EPC

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

In **J 16/86** the board ruled that a request for re-establishment filed over a year after expiry of the non-observed time limit was inadmissible whatever the reasons for its late submission (see also **J 2/87** (OJ 1988, 330), **J 34/92**).

In **J 6/90** (OJ 1993, 714) the statement of grounds was not submitted until shortly after the end of the period of one year stipulated in Art. 122(2) EPC, third sentence, but within the period of two months specified in Art. 122(2) EPC, which in the present case expired later. The Legal Board of Appeal pointed out that the one-year period served to provide legal certainty. If this period had elapsed, any party could confidently assume that a patent application or patent which had been rendered invalid by the non-observance of a time limit would not be revived. However, if on inspecting the file a third party noted that an application for re-establishment had been made within the one-year time limit, he would have adequate notice. The board concluded, "To make a valid request for re-establishment of rights within the year immediately following the expiry of the unobserved time limit, it is sufficient if the files contain a clearly documented statement of intent from which any third party may infer that the applicant is endeavouring to maintain the patent application" (see also **T 270/91**, **T 493/95**).

2.3 Making good the omitted act

The omitted act must be performed within two months from removal of the cause of non-compliance (Art. 122(2) EPC, second sentence).

According to **T 167/97** (OJ 1999, 488), the requirement of Art. 122(2) EPC, second sentence, implies that the completed act likewise must meet the requirements of the EPC - ie in the present case that the statement of grounds of appeal is admissible for the purpose of Art. 108

EPC, last sentence. Where the statement of grounds filed with the request for re-establishment is insufficient for the appeal to be declared admissible, the request for re-establishment must itself be declared inadmissible.

2.4 Filing and substantiation of the application under Article 122(2) and (3) EPC

Under Art. 122(2) EPC an application for re-establishment of rights has to be filed in writing within two months of the removal of the cause of non-compliance with the time limit. Under Art. 122(3) EPC the application has to state the grounds on which it is based, and set out the facts on which it relies. According to the established case law of the boards of appeal, these provisions have consistently been interpreted as meaning that a statement of grounds, containing at least the core facts on which the application relied, had to be filed within the stated time limit. Further evidence to back up these allegations of fact could, if necessary, be presented after the expiry of the time limit.

In **T 13/82** (OJ 1983, 411) the board held that the application would be duly supported only if it was clear from the facts set out and substantiated that the applicant had taken all due care required by the circumstances to observe the time limit. The board held that a conclusive case must be made, setting out and substantiating the facts, for the probability - at least - that a wrongful act or omission on the part of an assistant was the cause of the failure to meet the time limit: the mere possibility was not sufficient to exculpate the applicant (**T 715/89**).

In **J 17/89** the board stressed that the two-month period laid down in Art. 122(2) EPC was clearly designed to enable the parties to carry out the necessary investigations and consultations, as well as to prepare the documentation for submission of a request under Art. 122 EPC.

In **T 287/84** (OJ 1985, 333) the board decided that an application for re-establishment of rights could be considered as complying with the requirement that it had to set out the facts on which it relied (Art. 122(3) EPC) if the initially filed application in writing, which did not contain such facts, could be read together with a further document, which contained them and was filed before the expiry of the period within which the application had to be filed.

In **J 5/94** it was decided that the grounds on which a request for re-establishment of rights was based could be amplified, provided this completed the submission that had been filed in due time and thus did not alter the basis on which the original request for re-establishment had been filed.

In **T 324/90** (OJ 1993, 33) the board held that evidence proving the facts set out in the application could be filed after expiry of the two-month time limit laid down in Art. 122(2) EPC. Only the grounds and a statement of the facts had to be filed within the two-month period. It was not necessary to indicate in an application for re-establishment the means (eg medical certificates, sworn statements and the like) by which the facts relied on would be proved. Such evidence could be submitted after the time limit, if so required (see also **T 667/92**).

In **J 8/95** the appellants argued that the German-language version of Art. 122(3) EPC did not stipulate that the statement of grounds for an application for re-establishment of rights had

to be filed within the time limit laid down in Art. 122(2) EPC. For this, no definite time limit had been prescribed. The appellants claimed that the case law in question was based entirely on the English and/or French versions of the EPC, and was not supported by the German version of Art. 122(3) EPC, first sentence. According to Art. 177(1) EPC, the three texts of the EPC were equally authentic. In the current case, the language of the proceedings was German; clearly, therefore, the decision had to be based on the German version, which was less strict. The board however decided that Art. 177(1) EPC assumed a uniform legislative intent, which could only be identified on the basis of all three texts of the EPC. This prevented an applicant from invoking the supposedly less strict wording of a provision of the EPC in the language of the proceedings (see also **T 324/90**, OJ 1993, 33).

In **J 26/95** (OJ 1999, 668) the applicant had missed two time limits which expired independently of one another and each resulted in the application being deemed withdrawn. The board held that in such an event a request for re-establishment had to be filed in respect of each unobserved time limit if the legal sanction of the application being deemed withdrawn was to be overcome. If this was done there were thus two requests for re-establishment which were legally independent of one another. It was irrelevant whether such requests were filed in the same letter or in different letters, and on the same or on different dates. Where two different time limits had been missed the loss of rights could only be overcome if the applicant showed, in respect of both time limits, that all requirements of Art. 122 EPC for the requests to be admissible and well-founded were met - including the payment of two fees under Art. 122(3) EPC, second sentence.

2.5 Correction of deficiencies in the application for re-establishment

In **T 14/89** (OJ 1990, 432) the board pointed out that the principle of good faith governing proceedings between the EPO and the parties involved required that the applicant have his attention drawn to deficiencies in his application for re-establishment of rights which were obviously easy to correct (in the case in point: fee not paid and substantiation not supplied) if correction of the deficiencies could be expected within the two-month time limit for restitutio under Art. 122(2) EPC. If this communication was not sent by the EPO within the two-month time limit, it had to be sent subsequently and a new time limit set. Acts, the deficiencies of which were corrected within this set time limit, were deemed to have been performed in due time within the meaning of Art. 122(2) EPC. This case law was confirmed by the Legal Board of Appeal in a similar case, **J 13/90** (OJ 1994, 456). The board pointed out, however, that this only applied to time limits which were not absolute (**J 34/92**).

In **J 41/92** (OJ 1995, 93) the board held that the users of the EPC could not, by merely asking the EPO to warn them of any deficiency that might arise in the course of the proceedings, shift their own responsibility for complying with the provisions of the EPC. If, however, a deficiency was readily identifiable by the EPO and could easily be corrected within the time limit, the principle of good faith required the EPO to issue a warning (following decisions **T 14/89**, OJ 1990, 432, and **J 13/90**, OJ 1994, 456). Whereas the EPO might be obliged, on the basis of the principle of good faith, to give information on a specific query, a party could not expect a warning in respect of any deficiency occurring in the course of the proceedings (see also **J 12/94**).

3. Time limits excluded from re-establishment under Article 122(5) EPC

3.1 General issues

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

Art. 122(5) EPC expressly excludes *restitutio in integrum* in the case of non-payment of the filing, search and designation fees within the time limits referred to in Art. 78(2) EPC and Art. 79(2) EPC and of the examination fee within the time limit referred to in Art. 94(2) EPC. This express exclusion formulated with regard to the non-payment of these fees within the normal time limit also applies in the event of their not being paid within the periods of grace provided for in R. 85a EPC and R. 85b EPC, for the obvious reason that to concede that *restitutio in integrum* applies to the non-observance of these grace periods would allow the unequivocal prohibition contained in Art. 122(5) EPC to be evaded (see **J 12/82**, OJ 1983, 221; **J 18/82**, OJ 1983, 441, and **J 11/86**). In **J 11/86** the board held that a European patent application for which no filing, search and designation fees had been paid in due time was deemed to be withdrawn (Art. 90(3) EPC, Art. 91(4) EPC). The non-payment of these fees was not a correctable deficiency under Art. 91(2) EPC, which the EPO had to give the applicant an opportunity to correct. Thus, the appellants could not derive any right from the non-issuance of a reminder by the EPO and *restitutio in integrum* was excluded by Art. 122(5) EPC whether or not such reminder had been sent.

In **J 8/94** (OJ 1997, 17), the board was asked to consider whether the exclusion from re-establishment under Art. 122(5) EPC also applied to the period of grace provided for in R. 85b EPC. For the old version of R. 85b EPC, which came into force on 4 June 1981, this question had already been answered in the affirmative by the Legal Board of Appeal (**J 12/82**, OJ 1983, 221). The board explained in **J 8/94** that, according to the new version of R. 85b EPC which had been in force, with minor amendments, since 1 April 1989 (see OJ 1989, 1 ff), the period of grace no longer immediately followed the time limit for filing the request for examination, but began to run only on notification of a communication from the EPO pointing out the failure to observe the time limit. This amendment was made because experience showed that, when a time limit was missed, the period of grace immediately following it could often not be observed either. The problem was the same for all periods of grace under R. 85a EPC and R. 85b EPC. The reasons for the new version of the two rules were therefore above all procedural. It was intended primarily to increase certainty for applicants with regard to the observance of periods of grace. It was not, however, intended that any change should be made with regard to the exclusion from re-establishment of periods of grace, as was clear from the preparatory documents. On this basis, the board concluded that the period of grace under the current version of R. 85b EPC was excluded from re-establishment in the same way as the normal time limit mentioned in Art. 122(5) EPC for filing the request for examination under Art. 94(2) EPC (confirmed by the decision in **J 25/94**).

In **J 12/92** the Legal Board of Appeal ruled that a request for re-establishment in respect of the time limit under Art. 121(2) EPC, second sentence, was possible (see **J 1/87**, OJ 1988, 323, **J 29/94**, OJ 1998, 147).

The provisions of Art. 122 EPC are not applicable to the time limits referred to in paragraph 2 of this Art. (T 900/90).

3.2 PCT time limits excluded under Article 122(5) EPC

In **J 16/90** (OJ 1992, 260) the appellant, who had failed to pay the filing fee, the search fee and the designation fees for his European patent application either within the time limit provided for in Art. 78(2) EPC and Art. 79(2) EPC or within the period of grace provided for in R. 85a EPC, applied for re-establishment of rights under Art. 122 EPC. In support of his application he cited Legal Board of Appeal case law, according to which Euro-PCT applicants who had not paid the appropriate fees had had their rights re-established (see **J 5/80**, OJ 1981, 343, and **J 12/87**, OJ 1989, 366). As a result direct European and Euro-PCT applicants were not being treated equally. This was one of the questions the Legal Board of Appeal referred to the Enlarged Board of Appeal.

In **G 3/91** (OJ 1993, 8) the Enlarged Board of Appeal held that, contrary to earlier rulings, Euro-PCT applicants were no more entitled to re-establishment of their rights, if they failed to observe the time limits for the payment of the national fee, designation fee or search fee, than were European applicants. The Enlarged Board noted that Art. 122(5) EPC does not expressly mention either R. 104b(1)(b) EPC (corresponds to existing R. 106 EPC) and (c) EPC (corresponds to existing R. 107(1)(e) EPC) or Art. 157(2)(b) EPC and Art. 158(2) EPC. However, under Art. 11(4) PCT, an international application fulfilling the requirements listed in items (i) to (iii) of paragraph (1) of that article "shall have the effect of a regular national application ...". An analogous provision was contained in Art. 150(3) EPC. Under such circumstances, any international application meeting the conditions laid down in the PCT and requesting a European patent was deemed to be a regular European patent application. The Enlarged Board of Appeal stated that the time limits to be observed by Euro-PCT and direct European applicants were in essence identical and that their equal treatment was therefore consistent with the law. Accordingly, both the time limits provided for in Art. 78(2) EPC and Art. 79(2) EPC and those provided for in R. 104b(1)(b) and (c) EPC (see above) in conjunction with Art. 157(2)(b) EPC and Art. 158(2) EPC were excluded from re-establishment under Art. 122 EPC.

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

In **G 5/92** and **G 6/92** (OJ 1994, 22 and 25) the Enlarged Board of Appeal considered whether re-establishment of rights should be granted in respect of the time limit for paying the examination fee under Art. 94(2) EPC. The Enlarged Board held that it followed from Art. 122(5) EPC read in conjunction with Art. 94(2) EPC that re-establishment could not be granted to an applicant who was prevented from meeting that deadline. The Enlarged Board referred to **G 3/91** (OJ 1993, 8), according to which Art. 122(5) EPC applied to a Euro-PCT as well as to a European applicant. The time limits under Art. 94(2) EPC were thus excluded from re-establishment of rights, no matter whether the applicant had chosen the "direct"

European or the Euro-PCT route.

In **G 5/93** the Enlarged Board added that a Euro-PCT applicant could be re-established in the time limit for paying the **claims fees** provided for in R. 104b(1)(b)(iii) EPC (corresponds to existing R. 110 EPC) because the direct European applicant was not excluded by Art. 122(5) EPC from re-establishment in the time limit to pay the corresponding fees provided for in R. 31.

Concerning the application of the new case law to proceedings which were still pending (see the referral by the Legal Board of Appeal in **J 4/93**), the Enlarged Board of Appeal stated in **G 5/93** (OJ 1994, 447) that Euro-PCT applicants could be re-established in the time limit for paying the national fee provided for in R. 104b EPC (now R. 106 EPC) in all cases where re-establishment of rights was applied for before decision **G 3/91** was made available to the public.

In **T 227/97** (OJ 1999, 495) the board noted that a time limit might only be specifically excluded by Art. 122(5) EPC. The board noted that there could be no presumption of any intention to exclude the time limit of R. 28(2) EPC from restitutio in integrum under Art. 122 EPC. The protection of the public was safeguarded by the provisions of Art. 122(6) EPC. The board made clear that the time limits in the rules of the Implementing Regulations were generally open to restitutio in integrum if failure to observe them lead to a loss of rights.

The board also held that under Art. 48(2)(a) PCT a Euro-PCT applicant who had not carried out a certain procedural act within the time limit prescribed in the PCT might take advantage of the relevant provisions of the EPC concerning re-establishment of rights (Art. 122 EPC) in all cases where the direct European applicant too might invoke them if he failed to observe the relevant time limit. The board came to the conclusion that the provisions of Art. 122 EPC were applicable to the time limit set by R. 28(2)(a) EPC and the equivalent time limit set by R. 13bis.4 PCT.

4. Article 48(2)(a) PCT

Art. 48(2)(a) PCT states that any contracting state shall, as far as that state is concerned, excuse, for reasons admitted under its national law, any delay in meeting any time limit. The application of provisions concerning restitutio in integrum is covered by Art. 48(2)(a) PCT, when the necessary conditions are fulfilled. Consequently, a Euro-PCT applicant who has not carried out a certain procedural act within the time limit prescribed in the PCT can take advantage of the relevant provisions of the EPC concerning re-establishment of rights in all cases where the direct European applicant too may invoke them if he fails to observe the relevant time limit (see **G 3/91**, OJ 1993, 8).

In **W 4/87** (OJ 1988, 425) the board decided that an application for restitutio in integrum could be submitted in cases where the statement of grounds supporting the protest under R. 40.2(c) PCT was submitted late, since Art. 122 EPC applies in conjunction with Art. 48(2) PCT.

In **W 3/93** (OJ 1994, 931) the request for re-establishment of rights was to enable the protest

to be deemed to have been filed within the time limit fixed by the ISA under Art. 17(3)(a) PCT and R. 40.1 PCT, and, in substance, for examination of the protest. The board held that by analogy with the principles developed by the Enlarged Board of Appeal in decision **G 5/83** (OJ 1985, 64, points 5 and 6 of the reasons) for interpreting the EPC, Art. 8(2) PCT should be construed to mean that in the event of a delay in meeting the time limit laid down in R. 40.3 PCT the same legal remedies were available as in the case of failure to observe other comparable time limits under the PCT or EPC (see also **W 4/87**). The board stated that when re-establishment of rights was granted, the legal situation was restored to that existing prior to the noting of the loss of rights which ensued from failure to observe the time limit. The board of appeal's decision based on failure to observe the time limit was thus rendered invalid, even though it was a final decision. In other words, the granting of re-establishment of rights destroyed the legal validity of the decision, which accordingly did not need to be set aside or amended. As a result, the protest was admissible and had to be examined on its merits.

5. Merit of applications for re-establishment of rights

Under Art. 122(1) EPC, for re-establishment to be allowed the requester must show that he missed the time limit despite taking all due care required by the circumstances.

5.1 Due care

In numerous decisions the boards have ruled on the "all due care required by the circumstances" issue. In considering it, the circumstances of each case must be looked at as a whole (**T 287/84**, OJ 1985, 333). The obligation to exercise due care must be considered in the light of the situation as it stood before the time limit expired. In other words, the steps the party took to comply with the time limit are to be assessed solely on the basis of the circumstances applying at that time (**T 667/92**, **T 381/93**).

In **T 30/90** the board held that the allowability of applications for re-establishment hinged on whether the conduct of the appellant and/or his representative, during the entire period after the relevant decision, was indicative of "all due care required by the circumstances". In this connection, "all due care" meant all appropriate care, ie as much as would be taken under the circumstances by the average reasonably competent patentee/representative.

In **J 23/87** the board ruled that exercising due care under Art. 122 EPC meant that an applicant, when deciding whether to pursue his application, could not rely entirely on information provided voluntarily by PCT authorities and the EPO at various stages of the procedure, and instead had to ensure that he was normally able to comply with the basic PCT and EPC time limits even if he received this information late or not at all.

The case law has established the criterion that due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system (**J 2/86**, **J 3/86**, OJ 1987, 362). In the latter case, the relevant party must show that the system normally works well (see eg **J 9/86**, **J 27/88**, **J 28/92**, **T 179/87**, **T 27/86**, **T 166/87**, **T 715/91**, **T 612/90**, **T 731/91**, **T 179/92**, **T 371/92** (OJ 1995, 324), **T 377/93**, **T 956/93**, **T 681/95**, **T 1062/96**, **T 186/97**).

If a party to proceedings requests re-establishment of rights on the basis that a document missed an EPO time limit because it did not arrive within the standard delivery time, that party will have to prove that the form of postage used would normally have ensured that the document would reach the EPO on time(**T 777/98**, OJ 2001, 500).

5.1.1 Exceptional circumstances

In **T 14/89** (OJ 1990, 432), due to **internal reorganisation and removals**, the R. 58(5) EPC communication was put into the wrong removal carton and consequently did not reach the responsible department of the patent proprietor. The board found that this fact, which led to non-observance of the time limit, constituted an isolated mistake such as could not be ruled out despite careful company organisation. The conditions for re-establishment of rights were therefore met.

In **T 469/93** the board found that even if all due care required by the circumstances were to be exercised, the occasional error during **complex transfers of company ownership** could not entirely be avoided. The error in this case being an exceptional one, the causes of which had since been removed, the appellant's request for re-establishment of rights was to be allowed.

In **J 13/90** (OJ 1994, 456) the applicant, a small firm employing about 15 people, was in **takeover** negotiations with another company. In the course of the negotiations a change of attorney took place. As a result of the unforeseeable breakdown in negotiations plus the fact that action had already been taken to replace the previous attorney, payment of the fourth-year renewal fee had been overlooked. This isolated mistake in a special situation was, in the board's opinion, excusable and the requested re-establishment of rights was therefore granted.

In **J 21/92** and **J 24/92** the applicant and his representative (both Americans) had each **changed their fee-monitoring system**, independently of each other. The situation was further complicated by the fact that the representative was no longer responsible for paying the appellant's renewal fees.

In **T 369/91** (OJ 1993, 561) the relevant circumstances involved **moving from a manual to a computerised time-limit monitoring system**. Here "due care" meant ensuring that during the changeover period the representatives handling the various kinds of cases were told which system - manual or computerised - had generated the reminder in question. Only then could they reliably know if and when a further reminder was likely.

5.1.2 A satisfactory system for monitoring time limits

a) General principles

An isolated mistake in a normally satisfactory system is excusable; the appellant or his representative must plausibly show that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (**J 2/86**, **J 3/86**, OJ 1987, 362) (see **J 23/92**). The fact that this system operated efficiently for many

years was evidence that it was normally satisfactory (see **J 31/90**, **J 32/90**, **T 309/88** and **T 30/90**).

In **T 130/83** the board stated that if a proper reminder system had been instituted by a representative, in order to guard against the consequences of oversight in a busy office, this was itself strong prima facie evidence of the taking of care by the representative (**T 869/90**, **T 715/91** and **T 111/92**, **T 428/98** (OJ 2001, 485)).

b) Small office

In **T 166/87** of 16.5.1988 the board held that the question whether a particular arrangement used in a particular office to ensure that procedural acts such as the payment of fees were completed in due time satisfied the requirement of "all due care" in Art. 122 EPC had to depend on the individual circumstances of each case (**J 9/86**). In the board's view, what had to be considered was whether the system during normal operation was reasonable and normally satisfactory, and therefore such as to establish that the applicant had used "all due care required by the circumstances" in his efforts to observe the time limit in question. The board held that in a relatively small office, normally working in an efficient and personal manner, employing normally reliable personnel, a cross-check mechanism, especially in relation to one-off payments such as an appeal fee, could fairly be regarded as superfluous (see **T 223/88**).

In **J 31/90** the board took the view that this system, while far from perfect, could be considered in the special circumstances of the case to be normally satisfactory. The board emphasised, however, that the system could only be so considered because of the particular conditions in which the representative and her secretary worked. Over a period of ten years, working together alone in a small office they had built up an excellent working relationship and mutual trust. The board was satisfied that the system had worked well over a considerable period of time. The fact that this system operated efficiently for many years was evidence that it was normally satisfactory (see **J 33/90**).

In **T 869/90** the board noted the absence of any kind of cross-check on the actions of the representative in question during the final ten days before the deadline. The representative himself appeared to have been in effect entirely responsible, during this final ten-day period, for meeting the time limit for the statement of grounds as well as for drafting it. The board found that especially in the context of a time limit which was inextensible, the provision within an office system of a cross-check on the activities of the representative responsible for the substantive work, by an independent person whose duty it was to ensure that the document in question was despatched on time, was a reasonable precaution. The board stated that the absence of such a cross-check in circumstances similar to the present case might well lead to a finding of lack of due care in future cases. The board however recognised that until that case occurred, the possibility that such an error could be made by the representative or one of his partners probably seemed extremely remote. Thus the board accepted, with some degree of doubt, that the requirement of "all due care" had been satisfied.

In **T 73/89** the board rejected the application for re-establishment of rights because, in order to work properly, the normally satisfactory diary system required a qualified attorney to check

whether, in any particular case, an extension was necessary or possible; in this case no such check was made.

In **T 828/94** the board noted that a monitoring system used in a particular office to ensure that payment of fees would be completed in due time should contain an independent cross-check to prevent the misunderstanding between a representative and a technical assistant from assuming that a notice of appeal would be prepared and filed on time by the other person, for example, someone would be responsible for checking independently of the representative and the assistant. The board noted that where a misunderstanding was likely to arise as a result of the two being responsible for the same file, the assistant should have clear instructions on how to proceed.

c) Large firm

In **J 9/86** the board was of the opinion that in a large firm where a large number of dates had to be monitored at any given time, it was normally to be expected that at least one effective cross-check was built into the system (**T 223/88**, **J 26/92** and **T 828/94**).

In **T 686/97** the board recognised that the specific remit of the administrative section, in particular the limitation of its function to a strictly non-interpretative application of relevant rules and time-limits, was and remains the only practicable one, and therefore finds it to be normally satisfactory.

The board held however that the applicant for restoration, a corporate patent department, relied solely upon the ascertainment of and compliance with relevant time limits upon information contained in various EPO forms and/or notices published in the Official Journal. Thus, the reminder system contained a significant, if not overwhelming reactive component and correspondingly lacked reliance on internal legal analysis and resultant administrative measures.

The board also observed that reminder systems normally satisfactory to ensure compliance with other Rules of Procedure under the EPC could not be satisfactory in the context of appeals to the boards, whose function is to provide a final judicial review under the EPC. In the board's finding, the provision of a "redundant" or "failsafe systems" is an essential component of a normally satisfactory reminder system in corporate departments. The failure to provide administrative reminders to the responsible patent attorneys of the time limits applying to the filing of Statements of Grounds of Appeal was incompatible with the operation of a normally satisfactory system and therefore the exercise of all due care within the meaning of Art. 122(1) EPC.

5.2 An oversight or inability to observe a time limit

5.2.1 Tactical considerations

Art. 122(1) EPC requires that the party in question must have been unable to observe a time limit. In **T 413/91** of 25.6.1992 the board stated that the word "unable" implied an objective fact or obstacle preventing the required action, eg a wrong date inadvertently being entered

into a monitoring system. The appellants' reasons for not filing any statement of grounds were that they had expected an agreement with the proprietor, which however did not come about. The board stated that such a reason did not justify re-establishment of rights, pointing out that it was an extraordinary means of judicial remedy. It offered no choice to a party as a substitute for the proper action to be taken, nor did it imply any right to have the fatal effect of an intentional step cancelled, even if this step later on proved to have been a mistake. A party who had deliberately chosen not to file a statement of grounds for the appeal could not achieve an appellate review through the back door of a request for re-establishment. The board therefore refused the request for re-establishment of rights.

In **T 250/89** (OJ 1992, 355) the opponent had claimed that he could not have filed the statement of grounds in due time because he would have needed to refer to documents withheld by a third party. The board confirmed the line taken in earlier decisions (see **G 1/86**, OJ 1987, 477, and **T 287/84**, OJ 1985, 333). When determining whether all due care required by the circumstances had been taken, the word "all" was important and failure to observe a time limit had to be the result of an oversight, not a culpable error. The board rejected the application for re-establishment of rights on the ground that the opponent had had sufficient material at his disposal to be able to draw up the statement of grounds in due time in accordance with Art. 108 EPC, third sentence, and R. 64 EPC.

5.2.2 Financial difficulties

In **J 22/88** (OJ 1990, 244) the Legal Board of Appeal had to resolve the question as to whether Art. 122 EPC applied in cases of financial difficulties lasting a fairly long time. The board referred to the "travaux préparatoires" and came to the conclusion that financial difficulties experienced through no fault of one's own and leading to failure to observe time limits for the payment of fees could constitute grounds for granting re-establishment of rights. A prerequisite for granting the request was that the applicant should have tried with all due care to obtain financial support. The board also made it clear that for "all due care" to be proven, it had, of course, to be clear that the financial difficulties were genuine and were due to circumstances beyond the reasonable control of the applicant (see **J 31/89**, **T 822/93**). In **J 9/89** the board noted that there was no evidence before the board of any effort having been made by or on behalf of the appellant to find financial support during the critical period.

In **J 11/98** the fifth renewal fee for a PCT application was not paid in time and the examining division issued a communication under R. 69(1) EPC noting that the application was deemed to be withdrawn under Art. 86(3) EPC. A newly appointed representative requested the EPO to recognise that proceedings were interrupted under R. 90(1)(a) or (b) EPC (see Chapter on interruption of proceedings page 291) and requested re-establishment in respect of the time limit, on the grounds that at the relevant times in 1996 the appellant/applicant had been seeking protection under Chapter 11 of US bankruptcy law.

The board confirmed the examining division's decision refusing the application for re-establishment. The applicant had not shown that at the relevant time it had been so lacking in funds as to be absolutely unable to make the payment. Only the latter situation had been accepted by the board, in an exceptional case, as a ground for re-establishment. The applicant's submissions showed that non-payment of the fifth renewal fee was due not to an

absolute inability to pay but to its business priorities at the time. That could not justify re-establishment.

5.3 Persons required to exercise due care

Primarily it is up to the applicant/patent proprietor to show due care. If third parties act for him he has to accept their actions on his behalf. The "due-care" obligation is assessed differently, depending on whether an applicant, his representative or an assistant is involved.

5.3.1 Due care on the part of the applicant

a) General principles

In **J 3/93** the board ruled that the duty to exercise all due care stipulated by Art. 122 EPC applied first and foremost to the applicant and then, by virtue of the delegation implicit in his appointment, to the professional representative authorised to represent the applicant before the EPO. The fact that the representative had acted correctly did not exempt his client from suffering the consequences of his own mistakes, or even negligence.

In **T 381/93** the board of appeal observed that the applicant was entitled to rely on his duly authorised professional representative to deal with the EPO. However, the board held that to the extent that he was on notice that a time limit had not been met and/or that instructions were required in order to meet it, an applicant had a duty to take all due care in the circumstances to meet the time limit.

In **J 22/92** the board held that the applicant, who had appointed US attorneys for the purpose of the PCT application, was entitled to believe that a copy of a communication had been sent to the US attorneys as well. The board referred to the principle of proportionality and stated that the loss of the patent application as a result of what may be considered at most a minor procedural irregularity would otherwise appear an extremely severe result. The board held that, in the case in point, the due care to be considered was in fact not that which was expected from a professional representative but that which was expected from an applicant unaware of the proceedings.

In **J 5/94** the board made allowance for the fact that the appellant was an individual applicant who had not appointed a representative and who was neither familiar with the requirements of the EPC nor in possession of an established office organisation attuned to ensuring that procedural deadlines were met. The board pointed out that in such a case the same standards of care as those required of a professional representative or the patent department of a large firm could not be applied.

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

b) Using an non-authorised representative

In **J 23/87** the applicant failed to furnish a translation of an international application within the time limit prescribed by Art. 22(1) PCT in conjunction with Art. 158(2) EPC. The appellant, a small Japanese firm with limited financial resources, submitted that a Japanese patent attorney without special knowledge of PCT matters had been consulted, and that this attorney incorrectly informed the appellant that "filing in designated countries could be made within twenty months from the PCT filing date" (instead of, correctly, the priority date) and that, due to this mistake in combination with the lack of official information, the appellant was unaware of the need to take action before the EPO at the relevant time. The board held that for an applicant who lacked the necessary knowledge of the PCT and the EPC procedures, it was obviously necessary to consult a competent professional representative in order to cope with the procedures involved in such a patent application. Thus, the board was not satisfied that the appellant, being completely ignorant about the special procedure to be observed in this case, had chosen a sufficiently competent professional representative and let him properly advise the appellant on the matters involved having had an opportunity to study the details concerning the present application. The board added that a mistake of this kind on the part of a professional representative, even properly consulted, could hardly be accepted as a ground for granting *restitutio in integrum*.

5.3.2 Due care on the part of the professional representative

a) General issues

In **T 112/89** the board stated that, regarding the due care required by Art. 122(1) EPC, the obligations of the applicant and those of his representative were clearly distinct and that the due care to be exercised by the representative might depend on the relationship which existed between him and his client. The board noted that it was clear that both the representative and the applicant had to exercise all due care in order to observe all the time limits during patent granting procedures. In the case at issue, the board was not convinced that the duty of the representative was fully discharged when he had notified his client that a time limit was to be observed and was satisfied that the client had received the notification. On the contrary, the board was of the opinion that when a representative had been instructed to lodge an appeal and did not receive in due time from his client the necessary additional instructions he needed to discharge his duty, he should take all necessary measures to try to obtain from his client these instructions.

In **J 16/93** the board stated that by virtue of the contractual relationship between the applicant for a European patent and the professional representative, to which the express authorisation on file with the patent application bore witness, the professional representative was responsible for complying with all the obligations incumbent on its client under the EPC. Furthermore, under the ordinary law applicable to representation, the client was not to do anything which might interfere with the proper execution of the representatives' brief, but - on the contrary - provide him from the start with the means enabling him to perform it. Moreover, it was a corollary of the fact that the EPC gave professional representatives and legal practitioners a monopoly of representation, as well as making representation compulsory for applicants for European patents having neither their residence nor principal place of business within the territory of one of the contracting states, that professional representatives were intended to act according to the instructions and on behalf of their client. The absence of any

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fault on the part of the representative in the execution of his duties as the applicant's agent did not exonerate the applicant if the latter's own lack of care meant that the representative was unable to act in a useful way.

It was also stated that a representative who had not received any funds for the purpose of paying the renewal fee and whose authorisation was silent in this respect was not expected to advance monies on behalf of his client out of his own pocket. As the client was, in this situation, free to abandon its application by ceasing to pay the fees demanded by the EPC, the representative risked effecting a payment which he would not be able to recover either from the EPO (even though his client had not wished the payment to be made), or from the client, if the authorisation was silent in this respect.

In **T 338/98** the appellant was first represented by professional representative A, but later asked him to transfer all files to a new representative B. One European patent application failed to be transmitted. Although the representatives were aware that the renewal fee was due for this application, they did not reach clear agreement about paying it, with the result that the fee was not paid and the application was deemed to be withdrawn. The applicant was not informed of the problem. Representative A was still registered as official representative for the case before the EPO, and representative B clearly knew of the appellant's decision to entrust the case to him for the future.

The board held that in these circumstances it did not appear appropriate formally to delimit the individual responsibilities of each of the representatives during a transfer of cases requiring, by its very nature, close co-operation between the persons involved and naturally leading to overlapping responsibilities. The fact that in these circumstances the representatives had been unable to reach agreement about the way to proceed and that the appellant had not been informed of the outstanding renewal fee and of the disappearance of the file in question was not an indication that all due care required by the circumstances had been taken at that moment.

Since at several stages in the transfer of responsibility for the appellant's patent portfolio the persons involved did not act with all due care required by the circumstances, the board did not allow re-establishment of rights.

In **J 16/92** the board made it clear that anyone getting himself into a situation where he could not be sure of being able to complete the omitted act ran the risk of his request for further processing being ruled inadmissible for failure to complete the omitted act in good time. In this case the representative had not started working on the file until four days before expiry of the time limit for further processing and hence had discovered too late that he was unable to find the first communication to which he was to respond.

b) Ignorance or erroneous interpretation of a provision of the EPC

In **J 3/88** the board noted that account should be taken of the fact that under Art. 134(1) EPC the contracting states had in principle confined representation of applicants before the EPO to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. The board stated that it followed that a representative could not

relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally, such as, for example, the interpretation of laws and treaties. If he delegated such tasks to an employee and if the latter made an error in the course of that work which resulted in the failure to observe a time limit, the representative could not claim that he had taken all due care required by the circumstances (see also **J 33/90**).

In **D 6/82** (OJ 1983, 337) the board decided that a mistake of law, particularly one regarding the provisions on notification and calculation of time limits, did not, as a general rule, constitute grounds for re-establishment of rights. The board further stated that neither ignorance of the provisions applicable nor a mistake as to the resulting legal position could justify re-establishment of rights. The obligation to take "all due care required by the circumstances" meant that persons engaged in proceedings before or involving the EPO had to acquaint themselves with the relevant procedural rules.

In **J 31/89** the Legal Board of Appeal confirmed that erroneous interpretation of the EPC on the part of the duly authorised representative with regard to the rules for calculating time limits (in the case in point, for the late payment of a renewal fee together with the additional fee) could not be excused. The appellant and the representative failed to determine correctly the last date for valid payment of the renewal fee (see **J 42/89**, **T 853/90**, **T 493/95**).

In **T 624/96** the board expressed doubts about the nature of the original mistake, which concerned calculation of the time limit for filing the statement of grounds of appeal. This was possibly a "mistake of law" caused by ignorance or misinterpretation of the provisions of the EPC, as in, eg, **J 31/89** or **T 853/90**. These decisions had held that if such a mistake resulted from failure to take all due care required by the circumstances the request for re-establishment should be refused as inadmissible. The board found that in the circumstances of the present case, however, the agent had not made a "mistake of law" of this kind. The agent cited an earlier appeal in which he had represented the same applicant, and after verifying this the board concluded that he therefore did indeed have some familiarity with the appeals procedure. He also submitted programmes of training courses, organised by IRPI (French institute for research into intellectual property) and the Paris chamber of commerce, at which he had given talks on European patents and EPO proceedings. This too indicated that the agent in question was regarded by users as reasonably familiar with such proceedings. The board therefore allowed the applicant's request for re-establishment.

In **J 28/92** the board held that the misinterpretation of a provision of the EPC by a representative was not without basis or unreasonable and considered that there was no basis for penalising the representative for having arrived at a not unreasonable interpretation of a rule of the EPC, which subsequently turned out to be wrong. The missed time limit was actually the result of the failure of the representative's secretary to carry out his instructions correctly. The representative of the applicant could show that he had a normally effective system for monitoring time limits and that he had duly instructed the reliable secretary. The board observed that the representative's interpretation of a legal provision of the EPC was not the result of, and did not lead to, a failure to exercise all due care required by the circumstances.

In **T 516/91** the mistake made by the representative was that he requested an extension of

two months for submitting the grounds of appeal. The board emphasised that the time limits set by Art. 108 EPC could not be extended. In mistakenly believing that an extension of these time limits was possible, the representative failed to exercise due care (see also **T 248/91** and **T 853/90**). In **T 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any legal error which might have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108 EPC.

In **T 460/95** the representative requested an extension of the time limit, although, in his professional capacity, he should have known that time limits under Art. 108 EPC could not be extended. The board noted that representatives were expected to be acquainted with the provisions of the EPC regarding time limits, and that the representatives in question had not been as vigilant as the situation demanded. In this specific case, however, the board found that the representative had taken the precaution of contacting the Registry of the Boards of Appeal beforehand, prior to his failure to observe the time limit, and had received information from that body which had led him to take action prejudicial to his interests. The board took the view that the appellants should not suffer injury merely because they had relied on information received from the EPO which later proved to be mistaken or likely to have been misunderstood. The board considered that the principle of trust constituted a further reason for acceding to the patent proprietor's request, and therefore, for acceding to the request for re-establishment of rights.

In **T 881/98**, the appellant's professional representative had written to the Registry of the boards of appeal requesting a two-month extension to a time limit, without giving reasons or indicating that the time limit in question was for submitting the statement of grounds of appeal. He added that if not notified to the contrary he would assume his request was allowed. Only after the time limit had expired did the appellant learn, following a telephone call between the representative and the Registry, that the time limit was not extendable and the appeal was therefore being dismissed as inadmissible. The communication to that effect was issued two days later. The appellant requested re-establishment of rights. He cited the principle of the protection of legitimate expectations: the Registry should have noticed the mistake and drawn attention to it in time.

The board refused the request for re-establishment. First, it confirmed the boards' case law whereby ignorance or misinterpretation of EPC provisions was no excuse for non-compliance with the time limit in question. Nor did it consider the Registry to have fallen short of legitimate expectations, as in this case (in contrast to **T 460/95**) the appellant had not been misled to his detriment by wrong information from the Registry but had himself made the mistake of thinking that the time limit could be extended. Nor, in the circumstances, was it easy for the Registry to realise the appellant's mistake, because the extension request was easily confusable with a routine one, especially since it was in a standard form.

In **T 733/98**, the examining division refused the European patent application in suit under R. 51(5) EPC, first sentence, because no approval was received, or any amendments proposed to the claims, description or drawings, within the period stipulated. The applicant filed a statement setting out the grounds of appeal which did not deal with the reasons given for the decision under appeal but dealt with formal and substantive issues in relation to new claims

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forming the appellant's main request and a first auxiliary request which had been filed together with the statement.

The board informed the appellants that the statement setting out the grounds of appeal did not comply with Art. 108 EPC, third sentence.

The appellants requested re-establishment in respect of the time limit for filing the statement of grounds, arguing that they had relied on Legal Advice No. 15/84 of the EPO, which had still been in force when they had received the communication under R. 51(4) EPC. The board held that the appellants had misinterpreted the Legal Advice in question, having failed to realise that the procedure for handling main and auxiliary requests which it described no longer applied once amended R. 51 EPC entered into force. The board decided that the requirement of all due care required by the circumstances within the meaning of Art. 122(1) EPC was not met in this case. The request for re-establishment was refused and the appeal rejected as inadmissible.

5.3.3 Due care on the part of a non-authorised representative

In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The board held that as regards the requirement of "all due care" within the meaning of Art. 122(1) EPC, the **US patent attorney** had to be regarded as the agent of the appellant. Thus, in order to comply with this requirement, it had to be established that the US patent attorney had taken the due care required of an applicant for or proprietor of a European patent by Art. 122(1) EPC.

In **J 25/96** the appellant was represented by a US attorney who had missed a time limit. The appellant requested re-establishment of rights. He submitted inter alia that a US attorney could not be subject to the same standards of care as an applicant or a European representative, since he could not be required to be as familiar with the European system.

The board held that where a US applicant availed himself of the services of a US patent attorney for matters which in relation to the EPO fell within the applicant's responsibility, the US patent attorney had to be regarded as the agent of the applicant. Thus, to meet the "all due care" requirement, the US patent attorney had to show he had taken the due care required of an applicant.

5.3.4 Fee payments by service companies

In **J 27/90** (OJ 1993, 422) the applicant, a US company with their principal place of business in the United States, and acting as a principal, properly appointed the professional representative as their agent by referring to a general authorisation (see R. 101(2) EPC). For the payment of renewal fees the appellant used a computerised service firm, a so-called "renewal fee payment agency". The appellant was informed that the application was deemed to be withdrawn because the renewal fee and additional fee had not been paid in due time. In appeal proceedings the appellant contended that there were two lines of communication, one dealing with technical and procedural matters and the prosecution of the application, comprising the professional representative and the US patent attorney of the applicants, and

one which dealt with the payment of renewal fees, instructed by the applicants.

The Legal Board of Appeal noted that principally the person or persons entitled to a patent application were responsible for the patent application. However, in accordance with Art. 134 EPC the applicants could appoint a professional representative. Here the professional representative took responsibility for the patent application vis-à-vis the applicants on the basis of their (internal) agency agreement. He could be considered by the EPO to bear this responsibility on the basis of his authorisation and on the basis of his professional capacity as a professional representative appearing on the list maintained by the EPO (Art. 134(1) EPC) in that he was to be considered entitled to undertake procedural steps in the interests of the applicants. The board noted that the authorisation referred to "all proceedings established by the EPC concerning the European patent application or patent". The board pointed out that with the exception of the filing of the application itself, only one act could be performed by any person, namely the payment of fees (Art. 133(2) EPC and old version of Legal Advice No. 6/80, OJ 1980, 303) and this therefore constituted an exception to the principle laid down in Art. 133(2) EPC. However the above-mentioned Legal Advice of the EPO did not contain any element which could lead to the conclusion that this exception extended beyond the mere act of executing payments. A different conclusion could not be drawn either from Art. 7 RFees, which allowed the Office to contact those making payments only where the purpose of a payment was unknown. The board made it clear that no duty to communicate with such a person regarding the outcome of the application itself arose out of the said rule. The professional representative thus remained fully in charge regarding all other acts, such as the handling of the application in all respects, including the receipt on behalf of the appellants of any correspondence, communication and decision from the EPO (R. 81(1) EPC). Therefore there could be no question of two lines of communication between the applicants and the EPO. The board held that the professional representative remained responsible for the application notwithstanding the fact that the applicants used an independent service firm for the payment of renewal fees.

5.3.5 Due care in dealing with assistants

(a) Introduction

An important legal question is whether the mistake by the assistant may be imputed to the representative of a party, and hence to that party.

The case law concerning due care on the part of professional representatives' assistants was established in **J 5/80** (OJ 1981, 343). This key ruling by the Legal Board of Appeal lays down that a request for re-establishment of rights can be acceded to in the event of a culpable error on the part of the assistant, if the professional representative is able to show that he has chosen for the work a suitable person properly instructed in the tasks to be performed, and that he has himself exercised reasonable supervision over the work. Where an assistant has been entrusted with carrying out routine tasks such as typing, posting letters and noting time limits, the same strict standard of care is not expected as is demanded of the representative himself (**J 16/82** (OJ 1983, 262), **J 26/92**). Decision **J 5/80** also pointed out that, if other than routine tasks are delegated which normally would fall to the representative by virtue of his professional qualification, the representative would not be able to establish that he exercised

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all due care (see **J 33/90** (see also **T 191/82** (OJ 1985, 189), **T 105/85**, **T 110/85** (OJ 1987, 157), **T 11/87**, **T 176/91**, **T 715/91** and **T 43/96**).

(b) Selection, instruction and supervision

It is incumbent upon the representative to choose for the work a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over the work (**J 5/80**, **J 16/82**). These duties are incumbent upon him also with regard to substitutes for holidays, special leave and other emergency situations. New assistants must be supervised on a regular basis for a period of at least some months (see **J 3/88**, **T 715/91**).

The case law cited above applies equally to a patent attorney residing in the USA (or his assistants) if he acts in collaboration with the duly appointed professional representative. In **J 3/88** the US patent attorney of a "non-resident" applicant acted in collaboration with the duly appointed professional representative. The "docket clerks" (assistants of the US patent attorney) were entrusted with the performance of routine tasks such as noting time limits and checking due dates. The board stated that in order to be able to carry out these admittedly rather simple tasks properly, they needed nevertheless some basic knowledge. In particular, the "docket clerks" should be familiar with the meaning of the various existing time limits for the payment of renewal fees they had to handle as well as the legal consequences in case a particular prescribed time limit was not met. In addition, they had to be able to identify the critical dates of a patent application and to record them on an "index card". Finally, the "docket clerks" ought to be acquainted with the conditions and modalities of informing the US patent attorney in charge about the due dates to be observed. Above all, they should know how to proceed when a fees reminder sent by a professional representative was received by the office of the US patent attorney. The board concluded that, although no special qualifications were required, it was fairly impossible for a "docket clerk" to perform these routine tasks satisfactorily without having previously been given appropriate instruction and being supervised closely until he was familiar with the job.

A reasonable supervision of the activity of a newly engaged "docket clerk" implied that his work be periodically checked. In order to be effective and avoid culpable errors, these periodic checks should not be initiated mainly by the "docket clerk" on the occasion of his alerting the patent attorney in charge to a coming due date, but should rather be performed systematically irrespective of such alerts, at least during an initial training period of several months. These checks should be aimed at making sure that, especially in consideration of subsequently received fees reminders, the "index cards" were accurately updated.

In **T 191/82** (OJ 1985, 189) the non-payment in due time of an additional fee was found to be clearly attributable to an unfortunate concatenation of errors by nevertheless properly selected and experienced employees.

In **J 12/84** (OJ 1985, 108) the due care required in the circumstances was absent where the employees of some other firm were instructed to sign for registered mail addressed to the representative, as he was not able to supervise the work of such persons not employed by his firm.

VI.E.5. Merit of applications for re-establishment of rights

In **T 309/88** the board stated that even employees without formal training as patent attorney's assistants could perform the task of recording and monitoring time limits. This was routine work which did not require specialised knowledge and professional qualifications. However, the assistant had to be properly instructed in the tasks to be performed and a trained employee had to be on hand to give advice.

In **J 26/92** the board noted that according to the case law of the boards of appeal, routine tasks could be entrusted to an assistant provided that the necessary due care on the part of the representative had been exercised in dealing with the assistant. In this respect, it was incumbent upon the representative to choose for the performance of routine tasks a suitable person, properly instructed in the tasks to be performed, and to exercise reasonable supervision over their work.

In **T 949/94** the board stated that a representative was expected to exercise a reasonable supervision over the work delegated. This did not mean that he had to supervise the posting of every letter. Once he had signed a letter and ordered his secretary to post it, he was entitled to assume that it had been posted. In the light of that, the board was satisfied that the representative had exercised due care in dealing with his secretary (**J 31/90**).

In **T 1062/96** the board found that the posting of a letter prepared and signed by the representative was a typical routine task which the representative could entrust to an assistant. In the case in question the assistant was expressly instructed to send the letter by fax on the same day. In a properly organised office the representative could rely on the correct execution of such an instruction. The sending of the fax did not require any specialised knowledge or qualification. Therefore, the assistant, here a secretary, who had proven to be reliable in the daily work of the representative's office, could have been expected to do this job within her own responsibility. Since the order was to be carried out more or less immediately, a later check whether the fax had actually been despatched was not necessary.

In **J 25/96** (see 5.3.3 above) the statement of grounds for the request for re-establishment of rights explained *inter alia* that non-observance of the time limit had been caused by the assistant entrusted with monitoring time limits.

The board held that the jurisprudence whereby a representative could entrust suitably qualified and supervised personnel with monitoring time limits had been developed for routine tasks and normal cases. It did not mean that a representative could also entirely leave such staff to monitor cases which

- (i) were particularly urgent
- (ii) needed particular attention and further steps by the representative himself to ensure that the necessary acts were still performed in time
- (iii) could result in an irrevocable loss of rights if any error or delay occurred.

The following circumstances which applied in the present case made it all the more

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appropriate for the representative not to leave the case solely to a docketing system or an assistant but personally to check in time whether or not instructions had been received:

- the basic time limit for entry into the regional phase had already been missed because of a docketing error, entailing higher costs for entry into the regional phase and reducing the time span still available

- only ten days were left for timely entry into the regional phase

- the US representative was aware that due to the appellant's difficult financial situation and the fact that a board-level decision was required it would take the appellant some time to make the decision, so she knew that instructions were likely to be delayed

- in her letter to the appellant she had not set a deadline or explained to the appellant that instructions were needed by a certain date at the latest; she had only asked for instructions at the earliest possible date.

(c) Technically qualified assistant

In **T 715/91** the board held that the consequences of an error by a technically qualified assistant (an engineer training for the European qualifying examination) imputed to the representative would also have to be borne by the appellants. The task of writing, or at least supervising, the despatch of important submissions, such as grounds of appeal, would normally fall to the representative himself. Furthermore, given that the assistant had only recently been taken on, the representative could not be expected to have been able to ascertain in such a short time to what degree the assistant did know the rules and regulations of the EPC. In **T 828/94** the board found *inter alia* that the technical assistant in charge was not supervised well enough and had not been properly instructed.

(d) Substitutes replacing assistants

In **J 16/82** (OJ 1983, 262) the board stated that the conditions mentioned above also applied in the case of a substitute replacing an assistant who was on holiday, ill or otherwise absent. It was a commonly experienced fact of life that assistants did have to be temporarily replaced from time to time. Where a qualified assistant was absent, therefore, the applicant or representative had either to be able to call on a similarly qualified substitute or else himself to take over the work assigned to the assistant. The **same standard of care** had to be exercised as regards the choice, instruction and supervision of the substitute as of the assistant himself (**T 105/85**).

In **T 324/90** (OJ 1993, 33) the board held that in a large firm, where a considerable number of deadlines had to be monitored at any given time, it had normally to be expected that at least an effective system of staff substitution in the case of illness and for absences in general was in operation in order to ensure that official documents such as decisions by the EPO, which started periods within which procedural steps had to be carried out, were properly complied with. From the facts submitted in this case it had to be concluded that no appropriate precautions had been taken in the event of unexpected absences on the part of

staff responsible for monitoring time limits. In **J 41/92** (OJ 1995, 93) the Legal Board of Appeal found that, in the case of a **professional working alone** and having a much smaller number of time limits to comply with, less strict standards in this respect could be applied. However, the board went on to say that a careful and diligent professional representative had, in any case, to be expected to take into account that he or she might fall ill and be prevented for some time from taking care of time limits. Therefore, if a professional representative ran a one-person office, appropriate provisions needed to be made so that, in the case of an absence through illness, the observance of time limits could be ensured with the help of other persons. If there was no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose.

5.3.6 Due care in using private mail delivery services

Since the EPC was adopted, the use of private mail delivery services has increased greatly in frequency and significance. The necessary conditions for the use of private courier services relating to the obligation to exercise "all due care required by the circumstances" have been considered by the boards of appeal.

In decision **T 667/92** the board considered whether the appellant could be said to have taken all the due care required by the circumstances when allowing only two days for the delivery from the UK to Germany and whether, in these circumstances, the choice of using a special carrier for the delivery was in keeping with the due care requirement. The board pointed out that a party who missed a time limit had also to show due care in its choice of method of delivery and that the use of outside agents might be held against the applicant under Art. 122 EPC owing to a lack of proper safeguards. The board added that in parallel situations telefaxing should preferably be used. The board took into account the very extraordinary circumstances regarding the withholding of the item by the customs in Munich for 36 hours, an incident which could not reasonably be foreseen, and allowed the request.

In **T 381/93** the problem arose from the failure of the private courier service to deliver the package containing the corresponding documents to the EPO as instructed. In deciding on due care, the board referred to decision **T 667/92** (see above), in which it was stated that a party who had missed a time limit had also to show due care in its choice of method of delivery. The board held that once a reliable carrier had been chosen and commissioned for the delivery, a party was entitled to rely on them, provided that the party had given all the necessary and proper instructions to the carrier.

6. Rights of use under Article 122(6) EPC

In **J 5/79** (OJ 1980, 71) the board stated that according to Art. 122(6) EPC, third party rights of user arose only where the restoration related to an already published European patent application or a European patent; those whose commercial interests were at stake should be entitled to be sure that protection, the existence of which was public knowledge, and which had fallen into the public domain, no longer had effect. This principle was already to be found in Art. 156(6) EPC of the "Preliminary draft for a Convention on a European Patent Law", published in 1962, and was set out both in Art. 142(6) EPC of the "Second preliminary draft

of a Convention establishing a European System for the Grant of Patents", published in 1971, and in the provisions of the first Preliminary draft for the Implementing Regulations "Re Art. 142, No. 1, second paragraph". The board stated that the basis of this rule had never been questioned. In the case at issue, the restoration related to an application that was unpublished at the material time, so on that ground alone there could be no third party rights of user.

There was another requirement of Art. 122(6) EPC, before third party rights could arise, which was also lacking in the present case, namely that the restoration of rights should be made public. Publication concerning European patent applications and patents took place in the "European Patent Bulletin". According to Art. 129(a) EPC, this Bulletin was to contain entries made in the Register of European Patents as well as other particulars the publication of which was prescribed by the EPC. Particulars of the restoration of rights within the period in default in the present case constituted no such "other particulars". In accordance with Art. 127 EPC, second sentence, no entries could be made in the Register of Patents prior to publication of the European patent application. Even in the case of published applications, R. 92(1)(u) EPC, provided that the date of re-establishment of rights was to be entered only if loss of the application (R. 92(1)(n) EPC) or the revocation of the patent (R. 92(1)(r) EPC) had been entered in the Register. That was not so in the present case. The board held therefore that no rights of user could be claimed by a third party on the facts in this case that the appellant was not adversely affected by the decision under appeal.

7. Restitutio in integrum - Interruption of proceedings

In accordance with R. 90 EPC, which the EPO must apply of its own motion, the legal incapacity of an applicant or his representative has the effect of interrupting proceedings and, where appropriate, the one-year time limit referred to in Art. 122(2) EPC (**J ..J/87**, OJ 1988, 323).

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

In **J 9/90** the Legal Board of Appeal held that for R. 90(1)(b) EPC (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) EPC and R. 20(3) EPC, the applicant entered in the Register of European Patents and the insolvent person (here a limited company) had to be legally identical. However, the fact that the persons involved were not identical did not necessarily rule out re-establishment of rights under Art. 122 EPC. Someone who was only indirectly affected by an event, such as insolvency, could be "unable" within the meaning of Art. 122(1) EPC. In such a case however the persons so affected had to prove that they had exercised all the due care that could have been expected of them in the circumstances of such an insolvency.

8. Interrelation between Article 122 EPC and Rule 85(2) EPC

In **T 192/84** (OJ 1985, 39) it was held that if the President of the EPO extended time limits expiring during a period of general interruption in the delivery of mail in a contracting state (R. 85(2) EPC), a pending application for re-establishment of rights considered to have been lost during that period which had been filed by a representative having his place of business within that state had to be deemed to have been made without purpose ab initio even though the non-observance of the time limit was due to causes other than the interruption in the delivery of mail. Accordingly, it could be declared that no rights were lost and the fee for re-establishment of rights could be refunded.

9. Principle of proportionality

In **T 111/92** the statement of grounds of appeal had been filed two days late due to an error of calculation of the due date on the part of the representative. The board held that the mistake in calculating the ten-day period due to human error at a time when the person in question was under pressure was an isolated mistake in an otherwise satisfactory system. The board referred to the principle of proportionality and stated: "In accordance with general principles of law, as applied in the context of administrative law, a procedural means used to achieve a given end (eg a sanction following a procedural non-compliance) should be no more than that which is appropriate and necessary to achieve that end. Bearing the principle of proportionality in mind, the loss of the patent application because of the procedural irregularity which has occurred in the present case would be a severe result. Moreover, the interests of any third party misled in the sense of Art. 122(6) EPC by the fact that the statement of grounds of appeal was filed two days late would be protected by Art. 122(6) EPC". The board allowed the application for re-establishment (see also **T 869/90**, **T 635/94**, **T 804/95**, **T 27/98**, **J 22/92**).

In **J 44/92** and **J 48/92** the board noted that the principle of proportionality only applied in borderline cases, in support of other grounds already substantiating to a certain extent the allowance of the appeal. Usually it had been applied where a time limit had been missed by one or two days due to some miscalculation (see below). The board considered that the principle of proportionality did not assist the appellant as there had been a major system fault, which could not be excused by reliance on the principle of proportionality.

In decision **T 971/99** and **T 1070/97** the board stated that Art. 122(1) EPC does not leave any room for the application of the principle of proportionality so that the number of days by which a time limit had been missed is irrelevant for deciding whether all due care was applied or not. Only the character of the conduct before the time limit expires is decisive for the consideration of the due care issue, not the length of the ensuing delay.

F. Late submission

1. The meaning of "late"

1.1 Delaying the proceedings

To expedite the proceedings, parties are supposed to submit all facts, evidence and requests at the outset, or - if this is not possible - as soon as they can. Arguments and evidence should not be filed piecemeal. The boards stress that an opponent is required to submit all his objections during the opposition period, setting each out in full. In **T 117/86** (OJ 1989, 401) it was pointed out that facts and evidence in support of an opposition which were presented after the nine-month period had expired were out of time and late, and might or might not be admitted into the proceedings as a matter of discretion under Art. 114(2) EPC. Boards had to ensure that proceedings were conducted expeditiously, and other parties fairly treated (see **T 101/87**, **T 173/89**, **T 237/89**, **T 430/89**, **T 951/91**, OJ 1995, 202). In **T 339/92**, the board held that late submissions should be taken into account if this did not delay the proceedings.

In **T 645/90** the board refused to allow the late-filed evidence into the proceedings as it had only been submitted at the oral proceedings; the respondents had not had the opportunity to assess it or provide their own counter-experiments, and its relevance was not immediately apparent.

In **T 252/95**, in his grounds of appeal the appellant cited a public prior use which he had not put forward in the opposition proceedings.

The board admitted this new submission: in deciding whether it was late, it had to consider the entire technical contribution in the opposition proceedings and the reasons given in the contested decision for refusing the opposition. The appellant had convincingly explained why he had been unable to respond to the opposition division's decision by continuing to argue on the basis of the public prior use originally cited, and why this new one was required for a further-reaching discussion of the features.

In principle, Art. 99(1) EPC, second sentence, and R. 55(c) EPC did require the opponent to submit his arguments within the opposition period, and under Art. 114 EPC he had to do so at least as soon as possible. The submissions made during the opposition period established both the legal and factual framework within which the substantive examination of the opposition was in principle to be conducted (**G 9/91** and **G 10/91**, OJ 1993, 408, 414, Reasons 6). The purpose of this rule was to focus the proceedings, and thus enable any factors jeopardising the patent's validity to be examined and decided within a reasonable time. It should not therefore be applied, in individual cases, in a manner at odds with that purpose and which forced the opponent - unless he was prepared to risk non-admission of late submissions - to inundate the opposition division and patentee with a mass of material which might well prove quite superfluous to the decision to be taken. So precisely in cases of public prior use - where multiple individual acts of such use had supposedly occurred before the priority date - it could serve the interests not only of both parties but also of the instances conducting the proceedings if just a few of those acts were selected for detailed substantiation. This meant inter alia that a subsequent pleading could not be disallowed as

late-filed should it transpire that for unforeseeable reasons the party's original one could not succeed.

2. Consideration of late submissions

Under Art. 114(1) EPC, the EPO is obliged to examine the facts of its own motion, and in doing so, it is not restricted to the facts, evidence and arguments provided by the parties and the relief sought. According to Art. 114(2) EPC, however, the EPO may disregard facts or evidence which are not submitted in due time by the parties concerned. The apparent contradiction between these two principles has generated a considerable body of case law. In **T 122/84** (OJ 1987, 177) the board summarised the historical development of the principle of ex officio examination with regard to late submission on the basis of the "travaux préparatoires" to the EPC.

For a long time, board of appeal practice was governed by the landmark decision **T 156/84** (OJ 1988, 372), according to which the principle of examination by the EPO of its own motion under Art. 114(1) EPC takes precedence over the possibility under Art. 114(2) EPC of disregarding facts or evidence not submitted in due time. Accordingly, the main criterion for deciding on the admissibility of late-filed documents and evidence was their **relevance**, ie their evidential weight in relation to other documents already in the case (see also **T 322/95**, **T 475/96**, **T 864/97**, **T 892/98**).

In some more recent decisions the relevance of late-filed documents was no longer viewed as being the only decisive criterion for admitting them. Other criteria, such as how late the documents were and whether their submission constituted a procedural abuse or whether admitting the late-filed documents could lead to an excessive delay in the proceedings, were also held to be decisive (see **T 534/89** (OJ 1994, 464), **T 17/91**, **T 951/91** (OJ 1995, 202)).

T 1002/92 (OJ. 95, 605) concerns the extent to which the principles set out by the Enlarged Board of Appeal in **G 9/91** and **G 10/91** (OJ 1993, 408, 420) with regard to the admissibility of fresh grounds of opposition (see Opposition procedure, p. 481) influence the admissibility of late-filed new "facts, evidence and arguments" in support of grounds of opposition already contained in the notice of opposition. The conclusion was as follows:

(a) In proceedings before the **opposition divisions**, late-filed facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55c EPC in support of the grounds of opposition on which the opposition is based should only **exceptionally** be admitted into the proceedings by the opposition division, if **prima facie**, there are clear reasons **to suspect** that such late-filed material would prejudice the maintenance of the European patent in suit. Such consideration of relevance as the principal factor follows from the administrative character of the opposition proceedings.

(b) In contrast to the first-instance procedure, the appeal procedure is a judicial procedure and therefore "less investigative". Therefore, as regards proceedings before the **boards of appeal**, new facts, evidence and related arguments which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55c EPC in

support of the grounds of opposition on which the opposition is based should only **very exceptionally** be admitted into the proceedings if such new material is **prima facie highly relevant** in the sense that it is highly likely to prejudice maintenance of the European patent. Also, other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause should be taken into account. In general the later that such new material is filed, the greater the degree of procedural complication that it is likely to cause (confirmed in **T 212/91**, **T 951/91** (OJ 1995, 202), **T 255/93**).

In recent years, the boards have looked for other ways to handle late submissions. For the existing case law - that the main criterion was the material's relevance - was found increasingly unsatisfactory (although confirmed in other decisions such as **T 68/98**, **T 864/97** and **T 892/98**).

Only rarely (**T 577/97**) did the boards persist with the approach whereby evidence is disregarded only exceptionally, irrespective of the procedural stage at which it is submitted (see **T 426/97**, **T 855/96**, Special edition of the Official Journal 2000 - Case Law, pages 55 and 56).

A new approach was tried in **T 633/97**. This was that the complexity of the examination necessitated by the late-filed material should also be a criterion for considering it. In this case new arguments, evidence and requests were submitted by the parties both before the expiry of the time limit set by the board in the summons to oral proceedings and in the course of the oral proceedings. Taking account of the fact that both the board and the parties must be considered to be technically and legally competent, the board held that a limitation of its discretion under Art. 114(2) EPC by applying fixed time limits to the submission of new evidence or requests is in general not appropriate. Nor does the application of a criterion based on the relevance of the "late-filed" material or the substantive allowability of "late-filed" requests seem to offer a convincing approach because this implies that the merits of such evidence or requests must indeed be duly assessed in advance.

Once oral proceedings have been arranged in appeal cases, the decision to admit new evidence or requests into the procedure should hinge neither on a fixed time limit for their submission nor on their merit. It should instead be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a reasonable time. New submissions should normally be disregarded if the **complexity of the technical or legal issues** raised is such that neither the board nor the other party can be clearly expected to deal with them without adjournment of the oral proceedings. Complex fresh subject matter filed at short notice before or during oral proceedings runs the risk of being not admitted to the proceedings without any consideration of its relevance or allowability.

3. Exercising discretion over admitting late submissions

In **T 705/90**, the board pointed out that any decision to disregard late-filed documents had to be accompanied by a statement of reasons. It was not enough simply to point out that the documents were late.

The boards have developed a substantial body of case law to be borne in mind when those reasons are given.

3.1 Examination as to relevance

3.1.1 Examination as to relevance - general principles

If the board conducts "examination as to relevance" when exercising its discretion under Art. 114(2) EPC, then the admission of a citation which has been filed late (ie could have been submitted earlier) depends on whether it is decisive (relevant) for the outcome of the case (see **T 258/84**, OJ 1987, 119). According to decision **T 156/84** (OJ 1988, 372) the principle of examination by the EPO of its own motion under Art. 114(1) EPC took precedence over the possibility of disregarding late-filed facts or evidence provided for in Art. 114(2) EPC. This was not only evident from the wording of both provisions; it also followed from the EPO's duty vis-à-vis the public not to grant or maintain patents which it was convinced were not legally valid. The EPO was therefore obliged to assess the citation's relevance by considering the facts. If, having regard to the facts of the case as a whole, the new submission had no material bearing on the decision, the board could, according to Art. 114(2) EPC, disregard the submission without having to give **detailed** reasons (see **T 71/86**, **T 11/88**).

In **T 326/87** (OJ 1992, 522) the board took the same line, on the grounds that Art. 114(2) EPC set a legal limit on the inquisitorial duties of the appeal boards and that these duties should not be interpreted as extending to carrying out a roving enquiry into facts alleged and evidence adduced at a late stage of the proceedings. (In the case in point, the opponent had submitted a new document with the statement of grounds of appeal.) The main criterion for deciding on the admissibility of a late-filed document was its relevance, ie its evidential weight in relation to other documents already in the case (see also **T 286/94**).

According to **T 273/84** (OJ 1986, 346) the discretionary power contained in Art. 114(2) EPC was clearly granted to ensure that proceedings ran smoothly and to forestall tactical abuse (see also, in this connection, **T 110/89** and **T 315/92**).

Regarding examination as to relevance, the board explained in **T 560/89** (OJ 1992, 725) that Art. 114(2) EPC allowed the EPO to disregard documents which contained no more information than the documents filed on time and did not disclose matter which could change the outcome of the decision. According to the decision in **T 611/90** (OJ 1993, 50), late-filed evidence, documents and other matter could be rejected by the boards of appeal on the ground of their irrelevance, ie on the basis that they were no more "weighty" or "cogent" than documents which were already in the case.

However, the late-filed evidence had to be admitted into the case and taken into account if

it was relevant - ie if it might cause the patent to be revoked or its scope to be limited (**T 164/89, T 1016/93**).

According to **T 97/90** (OJ 1993, 719) the wording of Art. 114(1) EPC did not mean that the boards of appeal had to conduct rehearings of the first-instance proceedings, with unfettered right, and indeed obligation, to look at all fresh matter regardless of how late it was submitted. Art. 114(2) EPC as well as Art. 111(1) EPC set a clear limit to the scope of any new matter that could be introduced into an appeal by the parties so that cases on appeal had to be, and remain, identical or closely similar to those on which first-instance decisions had been rendered. This case law was confirmed by the boards of appeal inter alia in **T 26/88** (OJ 1991, 30) (where it was stated that the essential function of the appeal procedure was to determine whether the decision issued by a first-instance department was correct on its merits), **T 326/87** (OJ 1992, 522), **T 229/90** and **T 611/90** (OJ 1993, 50).

In **T 201/92** the board pointed out that facts and evidence had to be submitted once they were available and once it had become clear that they were relevant, so that the board and the other parties could take the steps deemed necessary.

3.1.2 Examination as to relevance with regard to **G 9/91** and **G 10/91**

In the light of **G 9/91** and **G 10/91** (OJ 1993, 408, 420) and with reference to the case law mentioned under point 2 on limited ex officio examination in appeal proceedings, the examination as to relevance was looked at critically in a number of recent decisions. According to the new approach to this question, in the exercise of discretion under Art. 114(2) EPC, late-filed facts and evidence can be excluded on grounds of abuse of procedure and during appeal proceedings on grounds of restrictions on the principle of ex officio examination.

In **T 212/91** the board confirmed that cases decided by the boards of appeal should have the same, or substantially the same, legal and factual framework as the case on the basis of which the department of first instance's decision had been rendered.

In **T 85/93** (OJ 1998, 183), the board, citing **G 9/91**, **G 10/91** and **T 212/91**, confirmed that evidence of common general knowledge, like any other evidence in support of an opponent's case, should be filed at an early stage in the proceedings before the opposition division (following **G 4/95**, OJ 1996, 412), and may be rejected as inadmissible at the board's discretion if filed for the first time during appeal proceedings.

3.1.3 Examination as to relevance and abuse of procedure

In some cases the boards of appeal disregarded late-filed material on the grounds of abuse of procedure.

In **T 951/91** (OJ 1995, 202) the board refused to take account of late-filed evidence **even before it was actually submitted** and pointed out that the discretionary power given to the departments of the EPO pursuant to Art. 114(2) EPC served to ensure that proceedings could be concluded swiftly in the interests of the parties, the general public and the EPO, and to

VI.F.3. Exercising discretion over admitting late submissions

forestall tactical abuse. Parties had to take into account the possibility that late-filed material would be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party failed to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the boards of appeal were fully justified in refusing to admit it in exercise of the discretion provided by Art. 114(2) EPC. The board informed the parties in a communication that the submission of further fresh experimental data proposed to be filed by the appellant (opponent) at some unspecified later date, some 20 months after the statement of grounds of appeal had been filed and at a time when the decision was substantially completed, was regarded as an abuse of procedure.

In **T 496/89** the board pointed out that the late introduction of documents and of other matter into the appeal proceedings is inimical and contrary to the public interest, quite apart from being unfair to the other party. Attempts by either party to spring a surprise on the other by deliberate late-filing, as well as inadvertent omissions to present arguments and the evidence needed to support them, ran counter to the spirit and intent of the EPC (see also **T 430/89**).

In **T 741/91** the board stated that filing evidence only one day prior to the oral proceedings before the opposition division, thus not allowing the other party to consider and respond to it during the oral proceedings, was not acceptable conduct on the part of the submitting party. The opposition division should disregard such evidence by exercising the discretion conferred upon it under Art. 114(2) EPC.

In **T 375/91** the board could see no reason why the respondent (opponent) did not present its tests in due time, that is promptly in reply to the appellant's statement and certainly before oral proceedings were appointed, so leaving the patentee sufficient time to reply, if necessary by filing counter tests. To have waited with the presentation of the tests until only seven weeks before the oral proceedings jeopardised the whole object of such proceedings, which was to prepare a case for decision on conclusion of the oral proceedings, and denied the appellant the right to file a detailed counterstatement. This was contrary to fair and proper procedure.

In **T 1019/92** the board reached the conclusion that the fact that an opponent after the end of the opposition period subsequently submitted prior art material originating from itself did not constitute an abuse of the proceedings in the absence of evidence that this was done deliberately for tactical reasons (in contrast to the situations found to exist in decisions **T 534/89** and **T 17/91**). The board admitted the late-filed document into the proceedings. Also, in **T 315/92** the board of appeal did not consider that there had been a tactical abuse and took the late-filed documents into account under the principle of examination by the EPO of its own motion, since these might have put maintenance of the patent at risk (see also **T 110/89**).

Filing with the statement setting out the grounds of appeal, new documents reinforcing the line of attack already made before the first instance had to be considered as the normal behaviour of a losing party and did not constitute an abuse of procedure (**T 113/96**).

An abuse of procedure presupposes the deliberate withholding of information (see **T 534/89**).

In **T 901/95**, the board ruled that a personnel change causing the appellants to learn belatedly about projects in their own very large firm did not constitute such abuse.

3.1.4 Procedural abuse in the case of public prior use

Stricter standards have been set by the boards of appeal particularly in the case of the admissibility of late-filed evidence of public prior use by the opponent. On the basis of Art. 114(2) EPC, the boards did not include late-filed evidence in the proceedings because in the specific circumstances there had been an abuse of procedure and a breach of the principle of good faith. In such cases the boards chose to refrain from examining the **potential relevance** of the submission (see **T 17/91** and **T 534/89** (OJ 1994, 464), **T 211/90**).

In **T 17/91** an allegation of prior use based on the opponents' own activities had been filed two years after the expiry of the opposition period, with no good reason for the delay. This, in the board's view, constituted an abuse of the proceedings and a breach of the principle of good faith. Irrespective of its potential relevance, the allegation was therefore to be disregarded under Art. 114(2) EPC.

Taking a similar line, the board ruled in **T 534/89** (OJ 1994, 464) that an objection based on prior use by the opponents themselves which was raised only after the expiry of the opposition period (Art. 99(1) EPC), although the factual circumstances were known to the opponents and there was nothing to prevent the objection being raised during that period, constituted an abuse of procedure. From this, the board concluded that when abuse of procedure was manifest, in view of the fact that a party deliberately refrained from raising an issue even though the necessary supporting evidence was available, it would be contrary to the principle of good faith to admit such evidence by applying Art. 114(2) EPC in that party's favour.

Four weeks before the oral proceedings in **T 211/90** the appellant alleged public prior use for the first time. However, the evidence was already familiar to the appellant before expiry of the opposition period. The board held that the fact that the appellant was unaware of the relevance of this evidence, even though familiar with it at the time of filing the opposition, did not justify its introducing the evidence into the proceedings for the first time at such a late stage - irrespective of the reasons why it did not become aware of the potential relevance of this material until then. Neither the fact that the appellant had changed representatives during the appeal proceedings, nor the fact that it was the new representative who first recognised the relevance of this material could justify taking it into account. The board therefore decided not to consider this material in the further proceedings, without examining its potential relevance.

In **T 985/91** the board referred to **T 17/91**, and held that in cases such as that before it, where the late-filed material related to an alleged prior use by the party filing it, this material should only be admitted into the proceedings in exceptional circumstances. Therefore, the board disregarded the late-filed material relating to an alleged prior use because neither the reasons given for the filing of the material concerned more than four years after the end of the time limit for opposition and only one week before the date of the oral proceedings, nor the content of the material itself, were such as to persuade the board that it would be proper to allow its

introduction into the proceedings.

In **T 847/93** the board held that the conclusions arrived at in **T 17/91** could not be applied directly to the case in point because the prior use asserted in that case was not based on the opponent's own activities, but rather referred to an apparatus manufactured by a third company and delivered to the opponent. The board remitted the case to the department of first instance.

In **T 45/88** the late-filed prior use was disregarded in view of the length of time the proceedings had already lasted (five years since the notices of opposition had been filed) and the need to carry out an extremely thorough examination of facts dating back more than nine years. As in the case of **T 262/85**, which the board endorsed, the circumstances associated with the taking of evidence - namely course, duration and outcome - were so uncertain as to warrant discretion being exercised in a negative sense.

In **T 503/94** the prior use allegation was raised for the first time in the appeal proceedings only two weeks before the oral proceedings. The appellants had given no reason for making the allegation at this late stage. The board stated that it raised a case entirely different from that on which the decision under appeal was based. It would only admit this fresh case into the proceedings if it were prima facie highly relevant. The evidence supplied was, however, deficient and so the board refused to admit it into the proceedings.

In **T 628/90** an allegation of public prior use, which was filed for the first time in appeal proceedings and was adequately substantiated, was taken into account because of its possible relevance to enable thorough consideration to be given to the patentability of the subject-matter of the contested patent (see also **T 150/93**).

3.1.5 Examination as to relevance, and justified late submission

In some decisions, however, it was decided that the delay was less important if the party was reacting to a finding in the contested decision or to the opponent's submission.

In **T 101/87** the board drew a distinction between (a) the case of an opponent attempting to find further prior art when the opposition division had decided that the original citations did not warrant revoking or restricting the patent, and (b) the case of an opponent making a further search in response to substantial amendments of a claim or to comments from the opposition division regarding a missing link in a chain of argument. In the latter case, new documents could be admitted into the proceedings, instead of being regarded as late-filed.

In **T 49/85** the board stated that a reference filed by an opponent for the first time with its statement of grounds was not submitted in due time unless representing the effective counter evidence to a newly emphasised reason given in the decision (see also **T 172/85** and **T 561/89**). The same applied if the party reacted to its opponent's submission, eg in **T 705/90**, where documents I to N were cited by the appellant in its observations in support of an argument presented in response to the respondent's statement of grounds. Also, in **T 238/92** the board of appeal did not consider a document presented for the first time with the statement of grounds of appeal as "late-filed", since it served as the first evidence of a feature

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considered in the contested decision as essential for the assessment of inventive step (see also **T 117/92**).

Where documents were filed with the statement of grounds of appeal but the need for filing them arose from the reasoning given in the decision under appeal, and they were too relevant to be disregarded under Art. 114(2) EPC, the board admitted them into the proceedings (**T 223/95**).

In **T 430/89** the explanation for the late submission of arguments and of a document was that the representative took over the case only recently. The board held that this could not be accepted as a justification for tardiness.

In **T 785/96**, with a letter sent just one month before the oral proceedings before the board, the appellant filed additional experiments. The appellant stated that the reason for this late filing was a change of representative, after which the necessity of the experiments had appeared.

The board confirmed the decision **T 97/94** (OJ 1998, 467) and stated that the change of representative does not form an acceptable ground for late filing unless it is due to force majeure. The new representative is obliged to continue the proceedings from the point they had reached when he took over from his predecessor (see also **T 552/98**).

4. Late submission and the right to be heard

A number of decisions addressed the question of how the right to be heard is safeguarded if the EPO intends to take into account in the decision late-filed facts and evidence.

In a case where an opposition division or a board of appeal feels bound by Art. 114(1) EPC to examine new facts or evidence submitted for the first time during oral proceedings, it must, in accordance with Art. 113(1) EPC, give the other parties the opportunity to comment before issuing a reasoned decision based on such facts or evidence (**G 4/92** (OJ 1994, 149); see also **T 484/90** (OJ 1993, 448)).

In **T 330/88** the board held that the right to be heard had not been contravened by virtue of a relevant document being submitted late during oral proceedings. The representative was given sufficient time during the oral proceedings held on two consecutive days to consider this document, consisting of only seven pages including the claim page and two figure sheets. He could be expected to be able to react to this new situation either by rejecting the document as irrelevant or by filing amended claims.

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

In **T 356/94** the board added that any late-filed facts or evidence could be admitted in the opposition proceedings in so far as such facts or evidence were subsequently discussed by the parties concerned in accordance with Art. 113(1) EPC, which meant allowing the parties sufficient time, depending on the nature of the facts or evidence submitted, to provide explanations. Taking into consideration comparative tests presented on the same day as oral proceedings were held could constitute an infringement of the other party's right to be heard, since the latter had had no material opportunity to check them.

In **T 270/90** the board refused to consider late-filed experimental data, on the grounds that the principle of fairness had been breached. In point of fact, the data was irrelevant anyway, but this was only a secondary consideration.

This case law was confirmed by **T 939/90**, in which the board was of the opinion that the evidence submitted was rightly excluded by the opposition division to the extent that its lateness practically precluded the opponents from countering it by tests of their own. The board stated that for obvious reasons this no longer applied to the appeal proceedings and admitted the evidence into the proceedings.

Also in **T 685/91** the board confirmed that the opposition division had rightly decided not to consider the experiment report, which was submitted about one month prior to the oral proceedings before the opposition division, because such a short period was clearly insufficient to carry out counter-experiments. However, the report was admitted into the appeal proceedings since the same comparative data had been submitted together with the statement of grounds of appeal in support of the objection of lack of inventive step raised initially in the statement of grounds of opposition. The board considered that the technical report did not take the respondent by surprise since the latter had had ample time and opportunity to carry out its own experiments.

In **T 259/94** the appellants submitted new evidence - including documents reflecting common general knowledge and reports of tests - two years after filing the appeal. The respondent did not object to their introduction into the appeal proceedings. The board held that in such circumstances the principle of "volenti non fit iniura" empowered it to admit the late-filed evidence.

In **T 106/97** the prior-art citation did not literally disclose the high purity value claimed in the patent in suit, but had to be read by a skilled person who was aware of the handbook which the appellant/opponent had cited only shortly before the oral proceedings on the appeal. The respondent asked that the handbook be disallowed as late-filed. The board held that a highly relevant handbook which constituted general technical knowledge could not be thus disregarded.

5. Late-filed arguments

In **T 92/92** the board pointed out that Art. 114(2) EPC did not provide a legal basis for disregarding late-filed **arguments** on the grounds that they were presented for the first time in oral proceedings. The board held that the EPC in the English version made a clear distinction between "facts and evidence" on the one hand and "arguments" on the other in

Art. 114(1) EPC and that Art. 114(2) EPC did not refer to arguments. Art. 114(2) EPC was to be interpreted such that the parties' right to argue their case was not unduly restricted.

Taking a similar line in **T 861/93**, the board ruled that decisions referred to by a party in support of its arguments were never citations which, under Art. 114(2) EPC, could be rejected as being late. Arguments were not covered by the said provision. Therefore, decisions to which a party referred in support of its arguments should be regarded as part of these arguments and should not be rejected as being filed late.

6. Documents cited in the patent or the search report

A document considered during the examination procedure is not automatically scrutinised in opposition or opposition appeal proceedings, even if it is quoted and acknowledged in the contested European patent (**T 155/87**, **T 198/88** (OJ 1991, 254), **T 436/88**, **T 484/89**). According to **T 291/89** this also applied to a document cited in the search report. In **T 536/88** (OJ 1992, 638), the board endorsed this principle but made an exception in a specific case, on the grounds that, although the document in question had only been filed after the expiry of the time limit for opposition, it was cited and acknowledged in the European patent as the closest prior art for the purpose of formulating the technical problem set out in the description. A document of this kind formed part of the opposition or opposition appeal proceedings even if it was not expressly cited within the opposition period (see **T 234/90**, **T 300/90**). See also **T 501/94** (OJ 1997, 193), where the board also went on to say that a document indicated in a citation as the closest prior art for the purpose of elucidating the technical problem set out in the citation did not automatically form part of the opposition or opposition appeal proceedings if not expressly cited within the opposition period.

Regarding this issue, the board commented in **T 387/89** (OJ 1992, 583) on the scope of the principle of *ex officio* examination under Art. 114(1) EPC in opposition proceedings. The board of appeal invoked this principle to introduce two documents which were mentioned in the search report but were not specifically cited by the opponents, and on the basis of these documents the appeal against the revocation of the patent was dismissed. In the board's view, neither an opposition division nor a board of appeal had any duty to reconsider the relevance of documents cited in the European search report if such documents had not been relied upon by the opponents to support their grounds of opposition. Under Art. 114(1) EPC, however, an opposition division or appeal board may introduce new documents into the opposition proceedings if it has good reason to suppose that the documents could affect the outcome of the decision. In **T 588/89** the board similarly introduced a document into the appeal proceedings under Art. 114(1) EPC, because, in its view, the document reflected the closest prior art and raised doubts as to whether an inventive step had taken place.

In **T 219/92** a document cited in the search report had to be taken into consideration in view of its relevance. The board also considered it justifiable to exercise its discretion under Art. 111(1) EPC to decide the case having regard to this document, since the responsibility for the late citing lay with the respondents and the decision was not to the appellant's disadvantage.

In **T 541/98**, document 04 - referred to in the introduction of the patent in suit - had not been

cited by the opponent or considered by the opposition division, and was mentioned for the first time by the board after the opposition proceedings. The appellant (patent proprietor) felt that was at odds with the judicial nature of proceedings before the boards.

The board took the view that document 04 was not new because it formed part of the patent specification. What was new was the argument based on this document, and a board could always put forward its own arguments.

7. Remittal to the department of first instance

If a new citation is filed during opposition appeal proceedings, the question arises whether the case is to be remitted to the department of first instance. In board of appeal case law (see **T 258/84** (OJ 1987, 119), **T 273/84** (OJ 1986, 346), **T 621/90**, **T 166/91**, **T 223/95**), the prevailing view is that, if a document filed for the first time in opposition appeal proceedings is relevant enough to be taken into consideration, the case should as a rule be remitted under Art. 111(1) EPC to the department of first instance so that the document can be examined at two levels of jurisdiction and the patent proprietor is not deprived of the possibility of subsequent review. However, it is established board of appeal practice that where the board comes to the conclusion that the document is not such as to prejudice the maintenance of the patent, the board may itself examine and decide the matter under Art. 111(1) EPC (**T 326/87** (OJ 1992, 522), **T 416/87** (OJ 1990, 415), **T 457/92**, **T 527/93**, **T 97/90** (JO 1993, 719)). Recently in **T 1070/96** the board stated that even though as a rule, a case should be remitted to the department of first instance, if a new document is so relevant that it has considerable influence on the decision to be taken, a remittal is, however, not appropriate if the board is able to deduce from the reasoning of the decision under appeal how the opposition division would have decided had it known the late filed document.

The appropriateness of remittal to the department of first instance is a matter for decision by the boards of appeal, which assess each case on its merits.

(a) Patent in jeopardy

In **T 326/87** (OJ 1992, 522) the board added that remittal to the department of first instance is particularly desirable if the new citation puts the maintenance of the patent at risk: where this is not the case, the board itself may decide on the matter, as eg in **T 253/85**, **T 49/89**, **T 565/89** and **T 881/91**.

In **T 638/89** the board of appeal followed this line of argument in remitting the case to the opposition division because a document cited for the first time in the statement of grounds for appeal was highly relevant and should therefore be admitted into the proceedings.

That remittal is not automatic where the patent is at risk is shown by **T 1060/96**. In this case a document (E4) had been submitted by the appellant/opponent during the appeal procedure and one year prior to oral proceedings. The respondent had not challenged consideration of the document. It did however ask that the case be remitted to the first-instance department.

The board found that remittal was not justified: the respondent had had over a year to study

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the document, and its relevant part was technically very simple and merely reinforced the teaching of known documents. So it was not a new fact which went beyond the facts, evidence and arguments put to the first-instance department. The board revoked the patent.

(b) New facts

In **T 125/93**, where a highly relevant document was filed by the patentee shortly before the date appointed for oral proceedings, the board admitted it to the proceedings pursuant to Art. 114(1) EPC, which had the concomitant effect of altering the factual framework of the case under appeal compared with that upon which the decision under appeal had been based. The legal consequence of such a shift in the framework being well settled, and there being no "special reasons" of the kind referred to by the Enlarged Board in **G 9/91** and **G 10/91**, the board referred the case back to the opposition division for further prosecution.

In **T 611/90** (OJ 1993, 50) the appellants/opponents presented an entirely fresh case - based on public prior use instead of the previously-cited ground of prior publication - in their statement of grounds for appeal. The board explained that it may, subject to the circumstances, be inappropriate for an appeal board to deal itself with the allowability of such an appeal, raising as it does a case quite different from that on which the contested decision is based. The public's and the parties' interest in having the proceedings speedily concluded may then be overridden by the requirement that appeal proceedings should not become a mere continuation of first-instance proceedings. To ensure fairness to both parties, the board remitted the case to the opposition division. It admitted the late-filed material into the proceedings but decided that the party responsible for the late submission should bear all the additional costs arising from it (see **T 847/93**).

In **T 97/90** the board referred to **T 611/90** and confirmed that if fresh evidence, arguments or other matter filed late in the appeal proceedings raised a case substantially different from that on which the contested decision was based, the case should be remitted to the department of first instance where this was demanded by fairness to both parties. However, this did not imply that all cases in which a new ground of objection was raised late in the appeal must be remitted to the department of first instance. On the contrary, this should only be done if the admission of the new ground into the appeal proceedings would lead to revocation of the patent.

In **T 852/90** the board of appeal acceded to a request from the appellants/opponents for permission to introduce fresh evidence at the start of oral proceedings. The board confirmed that where a case on appeal turned out to be different from - or dissimilar to - the case decided by the department of first instance, it should be remitted to that department, pursuant to Art. 111(1) EPC. In the case in point, however, the late-filed evidence amounted to no more than an amplification - albeit a significant one - of the case already canvassed before the opposition division. The board therefore decided that there was no need to remit the case.

8. Apportionment of costs

According to board of appeal case law, if a party introduces important facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into

account in the apportionment of costs (see p. 492, and **T 117/86** (OJ 1989, 402), **T 326/87** (OJ 1992, 522), **T 97/90**, **T 611/90** (OJ 1993, 50), **T 110/91**, **T 705/92**, **T 847/93**, **T 1016/93**).

If the reasons for the late citing of a document do not point towards negligence or other circumstances that would amount to an abuse of procedure, there is no reason of equity which would justify an apportionment of costs in the other party's favour (**T 1016/93**).

G. Rules relating to Fees

1. Payment of fee

(a) Incorrect debit orders

Under Art. 5(2) and 8(2) RFees the EPO has opened deposit accounts for the settlement of fees and costs of other services provided by the EPO (see consolidated version of the respective regulations in the Ancillary regulations to the EPC (2001) under Art. 5(2) RFees). In three decisions the boards ruled in favour of the user of a deposit account where the debit order was incorrect:

A debit order must be carried out notwithstanding incorrect information given in it, if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (**T 152/82**, OJ 1984, 301).

A statement in a submission to the EPO stating that a debit order for payment of a fee has been issued may, if need be, itself be considered such a debit order in the absence of any record of the original (**T 17/83**, OJ 1984, 307).

T 170/83 (OJ 1984, 605) concerned a case in which a national Office form was used in error to effect a debit order, with the result that the particulars given (eg addressee, account number, amount) were incorrect. The board decided that the debit order was effective provided it at least gave particulars (in this instance the patent number) attributable to an EPO dossier which when consulted established without doubt the particulars intended and thus that the form was intended for the EPO.

(b) Designation fees

If the amount paid in respect of designation fees under Art. 79(2) EPC, second sentence, or R. 85a EPC is not sufficient for all the Contracting States designated at the time of payment, the payer must be requested pursuant to Art. 7(2) RFees, first sentence, to select the states he wishes to designate. If the payer does not comply in due time with this request, Art. 9(2) RFees must be applied instead of Art. 7(2) RFees, second sentence (**J 23/82**, OJ 1983, 127). (Art. 79(2) EPC has been amended since this decision, but only in respect of the time limit for payment of the designation fees.)

However, it is not justified for the EPO to proceed according to Art. 9(2) RFees, second

sentence, in a case where the applicant has individually indicated the states he has designated, for which he has paid the corresponding amount in designation fees, and where, on invitation under Art. 7 RFees, he does not indicate other states for which the payment should be used but confirms his wish to maintain the original individual designations (**J 19/96**). According to the Legal Board of Appeal, the fact that the designation of the states expressly indicated by the applicant was not possible for legal reasons was not equivalent to the situation where the applicant had not specified how to apply an insufficient overall amount, as referred to in Art. 9(2) RFees, first sentence (as in **J 23/82** above). The designation was still a clear and unequivocal declaration of the procedural will of the applicant which was binding on the EPO.

(c) Indication of purpose of payment

In **J 19/96** the board noted that **J 23/82** (OJ 1983, 127) held that the indication of the purpose of a payment within the time limit for payment was not a mandatory requirement for payment to have been made in due time and, according to Art. 7(2) RFees, could thus still be given later. However, the current board doubted whether this meant that it was generally possible to change the purpose of a payment after expiry of the relevant time limit with retroactive effect to the date on which the payment was made.

(d) Methods of paying

The remittance of German Patent Office fees vouchers does not comply with Art. 5 RFees and thus cannot be regarded as payment of a fee (**T 415/88**).

2. Date of payment

Art. 8 RFees as amended stipulates that the date on which payment shall be considered to have been made shall be the date on which the payment is "actually" entered in an account held by the EPO. (See **J 24/86** (OJ 1987, 399) for a summary of the previous case law on this matter).

Under Art. 8(3) RFees, the period for payment of a fee is considered to have been observed even if payment is not received until after expiry of the period in which it should have been made, on condition that the following requirements are met (see eg **T 842/90**):

(a) the person who made the payment must provide evidence to the EPO that within the period within which the payment should have been made he effected the payment in a contracting state, for example through a Giro account held by the EPO;

(b) the person who made the payment must pay a surcharge of 10% on the relevant fee unless he effected payment not later than ten days before the expiry of the period for payment.

Under Art. 8(1)(a) RFees, where an amount is transferred to a bank account, the date on which the amount of the payment or transfer is actually entered in the EPO's bank account is considered to be the date on which the payment has been made to the EPO. Thus, where

an appeal fee is mistakenly **transferred to a bank account** held by the German Patent Office ('GPO'), neither the date on which the transfer is entered in the GPO's account nor the date on which the order to transfer the amount to the GPO is issued may be taken into account to establish whether a fee due to the EPO has been paid in due time (**T 45/94** and **T 1130/98**). The boards pointed out that, in the Administrative Agreement between the German Patent Office and the EPO concerning procedure on receipt of documents and payments dated 29.6.1981, as amended on 13.10.1989 (OJ 1991, 187), there are no provisions regarding the passing on of the payment or notification of the EPO for erroneous bank transfers. Sums of money payable to the EPO and paid into one of the accounts held by the German Patent Office are, under the terms of the Administrative Agreement, repaid to the payer (**J 49/92**). On the other hand, according to Art. 1(5) of the Administrative Agreement, payments sent by **post** to the GPO are accepted on behalf of the EPO and set aside for daily collection by an EPO employee.

3. Small amount lacking

Under Art. 9(1) RFees, a time limit for payment is in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO is given the discretion (fourth sentence), where this is considered justified, to overlook any small amounts lacking without prejudice to the rights of the person making the payment.

The justification for overlooking a small fee underpayment has been considered by the boards of appeal in several cases. In **T 130/82** (OJ 1984, 172) the board decided that it was justified to overlook an underpayment of just over 10%. In **J 11/85** (OJ 1986, 1) the board stated that an underpayment of about 10% may as a rule be considered as a small amount (see also **T 109/86** of 20.7.1987).

In **T 290/90** (OJ 1992, 368) the board found that this question must be decided on an objective basis, having regard to all the relevant circumstances of the case, and not on a subjective basis. The board reached the conclusion that in the circumstances of that case, 20% of the opposition fee could properly be regarded as a small amount for the purpose of Art. 9(1) RFees, because it was inappropriate to punish the appellant for contending he was entitled to a reduction in the opposition fee and the missing 20% was paid soon after expiry of the period.

However, in **T 905/90** (OJ 1994, 306, Corr. OJ 1994, 556) the board found that the meaning of 'smallness' could best be determined by comparing the amount of shortfall with the amount of the full fee. When viewed in this light, and regardless of its absolute quantity or its quantity in relation to the ability to pay, or the consequences of not paying it, a difference of 20% clearly could not, on purely arithmetical grounds, be regarded as small. It was with very small or trifling amounts that Art. 9(1) RFees was designed to deal so as to prevent a loss of rights where an inadvertent error of some kind had led to a slight underpayment of an amount due in respect of the relevant proceedings.

In **J 27/92** (OJ 1995, 288) the examination fee was underpaid by about 20%, amounting to DEM 560. Distinguishing **T 905/90**, the board defined the concept of a "small amount lacking" in Art. 9(1) RFees as a fixed proportion of the amount of the particular fees to be paid. At

most, 20% of the fee to be paid might be regarded as small within the meaning of the said provision. Moreover, the choice of 20% as the percentage to be considered a "small amount" would achieve the desirable end of making it possible to apply Art. 9(1) RFees to cases where a party paying fees mistakenly sought to take advantage of the 20% reduction in fees available in relation to Art. 14(2) and (4) EPC under R. 6(3) EPC and Art. 12 RFees. In the case in point the board decided that it was justified to overlook the deficit as the applicant not only paid it without delay, but also appeared to have been misled into paying only 80% of the fees as a result of information provided by the EPO.

H. Procedural steps

1. General principles

A procedural step is an act, performed by a party to the proceedings, which falls under procedural law as regards the conditions governing it and its effect, and which influences the course of the proceedings.

The decisions of the boards of appeal have developed a number of principles regarding procedural steps.

In proceedings before the EPO a distinction can be made between two kinds of procedural step: those affecting the scope, subject-matter and effect of the requested decision, and those affecting the form of the proceedings. This chapter looks at general principles applying to both types of procedural step. The special features relevant to opposition and appeal statements, to requests for a different apportionment of costs, reimbursement of the appeal fee and appointment of oral proceedings, and to the filing of amended claims are dealt with in the appropriate chapters.

To be effective, declarations regarding procedure need to be clear; ambiguous declarations are ineffective (**J 11/94**, OJ 1995, 596).

Procedural statements may not be subject to any conditions. In **J 27/94** (OJ 1995, 831) the applicant, replying to the communication under R. 51(4) EPC, approved the text of the patent and also made the following statement : " The applicant ... will file in due course a divisional application". After filing the response it filed the divisional application. The Receiving Section refused to treat the application as a divisional application. The decision was based on opinion **G 10/92** which stated that an applicant could only file a divisional application on the pending earlier application up to the approval in accordance with R. 51(4) EPC. The applicant filed an appeal against the decision of the Receiving Section, stating inter alia that the reply to the communication under R. 51(4) EPC did not contain a clear and final approval of the text because it expressed the clear intention to have the previously deleted subject-matter protected by means of a divisional application. The board was of the opinion that the two statements could not be separated from each other without neglecting their correlation and mutual dependence. Hence, the examining division should not have treated the letter as a valid approval, because it contained a condition which made the approval invalid. In the interests of legal security procedural statements had to be unambiguous. This implied that

a statement should not be subject to any condition, leaving it unclear whether or not the EPO could proceed further on the basis of it.

Procedural statements are open to interpretation (**G 9/91**, OJ 1993, 408). They are not valid if they are filed by a person who is not entitled to do so (**J 28/86**, OJ 1988, 85). Statements filed during proceedings before the department of first instance are not valid in the subsequent appeal proceedings (**T 34/90**, OJ 1992, 454; **T 45/92**; **T 501/92**, OJ 1996, 261).

According to **T 212/88** (OJ 1992, 28) all requests by parties, including any request for apportionment of costs, should be made before announcement of the decision at the conclusion of oral proceedings. In **T 552/97** the board ruled that, before issuing its decision, the department responsible should clarify the position, ascertaining exactly what was requested and verifying the correctness of its assumption that a request had been withdrawn. An objective lack of clarity at the end of the oral proceedings constituted a substantial procedural violation.

The issue in **J 12/95** was whether the filing of a procedural statement was valid. A European patent application was filed on 19.4.1994 as a divisional application. The Receiving Section refused to treat the application as a divisional application because it was filed after approval had been indicated in respect of the earlier pending application. The approval had been received by fax on 18.4.1994 and as a confirmation copy on 19.4.1996. The applicants/appellants submitted that the transmission of the approval by fax on 18.4.1994 was contrary to their representative's true intentions and occurred in contravention of his express instructions. The board held that a valid procedural declaration required that it be set down in writing, signed and communicated to the EPO by the person responsible. In the present case the content of the declaration was attributable to the appellant's representative whereas the fax transmission was not because there was convincing evidence that this transmission took place against the express order of the authorised representative and could not therefore be treated as a valid approval. The divisional application had to be considered to have been filed within the time limit laid down in R. 25(1) EPC.

Requests relating to ancillary proceedings (eg apportionment of costs) remain pending, even if the appeal is withdrawn (**T 265/93** and, similarly, **T 789/89**, OJ 1994, 482).

2. Signatures

In **J 25/86** (OJ 1987, 475), the board held that the signing of the authorisation is to be considered to be the legal act from which an application ultimately originated.

In **T 960/95**, the board ruled that under Rule 61a EPC in conjunction with R. 36(3) EPC, first sentence, an opposition had to be signed. A missing signature was a deficiency which could be remedied under R. 36(3) EPC, second sentence. According to **T 850/96**, the same had to apply to signatures which were not legible. An opposition signed by a non-authorised third party should be treated like an unsigned one (**T 665/89**).

3. Main and auxiliary requests

3.1 Admissibility

The appellant in **T 382/96** had filed ten auxiliary requests featuring proposals for amending the claims. Some of these auxiliary requests contained no more than broadly outlined alternatives with no proper verbal formulation, and one of the requests was even said to require consultation with the board before it could be more accurately defined. There were a total of 400 alternative versions for the claims.

The board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (in opposition proceedings the proprietor). That was clear for example from the provisions of R. 51(4) to (6) EPC and R. 58(4) and (5) EPC. The applicant/proprietor could not offload this responsibility *de facto* on to the European Patent Office or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. In the board's view, doing so constituted an abuse of procedure, as it overburdened the European Patent Office and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings. The auxiliary requests in question were rejected as inadmissible for lack of concrete verbal form because they did not identify the extent to which amendment/cancellation of the impugned decision was requested (see R. 64(b) EPC).

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

3.2 Examination procedure

According to **T 1105/96** (OJ 1998, 249), an applicant had a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests even if the examining division communicated its view that all except the last auxiliary request were inadmissible or unallowable, and he was then entitled to a reasoned appealable decision in respect of rejection of each such request. Where an examining division had communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests were abandoned was an unlawful exercise of discretion under R. 86(3) EPC and a substantial procedural violation within R. 67 EPC (see **T 155/88**).

At oral proceedings before the examining division in **T 549/96** the appellant was given the opportunity to withdraw his main request and his auxiliary requests 1 and 2, so as to allow the examining division to grant a patent on the basis of the third auxiliary request. The appellant refused and submitted that according to the principle of *reformatio in peius* the applicants should have received a decision allowing the third auxiliary request while explaining the grounds on which the other requests were refused, instead of a decision to refuse the patent application.

In this context the board noted that Art. 113(2) EPC required the examining division to decide upon an application only in the text agreed by the applicant. It followed therefrom that an applicant had to indicate clearly at the end of the proceedings which text he wished to be used. Otherwise the examining division would be unable to decide which version should be the basis for its proceedings. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, eg by express disapproval or by maintaining one or more unallowable higher-preference requests, the examining division could refuse the application under Art. 97(1) EPC.

The board noted that the situation in opposition proceedings differed from that in grant proceedings. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC to the effect that the European patent met the requirements of the EPC, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the Convention. The purpose of such an interlocutory decision in opposition proceedings was to save the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in *ex parte* appeal proceedings the principle of examination *ex officio* applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the application in a certain version met the requirements of the Convention, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113).

3.3 Opposition procedure

According to **T 234/86** (OJ 1989, 79), the opposition division can - and in certain circumstances must - maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be substantiated (see also **T 488/94**).

In **T 5/89** (OJ 1992, 348) the board confirmed that a decision may confine itself to rejecting the main request only if all subordinate requests have been withdrawn. This principle was further confirmed in **T 785/91**.

4. Maintenance in the case of prior European rights

In **T 117/90**, during the opposition and appeal proceedings, a European patent application was found to be part of the state of the art under Art. 54(3) and (4) EPC and thus caused lack of novelty for all the designated states except Austria and Luxembourg. The board revoked the contested patent for all states, including Austria and Luxembourg, on the grounds that the respondents had requested only the rejection of the opponents' appeal and not the maintenance of the patent in Austria and Luxembourg (see also **T 796/90**).

In comparable situations maintenance of the patent for some of the originally designated states was examined by the boards. This was the case in decisions **T 622/89**, **T 368/90**, **T**

755/90 and **T 806/90** on the basis of requests to that effect from applicants or patentees, some of whom had submitted separate sets of claims for the various (groups of) states.

I. Withdrawal of application and surrender of patent

1. Withdrawal of patent application as a whole

A request for withdrawal of a European application should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141). In **J 11/87** (OJ 1988, 367) the board added that where there was even the slightest doubt as to the proprietor's actual intent it had always considered that such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been his true intent.

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

In **J 15/86** (OJ 1988, 417) the board stated with regard to the declaration of withdrawal that, in practice, in the operation of the European patent system, there was a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there was a dispute as to the applicant's intention had to be considered on its own facts. A written statement of the applicant or his representative had to be interpreted in the context of the document as a whole and of the surrounding circumstances. It was too late to ask for retraction of a notice of withdrawal once the withdrawal had been published in the European Patent Bulletin (see Legal Advice No. 8/80, OJ 1981, 6, point 2).

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

In **J 4/97**, the applicants withdrew their application by letter filed on 9 September 1996. On 12 September 1996 the applicants informed the EPO that their request for **withdrawal was erroneously made** and should be cancelled. The EPO notified the applicants that the withdrawal had come into force and could not be corrected. On 6 November 1996 a notification was published in the European Patent Bulletin according to which the application was withdrawn. The board held that the withdrawal of the application could be corrected under R. 88 EPC. The legal considerations contained in decision **J 10/87** concerning the retraction of a withdrawal of a designation of a contracting state equally applied to the withdrawal of a patent application as a whole. In particular, it had to be ascertained that the withdrawal had been due to an excusable error and that the retraction of the withdrawal had

not adversely affected the public interest or the interest of third parties.

In the circumstances of the case at issue, the board held that the fact alone that the withdrawal was retracted after only three days was a strong indication that it had indeed been made in error. The error resulted from a confusion between two similar reference numbers assigned by the appellants to their patent applications. In the board's opinion this mistake could be considered as an excusable oversight. The public interest was not affected because the withdrawal was retracted before the corresponding entry was made in the Register of European Patents and more than six weeks before the withdrawal was officially notified to the public in the European Patent Bulletin. The interests of third parties could be protected if a national court applied Art. 122(6) EPC *mutatis mutandis*.

2. Surrender of patent as a whole

In the key decision **T 73/84** (OJ 1985, 241), when the patent was revoked at the instigation of the patent proprietor, the board stated that "the patent proprietor cannot terminate the proceedings by telling the EPO that he is **surrendering** the European patent, since this is not provided for in the EPC. Thus he would only be able, as far as national law permitted, to surrender the patent vis-à-vis the national patent offices of the designated contracting states under the relevant national law". If the proprietor of a European patent stated in opposition or appeal proceedings that he no longer approved the text in which the patent had been granted and would not be submitting an amended text, the patent was to be revoked. The board held that in such a case there was no text of the patent on the basis of which the board could consider the appeal: under Art. 113(2) EPC the EPO must consider the European patent only in the text submitted to it or agreed by the proprietor of the patent.

Following Legal Advice No. 11/82 (OJ 1982, 57) and **T 73/84**, the board stated in **T 186/84** (OJ 1986, 79) that if in opposition proceedings the proprietor of a patent requested that his patent be revoked, it was to be revoked without substantive examination. According to this Legal Advice, a European patent was revoked (without any further examination as to patentability) if the proprietor stated that he no longer approved the text in which the patent was granted and did not submit an amended text. This was assumed also to apply if the proprietor requested that the patent be revoked (see **T 237/86** (OJ 1988, 26), **T 347/90**). In **T 459/88** (OJ 1990, 425) the board added that there was no public interest in maintaining a patent against the patent proprietor's will.

See also page 540.

3. Abandonment of parts of an application or patent

3.1 Abandonment of subject-matter of the application or patent

If an applicant or patent proprietor abandons claims the question arises whether his aim is the **substantive abandonment** of the relevant subject-matter of his application or patent, or whether his intention is to file a **divisional application** in respect of the subject-matter involved or whether the action is merely an **attempt to reformulate the claims** to take account of objections made by the EPO or an opponent.

3.1.1 Abandonment with substantive effect

If the abandonment has substantive effect, there is no possibility of reinstating the abandoned subject-matter, either as part of pending grant or opposition proceedings or by filing a divisional application. This is the assumption if the relevant parts of the description are also abandoned.

In **T 61/85** the applicant had amended the claims before the examining division and requested during appeal proceedings that the claims be granted as originally filed. The board refused this request since the applicant had expressly and unambiguously abandoned the entire original claim and the relevant parts of the description.

In **J 15/85** (OJ 1986, 395) the applicant had submitted new claims to dispel objections by the examining division and had declared that the other claims should be deleted. The applicant had, however, not stated that such deletion should be without prejudice to the filing of a divisional application (see reasons, 3). After the communication pursuant to R. 51(4) EPC, based on the new claims, had been issued, the applicant's representative had filed a divisional application in respect of the claims that had been dropped. The board did not allow such reinstatement. At the date of abandonment of the claims the parent application had already been published so that the public had access to the file and were entitled to assume that the appellant had irrevocably abandoned the claims and would not thereafter seek to obtain protection for them.

A declaration of abandonment could, however, be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent.

In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and came to the conclusion that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings.

In **J 13/84** (OJ 1985, 34) the board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application (see above). In particular, all the circumstances had to be taken into consideration and not just the preceding declarations. In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that "in accordance with the examiner's suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation". The

Receiving Section took the view that the divisional application, with the former claim 21 as its subject-matter, was not filed within the period of two months prescribed in R. 25(1)(b) EPC (old version). It argued that claim 21, which had already been divided out from the application on 6.6.1983 and therefore no longer formed part of the parent application on 31.8.1983 (the date of filing of the divisional application), could no longer be converted into a divisional application. The board did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, ie taking into account all the circumstances. It added that, generally speaking, and as stated in the summary of the Legal Board's decision in **J 11/80** (OJ 1981, 141), "a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous". The board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467), in which it was found that, where claims were withdrawn specifically under R. 25(1) EPC, the applicant's restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

3.1.2 Abandonment without substantive effect

The limitation of claims may represent attempts to respond to objections by the EPO or an opponent without necessarily involving any immediate intentions of substantive abandonment. In this case the question arises of whether the applicant or patent proprietor can reinstate broader claims which had been proposed at an earlier stage of the proceedings.

(a) Examination proceedings

In **T 472/91** the board allowed the reinstatement during ex parte appeal proceedings of claims amended during the examination procedure.

However, aspects of procedural law could present obstacles to the reinstatement of dropped claims or the filing of a divisional application involving such claims.

In **T 12/81** (OJ 1982, 296), the application had been refused. In their statement of grounds of appeal the applicants requested that claim 5 be deleted. During the oral proceedings, however, the applicants requested that this claim be reinstated in the application. The board refused this request on the grounds that allowing such a late request contravened the ratio legis of R. 86(3) EPC in conjunction with R. 66(1) EPC, which was to prevent proceedings becoming unduly prolonged.

In **T 92/85** (OJ 1986, 352) the applicants had amended their claims several times and finally proposed "to limit the application to the embodiment of Figure 6 which had been the subject-matter of the original claim 8". They had then filed correspondingly limited claims. After the communication pursuant to R. 51(4) and (5) EPC (old version) had been sent out the applicants' representative requested the extension of the claims and submitted a set of

Withdrawal of application and surrender of patent

amended claims and an amended description. He also requested permission to file a divisional application. The board held that after the issue of the communication pursuant to R. 51(4) and (5) EPC and in the absence of exceptional circumstances, the examining division could refuse to allow the filing of a divisional application in the exercise of its discretion under R. 25(1)(a) EPC (old version) and also refuse its consent to further amendments pursuant to R. 86(3) EPC.

(b) Opposition proceedings

(aa) Reinstating broader claims before the opposition division

In **T 64/85** during opposition proceedings the patent proprietor had first amended his claim 1 and then asked as his main request that the patent be maintained as granted. The opponent was of the opinion that the patent proprietor had, by his amendments, abandoned certain subject-matter. Since both the opponent and the public ought to be entitled to trust that this subject-matter was no longer protected, such abandonment should not be reversible. The board took the view that decision **J 15/85** was not applicable in this case since the amendments here did not affect any embodiment in the description or the drawings, with the result that they did not unambiguously limit the protection originally sought but rather clarified features which were already implicitly comprised in the description. The board also held that an amendment made before the opposition division had commented on patentability could not be definitive (see also **T 168/99**).

In **T 123/85** (OJ 1989, 336) the board stated that during the opposition proceedings the patent proprietor was entitled to amend a request already made; in particular he could reinstate the patent in the form in which it was granted, provided this did not constitute an abuse of procedural law. In requesting that their patent be maintained in a limited form the patent proprietors were merely trying to delimit their patent to meet objections expressed by the EPO or the opponents. However, the patent proprietors did not, by virtue of such limitation, irrevocably abandon subject-matter covered by the patent as granted but not by the request as thus limited (likewise **T 155/88**, **T 225/88**, **T 715/92**).

The view taken in **T 123/85** that this also applied to the subsequent appeal proceedings now only applies to the extent laid down in **G 9/92** and **G 4/93** (OJ 1994, 875) (see below and under "Appeal").

(bb) Reinstating broader claims in opposition appeal proceedings

According to **G 9/92** and **G 4/93** (OJ 1994, 875), in opposition appeal proceedings the extent to which the patent proprietor is entitled to make amendments depends on the result of the first-instance proceedings and on whether the patent proprietor himself filed an admissible appeal or is merely the respondent. The view taken in decisions such as **T 576/89** (OJ 1993, 543) **T 770/89** and **T 217/90** is no longer applicable.

(1) Where the patent proprietor is appealing against the **revocation** of his patent, he is entitled to revert to a more broadly worded version of the patent, and in particular the one as granted, even if he had filed a restricted version at the commencement of appeal proceedings

VI.1.3. Abandonment of parts of an application or patent

(T 89/85; T 296/87, OJ 1990, 195; T 373/96; T 65/97 and T 564/98). Should opposition appeal proceedings reveal that the claims as amended during opposition proceedings are in breach of Art. 123(3) EPC, the patent proprietor and appellant must be allowed to abandon this version (T 828/93). The right in principle to reactivate earlier claims is refused if it appears to constitute an abuse of procedure, as was the case in T 331/89.

(2) Where the **opposition was rejected** and the patent maintained as granted, the respondent/patent proprietor can revert to the version as granted, provided he has first proposed restrictions during the appeal proceedings (T 705/91).

(3) Where the patent was **maintained as amended** the **patent proprietor** who did **not** himself file **an admissible appeal** may, according to G 9/92, G 4/93 (OJ 1994, 875), in principle only defend the patent in the form it which it was maintained by the opposition division in its decision. He may not revert to the version of the patent as granted (see also T 369/91, OJ 1993, 561). Any amendments he proposes in the appeal proceedings may be rejected by the board if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal (see, for example, T 266/92 of 17.10.1994). According to T 752/93 of 16.7.1996, however, an amendment made in the course of appeal proceedings to the version as amended by the opposition division which is appropriate and necessary may not merely restrict this version, it may also extend it - even in cases where the patent proprietor has not filed an appeal. For the limits set on the patentee/respondent to make amendments see G 1/99, OJ 2001, 381 and chapter "Appeal procedure".

If however, where the patent is maintained in amended form, the **patent proprietor** is himself the **appellant**, he may in appeal proceedings pursue claims which are broader than those held to be allowable by the opposition division.

It was however decided that in appeal proceedings the patent proprietor may only pursue claims which were the subject of the first-instance decision. In T 528/93 the board took the view that a request containing an independent claim filed earlier in virtually identical form, then withdrawn during proceedings before the opposition division and hence not the subject of the contested decision, was not the subject of the appeal, because the appellant was not adversely affected by such a decision with respect to that request. Exercising its discretion, the board did not therefore admit this request into the appeal proceedings (see also T 506/91).

3.1.3 Non-payment of further search fees in the case of lack of unity

According to T 178/84 (OJ 1989, 157) it is clearly the intention of R. 46(1) EPC to regard subject-matter as abandoned in a particular patent application if, in response to an invitation according to this rule, the further search fee is not paid for this subject-matter within the time limit set by that rule. Since a different view was taken in T 87/88 (OJ 1993, 430), the President of the EPO referred the matter to the Enlarged Board of Appeal which, in G 2/92 (OJ 1993, 591), held that an applicant who failed to pay the further search fees for a non-unitary application could not pursue that application for the subject-matter in respect of which no search fees had been paid. He would have to file a divisional application in respect of such subject-matter. However, non-payment was not to be equated with the abandonment

of parts of the application.

3.1.4 Non-payment of claims fees

If an applicant fails to pay claims fees, he is considered under R. 31(2) EPC to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a substantive loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned pursuant to R. 31(2) EPC, which were not otherwise to be found in the description or drawings, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2) EPC, appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) EPC in conjunction with Art. 123(2) EPC. An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed (see reasons 6 and 7). This view has since been confirmed in other ex parte proceedings, namely **T 490/90**.

J. Law of evidence

1. Introduction

Before an administrative authority or a court takes a decision, it is required to establish the existence of the material facts, ie the facts from which, under the relevant legal provision, the legal effect ensues. The facts are established by taking evidence. However, facts need not be proved if they have already been established or if the authority or court has to assume their existence.

Where the onus is on the parties to present their case, they are required to furnish proof of the facts they allege, in so far as such facts are disputed. Where the investigative principle applies, the evidence relating to the facts to be proved must be obtained by the body which has to take the decision, although the lengths to which it must go are left to it in the proper exercise of its discretion. The body in question is not bound by mutually corroborating statements made by parties on opposing sides; it has wide discretion to decide what evidence to accept and the weight it attaches to it (the principle of unfettered consideration of the evidence).

Art. 117 EPC and R. 72 to 76 EPC contain provisions governing means of giving or obtaining evidence, the procedure for taking evidence and the conservation of evidence. The boards of appeal have considered other questions arising in connection with the law of evidence.

1.1 Terminology

The boards have interpreted the term "taking of evidence" broadly, applying it not only to the

procedures listed in R. 72 EPC but also to the production of documents of any kind, unsworn declarations and the giving and obtaining of evidence, whatever its form (see **T 117/86** (OJ 1989, 401), **T 416/87** (OJ 1990, 415), **T 323/89** (OJ 1992, 169), **T 314/90**).

The term "documents" in Art. 117(1)(c) EPC, which is not elucidated in the EPC, was defined in **T 314/90** as meaning essentially all written documents in which thoughts are expressed by means of characters or drawings, including published documents.

In **T 795/93** the board was of the opinion that a document as a means of disclosing the state of the art was a means of proof with a variety of functions. It was intended first to prove what had been made available to the public in the written description it contained, ie what contribution in the form of information, knowledge, teaching, etc. it made to the state of the art, and also served to prove when such information had been made available.

In **T 543/95** the board drew a distinction between the terms "evidence" and "substantiation". The time at which something could be said to have been made available to the public was substantiated by indication of a date or of a restricted period and by indication of the means by which the time claimed was established. The purpose of the evidence was to verify whether the assertion made was in fact correct. Substantiation did not extend to evidence, even if it was possible for both to coincide when using written documentation as a means of proof.

In **T 558/95** the board stated that a statutory declaration ("eidesstattliche Erklärung") was evidence within the meaning of Art. 117(1) EPC and as such subject to the free evaluation of evidence. It took the place of the sworn statements in writing referred to in Art. 117 EPC which did not exist as evidence under German law.

In **T 301/94**, the board confirmed the practice of the boards of appeal stating that the EPC did not contain any restrictions with regard to the kind of evidence which could be produced in proceedings before the EPO. A "déclaration sur l'honneur" certified by a "notaire" is therefore admissible as means of proof.

2. Admissibility of evidence

The question has often arisen as to whether a particular submission may be admitted as evidence. This question has to be kept separate from that of the actual consideration of the evidence. Art. 117 EPC does not contain an exhaustive list of admissible evidence. Nor does the EPC provide that certain points of fact may be established only by certain means of evidence. The boards have therefore assumed that any kind of evidence is admissible for any facts that have to be proved.

In **G 11/91** (OJ 1993, 125) the Enlarged Board of Appeal stated that evidence of what was common general knowledge on the date of filing of a patent application may be furnished in connection with an admissible request for correction under R. 88 EPC, second sentence, in any suitable form allowed by the EPC - and Art. 117(1) EPC in particular - as a means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form (see also **G 3/89**, OJ 1993, 117).

The Legal Board of Appeal decided along the same lines in **J 11/88** (OJ 1989, 433), according to which questions of fact must be settled on the basis of any credible information available. In **T 838/92** too, the board established that any kind of evidence is admissible. In this case, the appellant argued that the witness's testimony should not be admitted as evidence; his impartiality was suspect because he was being sued for infringing the corresponding French patent.

In **T 482/89** (OJ 1992, 646) the board took the view that an employee of one of the parties to the proceedings could be heard as a witness (see also **T 443/93** and **T 937/93**). In **T 124/88** and **T 830/90** (OJ 1994, 713) employees of the opponent were heard without the admissibility of such oral evidence being called into question. In **T 575/94** the board held that hearing the employees of an opponent or of a company whose involvement was as a client of the opponent was not precluded. It was also pointed out in **T 838/92** and **T 443/93** that the fact that a witness might be biased did not make his oral evidence inadmissible but was a matter to be taken into account when the EPO considered the evidence.

In **T 558/95** the board held that the fact that the statutory declarations provided by the opponent were to some extent identical in wording and drawn up by employees of the opponent did not rule them out as admissible evidence. It was rather a question of evaluation to see whether the evidence provided was sufficient.

Art. 117(1)(g) EPC allows sworn statements in writing as a means of giving or obtaining evidence.

In **T 674/91** the board noted that it was board of appeal practice to regard affidavits or statutory declarations in original or copy form as admissible means of providing evidence, to avoid having to call the person who had made the declaration as a witness. In **T 770/91** the board pointed out that although statutory declarations were not covered by Art. 117(1)(g) EPC, they were taken into account in accordance with the principle of the unfettered consideration of evidence. In **T 970/93** the board pointed out that there was no express provision for the acceptance by the EPO of unsworn declarations in the catalogue given under Art. 117(1) EPC. However the EPO accepted unsworn solemn declarations, in the same way as it accepted other unsworn statements.

In **T 327/91** it was ruled that any kind of document, regardless of its nature, was admissible in proceedings before the EPO. The fact that an affidavit was submitted by the appellant's general manager did not make it inadmissible. Assessment of the affidavit was a question to be dealt with in accordance with the principle of the unfettered consideration of evidence.

In **T 231/90** it was made clear that evidence supplied in the form of testimony by witnesses or statutory declarations was not admissible if such means of evidence were offered in place of delivery notes which could no longer be produced because such a long time had been allowed to elapse that they had been destroyed during routine shredding.

In **T 395/91** it was not considered appropriate for an expert to be heard since the questions to be answered by the expert had already been answered by the inventor as a person skilled in the art. The board was further of the opinion that assessment of the patent law aspects,

on the basis of comprehensible technical facts, was a matter for the members of the board and not a technical expert.

In **T 543/95** the opponent/appellant had asserted in the grounds for opposition that a brochure illustrating the apparatus had been made available to the public at a specified time. As proof he had cited the date printed on the brochure, and also offered to provide a witness. Regarding prior use of the apparatus, he had offered only witness corroboration. The opposition division had refused to hear the witness, commenting that he would serve only to confirm the facts presented. It regretted that the opponent had not produced further documents showing when the brochure was made public.

The board pointed out that the purpose of all evidence, whatever its nature, was to confirm a party's assertions. Parties were free in their choice of evidence. The kinds listed in Art. 117(1) EPC were merely examples. It was not for opposition divisions to criticise the absence of other types of evidence.

3. Procedure

It was made clear in **J 20/85** (OJ 1987, 102) that the Receiving Section too had the power to take evidence, although this EPO body was not listed in Art. 117 EPC. The board also laid down the principle whereby, in any case of disagreement, evidence relating to it should be taken as soon as it arose. Evidence could also be taken from parties without the presence of their patent attorneys if the latter had been informed of the hearing (see **T 451/89** and **T 883/90**).

In **T 953/90** the board held that when a party sought to prove potentially relevant facts by means of the statement of a witness, it was particularly important that this statement be furnished early in the opposition phase so as to enable the witness to give oral evidence in accordance with Art. 117 EPC, if the statement was disputed by a party on the other side or if the EPO considered it necessary.

T 760/89 (OJ 1994, 797) dealt with the possibility of returning documents which had been filed as evidence and were subject to an obligation to maintain secrecy. The ruling was that documents filed as evidence during opposition proceedings and submissions referring to them in principle remained in the file until the end of the proceedings and for at least five more years (see R. 95a EPC). Documents filed as evidence could only exceptionally and on a substantiated request remain unconsidered and be returned. Such an exception existed if the interests of the filing party in having them returned unconsidered clearly prevailed over the interests of any other party and the public interest. This might be the case if the documents were filed in breach of a confidentiality agreement and if they did not belong to the state of the art but were third party statements filed as part of the response to the opposition, and if the other parties involved agreed with the request. The same applied to submissions referring to such documents.

In **T 39/93** the board held that it had to decide an appeal on the basis of the evidence and arguments adduced in the current proceedings. It would be wholly wrong for it to take cognisance of any matter that was not actually in this particular case. If an original

photomicrograph was a piece of evidence that had been introduced in another case and only a photocopy of this had been introduced in the case in question, the board was limited to a consideration of the photocopy filed in the present appeal.

In **T 232/89** the opponent/respondent had produced two affidavits which had not been contested by the patent proprietor/appellant, but had not tendered any witnesses. The opponent's request that the authors of the affidavits also be heard as witnesses was rejected, as the affidavits were quite sufficient in the circumstances.

In **T 674/91** it was stated that according to the practice of the boards of appeal, affidavits or statutory declarations, whether originals or copies, were acceptable as evidence. As one of the purposes of this form of evidence was to avoid having to call the signatory as a witness, it seemed superfluous to have them confirmed in this way. Since these statements were usually drawn up on the basis of answers to questions formulated by lawyers, it was not surprising to find the same stereotyped formulations in different declarations. The board was not required to check the signatures of the persons concerned, unless evidence disputing their validity was produced.

In **T 804/92** (OJ 1994, 862) the opposition division had, in a communication to the parties, suggested in detail the content of a statement under oath. Such a practice was firmly rejected by the board because it involved the risk of leading witnesses and could seriously undermine the probative value of such statements. This applied to departments at any instance in proceedings before the EPO.

In **T 798/93** the board emphasised that sworn statements in writing, which were one of the means of giving or obtaining evidence listed in Art. 117(1) EPC, were not automatically ordered simply at the request of one of the parties. All means of giving or obtaining evidence listed in Art. 117 EPC were subject to the discretion of the department concerned, which ordered them only when it considered this necessary.

In **T 142/97** (OJ 2000, 358) the board decided that EPO departments must ascertain the relevance of evidence submitted to them before deciding to admit or reject it. Only in exceptional circumstances need they not do so.

In the case in point, however, the opposition division based its refusal of the offers to present evidence on mere conjecture as to its content, and failed even to take cognisance of the evidence tendered and its connection with the circumstances of the prior use, although there were no circumstances which would have made examination as to relevance dispensable. An opposition division's refusal to consider evidence filed in due time (eg witness testimony or inspection) thus infringes a party's fundamental rights to free choice of evidence and to be heard (Art. 117(1) EPC and Art. 113(1) EPC).

4. Evaluation of evidence

The EPC says nothing about how the outcome of taking evidence should be assessed. The principle of unfettered consideration of evidence applies. The body required to take the decision therefore decides - on the basis of the whole of the evidence taken and the

proceedings, and in the light of its conviction arrived at freely without reference to any legislative provisions on the evaluation of evidence - whether an alleged fact has occurred or not (see **T 482/89** (OJ 1992, 646), **T 327/91**, **T 838/92**, **T 575/94**). Nor, consequently, have any general rules for the evaluation of evidence been laid down, but it has been decided in individual cases when a particular means of evidence was sufficient.

If a party fails to submit available evidence when asked by the board to do so, this may be taken as an indication that possibly the evidence does not support his arguments (**T 428/98**, Reasons 3.6).

For examples of the appraisal of evidence, the following decisions may be cited.

In **T 473/93** the board decided that the appellant's surmise that he had been in error in making his statutory declaration was not sufficient to allow orally presented facts which deviated from the declaration to appear more credible. The fact alleged orally therefore had to be regarded as not proven.

In **T 332/87** a dated internal paper, marked as being confidential and not signed, was - together with an undated leaflet - not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use. In **T 204/88** a letter of tender was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. In **T 482/89** (OJ 1992, 646) the board took the view that an unsigned delivery note, together with other documents, could constitute sufficient evidence of delivery.

In **T 162/87** and **T 627/88** it was decided that the statement made by an employee of the party alleging prior use could be sufficient. The statements of employees of one of the parties were also used in the above-mentioned decisions **T 124/88**, **T 482/89** (OJ 1992, 646), **T 830/90** (OJ 1994, 713), **T 838/92** and **T 327/91**, without any grounds for their credibility being given. The credibility of witnesses could not be impugned merely because they were related to one another and had a business relationship with one of the parties (**T 363/90**). In **T 937/93** it was stated that the probative value of the declarations of a witness depended on the circumstances of the particular case.

In **T 1191/97** the board thought the fact that the events at issue had taken place a long time ago could readily explain certain imprecisions in the witness's testimony. That applied in particular to the date of delivery of the prior-use item - which however was precisely established by other documentary evidence. The board saw no indication that the witness had been in breach of his obligation to testify to the best of his recollection.

In **T 970/93** the claims referred to a continuous multi-stand mill plant for producing steel plates. Two prior uses, a mill plant in China and a mill plant in Germany, were put forward by the opponents/appellants. A discussion developed on the subject whether the skilled person

would have been able to recognise the relevant feature, ie the rolling speed ratio of the mill plant in China, because such ratio could not be derived from a single rolling event. Furthermore, the respondent took the view that both the builders and the owners of the plant would impose confidentiality in order not to reveal the actual capacity of the mill, thus putting competitiveness at risk.

Following the principle of the balance of probabilities it was in the board's view very unlikely that in a period of almost seven years between the start of operations at the plant and the priority date of the patent in question, the mill drive motor speed ratio of the mill would not have become publicly available taking account of the following evidence and circumstances: it was common practice in China to promote and demonstrate newly-installed industrial plants as a means of instruction to young engineers. Considering that one of the main performance parameters of a mill was its "speed cone", such a skilled person would enquire about this parameter or work out the speed ratio of the stand himself by comparing the minimum and maximum speed of the mill rolls. In view of the instructional aspects it was not at all likely that secrecy would bar this information path for competitive reasons as supposed by the respondent. In the absence of any evidence as to confidentiality the principle also applied that the company that purchased the mill could be considered a member of the public which through the purchase of the mill and subsequent use thereof took possession of all the relevant information with respect to the rolling speed ratio.

In **T 905/94** the patent proprietor had exhibited a blind at an exhibition. After having considered the evidence regarding the exhibition the board looked at the question of whether use of the same trade name for different models could constitute evidence of the fact that the patent proprietor had marketed or described the blinds according to the patent at issue before the date of priority. In the board's opinion, such use could not constitute sufficient evidence since it was common practice in industry for the same name to be used and retained for a product, the technical characteristics of which changed over time as improvements were made. The board also emphasised that the fact that one witness had made his declaration three years earlier than other witnesses was not sufficient reason to make his testimony more credible.

To prove the alleged public prior use, in **T 212/97**, the appellants (opponents) had cited facts based on hearsay. The appellants' attention had been drawn several times to the inadequacy of the evidence for the alleged prior uses. They failed to cite any witnesses. However, where public prior use was alleged, opponents had to do everything they could to provide satisfactory evidence.

In **T 687/93** the board had to decide on the basis of some documents indicating the product number and its commercial name whether a resin composition had been made available to the public. The board was of the opinion that a manufacturer would at least change the code number identifying a product if this was modified in any way so that products bearing an unchanged code number, possibly in association with a trade name, could be assumed to be the same.

In **T 48/96** the board stated that, in order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not

sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody; for example, there could have been a delay. It therefore decided not to accept copies of pages from a catalogue bearing a date as sufficient proof of availability to the public.

In **T 970/93** the respondent had disputed the validity of all the evidence brought forward but mainly based its objection on the assumption that the evidence could have been falsified. The board held that such an allegation based solely on suspicion could not reasonably be expected to form a valid ground for casting doubt on the credibility of the evidence. It accepted them as valid evidence.

In **T 301/94**, the board confirmed that the principle of unfettered consideration of evidence applied to any kind of evidence submitted in these proceedings. Furthermore, the board stated that the probative value of a "déclaration sur l'honneur", the signature of which had been certified by a "notaire", depended on the particular circumstances of the case.

In **T 750/94** (OJ 1998, 32) the board held that in accordance with the principle of unfettered consideration of evidence items of evidence relevant to a matter at issue had to be given an appropriate weight in order to establish reliably what was likely to have occurred. An unsigned statement by an unknown and unnamed person should in principle be given minimal weight.

In national proceedings before the Dutch District Court and Court of Appeal, several witnesses were heard, and written statements were introduced from both parties. The Dutch Court of Appeal could not establish an uninterrupted chain of proof that the alleged public prior uses had indeed taken place before the priority date of the contested patent. After evaluating the Dutch Appeal Court's findings, the board's judgment in **T 665/95** was that no further investigations were necessary and that the conclusion of the Dutch Appeal Court could be followed, with the consequence that the subject-matter of the granted claim 1, contrary to the impugned decision of the opposition division, was considered to be novel.

5. Standard of proof

The facts on which the decision is based must have been established to the satisfaction of the deciding body. The question arises as to what degree of satisfaction is necessary. A substantial number of board of appeal decisions deal with this problem.

The boards of appeal generally apply the standard of the "balance of probabilities", ie they are satisfied on the basis that one set of facts is more likely to be true than the other. This applies particularly in opposition appeal proceedings, see inter alia **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**, **T 109/91**, **T 409/91**, OJ 1994, 653; **T 1054/92** of 20.6.1996, **T 296/93**, OJ 1995, 627, point 5.2 of the reasons; **T 326/93**, **T 343/95**. However, this standard is also applied in the decisions issued in ex parte proceedings, **T 381/87**, OJ 1990, 213; **T 69/86**, **T 128/87**, OJ 1989, 406; **T 939/92**, OJ 1996, 309.

In other cases (eg **T 100/97**) the board decided on the basis of circumstances of which it was

sufficiently certain.

In **T 1103/96** the board ruled that even if it was not possible to reconstruct exactly what had happened during oral proceedings before the first-instance department, so that the board had only circumstantial evidence on which to base its decision, the facts apparent from the file nonetheless suggested with a sufficient degree of certainty that the appellant's arguments regarding violation of the right to be heard were well founded.

A much stricter standard of proof is applied in some cases.

According to decision **T 750/94** (OJ 1998, 32), when an issue of fact is being examined and decided by the EPO on the balance of probabilities, the more serious the issue the more convincing must the evidence be to support it. If a decision on such an issue might result in refusal or revocation of a European patent, for example in a case concerning alleged prior publication or prior use, the available evidence in relation to that issue had to be very critically and strictly examined. A European patent should not be refused or revoked unless the grounds for refusal or revocation (that is, the legal and factual reasons) were fully and properly proved.

(a) Content of a disclosure

In **T 793/93** the relevant prior art document had failed to disclose explicitly something falling within a claim. The board held that availability within the meaning of Art. 54 EPC could still be established if the inevitable outcome of what was literally or explicitly disclosed fell within the ambit of that claim. In the board's view, a standard of proof much stricter than the balance of probability, to wit "beyond all reasonable doubt", needed to be applied. It followed that if any reasonable doubt existed as to what might or might not be the result of carrying out the literal disclosure and instructions of a prior art document, in other words if there remained a "grey area", then the case of anticipation based on such a document had to fail (see also **T 464/94**).

In **T 348/94**, the board held that it had not been proven beyond reasonable doubt that the technical contents of the oral presentation at the conference corresponded **in all details** to the relevant article published 10 months later in the conference proceedings. Unless there was proof to the contrary, a written publication, supposedly based on a paper previously read at a public meeting held some time earlier, could not be assumed to be identical to what was disclosed orally but might contain additional information (see also **T 890/96**).

In **T 838/97**, the board emphasised that there must be no doubt that the prior disclosure, as read by the skilled person, unambiguously corresponded in all its technical features to the subject-matter as claimed.

(b) Prior use

In **T 782/92**, the board took the view that public prior use had to be proved beyond any reasonable doubt. **T 472/92** (OJ 1998, 161) reaffirmed the approach of the balance of probabilities in normal cases, but made a distinction for cases of public prior use where

practically all the evidence in support of an alleged public prior use lay within the power and knowledge of the opponent. In such cases, the patentee seldom had any ready, or indeed any access to it at all. All he could, in practice, do was to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any gaps in the chain of commercial transactions that needed to be established by the opponent in order to succeed on this ground. The board stated that in such cases an opponent had to prove his case up to the hilt, for little if any evidence would be available to the patentee to establish the contradictory proposition that no public prior use had taken place (confirmed in **T 97/94** (OJ 1998, 467, reasons, 5.1) and **T 848/94**).

(c) Art. 123(2) EPC or R. 88 EPC, second sentence

The boards only allowed amendments or corrections if it was certain beyond any reasonable doubt that the subject-matter of the application had not been extended beyond that of the application as filed (**T 383/88**, **T 581/91**). When examining Art. 123(3) EPC the board laid down the principle in **T 113/86** that voluntary amendments requested by the patentee which were not necessitated by any of the grounds for opposition raised by the opponent or by the board should, in principle, not be allowed if there was the slightest doubt that the unamended patent could be construed differently to the patent as amended.

(d) Re-establishment of rights

In cases of re-establishment of rights it is usually ruled that, on the basis of the evidence furnished, the board is or is not satisfied that the facts adduced to substantiate the application for re-establishment of rights are true. In **T 243/86** and **T 13/82** (OJ 1983, 411), a request was made for "Glaubhaftmachung" (ie that the facts on which the application relies be set out) in accordance with Art. 122(3) EPC, first sentence. Whether this term signifies - as in German, Austrian or Swiss law - that a lower degree of probability is sufficient has not yet been decided.

(e) Disciplinary matters

In **D 5/86** (OJ 1989, 210), the board held that an infringement of the rules of professional conduct had to be established to the satisfaction of the disciplinary body before it could impose a disciplinary measure. Absolute certainty was not required, but a degree of probability which in human experience verged on certainty. A disciplinary measure could not be imposed if there was reasonable doubt as to whether the infringement had occurred.

(f) Opposition on behalf of a third party

In **G 3/97** (OJ 1999, 245) and **G 4/97** (OJ 1999, 270) the Enlarged Board of Appeal held that if the person named as opponent according to R. 55(a) EPC is acting on behalf of a third party, such an opposition is inadmissible only if the involvement of the opponent is to be regarded as circumventing the law by abuse of process. The deciding body had to be satisfied on the basis of clear and convincing evidence that the law had been circumvented by abuse of process.

6. Burden of proof

6.1 Unprovable facts

If a material fact is not or cannot be proven, a decision is taken on the basis of who carries the relevant burden of proof: the fact that the real position cannot be established operates to the detriment of the party which carries the burden of proof for this fact. The EPC contains no explicit provisions in this respect. However, a few principles can be inferred from board of appeal practice.

According to **T 200/94** (following established case law), if a board's investigations did not enable it to verify beyond reasonable doubt the facts alleged, this went to the detriment of the party needing to prove them, ie the party who relies on these facts.

In **ex parte proceedings** the applicant bears the burden of proof for the facts in his favour, eg the fact that a document cited by the examining division does not form part of the state of the art (**T 160/92**, OJ 1995, 35), the fact that the conditions laid down in Art. 123 EPC have been met (**T 383/88**) or the fact that a limitation of the claims is admissible (**T 2/81**, OJ 1982, 394).

In **T 32/95** the board found that once the applicant showed sound reasons for doubting whether a cited document belonged to the state of the art, the examiner should act as recommended in the Guidelines C-IV, 5.2, ie when any further investigation did not produce evidence sufficient to remove that doubt, not pursue the matter further.

With regard to **opposition proceedings**, the principle was laid down in **T 219/83** (OJ 1986, 211, Corr. OJ 1986, 328) that the patent proprietor is given the benefit of the doubt if the parties make contrary assertions regarding facts barring patentability which they cannot substantiate and, furthermore, the EPO is unable to establish the facts of its own motion (see also **T 293/87**, **T 459/87**). In appeal proceedings, the party's status as opponent makes no difference when it comes to assigning the burden of proof (this follows eg from **T 740/90** and **T 270/90**, OJ 1993, 725; **T 381/87**, OJ 1990, 213). If the opponent disputes eg the existence of an inventive step, he bears the burden of proof in this respect at first and second instance (see **T 382/93**).

These principles were confirmed with regard to non-reproducibility of the invention *inter alia* in **T 16/87** (OJ 1992, 212) and **T 182/89** (OJ 1991, 391).

In **T 1003/96**, the board confirmed that in case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (see decisions **T 230/92**, **T 345/86**, **T 601/91**, Reasons 5.2.6, and **T 968/91**).

In **T 547/88** inventive step was contested. Although the board had asked the parties to issue a joint protocol stating what tests had to be done and under what conditions, each party in fact conducted his own experiments and obtained contradictory results. It was therefore not possible for the board, on the basis of these tests, to conclude definitively that no inventive step was involved. The board held that in such a case the patent proprietor should be given

the benefit of the doubt with regard to the relevance of the claimed features to the problem to be solved. Moreover, since the prior art did not suggest the subject-matter of the contested claims, that subject-matter implied an inventive step. The patent was therefore maintained.

In **T 254/98**, the appellant (patentee) provided no proof for the contention that it was not within its power to obtain counter-evidence from the firm in question. The board pointed out that a party could not relieve itself of the burden of providing counter-evidence for facts it alleged by simply referring to **T 472/92** (OJ 1998, 161) and stating that all the evidence was within the power of its adversary, without bringing proof that not he but only the Respondent was able to collect the evidence in support of the respective contention.

Questions relating to the allocation of the burden of proof can also arise in connection with **procedural questions**.

In **J 10/91** the board held that if a letter, and attached cheque in payment of a fee, had been lost without further evidence or high probability that it had been lost in the EPO, the risk was then borne by the sender.

In **T 632/95** the board confirmed that the burden of proving that a document had been received lay with the party submitting the document just as, vice versa, the EPO bore the burden of proving receipt of the documents it issued.

In **J 8/93**, the board confirmed that even conclusive evidence that something had been posted could not be treated as sufficient to prove that a document had been received by the EPO. If the post failed to deliver a document, the applicant would suffer the consequences for failing to file that document.

If a party relied on the fact that there was a general legal maxim along the lines of Art. 125 EPC, according to which his appeal would have to be allowed (in the case in question: the principle whereby decisions of a court of final jurisdiction could be set aside in the event of serious procedural errors), he would have to produce evidence that such a procedural principle existed in most EPC contracting states (**T 843/91**, OJ 1994, 832).

In **T 833/94** the board held that, when the evidence offered does not directly indicate the truth or falsity of the fact in issue, but requires knowledge of the national law and patent practice, such law and practice has to be proved as does any other fact on which a party bases its arguments.

According to the German version of R. 78(2) EPC, second sentence, (formerly R. 78(3) EPC), the EPO must in a case of doubt, "im Zweifel", establish the date on which the letter was delivered to the addressee. In **T 247/98** the board decided that, when establishing the meaning of the term "im Zweifel" in the German version of R. 78(2) EPC, account should be taken of the French and English versions, which assumed that there was a dispute ("en cas de contestation", "in the event of any dispute").

From the general principles concerning the burden of presentation which fell on the parties, it followed that a party seeking the application of a legal provision favourable to its interests

had to set out the facts justifying such application, even if it did not ultimately bear the burden of proof for those facts. Although, in the event of a dispute within the meaning of R. 78(2) EPC, the burden of proof for the date of delivery fell on the European Patent Office, this could not be taken to mean that a party wishing to rely on the late delivery of a letter from the Office had no obligation to contribute to the clarification of circumstances within its own sphere of activity but could sit back, as it were, and wait to see whether the Office succeeded in ascertaining when the letter had been delivered to the party. A dispute ("Zweifel" in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting.

Having regard to the above, in the case in point the mere absence from the file of the advice of delivery and of the receipt from the appellants' then representative did not constitute a sufficient basis for a dispute ("Zweifel" or "contestation") under R. 78(2) EPC over whether the decision had been delivered to the appellants' then representative within ten days of despatch. It was generally known that advice of delivery notes, and receipt notes, were not always sent back to the Office; therefore, the fact that they were missing from the file did not necessarily mean that a delivery error had occurred. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ("Zweifel") within the meaning of this Rule.

At all events, in proceedings before the EPO, facts which related to a party's own actions or were the subject of a party's own perceptions could not be denied on the ground of "ignorance" by that party if the presentation of the facts in question was essentially the party's responsibility.

6.2 Shifting of the burden of proof

In the case law of the boards of appeal the term "burden of proof" is also used in another sense: if a party has achieved a favourable decision at first instance or has already produced convincing proof of the facts alleged by it, then the burden of proof shifts to the other party i.e. the party must now disprove or at least negate this evidence in order to achieve a decision in its favour.

In **T 270/90** (OJ 1993, 725) it was pointed out that each party carried the burden of proof for the facts it alleged. If one party furnished convincing proof of the fact it had alleged, the burden of proof for the other party's contrary assertion shifted to the latter. In **T 109/91** the board held that the burden of proof might shift constantly as a function of the weight of the evidence. This was confirmed in many decisions (see eg **T 525/90**, **T 239/92**, **T 838/92**).

In **T 954/93** the appellant/opponent had put forward objections to the patent on the basis of lack of novelty, which would have had to be demonstrated by means of experiments. He had not however carried out any tests on the ground that they would have been very expensive. The board considered the allegation unproven and refused to reverse the burden of proof. The fact that experiments would have been very expensive did not shift the burden of proof onto the patent proprietor.

In **T 743/89** the board applied the principle of prima facie evidence. Here, it had been proved

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

In **T 585/92** (OJ 1996, 129) the board held that in opposition proceedings the burden of proving that the objections raised under Art. 100 EPC have been substantiated lay with the opponent. However, once the opposition division had decided to revoke the patent, the burden shifted to the proprietor of the patent, who had to demonstrate on appeal that the reasons for revoking the patent were not sound, ie that the opposition division's decision was wrong as to the merits.

Questions relating to the shifting of the burden of proof can also arise in connection with procedural questions.

According to **T 128/87** (OJ 1989, 406) a party presenting a cheque to the EPO bears the burden of proof for its receipt by the EPO. If the EPO denies receiving a document, but the party furnishes proof that it was filed, according to **T 770/91** and **J 20/85** (OJ 1987, 102) the EPO carries the burden of proof for its allegation that it did not receive the document.

K. Representation

1. The list of professional representatives under Article 134(1) EPC

Art. 134(1) EPC stipulates that professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. The requirements for such entry are laid down in Art. 134(2) EPC.

Persons whose name appears on the list of professional representatives (Art. 134(1) EPC) and who have passed the European qualifying examination (Art. 134(2)(c) EPC) possess scientific or technical knowledge, because under Art. 10(1) REE 1994 (OJ 1994, 7) evidence of such knowledge is a condition for admission to the examination. Practically all persons entered on the list under the special provisions of Art. 163 EPC may also be assumed to possess such knowledge. The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters (**D 14/93**, OJ 1997, 561).

In **J 1/78** (OJ 1979, 285) the appellant was entered on the list of professional representatives before the EPO under the letter "V" as "von F., A.". The object of his appeal was to obtain a ruling which would enable him to be entered under the letter "F" as, for example, in the telephone directory. The decision found that the entry was made in accordance with the principles laid down by the President of the EPO whereby the full surname must be entered in alphabetical order. Under German law, former titles of nobility ("von") form part of the

surname. The board noted that the purpose of entry on the list was to confer upon the person whose name was entered the right to appear in the European patent grant procedure. A distinction had to be made between entry for the purposes of conferring a right and publication of the list, which latter was not prescribed in the EPC. The EPO issues a directory from time to time for the purposes of meeting public demand for information. In this directory, the person entered on the list could be allowed an additional entry under another letter should he so desire.

2. Representation before the EPO of applicants not having residence or place of business within a contracting state

Art. 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing the European patent application (see **T 451/89** and **T 883/90**); the Implementing Regulations may permit other exceptions.

In **T 213/89** the Japanese inventor replied directly to the EPO with a set of revised application documents, and accompanied by a letter to his representative indicating that the revised documents had also been sent to the representative. The board noted that no confirmation by the representative was received that any of the submissions directly received from the inventor should be regarded as an official reply to the Office action. Since persons not having a residence or their principal place of business within the territory of one of the contracting states must act through their representative in the proceedings, the said submissions received direct could not be taken into account.

3. Professional representatives during the transitional period under Article 163(6) EPC

One of the conditions for including a professional representative on the EPO list is that he has passed the European qualifying examination (EQE). During a transitional period after the EPC first entered into force, this requirement could be waived under the conditions laid down in Art. 163 EPC (see **J 19/89** (OJ 1991, 425), **J 10/81**). For all states belonging to the EPC since the beginning, this period ended on 7.10.1981 (decision of the Administrative Council dated 6.7.1978, OJ 1978, 327). After that date, under Art. 163(6) EPC, a person with his place of business or employment in a state newly acceding to the EPC may, during a period of one year as from that state's accession, be added to the list under the conditions laid down in Art. 163(1) to (5) EPC, ie without having to pass the EQE.

The reunification of Germany posed its own problems, in **J 18/92**, **J 30/92**, **J 31/92**, **J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) EPC should be applied to patent attorneys, even where they had qualified in West Germany and not the former GDR. In the board's view, Art. 163(6) EPC could only be applied by analogy to those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West. The board held that it would be strange if those who were admitted as patent

agents in a contracting state were able to become authorised representatives without having to pass the examination merely by way of analogy with people working in a country which had just become a member. The appeals were accordingly dismissed.

4. Legal practitioners entitled to act as professional representative under Article 134(7) EPC

4.1 Introduction

Under Art. 134(1) EPC, professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on the above list. However, Art. 134(7) EPC provides that professional representation in such proceedings may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the contracting states and having his place of business within such state, to the extent that he is entitled, within the said state, to act as a professional representative in patent matters. The arrangements for legal practitioners set out in Art. 134(7) EPC constituted therefore an exception.

In **J 19/89** (OJ 1991, 425) it was observed that despite all the differences in the designations and career backgrounds of the persons included in the ranks of legal practitioners, the profession had developed on an essentially equal footing in the contracting states as a result of Europe's common legal history and shared legal culture. The board noted that the last clause of Art. 134(7) EPC, first sentence, was necessary, because under national law even an actual legal practitioner might be precluded to some degree from acting as a professional representative in patent matters. That clause prevented a "Rechtsanwalt", "legal practitioner" or "avocat" from having more extensive powers of representation before the EPO than he was entitled to before his national patent office. Art. 134(7) EPC was therefore a special rule limited in scope to the corpus of legal practitioners, which existed under various designations in all the contracting states. Members of the profession of Rechtsanwalt and comparable professions in the contracting states were entitled under Art. 134(7) EPC to act as professional representatives before the EPO, not by virtue of their status as individual Rechtsanwälte but by virtue of the institution of the profession of Rechtsanwalt as such.

4.2 Register of legal practitioners

The register of legal practitioners must be clearly distinguished from the **list of professional representatives** established in accordance with Art. 134(1) to (4) EPC. Whereas according to Art. 134(4) EPC, the entry of a person's name in the list of professional representatives entitles them to act in **all** proceedings established by the EPC, the EPC does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not general, but depends directly on their complying with the provisions of Art. 134(7) EPC (**J 27/95**).

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters; it would be jeopardised if legal practitioners without such qualifications were included on the list. Accordingly, the conditions for entry on the list of professional representatives under Art. 134(2) EPC also applied to legal

practitioners (**D 14/93**, OJ 1997, 561).

According to the practice of the EPO, legal practitioners who indicate their intention to undertake representation in proceedings before the EPO and present an authorisation are entered in a register of legal practitioners, provided that they comply with the requirements of Art. 134(7) EPC. The Legal Division is responsible for checking these requirements and for the registration of names in, or deletion from, the register of legal practitioners (see decision of the President dated 10.3.1989 concerning the responsibilities of the Legal Division, point 1.1(c), OJ 1989, 177) (**J 27/95**).

4.3 Precise meaning of Article 134(7) EPC

In **J 19/89** (OJ 1991, 425), the Legal Board of Appeal considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC and hence be authorised to act before the EPO. The board decided that irrespective of his specialist qualifications and powers of representation in national patent matters, a **patent attorney** under national law could not be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC, and therefore was not entitled to act as a professional representative before the EPO (see also **D 14/93** (OJ 1997, 561)).

In **J 27/95** the appellant, a Spanish citizen, requested to be recognised as a legal practitioner within the meaning of Art. 134(7) EPC and to be allowed to undertake professional representation in proceedings established by the EPC. According to the decision of the Legal Division, Art. 134(7) EPC only applied to legal practitioners entitled to act as representatives before their national patent offices by virtue of the exercise of the profession of legal practitioner "as such". However, according to the Legal Division, in Spain legal practitioners were not as such entitled to act as representatives in patent matters. In the statement of grounds filed by the appellant, it was contended inter alia that the wording of Art. 134(7) EPC did not contain any limitation to legal practitioner "as such". In Spain the registration as "Agente de la Propiedad Industrial" was a pure formality completed within one afternoon on production of evidence of the requisite university degree.

The Legal Board of Appeal first made it clear that the competence of legal practitioners to undertake representation before the EPO depended directly on their complying with the provisions of Art. 134(7) EPC. Thus, each time a legal practitioner made a request to act as a professional representative in proceedings before the EPO, the Legal Division had the right to examine whether he or she satisfied the conditions under Art. 134(7) EPC. If such a request was refused, it could be refiled and reconsidered on the basis of new facts at any time.

In its decision the board pointed out that according to Art. 134(7) EPC a legal practitioner qualified in a contracting state had to have "his place of business in such State". The board noted that in all three languages of the EPC the expression "his place of business" (in contrast to "a place of business") was used. The board stated that this formulation made it clear that the place of business within the meaning of Art. 134(7) EPC was the place (if any) at which a person practised his or her profession as legal practitioner. However, the only

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evidence before the board was the registration of an address in Spain which could not be accepted as proof of a place of business within the meaning of Art. 134(7) EPC. Therefore, in the absence of any evidence that the appellant had a place of business in Spain within the meaning of Art. 134(7) EPC, the board had to reject the appeal. In these circumstances it was neither necessary nor appropriate for the board to consider the further issues on which the decision of the department of first instance was based.

4.4 Limits to the entitlement of legal practitioners

In **D 14/93** (OJ 1997, 561) the Disciplinary Board of Appeal noted that persons whose name appeared on the list of professional representatives (Art 134(1) EPC) and had passed the European qualifying examination possessed scientific or technical knowledge, because under Art. 7(1)(a) REE 1991 (now Art. 10(1) REE 1994) evidence of such knowledge was a condition for admission to the examination. Legal practitioners on the other hand did not normally possess the scientific or technical knowledge required with a view to activities pertaining to European patent applications and patents. The board held that a legal practitioner did not have the same entitlement as a professional representative to train candidates under Art. 7(1)(b)(i) REE (now Art. 10(2)(a)(i) REE 1994). The training of candidates under Art. 7(1)(b) REE 1991 (now Art. 10(2) REE 1994) did not constitute "proceedings established by the EPC" within the meaning of Art. 134(7) EPC. The training period pursuant to Art. 7(1)(b) REE 1991 for enrolment for the European qualifying examination could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said legal practitioner was also a patent attorney under national law.

5. Procedural steps performed by a person other than the representative in charge

In **J 28/86** (OJ 1988, 85) the Legal Board of Appeal held that a request for examination filed by a person who was not entitled to act as a representative in accordance with Art. 134 EPC was invalid. The board noted that the situation did not change because the representative had later been entered on the list of professional representatives. In this capacity he had neither approved nor resubmitted the invalid request he had made earlier.

In **J 32/86** the board held that the mere appointment of a professional representative to meet the requirement of Art. 133(2) EPC (the appellant had his residence in the USA) did not automatically have the legal effect of validating acts previously performed by an applicant himself. The EPO was however obliged to give the representative a fair chance to remedy any deficiency of this kind that might have occurred before his appointment and which could still lawfully be remedied by him.

In decision **T 665/89** the board addressed the question of the admissibility of an opposition by an opponent whose residence was in a contracting state, where the notice of opposition was signed by a person who was neither a professional representative (Art. 134(1) EPC or Art. 134(7) EPC) nor an employee of the opponent (Art. 133(3) EPC). The board of appeal concluded that the actions of the unauthorised person ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent made up for the missing correct signature at the EPO's invitation within the time limit laid down. The

document thus retained the original date of receipt in accordance with R. 36(3) EPC, third sentence.

6. Authorisations for appointment of a representative

6.1 Filing of the authorisation

R. 101(4) EPC stipulates that if the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken (see **T 355/86**).

R. 101(4) EPC attaches particular importance to formal clarification of the legal relationship between the entitled person and the representative, especially as regards the applicant/representative situation. In **T 10/82** (OJ 1983, 407) the person who gave his name as opponent was a professional representative within the meaning of Art. 134 EPC. The board held that a professional representative, within the meaning of Art. 134 EPC, was not entitled to give his own name as opponent when acting for a client. Thus, the opposition was inadmissible.

In **J 12/88** it turned out that the former representative of the appellant had acted before the EPO on behalf of the appellant without being instructed to do so and using a forged authorisation. The board considered all these proceedings to be null and void. There had never been a valid European patent application before the EPO. All fees paid to the EPO on behalf of the appellant were never due and had to be reimbursed.

In **T 850/96** the appellant had alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorization. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorization.

In the case under consideration both signatories of the notice of opposition were professional representatives. The board held that Art.1(1) of the decision of the President of the EPO of 19 July 1991 (OJ 1991, 489) stipulates that a professional representative whose name appears on the list maintained by the European Patent Office **and who identifies himself as such** shall be required to file a signed authorization only in the circumstances set out in paragraph (2) and (3) of Art.1 of this decision of the President. In the present case, the deficiency had not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives.

In the case in point, the signatories of the notice of the opposition referred to their being professional representatives when the opposition division invited them to file an authorisation. The opposition division was satisfied with this reply. Contrary to the appellant's allegations no time limit was prescribed as to when such identification as professional representative must take place. Therefore, it could be done after the filing of the notice of opposition. Therefore, contrary to the appellant's allegations R. 101(4) EPC prescribing that if the authorization was not filed in due time the procedural steps taken by the representative be

deemed not to have been taken, did not apply in the present case, with the consequence that the notice of opposition had to be considered duly filed.

6.2 Appointment of a common professional representative

In **J 35/92** the first-named of two individual joint applicants had transferred his rights in the application to a company, which had appointed another representative who had then purportedly withdrawn the application. The second applicant did not agree with the withdrawal. The department of first instance held that the company was entitled unilaterally to withdraw the application by virtue of R. 100(1) EPC, according to which the first-named applicant could be regarded as the representative of both, but the board of appeal disagreed. R. 100 EPC applied only where no joint professional representative had been appointed, whereas in the case in question the original applicants had appointed a representative, who continued to act for the second applicant. The board therefore concluded that the purported withdrawal of the application by the first-named applicant was invalid. The parties were given two months to appoint a joint professional representative, failing which one would be appointed by the EPO.

In **J 10/96** the Legal Board of Appeal ruled that where several applicants were represented jointly by a professional representative, who during the course of proceedings ceased to represent his clients, the correct procedure to be followed was that contained in R. 100(2) EPC, second sentence, according to which the applicants were to be requested by the EPO to appoint a common representative within two months. If this request was not complied with, the EPO was empowered to appoint the common representative.

6.3 General authorisations

In **J 11/93** under R. 69(2) EPC the applicant formally applied for a decision on the finding that his application was deemed to be withdrawn. He submitted in his statement of grounds of appeal that the official communication under R. 85a(1) EPC should have been sent to the authorised European representative since he had been duly empowered to act on behalf of the applicant by a general authorisation filed with the EPO in respect of another European patent application. Instead of this the communication was sent directly to the applicant, a US company.

The board observed that the usual form recommended for general powers had not been used and nothing in the document filed with the co-pending application allowed the Receiving Section to infer that the applicant intended said document to be regarded as a general power rather than a specific one. The board confirmed that the authorisation in suit had never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication pursuant to R. 85a(1) EPC to the applicant at its last known address, rather than to the representative. Under these circumstances the board considered that when the letter pursuant to R. 85a(1) EPC sent directly to the applicant was issued no European professional representative had yet been appointed by the applicant. Hence the provisions of R. 81 EPC, according to which - if a representative (ie a European one) had

been appointed - notifications were to be addressed to him, could not apply but consequently only those of R. 78(2) EPC (version as in force up to 31.12.1998) relating to notifications in respect of addressees not having either a residence or place of business in one of the contracting states and who had not appointed an authorised representative.

In **J 17/98** the Legal Board of Appeal needed to rule on whether communications concerning the deemed withdrawal of applications had been correctly notified to the applicants, who were residents of a non-EPC contracting state, even though general authorisations were held by the EPO on their behalf. The applicants argued that the communications relating to deemed withdrawal should in fact have been notified to the representatives appearing in the general authorisations on file with the EPO. The Board held that the filing of a general authorisation to act on behalf of a specific applicant and the notification of the appointment of a representative in an individual application were two separate procedural acts. By definition, general authorisations did not refer to specific cases and did not allow the EPO to assume, without further information from the applicant, that a specific representative had been appointed in a particular case. From the Convention it was clear that the filing of a general authorisation did not imply the appointment of a professional representative in a specific case. In such clear cases directly following from the provisions of the Convention the principle of the protection of legitimate expectations did not require the EPO to issue comprehensive legal advice extending beyond the form in question, provided it was in itself clear and unambiguous.

6.4 Sub-authorisations

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 EPC was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

6.5 Authorisation of an association of representatives

In **J 16/96** (OJ 1998, 347) the EPO Legal Division had informed a company X that its patents department could not be registered as an association of representatives. Such an association meant one consisting solely of professional representatives in private practice. This was clear from the "Communication on matters concerning representation before the EPO" (OJ 1979, 92). Since the members of a company's patent department were not in private practice, they could not be registered as an association. In its decision, the Legal Division explained that the interpretation of the term "association of representatives" was based on a 1978 decision by the Administrative Council of the EPO regarding the interpretation of R. 101(9) EPC.

The board examined whether such Council decisions were binding on the boards of appeal. It pointed out that under Art. 23(3) EPC board members were not bound by instructions and were required to comply only with the EPC. Neither in formal nor in practical terms, therefore, could a Council decision on the interpretation of an EPC rule be binding on them. For the purpose of interpreting R. 101(9) EPC, the Council's decision had to be set alongside the general rule of interpretation laid down in Art. 31(1) of the Vienna Convention on the Law of Treaties.

The board concluded that there was no basis in the EPC for the Office's practice of restricting R. 101(9) EPC to professional representatives "in private practice". An association within the meaning of that provision could therefore also be formed by professional representatives not in private practice. This interpretation of R. 101(9) EPC was consistent with the EPC's general aim, as stated in its preamble, of providing protection for inventions in the contracting states by a single procedure for the grant of patents. As noted when it was first introduced, R. 101(9) EPC was to be applicable in various countries, with differing national legal provisions and traditions, where representatives had often pooled their resources by forming some kind of association, such as a firm. This was why it had been reworded, and the original terms "partnership" and "Sozietät" replaced with more general ones: "association of representatives" and "Zusammenschluss von Vertretern". The French term "groupement de mandataires" had remained unchanged (see CI/GT VI/166d/77 of 20.4.1977). In view of this, there was no reason to interpret the term "association of representatives" in a way which limited its meaning.

7. Oral submissions by an accompanying person

7.1 General

In **J 11/94** (OJ 1995, 596), the Legal Board of Appeal referred the question to the Enlarged Board of Appeal of whether a board of appeal could exercise discretion in deciding whether or not a person not entitled under Art. 134(1) and (7) EPC to represent parties to proceedings before the EPO could make submissions during oral proceedings in addition to the pleadings by the professional representative, and if such discretion existed which criteria the board had to observe when exercising it.

The Enlarged Board of Appeal also had to decide on a question referred to in decision **T 803/93** (OJ 1996, 204). This question was whether, and if so in what circumstances, a person other than the professional representative (that is, an accompanying person) may make oral submissions on behalf of that party concerning either legal or technical issues, during oral proceedings under Art. 116 EPC before an opposition division or a board of appeal. This question went beyond the circumstances of **J 11/94**, which concerned ex parte proceedings involving only legal issues.

The Enlarged Board gave its answer in two decisions, **G 2/94** (OJ 1996, 401) referring to **J 11/94**, and **G 4/94** (OJ 1996, 412) occasioned by **T 803/93**.

In **G 4/95** (OJ 1996, 412) the Enlarged Board noted that the appointment of a professional representative by a party involved the authorisation and identification of the professionally qualified person who was responsible for the presentation to the EPO of all submissions made by the party. Such presentation of a party's case was the essential core of the function of a professional representative under Art. 133 EPC. During oral proceedings, a professional representative was expected to present the entire case of the party that he or she represented.

The Enlarged Board considered separately the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand.

Representation

As to the presentation of facts or evidence by an accompanying person, the Enlarged Board held that such oral submissions during oral proceedings - in addition to the complete presentation of the party's case by the professional representative - are not excluded under the EPC. They may be allowed under the overall discretionary control which the EPC gives to the EPO with respect to the filing of facts and evidence.

As to the question whether an accompanying person may make oral submissions during oral proceedings by way of argument, the Enlarged Board pointed out that Art. 133 EPC made no distinction between written and oral proceedings in connection with the requirements for representation. Thus a professional representative was responsible for all written and oral submissions made on behalf of the party who had appointed him. However, in the context of the **written procedure** provided under the EPC for oppositions and opposition appeals an appointed professional representative could submit additional documents signed by a third person (for example a professor of law or science). Provided that they were submitted under the responsibility and control of the professional representative, they did not have to be excluded from consideration in the proceedings in which they were filed. Similarly, during **oral proceedings** under Art. 116 EPC in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party was not excluded from making oral submissions in relation to either legal or technical issues on behalf of that party to the proceedings under the control of the professional representative, and in addition to the complete presentation of the party's case by the professional representative.

The Enlarged Board further held that such oral submissions could not be made as a matter of right, but only with the permission of and at the discretion of the EPO. It decided that, if during oral proceedings before either an opposition division or a board of appeal a party wished that, in addition to the complete presentation of its case by its professional representative, oral submissions should be made on its behalf by an accompanying person, the admissibility of such additional oral submissions was a matter for the discretion of the EPO, bearing in mind in particular the nature and timing of each individual request for the making of such additional oral submissions, and the intended subject-matter of such oral submissions. The following **criteria** should be considered by the EPO when exercising its discretion:

- (i) the professional representative should request **permission** for such oral submissions to be made. The request should state the name and qualifications of the accompanying person and should specify the subject-matter of the proposed oral submissions.
- (ii) The request should be made sufficiently in advance of the oral proceedings so that all opposing parties were able properly to prepare themselves in relation to the proposed oral submissions.
- (iii) A request which was made shortly before or at the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party agreed to the making of the oral submissions requested.
- (iv) The EPO should be satisfied that oral submissions by an accompanying person were made under the continuing responsibility and control of the professional representative.

In **G 2/94** (OJ 1996, 401) the Enlarged Board made clear that there was no difference as a matter of principle between the admissibility of such oral submissions in ex parte proceedings and in inter partes (opposition) proceedings, and that this matter had been fully considered in the context of opposition proceedings in decision **G 4/95** (OJ 1996, 412). The Enlarged Board noted that it was important that the board should control the proceedings. The board should exercise its discretion in accordance with the circumstances of each individual case. The main criterion to be considered was that the board should be fully informed of all relevant matters before deciding the case. The board should be satisfied that the oral submissions were made by the accompanying person under the continuing responsibility and control of the professional representative.

In **T 334/94** the board emphasised that for a legal or technical expert to be allowed to make submissions at oral proceedings on behalf of a party and under the control of that party's representative, certain criteria relating to Art. 113(1) EPC had to be fulfilled. **G 4/95** had ruled that the party wanting such submissions to be made had to ask permission sufficiently in advance of the oral proceedings to give the other parties time to prepare. Only in exceptional circumstances should the EPO allow such a request if made just before the date of the hearing, unless all the other parties agreed. The board noted that the Enlarged Board had not defined what "sufficiently in advance" meant, or laid down a deadline for making such requests. In its view, the **deadline of one month** before the proceedings for filing submissions or new sets of claims was a minimum. On that basis, nominating an accompanying expert one week before the proceedings was not acceptable.

In **T 621/98** the board was faced with the question during oral proceedings of whether the patent proprietor, who was professionally represented, needed to announce in advance his intention to make submissions during the proceedings, pursuant to **G 4/95** (OJ 1996, 412). The board ruled that the patent proprietor was a party to the proceedings and as such was not to be treated as an accompanying person. As a party to the proceedings he had a right to take part in them.

7.2 Oral submissions by former members of the boards of appeal

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chairman of the Legal Board of Appeal who had retired about a year and a half previously. The professional representative requested permission for the former board member to make submissions in addition to his own arguments. The case referred to the Enlarged Board therefore encompassed the question whether special criteria applied to the exercise of a board's discretion in relation to a request for the making of additional oral submissions by a former board of appeal member.

The Enlarged Board noted in **G 2/94** (OJ 1996, 401) that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in the context of national judicial systems where it was clear that persons accepting appointments as judges were subject to restrictions if they wished to work in private

legal practice after having served as judges. The existence of such restrictions reflected the generally recognised principle of law that parties to legal proceedings were entitled to a fair hearing before judges who could not reasonably be suspected of partiality. It concluded that the above potential conflict had to be resolved in the direction of avoiding any suspicion of partiality during the conduct of proceedings before the EPO. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interests of former board of appeal members who wished to make oral submissions on behalf of parties to the proceedings.

It was therefore necessary to place **restrictions** on the admissibility of such oral submissions, at least for a reasonable period of time following termination of a person's appointment as a member of the board of appeal. In the absence of specific legislation, the point in time following termination of his or her appointment after which a former member of the boards of appeal might make oral submissions in proceedings before the board of appeal, was **a matter within the judicial discretion** of the boards of appeal. The Enlarged Board found that during either ex parte or inter partes proceedings, a board of appeal should refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, unless it was completely satisfied that **a sufficient period of time** had elapsed following termination of such former member's appointment to the boards of appeal, so that the board of appeal could not reasonably be suspected of partiality in deciding the case if it allowed such oral submissions to be made.

The board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least **three years** have elapsed following termination of the former member's appointment to the boards of appeal. After three years have elapsed, permission should be granted except in very special circumstances. Before the expiry of three years, there would normally be too great a risk that the public would consider the making of such submissions in oral proceedings to give an unfair advantage to the party on whose behalf a former member appeared.

7.3 Oral submissions by qualified patent lawyers of non-EPC contracting states

Another question of law decided in **G 4/95** above was whether, having regard in particular to the provisions of Art. 133 EPC and Art. 134 EPC, a person who was not qualified in accordance with Art. 134 EPC but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party's case as if he were qualified under Art. 134 EPC. The Enlarged Board decided that no special criteria applied to the making of oral submissions by qualified patent lawyers of countries which were not contracting states to the EPC. The criteria set out above were equally applicable to such patent lawyers.

8. Distinction between presentation of facts and evidence and presentation of arguments

In **G 4/95** the Enlarged Board noted that the distinction between the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand, was of basic importance under the EPC. It noted, as discussed in decision **T 843/91** (OJ 1994, 818),

a practice developed in the boards of appeal "to allow contributions by experts under the control of the authorised representative when it considers it would be useful for the good understanding of the case", thus mirroring the practice within the opposition division. In decision **T 843/91** it was suggested that the legal basis for admitting such oral submissions by "experts" was Art. 117 EPC. In this connection, the Enlarged Board did not accept that Art. 117 EPC provided a legal basis for hearing oral submissions by an accompanying person involving the presentation of facts and evidence, as was suggested in decision **T 843/91** for example. Art. 117 EPC and its Implementing Rules, R. 72 to 76 EPC, are solely concerned with setting out the procedure relevant to formal "taking of evidence". Such procedure necessarily involved as a precondition for its use the making of a decision to take evidence in the sense of Art. 117 EPC, and such decision had to set out all the matters prescribed in R. 72(1) EPC, as the first stage in the procedure.

L. Decisions of EPO departments

1. Right to a decision

Pursuant to R. 69(1) EPC, the EPO, if it notes that the loss of any rights results from the EPC, must communicate this to the party concerned. If the party disagrees with the finding of the EPO it may apply for a decision on the matter by the EPO (R. 69(2) EPC) or it may request further processing or re-establishment of rights, as the case may be (**J 14/94**, OJ 1995, 824).

The right to a decision after notification of loss of rights is a substantial procedural right which cannot be ignored by the EPO. A party who applies for a decision under R. 69(2) EPC is entitled to receive one. If the correctness of a notification of loss of rights under R. 69(1) EPC is challenged, the EPO has a duty to reply within a **reasonable period of time** having regard to the subject-matter of the communication (see **J 29/86**, OJ 1988, 84; **J 34/92**).

In **J 7/92** the board stated that although it would be preferable for the EPO to issue a communication under R. 69(1) EPC quickly, it could not be blamed for having done so in the present case over seven months after expiry of the period of grace. The EPC did not provide that the EPO should note the loss of rights mentioned in R. 69(1) EPC within a certain period. Nor did it provide any period of time for the ensuing communication. The EPO could not be required to keep a permanent and close eye on every file so as always to act as quickly as possible in order to preserve all the applicant's rights. However, when the EPO had to handle incoming requests or documents containing clear deficiencies which were obviously easy to correct and could be expected to be remedied within the time limit to avoid a loss of rights, then the question might arise whether - depending on the case - the principles of good faith governing the relations between the parties and the EPO did not demand that the EPO should not fail to draw attention to such deficiencies (see chapter on "The principle of the protection of legitimate expectations", p. 251).

In **J 43/92** the board noted that a decision pursuant to R. 69(2) EPC could only validly be applied for in the circumstances defined in R. 69(1) EPC. Thus, it was a necessary condition for such an application that the EPO previously noted the loss of a right resulting from the EPC without any decision and communicated this to the party concerned. Otherwise, there

was no basis for the EPO to give a decision pursuant to R. 69(2) EPC. The Board further noted that R. 69(1) EPC did not prescribe any particular form for the communications provided therein distinguishing them from other communications or notifications under the EPC. Even if, according to the Legal Advice No. 16/85, OJ 1985, 141, communications in which the EPO noted the loss of any right normally contained a reference to the time limit for an application for a decision on the matter under R. 69(2) EPC, such reference did not appear to be necessarily decisive as to the true nature of the communication. Whether a document constituted a communication pursuant to R. 69(1) EPC should be derived from its substantive content and its context (as to the form for such communications, see below under "Form of decisions").

2. Composition of examining divisions

In **T 714/92** the board could not find any indication in the part of the file open to public inspection that the primary examiner had already signed the impugned decision before the date on which he left the examining division. The board held that to take a decision on a date on which the examining division no longer existed in its stated composition, without the examining division ensuring that it be apparent from the part of the file open to public inspection that the member who left the examining division had agreed the text of the decision before leaving, had to be considered as a substantial procedural violation. Thus the impugned decision was set aside as void ab initio and without legal effect.

3. Composition of opposition divisions

Art. 19(2) EPC stipulates that an opposition division must consist of three technical examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates.

In **T 390/86** (OJ 1989, 30) oral proceedings had taken place in the presence of three examiners appointed to form the opposition division. The Chairman had announced its decision during the oral proceedings in the presence of the other two examiners. Although the decision had subsequently been duly reasoned in writing, it had been signed by three members other than those before whom the oral proceedings had taken place. The board considered whether the decision of the opposition division was valid having regard to the circumstances. The board held that it was quite clear from Art. 19(1)(2) EPC that an opposition in respect of a European patent was in all cases to be conducted and decided by three technical examiners appointed on a personal basis in respect of a particular opposition (in some cases an additional legal examiner might also be appointed), and that oral proceedings had to be before the three technical examiners personally appointed to form the opposition division. Further, the reference to voting in the final sentence of Art. 19(2) EPC made it clear that an opposition should be decided on the basis of the personal votes of the individual examiners appointed to constitute a particular opposition division. It was thus clear from Art. 19 EPC that the power to examine and decide an opposition pursuant to Art. 101 EPC and Art. 102 EPC had at all times to be exercised personally by the examiners appointed to do so. In accordance with the well-known principle "delegatus non potest delegare", the power of a department of the EPO such as an opposition division to issue a decision had not only to be exercised personally but also to be seen, both by the parties and

by the public, to be exercised personally. Similarly, where a decision was issued in writing setting out reasons for an oral decision, the parties and the public should be able to see from the written decision that it had been taken by the examiners appointed to the particular opposition division responsible for that oral decision. It was of course possible that not all the appointed members were able to sign a written decision (for example through illness). However, in the board's view, if the decision of a particular division was to be legally valid, it had to have been written on behalf of and represent the views of the members who were appointed to that division to decide the issue or issues which were the subject of the decision, and it had to bear signatures which indicated this. As a result, the written reasons for a decision delivered during oral proceedings could only be signed by the members of the deciding body who took part in the oral proceedings. The board therefore held that if, in a case where a final substantive decision had been given orally by an opposition division during oral proceedings, the subsequent written decision giving the reasons for that oral substantive decision was signed by persons who did not constitute the opposition division during the oral proceedings, the decision was null and void.

It was further held that since the oral proceedings had taken place more than two years before and the (invalid) written decision had been given more than one year before (almost one year after the oral decision), the requirements of R. 68(1) EPC could no longer be properly complied with, and the substantive decision was therefore incurably void. The opposition had therefore to be re-examined.

In its decision **T 243/87** the board of appeal developed further the principles established in decision **T 390/86** (see above). The board held that even though only one member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision signed subsequently accurately reflected the point of view of all three members who had taken part in the oral proceedings, or even of the majority of the opposition division. In the board's view, the exceptional situation in which one of the appointed members was incapacitated (for example through illness) was quite different. In such cases it was right to accept that, although the reasoned written decision should be signed only by the members of the division who actually took part in the oral proceedings, one of them could sign on behalf of the member unable to do so. It was of course advisable to check that the reasoned written decision represented the point of view of all the members who took part in the oral proceedings.

In **T 251/88** the composition of an opposition division was held to be contrary to Art. 19(2) EPC, because two of the three members had taken part in the proceedings for grant of the patent to which the opposition related. The board of appeal ordered that the decision of the opposition division be set aside and the case be remitted for fresh examination by an opposition division with a different composition (see also **T 382/92**).

In **T 939/91** the chairman of the opposition division had participated as second examiner in the decision to grant the patent in suit, as was clear from EPO Form 2035.4. The board of appeal decided that the opposition division had therefore violated the provisions of Art. 19(2) EPC and that the decision delivered had to be annulled on the grounds that the department delivering it had not been competent to do so. The board felt it fair to order reimbursement of the appeal fee, given that violation of the provisions of Art. 19(2) EPC had to be considered

as a substantial procedural violation.

In **T 476/95** the chairman of the opposition division had, at an earlier stage of the grant proceedings, written and signed a negative communication which preceded the decision of the examining division to refuse the application. In the board's opinion, Art. 19(2) EPC, first and second sentences, referred to the participation of members of the opposition division at every stage of the grant proceedings, not only to their involvement in the final decision. The primary examiner in the opposition proceedings had also been a signatory to the decision refusing the application after examination. A breach of Art. 19(2) EPC was considered to have occurred if both the primary examiner and the chairman of the opposition division had taken part in the grant proceedings.

In **T 960/94** the board held that to comply with R. 68(1) EPC, second sentence and R. 68(2) EPC a written reasoned decision confirming the orally announced decision was required. Such a written reasoned decision must be issued on behalf of the very same members of the opposition division who were present at the oral proceedings, as the task of giving a written reasoned decision is personal to those members of the opposition division present at the oral proceedings and cannot be delegated to a differently composed opposition division, even if two of the members remain the same (following **T 390/86**, OJ 1989, 30). As no confirmatory written decision had been issued in the names of the members present at the oral proceedings, the decision given orally was void and had to be set aside.

4. Suspected partiality

In **G 5/91** (OJ 1992, 617), the Enlarged Board of Appeal commented on the suspected partiality of a member of an opposition division. In the case which had led to the referral, **T 261/88** (OJ 1992, 627), the primary examiner was a former employee of the opponent and had represented that company many times in examination and opposition proceedings before the EPO. The Enlarged Board observed that although the questions referred to it were directly related only to proceedings before an opposition division, the problems involved were of a general character and also had a bearing on the activities of the other EPO departments of first instance charged with the procedure, eg the examining divisions (see Art. 15 EPC).

The Enlarged Board stated that it must be considered as a general principle of law that **nobody should decide** a case in respect of which a party may have good reasons to assume partiality. The basic requirement of impartiality therefore also applied to employees of the EPO departments of first instance engaged in decision-making activities affecting the rights of any party. Although the provisions of Art. 24 EPC on exclusion and objection only applied to members of the boards of appeal and the Enlarged Board of Appeal and not to employees of the EPO departments of first instance, including opposition divisions, this did not justify the conclusion that such employees were exempt from the requirement of impartiality. Furthermore, although Art. 24 EPC was only applicable to appeal proceedings, it seemed justified to apply the principles underlying the provisions of Art. 24(3) EPC, second and third sentences, to an objection on the ground of suspected partiality before a department of first instance. Such an objection could thus be disregarded if it was not raised immediately **after** the party concerned became aware of the reason for the objection or if it was based on nationality. Finally, the Enlarged Board found that the question whether or not

an objection to a member of an opposition division on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case. Such considerations involved factual questions of degree rather than points of law and were therefore not a matter for the Enlarged Board of Appeal to decide.

In **T 433/93** (OJ 1997, 509) following a substantial procedural violation in connection with a decision issued by a first-instance department, the decision was set aside at the request of a party, and the case was remitted to the department of first instance for re-hearing. Following such remittal, the board found it necessary for the case to be examined and decided by a different composition of opposition division (that is, by a composition of three new members), in relation to the grounds of opposition raised and introduced into the proceedings. The board considered that if the case was to be heard further and re-decided by the same composition of opposition division, the members of the opposition division would have to attempt to put out of their minds the result of their previous decision before re-hearing and re-deciding the case.

The board held that the important point was not whether the file record showed any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see **T 261/88**, 16.2.1993), or whether the present members of the opposition division would in fact be unprejudiced or impartial if they re-heard the case, but **whether a party would have reasonable ground** to suspect that they would not receive a fair hearing if the case was re-heard before the same composition of opposition division (whether because of possible prejudice as to how the case should be decided, or because of possible partiality, or otherwise).

In **T 261/88** of 16.2.1993 the board held that disqualifying partiality presumed a preconceived attitude on the part of a deciding person (in this case the first examiner) towards a party (in this case the patentee) of the case. The fact that the views held on the issues of the case by the examiner differed from those held by the party was itself not disqualifying. The board noted that disqualifying partiality was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties (eg a judge) was swayed by his attitude towards a party. The board examined whether the reasoning underlying the decision under appeal showed such major deficiencies that there was reason to believe that the primary examiner was, either deliberately or inadvertently, trying to "bend" the facts of the case, and that this was done because of a preconceived attitude towards one of the parties. The board could not find anything basically or conspicuously wrong with the analysis of the technical questions. The content of the file did not go beyond the framework of a normal discussion between the EPO and an applicant, and there was nothing manifestly unreasonable to be found in the reasoning, so that disqualifying partiality could not be concluded.

In **T 843/91** (OJ 1994, 818), a newly appointed board had to consider whether the three members of the board of appeal originally appointed could be suspected of partiality. The board agreed with the view held in decision **T 261/88** (see above) that disqualifying partiality presumed a preconceived attitude towards a party on the part of a person in a decision-making capacity. More precisely, partiality would be knowingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other

party. The board referred to **G 5/91** (OJ 1992, 617) which stated that the question whether or not an objection to members on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case.

In **T 143/91** the board held that a member of an opposition division was biased if it could be shown that he had a personal **interest** within the meaning of Art. 24(1) EPC. The mere fact that the member was previously employed by a company dependent on a party to the opposition proceedings was not, however, sufficient proof of such an interest.

In **T 951/91** (OJ 1995, 202, edited version, Reasons Nr. 14 not published) objections under Art. 24 EPC and Art. 19(2) EPC were raised by the appellant in the statement of grounds of appeal suggesting that the opposition division had been biased in its attitude to the parties. In reaching its decision on this point, the board observed that nothing in the minutes of the oral proceedings, which the appellant had not criticised, led to the conclusion that the arguments had not been duly considered by the opposition division or that the latter was suspected of bias during those proceedings. The board examined the reasons set out in the appealed decision and observed that the decision itself did not reveal any bias.

In **T 241/98** dated 22.3.1999 a party to the appeal proceedings raised an objection under Art. 24(3) EPC to a member of the board on the basis of suspected partiality. As the objection was formally admissible the board held oral proceedings on the substantive issue of partiality, excluding the member objected to and including his alternate. As the board was unable to establish any objective basis for a suspicion of partiality, the exclusion of the original member was lifted and the appeal was continued before the board in its original composition. The appellant had relied on decision **T 253/95** in which the board had held that alerting a party to an argument against him in advance of oral proceedings amounted to a clear violation of the principle of impartiality. Such a statement, taken out of its context, namely an overriding need for a board to act impartially, contravened the established practice of the boards of appeal under Art. 110(2) EPC and Art. 12 RPBA, according to which a preliminary appreciation of substantive or legal matters could always be communicated, if expedient, in a non-binding form to the parties.

In **T 1028/96** dated 15.9.1999 the board had to consider the correct procedure where an objection of partiality was raised against board members. The board ruled that a preliminary examination for admissibility under Art. 24(3) EPC was incumbent on the original board, following which the procedure under Art. 24(4) EPC might need to be followed if the objection was admissible. An objection by a party that a member of the board had previously "participated in the decision under appeal" (Art. 24 (1) EPC) only covered decisions of the examining and opposition divisions and not decisions of the boards of appeal arising from those decisions. An objection under Art. 24(3) EPC based on "suspected partiality" could give rise to exclusion of board members originally appointed in circumstances where substantially the same crucial facts were at issue in opposition appeal proceedings as had previously been at issue in grant appeal proceedings "in the light of the particular circumstances of each individual case".

According to **T 954/98** of 9.12.1999, the rules for exclusion from a board for partiality should

be interpreted not only in the light of the principle of judicial impartiality, but also the principle of "gesetzlicher Richter" (ie according to the principle of "the duly designated judge"); such that firstly a member whose impartiality was suspect should not handle a case, but secondly that parties should not be able to change the composition of boards at will for no objective reason.

Purely subjective impressions or vague suspicions were not enough to disqualify a member. The member's behaviour or situation had to provide objective justification for a party's fears. The mere fact of taking discretionary procedural steps which might disadvantage a particular party was not enough to justify exclusion, not even if the party concerned interpreted those steps as expressing bias against it.

5. Date of decision

5.1 Entry into force of decisions

The Enlarged Board of Appeal has held that it is necessary to distinguish between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 EPC if one of the parties has filed an admissible and well-founded appeal (**G 12/91**, OJ 1994, 285).

5.2 Completion of the internal decision-making process

In **T 586/88** (OJ 1993, 313) the board referred the following point of law to the Enlarged Board of Appeal: "If the decision of an examining or opposition division is pronounced not at the end of oral proceedings but following written proceedings or proceedings continued in writing after oral proceedings, at what point is the internal decision-making process within that department of the EPO completed?".

In **G 12/91** (OJ 1994, 285) the Enlarged Board of Appeal stated that the point of law referred was of vital importance to the general question of determining the final point at which a first-instance department of the EPO could still take account of further submissions by the parties. The Enlarged Board noted that the point in time at which a decision entered into force, ie the moment it was pronounced or notified, was not the last moment at which parties could still submit observations. This had to be done **at an earlier point** in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions.

As far as oral proceedings were concerned, established board of appeal case law had this point in time as the time of closure of the debate, which was fixed by the decision-making department - having first heard the parties' submissions - to allow itself time to consider its

decision. Once the debate had been closed, further submissions by the parties had to be disregarded unless the decision-making department allowed the parties to present comments within a fixed time limit or decided to reopen oral proceedings for further substantive debate on the issues.

In the case of decisions taken following written proceedings, the final moment at which fresh matter submitted by the parties could still be taken into account had to correspond to the time of closure of the debate during oral proceedings. The need to ensure legal certainty required that this moment be as clearly fixed as the moment when the debate was closed during oral proceedings. Neither the EPC nor its Implementing Regulations contained any provision fixing that moment.

The Enlarged Board pointed out that the date on which the three members of an examining or opposition division signed a decision was extremely important, as the date indicated was the date on which the division decided whether a patent application had to be refused, an opposition rejected or a patent granted or revoked. However, it was also a decision taken "in camera", because at the moment it was taken it did not have any immediate effect on the parties involved and was **not** therefore **binding** on the decision-making department that issued it. If, after it had signed it, the department discovered that it had failed to take account of a key point, it could amend its decision, despite having already signed it, because it had not yet left its custody.

Having weighed up the various arguments, the Enlarged Board of Appeal reached the conclusion that the point in time at which the internal decision-making process was completed was the date on which the formalities section handed over the date-stamped, post-dated decision to the EPO postal service. This was a date the parties could ascertain very easily, because, as the President of the EPO had explained, it was always three days prior to the date stamped. Internal EPO instructions made clear that a period of three days always elapsed between the date-stamping of a decision and its despatch. If, for whatever reason, the EPO postal service was unable to despatch the decision on the date stamped, it returned the decision to the formalities section where it was given a new date, which again pre-dated the date of actual despatch by three days. This practice ensured that the date of despatch was always stamped on the decision three days before it was actually despatched. This date was therefore very easy to ascertain, both for the EPO and the parties. It thus fulfilled the need for strict legal certainty which the handing down of a decision had to ensure.

When a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it. This moment marks the completion of proceedings before the decision-making department. Once proceedings have been completed the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter. Seeing that it is important for the parties to know at which point in time the decision-making process following written proceedings is completed, this point in time should be clearly indicated in the decision. The formalities section should also keep a register of the dates on which decisions are handed over to the EPO postal service to enable those dates to be ascertained at any time (see also **T 631/94**, OJ 1996, 67).

In **T 798/95** the decision to grant a European patent was handed over to the EPO postal service for notification on 25.8.1995 during the official working time of the EPO. On 25.8.1995, at 6.47 pm, the appellant filed a request by telefax for amendment of the application under R. 86(3) EPC. The board held that a request for amendment filed after the completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date. The board noted that the proceedings before the examining division were completed not later than at the end of the official working time on that date. Thereafter, the examining division could no longer amend its decision, as it was not competent to consider the request. The appellant's submissions that the examining division had been responsible for the application all day on Friday, 25.8.1995 and that it was possible to amend the application until issue of the decision were therefore not correct.

6. Form of decisions

6.1 General issues

In **T 390/86** (OJ 1989, 30) the board stated that when a substantive decision is given orally during oral proceedings it must be formally notified to the parties in writing (R. 68(1) EPC) and formally completed by giving reasons for the decision in writing (R. 68(2) EPC). In the board's judgment, it was clear from R. 68 EPC and Art. 108 EPC that until a substantive oral decision was formally completed in writing and notified to the parties, the two-month period within which a notice of appeal had to be filed did not begin.

In **J 8/81** (OJ 1982, 10) the board stated that in accordance with the normal practice of the EPO, the contents of the communication ought to have been identified as a decision, so as to preserve the clear distinction made in the Convention and Implementing Regulations between decisions and communications; see eg R. 68 EPC and Art. 70 EPC. The letter ought also to have drawn attention to the possibility of appeal and the provisions of Art. 106 EPC to Art. 108 EPC, in conformity with R. 68(2) EPC. The fact that the requirements of R. 68(2) EPC were not fully complied with did not, however, mean that the letter was merely a communication. Whether a document issued by the EPO constituted a decision or a communication depended on the substance of its **contents**, not on its **form** (**J 43/92, T 222/85**, OJ 1988, 128).

In **T 42/84** (OJ 1988, 251) the board held that the alleged failure of the EPO to enclose the text of Art. 106 EPC to Art. 108 EPC with the decision neither invalidated the decision nor did it constitute a substantive procedural violation. R. 68 EPC stated that the written communication of the possibility of appeal had to draw the attention of the parties to the provisions laid down in Art. 106 EPC to Art. 108 EPC, the text of which should be attached. However, it also stated that the parties could not invoke the omission of that communication. This had, in the board's view, to be read as applying also to the omission of the text of the articles alone.

In **T 222/85** (OJ 1988, 128) the board noted that the contents of a "communication" never constituted a "decision". This distinction was important, because only a "decision" could be the subject of an appeal - see Art. 106(1) EPC. In the case at issue the communication only

represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" were always final and binding in relation to the department of the EPO which issued it, and could only be challenged by way of appeal.

In **J 20/99** the board noted in its decision that all EPO departments should, if quoting a decision of the boards of appeal or any other legal authority, identify that authority and place the cited passage(s) in quotation marks. It found that the examining division had raised in its communication some objections having in mind the reasons of a decision of a board of appeal that were repeated verbatim without any quotation marks or attribution. The board had observed that the situation then was completely different from that which the examining division had in mind.

6.2 Inconsistency between oral and written decisions

In **T 666/90** the opposition division had indicated during oral proceedings that it would maintain the European patent as amended if new documents conforming to the version of the claims it had said it would allow were submitted. Although such a set of claims had not yet been formally submitted in writing by the applicants' representative during oral proceedings, the representative had given an undertaking to do so later and had done so by the deadline set. The written decision had revoked the patent however. The board held that this inconsistency between the oral and written decisions was in breach of R. 68(1) EPC and was hence a substantial procedural violation.

In **T 425/97** an appellant submitted as unique ground of appeal the inconsistency existing between the written decision and the form of the patent held as patentable by the opposition division at the oral proceedings. The board held that, any substantive deviation, as in the present case, of the decision notified in writing from the decision taken at the oral proceedings and given orally amounts to a procedural violation.

6.3 Reasons for the decision

6.3.1 Reason for main and auxiliary requests

Under R. 68(2) EPC, decisions of the EPO which are open to appeal must be reasoned. According to the established jurisprudence of the boards of appeal, a reasoned decision must be given **for each** of the different requests (main and auxiliary requests). Although in exceptional circumstances a reference in the reasons for a decision to grounds given in preceding communications may be allowed, it must be quite clear from those grounds which considerations played a crucial role for the division responsible when it took its decision (**T 234/86**, OJ 1989, 79). It must be ensured that, before issuing a decision revoking the patent solely on the basis of the patent proprietor's main request, the proprietor has expressly withdrawn all subordinate requests (see **T 81/93**, **T 5/89**, OJ 1992, 348, section 2.2). If the patentee files one or more auxiliary requests in addition to a main request and does not withdraw any of them, an opposition division is obliged in its decision to give reasons why each successive request is either not admissible (in the exercise of its discretion under R. 57(1) EPC and R. 58(2) EPC) (**T 155/88**; **T 406/86**, OJ 1989, 302; **T 951/97**, OJ 1998, 440)

or not allowable on substantive grounds. If an opposition division allows an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests are not allowable, that decision should be set aside as void and without legal effect, and the appeal fee refunded on the basis of a substantial procedural violation (see **T 484/88**).

6.3.2 Compliance with the requirements of Rule 68(2) EPC

In **T 856/91**, the contested decision referred to the knowledge of prominent skilled persons and cited "a statement by a well-known expert" but contained no information enabling the reader to infer who these persons were or exactly what they had said. The board took the view that this incomplete information did not constitute a breach of R. 68(2) EPC, since it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient.

In **T 647/93** (OJ 1995, 132) the appellants had lodged an appeal against the decision of the examining division to refuse the application and claimed that the latter had committed substantial procedural violations in that, inter alia, it had not followed the procedure set out in the Guidelines, or provided a written reasoned decision as required by R. 68(2) EPC. The board observed that the reasons for the refusal were somewhat enigmatic, and that there was no basis for them in the EPC. However, the board held that even if the reasons for the decision were not well founded, this did not mean that the decision was not reasoned at all within the meaning of R. 68(2) EPC.

6.3.3 Non-compliance with the requirements of Rule 68(2) EPC

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition had not been correctly reasoned within the meaning of R. 68(2) EPC, first sentence, if, after giving the reasons why the opposition division, unlike the opponent, considered the subject-matter of the patent to be new, it failed to state the reasons why it considered that the subject-matter also involved an inventive step.

In **T 292/90** regarding inventive step, the examining division had merely said that the claimed process amounted to an obvious juxtaposition of the teachings of documents 2, 3 and 4. There was no explanation of how the examining division had arrived at this conclusion. The board considered this form of reasoning to be insufficient. The reasoning given in a decision open to appeal had to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision on inventive step therefore had to contain the logical chain of reasoning which had led to the relevant conclusion (see also **T 52/90**).

In **T 153/89** the examining division had given no reasons for finding in its decision that the subject-matter of the dependent claims was not inventive. The board of appeal took the view that the perfunctory statement in the contested decision did not permit the board to judge whether this issue had been sufficiently investigated, or investigated at all. The examining division's decision on such grounds did not amount to a reasoned decision.

In **T 740/93** the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division), with the order for further

prosecution by a correctly composed opposition division. The new opposition division rendered a decision which was nearly identical to the first one. The board held that, in accordance with R. 68(2) EPC, decisions of the EPO which were open to appeal had to be reasoned. In this respect the board accepted that reasoning did not mean that all the arguments submitted should be dealt with in detail, but it was a general principle of good faith and fair proceedings that reasoned decisions should contain, in addition to the logical chain of facts and reasons on which every decision was based, at least some motivation on crucial points of dispute in this line of argumentation, in so far as this was not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing. Although the decision under appeal contained a reasoning as to why the subject-matter of the patent in suit was considered to lack an inventive step and indeed contained references to points of dispute raised in the proceedings up to the first decision, it did not contain any direct reference to the important issues of dispute raised by the appellant in its appeal against the first decision. Since the second decision was nearly identical to the first one, it did not meet the requirements of R. 68(2) EPC, in that it was not sufficiently reasoned, which failure amounted to a substantial procedural violation.

In **T 227/95** the appellants submitted that the decision of the opposition division to maintain the patent in amended form was not reasoned within the meaning of R. 68(2) EPC. In its decision, the board agreed with this view. The decision contained no reasons on the merits of the case. Instead, it merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (**T 527/92**). However, decision **T 527/92** contained no such reasons, since the case was remitted to the opposition division for further prosecution. The board in that case decided only that the patent could not be maintained in accordance with the patentees' (then) main request. The examination of the auxiliary request was left entirely to the department of first instance.

In **T 698/94** the board noted that neither the minutes of the oral proceedings before the opposition division nor the "Summary of Facts and Submissions" of the appealed decision itself contained the slightest hint at the arguments brought forward by the parties. It was impossible for the parties to the proceedings to see how the opposition division had arrived at its conclusion of lack of novelty. As a result, the losing party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which was the very purpose of proceedings before the boards of appeal (see the decision of the Enlarged Board in **G 9/91**, OJ 1993, 408, paragraph 18). The board explained that the requirement of R. 68(2) EPC for decisions to be "reasoned" meant that the decision had expressly to set out the logical chain of argument upon which the conclusion and therefore the final verdict were based, in respect of each and every ground that had been pleaded and substantiated. The de facto absence of reasoning in the decision under appeal represented a substantial procedural violation.

In **T 135/96** the opposition division had completely ignored two documents as well as some lines of argument developed by the appellants/opponents in support of their allegation that the claimed subject-matter lacked an inventive step. The board held that the failure to consider these documents and arguments, which were relevant to the ground of lack of inventive step on which the decision under appeal was based, constituted a violation of the

right to be heard and thus a substantial procedural violation as well as a fundamental deficiency in the first-instance proceedings. Moreover, the decision under appeal was not in conformity with R. 68(2) EPC, since it gave no reason why the subject-matter of the independent claims was considered to involve an inventive step in respect also of the two additional lines of argument developed by the opponents.

In **T 652/97** the board held that the principle enshrined in R. 68(2) EPC ensured a fair procedure between the EPO and parties to proceedings, and the EPO could only properly issue a decision against a party if the grounds on which it was based had been adequately reasoned. The decision had not provided the opponent with any reasoning concerning its main argument, which conflicted with the requirements of R. 68(2) EPC and constituted a substantial procedural violation.

In **T 615/95** in an annex to its decision, the examining division considered that an interlocutory revision could only be possible on condition that several objections were overcome. These objections were unrelated to the grounds of refusal and had clearly no link at all to the decision under appeal. The board held that an examining division's decision should not be supplemented normally by annexes dealing with issues having no relation to the issues dealt with in the reasons for this decision.

In **T 473/98** (OJ 2001, 231) the board held that it is entirely appropriate and desirable in the interests of overall procedural efficiency and effectiveness that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC employing the standard decision formula, by way of obiter dicta, findings which could obviate remittal in the event of the revocation being reversed on appeal.

See Chapter on Reimbursement of appeal fees (Appeal Procedure) on inadequate reasons given in the decision at first instance, and the circumstances in which reimbursement of the appeal fee is justified.

6.4 Signatures on a decision

In **T 390/86** (OJ 1989, 30) the board noted that although R. 70 EPC states that "any communication from the EPO is to be signed by and to state the name of the employee responsible", there was nothing in R. 68 EPC or elsewhere in the EPC which specifically required the decision of a first-instance department of the EPO (ie a decision which was open to appeal) to be signed by the employee or employees responsible. The board, however, having regard to the principles which were applicable, came to the conclusion that if the decision of a particular division was to be legally valid it had to bear the signatures of the members who had been appointed to that division to decide the issue or issues which were the subject of the decision.

In **T 243/87** the decision was substantiated and issued in writing after oral proceedings. The decision was signed by two members who had taken part in the oral proceedings and by one who had not. The board ruled that the latter signature rendered the decision null and void. It ordered remittal to the department of first instance, and a refund of the appeal fee because a substantial procedural violation had occurred.

In **T 777/97** the appellant had requested correction of the description before the opposition division. The first examiner had signed the correction decision also on behalf of the division's absent chairman. The board ruled that the decision was valid.

In **T 999/93** the board held that if a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issues forming the subject of the decision, and it must bear signatures which indicates this.

In **D 8/82** (OJ 1983, 378) the board had to decide whether a signature was valid, where the surname appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. The board held that the signature was valid since in several Contracting States of the EPO there is no requirement that a signature be legible or recognisably composed of letters. It is enough that it serves to identify the signatory.

In **T 225/96**, the file showed that the contested decision had been signed by only the first examiner on the opposition division, and not by its chairman, second examiner and legal member. The board sent the case back for regularisation. The division however replied that the three non-signing members were not at this stage of the proceedings prepared to put their names to a text issued without their knowledge or approval.

The board decided that this response meant the division had not yet finalised a reasoned decision; the document sent to the parties was merely a draft from the first examiner. But to issue the parties with a draft decision not approved by all division members present at the oral proceedings was a substantial procedural violation. The board added that if, as it had first imagined, the signatures had merely been missing, this could have been corrected under R. 89 EPC which allows correction of linguistic errors, errors of transcription and obvious mistakes in EPO decisions. It also noted that decisions' accompanying forms are never signed, because they are computer-generated and therefore, under R. 70(2) EPC, 1st sentence, a seal may replace the signature. In general, the decision as notified to the parties is presumed to be authentic.

7. Correction of errors in decisions

7.1 General issues

In decisions of the EPO, only linguistic errors, errors of transcription and obvious mistakes may be corrected (R. 89 EPC).

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chairman's or minute-writer's signature at the end of an opposition division's decision was a rectifiable, obvious error within the meaning of R. 89 EPC. In the case in question a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings. The board held that correction of the two errors had to be by means of a decision under R. 89 EPC with retrospective effect from the date of the original decision. The same board emphasised the retrospective effect of corrections under R. 89 EPC in **T 116/90** but stated that it was unnecessary to redate the decision as

from the date of correction.

In **T 850/95** (OJ 1997, 152) the decision to grant under R. 51(6) EPC had been despatched when the applicant filed two additional pages of the description, which had been omitted due to a clerical error when the applicant filed a complete set of replacement pages for the text of the application, and requested their inclusion in the patent specification. He was informed that the technical preparations for the publication of the patent specification had been completed. The applicant requested that the patent be re-published incorporating the missing pages. The request for correction was refused by the examining division on the ground that "the corrections specified did not relate to passages in the patent specification where the Division wished to base its decision on a different text (Guidelines, Part E-X, 10)".

The board found that, according to the practice of the EPO, the decision to grant issued by the examining division (an electronically generated form) referred to the documents approved by the applicant under R. 51(4) EPC, so that they became an integral part of the decision to grant. It followed from this that errors in the specification might also be corrected under R. 89 EPC. The board held that, in a decision to grant, if the text given for grant was not and obviously could not be the text corresponding to the real intention of the examining division, there was an obvious mistake within the meaning of R. 89 EPC, and the text erroneously indicated could be replaced by the text on which the examining division actually wanted to base its decision. The board noted that the filing of replacement pages for the whole specification should be avoided unless the extent of the amendments made it absolutely necessary.

In **T 425/97** in a note from the opposition division concerning a consultation by telephone it was stated that appellant II (patentee) had drawn the opposition division's attention to an obvious error in the minutes and in the decision. This consultation was followed by the dispatch by telefax of a revised version of the "Facts and submissions" and the "Reasons" of the decision and a revised form of the minutes. A new term for appeal was not set. In a short accompanying communication, the opposition division informed the parties that the correction was made according to R. 89 EPC, and had "become necessary because auxiliary request 7 and 8 obviously had been confounded". No trace of said auxiliary request 8 was however to be found in the foregoing history of the case. In the corrected form of the decision, a completely fresh text of the valid claim was enclosed. The minutes were corrected accordingly.

The board referred to **G 8/95** which dealt with the scope of R. 89 EPC, stating that the difference between an appeal against a decision and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed. This means that it could be within the scope of R. 89 EPC to correct the text of the patent if it is not and cannot be in the form corresponding to the intention of the deciding instance (**T 850/95**, OJ 1997, 152). The board found however that, in the case at issue, the intention of the opposition division apparently had changed between the oral proceedings and the issuance of the written decision in its original version. The claim on which the revised version of the decision was based was substantially different from the non-revised one. Moreover, the text of the minutes of the oral proceedings attached to the decision was not the original one, but

was also modified to bring it into agreement with the decision. For these reasons, the original decision could not be revised under R. 89 EPC since the modifications introduced would change not only the form but its very substance.

In **T 212/97** the board pointed out that R. 89 EPC permitted the opposition division to correct an obvious mistake in the copy of the decision notified to the parties. In the case at issue, a fourth person had been named as a member of the opposition division although no such person had been mentioned in the original document.

In **T 965/98** the board issued a decision orally on the basis of claims submitted during oral proceedings. However, during preparation of the written reasons, the appellant requested correction of an obvious error in the claims. The board agreed to the correction under R. 88 EPC and amended its original decision to take account of the correction under R. 89 EPC.

In **T 867/96** the patentee had requested the correction under R. 89 EPC of a sentence, in the reasons for a board of appeal decision, stating that all the parties had agreed that a certain document represented the closest prior art. The board pointed out that the case was closed, as *res judicata*, and therefore no longer before it. Citing in particular **G 8/95** (Reasons 3.4) and **G 1/97**, the board held that only the board which had taken a decision could decide whether it required correction. Furthermore, establishing whether correction was necessary involved studying the facts, implying in general and up to a certain point that such requests were admissible. The present board thus ruled that the request for correction was admissible. However, it also held that this particular request did not fulfil the requirements of R. 89 EPC, was unfounded and should therefore be refused.

7.2 Errors in the printed version of the European patent specification

In **T 150/89** some printing errors in the published patent specification were found which were not present in the version accepted by the Office. The board found that such omissions should normally be corrected as a matter of routine. The decision to grant was legally binding as regards existence and scope of the patent (Art. 97 EPC). The specification reproduced that decision (Art. 98 EPC). It was an official document published by a public authority for general information, and as such had legal force before the courts. It was therefore subject to the same correction criteria as the grant decision itself under R. 89 EPC. That provision did not cover matters of fact or substance ; only obvious errors could be corrected. The Office could make such corrections **on request or of its own motion** . Thus the specification was to be brought into line with the decision to grant, and whether this took the form of a reprint or a corrigendum (which was a matter for the department of first instance, or possibly its formalities officer, to decide) should clearly indicate the correction made.

7.3 Competence to correct a decision under Rule 89 EPC

In **G 8/95** (OJ 1996, 481) a question of law was referred to the Enlarged Board of Appeal to decide which board of appeal (either the technical board or the Legal Board) was competent to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC for correction of the decision to grant. In the view of the Enlarged Board, the **basis** of such a request for correction was not that the party was not granted what it had requested.

Rather, such a request was based on the allegation that there was a linguistic error, error of transcription or similar obvious mistake.

The Enlarged Board noted that the competence to correct errors in a decision under R. 89 EPC lay with the body which had given the decision. Hence, in the examination procedure the examining division had to decide on a request to correct errors in the decision to grant. If the request for correction of the decision to grant concerned the grant of the patent, then the decision on the correction had also to concern the grant of the patent, since it was the request of the party which defined the subject of the dispute. The Enlarged Board also agreed with the statement made in **J 30/94** (OJ 1992, 516) that it was the decision to refuse the request for correction which was under appeal. According to the Enlarged Board, this did not alter the subject of the dispute in the second instance. The decisive criterion in Art. 21(3)(a) EPC was not that the decision under appeal was the decision to grant itself. It was sufficient for the decision to "concern" the grant, and this was necessarily the case if the subject of the decision was the text in which the patent was to be or had been granted, since this was the result of the substantive examination and defined the rights conferred by the patent. The Enlarged Board came to the conclusion that the decision refusing a request for correction of the decision to grant concerned the grant of the patent. It was, therefore the technical boards as defined in Art. 21(3)(a)(b) EPC which had to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC for correction of the decision to grant.

In **J 12/85** (OJ 1986, 155) the board noted that the existence of inconsistencies in the decision to grant a patent might be a ground for filing a request for correction based on R. 89 EPC. However, a board of appeal could only examine appeals from decisions of other-instance departments of the EPO (Art. 21(1) EPC). Thus it could not examine a request for a correction of the decision under appeal based on R. 89 EPC. A decision on such a request had first to be taken by the department of first instance before the matter could be referred to a board of appeal. The board further noted that inconsistencies did not affect the validity of the decision to grant the patent nor imply that the appellant was "adversely affected" by this decision.

8. Principles for the exercise of discretion

In **J 4/87** the appellant submitted that there was nothing in the EPC which prevented the EPO from exercising discretion in cases of exceptional delay in the post. The board, however, held that as a matter of law the EPO had no general discretion as suggested by the appellant. The EPO could only exercise discretion if the power to do so could be derived from the EPC.

In **J 20/87** (OJ 1989, 67) the Receiving Section had rejected a request for a partial refund of the European search fee. In the reasons for its decision it was stated, inter alia, that the criteria for the refund of the European search fee were defined in Art. 10 RFees and these did not leave room for any discretion in favour of the applicant. In the case in question, these criteria had not been fulfilled. The board confirmed the finding of the Receiving Section and found that there was nowhere any support for the idea that the EPO was entitled to exercise any general discretion based on equity in respect of refunding the fee for the European search report. In fact, the existence of such a discretionary power could lead to serious difficulties in practice, bearing in mind the very large number of applications before the EPO

and the great variety of possible borderline cases to be considered individually on such a general basis.

In **T 182/88** (OJ 1990, 287) the board clarified its case law concerning the exercise of discretion given to EPO departments. The board held that when exercising discretion, whether for or against a particular party, the reasons for the exercise of that discretion should be given. In any case where the EPC gave discretion to a department of the EPO in relation to an issue in proceedings before it, general principles of law required such discretion to be exercised having regard to the factors which were relevant to that issue. Those factors were in turn determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as a whole (see **T 183/89**). The board stressed that discretion had always to be exercised on a case-by-case basis, having regard to the particular circumstances. Discretion had always to be exercised judicially, by taking into account those factors which were legally relevant to the issue in question and ignoring those which were not. Showing consideration to parties before the EPO should not be confused with the proper exercise of discretion according to law.

The board made clear that where the EPC had given discretion to a department of the EPO in relation to proceedings at first instance before it, such discretion was normally best exercised by the department of first instance, because it had control over the proceedings and should be aware of all the factors which were relevant to the exercise of its discretion. Furthermore, once a department of first instance had exercised its discretion, in any appeal against a decision involving the exercise of that discretion a board of appeal was normally reluctant to interfere with such a decision, unless the reasoning in the decision had clearly been based on wrong principles. In the case in point, the board found that the reasoning of the examining division's decision did not provide an adequate basis for deciding on the exercise of discretion. According to the board, the examining division's function was not merely to consider whether the facts of the case before it were exactly the same as a previous case in which a board of appeal had decided in favour of an applicant. Its function was to decide on the applicant's request having regard to the factors which were relevant. In the circumstances, the board observed that this was a case in which it should set aside the decision of the examining division and itself decide the question of discretion (pursuant to the board's powers under Art. 111(1) EPC).

In **G 7/93** (OJ 1994, 775) the Enlarged Board stated that if an examining division had exercised its discretion under R. 86(3) EPC against an applicant in a particular case and the applicant filed an appeal against the way in which discretion had been exercised, it was not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised its discretion in the same way as the department of first instance. If a department of first instance was required under the EPC to exercise its discretion in certain circumstances, it should have a certain degree of freedom when doing so, without interference from the boards of appeal. In the circumstances of a case such as that before the referring board, a board of appeal should only overrule the way in which a first-instance department had exercised its discretion if it came to the conclusion either that the department had not exercised its discretion in accordance with the proper principles as set out above, or that it had done so in an unreasonable way, and had thus exceeded the proper limits of its

discretion (see also **T 640/91**, OJ 1994, 918).

9. Legal status of the Guidelines for Examination in the EPO

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the EPO Guidelines. According to these two decisions, the Guidelines were only general instructions intended to cover normal occurrences. Thus, an examining division could depart from them provided it acted in accordance with the EPC. In reviewing the decision of an examining division, a board of appeal would wish to ensure uniform application of the law and judge whether the division had acted in accordance with the EPC, not whether it had acted in accordance with the Guidelines.

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94**, **T 937/97**)

10. Duties not entrusted to formalities officers

In **T 161/96** (OJ 1999, 331) the appellant requested that the opposition fee be considered to have been paid in due time and that the notice of opposition I be deemed to have been filed validly within the opposition period. He applied for a decision by the EPO under R. 69(2) EPC. The appellant was informed within the meaning of R. 69(2) EPC, second sentence, by a formalities officer of the opposition division. Later on, the opposition division rejected opposition I as inadmissible.

The board held that the **act of informing** an opponent within the meaning of R. 69(2) EPC, second sentence, does not belong to the duties entrusted to formalities officers of the opposition divisions by virtue of the powers transferred to the Vice-President of Directorate-General 2 of the EPO by order of the President of the EPO of 6 March 1979, under R. 9(3) EPC (cf. Notice dated 15 June 1984 as revised and supplemented on 1 February 1989 [OJ 1984, 319; 1989, 178], point 4). The appellant was not therefore entitled to rely on the formalities officers's communication that no loss of rights had occurred.

11. Jurisdiction

In **J 42/92** the board had to decide whether a request under R. 88 EPC, second sentence, could be made after grant. It came to the conclusion that a request under R. 88 EPC for amendments to the description or claims could only be filed during the pendency of application or opposition proceedings. Under Art. 97(4) EPC, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After that date, R. 88 EPC could only be applied while opposition proceedings were pending.

The board also pointed out that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections (bearing

in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **T 777/97**).

M. Other procedural questions

1. Language privilege

Natural or legal persons having their residence or principal place of business within the territory of a contracting state having a language other than English, French or German as an official language, and nationals of that state who are resident abroad, may file documents which have to be submitted within a given time limit in an official language of the contracting state concerned (Art. 14(2) EPC and Art. 14(4) EPC). These persons thereby become entitled to a fee reduction under R. 6(3) EPC.

The leading decision in this area is **G 6/91** (OJ 1992, 491) following a referral by **T 367/90** of 2.7.91 (OJ 1992, 529). The Enlarged Board of Appeal ruled that the persons concerned were only entitled to the fee reduction under R. 6(3) EPC if they filed the **essential item** of the **first act** in filing, examination, opposition or appeal proceedings in an official language of the state concerned other than English, French or German, and supplied the necessary translation no earlier than simultaneously with the original. To be able to claim the fee reduction it was sufficient for the **notice of appeal** to be filed as the essential item of the first act in appeal proceedings in an official language of a contracting state and be translated into one of the official languages of the EPO. Subsequent items, such as the statement of grounds of appeal, could then also be filed in an EPO official language.

These principles have since been applied in a number of decisions, for example in **T 367/90** of 3.6.92, **T 385/90** and **T 297/92**.

As far as opposition proceedings are concerned, the board decided in **T 290/90** (OJ 1992, 368) that to be granted a 20% reduction in the opposition fee under R. 6(3) EPC, that part of a **notice of opposition** which is governed by R. 55(c) EPC should always be filed in a non-official authorised language.

Neither a request for a fee reduction, nor a notification that only a reduced fee has been paid, is an essential part of the first act of the relevant proceedings. This is in contrast to the **notice of appeal**, which, although linguistically insensitive, is clearly essential to appeal proceedings (**T 905/90** (OJ 1994, 306; Corr. OJ 1994, 556), applying **G 6/91**; see also **J 4/88** (OJ 1989, 483)).

Where a patent application was filed in one of the languages referred to in Art. 14 EPC, a date of filing was to be attributed under Art. 80 EPC, irrespective of the fact that the applicant had neither its residence nor principal place of business in a Contracting State nor was a national of a Contracting State, provided that all the other requirements of Art. 80 EPC were satisfied (**J 15/98**, OJ 2001, 183). However, it is inadmissible for a German opponent to file an opposition in the Dutch language even if represented by a Dutch patent attorney (**T 149/85**

(OJ 1986, 103)).

In **J 21/98** (OJ 2000, 406) the board found that the Guidelines A-XI, 9.2.3 were both misleading, being based on a misunderstanding of **G 6/91** (OJ 1992, 491), and also in contravention of the EPC. As a result, the appellant/applicant, who had filed a request for examination in Italian within the time limit provided for under Art. 94(2) EPC, and a simultaneous English translation, had been refused the 20% reduction in the examination fee pursuant to Art. 14 EPC. According to the Receiving Section, the written request for examination in the Italian language should either have been entered in the pre-printed box contained in EPO Form 1001, or have been sent to the EPO with that form.

According to the board, Art. 94(2) EPC, in connection with Art. 75 EPC, Art. 92 EPC and Art. 94(1) EPC, were to be interpreted such that, within the grant procedure, the request for examination constituted an autonomous step quite separate from the (previous) step of filing the patent application, enabling the applicant to consider whether to continue the grant procedure in the light of the search report. Since the EPC gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right must be owed to the applicant who wanted to avail himself of the option provided for in Art. 14(2) EPC and Art. 14(4) EPC.

Nor was this finding in conflict with **G 6/91**, which stated that the persons referred to in Art. 14(2) EPC are entitled to the fee reduction if they file the essential item of the first act in filing, examination or appeal proceedings in accordance with the provisions. Nowhere did the decision suggest that the time limit for filing the request for examination should be changed. (See also **J 22/98**, **J 6/99**, **J 14/99** and **J 15/99**).

However, under Art. 14(4) EPC, those entitled to file in an official language of a contracting state under Art. 14(2) EPC must supply a translation in English, French or German within the time limit prescribed in the Implementing Regulations, failing which either the application is deemed withdrawn under Art. 90(3) EPC or the original document is deemed not to have been received under Art. 14(5) EPC (see **T 323/87** (OJ 1989, 343) and **T 193/87** (OJ 1993, 207)).

2. Inspection of files

Under Art. 128 EPC, the confidential treatment of patent applications ceases on publication of the application, not on expiry of the 18-month period mentioned in Art. 93 EPC (**J 5/81**, OJ 1982, 155).

Any person who can prove that the applicant for a European patent has invoked the rights under the application against him may obtain inspection of the files prior to the publication of the application and without the consent of the applicant under Art. 128(2) EPC. According to **J 14/91** (OJ 1993, 479) these rights can be said to have been invoked where the invocation of rights is formulated in relation to the first filing in a contracting state but the subsequent European application is mentioned at the same time. Any dispute between the applicant and a third party concerning the latter's right to inspect the files pursuant to Art. 128(2) EPC is best decided in oral proceedings convened at short notice.

R. 93 EPC indicates those parts of the file which shall be excluded from inspection pursuant to Art. 128(4) EPC. In **T 811/90** (OJ 1993, 728) the board held that filed documents which, following a substantial procedural violation, were to be withdrawn from the part of the file available for public inspection and which did not fall under the exclusions listed in R. 93 EPC had to be returned to the filing party if it so requested. Thus, even those documents marked as "confidential" in **T 516/89** (OJ 1992, 436) were returned to the party concerned - without note being taken of their contents - since they did not belong to the classes of documents to be excluded from file inspection under R. 93 EPC.

Where a priority document reached the EPO in time, but was actually filed by a third party in connection with another application, the board held that the priority claim was lost. One reason given was that R. 38(3) EPC and R. 104b(3) EPC (now R. 111(2) EPC) ensure that a certified copy of the previous application is available to third parties requesting inspection of the file. This would clearly not be the case where a document is included only in a completely unrelated file (**J 11/95**).

3. Register of Patents

3.1 General

No entries can be made in the Register of Patents prior to publication of the European patent application (Art. 127 EPC). Even in the case of published applications, R. 92(1)(u) EPC provides that the date of re-establishment of rights is to be entered only if loss of the application (R. 92(1)(n) EPC) or the revocation of the patent (R. 92(1)(r) EPC) has been entered in the Register (**J 5/79** (OJ 1980, 71)).

3.2 Registration of licences

As to the recording in the Register of European Patents of an exclusive licence under a patent **already granted**, the Legal Board of Appeal ruled in its decisions **J 17/91** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the contracting states designated in the request for grant.

3.3 Transfer

Art. 72 EPC provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. Under R. 20(1) EPC, a transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This is in line with the PCT system (R. 92bis. 1 PCT).

In **J 38/92** and **J 39/92** the Legal Board of Appeal ruled that a transfer could only be recorded in the Register of European Patents on the basis of an official document in accordance with (an earlier version of) R. 20(1) EPC if that document **directly** verified the transfer. It did not suffice if a judgment was submitted which mentioned another document from which it was possible to verify the transfer.

Assessing whether there are documents satisfying the EPO that a transfer has taken place in accordance with R. 20(1) EPC and R. 20(3) EPC and making the entry in the register is the responsibility of the relevant department of first instance. Accordingly, in appeal proceedings, substitution of another party for the original applicant, is possible only once the relevant department of first instance has made the entry or where there is clear-cut evidence of a transfer (**J 26/95** (OJ 1999, 668)).

Under Art. 20 EPC the Legal Division is responsible for decisions in respect of entries in the Register of European Patents and their deletion. An appeal lies to the Legal Board of Appeal, not to a technical board (Art. 106(1) EPC and Art. 21(2) EPC). The entitlement of the patent proprietor entered in the Register of Patents may not therefore be questioned in opposition and subsequent appeal proceedings (**T 553/90**, OJ 1993, 666).

A transfer can be recorded in the Register of European Patents even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application (**J 10/93**, OJ 1997, 91).

4. Suspension of proceedings

Under R. 13(1) EPC the EPO must stay the proceedings for grant ex officio if a third party provides it with proof that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent (see **J 28/94** (OJ 1997, 400)), unless the third party consents to the continuation of such proceedings. The patentee will not be heard but may file a request with the Legal Division not to suspend proceedings. An appeal may be filed against the Legal Division's decision adversely affecting the applicant, proprietor or third party respectively.

A decision of the examining division to grant a European patent (Art. 97(2) EPC) does not take effect on the date the decision-making process following written proceedings before that division is completed, but on the date on which the European Patent Bulletin mentions the grant (Art. 97(4) EPC). In the interim period, proceedings for grant are still pending before the EPO and a request for suspension of proceedings under R.13 EPC is admissible (**J 7/96** OJ 1999, 443)). This decision was followed in **J 36/97**. The respondents raised the issue of the jurisdiction of the Landgericht München I arguing that the appellants' action constituted an abuse of law. The board disagreed, however, pointing out that pursuant to Art. 7 of the Protocol on Recognition, the courts in the Contracting States before which entitlement proceedings were brought were of their own motion to decide whether or not they had jurisdiction pursuant to Art. 2 to 6 of the Protocol. Moreover, according to Art. 9(2) of the Protocol, neither the jurisdiction of the national court whose decision is to be recognised nor the validity of such decision may be reviewed. In connection with R. 13 EPC, it was sufficient for the board to ascertain that the party requesting suspension of the proceedings had opened proceedings against the applicants in a Contracting State for the purpose of seeking a judgement that it was entitled to the grant of the European patent. See also **J 8/96**.

Suspension must be ordered if satisfactory proof of the opening of relevant proceedings before a national court is given to the EPO by a third party, provided that the European patent

application has not been withdrawn or is not deemed to have been withdrawn. If, in accordance with R. 13(3) EPC, the EPO sets a date on which it intends to continue the proceedings for the grant of the European patent, the date may be varied or the order staying the proceedings may be discharged at the subsequent request of the applicant or of the third party who applied for the order (**T 146/82** (OJ 1985, 267)).

Suspension of the proceedings for grant means that the legal status quo existing at the time they were suspended is maintained, ie neither the EPO nor the parties may validly perform any legal acts while the proceedings are suspended (**J 38/92** and **J 39/92**).

5. Notifications

If a representative has been appointed, notifications are addressed to him in accordance with R. 81(1) EPC.

In **J 19/92** the Legal Board of Appeal held that notifications to an applicant's representative are duly made if they were despatched before the representative relinquished his brief. The notification to the applicant does not therefore have to be repeated after the brief has been relinquished. On the contrary, it is the representative who is obliged to inform his client of the notification.

However, in **T 703/92** the written decision and minutes of the oral proceedings were sent not to the authorised representative but to the opponents. The board found that, as the provision relating to notification had not been observed, the question whether a notification had effectively taken place depended (in accordance with R. 82 EPC) on whether and when the representative had received the full decision.

In **J 9/96** the Legal Board of Appeal held that notification of a communication posted as an ordinary letter in accordance with R. 78(2) EPC is deemed to have been made when despatch has taken place. However, if the communication does not reach the addressee and is not returned to the EPO, the legal fiction of deemed notification cannot be applied, unless the EPO can establish that it duly despatched the communication. See also **J 27/97** and **J 32/97**. R. 78(2) EPC has since been amended with effect from 1.1.1999, such that notifications to addressees, who have not appointed a representative and have neither their residence nor a place of business within the territory of one of the Contracting States, are effected by registered letter (OJ 1999, 301, 304). Facsimile transmissions of notifications do not satisfy the requirements of R. 77(1) EPC and cannot therefore be considered as regular notification within the meaning of Art.119 EPC and R. 77 EPC (**J 27/97**).

When establishing the meaning of the term "im Zweifel" in the German version of R. 78(3) EPC (now R. 78(2) EPC), account should be taken of the French and English versions, which assume that there is a dispute ('en cas de contestation', 'in the event of any dispute'). A dispute ('Zweifel', literally 'doubt' in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ('Zweifel') within the meaning of this rule (**T 247/98**).

A communication under R. 85b EPC was handed not to the appellant or his spouse (regulation dated 19.12.1995 to protect customers of the postal service in Germany (RPCPS, BGBl I, page 2 016)) but to a third party not authorised by the appellant to accept it. The said party was in the addressee's business premises, but not an employee. In the board's view, that meant that notification under Section 12(1) and (2) RPCPS had not occurred. Nor did the party qualify under any of the categories of "substitute addressee" defined in Section 13 RPCPS. There was also no evidence that the appellant had ever seen the communication. The board therefore found the EPO had not shown notification to have been properly effected (**J 35/97**).

6. Unity of the European patent application

A patent was owned in one designated state (UK) by one company (A) and in other designated states by another related company (B). Only company B filed an appeal against revocation of the patent. The respondents raised the question whether the revocation decision had become final as regards the UK, where only A had a patent, since the appeal filed by B and the subsequent decision of the board of appeal on it could not affect the decision under appeal with regard to the UK but only with regard to the designated states for which B was the patent proprietor

The board held that the principle of unitary procedure leading up to the grant of one European patent must be taken into account. This principle derived from Art. 118 EPC, which explicitly stated that applicants for different contracting states should, for the purpose of proceedings before the EPO, be regarded as joint applicants or proprietors. Thus the decisions of both first and second instance took effect for all the designated states (**T 119/99**).

N. Interpretation of the EPC

The Vienna Convention on the Law of Treaties applies only to agreements which postdate its entry into force, and therefore not for interpreting the EPC. In **J 8/82** (OJ 1984, 155) the board noted however that it was well recognised that what the Vienna Convention said in its Art. 31 and 32 about the interpretation of treaties merely codified existing public international law. In its first decision (**G 1/83**, OJ 1985, 60), the Enlarged Board of Appeal endorsed this, pointing out that the International Court of Justice, the European Court of Human Rights, the Federal German Constitutional Court and the House of Lords had also applied the principles of interpretation in Arts. 31 and 32 of the Vienna Convention to treaties to which strictly they did not apply. It concluded that the European Patent Office should do the same. Art. 31 of the Vienna Convention says that a treaty must be interpreted in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose. **T 128/82** (OJ 1984, 164) adds that under Art. 32 of the Vienna Convention recourse may also be had to supplementary means of interpretation, such as the international treaty's legislative history (eg the preparatory work and the circumstances in which the treaty was concluded), in order to confirm the meaning arrived at by applying Art. 31 or to determine the meaning when applying Art. 31 leaves the meaning ambiguous or obscure, or produces a meaning which is obviously nonsensical or unreasonable. In **J 4/91** (OJ 1992, 402), for example, the Legal Board of Appeal drew on historical material relating to the EPC to support

its view, arrived at from a teleological and systematic interpretation of the relevant provisions, regarding the additional period for paying renewal fees. **G 1/98** (OJ 2000, 111) discussed the purpose of Art. 53(b) EPC, its relationship to other international treaties and legal texts, and its legislative history. In **G 3/98** and **G 2/99** (OJ 2001, 62 and 83), the Enlarged Board reached its conclusions on Art. 55(1) EPC after interpreting the wording and considering also the legislator's intention and the aspects of systematic, historical and dynamic interpretation.

In **J 8/95** it was held that **Art. 177(1) EPC** was based on the assumption that the authors of the EPC had one intention, which was to be determined using the three versions of the Convention. Even if one language version of a provision were found to differ from the other two versions, no legal consequences could be derived from that version other than could be derived from the other two versions - regardless of the language of the proceedings. A difference in the wording in one language would have to be considered only in so far as it could form one element of the interpretation. In the case at issue, however, the provision under consideration, even in the allegedly different version, could readily be understood in context in the same way as the other two official languages, with the result that all three versions of the provision corresponded as far as content was concerned.

In **J 16/96** (OJ 1998, 347) the issue was whether an association of representatives within the meaning of R. 101(9) EPC could also be formed by professional representatives who did not work in private practice. The Administrative Council of the European Patent Organisation had decided at its 4th meeting in 1978 that an association within the meaning of this rule could only be an association consisting of professional representatives in private practice. The Legal Board of Appeal pointed out that in their decisions the boards of appeal were not bound by any instructions and complied only with the provisions of the EPC (Art. 23(3) EPC). The boards of appeal could not be formally bound to a **decision of the Administrative Council concerning a question of interpretation**, nor could such a decision be deemed to be an instruction for their decisions. However, such a decision was a relevant element in interpretation.

According to the Vienna Convention on the Law of Treaties, the EPC had to be interpreted "in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose" (Art. 31(1) Vienna Convention). According to Art. 31(3)(a) Vienna Convention, "any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions" had also to be taken into account. Interpreting the case in accordance with Art. 31(1) of the Vienna Convention, the board concluded that an association within the meaning of R. 101(9) EPC could also be an association of representatives not engaged in private practice. The intended aim of the Council's decision, which was to eliminate ambiguities in the application of R. 101(9) EPC, had, in the light of recent developments in the profession, not been achieved, and as such the decision was less important in relation to the other factors involved in interpretation.

In **T 557/94** the board discussed the **TRIPS** requirement for the judicial review of decisions revoking a patent. While recognising that the EPO was not a party to TRIPS the board investigated whether the basic principle of judicial review under Art. 32 TRIPS was satisfied by the EPC. It found that in any case, under Art. 111(1) EPC, second sentence, the board of

appeal was empowered either to decide on the merits of the case **or** to remit the case; it was not restricted to the latter alternative if the opposition division maintained the patent and the board was considering revoking the patent for the first time. Reading Art. 32 TRIPS in the context of the usual structure of judicial review in the EPC contracting states and the EPC itself, this provision guaranteed an instance for judicial review in revocation proceedings, but did not oblige the reviewing instance to remit the case to the department of first instance for continuation of proceedings when revocation was being considered by the judicial instance for the first time.

The right of the parties to fair proceedings if a relevant document was introduced only at the appeal stage was a quite different matter. According to the case law of the boards such a procedural situation called for careful consideration.

In **T 1173/97** (OJ 1999, 609, Reasons 2) the board however thought that, although TRIPs could not be applied directly to the EPC, it was appropriate to take it into consideration in connection with the patentability of computer program products. For TRIPs was aimed at setting common standards and principles concerning the availability, scope and use of trade-related intellectual property rights. It thus gave a clear indication of current trends. The appellant's reference to current practice at the US and Japanese patent offices caused the board to emphasise that the legal position in the USA and Japan differed greatly from that under the EPC: only the EPC contained an exclusion such as that in Art. 52(2) and (3) EPC. These developments nevertheless represented a useful indication of modern trends and, in the board's view, could contribute to the further highly desirable (worldwide) harmonisation of patent law.

In **T 452/91** the board took the view that in proceedings before the instances of the EPO, questions of patentability were to be decided solely in accordance with the EPC. No **national decision** should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It could be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might well lead an EPO instance to a similar conclusion under the EPC, but this would first need a careful assessment of the EPC, and of relevant EPO board of appeal case law, a comparison with the legislation and jurisprudence on which the national instance reached its conclusion, and a study of the position in other contracting states.

