

VII. PROCEEDINGS BEFORE THE EPO

A. Preliminary and formalities examination

Under Art. 16 EPC, the Receiving Section is responsible for the examination on filing and the examination as to formal requirements of each European patent application; the revised version of Art. 16 EPC is provisionally applicable under Art. 6 of the Act Revising the EPC dated 29.11.2000. The Receiving Section also publishes the European patent application and the European search report.

The **examination on filing** under Art. 90 EPC relates, in particular, to the assessment whether the European patent application satisfies the requirements for the accordance of a date of filing in conformity with Art. 80 EPC (see Art. 90(1)(a) EPC). If the European patent application fails to meet these requirements, the Receiving Section will inform the applicant that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within one month. If the applicant does so, he will be informed that the date of filing is the date on which the requirements of Art. 80 EPC were met (R. 39 EPC).

The **examination as to formal requirements** under Art. 91 EPC starts, if a European patent application has been accorded a date of filing, provided that the application is not deemed to be withdrawn because the filing fee and the search fee had not been paid or the translation under Art. 14(2) EPC had not been filed in due time. Additionally R. 40 EPC to R. 43 EPC must be taken into account.

1. Accordance of a date of filing

1.1 Language of the filed documents

In **J 18/96** (OJ 1998, 403), a request for grant of a European patent was filed on 2.2.1995 together with a **description in English** in the form of a scientific article, a **claim in German**, a German abstract and drawings with explanations in German and English. The filing and search fees were not paid, even after a communication under R. 85a(1) EPC was sent. On 17.11.1995, the applicant requested that a priority document be issued. The Receiving Section refused this request on the grounds that the application could not be accorded a filing date.

The board confirmed that the requirements of Art. 80 EPC for the accordance of a filing date were not met if the description and claims were filed in two different official languages, in which case the patent application was not legally valid. Although it did not do so in the case in question, the Receiving Section should have given the applicant the opportunity to remedy the easily corrected deficiency in accordance with Art. 90(2) EPC in conjunction with R. 39 EPC. However, it did issue a filing number and, in further correspondence, led the applicant to the legitimate belief that the application had been validly filed. In accordance with the principle of the protection of legitimate expectations, the application had to be accorded the filing date of 2.2.1995 and this had to be confirmed in the requested priority document, even

if the application had since been deemed to have been withdrawn because of non-payment of fees. The accordane of a filing date was not dependent on the payment of fees.

In **T 382/94** (OJ 1998, 24) the **application** was filed in **German**. The **drawings**, however, contained flow sheets **with text matter in English**. The board decided that an application could be accorded a filing date where the claims and description were filed in the language of proceedings. However, the accordane of a filing date was not dependent on any text matter in the drawings being in a language in accordane with Art. 14(1) or (2) EPC. The accordane of a filing date related to the whole of the application documents filed. In the case in question, the English text matter in the flow sheets was thus part of the original disclosure, and amending the application on the basis of a translation into German of these passages did not, contrary to the opinion of the examining division, represent an infringement of Art. 123(2) EPC.

In **J 15/98** (OJ 2001, 183) the European patent application was filed in Spanish with the Spanish Patent and Trademarks Office (PTO) the day before the last day of the priority year and forwarded to the EPO some days later. The core of the problem was that the applicant did not have her residence or principal place of business in an EPC Contracting State and was not a national of an EPC Contracting State either. The EPO Receiving Section did not accord the date of filing the application with the Spanish PTO as date of filing under Art. 80 EPC.

The Legal Board of Appeal took the view that it depended on the interpretation of Art. 80(d) EPC in conjunction with Art. 14(1) and (2) EPC whether the date of filing the application with the Spanish PTO could be accorded as filing date. It held that according to the literal construction of Art. 80(d) EPC it seemed to be clear that the reference to Art. 14 EPC was made only to identify the possible languages to be used. No reference was made to the entitlement to use these languages. Spanish was an official language of a Contracting State. Pursuant to Art. 14(2) EPC it was possible to use Spanish to file an application. Thus, under the EPC an application filed in Spanish could be accorded a filing date. The effects deriving from the filing date could not depend solely on the nationality of the applicant since there was no ground for discrimination in this respect. The Legal Board of Appeal ordered that the date of filing the Spanish version of the patent application with the Spanish PTO be accorded as date of filing within the meaning of Art. 80 EPC.

1.2 Request for grant

J 21/94 of 20.1.1997 is the final decision in a case in which an interlocutory decision of 12.4.1995 (OJ 1996, 16) had led to a referral to the Enlarged Board of Appeal (**G 2/95**, OJ 1996, 555). When filing the request for grant in respect of invention A, the applicant had inadvertently submitted the description and claims for invention B. Replacement of the wrong documents by the right ones under R. 88 EPC was, according to **G 2/95**, not possible.

The Legal Board of Appeal decided that, despite the discrepancy between the request for grant, which named invention A, and the documents furnished, which related to invention B, a filing date could be accorded to invention B, the invention actually disclosed. A central requirement of Art. 80 EPC was the disclosure of an invention according to paragraph (d),

which could no longer be corrected after the date of filing (Art. 123(2) EPC). Art. 80(a) EPC merely covered an obvious prerequisite for proceedings, namely that the grant proceedings could only be started when the person filing the documents pertaining to an invention within the meaning of Art. 80(d) EPC indicated that he wished these proceedings to be initiated. To do this applicants did not have to use a request for grant form nor did they have to give the title of the invention. If these formal requirements were omitted or if they contained errors, these deficiencies could be remedied at any time. Having no knowledge of the applicant's subsequent actions and explanations, the Receiving Section had to assume, when the application was filed, that the applicant was seeking protection for the invention actually disclosed, that is invention B.

No filing date could be accorded to invention A, which was also disclosed during the grant proceedings by virtue of the filing of the relevant claims and description, nor could a separate grant procedure be initiated for it if it was not obvious that protection was being sought for this invention. The latter required it to be obvious, on the basis of the disclosure of A **and** a request for grant pertaining to A, that protection was being sought. That could be the case if the description and claims in respect of invention A were actually filed together with a letter stating clearly that protection was being sought for A, that it should be accorded at least the date on which these documents were filed as its date of filing, and that a grant procedure for A should be initiated.

1.3 Claims

In **J 20/94** (OJ 1996, 181) the Legal Board of Appeal referred the question to the Enlarged Board of Appeal whether, for a filing date to be established in respect of a European patent application, it was necessary for the filed application to contain, in addition to a description, at least one claim formulated separately from the description and recognisable as such. If the answer to this were no, it was to be clarified whether for a filing date to be established within the meaning of Art. 80 EPC it was sufficient if there was at least one claim which, although not expressly formulated as such, was derivable from the invention as described, and to what extent a claim not expressly formulated as such had to be derivable. The patent application in question was, however, withdrawn shortly afterwards, with the result that the Enlarged Board of Appeal was no longer able to take a decision on the merits.

2. Application documents

2.1 Filing of application documents

The boards of appeal accepted early on that application documents could be filed by facsimile means (**J 20/84**, OJ 1987, 95). Since then, the legal basis for filing by fax has been set out in the decision of the President of the EPO dated 26.5.1992 on the use of technical means of communication for filing patent applications and other documents (OJ 1992, 299) and in the Notice from the EPO dated 2.6.1992 (OJ 1992, 306).

Two decisions point out the need to ensure - if the applicant wishes to be accorded a particular date of filing - that application documents are actually received by the EPO itself or by a competent national authority by that date. This is particularly important where

applications are filed by post.

In **J 18/86** (OJ 1988, 165) the board stated that under R. 24 EPC in conjunction with Art. 75(1)(b) EPC the date of filing of a European application was always the date on which the application documents were actually received, either by the EPO directly or by a competent national authority. R. 24 EPC provided a comprehensive and self-sufficient system in accordance with which the EPO could determine the date of filing of a European patent application wherever (in accordance with Art. 75(1) EPC) it was filed. Nothing in the EPC admitted of the possibility of applying a provision of any national law to the determination of the date of filing of a European patent application.

In **J 4/87** (OJ 1988, 172), as a result of an unforeseeable postal delay, a European patent application posted in the United Kingdom on 4.12.1985 did not reach the EPO until 11.12.1985. The application claimed priority from 8.12.1984. The postal delay was due to a general interruption in the delivery of mail in the United Kingdom during the period from 15.11. to 5.12.1985 inclusive. Time limits expiring within that period were extended to 6.12.1985 pursuant to R. 85(2) and (3) EPC. Thus, in that particular case, the 12-month time limit for claiming priority expired outside the period of interruption of mail specified in the President's notice. The appellant asked for an individual extension of the time limit on the grounds that nothing in the EPC prevented the EPO from allowing discretion in cases where the applicant might suffer hardship due to exceptional delays in the post. The appeal was dismissed since nothing in the EPC enabled the EPO to accord a date of filing for an application other than that on which the main documents making up the application were received by the competent authority. In consequence, the principles set out in decision **J 18/86** above applied equally to an application filed direct with the EPO in Munich.

2.2 Subsequent filing of drawings

In **J 19/80** (OJ 1981, 65) it was held that if a part of a drawing is missing, the missing part is not to be considered as a missing drawing for the purposes of R. 43 EPC; the whole figure is to be considered as an incorrect drawing. The correction of drawings is dealt with in R. 88 EPC. However, according to **G 3/89** and **G 11/91** (OJ 1993, 117 and 125), the priority documents cannot support a correction under R. 88 EPC, second sentence. If a sheet including two complete figures is filed late, these cannot be considered incorrect drawings for the purposes of R. 88 EPC. The late filing of one or more complete figures is dealt with in R. 43 EPC (**J 1/82**, OJ 1982, 293).

2.3 Replacing the invention

R. 88 EPC gives the EPO discretion in allowing corrections. In **J 21/85** (OJ 1986, 117) the Legal Board had held that R. 88 EPC did not permit an invention covered by a request for grant of a patent to be exchanged for another, even if a request for correction under R. 88 EPC was submitted immediately the application had been filed and it was demonstrated beyond doubt that the inventions were unintentionally confused.

In **T 726/93** (OJ 1995, 478), however, the board exercised its discretion by allowing the erroneously filed wrong claims and description to be replaced by the documents which the

appellant had actually intended to file.

In **J 21/94** (OJ 1996, 16) doubts were raised about **T 726/93** and the following question was referred to the Enlarged Board: "Can the complete documents forming a European patent application, that is the description, claims and drawings, be replaced by way of a correction under R. 88 EPC by other documents which the applicant had intended to file with his request for grant?" In **G 2/95** (OJ 1996, 555), the Enlarged Board ruled that they could not.

In decision **J 21/94**, taken on 20.1.1997 and terminating these appeal proceedings, the Legal Board concluded that the originally disclosed invention B could be accorded a filing date even if there were contradictions between the request for grant (which related to invention A) and the application documents (which disclosed invention B). If a further invention (here invention A) was disclosed during grant proceedings, it could not be given a filing date unless it was clear that protection for this invention was now sought (see also page 404).

2.4 Extent of competence of the Receiving Section

R. 88 EPC, second sentence, lays down as a condition for acceptance of a request for correction concerning a description, claims or drawings that a correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction. This often requires a technical examination of the file, so that the question arises whether the Receiving Section is competent to deal with the correction in such a case.

In decision **J 4/85** (OJ 1986, 205) the board made it clear that the duties of the Receiving Section did not include a technical examination of the file; it should not, therefore, take a decision on a request for correction necessitating such an examination, but should leave the request in abeyance until the file had been transferred to the examining division. However, in **J 33/89** (OJ 1991, 288) the board pointed out that the Receiving Section remained competent for decisions on requests for correction of drawings under R. 88 EPC, second sentence, unless the request necessitated a technical examination.

3. Identity of the applicant

In **J 25/86** (OJ 1987, 475) it was pointed out that the requirement of Art. 80(c) EPC for "information identifying the applicant" was to be considered to be met whenever it was possible to establish beyond reasonable doubt the identity of the applicant on the basis of all data contained in the documents filed by the applicant or his representative.

In Art. 60(3) EPC the principle is established that the EPO assumes the applicant to be entitled to the European patent. This fiction only relieves the EPO of any need to investigate the existence of the entitlement. However, when a person referred to in Art. 60(1) EPC, other than the applicant, disputes the entitlement to the grant of a European patent, the entitlement may be modified under the conditions provided for in Art. 61 EPC.

Following **J 7/80** (OJ 1981, 137) it was held in **J 18/93** (OJ 1997, 326), **J 17/96** and **J 31/96** that a correction substituting the name of the applicant was allowable under R. 88 EPC if

there was sufficient evidence to support the request for correction. This rule was not in conflict with the provisions of Art. 61 EPC, which concerned ownership disputes. R. 88 EPC, second sentence, was not applicable. It was only necessary to verify whether there was sufficient evidence to support the request under R. 88 EPC for correction of the applicant's name: where the correction of a mistake was requested and the second sentence of R. 88 EPC was not applicable, the EPO had to be satisfied that a mistake had been made, what the mistake was and what the correction should be. In order to avoid any abuse, the burden of proving the facts had to be a heavy one (**J 8/80**, OJ 1980, 293).

A correction under R. 88 EPC, first sentence, was retroactive to the original date of filing (**J 3/91**, OJ 1994, 365, point 4.3; **J 2/92**, OJ 1994, 375, point 5.2.2) and the application was restored to the form which it should have taken on the filing date if the error had not been made (**J 4/85**, OJ 1986, 205).

4. Designation of states

4.1 Article 79(2) EPC, old version

Under Art. 79(2) EPC as in force until 30.6.1997, designation fees had to be paid before the European patent application was published, namely within 12 months of the date of filing or, if priority was claimed, within 12 months of the priority date or within one month of filing the subsequent European patent application (whichever was the later date).

In **J 8/80** (OJ 1980, 293) the Legal Board of Appeal interpreted R. 88 EPC, first sentence, as meaning that a correction was not precluded by virtue of its not being "obvious" within the meaning of R. 88 EPC, second sentence. Moreover a mistake could result from an omission. The Legal Board accordingly ruled that the designation of states was correctable if it could be shown which states ought in fact to have been designated (**J 4/80**, OJ 1980, 351; **J 12/80**, OJ 1981, 143) and if a request for correction was made in time for a warning to be given when the patent application was published (**J 3/81** (OJ 1982, 100), **J 21/84** (OJ 1986, 75)). According to **J 10/87** (OJ 1989, 323), subject to certain narrowly circumscribed conditions, the withdrawal of a contracting state's designation was correctable after publication of the European patent application (see "Case Law of the Boards of Appeal of the EPO", 2nd (1996) edition, page 265). New Art. 79(2) EPC has now superseded this case law as regards correction of designation of states.

4.2 Article 79(2) EPC, new version

Since 1.7.1997, under new Art. 79(2) EPC, designation fees are now payable up to six months from the date on which the European Patent Bulletin mentions the publication of the European search report. Thus a new designation system applies to EP applications filed as from 1.6.1997. Precautionary designation of all EPC contracting states has been replaced by **express designation of all states party to the EPC** on the date of filing. Those states for which designation fees have been validly paid, and where under R. 23a EPC the application is thus comprised in the state of the art, are published in the European Patent Bulletin (see Supplement to OJ 5/1999).

Under the old rules, **J 14/90** (OJ 1992, 505) and **J 18/90** (OJ 1992, 511) laid down principles about designating states which only became party to the EPC a few days after the EP application was filed, and **J 30/90** (OJ 1992, 516) ruled that a PCT application could give rise to a European patent only in states for which the EPC too was in force when the international application was filed (see "Case Law of the Boards of Appeal of the European Patent Office", 2nd (1996) edition, page 266).

Also under the old rules, in **J 25/88** (OJ 1989, 486) the Legal Board of Appeal ruled, in the case of an application for which Form 1001 had not been used, that the absence from the (otherwise adequate) documents filed by the applicant of an explicit designation of a particular contracting state (a requirement under Art. 80(b) EPC for according a date of filing) was to be considered as a precautionary designation of all the contracting states.

4.3 Effect of non-payment of designation fees

On 5.10.1998 the EPO President asked the Enlarged Board of Appeal under Art. 112(1)(b) EPC whether deemed withdrawal following failure to pay designation fees meant that the designation was of no legal effect and deemed never to have taken place [...] or whether deemed withdrawal under Art. 91(4) EPC was effective only from a later date.

The statement which gave rise to this referral of a point of law to the Enlarged Board by the President of the EPO was the Legal Board's observation (**J 22/95**, OJ 1998, 569) that the deemed withdrawal of a designation as a consequence of non-payment of the designation fee had effect from the outset, ie the designation was invalid ab initio. However, EPO practice is based on the assumption that this deemed withdrawal only has effect ex nunc, ie on expiry of the term for payment of designation fees.

In **G 4/98** (OJ 2001, 131), the Enlarged Board of Appeal found that there was no support under the European patent system for the view that failure to pay designation fees in due time had the effect that the designations disappear retroactively as if they had never existed. On the contrary, the board pointed out that the wording of Art. 78(2) EPC and Art. 79(2) EPC and the system clearly indicate that up to the due date for payment of the designation fees, the designations deploy their full effects. Only if the designation fees were not paid in due time, would the designations not have any effect with respect to acts to be performed after that date, such as the filing of a divisional application. Retroactivity of the effects of non-payment of designation fees would occur only where the EPC explicitly provides for it, ie in the case of provisional protection (Art. 67(4) EPC).

The board also found that a non-retroactive effect of the deemed withdrawal of designations due to the failure to pay the corresponding fees would allow the situation in respect of **divisional applications** to be dealt with appropriately. According to the approach of **J 22/95**, all divisional applications filed before the due date of the payment of designation fees for the parent application would disappear if the designation fees were not paid in due time, because the designations would be deemed never to have taken place and thus the requirement of Art. 76(2) EPC could not be met, namely that the divisional application shall not designate Contracting States which were not designated in the earlier application. To avoid this consequence, the applicant would be forced to pay the designation fees for the parent

application, even if he had lost all interest in it, for example due to an unfavourable search report. By contrast, the board pointed out that an **ex nunc** effect of the deemed withdrawal of designations due to the non-payment of the corresponding fees meant that failure to pay these fees did not affect the validity or the geographical extent of the divisional application. The applicant might designate all Contracting States designated in the parent application in the divisional application, and he might proceed with all of them even if in respect of the parent application he later paid only some or no designation fees. This was in line with the fact that the procedure concerning the divisional application was in principle independent from the procedure concerning the parent application and that the divisional application was treated as a new application.

The second question submitted by the President of the EPO related to the date from which the deemed withdrawal of the designation of a Contracting State took effect. The Enlarged Board of Appeal held that since in its opinion no general retroactive effect was attached to the fact that a designation was deemed to be withdrawn, the deemed withdrawal necessarily took effect upon expiry of the time limits mentioned in Art. 79(2) EPC, R. 15(2) EPC, R. 25(2) EPC and R. 107(1) EPC, as applicable, and not upon expiry of the period of grace provided by R. 85a EPC.

4.4 Correction of designation of states in Euro-PCT applications

J 17/99 (see also Chapter IX, The EPO acting as a PCT authority) explained that with respect to corrections of designations in Euro-PCT applications, the same principles shall apply as for Euro-direct applications.

J 27/96 concerned a Euro-PCT application designating all the then 17 EPC contracting states for a European patent. Owing to a misinterpretation of the designation instructions, the representative only designated 10 states and paid 10 designation fees on entry into the regional phase. After expiry of the time limit under R. 85a(2) EPC, the appellant filed a request for correction under R. 88 EPC to the effect that the remaining states be designated, and paid the respective fees. The Legal Board held that although its case law had in principle allowed a designation to be added under R. 88 EPC, failure to pay a fee in due time could not be remedied under that Rule.

The appellant's auxiliary request to replace states expressly indicated as states for which designation fees had been paid upon entry into the regional phase by states designated only later by way of correction under R. 88 EPC likewise failed. The appellant had never contended nor submitted any proof that the original designation had been made erroneously. In this context, the appellant had argued that were his main request, ie the addition of the omitted designations, to be allowed, more states would be designated than fees paid. In this situation, the EPO would have been obliged to ask the applicant for which states the fees paid were intended and the most important states could have been chosen. The Legal Board objected, pointing out that the retroactive effect of the correction did not mean that the applicant was reinstated in the procedural phase when designations had to be made and fees paid or that, in consequence, the whole procedure in that phase would be available to him again. Correction of a mistake was an isolated procedural measure and not a case of re-establishment into a procedural phase as a whole.

5. Divisional applications

5.1 Time of filing a divisional application

In **G 10/92** (OJ 1994, 633) the Enlarged Board of Appeal considered the question of the point in time up to which an applicant could file a divisional application on a pending earlier European patent application.

The President of the EPO had referred this point of law in accordance with Art. 112(1)(b) EPC, pointing out that the ruling in the two consolidated cases **J 11/91** and **J 16/91** (OJ 1994, 28) was at variance with that in **T 92/85** (OJ 1986, 352). In **J 11/91** and **J 16/91** the Legal Board of Appeal had taken the view that an applicant could, notwithstanding R. 25(1) EPC (in the version which entered in force on 1.10.1988), still file a divisional application up to the date of the decision to grant pursuant to Art. 97(2) EPC.

In its opinion, however, the Enlarged Board of Appeal concluded that under the amended version of R. 25 EPC in force since 1.10.1988 an applicant could only file a divisional application on the pending earlier European patent application up to the approval in accordance with R. 51(4) EPC. Art. 76(3) EPC contained a general authorisation for laying down the procedure for filing European divisional applications. This general authorisation also allowed the Administrative Council to determine the point in time up to which a European divisional application could be submitted. R. 25 EPC was therefore consistent with Art. 76(3) EPC and hence was also reasonable and appropriate.

The Enlarged Board of Appeal pointed out that while the approval pursuant to R. 51(4) EPC was a procedural statement, and hence could be withdrawn, the mere fact that approval could be withdrawn did not mean that applicants who withdrew approval then acquired the right to file a divisional application. If, however, the examination procedure was **reopened** after the approval in accordance with R. 51(4) EPC, it was, for the purposes of R. 25 EPC, the last approval given by the applicant during proceedings that was decisive, ie the point at which it was clear that the applicant approved the final text proposed by the examining division. The same was true of appeal proceedings if the board of appeal concluded that the patent had to be amended prior to grant. The applicant then had to approve the amended text again. The Enlarged Board noted that R. 25 EPC as amended is perfectly reasonable and appropriate.

In **J 36/92** the appellant approved the text of the patent application according to R. 51(4) EPC, stating in the same letter, "We have today filed a divisional application including". However, the divisional application reached the EPO one day after the applicant's letter. The board referred to **J 13/84** (OJ 1985, 34) and stated that from the wording of the letter it was apparent that the two pieces of information had to be seen as correlated and mutually dependent on each other. Where an applicant approved the text of a European patent application pursuant to R. 51(4) EPC and in the same letter stated that he had that day filed a divisional application, the filing of the divisional application should be allowed, whether or not it was actually received by the EPO together with the letter (see also **J 27/94**, OJ 1995, 831).

In **J 29/96** (OJ 1998, 582) the board held that where consent has been given to the text of an earlier application pursuant to R. 51(4) EPC, then withdrawal of this consent for the sole purpose of filing a divisional cannot re-open the period in which a divisional application can be filed (see **G 10/92**, 1994, 633). In **J 3/99** the Legal Board, (referring to **G 10/92**, OJ 1994, 633, point 5 of the reasons) stated that the mere fact that **after** a communication under R. 51(6) EPC had been issued, an applicant withdrew its prior approval by filing amendments did not mean that it acquired the right to file a divisional application. This right lapsed on the deadline set by R. 25(1) EPC, i.e. when the text in which the European patent was to be granted was validly approved in accordance with R. 51(4) EPC.

J 14/95, **J 15/95**, **J 16/95**, **J 17/95**, **J 24/95**, **J 25/95** and **J 30/95**, all of which relate to a similar set of facts, considered the question of whether an application had to be treated as a divisional application despite the fact that, prior to its being filed, the applicants had indicated their approval of the text of the parent application intended for grant. Citing R. 25(1) EPC and the opinion of the Enlarged Board of Appeal in **G 10/92** (OJ 1994, 633), the Receiving Section refused to treat the relevant applications as divisional applications. The appellants thereupon argued that, in view of the publication of **J 11/91** and **J 16/91** (OJ 1994, 28) and applying the principle of the protection of legitimate expectations, a divisional application could still be filed even after approval pursuant to R. 51(4) EPC had been given, since at the time the Enlarged Board of Appeal's opinion in **G 10/92** had not yet been made available to the public. The Legal Board of Appeal pointed out that the publication of **J 11/91** and **J 16/91** (OJ 1994, 28) did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. As early as in **J 27/94** (OJ 1995, 831) it had been stated that the department of first instance was not obliged by the principle of good faith to allow the filing of divisional applications after the approval of the text intended for grant on the basis of decision **J 11/91** until such time as opinion **G 10/92** (OJ 1993, 6) had been made available to the public (see also "Protection of legitimate expectations", p. 251).

In **J 4/96** the applicants had not filed a divisional application until three months after they had issued their statement of approval pursuant to R. 51(4) EPC. One of the lines of reasoning advanced by the applicants in support of their action cited **J 27/94** (OJ 1995, 831), arguing that, having earlier not ruled out the option of filing divisional applications, their approval had been subject to a condition and hence invalid. The board was unable to endorse this interpretation on the grounds that a period of almost seven months had elapsed between the applicants' statement reserving their right to file divisional applications and their giving clear - and from the wording unconditional - approval of the text intended for grant. The applicants had therefore given their approval without any reference whatsoever to any intention on their part to file divisional applications, in contrast to the position in **J 27/94**, where one and the same statement had signalled both approval and the intention to file a divisional application. The applicants also argued that the time limit for stating their approval had yet to expire when they filed their divisional application. While agreeing that this was indeed so the board pointed out that this was not the point at issue in the wording of R. 25(1) EPC, since R. 25 EPC did not address the issue of the **time limit** within which approval had to be given but the **point in time** at which it actually was given.

In **J 21/96** the Legal Board explained that R. 25(1) EPC did not stipulate a time limit within the

meaning of Art. 122(1) EPC. It merely identified a point in the grant procedure after which a divisional application might no longer be filed. This point was decided upon by the applicant when he gave 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.

Following an appeal against the refusal of a European patent application a technical board decided to remit the case to the examining division with the order to grant the patent on the basis of a set of documents submitted in oral proceedings. The examining division issued a communication under R. 51(6) EPC. The applicant requested that the communication be withdrawn and a communication under R. 51(4) EPC be issued in order to allow the filing of a divisional application. The applicant was informed that a communication under R. 51(4) EPC could no longer be issued since he had already approved the text intended for grant during the oral proceedings before the board of appeal. He appealed. In **J 8/98** (OJ 1999, 687) the Legal Board of Appeal held that, in the absence of exceptional circumstances, approval of the text in which the patent was to be granted was implied in the appellant's request that a decision be taken on the basis of the text submitted to the technical board. However, the Legal Board refrained from applying R. 25(1) EPC by analogy to this situation. The approval given in oral proceedings before a board of appeal was not equivalent to approval given in reply to a communication under R. 51(4) EPC. The filing of a divisional application after remittal to the department of first instance was therefore not excluded. The choice of the appropriate deadline for filing a divisional application in the situation under consideration appeared to be a matter of legislative discretion.

5.2 Payment of designation fees and divisional applications

In **J 19/96** the Legal Board stated that only such states may be designated in a divisional application as were still validly designated in the parent application at the filing date of the divisional application. Inasmuch it confirmed **J 22/95** (OJ 1998, 569). There was no doubt that the effect of deemed withdrawal of the designation on the protection under Art. 67(4) EPC was that protection for the respective state had never come into existence; this also applied where the designation for which no designation fee had been paid was, in accordance with Art. 91(4) EPC, as such, ie as a procedural declaration, only deemed to be withdrawn with effect ex nunc, on expiry of the term for payment. Thus, the core of the reasoning in **J 22/95** that it would be unjustifiable for rights already lost in the parent application at the filing date of the divisional application to be resurrected by filing a divisional application, remained valid for cases such as the one in question, where the designation was undoubtedly deemed withdrawn when the divisional application was filed.

6. Correction of priority declarations

Early on the Legal Board allowed correction of state designation under R. 88 EPC, first sentence (**J 8/80**, OJ 1980, 293; **J 12/80**, OJ 1981, 143; **J 3/81**, OJ 1982, 100; **J 21/84**, OJ 1986, 75). Shortly afterwards the rather strict principles developed in these decisions were also applied in cases where correction of priority declarations was at stake. Although a mistake correctable under R. 88 EPC, first sentence, can be an incorrect statement or the result of an omission, all the previous cases related to omitted priority declarations (**J 3/82** (OJ 1983, 171), **J 4/82** (OJ 1982, 385), **J 14/82** (OJ 1983, 121), **J 11/89**, **J 7/90** (OJ 1993,

133)).

In the four decisions **J 3/91** (OJ 1994, 365), **J 6/91** (OJ 1994, 349), **J 9/91** and **J 2/92** (OJ 1994, 375), the Legal Board refined the principles to be applied to corrections of priority declarations. In **J 6/91** it analysed and summarised the previous case law, pointing out that the applicant had to prove a mistake, ie that the document filed with the EPO did not express the true intention of the person on whose behalf it was filed. In the earlier decisions the burden of proof on the applicant was defined as a heavy one. In **J 9/91**, however, the board now took the view that the omission of a priority declaration would, in nearly every case, be an error. Thus, as a general rule, there was no need in cases of this kind to require special evidence to discharge the burden on the applicant of proving that a mistake had been made.

Despite the fact that R. 88 EPC, first sentence, allowed correction without any time bar, the Legal Board followed the established case law requiring a request for correction of a priority claim to be made sufficiently early for a warning to be included in the publication of the application (**J 3/82** (OJ 1983, 171), **J 4/82** (OJ 1982, 385), **J 14/82** (OJ 1983, 121)). This principle was upheld because the EPO, when exercising its discretionary power under R. 88 EPC, first sentence, had to balance the applicant's interest in gaining optimum protection and a third party's interest in maintaining legal security and, in particular, in ensuring that the published application data were correct.

The board noticed, however, that the previous case law in special circumstances already allowed the correction even without such a warning:

(1) if the EPO was partly responsible for the fact that no warning was published (**J 12/80**) and/or

(2) if the interest of the public was not seriously affected because

(a) the mistake was obvious (in this sense, implicitly, **J 8/80**);

(b) only a second or further priority was added (**J 4/82**, **J 14/82**, **J 11/89**);

(c) the public was otherwise informed about the full scope of protection sought by the applicant (**J 14/82**).

In **J 3/91**, **J 6/91** and **J 2/92** it was held that even after publication of a European patent application without a warning, the priority declaration could be corrected under R. 88 EPC, first sentence, provided that there was an **obvious discrepancy** in the published application indicating that something was wrong. In such a case the interests of third parties were not adversely affected by the correction.

In **J 3/91** the board held that an experienced practitioner could have noticed the obvious discrepancy because the claimed Japanese priority date (31.12.1983) and the European application date (3.1.1984) were close together and the Japanese file number was mentioned.

In **J 6/91** the international application in suit claiming priority from a US continuation-in-part application was itself presented as a continuation-in-part application and referred back to an

earlier US application. In view of this and other special circumstances, the board allowed the addition of a (first) priority claim referring to the earlier US application.

In **J 2/92** the US priority date claimed for a PCT application was, owing to a clerical error, a Saturday when the USPTO was closed, instead of the previous Friday. The correct date was indicated on the priority document. Owing to a further clerical error in the request for transmittal of priority documents under R. 17.1(b) PCT (a typing error in the document number), the Receiving Office - in this case the USPTO - transmitted the wrong document to WIPO. The board allowed its replacement even after publication of the international application, adding, however, that this might not always be possible.

In the parallel cases **T 972/93** and **T 973/93** the examining division refused a request for the priority date to be corrected. European patent application E1 claimed the priority of a French application F1, from which two French divisional applications F2 and F3 were filed within the priority year claiming the priority of the parent application. The matter at issue in **T 972/93** and **T 973/93** were European applications E2 and E3, which claimed the priority of F2 and F3 respectively. In error however, the filing date of F2 and F3 was given as the priority date. This mistake was detected during examination proceedings, after E2 and E3 had been published with the wrong priority date, because E1 was discovered as a prior right within the meaning of Art. 54(3) EPC.

Following **J 6/91** (OJ 1994, 349) in particular, the board of appeal allowed the correction, ruling that the mistake was apparent, because only eight months separated the filing date of E2 and E3 from the incorrect priority date, whereas the priority year was usually exploited to the full. The interests of third parties had not been adversely affected because the precautionary filing of two European divisional applications with respect to E1, which had the same content as F2 and F3, made it possible to gain protection for the subject-matters of E2 and E3 with the priority of F1.

On the other hand, in **J 7/94** (OJ 1995, 817) the board did not allow the correction. It held that the mere fact that an existing priority was not claimed could not justify adding this priority by correction. For these reasons the board maintained its practice that a correction after publication could only be allowable under special circumstances, in particular, if it was apparent on the face of the published application that a priority was wrong or missing. The board stated that it was not sufficient, as suggested by the appellant, that a mistake might be detected after consulting the priority document, since the published data as such should be reliable at the publication date. In the case at issue it was not apparent even from the priority document as filed relating to the priority indicated in the request form that the priority data were not correct (see **T 796/94**).

The appellant's argument that the interest of the public was not affected by the addition of a second or subsequent priority was also rejected. It was true that in such a case the publication of the application was not delayed. Nevertheless, the addition of a priority of a later date than the priority erroneously claimed might also affect the public because any additional priority was relevant for the evaluation of the validity of the patent.

In **J 11/92** (OJ 1995, 25) the priority of four UK applications was claimed for the European

patent application. After the technical preparations for publication of the European application had been completed the applicant requested the addition of an omitted priority. It was explained that the third priority disclosed 24 examples. However, two weeks before the third priority the applicant had filed a UK application which had been inadvertently overlooked in the European filing. This UK application already disclosed 21 of the 24 examples. Accordingly the earlier application was the first one to disclose the subject-matter of these 21 examples, while the latter one was the second to do so, and, thus, provided no basis for priority in respect of the common subject-matter. The Receiving Section refused the request for correction because it was not filed sufficiently early for a warning to be included in the publication of the application.

Following established case law the Legal Board pointed out that a correction under R. 88 EPC, first sentence, was at the discretion of the competent authorities and that the interest of the applicant in gaining optimum protection and the interest of the public in legal security were to be balanced. Applying this basic principle to the present case the board allowed the requested addition of a fifth priority claim. It took into account the fact that the appellant filed in due time, as a precautionary measure, a second application claiming priority from the omitted UK application. By this "auxiliary" application the parties were informed of the full scope of European patent protection sought. In addition, the public was fully informed of the scope of European patent protection sought as far as the subject-matter was concerned since the examples disclosed in the omitted priority application were covered by the first and third priority applications. Finally, the board took into account the fact that the applicant acted promptly after detection of the mistake and that the patent grant procedure, including publication of the application after 18 months, had not been held up in any way.

7. Filing of priority documents

In **J 1/80** (JO 1980, 289) it was stated that R. 38(3) EPC permitted an applicant to file certified copies of the priority documents at any time before the end of the sixteenth month after the date of priority. There was only a deficiency if the priority documents had not been filed at the end of the period. It could only be said that there was a deficiency thereafter and the applicant had to be given an opportunity to remedy that deficiency within a further period (Art. 91(2) EPC, R. 41(1) EPC, R. 84 EPC). There was a loss of rights only if the applicant did not take advantage of that opportunity.

In **J 11/95** a Euro-PCT application had been filed. The applicant was unable to file the priority document either on entering the regional phase or when invited to do so by the EPO in a communication under R. 41(1) EPC.

The Legal Board pointed out that R. 17.1(a) PCT prescribed that a certified copy of the national application whose priority was claimed had to be submitted by the applicant to the International Bureau not later than 16 months after the priority date, unless already filed with the receiving office. If this requirement was not complied with, any designated State may disregard the priority claim (R. 17.1(c) PCT). The EPC did not make use of the latter option.

Pursuant to R. 104b(3) EPC, where the priority document provided for in Art. 88(1) EPC and R. 38 EPC had not yet been submitted at the expiry of the 21 or 31 months period for entry

into the regional phase, the European Patent Office shall invite the applicant to furnish the same within such period as it shall specify. The failure to comply with this invitation leads to a loss of the right of priority. Thus, in the present case, the Receiving Section was correct in noting, based on Art. 91(3) EPC and R. 69 EPC, the loss of the right of priority for the present patent application.

The board added that there was a public interest in knowing whether and to what extent a priority claim was justified. In this context, the provisions of R. 38(3) EPC and R. 104b(3) EPC ensured that a certified copy of the previous application was available to third parties requesting a file inspection in due time after publication or entry into the regional phase. In the circumstances of the present case, these objectives were not achieved through the filing of a certified copy of the previous application by another applicant with reference to his own international application. Obviously, the files of the appellant's application would not have revealed this document, included in a completely unrelated file.

8. Applicability of Article 110(3) EPC

If the appellants fail to reply in due time to an invitation under Art. 110(2) EPC, the European patent application is deemed to be withdrawn under Art. 110(3) EPC even if the appeal relates to formal points, as the effect of the appeal, namely that the board of appeal is now competent for the case, applies to the entire application (**J 29/94**, OJ 1998, 147; see page 505).

9. Publication of the application

In **J 5/81** (OJ 1982,155) it was stated that the key date for completion of the technical preparations for publication under Art. 93 EPC specifiable pursuant to R. 48(1) EPC could be said to give the applicant a certain minimum period of time within which his withdrawal of the application also prevented its publication. If the application was not withdrawn until after the key date, the applicant could no longer rely on its not being published. Nevertheless, the EPO was allowed by law to prevent publication, at its own discretion.

B. Examination procedure

1. Request for examination

According to Art. 94(1) EPC, the EPO shall examine, on written request, whether a European patent application and the invention to which it relates meet the requirements of the EPC. Art. 94(2) EPC states that a request for examination may be filed at any time from the date of filing of the application up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report.

In **J 12/82** (OJ 1983, 221) the board found that the unequivocal terms of Art. 94 EPC did not permit any wide interpretation - in fact the article required that the request be written, filed within a certain period and accompanied by payment of the fee within the same period. In addition it should be noted that the authors of the EPC, ie the contracting states, gave the

request filed within the time limit extensive effects: it could not be withdrawn (Art. 94(2) EPC, last sentence), yet on the other hand, if it was filed late the patent application was automatically deemed to be withdrawn (Art. 94(3) EPC). The board held that the mere payment of the examination fee within the time limits provided for in Art. 94(2) EPC and R. 85b EPC could not be a substitute for filing the request itself in good time. Now the EPO Form 1001.1 for request for grant contains the written request for examination.

In **J 4/86** (OJ 1988, 119) the board held that failure to file a request for examination for a European patent application would result in the application's being deemed to be withdrawn upon expiry of the period referred to in Art. 94(2) EPC and not subsequently upon expiry of the period of grace provided by R. 85b EPC. In such a case, therefore, a renewal fee which did not become due until after expiry of the first-mentioned time limit had to be refunded.

In **J 25/92** the board found that in so far as the applicant for a European patent application had to use the EPO forms, he only had to ensure that the examination fee was paid in time, as the first condition - that the request be written and filed within a certain period - was fulfilled. That meant that the payment of the fee in due time really constituted the request.

2. Stage prior to substantive examination

2.1 Communication under Article 96(1) EPC and Rule 51(1) EPC

Under Art. 96(1) EPC if the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the EPO will invite him after the transmission of the report to indicate, within a period to be determined, whether he **desires to proceed further** with the European patent application. Additionally, R. 51(1) EPC provides that, in the invitation pursuant to Art. 96(1) EPC, the EPO will invite the applicant, if he wishes, to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

In **J 8/83** (OJ 1985, 102) and **J 9/83** the board found that if a supplementary European Search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitations provided for in Art. 96(1) EPC and R. 51(1) EPC. Since in the case of such an international application, responsibility for examination of the application does not pass to the examining division until the applicant has indicated under Art. 96(1) EPC that he desires to proceed further with his application, the applicant may obtain a refund of the examination fee if in response to the invitation under Art. 96(1) EPC he withdraws his application, or allows it to be deemed to be withdrawn.

The board noted that the provisions of Art. 96(1) EPC and R. 51(1) EPC clearly operate in the respective interests of applicants, third parties and the EPO by encouraging applicants to review their applications critically and realistically in the light of the European search report, before substantive examination begins. The opportunity given by the Office to obtain a refund of the substantial fee for examination by withdrawing the application at that stage, or allowing it to be deemed to be withdrawn, provides an additional incentive to withdraw cases which are unlikely to succeed.

2.2 Amendments after receipt of the European search report (Rule 86(2) EPC)

Before receiving the European search report the applicant may not amend the description, claims or drawings of a European patent application except where otherwise provided (R. 86(1) EPC).

In **J 10/84** (OJ 1985, 71) the board noted that the general purpose of R. 86(2) EPC was to permit the applicant for a European patent to make voluntary amendments in order to take the results of the European search report into account.

Following receipt of the European search report and before receipt of the first communication from the examining division, the applicant may, of his own volition, amend the description, claims and drawings (R. 86(2) EPC). Moreover, since he has the right under R. 51(1) EPC to comment on the European search report at that stage, he can expect to receive the examining division's response to his comments in the first communication, which can be to his advantage because of his right to submit amendments with his reply to that communication (R. 86(3) EPC) (see **J 8/83** (OJ 1985, 102) and **J 9/83**).

In **J 6/96** the Legal Board of Appeal noted that, for a non-PCT applicant seeking a European patent, amendments before the receipt of the search report were prohibited by R. 86(1) EPC whereas the applicant who had filed a PCT application was permitted to make amendments even after the 21 or 31-month period provided for in R. 104b(1) EPC (now R. 107 EPC). However, according to Art. 157(1) EPC, the international search report under Art. 18 PCT took the place of the European search report. Therefore - beyond the possibility of filing amendments with the International Bureau after receipt of the international search report (Art. 19 PCT and R. 46 PCT) - a PCT applicant seeking a European patent could present amended patent claims to the EPO as soon as it had received the international search report. Thus, the possibility for a PCT applicant to amend claims before each designated office (Art. 28 PCT) was only the consequence of the fact that it is in another procedural phase. It appears from the above that in fact the PCT applicant has more time to amend claims than a non-PCT applicant.

2.3 Failure to reply to the communication pursuant to Article 96(1) EPC (Article 96(3) EPC)

According to Art. 16 EPC, the Receiving Section ceases to be responsible for a European patent application when a request for examination has been made or the applicant has indicated under Art. 96(1) EPC that he desires to proceed further with his application. If the applicant does not wish to proceed further, he may simply refrain from answering the invitation within the time limit, so that the application is deemed to be withdrawn pursuant to Art. 96(3) EPC.

In **J 33/86** (OJ 1988, 84) the board found that if the applicant files the request for examination and pays the examination fee before the European search report is transmitted to him, and fails to state within the period specified under Art. 96(1) EPC whether he desires to proceed further with his application, then under Art. 96(3) EPC the application is deemed to be withdrawn. Until that time the Receiving Section remains responsible for the examination of

the application (see Art. 16 EPC).

Art. 16 EPC was revised in 2000, the revised version being provisionally applicable under Art. 6 of the Revision Act.

3. Substantive examination of the application

3.1 First and further communications pursuant to Article 96(2) EPC and Rule 51(2) EPC

The purpose of the examination is to ensure that the application and the invention to which it relates, meet the requirements set out in the relevant articles of the Convention and Rules of the Implementing Regulations.

Art. 96(2) EPC states that if the examination of a European patent application reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the examining division shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period to be fixed by the examining division.

According to the established case law of the boards of appeal, it is left to the examining division's discretion to decide whether to issue a **further invitation**. The words "as often as necessary" indicate that the examining division may use its discretion to act according to the circumstances. Under Art. 113(1) EPC, however, it is not necessary to give the applicant repeated opportunities to comment on the examining division's submissions if the main objections to the grant of a European patent remain the same. A further invitation to present comments following a substantiated communication in which deficiencies were recorded is only appropriate if it would appear likely that, in the light of the applicant's reply, the examination proceedings would terminate in the granting of a patent (see **T 84/82**, OJ 1983, 451, **T 161/82** (OJ 1984, 551), **T 162/82** (OJ 1987, 533), **T 243/89**, **T 300/89** (OJ 1991, 480), **T 793/92** and **T 516/93**).

In **T 640/91** (OJ 1994, 918) the board stated that the requirement in Art. 96(2) EPC that the examining division must invite the applicant to file his observations "as often as necessary" implicitly recognised that in certain circumstances the examining division would be legally **obliged** to invite further observations from the applicant before issuing a decision. Having regard to Art. 113(1) EPC, there was a "necessary" legal obligation for an examining division to invite further observations from an applicant before issuing a decision adversely affecting him, where the division might be inclined to issue an immediate decision on the ground that he had shown lack of good faith in his previous observations. The board pointed out, moreover, that it was in principle not the function of an examining division to assess either the degree of collaboration from applicants or their good faith when deciding whether or not to invite further observations in the exercise of its discretion under Art. 96(2) EPC. The exercise of this discretion depended primarily upon whether or not there was a reasonable prospect that such an invitation could lead to the grant of a patent (see also **T 855/90**, in which the board found that the examining division had exercised its discretion unreasonably).

In **T 802/97** the board noted that when applying Art. 96(2) EPC to determine in a specific case

whether an applicant should be given a further opportunity to present comments or amendments before refusing an application after a single official communication, the established practice of the examining divisions as set out in particular in the Guidelines for Examination in the EPO is to **warn** the applicant who had made a **bona fide attempt** to deal with the examining division's objections, eg by a telephone conversation or by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a specified time limit. Only when the applicant has not made any real effort to deal with the objections raised in the first communication, should the examining division consider immediate refusal of the application, this however being an exceptional case (see Guidelines C-VI, 4.3).

In the circumstances of the present case, the only definite objections raised by the examining division's communication concerned Art. 84 EPC (clarity), whereas it was stated that a complete examination of the claims as regards the requirements of Art. 52(1) EPC (patentability) was not considered economic at that time and was postponed pending amendment to meet these and other objections. The further objections raised following this remark and concerning Art. 52(1) EPC were explicitly declared as "a provisional opinion" only. The board observed that by these statements the examining division had created the impression that it was sufficient for the applicant to deal in his answer with the objections raised under Art. 84 EPC since the final examination as to patentability was postponed pending the removal of the Art. 84 EPC objections.

In the board's judgment, the appellant's reply constituted a bona fide attempt to deal with the examining division's objections. Accordingly, the immediate refusal of the application without any prior warning to the appellant constituted a substantial procedural violation within the meaning of R. 67 EPC in view of Art. 96(2) EPC.

In **T 89/93** the board again held that the examining division could not refuse an application after a first communication if the applicant had made a **serious attempt** to overcome the objections raised or if it appeared likely that continuing the procedure would lead to a positive result. Following **T 908/91**, the board decided, however, that reimbursement of the fee for appeal would not be equitable.

In **T 79/91** the board held that the refusal of the application after only one communication was not contrary to Art. 96(2) EPC because it was unlikely that further communications would have produced a positive result.

In **T 63/93** the board stated that a patent application could be refused after the first communication if the applicant's response failed to convince the examining division, particularly where the claimed subject-matter had not been substantially modified (see also **T 66/83**, **T 304/91**).

3.2 Contents of a communication under Article 96(2) EPC (Rule 51(3) EPC)

Under the procedure set out in Art. 96(2) EPC, if the examination has revealed that the European patent application or the invention on which it is based does not meet the requirements of the EPC, the examining division's communication shall contain a reasoned

statement covering, where appropriate, **all the grounds against** granting the European patent (R. 51(3) EPC). Moreover, the examining division should invite applicants as often as necessary to file their comments.

In **T 5/81** (OJ 1982, 249) the appellant submitted that, in the only communication sent, the examiner failed to comment on claim 5, an omission which is contrary to Art. 96(2) EPC and R. 51(3) EPC. The board noted that an appeal may relate only to a decision subject to appeal within the meaning of Art. 106(1) EPC and not to preparatory measures. Art. 96(2) EPC and R. 51(3) EPC apply exclusively to that **preparatory procedure**. A failure to comply with these requirements could not be taken into consideration unless it had some influence on the decision to refuse, as in the case of a breach of Art. 113(1) EPC. The appellant's objection was unfounded not only for this reason but also because the examiner commented on the content of the claim in question by drawing attention to the possibility of formulating an independent claim based thereon. Since the appellant did not make use of that possibility, the examining division was not obliged to discuss it when refusing the application. The allusion thereto in the reasons for the decision did not form part of the ratio decidendi and was intended solely to demonstrate that the examining division was aware of the fact that the application might contain patentable subject-matter. A refusal under these circumstances was not open to challenge.

In **T 161/82** (OJ 1984, 551) the board noted that a distinction had to be made between the grounds on which a decision was based (ie the requirements of the EPC which were not satisfied by the application or the invention to which it related) and the reasoned statement explaining in greater detail why the examining division was of the opinion that such grounds existed (see R. 51(3) EPC). Art. 113(1) EPC did not require an applicant to be given repeated opportunity to comment on arguments of the examining division so long as the decisive objections to the grant of the European patent remained the same except for some supplementary observations concerning the applicant's arguments which did not convince the examining division. In **T 568/89** the board held that whether the given reason was correct or not was a matter of judgment and not of procedure.

In **T 20/83** (OJ 1983, 419) the board noted that Art. 96(2) EPC prescribes that the examining division must draw all obstacles to patentability to the applicant's attention. This conclusion related to the requirements for patentability as laid down in the EPC itself. The validity of a patent in various contracting states was however not an immediate condition under the EPC (see **T 830/91**, OJ 1994, 728).

In **T 98/88** the board pointed out that R. 51(3) EPC did not make it compulsory for communications in accordance with Art. 96(2) EPC to set out **all the grounds** against the grant of the patent. The board's view in this case was that deferral of the examination in respect of the requirements under Art. 52 EPC until a clear version of the claims had been received did not conflict with R. 51(3) EPC.

3.3 Amendments after receipt of the first communication (Rule 86(3) EPC)

After receipt of the first communication from the examining division the applicant may, of his own volition, **again** amend the description, claims and drawings once in reply to the

communication. No further amendment may be made without the consent of the examining division (R. 86(3) EPC).

In **T 229/93** the board found that in the circumstances of the case at issue the examining division should have considered refusing to consent to the amendments pursuant to R. 86(3) EPC, since the filing of such amendments after the expiry of the time limit for answering the first communication of the examining division in the form of a completely retyped description was contrary to the requirement of procedural economy (see **T 113/92**).

In **T 300/89** (OJ 1991, 480) the board pointed out that even if it were possible for the examiner to envisage amendments which might lead to the grant of a patent, the burden lay with the applicant to propose amendments if he so wished (including various alternatives in the form of auxiliary requests). These amendments could be proposed in the applicant's observations in reply to the first communication (Art. 96(2) EPC) from the examining division, where any objections were raised (**T 599/92**). It also held that an applicant had a right to request oral proceedings at any time, but if he wished to avoid the risk of an adverse decision being issued without oral proceedings being appointed, he should request oral proceedings at the latest in his observations in reply to such (here first) communication under Art. 96(2) EPC.

3.4 Admissibility of amendments after reply to the first communication

Under R. 86(3) EPC, last sentence, after receipt of the reply to the first communication from the examining division, amendments to a European patent application cannot be made without the consent of the examining division. It is therefore a matter of **discretion** for the latter.

According to the consistent case law of the EPO boards of appeal, an examining division when exercising such discretion must consider **all relevant factors** of the specific case and balance in particular the applicant's interest in obtaining an adequate protection for his invention and the EPO's interest in bringing the examination to a close in an effective and speedy way. Furthermore, once an examining division has exercised such discretion, a board of appeal should only overrule it if it comes to the conclusion either that the examining division did not exercise its discretion in accordance with the right principles or that it exercised its discretion in an unreasonable way and had thus exceeded the proper limit of its discretion; see in particular, **G 7/93**, OJ 1994, 775, points 2.5 and 2.6 of the Reasons; **T 182/88**, OJ 1990, 287, points 3 and 4 of the Reasons and **T 237/96**.

In **T 43/83** the board noted that according to R. 86(2) and (3) EPC an applicant was entitled to amend his application twice of his own volition. In the case at issue the applicant had not availed himself of these two opportunities. According to R. 86 (3) EPC he needed the consent of the examining division for further amendments, so that the examining division was fully entitled to decide on the application after the first communication and to refuse the application exclusively on grounds which had already been mentioned in their first communication, satisfying thus Art. 113(1) EPC as well.

In **T 951/97** the board noted that whether or not consent was given was at the discretion of

the examining division and depended on the facts of the individual case, on the nature of the grounds for seeking an amendment, and equally on the stage of the procedure. It was easier to secure an amendment at an earlier rather than at a later stage (see **T 529/94**, **T 76/89**).

In **T 1105/96** (OJ 1998, 249) the board noted that the admissibility of any main or auxiliary request which was filed after the reply to the first communication from the examining division was a matter within the discretion of the examining division (R. 86(3) EPC). Such discretion must be exercised lawfully having regard to the relevant circumstances. In a case such as this, where an examining division had indicated that a further request in the form of an amended text for the main claim of an application would be allowable, it was difficult to imagine any circumstances in which it would be lawful for the examining division to deny the admissibility of such request, in the exercise of such discretion. Certainly, in the circumstances of the case at issue, the rejection in advance of such a further auxiliary request unless all preceding requests were abandoned was an abuse of procedure, an unlawful exercise of discretion under R. 86(3) EPC and thus a substantial procedural violation within the meaning of R. 67 EPC.

In **T 166/86** (OJ 1987, 372) the board held that under R. 86(3) EPC, further amendments - which included the submission of a separate set of claims for a given contracting state - could only be made with the consent of the examining division (see Legal Advice No. 4/80, OJ 1980, p. 48). The examining division had to take the decision on whether to consent to the requested amendment after due assessment of the particular circumstances. In particular, this involved balancing the Office's interest in speedy completion of the proceedings against the applicant's interest in obtaining a patent which was legally valid in all the contracting states. The examining division would not be able to refuse its consent to an amendment if, for good reasons, the applicant was only at that late stage in a position to request the amendment, or if the requested amendment was obviously essential for him and to take it into account would not appreciably delay the grant procedure. In the board's view, the latter situation was the case here.

In **T 182/88** (OJ 1990, 287) and **T 166/86** (OJ 1987, 372), the board decided that a separate set of claims submitted at a late stage in the proceedings was admissible under the particular circumstances. It added that the EPO's user-friendly reputation should clearly be excluded from consideration during the exercise of any discretion by the EPO. The showing of consideration towards parties before the EPO should not be confused with the proper exercise of discretion according to the law. It was also held that when a decision hinged on the exercise of discretion, the **reasons should be given**.

In **T 872/90** the board held that neither the remark "that the applicant has already once amended the claim" nor a reference to R. 86(3) EPC could be considered to represent a reasoning because, in the board's opinion, such statements solely constituted a reference to the power given to the examining division by the above rule.

3.5 Amendments relating to unsearched subject-matter

Amended patent claims which refer to unsearched subject-matter and which do not combine with the original claims to form a single general inventive concept must, under the new R.

86(4) EPC (which entered into force on 1 June 1995), be rejected as inadmissible.

In **T 442/95**, at the beginning of the substantive examination, the examining division had raised a lack of unity objection against the claims as filed on the basis of the finding that these related to three different groups of inventions. Later, the appellants filed amended claims based on the subject-matter of the three groups. These claims were refused by the examining division on the grounds of lack of novelty. In the appeal proceedings the appellants submitted new claims, based on subject-matter which did not appear in the claims as filed. They submitted that the description of this newly claimed subject-matter was to be found in the description. In the board's judgment, the subject-matter claimed had not been searched and did not combine with the originally claimed and searched groups of inventions to form a single general inventive concept. There was no need at this stage to investigate whether the application as filed provided support for such a claim, because under R. 86(4) EPC the claim was not admissible. The only path open to the appellants was to pursue the subject-matter of said claim in the form of a divisional application.

In **T 613/99**, the EPO as International Searching Authority considered that the invention forming the subject-matter of claims 1 and 2 of the international application related to acts excluded from patentability. On the basis of R. 39(1)(iii) PCT, it refrained from searching these two claims but established an international search report on the remaining claims. The examining division having stated in a later communication that claims 1 and 2, in view of the amendments made to them, no longer concerned subject-matter excluded from patentability, the applicants responded by filing a fresh set of claims comprising these two claims only. Subsequently, the examining division refused the European patent application, explaining that R. 86(4) EPC was applicable in this case since the amended claims related to matter which had not been the subject of an international search.

The board of appeal decided that this line of argument was not acceptable. It stated that R. 86(4) EPC referred to a particular situation, ie where subject-matter was described but not claimed in the original application and was therefore not searched; where that subject-matter failed to meet the requirement for unity of invention with the matter claimed in the application; and where, following the search report, the applicants had filed fresh claims relating only to this unsearched matter. In this situation, the patentability of these fresh claims could not be examined in the context of the original application, since this would have amounted to a derogation from the principle endorsed in **G 2/92** (OJ 1993, 591), according to which the invention to be examined had to be an invention for which a search fee had been paid.

In the case at issue, the situation was entirely different. The claimed subject-matter in the application under consideration had been claimed in the original application and had therefore been searched, even if it had not been possible to carry out a meaningful search. Moreover, the invention forming the subject of claims 1 and 2 of the application at issue was substantially the same as that which formed the subject of claims 1 and 2 of the original application. In such a situation, if the examining division rejected a finding of the search division regarding matter excluded from the search, a so-called additional European search could be carried out at the request of the examining division.

In **T 443/97** the appellant (opponent) had argued that the amended claim contravened R.

86(4) EPC.

The board stated that the amended claim did not relate to unsearched subject-matter. Moreover, it pointed out that R. 86(4) EPC related to issues concerning lack of unity of invention. It was also clear from the EPO Notice dated 1 June 1995 (OJ 1995, 409) that R. 86(4) EPC concerned examination proceedings, and particularly those cases in which no further search fees requested by the search division for non-unitary subject-matter had been paid by the applicant. The purpose of R. 86(4) EPC was to exclude any amendment which circumvented the principle according to which a search fee must always be paid for an invention presented for examination. The board noted that unity of invention was a requirement of an administrative nature and that the administrative purposes of this requirement were fulfilled when the examination procedure had been concluded, ie when the patent had been granted (see **G 1/91**, OJ 1992, 253, section 4.2). Therefore, R. 86(4) EPC was not relevant for the opposition case at issue.

3.6 Issuance of a further communication under Article 113(1) EPC

Under Art. 113(1) EPC the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

In **T 734/91** the applicant had filed a fresh set of claims to overcome all the objections mentioned in the examining division's communication. The board confirmed that the applicant should not be given repeated opportunities to comment on the same objections but pointed out that, where an applicant had made a **bona fide attempt** to overcome the objections raised by the examining division, Art. 113(1) EPC might require him to be given the opportunity to present his comments on the grounds for refusing the amended claims.

In **T 907/91** the examining division refused the application without informing the applicant of its grounds for not accepting the amended documents submitted after receipt of the first communication and after oral proceedings. The board held this action to be in breach of Art. 113(1) EPC because, prior to issuing the contested decision in written or oral proceedings, the examining division should have given its reasons for refusing to accept the amended documents. Such grounds could be of a formal nature or relate to substantive patent law, depending on the relevant provisions. However, other grounds could also be brought to bear, based on generally recognised principles of procedural law (see Art. 125 EPC), such as the applicant's attempt to delay proceedings by submitting an excessively large number of requests for amendments in clear abuse of the patent grant procedure.

In **T 951/92** (OJ 1996, 153) the board summed up the case law by stating that Art. 113(1) EPC was intended to ensure that, before a decision refusing an application for non-compliance with a requirement of the EPC was issued, the applicant had been clearly informed by the EPO of the essential legal and factual reasons on which the finding of non-compliance was based. This was so that in advance of the decision he knew both that the application might be refused and why, and also so that he might have a proper opportunity to comment upon the reasons and/or to propose amendments so as to avoid refusal of the application. Thus the term "grounds or evidence" in Art. 113(1) EPC should **not be narrowly** interpreted. In particular, in the context of the examination procedure the word "grounds" did

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not refer merely to a ground of objection to the application in the narrow sense of a requirement of the EPC which was considered not to be met. The word "grounds" should rather be interpreted as referring to the **essential reasoning**, both legal and factual, which led to refusal of the application (**T 187/95**). In other words, before a decision was issued an applicant had to be informed of the requirement which he had to meet and had to have an opportunity of meeting it. If a communication under R. 51(3) EPC and pursuant to Art. 96(2) EPC did not set out the essential legal and factual reasoning to support a finding that a requirement of the EPC had not been met, then a decision based on such a finding could not be issued without contravening Art. 113(1) EPC, unless and until a communication had been issued which did contain the essential reasoning. If a decision was issued in the absence of a communication containing essential reasoning, Art. 96(2) EPC was also contravened, since in order to avoid contravening Art. 113(1) EPC it was "necessary" to issue a further communication (see also **T 520/94**, **T 750/94** (OJ 1998, 32), **T 487/93**, **T 121/95**).

In **T 309/94** the board found that the examining division, in its last communication before its decision, had hinted to the appellants (applicants) that a positive decision, eg to grant a patent, could be expected if amended claims in the sense indicated by this first-instance department were filed. Accordingly, the appellants filed such claims. Without any further information, and deviating from the impression given to the appellants, the examining division then issued a decision refusing the application. This deprived the appellants of the opportunity to present comments or counter-arguments and thus infringed the requirements of Art. 113 EPC. The board held that this amounted to a substantial procedural violation justifying reimbursement of the appeal fee.

In **T 92/96** the board found that, after notification of a correctly reasoned communication from the examining division, the applicants had had an opportunity to comment on the objections set out therein, but had confined themselves to suggesting a **minor correction** to the claim. A correction of this kind was not such as to lead the examining division to modify its opinion, as the essential features of claim 1, which had been considered to lack an inventive step, had remained unchanged. It had therefore to be expected that the examining division would decide to refuse the application after receiving the applicants' letter, since the applicants had made no real effort to reply to the objections. In the board's view, the applicants had therefore suffered no prejudice, and the examining division was not obliged, by virtue of the provisions of the EPC or of the principle of good faith, to issue a new communication or to grant a telephone interview to discuss the problem of inventive step on which it had already given a negative ruling. Consequently, the examining division had not committed a procedural violation, particularly with regard to Art. 113(1) EPC, and under these circumstances the reimbursement of the appeal fee requested by the appellants on the basis of R. 67 EPC was not granted.

In **T 946/96** the board noted that if an examining division refused its consent to a further amendment under R. 86(3) EPC, the recognised correct procedure for the examining division to follow was clearly set out in Part C of the Guidelines, Chapter VI 4.12: "If a request for amendment is to be refused under R. 86(3) EPC, the applicant must first in compliance with Art. 113(1) EPC be sent a communication giving the reasons for refusing the amendment". Here, the first indication given to the appellant that the examining division was not prepared to consent to the introduction of the claims submitted was in the decision under appeal. This

was a substantial procedural violation by the examining division. Art. 113 EPC had to be complied with also in the case of a refusal of consent under R. 86(3) EPC, irrespective of how many previous communications had been issued.

The board went on to say that if the examining division refused consent of the latest submitted amended claims under R. 86(3) EPC this did not automatically revive previous sets of claims which the examining division had consented to consider under R. 86(3) EPC - unless the applicant had indicated that he was relying on these as an auxiliary request. The correct procedure was to notify the applicant of the grounds for intending to refuse consent to the latest set of claims and to ask him whether he wanted a decision on that basis. If the applicant then maintained his request solely on the basis of these claims, and any further arguments by the applicant did not persuade the examining division to change its mind, then a decision should be given in which the **reasons for the refusal** of consent under R. 86(3) EPC were stated, and the application would be refused under Art. 97(1) EPC and Art. 78(1)(a) EPC on the basis that it contained no claims to which the applicant had agreed.

In **T 802/97** the board held that if a decision includes several grounds, it shall meet the requirements of Art. 113(1) EPC with respect of each of the grounds. In the board's judgement, if a decision of the EPO includes several grounds supported by respective arguments and evidence, it is of fundamental importance that the decision as a whole meets the mandatory requirements of Art. 113(1) EPC. Leaving it up to the deciding body to suggest which of the grounds were to be considered as the basis of the decision and which were not - and did not therefore need to comply with the requirements of Art. 113(1) EPC - could only lead to legal uncertainty and confusion of the parties. An exception from the above principle could be obiter dicta which were not part of the grounds on which a decision is based.

In **T 275/99** the board held that the requirements of Art. 113(1) EPC are met if the appealed decision was entirely based on the grounds, facts and evidence which were already known to the appellant from the extensive international preliminary examination report (IPER) which had been drawn up for the description and the claims of the international application corresponding exactly to the European application refused and which had been incorporated by way of reference in an official communication of the examining division.

3.7 Informal communications

3.7.1 Telephone conversations

In **T 300/89** (OJ 1991, 480) the board held, in relation to the appellant's complaint as to the failure of the examiner to telephone as requested, that the practice in relation to such informal communications was clearly set out in the Guidelines. Such informal communications and the practice relating to them should be clearly distinguished from the formal examination procedure governed by Art. 96(2) EPC and R. 51 EPC. The examiner's discretion as to whether to make such an informal communication had to be exercised in accordance with the Guidelines, having regard to the particular circumstances of each individual case. An exercise of such discretion adversely to an applicant, such as in the case in question, could not by its nature be a procedural violation, however, because the procedure for such conversations was informal in the sense that it was not governed by the EPC, but was

additional to the procedure provided by the EPC. In any event, in the board's view, in the case in question no criticism could properly be made of the examiner in relation to his failing to telephone the appellant.

In **T 160/92** (OJ 1995, 35) the appellant claimed that in two telephone conversations with the primary examiner he was misled into believing that a refusal was not imminent, as a further communication would be issued as the next step of the procedure. The board noted that telephone calls between examiners of the EPO and applicants, in some situations, could be a tool for speeding up an otherwise slower procedure. However, one should be warned against expecting too much from them in critical situations, as misunderstandings could happen more easily than in writing, sometimes promoted by the fact that one of the two participants in the conversation might not be fully prepared for dealing with the case. It was with good reason that the procedure before the EPO was in principle, with the exception of oral proceedings under Art. 116 EPC, a written procedure. Moreover, in the examination (as well as in the opposition) procedure the primary examiner was only one of a division of three examiners, it being well-known that his individual statements could not be binding for the division. Furthermore, telephone conversations were not provided for in the EPC and did not, as such, form part of the formal procedure before the Office.

The board did not deny that the principle of good faith should govern all the actions relating to procedural matters, even the informal ones, of employees of the EPO towards parties to the proceedings. However, before the decision of the examining division could be set aside it would have to be manifestly clear that the rules of procedure as laid down in the EPC had been infringed. Since telephone conversations did not form part of the said formal procedure, the board did not consider it necessary to conduct a detailed investigation aimed at clearing up what was said in the above-mentioned telephone calls, the sequence of procedurally relevant facts being already clearly established in the file. The board held that the answer to the controversial question whether the applicant was misled about the possibility of imminent refusal of the application must be sought by focusing on the procedurally relevant content of the file.

3.7.2 Interviews

In principle, the refusal of a request for an interview with the examiner concerned does not contravene any of the rules of procedure contained in the EPC. If the applicant requests an interview, the request should be granted unless the examiner believes that no useful purpose would be served by such a discussion (Guidelines C-VI, 6.1a).

In **T 98/88** it was held that Art. 116 EPC gave every party the absolute right to oral proceedings, but not the right to an interview with a particular member of an examining division. It is for the examiner concerned to decide whether such an interview should take place (see also **T 235/85**, **T 19/87**, OJ 1988, 268, **T 409/87**, **T 193/93**, **T 589/93**).

In **T 409/87** the appellant had requested an interview which had been denied by the examining division without being given reasons. The board observed that although the decision under appeal did not indicate specifically why the requested interview had not been granted, it was clear from it that the examining division had considered that such an interview

would not have served any useful purpose. Under such circumstances, the examiner, according to the Guidelines Part C-VI, 6.1, did not need to grant the interview requested. An interview, in contrast to oral proceedings, not being a procedural step provided by the EPC, the refusal to grant a request for an interview was not a decision open to appeal and, therefore, did not fall under the provision of R. 68(2) EPC, first half-sentence.

In **T 182/90** (OJ 1994, 641) the appellant did not request oral proceedings before the examining division but instead asked only for an interview. The board held that no contravention of Art. 116(1) EPC as alleged by the appellant could be recognised.

In **T 872/90** the board held that in accordance with established jurisprudence (see **T 19/87** OJ 1988, 268), if any reasonable doubt existed in the minds of the examining division as to the true nature of a potentially ambiguous request made to it by the applicant it was clearly desirable, as a matter of practice, that the examining division should seek clarification from the party concerned, in particular because the right to an oral hearing provided by Art. 116 EPC was an extremely important procedural right which the EPO should take all reasonable steps to safeguard. Violation of this right had, therefore, in principle, to be considered as a substantial procedural violation within the meaning of R. 67 EPC unless the circumstances and reasons for the refusal to grant that right could be considered as a mere error of judgment. Having regard to the somewhat **ambiguous nature of the request** for an opportunity "to be heard", which in the first place gave rise to the interpretation to represent a request for an informal interview, the allowance or refusal of which was entirely a matter of discretion, the board found that such an error of judgment had in fact occurred and there was no procedural violation in this respect (see **T 19/87**, **T 283/88**, **T 668/89** and **T 589/93**).

In **T 366/92** the statement that the applicant "would welcome the opportunity to discuss the case with the Examiner at an informal interview ..." did not constitute a request for oral proceedings under Art. 116 EPC.

In **T 299/86** (OJ 1988, 88) the board held that the right of a party to request oral proceedings under Art. 116 EPC was in no way affected by the fact that such party could have also requested and/or attended an interview with the examiner.

In **T 808/94** the board stated that informal interviews (also called "personal consultation") and/or informal consultations by telephone which were carried out by the primary examiner alone could not replace duly requested oral proceedings under Art. 116 EPC, which were to take place before all members of the examining division (Art. 18(2) EPC).

Board of appeal decisions concerning oral proceedings in examination proceedings are dealt with on p. 271.

3.8 Failure to reply to the communication pursuant to Article 96(2) EPC (Article 96(3) EPC)

If an applicant fails to reply to a communication pursuant to Art. 96(2) EPC and R. 51(2) EPC inviting him to file his observations on the disclosed deficiencies, Art. 96(3) EPC prescribes that the application will be deemed withdrawn. The phrase "fails to reply in due time to any

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invitation under ... paragraph 2" in Art. 96(3) EPC is 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 (**T 685/98**, OJ 1999, 346).

In **J 37/89** (OJ 1993, 201) the Legal Board of Appeal construed Art. 96(3) EPC to mean that an applicant who merely requested an extension of the period for filing a reply, which request was then refused, "fails to reply" within the meaning of Art. 96(3) EPC, with the consequence that the application had to be deemed withdrawn.

In **T 160/92** (OJ 1995, 35) the board held that Art. 96(3) EPC did not require "a complete reply", but only "a reply" in order to avoid the consequence of having the application deemed to be withdrawn. A letter of reply to a communication of the examining division filed in due time by the applicant and dealing with substantial points of this communication constituted a reply within the meaning of Art. 96(3) EPC and thus, from the point of view of procedural law, ruled out the possibility of deemed withdrawal.

In **J 29/94** (OJ 1998, 147) the board observed - in relation to Art. 110(3) EPC - that there was another form of reply which could result in a refusal, and not in the deemed withdrawal of the application: if the applicant did not want to reply in substance to the communication, it was permissible for him to ask for a decision on the file as it stood.

In **T 685/98** (OJ 1999, 346) the board noted that prior to a valid refusal under Art. 97(1) EPC the applicant must either have exercised his right to comment or have waived this right. It held that a simple procedural request made by the applicant after receipt of the R. 51(2) EPC communication could not be treated as a waiver of the right to present comments during the remainder of the four-month term set for reply. When the applicant neither replied in substance to the objections raised nor waived his right to present comments, then the refusal of the application was ultra vires and voidable ab initio because under Art. 97(1) EPC the application was to be refused, if no different sanction was provided for by the EPC. However, Art. 96(3) EPC provides a different sanction for failure to reply, namely the deemed withdrawal of the application.

In unclear cases there can be no presumption that an applicant has waived his right to be heard under Art. 113(1) EPC. As was emphasized by the Enlarged Board of Appeal in decision **G 1/88**, surrender of a right cannot be simply presumed (A jure nemo recedere praesumitur). Hence a refusal decision pursuant to Art. 97(1) EPC based on such a presumption and taken before expiry of the term originally set for reply to a communication contravenes Art. 113(1) EPC and thus involves a substantial procedural violation. The board made it clear that where an applicant's letter of reply to a first R. 51(2) EPC communication contains only a procedural request devoid of any substantive implications, the examining division has no power to refuse the application under Art. 97(1) EPC.

3.9 Refusal of a European patent application under Article 97(1) EPC

3.9.1 General issues

Under Art. 97(1) EPC the examining division will refuse a European patent application if it is of the opinion that such application or the invention to which it relates does not meet the requirements of the EPC, except where a different sanction is provided for by the Convention.

A European patent application which fails to meet one of the requirements of the EPC has to be **refused in its entirety**, without its being necessary to consider whether the application as a whole, eg a dependent claim, might contain material indicative of an inventive step (**T 5/81**, OJ 1982, 249, **T 293/86**, **T 398/86** and **T 98/88**). In **T 162/88** it was stated that if the European patent application in the version submitted or approved by the applicant contained a claim which the examining division considered unallowable, the examining division had to refuse the European patent application in its entirety under Art. 97 EPC and not just the claim concerned (see also **T 117/88**, **T 253/89** and **T 228/89**).

In **T 11/82** (OJ 1983, 479) the board held that a European patent application had to satisfy the conditions laid down in the Implementing Regulations (see Art. 78(3) EPC). If, in the opinion of the examining division, the application did not do so, the examining division was obliged by Art. 97(1) EPC to refuse it.

In several decisions the boards pointed out that it was highly desirable that the examining division should give an appealable decision with **sufficient reasoning** on all the issues that had been properly raised by the EPO during the examination proceedings and dealt with substantively in the applicant's reply. Such "complete" decisions streamlined the procedure rendering remittal to the department of first instance unnecessary: the board could decide all issues already raised in the department of first instance without depriving the appellant of the opportunity to have them considered at two instances (see **T 153/89**, **T 33/93** and **T 311/94**).

In **T 839/95** the examining division did not take a final decision as provided for in Art. 97 EPC. Instead, it issued a decision indicated as an interlocutory decision under Art. 106(3) EPC rejecting the main and two auxiliary requests and stating that the invention claimed according to the third auxiliary request was found to meet the requirements of the Convention.

The board noted that an interlocutory decision in the case of an allowable auxiliary request is foreseen in the instructions to examiners only for auxiliary requests in opposition proceedings (Guidelines for Examination in the EPO, D-VI, 7.2.2). It did not consider it appropriate for the department of the first instance to proceed in the same way in grant proceedings. In the board's judgment, the purpose of the interlocutory decision in opposition proceedings is intended to save the proprietor the further cost of fulfilling the formal requirements under R. 58(5) EPC before there is a final decision on the version in which the patent can be maintained (**T 89/90**, OJ 1992, 456). A corresponding situation does not exist in grant proceedings because there is no adverse party who may object to the version to which the applicant has agreed. The appeal was admissible, since the appellant was adversely affected by the rejection of his preceding requests.

3.9.2 Double patenting and refusal under Art. 97(1) EPC

In **T 587/98** (OJ 2000, 497) the examining division refused a European patent application filed as a divisional application. The reason given for the refusal was that the subject-matter of the divisional application and that of the parent application overlapped. The claims were allowable under Art. 125 EPC (Guidelines C-IV, 6.4) because it was a general procedural principle that two patents should not be granted to the same applicant for the same invention.

The board observed that the procedure governing the filing of divisional applications defined in the EPC was self-contained and complete. Hence, quite apart from the consideration that the decision under appeal concerned a matter of substantive law rather than a matter of procedure and Art. 125 EPC was not applicable to substantive law, the condition precedent for the application of Art. 125 EPC - "the absence of procedural provisions in this Convention" - was not fulfilled.

The board found that the claims in the case at issue were not "conflicting" claims within the meaning of the Guidelines. Therefore the question whether any legal basis could be found in the law and practice of the Contracting States for the prohibition of "conflicting" claims expressed in the Guidelines did not fall to be decided in this appeal. The kind of "overlap" in the case at issue was not prohibited under the EPC in the situations outlined and it was not apparent to the board why it should be prohibited between divisional and parent applications. It was, however, necessary for the board to decide whether there was a legal basis for refusal on the facts of the present case, ie whether there was a requirement of the EPC that was not met (cf Art. 97(1) EPC).

The board held that no express or implicit provision in the EPC existed that prohibits the presence in a divisional application of an independent claim - explicitly or as a notional claim arrived at by partitioning of an actual claim into notional claims reciting explicit alternatives - which is related to an independent claim in the parent application so that the 'parent' claim includes all the features of the 'divisional' claim combined with an additional feature.

3.10 Amendments filed before the boards of appeal

In **T 63/86** (OJ 1988, 224) the board noted that the wording of the whole of R. 86(3) EPC pointed specifically to the examining division. In cases of minor amendments filed during the appeal, it might be appropriate for a board of appeal to exercise the discretion of the examining division under R. 86(3) EPC. However, where substantial amendments had been proposed which required a substantial further examination in relation to both the formal and substantive requirements of the EPC, such further examination should be carried out, if at all, by the examining division as the first instance, only after the examining division had itself exercised its discretion under R. 86(3) EPC (**T 47/90** (OJ 1991,486), **T 1/92** (OJ 1993, 685), **T 296/86**, **T 341/86**, **T 347/86**, **T 501/88**, **T 531/88**, **T 317/89** and **T 184/91**).

In **T 1051/96** the appellants re-introduced on appeal matter which, having been objected to under Art. 82 EPC by the examining division, had not been further prosecuted by them. The board held that the applicant could not be allowed, on appeal from a decision refusing the restricted claim on some other ground, such as lack of inventive step, to put forward a request

which reverted to the broader claim and thus re-introduced matter open to the objection of lack of unity. It decided that the admission of this request into the proceedings should be refused in the exercise of the board's discretion under R. 86(3) EPC (see **T 63/86**, OJ 1988, 224). The board noted that this was because, as was clear from the EPC, in particular Art. 96 EPC, and had been stated in point 4 of Enlarged Board of Appeal decision **G 10/93** (OJ 1995, 172), it was the task of the examining division, and not that of the board of appeal, to carry out a full examination as to patentability requirements. Proceedings before the boards of appeal in ex-parte cases were primarily concerned with examining the contested decision.

4. Examination proceedings after issue of the Rule 51(4) EPC communication

4.1 Introduction

4.1.1 The 1987 amendments to Rule 51 EPC

Under R. 51 EPC, in its version prior to 1 September 1987, express approval of the text in which the examining division intended to grant a patent was not foreseen. Decision **J 22/86** (OJ 1987, 280) led to amendments being made to R. 51 EPC.

The travaux préparatoires to the 1987 amendments explain that a need existed to separate the substantial issue of the text for grant from that of other formalities to be carried out in order for the application to proceed to grant, ie the filing of translations and payment of fees. In the past, in order to protect applicants against loss of rights as a result of the fairly complicated procedure, a practice making use of restitutio in integrum under Art. 122 EPC had evolved, which, however, was called to a halt by decision **J 22/86** (OJ 1987, 280). The proposed separation of procedures was intended to safeguard the interests of the applicants (OJ 1987, 272). The amendments to R. 51 EPC were described as serving the purpose of enabling loss of rights to be remedied through further processing rather than through the time-consuming and burdensome procedure under Art. 122 EPC of restitutio in integrum (**T 830/91**, OJ 1994, 728).

4.1.2 Rule 51 EPC

Under R. 51(4) EPC, before the examining division decides to grant the European patent, it will inform the applicant of the text in which it intends to grant it and will request him to indicate, within a period to be set by it, his approval of the text notified.

R. 51 serves to terminate the examination stage and to process the application to grant. The applicant is requested through the R. 51(4) EPC communication to submit express approval of the text intended for grant. A time limit of four months, extendable to six months, is provided. When it has been received, approval is acknowledged through a R. 51(6) EPC communication. Should the applicant request amendments within the R. 51(4) EPC period, the examining division may allow them under R. 86(3) EPC, but if it does not, the division must issue a reasoned opinion, requesting the applicant to submit his observations (R. 51(5) EPC). If the amendments are accepted, there will as a rule be no further R. 51(4) EPC communication and the R. 51(6) EPC communication will be issued without delay. Should the applicant choose not to submit any approval in writing under R. 51(4) EPC, the application

will be refused by way of a decision which is appealable (T 830/91, OJ 1994, 728).

4.2 Approval of the text by the applicant

Before the examining division decides to grant a European patent, it informs the applicant, in accordance with R. 51(4) EPC, of the text in which it intends to grant it and requests him to indicate his approval of the text notified. If no such approval is communicated within the relevant period, the application is refused in accordance with R. 51(5) EPC.

In T 1/92 (OJ 1993, 685), the board held that neither the Convention, nor the Implementing Regulations, expressly prescribed any **binding effect** of the approval under R. 51(4) EPC in its new version (see T 830/91, OJ 1994, 728). The travaux préparatoires to the 1987 amendment of R. 51 EPC, in effect from 1.9.1987, CA/26/87 - XXVI, made no mention either of such a preclusive effect of the approval. The main object was to separate the procedure for approval from the subsequent formal requirements (fees for grant, etc.) in order to safeguard the rights of applicants, depending on their reaction to the text proposed for grant. This was a result of decision J 22/86 (OJ 1987, 280) invalidating the former practice of interlocutory revision on appeal. The 1987 amendments did not change the basic procedural principle that the latest request filed within a stipulated time limit, whereby earlier requests were withdrawn, was the one validly expressing the position of the party in question. It followed from the above that an approval filed in response to a R. 51(4) EPC communication was not absolutely binding and that a decision to grant could thus not be issued if, at the end of the time limit given in the communication, it could not be established that the applicant still agreed unambiguously to the text intended for grant.

The board further noted that nowhere in the Guidelines was it stated that approval precluded a **subsequent request for amendment** filed on time. Neither the Convention nor its Implementing Regulations imposed such an effect. The board stated that the Guidelines, Part C-VI, 4.10, seemed to need a qualifying amendment to ensure that all requests filed within the time limit under a R. 51(4) EPC communication were duly taken into account by the examining division before proceeding under R. 51(6) EPC. Preparatory measures for grant of the patent could not be undertaken before lapse of the time limit for replying to the R. 51(4) EPC communication (ie four or six months as the case might be). Only after having made sure at the end of this period that the approval had been irrevocably given, as required by R. 51(6) EPC, was the examining division free to proceed to grant.

In J 12/83 (OJ 1985, 6) the board held that an applicant for a European patent could be "adversely affected", within the meaning of Art. 107 EPC, by a decision to grant the patent if the patent were granted with a text not approved by the applicant, contrary to Art. 97(2)(a) EPC. Approval, for the purposes of that article, had to be established "in accordance with the provisions of the Implementing Regulations" (in the case in question: R. 51(4) EPC).

In J 13/94 the board observed that any approval of the text, in accordance with R. 51(4) EPC, might thus have serious procedural consequences for applicants. Hence, according to the jurisprudence of the Legal Board of Appeal, declarations by applicants should only be treated as valid approval under R. 51(4) EPC if they were clear and unambiguous which, in particular, implied that:

- the approval was not subject to any condition (**J 27/94**, OJ 1995, 831);
- it was clear to which text the applicant had given his approval (**J 29/95**, OJ 1996, 489).

In **J 27/94** (OJ 1995, 831) the board held that in the interests of legal certainty a procedural declaration had to be unambiguous (confirmation of **J 11/94**, OJ 1995, 596). This implied that it must not be subject to any condition, leaving it open whether the EPO could proceed further on the basis thereof. It found that the examining division should not have treated the letter in question as valid approval under R. 51(4) EPC, because it contained a condition which made the approval invalid. The approval of the text intended for grant was a necessary requirement for the next step in the proceedings, ie the communication under R. 51(6) EPC. It had to be clear for the EPO when receiving the declaration whether or not it was an appropriate basis for the despatch of this communication. In the interests of legal certainty the board stated that procedural declarations had to be unambiguous. The examining division should have objected to the invalid approval, with the eventual consequence foreseen in R. 51(5) EPC, first sentence.

4.3 Article 113(2) EPC

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

This article obliges the Office not to issue patents to which the applicant or patentee has not agreed. This provision is based on the fundamental right of parties to civil law proceedings to decide the scope of their case, and the procedural principle that the parties may at any time file a request, indicating their intention to change this scope, as long as their case is still pending. Additionally, in accordance with Art. 164(2) EPC, the provision of Art. 113(2) EPC must prevail over any practical arrangements provided for in the Implementing Regulations (see also the EPO practice in cases of late-filed amendments, eg **T 375/90**) (**T 830/91**, OJ 1994, 728).

In **T 32/82** (OJ 1984, 354) the board held that in accordance with Art. 113(2) EPC, it could only decide on the European patent application in the text submitted to it or agreed by the applicant. It followed that when deciding the appeal the board had no authority under the EPC to order the grant of a European patent containing claims which were different from those submitted by the applicant in their content or interdependency. Even if the board had indicated to an applicant that a dependent claim might be allowable if rewritten as an independent claim but the applicant had not expressly requested the board to consider it as such, the board was not obliged to do so.

In **T 872/90** the board held, in view of the requirement of Art. 113(2) EPC according to which the EPO will consider and decide on the European application only in the text submitted to it, or agreed, by the appellant, that former claims which had been replaced by newly filed claims could no longer be considered to constitute a text agreed to by the applicant.

In **T 647/93** (OJ 1995, 132) the board found that the provision of Art. 113(2) EPC was a

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fundamental procedural principle, being part of the right to be heard, and was of such prime importance that any infringement of it, even as a 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 question, 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 (see **T 121/95**).

In **T 237/96** the board noted that in circumstances in which, as in the case in question, amendments proposed by the applicant were not allowed by the examining division by virtue of R. 86(3) EPC 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.

4.4 Amendments filed within the period under Rule 51(4) EPC

If the applicant fails to communicate his approval within the period according to paragraph 4, the European patent application will be refused. If within this period the applicant proposes amendments to the claims, description or drawings to which the examining division does not consent under R. 86(3) EPC, the examining division will, before taking a decision, request the applicant to submit his observations within a period it will specify and will state its reasons for so doing (R. 51(5) EPC) (see **T 830/91**, OJ 1994, 728).

In **T 375/90** the board noted the conditions defined by the boards of appeal limiting the extent of the discretion which may be exercised when applying R. 86(3) EPC, where amendments were proposed by the applicant after issue of the R. 51(4) EPC communication:

(a) There is no discretion in the obligation to admit amendments which remove deficiencies constituting violations of the EPC (see **T 171/85** (OJ 1987, 160), **T 609/88**).

(b) In all other cases the Office's interest in a speedy completion of the proceedings must be balanced against the applicant's interest in the grant of a patent with amended claims (see **T 166/86** (OJ 1987, 372), **T 182/88** (OJ 1990, 287) and **T 76/89**).

The board noted that the Guidelines, Part C-VI, 4.8 and 4.9, stated that "the communication under R. 51(4) EPC does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure and only minor amendments will be considered within the period under R. 51(4) EPC". Moreover, the applicant had to "give good reasons for proposing the changes only at this stage of the proceedings". These rules of the Guidelines also reflected the call for the balance of interests applicable when judging cases falling under category (b) mentioned above. It followed from the foregoing considerations that the examining division (or the board acting within its competence), when applying the provisions of R. 86(3) EPC, was **not completely free** to deny any examination of the respective amended documents.

In **T 171/85** (OJ 1987, 160) the applicants argued that the amendment requested was covered by R. 88 EPC and could therefore be made even after communication of approval

under R. 51(4) EPC. The board noted that it was true that in the generally-accepted view corrections under R. 88 EPC, second sentence, could be made at any time prior to the decision to grant (see also Guidelines (March 1985), Part C-VI, 5.9). However, the board considered that in this particular case the requirement of R. 88 EPC, second sentence, was not met. The board took the view that although correction under R. 88 EPC, second sentence, was not possible, the documents nonetheless contained an inconsistency which should properly have been removed before the communication under R. 51(4) EPC was issued. If this was not done the precondition for grant under Art. 97(2) EPC that "the application ... meet the requirements of this Convention" appeared not to be met. The board of appeal saw no reason why an inconsistency between claims or between claims and the description should not be removed, in agreement with the examining division and the applicant, even if the latter had communicated approval of the (faulty) text under R. 51(4) EPC. Nor as a rule would it seem necessary to set aside and replace the communication under R. 51(4) EPC; this need be done only if in a contracting state there might be a loss of rights under Art. 65(3) EPC unacceptable to the applicant.

In **T 1/92** (OJ 1993, 685) the board found that if, according to R. 51(6) EPC, it could not be established beyond doubt at the end of the time limit under R. 51(4) EPC that the applicant approved the text in which the examining division intended to grant the European patent, the examining division could not proceed to the grant of the patent and R. 51(5) EPC applied. The board further noted that as the appellants' requests that their approval be disregarded and that the time limit for response to the R. 51(4) EPC communication be extended were filed within the four-month period given in that communication, they were entitled, in accordance with R. 51(5) EPC to make observations upon invitation by the examining division, should it not consent to the proposed amendments. This meant that in any circumstance the appellants were entitled to a response dealing with their requests. Under R. 51(4) EPC, last sentence, they were further automatically entitled to the requested extension. R. 51(5) EPC expressly entitled the applicant to a response from the examining division to a request for amendment, if this request was filed on time. As a result, no final decision could be taken until that time limit had expired, and only then if there was unambiguous approval.

In **T 999/93** the decision to refuse the application under R. 51(5) EPC, first sentence, for lack of any approved text of the application (Art. 113(2) EPC), was incorrect since the fact that the appellant never withdrew the main and first and second auxiliary requests as well as the appellant's letter of 6.4.1993 (disapproval of the text proposed for grant, but request for a decision on the main request) clearly showed that he indeed approved and proposed the text according to his higher-ranking requests (see also R. 51(5) EPC, second sentence). The decision would instead have required a reasoning as to the substance of the main, first auxiliary and second auxiliary requests.

In **T 237/96** the board held that the broadening of the scope of claim 1 requested by the applicant after receipt of the examining division's communication under R. 51(4) EPC so as to encompass one originally disclosed embodiment was not consistent with his previous submission that said embodiment was not part of the invention, raised new issues as to clarity and inventive step and was not supported by any argumentation in favour of the allowability of the amended claim. The board found that the examining division in refusing to

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consent to the amendment under R. 86(3) EPC did not exercise its discretion in a wrong or unreasonable manner. Had it given its consent to the amended version of the claim, it would have been necessary to restart examination from the beginning, which, given the prima facie lack of clarity of the claim, would have led to a considerable delay.

In **T 1066/96** the board noted that, pursuant to R. 51(5) EPC, the examining division had the discretion not to consent under R. 86(3) EPC to amendments proposed by the applicant within the period set by the communication under R. 51(4) EPC. However, in that case, R. 51(5) EPC explicitly provided that "the examining division shall, before taking a decision, request the applicant to submit his observations within a period it shall specify and shall state its reasons for so doing". These provisions had to be seen in the light of the general rule laid down in Art. 113(1) EPC, under which "the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

In this context, it was clear that further amendments could not be excluded wholesale in advance, but the discretion under R. 86(3) EPC had to be exercised on a case-by-case basis balancing the interests of the EPO and the applicant against one another (see **G 7/93**). Therefore, in exercising its discretion under R. 86(3) EPC in a negative way, an examining division could only refuse an application if, before issuing a decision, it had informed the applicant about the fact that the further amendments requested would not be admitted and about the reasons for not admitting said amendments, thereby taking due account of the applicant's reasons for such late filing of further amendments. If the applicant maintained its request and its counterarguments were not considered convincing by the examining division, the application had to be refused under Art. 97(1) EPC, since it contained no claims to which the applicant had agreed.

4.5 Re-opening examination after approval of the text for grant

In **G 10/92** (OJ 1994, 633) the Enlarged Board stated that if examination proceedings were re-opened by the examining division after approval in accordance with R. 51(4) EPC, because - for whatever reason - the proposed text for grant was to be amended, R. 51(4) EPC required that the applicant once again be informed of the text in which the examining division intended to grant the European patent. The same was true in appeal proceedings. The approval in accordance with R. 51(4) EPC given before the department of first instance was equally binding on an appeal. If the board of appeal then concluded that the patent had to be amended prior to grant, the applicant again had to approve the amended text, approval being stated before the board if the board was ruling on the issue, or to the examining division if the matter had been remitted.

In **G 10/93** (OJ 1995, 172) the Enlarged Board held that the examining division was not bound by the view - whether positive or negative - expressed in the examination pursuant to Art. 96(2) EPC. examination proceedings could be re-opened "for whatever reason" after the approval in accordance with R. 51(4) EPC.

4.6 Approval established by the examining division (Rule 51(6) EPC, first sentence)

R. 51(6) EPC, first sentence, stipulates expressly that the examining division can establish the applicant's approval of the text intended for grant "taking account of any proposed amendment".

In **J 29/95** (OJ 1996, 489) the board stated that this meant that the examining division could proceed on the basis of the amendments and that the documents to which no amendments had been made remained unchanged. R. 51 EPC did not allow the applicant to take a stance only in respect of part of the documents communicated to him. Hence, R. 51(6) EPC, first sentence, provided a basis for the examining division to establish that the parts of the documents intended for grant, for which no amendments had been submitted, had been agreed to. Only if the applicant filed amendments to specific parts of the documents communicated to him together with a declaration that he did not approve other parts, was the examining division prevented from establishing the applicant's approval. In the latter situation, however, R. 51(5) EPC, first sentence, was applicable and the application had to be refused. This course of action was not only clear from the wording of R. 51(4) to (6) EPC, it was also in the interests of a streamlined procedure. R. 51(4) EPC provided for a final check of the documents intended for grant. It brought the substantive examination of the case to an end. This implied that there should be no opportunity for the applicant at this stage to call into question the result of the previous examination which was based on his own requests and to leave open his position on the application as a whole.

In **J 15/95** the board held that the opportunity to file amendments after approval of the text did not imply a right to have a further communication under R. 51(4) EPC. As explained in **J 29/95** (OJ 1996, 489), the filing of amendments after the communication under R. 51(4) EPC did not prevent the examining division from establishing the applicant's approval, taking account of the requested amendments under R. 51(6) EPC. In this situation, a further communication under R. 51(4) EPC was not issued. Furthermore, the examining division, in exercising its discretion pursuant to R. 86(3) EPC, could decide not to allow an amendment. This showed that the applicant was not entitled to receive a further communication under R. 51(4) EPC (see **J 14/95**).

4.7 Examination after remittal for further prosecution

In **T 79/89** (OJ 1992, 283) the board rejected the appellant's main request, and remitted the case to the department of first instance for further prosecution on the basis of the auxiliary request. In this case, Art. 111(2) EPC was applicable: the first-instance department "shall be bound by the ratio decidendi of the board of appeal, insofar as the facts are the same". The ratio decidendi of the board of appeal's previous decision was that the subject-matter of the main request was not allowable, but that the grant of a patent in accordance with the auxiliary request was subject to a consideration of its patentability by the examining division. In this case, in the board's judgment, following the issue of the board's previous decision, the examining division clearly had no power to re-open examination on the basis of the claims which the appellant requested (with subject-matter corresponding to the previously rejected main request). Having examined the subject-matter of the auxiliary request for patentability and found no objection to it, the examining division was bound to issue a communication

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under R. 51(4) EPC with text based on the auxiliary request. Furthermore, in the absence of approval of such text, in the board's judgment the examining division was bound to refuse the application, for the reasons set out in its decision. Since the examining division had no power to re-open examination in respect of the claims as requested by the appellant, in the context of the appeal in question the board necessarily had no power to re-open examination in respect of such claims, because it could only exercise power which was within the competence of the examining division (Art. 111(1) EPC). Thus, the main request of the appellant had to be refused.

4.8 Amendments after issue of the Rule 51(6) EPC communication

R. 51(6) EPC requires the Office to establish whether or not valid approval has been indicated. A communication pursuant to this paragraph only invites the applicant to pay certain fees and file the translations due (**T 830/91**, OJ 1994, 728).

The wording in R. 86(3) EPC "No further amendment may be made without the consent of the examining division" simply means that the examining division may or may not give its consent to a request for amendment by the applicant. However, since the underlying object of a R. 51(6) EPC communication is to conclude the granting procedure on the basis of the approved text, a request for amendment which is received by an examining division after such a communication has been issued should be **considered in a different way** from a similar request for amendment received at a much earlier stage in the overall examination procedure, and in particular before approval by the applicant of a notified text. Such a request should be considered in the context of the very late stage in the pre-grant procedure at which it has been made, and against the background that the examining division has already completed its substantive examination of the application, and that the applicant has already had at least one opportunity to amend the application. Against such background, allowing a requested amendment after issue of a R. 51(6) EPC communication will be the exception rather than the rule. Nevertheless, the question remained in what kind of circumstances it would be appropriate to make an exception to the normal rule.

In **G 7/93** (OJ 1994, 775), in response to a referral in **T 830/91** of 25.5.1993 (OJ 1994, 728), the Enlarged Board of Appeal looked initially at the question of the admissibility of amendments to the patent application after a R. 51(6) EPC communication. Decisions **T 1/92** (OJ 1993, 685) and **T 675/90** (OJ 1994, 58) had differed in their interpretation of this point.

The Enlarged Board of Appeal concluded that the approval of a notified text submitted by an applicant pursuant to R. 51(4) EPC was **not** rendered **binding** by virtue of a communication being issued in accordance with R. 51(6) EPC. Even following the issue of such a communication and until the issue of a decision to grant the patent, it was left to the discretion of the examining division under R. 86(3) EPC, second sentence, whether or not to allow amendment of the application.

In the Enlarged Board's view, when considering the possible circumstances when it might be appropriate for an examining division to exercise its discretion under R. 86(3) EPC to allow an amendment after issue of a R. 51(6) EPC communication, it should be borne in mind that a request for amendment at that stage might arise either as a result of a realisation by the

applicant of the need for amendment, or as a result of a point raised by the examining division, or as a result of consideration of observations made by a third party pursuant to Art. 115 EPC. In any of these circumstances, the discretion to allow amendment should be exercised according to the same principles. Of course, an objection should only be raised by an examining division at that stage of the proceedings if it was prepared to allow amendments to meet the objection. When exercising its discretion following the issue of a R. 51(6) EPC communication, an examining division had to consider **all relevant factors**. In particular it had to consider and balance the applicant's interest in obtaining a patent which would be legally valid in all of the designated states, and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. Having regard to the object of a communication under R. 51(6) EPC, which was to conclude the grant procedure on the basis of the previously approved text, allowance of a request for amendment at that late stage in the grant procedure would be the **exception** rather than the rule.

A clear example of an exceptional case when it might be appropriate to allow amendment was, in the Enlarged Board's view, where the applicant requested separate sets of claims to be substituted in respect of designated states that had made reservations under Art. 167(2) EPC. Similarly, other **minor amendments** which did not require the re-opening of substantive examination and which did not appreciably delay the issuing of a decision to grant the patent might be allowable after a R. 51(6) EPC communication had been issued.

As to the second question referred to it, of whether the EPO was obliged to consider reservations under Art. 167(2) EPC as constituting requirements of the EPC which had to be met in accordance with Art. 96(2) EPC, the Enlarged Board of Appeal held that, "Under Art. 96(2) EPC, an examining division is required to consider whether the application or the invention to which it relates meets the requirements of the EPC. When a Contracting State to the EPC makes a reservation under Art. 167(2) EPC it reserves the right to make provisions in its national law on the matters set out in Art. 167(2) EPC. Such provisions of national law are clearly not "requirements of the EPC" within the meaning of Art. 96(2) EPC".

Thus **G 7/93** supersedes on this point decisions **T 860/91** and **T 675/90**, in which it was held that the discretionary power conferred by R. 86(3) EPC to allow amendments no longer existed after a R. 51(6) EPC communication had been issued.

In **T 790/93** a request for amendment was submitted after the R. 51(6) EPC communication had been issued but before the patent was granted. The formalities officer who issued the decision granting the European patent did not take account of the request for amendment. The board held that the formalities officer had exceeded his authority, ruling that he should have forwarded the request to the examining division since a formalities officer could only take the decision to grant the European patent (R. 51(11) EPC) in clear cases. The decision to correct errors in the description, claims or drawings of the application always lay with the examining division.

In **T 1225/97** the applicants had appealed against the decision of the examining division on the ground that it had not taken account of decision **G 7/93**, in which the Enlarged Board of Appeal had ruled that even after the issue of a communication under R. 51(6) EPC an

examining division could still exercise its discretion under R. 86(3) EPC, second sentence, to allow amendment of an application.

The board could not see that the examining division had exercised its discretion inappropriately according to the criteria laid down in decision **G 7/93**. Although the appellants argued that the substantive examiner would immediately realise, in the light of the examination he had already carried out, that the amendments were admissible, this view failed to take account of the fact that the primary examiner would no longer be in a position, several months later, to remember all the details of the application. In fact, the examination of the amendments could be expected to take some considerable time. The amendments were therefore not “minor” changes of the kind which did not require the resumption of substantive examination.

4.9 Amendment after completion of the proceedings

In **T 798/95** the decision to grant the European patent was handed over by the formalities section of the examining division to the EPO postal service for notification. The request for amendment of the application under R. 86(3) EPC was filed on the same day at 6.47 pm, thus after completion of the proceedings. Referring to **G 12/91** (OJ 1994, 285), the board held that a request for amendment under R. 86(3) EPC filed after completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date.

4.10 Oral proceedings after the issue of a Rule 51(6) EPC communication

In **G 7/93** (OJ 1994, 775) the Enlarged Board of Appeal held that as a matter of legal power, following receipt of the applicant's approval of the text notified under R. 51(4) EPC and following issue of a R. 51(6) EPC communication, the examining division still had discretion as to whether or not to allow the amendment of an application up until a decision to grant a patent was issued.

In **T 556/95** (OJ 1997, 205) the request for amendments following a R. 51(6) EPC communication had been accompanied by a request for oral proceedings. The board had to decide whether the examining division was entitled to refuse the amendments under R. 86(3) EPC without first holding oral proceedings. The board held that the conditions for amendment of an application laid down in Art. 123(1) EPC in conjunction with R. 86(3) EPC remained applicable so long as the examining division retained competence over the application, ie even after issue of a communication under R. 51(6) EPC, and until the decision to refuse or grant the application was taken. The right to be heard at oral proceedings under Art. 116(1) EPC subsisted so long as proceedings were pending before the EPO, and a request for oral proceedings had to be granted before any request by a party, whether procedural or substantive, was decided against that party so as to cause them a loss of rights. Thus the examining division's discretion had to be exercised in such circumstances having regard to Art. 116(1) EPC. The Enlarged Board had no power to limit the application of Art. 116(1) EPC by means of any guidance it might lay down as to how an examining division should exercise its discretion under R. 86(3) EPC.

5. Consolidation of proceedings

In **J 17/92** the board first pointed out that Legal Advice No. 10/81, since replaced by Legal Advice No. 10/92 (OJ 1992, 662), the text of which did not differ in any material respect, was not binding on EPO bodies. Thus the possibility of consolidation that it interpreted into the EPC and the preconditions that it laid down for such consolidation were subject to review by the boards of appeal. The board held that allowing consolidation was something both permissible and desirable under the EPC, in accordance with the desire expressed in the preamble to the Convention that such protection be obtainable in the contracting states by means of a single procedure for the grant of patents. Consolidation was not only in the interest of applicants, but also in that of the public not to have to take account of two separate European patents with the same text. However, the board also found that the conditions to be imposed on consolidation should not be more restrictive than necessary. It therefore took the view that the condition that the two applications at issue as filed had to be identical was too stringent. Where, as in the case in point, an applicant was seeking to consolidate a Euro-PCT application for certain contracting states with a direct European application for other contracting states, it was not unnatural for the direct European application to be adapted to European requirements and the Euro-PCT application to contain claims adapted to the requirements of the applicant's home country. The board found that if the form of claims with which the applicant wished to proceed in the consolidated applications was acceptable either as an amended set of claims or as being identical to the set of claims as filed, consolidation should be possible. In the case at issue the differences related only to dependent claims and to the introduction of a claim in the first medical use format. In the board's view, such an amended set of claims should prima facie not prevent consolidation.

6. Divisional applications

6.1 Relationship between parent and divisional application

Under Art. 76(1) EPC a European divisional application may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application is deemed to have been filed on the date of filing of the earlier application and has the benefit of any right to priority.

R. 25(2) EPC in its old version was deleted with effect from 1.6.1991, so as to conform with EPO practice, according to which an unamended description, identical to that contained in the parent application, was normally accepted. In accordance with the reason for the proposed change given at the time - more flexibility for both EPO and applicant - it was thought preferable to leave it to the examining division to deal with amendments to the description and drawings, taking into account the relevant circumstances of the case. The Guidelines too (C-VI, 9.5) state that the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application.

In **T 441/92**, therefore, the board took the view that there was nothing in the EPC to prevent an applicant from repeating the parent description in a divisional application and that there was no contravention of Art. 76(1) EPC in this respect in the case in point. Moreover, with

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

The relationship between parent application and divisional application was one of the issues before the board of appeal in **T 118/91**. In this case the board held that neither Art. 76 EPC nor any other article of the EPC gave any support to the contention that the subject-matter of the divisional application should be considered as having been abandoned in the original application. The "content of the application as filed" referred to in Art. 100(c) EPC and Art. 123(2) EPC was the totality of information given to the skilled person by the original application and logically could not be reduced by the subsequent filing of a divisional application, whatever the content thereof. Likewise, the board could find no support for the contention that features forming part of the subject-matter of the divisional application could not be the subject of a dependent claim in the parent application. This question was dealt with in the Guidelines at C-VI, 9.6, where it was indicated that one application might generally claim its own subject-matter in combination with that of the other application. The board found no fault with this approach and did not see that it imposed an unfair burden on competitors or led to "double patenting" in its normal sense. In this particular case, the board was satisfied that any danger of "double patenting" had been eliminated by extensive restriction of the claims of the divisional application. The board added that by analogy, in the reverse situation, the lapse of a parent application could not have the effect of reducing the content of a previously filed divisional application.

7. Entry into force of a decision to grant a European patent

Under Art. 97(4) EPC, the decision to grant a European patent referred to in Art. 97(2) EPC does not take effect until the date on which the European Patent Bulletin mentions the grant. This mention is published at the earliest three months after the start of the time limit referred to in Art. 97(2)(b) EPC for the payment of the fees for grant and printing. The EPO must publish a specification containing the description, claims and any drawings at the same time as it publishes the mention of the grant (Art. 98 EPC).

In **J 7/96** (OJ 1999, 443) the board did not share the view of the department of first instance and the applicant that the proceedings for grant are concluded on the date the examining division reaches its decision to grant a European patent under Art. 97(2) EPC. The board noted that it was true that this date represents the date on which the process of reaching a decision on the application within the examining division is concluded; both the EPO and the applicant are bound by the decision as far as the text of the patent to be granted, the claims, description and drawings are concerned, and the subject-matter of the text of the patent becomes *res judicata* at that date. Thereafter, the EPO can no longer amend its decision and must disregard any fresh matter the parties may submit thereafter (see **G 12/91**). Only linguistic errors, errors of transcription and obvious mistakes may be corrected later under R. 89 EPC. The date on which the decision to grant the European patent is reached is thus clearly decisive as regards the EPO and the applicant.

It is from this date of mention under Art. 97(4) EPC that, in accordance with Art. 64(1) EPC, a European patent confers on its proprietor the same rights in respect of each contracting state in respect of which it is granted as would be conferred by a national patent granted in that state. The EPO publishes the mention of the grant of the European patent at the same time as it publishes a specification of the patent containing the description, claims and any drawings. Thus the date on which the mention of the grant of the patent is published is also the date on which the text of the patent is made available to the public (Art. 98 EPC). The mention also marks the time when the responsibility of the EPO comes to an end and the national patent systems take over the granted patent becoming a bundle of national patents. It also marks the start of the period during which a notice of opposition may be filed (Art. 99(1) EPC). Thus, the date of publication of the mention of the grant of the patent is the date on which the grant of the patent takes legal effect with respect to third parties, and on which the extent of protection conferred on the applicant is determined once and for all by means of the accompanying publication of the specification of the patent pursuant to Art. 98 EPC.

During the period between the decision to grant the patent (Art. 97(2) EPC) and the publication of the mention of the grant (Art. 97(4) EPC), the application is deemed to be **still pending** before the EPO. As the department of first instance itself admits in its decision, and as is also not disputed by the applicant, according to established EPO practice it is still possible during this **interim period** to take some limited action in respect of the application, which may, for example, be withdrawn or transferred. Applicants may even withdraw individual designations if they so wish. For its part, the EPO continues to have certain rights or obligations concerning the patent during this period; for example, the annual fees fall due and transfers of rights in the patent must be registered by the EPO.

8. Errors in the Patent Bulletin

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

In decision **J 14/87** (OJ 1988, 295) the question arose to what extent a deficiency in the publication of the mention of grant of a European patent, ie the omission of important particulars relating to the grant, might render the patent ineffective. The board held that in principle deficiencies in the publication of the mention of grant in the European Patent Bulletin did not necessarily render the decision to grant within the meaning of Art. 97(4) EPC ineffective. Nevertheless, this matter could be decided only in the light of the case in question and of the fact that the purpose of the publication was to draw the attention of interested parties to the grant of the patent, and also that any decision to file an opposition had, under normal circumstances, to be based on a careful examination of the extent of the protection conferred by the patent and not solely on the particulars given in the European Patent Bulletin. Such an examination could be carried out satisfactorily only if the patent specification was published at the same time as the mention of grant of the patent.

9. Metric or SI units

Decision **T 561/91** (OJ 1993, 736, see also **T 176/91** and **T 589/89**) led to the amendment of R. 35(12) EPC since it found that the old version of R. 35(12) EPC only required applicants

for a European patent to express weights and measures in metric units. The new wording of R. 35(12) EPC, first sentence, now makes it clear that metric units means SI units: "Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units." R. 35(12) EPC was amended by decision of the Administrative Council of 13.12.1994 and entered into force on 1.6.1995 (OJ 1995, 409).

C. Opposition procedure

1. The legal nature of opposition proceedings

1.1 Introduction

The nature of the main procedural principles for opposition proceedings has been the subject of a number of decisions by the boards and the Enlarged Board of Appeal. Opposition is a means, to which any person may have recourse, of contesting a decision and causing the legal validity of a patent to be re-examined. The filing of a notice of opposition sets a particular administrative procedure in train which follows on directly from the grant of the patent. Opposition is not a legal remedy in the classic sense, and, unlike an appeal, it therefore has **neither** suspensive effect **nor** the effect of transferring the case to a superior tribunal (**T 695/89**, OJ 1993, 152).

1.2 Independent procedure

In **T 198/88** (OJ 1991, 254) the board held that opposition was an independent procedure following the grant procedure (confirmed in **T 373/87**). It was a separate procedure in which a patent wrongly granted could be limited or revoked. Consequently, the opposition procedure was not part of the grant procedure. It was held in particular that a document taken into account in the procedure before the examining division was not automatically evidence to be considered in the opposition procedure, even if indicated as background art in the opposed patent. In **G 1/84** (OJ 1985, 299) the Enlarged Board of Appeal held that the opposition procedure was **not** designed to be **an extension** of the examination procedure (see **T 182/89** (OJ 1991, 391), **T 387/89** (OJ 1992, 583) and **T 279/88**).

1.3 Contentious proceedings

The post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment.

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board observed with regard to the general scope of opposition under the EPC that it was important that opposition took place only after grant of the European patent, ie at a point in time when the proprietor was enjoying in each designated contracting state the same rights as would be conferred by a national patent granted in that state (Art. 64 EPC and Art. 99 EPC). Thus, the relief sought by the opponent was not, as in traditional pre-grant opposition, refusal of the patent

application but revocation of the patent as granted (in its entirety or in part) with effect *ex tunc* in all designated contracting states (Art. 68 EPC). Furthermore, the grounds for opposition (Art. 100 EPC) being limited to and essentially the same as the grounds for revocation under national law (Art. 138 EPC), it appeared that the concept of post-grant opposition under the EPC differed considerably from that of classical pre-grant opposition and in fact had several important features more in common with the concept of traditional revocation procedure. It thus seemed to the Enlarged Board that post-grant opposition proceedings under the EPC were in principle to be considered as **contentious proceedings** between parties normally representing opposite interests, who should be given equally fair treatment.

In **G 9/93** (OJ 1994, 891) the Enlarged Board of Appeal overturned the case law established by the Enlarged Board's decision in **G 1/84** (OJ 1985, 299). In **G 1/84** the Enlarged Board had held that a patent proprietor could file a notice of opposition against his own patent. A new referral to the Enlarged Board of Appeal questioned whether this was still applicable in the light of the nature of the opposition proceedings as expounded in decisions **G 9/91** and **G 10/91** (see **T 788/90**, OJ 1994, 708). In reaching its decision in **G 9/93**, the Enlarged Board endorsed the concept of opposition which it had applied in those recent decisions. It concluded, having regard in particular to the nature and purpose of the opposition procedure as provided for in Part V of the EPC, that the words "any person" in Art. 99(1) EPC could only be reasonably interpreted as referring to the public at large which was being given the opportunity to challenge the validity of the patent in question. In the board's opinion, it appeared artificial to include the patent proprietor. The provisions of Part V of the EPC and the corresponding Implementing Regulations were clearly based on the assumption that the opponent was a person other than the patent proprietor and that the opposition proceedings were always *inter partes*. Thus the board held that the patent proprietor was therefore not entitled to oppose his own patent.

In **T 263/00** the board found that once an opposition was filed the procedure automatically became bilateral, no matter whether the opposition was valid, admissible or allowable. Rule 57(1) EPC expressly required the opposition division to communicate the opposition to the proprietor of the patent, and the Guidelines for Examination (D-IV, 1.5) provided that communications and decisions about whether the opposition was deemed to have been filed and was admissible were also notified to the proprietor of the patent. Thus a decision by an opposition division "to end the *ex parte* proceedings" was not foreseen in the EPC.

1.4 Principle of *ex officio* examination

The opposition procedure is a purely administrative procedure, whereas the appeal procedure must be regarded as a procedure proper to an administrative court (see also **G 7/91**, **G 8/91** (OJ 1993, 356 and 346) and **G 9/91** (OJ 1993, 408)).

Proceedings under the EPC in respect of European patent applications and patents are, with some exceptions, initiated by a party. The initial "request" determines the extent of the proceedings. This is known as the **principle of party disposition** (*ne ultra petita*) (see **G 9/92** (OJ 1994, 875), **G 4/93** (OJ 1994, 875)). In proceedings before the EPO, the principle of *ex officio* prosecution applies together with the principle of party disposition (**T 695/89** (OJ 1993, 152)).

Opposition proceedings are post-grant proceedings (Art. 99 EPC) to which Art. 99 EPC to Art. 105 EPC and the corresponding provisions of the Implementing Regulations are applicable. In such proceedings the EPO must examine the facts of its own motion (Art. 114(1) EPC). Certain restrictions have however been placed upon this so-called principle of ex officio examination in order to make such proceedings clearer, to shorten and accelerate cases, and to limit the risks to the parties.

In **G 9/91** the Enlarged Board addressed the issue of the power of an opposition division or board of appeal to decide upon the patentability of parts of a patent which had not been attacked in the notice of opposition. According to this decision, opposition proceedings are only **pending** to the extent to which the European patent is opposed in the statement pursuant to R. 55(c) EPC. Subject-matter not opposed therein is not subject to any "opposition" within the meaning of Art. 101 EPC and Art. 102 EPC, nor are there any "proceedings" within the meaning of Art. 114 EPC and Art. 115 EPC in existence concerning any unopposed subject-matter (see reasons, 10 and 11). The opposition division or board of appeal, therefore, has the power to decide on the revocation or maintenance of a patent **only** to the **extent** to which the patent is opposed in the notice of opposition.

Application of the principle of ex officio examination (Art. 114(1) EPC) to the grounds for opposition is also subject to restrictions. However, in this case the restricted application is not derived from the principle of party disposition; the proper extent of examination has to be determined by the application of other procedural principles (**G 10/91**, reasons, 12). In first instance proceedings the opposition division should examine **only** those **grounds** for opposition which the opponents have submitted within the time limit for opposition and have properly supported with facts and evidence. Grounds extending beyond this may only be considered in exceptional cases to which special conditions apply (**G 10/91**, reasons, 16).

1.5 Principle of impartiality

In **T 293/92** the opposition division, instead of limiting itself to evaluating the parties' requests, took a more active role in that it suggested in a communication the wording of a claim thought to be allowable. The board stated that apart from being undesirable from the point of view of impartiality in inter partes proceedings, such suggestions might also lead to confusion as regards the provisional and non-binding nature of communications written in proceedings before the EPO. In the case in question, the opposition division, by suggesting an allowable independent claim, had led the parties to assume that the claims on file were not allowable; the opposition division's change of mind during the oral proceedings might be seen as rather unexpected and surprising for the parties. The board found that such an undesirable course of events showed that opposition divisions in inter partes proceedings should refrain from making suggestions to the parties.

In **T 223/95** the appellant had argued that the opposition division should take steps of its own motion to establish by investigation the level of knowledge of the person skilled in the art. The board observed that such an **investigative approach** would not be consistent with the character of the post-grant opposition proceedings under the EPC, which are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment. In the board's opinion, it was unrealistic

to suppose that the seeking, gathering and selection of evidence could be conducted in an entirely impartial fashion; herein lay an essential distinction between the functions of the examining divisions and the opposition divisions. For that reason it was the responsibility of the opponent to present to the opposition division the facts, evidence and arguments in support of the grounds on which the opposition was based.

2. Right to be heard in opposition proceedings

2.1 Opportunity to make comments and the principle of equal rights

In inter partes proceedings such as opposition proceedings the right to be heard is inextricably linked to the **principle of equal rights**. Consequently, no party should be given preferential treatment in the number of times it is allowed to present its case orally or in writing. The opposition division is therefore required to ensure that the parties can exchange their submissions in full and have equal opportunity to comment on them (see **T 190/90**, **T 669/90** (OJ 1992, 739), **T 682/89**, **T 439/91**).

In **T 190/90**, the board held that the fact that a full exchange of submissions takes up more time than a partial exchange of submissions does not justify the violation of a fundamental procedural rule. If the opposition division considers a multiple exchange of submissions expedient, it must give each party equal opportunity to comment. Thus, the opposition division may invite a party to submit a **rejoinder to the reply** to the notice of opposition, but in that case it is obliged to invite the other party to respond to that rejoinder, whereafter it must decide again whether a third exchange of submissions is expedient (see also **T 669/90**). The fact that R. 57(3) EPC leaves it to the opposition division, "if it considers it expedient", to invite the opponents to reply cannot be interpreted as an authorisation to derogate from the fundamental principles of equal rights referred to above. The opposition division must exercise this discretionary power before starting a second exchange of submissions, ie before issuing the invitation to submit the rejoinder, as is made clear in R. 57(3) EPC.

In **T 532/91** the board considered it expedient to draw attention to the principle of equal rights. The board remarked that if the opposition division considered it expedient to start a **second exchange of submissions** and to indicate to the opponents the possibility of submitting a rejoinder, it was obliged to do so, in the **same way**, to the appellants (patent proprietors), so that the exchange of submissions could be completed and to place the parties on the same footing as regards the number of times they could present their arguments. The board failed to see why, during the same exchange of submissions, the opposition division had written to the opponents: "You are at liberty to file your rejoinder ..." and to the appellants (patent proprietors): "Please take note", which could have led the latter to be unsure of their right to submit a rejoinder. Such inequality of treatment was incompatible with the principle of equal rights - particularly since it was the patent proprietors who had been treated less favourably - and in itself constituted a procedural error.

In **T 789/95** the file contained no indication that a copy of the opponent's observations had been forwarded to the patent proprietor. It was therefore to be assumed that the communication of the observations to the patent proprietor had been omitted, in contravention of the Guidelines. In the board's view, this constituted a substantial procedural

violation, as it infringed the principle that all parties to proceedings must be accorded the same procedural rights.

2.2 The need for an invitation under Article 101(2) EPC

2.2.1 Admissibility of parties' observations

Under Art. 101(2) EPC, in examining an opposition the division invites the parties "as often as necessary" to comment, within specified periods, on its own communications or those filed by other parties.

According to **T 295/87** (OJ 1990, 470) in opposition proceedings under Art. 101(2) EPC and R. 57 (1) EPC the proprietor has a right to file observations upon a notice of opposition. Thereafter, observations from the parties are only admissible in the exercise of the discretion of the Opposition Division or a Board of Appeal, if such observations are necessary and expedient in the sense of Art. 101(2) EPC and R. 57(3) EPC (see also **T 406/86**, OJ 1989, 302; **T 7/95**). It is in the interest of the efficient conduct of opposition proceedings that observations by parties should be properly limited to what is necessary and expedient.

The board drew attention to the "General Principles" applying to opposition procedure contained in the Information from the EPO published in OJ 1985, 272, which it endorsed: "The EPO's aim is to establish as rapidly as possible, in the interests of both the public and the parties to the opposition proceedings, whether or not the patent may be maintained given the opponent's submissions. It seeks to achieve this by means of a speedy and streamlined procedure, which implies firm control by the opposition division at all stages. This requirement must however be balanced against the need to allow the parties to present their cases adequately so that the correct decision can be made." Insofar, the new version of the information from the EPO on the opposition procedure published in OJ 1989, 417 remained unchanged.

2.2.2 Invitation under Art. 101(2) EPC

According to board of appeal case law, Art. 101(2) EPC and R. 58(3) EPC do not require an opposition division to issue at least one communication before taking its decision, unless there is a need to do so on the basis of Art. 113(1) EPC. Art. 101(2) EPC does not require the grounds for not maintaining the patent invariably to be set out in a communication, but only if this is "necessary". Such "necessity" can arise only in efforts to establish the facts or in view of Art. 113(1) EPC. So the opposition division **must issue a communication only** if it considers this necessary, eg to take up **new** substantive or legal arguments or draw attention to points still requiring clarification (see **T 275/89** (OJ 1992, 126), **T 538/89**, **T 682/89**, **T 532/91**). Not issuing at least one communication under Art. 101(2) EPC cannot in itself substantiate an allegation of infringement of the right to be heard under Art. 113 EPC (**T 774/97**). For the purposes of Art. 101(2) EPC it is necessary to invite the proprietor to present his comments by filing observations if new evidence filed late by an opponent is to be taken into consideration in view of its relevance, and in the absence of observations upon such evidence by the patent proprietor, before the case can be decided on the basis of such evidence (**T 669/90**, OJ 1992, 739).

If, however, a patent was revoked without prior observations from the opposition division and if the relevant decision stated that the claims contained grantable subject-matter, it could be deemed that a violation of Art. 101(2) and R. 57(3) EPC (**T 103/97**) had occurred. In the case in question, the patentee only found out that the opposition division was of the opinion that the patent in suit contained grantable subject-matter when it received the contested decision. The fact that the patentee had not requested oral proceedings was interpreted in the contested decision as meaning that it waived any further amendments to the claims. This represented a violation of the principle of the right to be heard under Art. 113(1) EPC, and the reimbursement of the appeal fee was therefore equitable on the grounds of a substantial procedural violation (R. 67 EPC).

In **T 669/90** (OJ 1992, 739), which relates to the use and terms of a previous EPO form, the board was of the view that if the EPO sent a communication which (on a reasonable interpretation) misled a party into believing that it was not necessary to defend its interests by filing observations in reply to new facts and evidence filed by an adverse party, and if such new facts and evidence then formed the basis for a decision adversely affecting the misled party, the latter had not had "an opportunity to present its comments" within the meaning of Art. 113(1) EPC. Such a procedure was also not a fair procedure and was contrary to the principle of good faith governing relations between the EPO and parties to proceedings before it. The board did not agree with decision **T 22/89**, in which, in similar circumstances, the board found that it could be inferred from the teaching of the document in question ("the relevance of the document existed beyond any doubt") that such a document would have a decisive role in the decision (see also **T 582/95**).

In **T 165/93** the patentees, despite having been informed of the additional objection of the opponents concerning the further sub-claims, did not react, but maintained their sole request for maintenance of the patent with the amended claims. The board held that in this case there was no necessity under Art. 113(1) EPC for the opposition division to announce its opinion in advance in a communication or to give a further opportunity to the patentees to declare whether they were interested in a limited patent.

In **T 621/91** the board held that Art. 113(1) EPC did not require that the party be given a **repeated opportunity** to comment on the argumentation of the EPO body so long as the decisive objection against the contested procedural action, as in this case, remained the same (see **T 161/82**, OJ 1984, 551). The board therefore considered that in this case, in deciding to reject the opposition immediately after replying to the communication, the opposition division did not abuse its power of discretion.

2.3 EPO communications to "take note" and sufficient time to submit a response

An invitation by the opposition division to file observations under Art. 101(2) EPC is distinct from a communication inviting the recipient to take note. Several decisions are concerned with the question of the time that should be allowed for a response to an EPO communication to "take note".

In **T 582/95** it was stated that it is at the discretion of the recipient to reply to this communication if he finds it necessary, having reviewed the significance of the material sent

to him. If he intends to reply but for any reason is prevented from doing so within a reasonable period of time, then the appropriate action is to inform the opposition division of his difficulties.

In **T 275/89** (OJ 1992, 126) the objection was made that the interval between the notification to the patentee of a submission from the opponents and the date the decision was issued was too short to allow the appellant to file observations. The board noted that the opposition division waited for somewhat longer than a month before taking its decision. In the board's view, in the case of a communication which was issued for information purposes only and which did not set a time limit for response, a period of **one month** (which in the present case was exceeded) sufficed as a rule to comply with the requirements of Art. 113 EPC.

In **T 263/93** the board ruled that the right to be heard enshrined in Art. 113(1) EPC required that the party concerned be given **sufficient time** to submit an adequate response if the EPO decided to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. Thus, a decision relying on such objections could not be taken until an adequate period of time had expired in which the other party could have been fairly expected to present its comments. The question regarding what period of time was sufficient for this purpose was a **question of fact** which had to be answered on the basis of the merits of each individual case (see, for example, **T 22/89** of 26 June 1990, cited in **T 669/90** and **T 275/89**). The board observed that, since any time limit set by the EPO should not be shorter than **two months**, thus regardless of whether or not the action required within such a time limit was simple or could be performed immediately, normally, ie in the absence of any exceptional circumstances, an adequate period of time for presenting comments should not be shorter than that mentioned above.

Exceptional circumstances in which a shorter period of time was acceptable were mentioned in **T 275/89** (reasons, 3.3). In this decision the board noted that a **shorter** period of time was deemed to be acceptable because in this case the documents on which the decision under appeal was based had already been mentioned in the notice of opposition together with an assessment of their substantive and legal significance, so that the decision under appeal was not based on fresh matter. The board in **T 263/93** went on to state that, even if it were to accept that the **relevance** of the respondent's counterstatement might have been immediately apparent, the appellant's right to a fair procedure (see **T 669/90**, OJ 1992, 739) required that the opposition division should have waited at least two months before issuing a decision based on the objections raised for the first time in this counterstatement. In any case, a period of time of about one month was, in the present circumstances, where difficult technical questions had to be considered, not even sufficient to give the appellant a realistic opportunity to inform the opposition division of his intention to file a substantive reply and to ask for an appropriate time limit for this purpose, let alone to present substantive comments (see also **T 494/95**).

In **T 914/98** the board stated that the seventeen day period which elapsed between the appellants receiving the reply of the respondents and the handing over of the decision to the EPO internal postal service was manifestly too short to give the appellants an adequate opportunity for comment. The respondents had suggested that the appellants should have

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informed the opposition division within this period that a substantive reply would be forthcoming. The Board did not agree as having regard to the case law the appellants could not reasonably have expected a decision to be issued so quickly.

In **T 582/95** the appellant contended that the opposition division had committed a serious procedural violation in taking its decision before the appellants had had the opportunity to comment on some late-filed documents and that, under the Guidelines (E-VIII, 1.2), a time limit of four months for reply should have been set at the time when the relevant submissions of the respondents were communicated (with EPO Form 2911) to the appellants.

The board explained that the communications, signed by the formalities officer and inviting the appellants to "take note" of the opponents' submissions, did not constitute communications of the opposition division within the meaning of Art. 101(2) EPC, which require a period to be fixed for reply (normally four months, see Guidelines E-VIII, 1.2). The board also found that the **relevance** of the respondent's submissions and the new prior art documents in question was **self-evident**. The time that elapsed between the notification of the aforementioned communications and the issuing of the contested decision, which was based on reasoning corresponding in essence to the respondents' submissions, gave the appellants sufficient opportunity, particularly in view of the relative simplicity of the subject-matter involved, to comment on the newly cited prior art documents if they so wished (Art. 113(1) EPC).

In **T 430/93** the opposition division had issued a communication giving the respondent another month (making five months altogether) to comment on the appellant's rejoinder to the opposition. The respondent's comments of 9 December 1992 were received by the EPO on the same day, and notified to the appellant for information only. The decision revoking the patent was taken on 5 February 1993 and posted on 9 March 1993. This infringed the appellant's right to be heard; he was not given enough time to respond to the respondent's comments, or even invited to do so.

In **T 494/95** the patent proprietor's observations (rejoinder to the opposition) on the opponent's notice of opposition had been forwarded in a brief communication without setting a time limit. The opponent had replied by letter to the patent proprietor's observations. However, the decision to dismiss the opposition had already been issued. In the board's view, it was clear from R. 57(3) EPC, from the note "Opposition Procedure in the EPO" (see OJ 1989, 417, point 5) and from previous decisions that, if oral proceedings do not take place and the decision is based solely on grounds on which the parties concerned have had an opportunity to present their comments, a decision may be taken without further notice upon expiry of the period allowed to the patent proprietor for submitting observations. This was precisely the case with the contested decision. Here, the board could not see that any procedural violation had occurred, as the decision was neither based on grounds unknown to the appellant (Art. 113(1) EPC), nor was the opposition division invariably obliged under the EPC to set a time limit for the appellant's response to the patent proprietor's observations or to suggest that any such response should be made. The contested decision did not mention any new documents to the opponent's disadvantage, and no surprising arguments were presented which went beyond the assessment of prior art that could be expected. It was also significant that no time limit had been set in the aforementioned brief communication, ie

that the opposition division had not considered this expedient (R. 57(3) EPC). The board held that the interval of more than one month between the notification of the patent proprietor's observations and the date of issuing the decision was still sufficient, in this case, to allow the appellant a reasonable opportunity to present comments (see **T 275/89**, OJ 1992, 126), or at least to indicate an intention of so doing, or to request oral proceedings.

2.4 Opportunity to present comments after remittal for further prosecution

In **T 832/92** the board noted that, normally, before a department of the EPO takes a decision in a case when a document has been sent to one of the parties, said party is given sufficient time to respond thereto (see **T 263/93**). However, in this case, as the case was remitted to the first instance for further prosecution, the recipient still had the opportunity to contest the argumentation of the other party.

In **T 892/92** (OJ 1994, 664) (see also p. 276 et seq.) the board ruled that Art. 113(1) EPC requires that an express opportunity to present observations be given to the parties by the opposition division after remittal to it of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings (see also **T 769/91**).

In **T 120/96** the board considered a case in which remittal to the opposition division for further prosecution on the basis of new evidence was immediately followed by the rejection of the opposition, ie without any intervening communication announcing the resumption of proceedings. The board noted that Art. 113(1) EPC requires that an express opportunity to present observations be given to the parties by the opposition division after remittal to it of a case by a board of appeal for further prosecution on the basis of new evidence, even if submissions in respect of this new evidence have already been made during the previous appeal proceedings. The term "opportunity" in this article could only be given effective meaning by applying the principles of good faith and the right to a fair hearing. For such an opportunity to exist, it is necessary that the parties be expressly asked whether or not they wish to present, within a fixed period of time, their comments, or if, as in the case at issue, the parties have already made detailed submissions during the previous appeal proceedings, whether or not these submissions should be regarded as complete. On these grounds alone, the board found that the immediate termination of the opposition proceedings following the remittal was inconsistent with Art. 113(1) EPC.

The board also found it desirable to clarify whether any requests submitted originally, ie before the opposition proceedings were interrupted by the appeal proceedings, were maintained, modified or withdrawn, or whether further requests were to be submitted. Following the established jurisprudence of the boards of appeal (**T 892/92**, OJ 1994, 664), the board was of the opinion that further proceedings on remittal by the board of appeal ordering "further examination of the opposition" should be regarded as a continuation of the original opposition proceedings, particularly in view of the fact that the original interlocutory decision to maintain the patent unamended was set aside by the board and was therefore no longer legally effective. Consequently, the appellant's original requests - including his subsidiary request for oral proceedings, which had never been withdrawn or amended - became effective again after remittal, so the opposition division should not have taken a

decision adversely affecting the appellant without giving him an opportunity to present his case orally (Art. 116(1) EPC).

2.5 Communication pursuant to Rule 58(4) EPC

In **T 219/83** (OJ 1986, 211) and **T 185/84** (OJ 1986, 373) the board stated that, after oral proceedings in an appeal from opposition proceedings, the parties must be sent a communication pursuant to R. 58(4) EPC only if they cannot reasonably be expected to state their observations concerning the maintenance of the European patent in the amended form definitively during the oral proceedings. This case law was confirmed in several decisions (**T 75/90**, **T 895/90**, **T 570/91**).

In **T 446/92** the board held that where an opponent who has been duly summoned is not represented at oral proceedings before a board of appeal, the decision of the board to maintain the contested patent in amended form in accordance with a request of the patentee submitted during these oral proceedings may nevertheless be given orally pursuant to R. 68(1) EPC at the end of these oral proceedings if no new facts or evidence are dealt with during these oral proceedings. Under these circumstances, the application of R. 58(4) EPC may be dispensed with because the patent in suit is maintained with an amended text emanating from and approved by the patentee (see **G 1/88** (OJ 1989, 189)) and, furthermore, because the opponent's deliberate decision to refrain from being represented at oral proceedings before the board is to be regarded as being tantamount to a tacit abandoning of his right to present comments pursuant to Art. 113(1) EPC and R. 58(4) EPC. In the previous decisions **T 424/88**, **T 561/89** and **T 210/90** the board did not send the parties/participants a communication pursuant to R. 58(4) EPC, even though the appellants (opponents) had not attended the oral proceedings.

2.6 Proper opportunity to present comments in reply to new grounds

In **T 433/93** the first time that the proprietor was made aware that "insufficiency" had been raised as a ground of opposition to the patent was upon receipt of the decision of the opposition division in which the patent was revoked on this ground. There was nothing in the file record of this case to suggest that it was specifically raised and introduced into the proceedings by the opposition division. The board held that the issue of the decision was directly contrary to the requirement of Art. 113(1) EPC. The board referred to **T 951/92** (OJ 1996, 53), where it was stated that "the term 'grounds or evidence' in Art. 113(1) EPC should not be narrowly interpreted. In particular, in the context of examination procedure the word 'grounds' does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the which is considered not to be met. The word 'grounds' should rather be interpreted as referring to the essential reasoning, both legal and factual, which leads to refusal of the application. In other words, before a decision is issued an applicant must be informed of the case which he has to meet, and must have an opportunity of meeting it". The board found that this interpretation of Art. 113(1) EPC was equally applicable in the context of opposition proceedings (see also **T 105/93**). In the case in point, in order to satisfy Art. 113(1) EPC, before issuing the decision it would have been necessary to inform the proprietor not only of the new ground of opposition being raised and introduced into the proceedings, this being the **legal basis** on which the patent was being challenged (see **G**

1/95 and **G 7/95**, OJ 1996, 615 and 626), but also of the **essential legal and factual reasons** which could lead to a finding of invalidity and revocation. Thereafter it would have been necessary to ensure that the proprietor had a proper opportunity to present comments in reply to this new ground.

In **T 656/96**, the opponent had based his opposition solely on the invention's purported lack of inventive step. Also, the opposition division's communication under Art. 101(2) EPC had raised no novelty objection. The patentee thereupon informed the division that he would not be attending oral proceedings. In its decision, the opposition division revoked the patent for lack of novelty, a ground advanced for the first time in the oral proceedings. The board stated that, according to **G 7/95** (OJ 1996, 626), the issues of novelty and inventive step constituted different grounds for opposition. As had been explained in **G 10/91** (OJ 1993, 420) any fresh grounds for opposition could be considered by the opposition division if, prima facie, they appeared, either in whole or in part, to prejudice the maintenance of the European patent. The board stated that, in the light of the opinion on novelty expressed in the communication from the opposition division, no prima facie case could be seen from the file, so that the appellant had been entitled to consider that the question of novelty would play no part before the opposition division. The appellant must therefore have been taken by surprise by the decision taken in his absence by the opposition division at the oral proceedings to revoke the patent on the grounds of lack of novelty, grounds on which he had not been asked, nor had any reason, to express an opinion .

2.7 Opportunity to present comments and extension of opposition

In **T 293/88** (OJ 1992, 220) the board found that the decision of the opposition division to revoke the patent without issuing any communication in advance disregarded the fact that validity at another level was not challenged at all, and a further opportunity to fall back at least to such position was reasonably to be expected in such circumstances. It also found that the opposition division should have assumed the prima facie validity of dependent claims which had not been objected to by the opponent at any stage. The onus of raising such related additional matter with the parties was on the opposition division under Art. 113(1) EPC. The board found that the opposition division had failed to inform the parties of its position with regard to dependent claims 7, 9 and 10, which were not challenged. Since the patent might have been maintained in an amended form on the basis of such claims at that stage in the absence of specific objections on the part of the examining division, the failure to inform all concerned was a substantial procedural violation and a reimbursement of the appeal fee was justified.

2.8 Provisional opinion and further opportunity to present comments

In **T 558/95** the opposition division had issued two written communications before the oral proceedings stating that, "in the provisional opinion of the opposition division", the subject-matter described in the public prior use did not prejudice the contested patent within the terms of Art. 100(a) EPC. The patent proprietor therefore found it "surprising" that detailed consideration was given to the public prior use during the oral proceedings. However, the board held that provisional opinions of this kind were not binding on the further proceedings. Especially in view of the fact that the opponent continued to elaborate his arguments against

these comments by the opposition division, the possibility of a different assessment by the opposition division could not be ruled out from the start.

2.9 Inadmissible oppositions

If an opposition is rejected as inadmissible but the division does not say why, thereby preventing the opponent from responding, it infringes his right to comment (**T 1056/98**).

3. Acceleration of proceedings in the case of pending infringement proceedings

If the opposition division is unable to process an opposition case speedily on account of the amount of work in hand, the Guidelines (D-VII, 1.1) stipulate that it should, in principle, process submissions in order of receipt. However, the Guidelines also list cases to be given priority. A notice from the EPO dated 19.5.1998 (OJ 1998, 361 and 362) clarified this matter. The EPO speeds up its processing of an opposition case when it is informed by a party to the proceedings or by the court or other competent authority of a contracting state that an infringement action is pending.

Decision **T 290/90** (OJ 1992, 368) gave the board of appeal the opportunity to comment on accelerated processing of oppositions and appeals. In a case involving seven oppositions, one had been rejected on formal grounds, whereupon the opponent filed an appeal on 12.4.1989. A communication under R. 69(1) EPC stating that the opposition was deemed not to have been filed was issued on 2.6.1989, followed by a decision under R. 69(2) EPC on 29.1.1990. The patent proprietor requested accelerated processing of the appeal because an infringement action was pending and, in view of the probable number of infringing products on the market, the longer the opposition proceedings took, the more difficult it would be for him to enforce the patent.

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

4. Intervention of an alleged infringer

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

In **G 4/91** (OJ 1993, 339) the Enlarged Board held that the intervention under Art. 105 EPC of an assumed infringer in the opposition proceedings presupposed that opposition proceedings were pending at the time he gave notice of intervention. Moreover, a decision of the opposition division on the relief sought had to be regarded as conclusive in the sense that the opposition division no longer had the power thereafter to amend its decision. The Enlarged Board further held that proceedings before an opposition division were terminated when such a conclusive decision was issued, irrespective of when this decision became final. Thus, if, after an opposition division had issued a decision terminating the proceedings, none of the parties to the opposition proceedings filed an appeal, any notice of intervention filed during the two-month period for appeal under Art. 108 EPC was invalidated.

In **T 631/94** (OJ 1996, 67) the board noted that when a decision to terminate opposition proceedings, taken in written proceedings, was handed over to the EPO postal service, it became public and effective and had therefore been issued. If the parties to the proceedings leading to that decision did not appeal, the opposition proceedings were completed at that point in time and thereafter intervention based on Art.105 EPC was no longer possible. See also p. 381 et seq.

In **T 446/95** the infringement action was based on a French **national patent**. The board held that the intention and purpose of an intervention in accordance with Art. 105 EPC was to enable the assumed infringer to defend himself against the action by the patentee based on the opposed **European patent**, in order to prevent the EPO and the national courts handing down contradictory decisions on the validity of European patents. In the case in question, the fact that the European patent had claimed priority from the French patent and that France had been designated was irrelevant, as there was no legal basis for intervening in the European patent on the basis of an infringement action relating to the French patent. The admissibility of an intervention before the EPO could not depend on a provision of national law. The intervention was therefore inadmissible.

In **T 392/97** the would-be interveners requested that the date for the appointed oral proceedings be postponed and submitted that they had not been duly summoned to the oral proceedings in accordance with R. 71(1) EPC, second sentence, which stipulated at least two months' notice. In the board's view, R. 71(1) EPC did not stipulate that the requirement of a two-month period also applied if, subsequent to a duly effected summons, there was an intervention by a third party. As a general principle, an intervener entered the proceedings at the stage they were at on the date of intervention, including **pending time limits**. Issuing a further summons or adjourning the date would in this case clearly conflict with the previous agreement between the opponent and the patentee as to the fixing of the oral proceedings and with the legitimate interest of the parties in bringing the proceedings before the EPO to a conclusion. The request for postponement of the appointed oral proceedings was therefore rejected.

For intervention during opposition appeal proceedings see page 509 et seq.

5. Transfer of opposition

The following question regarding the transfer of an opposition was put to the Enlarged Board

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

In **G 4/88** (OJ 1989, 480), the Enlarged Board of Appeal, after noting that the EPC implicitly acknowledged the transmission of the opposition to the opponent's heirs and that, by analogy, the opposition could be transmitted to the opponent's universal successor in law (R. 60(2) EPC), held that the opposition constituted an inseparable part of the enterprise's assets; therefore, in so far as those assets were transferable or assignable under the applicable national laws, the opposition which was part of them had also to be regarded as transferable or assignable in accordance with the principle that an accessory when annexed to a principal object becomes part of the principal object.

In **T 659/92** (OJ 1995, 519) the board added that a party's rights in a case may be transferred at any stage of opposition appeal proceedings, provided they are transferred together with the business assets or the assets in the interests of which the appeal was filed.

In **T 670/95** the board summarised the case law regarding transfer of opponent status. Opponent status is not freely transferable (**T 659/92**, see above). It does however move to the successor in title in case of universal succession, eg a takeover or merger of legal persons (**T 349/86**, **T 475/88**). It is also transferable to a third party together with the opponent's business assets or firm in the interests of which the opposition was filed (**G 4/88**, OJ 1989, 480). This may occur even during opposition/appeal proceedings. However, to obtain opponent status, and become party to the appeal proceedings, the new opponent must first satisfy the Office that a transfer has duly taken place. Until he does so, the proceedings are conducted with the original opponent (**T 870/92**). The board therefore ruled that a firm cannot simply claim to be the original opponent's successor in title; it must provide proof of a proper transfer.

For further decisions about the transfer of party status, see p. 507 et seq., see also **T 9/00** (OJ 2002, ***), headnote on p. xxv.

6. Withdrawal of opposition - continuation of opposition proceedings (Rule 60(2) EPC)

6.1 Withdrawal during opposition proceedings

R. 60(2) EPC provides that the opposition proceedings may be continued by the EPO of its own motion if the opposition is withdrawn.

In **T 197/88** (OJ 1989, 412) the board considered the circumstances under which opposition proceedings could be continued by the EPO of its own motion under R. 60(2) EPC when an opposition was withdrawn. In a communication under R. 58(4) EPC the opposition division had proposed an amended version of the patent which the patent proprietor approved. The opponent at first raised objections but then withdrew his opposition, whereupon the opposition division terminated the proceedings. In response to the patent proprietor's appeal, the board remitted the case to the opposition division to continue the proceedings. The board

pointed out the EPO's duty to the public not to maintain patents which it was convinced were not legally valid at all or only to a limited extent. Furthermore, it was often the patent proprietor who was interested in limiting his patent to ensure that his claims stood up to legal scrutiny. The proceedings ought therefore to be continued if they had reached such a stage as to be likely to result in limitation or revocation of the European patent without further assistance from the opponent and without the opposition division itself having to undertake extensive investigations.

In **T 558/95** the chairman informed the parties at the oral proceedings that the patent proprietor's main request was refused. Several months later, the opponent withdrew the opposition. The opposition division thereupon issued the contested interlocutory decision, in which the reasons for refusing the main request were based on the opposition division's assessment of the relevance of the public prior use, while the auxiliary request was allowed. The patent proprietor appealed against the interlocutory decision. In his statement of grounds for appeal, he argued, inter alia, that, after the withdrawal of the opposition, there had no longer been any reason for the opposition division to continue the proceedings, unless the evidence already considered had sufficed to justify the limitation or revocation of the contested patent, without additional help from the opponent and without further detailed investigations. These conditions had not been satisfied. The board noted that the main request had been refused at the oral proceedings, ie before the opposition was withdrawn. The decision concerning this request was final; even after the withdrawal of the opposition, it could no longer be reviewed by the department of first instance. The continuation of the proceedings by the EPO of its own motion under R. 60(2) EPC, second sentence, therefore applied only to the auxiliary request, which had not been the subject of a final decision at the oral proceedings.

6.2 Withdrawal of opposition during appeal proceedings

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

In particular, in **T 629/90** (OJ 1992, 654) two oppositions had been lodged against the granting of a patent. One opponent had withdrawn its opposition prior to delivery of the decision by the opposition division. The patent proprietor lodged an appeal against the patent's revocation. The other opponent withdrew its opposition prior to oral proceedings before the board. The board held that, in contrast to the situation in opposition proceedings, where it was a matter of discretion whether the case was continued following withdrawal of the opposition, withdrawal in appeal proceedings had no direct significance in terms of procedural law if the opposition division had revoked the European patent. In this case, the board of appeal had to examine the substance of the opposition division's decision of its own motion; it could only set the decision aside and maintain the patent if the latter met the requirements of the EPC. The board could also take account of evidence submitted by an opponent prior to withdrawal of the opposition (see also p. 540).

7. Surrender or lapse of a European patent

R. 60(1) EPC provides that if a European patent has lapsed or been surrendered in respect

of all the designated states, the opposition proceedings may be continued at the request of the opponent, provided the request is filed within two months of the date on which the EPO notified the opponent of the surrender or lapse.

In **T 194/88** the board found that R. 60(1) EPC established **no legal obligation** for the EPO to ascertain of its own motion the legal status of a European patent and did not apply in the event of an alleged surrender or lapse of a European patent, unless confirmation thereof had been received by the EPO from the appropriate authorities of all the designated contracting states.

In **T 73/84** (OJ 1985, 241) the board ruled that the patent proprietor could not terminate the proceedings by telling the EPO that he was surrendering the European patent, since this was not provided for in the EPC. Thus he could only, as far as national law permitted, surrender the patent vis-à-vis the national patent offices of the designated contracting states under the relevant national law (**T 196/91**); see also under the chapter "Surrender of patent as a whole" on page 345.

In **G 1/90** (OJ 1991, 275) the Enlarged Board observed that while the patent grant procedure clearly provided scope for legal fictions, ie withdrawal of the patent application, a similar interpretation was out of the question in proceedings before the opposition divisions. Once a patent had been granted, the proprietor could no longer surrender it by informing the EPO. At this stage in the proceedings, notices of surrender had to be addressed to the national authorities of the designated contracting states.

8. Admissibility of opposition

8.1 Examination by the EPO of its own motion

It is a principle firmly established by board of appeal case law that the admissibility of an opposition is examined by the EPO of its own motion. An objection that the opposition is inadmissible because the opponent is not entitled to file an opposition may be raised at any stage of the proceedings, ie even at a late stage before the board of appeal, because the admissibility of the opposition is an indispensable procedural requirement for any substantive examination of the opposition submissions (see **T 289/91**, OJ 1994, 649, **T 960/95**, **T 1180/97**). Also in **T 522/94** (OJ 1998, 421) the board held that the admissibility of the opposition had to be checked ex officio in every phase of the opposition and ensuing appeal proceedings. It could and, where appropriate, had to be raised by the board in appeal proceedings, even if this was the first time the matter was addressed (see also **T 28/93**, **T 590/94**).

In **T 541/92** it was ruled that the board of appeal was obliged, by virtue of Art. 101(1) EPC, to examine the admissibility of an opposition, even if the patent proprietors had not raised the question of its inadmissibility during either opposition or appeal proceedings.

In **T 199/92** it was held that the board was empowered to raise the issue of admissibility of an opposition if it had **sound reasons** for so doing.

In decision **T 222/85** (OJ 1988, 128) the appellant contended that once the opposition had been declared admissible by means of the communication according to R. 57(1) EPC there was no basis in the EPC for reversing this decision and declaring the opposition inadmissible. However, the board decided that a communication under R. 57(1) EPC indicating the admissibility of an opposition was not a decision of the opposition division, and the sending of such a communication did not prevent the subsequent rejection of the notice of opposition as inadmissible under R. 56(1) EPC, for example if the admissibility was challenged by the patent proprietor in the proceedings (see also **T 621/91**).

In **T 522/94** (OJ 1998, 421) the board commented by way of obiter dictum on the significance of admissibility. This was a classic example of a case where turning a blind eye to procedural requirements had led to an impasse. The opponent had not set out enough facts for the opposition division to be able to determine the issues of novelty and inventive step. The board stressed that admissibility of the opposition was an important aspect when checking the opposition as to formal requirements, and that to go into the merits of the case where there was a lack of admissibility could not be justified by the theory "that a patent cannot be maintained when its lack of validity strikes the eye". There was no such "eye-striking case" if the facts, evidence and arguments were insufficient. The requirement of admissibility was not to be circumvented by over-emphasising the ex officio principle and shifting the burden of establishing the case from the opponent to the opposition division.

In referral decision **T 649/92** (OJ 1998, 97) the board found that it was not clear whether a board of appeal in appeal proceedings could start an enquiry involving asking for further evidence to resolve the question of admissibility due to doubts as to the real identity of the opponent. In **G 4/97** (OJ 1999, 270) the Enlarged Board of Appeal reaffirmed that the admissibility of an opposition on grounds relating to the identity of an opponent could be challenged during the appeal, even if no such challenge had been raised before the opposition division.

In **T 925/91** (OJ 1995, 469) the appealed decision of the opposition division did not confine itself to rejecting the opposition as inadmissible but, in addition, expressed its opinion on the validity of the patent. The board followed the previous case law of the boards of appeal, according to which an opposition could not be examined as to its substance when it had been declared inadmissible. As soon as an opposition had been **rejected as inadmissible**, the opposition procedure was legally terminated and **substantive examination could not be initiated**. The inadmissibility of an opposition, when finally decided, or an appeal, had the effect of transferring the European patent to the national jurisdiction of the designated states, which then assumed sole responsibility for assessing the patent's validity with reference to their own legislation. The board therefore came to the conclusion that it was inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider that opposition's merits. The board further held that remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. However such remarks should, on principle, be avoided as a procedural deficiency of this kind could result in legal uncertainty during the national phase and could disadvantage either the proprietor or the opponent (see also **T 328/87**, OJ 1992, 701).

8.2 Competence to decide

According to R. 56(1) EPC, if the opposition division notes that the notice of opposition does not comply with the provisions, among others, of Art. 99(1) EPC (ie the provisions governing, inter alia, the time limit for filing a notice of opposition), it must reject the notice of opposition as inadmissible.

In **T 295/01** (OJ 2002, ***) the board stated that according to this provision, the competence to decide on the inadmissibility of a notice of opposition lies with the opposition division and cannot be entrusted to formalities officers.

Since the provision of point 6 of the Notice of the Vice-President of DG2 concerning “the entrustment of formalities officers of certain duties normally the responsibility of the opposition division of the EPO” (OJ 1999, 506) conflicts with provisions of a higher level (R. 9(3) EPC and R. 56(1) EPC), the latter prevail in analogy with the provisions of Art. 164(2) EPC.

8.3 Formal requirements for an opposition

8.3.1 General

According to Art. 99(1) EPC notice of opposition must be filed within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin. In the interests of legal certainty, the EPC lays down certain requirements for an opposition that must be met before the opposition period expires. These include the requirements that the patent opposed be identified, the notice of opposition be in writing, specific grounds be stated and the appropriate fee be paid.

A notice of opposition is to be rejected as inadmissible pursuant to R. 56(1) EPC if it does not comply with the provisions of Art. 99(1) EPC, R. 1(1) EPC and R. 55(c) EPC or does not provide sufficient identification of the patent opposed, unless these deficiencies are **remedied** before expiry of the opposition period (**T 925/91** (OJ 1995, 469), **T 590/94**).

In **T 152/85** (OJ 1987, 191) the board stated that Art. 99(1) provided a nine-month period during which notice of opposition could be filed and the **opposition fee** paid, payment of the fee being essential for filing of the opposition. Until the requirements of Art. 99(1) EPC had been met, a potential opponent was not a party to any proceedings before the EPO.

In **T 193/87** (OJ 1993, 207) the board found that if a notice of opposition was filed in a language of a contracting state other than an official language of the EPO and the **translation** prescribed in Art. 14(4) EPC was not filed in due time, the notice should be deemed not to have been received, and the opposition fee was to be refunded (following **T 323/87**, OJ 1989, 343). Since the opposition had not come into effect, there was no question of examining its admissibility under R. 56(1) EPC.

In **T 960/95** the notice of opposition was filed **without having been signed**. The board stated that a notice of opposition should be duly signed (R. 36(3) EPC, first sentence, in conjunction with R. 61a EPC). The omission of the signature was remedied within the time limit set by the

opposition division, and the notice of appeal therefore retained its original date of receipt (R. 36(3) EPC, third sentence).

In **T 344/88** the board of appeal considered whether the citing by the opponent of the wrong number for a patent specification contravened R. 55(c) EPC, if the **mistake** was not corrected until after expiry of the opposition period. The first patent specification cited by the opponent bore no relation at all to the invention. However, the notice of opposition contained enough detailed information for it to have been possible to identify the actual patent specification intended. The board of appeal allowed the number to be corrected. Given such a detailed submission of facts, it would have been taking formal requirements too far to reject the opposition simply because the wrong number had been given for a cited patent specification. Whether or not the EPO actually effected a correction between receipt of the notice of opposition and expiry of the period of opposition was irrelevant. The sole decisive factor was that the error was recognisable within the period for opposition and that the opposition division was able, on the basis of the description of the citation, to establish the latter's identity beyond all doubt.

In **T 438/87** the question addressed was whether a delay in **publication** of the European patent specification could in any way affect calculation of the time limit for filing an opposition. The board of appeal noted that "since mention of the grant of the patent in suit was brought to the public's attention in the normal way in the Bulletin ... it is this latter date which should be taken as the point from which the opposition time limit runs, irrespective of what problems may have affected publication of the patent specification and what consequences such untoward event may have for certain third parties owing to their geographical location".

In decision **T 317/86** (OJ 1989, 378) the opponent had not indicated **the title** of the invention within the period specified under R. 56(2) EPC. The board decided that omission from the notice of opposition of the title of the invention - merely an item of bibliographical data identifying the contested patent - did not constitute a deficiency within the meaning of R. 56(2) EPC, provided that the other particulars available to the EPO were together sufficient to identify easily and beyond doubt the patent being contested by means of an opposition.

8.3.2 Designating the opponent

R. 55(a) EPC provides that the notice of opposition shall contain the name and address of the opponent and state where his residence or his principal place of business is located, in accordance with the provisions of R. 26(2)(c) EPC, which deals with the precise particulars by which such identity needs to be established.

In **T 25/85** (OJ 1986, 81) the board held that if the identity of an opponent had not been established before expiry of the period allowed for opposition, the opposition was inadmissible.

In **T 870/92** the respondent in appeal proceedings had argued that the opponent lacked the capacity to be a party and that the opposition must therefore be refused as inadmissible. The board emphasised that, when indicating a legal entity, failure to use its exact official designation (R. 26(2)(c) EPC and R. 61(a) EPC) did not necessarily mean that the opposition

was inadmissible. An incorrect designation which nevertheless sufficed to indicate the party's identity had to be distinguished from the absence of such information. Errors in a designation could be corrected at any time (R. 88 EPC, first sentence) (see also **T 828/98**).

8.4 Entitlement to file an opposition

8.4.1 General conditions

In **G 3/97** and **G 4/97** (OJ 1999, 245, 270) the Enlarged Board of Appeal looked at the whole issue of opponent status. On many points, these decisions superseded earlier case law on the entitlement and identifiability of opponents (see also point 8.4.4). According to **G 3/97** and **G 4/97**, an opponent's status is a procedural status, and the way it is substantiated is a matter of procedural law. In the EPC, this is laid down in Art. 99(1) EPC in conjunction with Art. 100 EPC, R. 55 EPC and R. 56(1) EPC. According to those provisions, the opponent is the person who meets the conditions set out therein for filing an opposition, in particular that of identifiability. The EPC sets no other explicit formal conditions for opponents.

8.4.2 Interest of the opponent

G 3/97 and **G 4/97** (OJ 1999, 245, 270) held that the EPC legislator had expressly designed the opposition procedure as a legal remedy in the public interest, which under Art. 99(1) EPC was open to "any person". Requiring an opponent to show an interest, of whatever kind, in invalidating the patent would be incompatible with that. The opponent's motives were irrelevant for the EPO, in the absence of evidence of abusive conduct.

As early as in **G 1/84** (OJ 1985, 299) the Enlarged Board had held that the **motives** of the opponent were in principle irrelevant (otherwise, no doubt, the phrase "any person" would have been rendered as "any person interested"), whilst his identity was of primarily procedural importance. In **T 635/88** (OJ 1993, 608) the board found that the EPC did not require any particular **interest** to start opposition proceedings. According to **T 590/93** (OJ 1995, 337) too, it was therefore clear that **any person**, as opposed to any person interested, might oppose a granted European patent. Had the intention of the legislature been different, the article would no doubt have been drafted to include locus standi or some other formulation of relevant interest as a precondition for the admissibility of an opposition.

In **T 798/93** (OJ 1997, 363) the board pointed out that the EPC and its attendant provisions imposed **no conditions** whatever regarding a person's status or motives for acting. It was therefore appropriate to refuse requests for the opposition to be declared inadmissible where, as in the case under consideration, they were based on either an objection regarding an aspect of the opponent's status, such as his profession (a representative authorised to appear before the EPO), or his field of technical expertise (different from that of the patent forming the subject of the opposition) or on his motives for acting (statement by the opponent saying that his only reason for acting was to complete his training).

8.4.3 Opposition by the patent proprietor

In **G 9/93** (OJ 1994, 891) the Enlarged Board overturned the decision in **G 1/84** (OJ 1985,

299) by holding that the **patent proprietor** was not covered by the term "any person" in Art. 99(1) and was therefore **not entitled** to oppose his own patent under that provision. The ruling on this matter in **G 1/84** could thus no longer be followed.

8.4.4 Opposition on behalf of a third party - "straw man"

Referrals **T 301/95** (OJ 1997, 519) and **T 649/92** (OJ 1998, 97) asked whether an opposition is inadmissible if the opponent is a "straw man" acting for some other person. In **G 3/97** and **G 4/97** (OJ 1999, 245, 270) the Enlarged Board of Appeal ruled that the opponent is the person who fulfils the requirements of Art. 99(1) EPC in conjunction with Art. 100 EPC, R. 55 EPC and R. 56(1) EPC. Filing the opposition makes him formally the legitimate opponent. If he has met the requirements for an admissible opposition, he is an opponent and remains such until the end of the proceedings or of his involvement in them. He cannot offload his status onto a third party. Thus there cannot be another "true" opponent apart from the formally authorised opponent. A third party who incites him to file the opposition cannot perform any procedural acts, and is certainly not treated as a party to the proceedings. The EPO also lacks the procedural scope for investigating the allegation that a straw man is involved. So an opposition is not inadmissible purely because the person named as opponent in accordance with R. 55(a) EPC is acting on behalf of a third party.

It is however inadmissible if the opponent's involvement is to be regarded as circumventing the law by abuse of due process.

a. Such circumvention of the law arises, in particular, if:

aa. the opponent is acting on behalf of the patent proprietor. According to **G 9/93** (OJ 1994, 891), a proprietor cannot oppose his own patent; opposition is an inter partes procedure, so the patentee and opponent must be different persons.

bb. if the opponent is acting on behalf of a client in the context of activities which, taken as a whole, are typically associated with professional representatives, without possessing the necessary qualifications pursuant to Art. 134 EPC. This would be the case if a person not entitled to act as a professional representative were acting on a client's behalf and carrying out all the activities typically carried out by professional representatives, while himself assuming the role of a party in order to circumvent the prohibition on his acting as a professional representative.

b. However, circumvention of the law by abuse of process does not arise purely because:

aa. a professional representative files an opposition in his own name on behalf of a client

bb. an opponent with either a residence or principal place of business in an EPC contracting state is acting on behalf of a third party who does not meet this requirement.

c. In determining whether the law is being circumvented by abuse of process, the principle of the free evaluation of evidence is to be applied. The burden of proof lies with the person alleging that the opposition is inadmissible. The deciding body has to be satisfied, on the

basis of clear and convincing evidence, that such abuse is occurring.

In **T 649/92** dated 28.09.1999 the respondent/patent proprietor challenged the appellant's status on the basis that he was a "straw man", ie acting on behalf of a third party, and therefore not entitled to be an opponent. The board, bound under Art. 112(3) EPC to **G 4/97** (OJ 1999, 270), had no grounds to suspect that the appellant was acting on the patentee's behalf or that any such circumvention of the law was occurring (see also **T 459/96** and **T 461/96**).

The principles now laid down by the Enlarged Board have rendered irrelevant much of the content of earlier decisions regarding oppositions filed by professional representatives, consultancy firms or straw men, or concerning doubts about (and evidence of) the opponent's true identity (**T 10/82**, OJ 1983, 407, **T 635/88**, OJ 1993, 608, **T 25/85**, OJ 1996, 81, **T 582/90**; **T 289/91**, OJ 1994, 649, **T 548/91**, **T 339/93**, **T 590/93**, OJ 1995, 337, **T 798/93**, OJ 1997, 363), and thus also the commentary in Section VII.C, points 8.3.4 to 8.3.6, 8.4.2 and 8.4.3 of the 3rd edition of the Case Law of the Boards of Appeal of the EPO.

8.4.5. Admissibility of joint oppositions

In **T 272/95** (OJ 1999, 590) the board considered whether "any person" in Art. 99 EPC could be construed to mean that a group of natural persons with no legal status of their own could validly file a single common opposition and whether such an opposition could be validly filed on behalf of all those persons, although only one fee was paid. Other issues to be clarified were how to organise the group's common representation to safeguard the patentee's procedural rights, and whether the group could become another "person" if the number of its members changed. The board therefore referred the following questions to the Enlarged Board of Appeal:

1. Is an opposition admissible which otherwise meets the requirements of Art. 99 EPC and R. 55 EPC if it is filed jointly by two or more persons and only one opposition fee is paid?
2. If the answer to question 1 is in the affirmative and a common representative was named under R. 100(1) EPC in the notice of opposition, is an appeal valid even if it is not filed by that person?
3. If the answers to questions 1 and 2 are in the affirmative, which other requirements, if any, have to be met by a joint opposition or a joint appeal in order to safeguard the rights of the patent proprietor?

The case is pending as **G 3/99**.

8.5 Substantiation of the grounds of opposition

8.5.1 Sufficiency of the notice of opposition

Under R. 55(c) EPC the notice of opposition must contain three items: a statement of (1) the extent to which the European patent is opposed and (2) of the grounds on which the

opposition is based as well as (3) an indication of the facts, evidence and arguments presented in support of these grounds. Such "indication of the facts, evidence and arguments" in support of the stated grounds of opposition is often referred to as the "substantiation" of the grounds of opposition. Several decisions have considered, in particular, this **third requirement**, and the conditions to be satisfied in order for it to be fulfilled.

In decision **T 222/85** (OJ 1988, 128) the board of appeal held that this requirement was only satisfied if the contents of the notice of opposition were **sufficient** for the opponent's case to be **properly understood** on an objective basis. The board reasoned that the purpose of requirement (3) of R. 55(c) EPC (in combination with requirements (1) and (2)) was to ensure that the notice of opposition set out the opponent's case sufficiently so that both the patentee and the opposition division knew what that case was. Whereas the requirements of R. 55(1)(a) and (b) EPC and the requirements (1) and (2) of R. 55(c) EPC could be considered as **formal** in nature, requirement (3) of R. 55(c) EPC, in combination with Art. 99(1) EPC, was **substantive** in nature, and called for reasoning which went to the merits of the opponent's case. A well-drafted opposition ought to contain reasoning that was full but concise. And in general, the less reasoning that a notice of opposition contained, the greater the risk that it would be rejected as inadmissible. The board held that the question whether a particular notice of opposition met the minimum substantive requirements of Art. 99(1) EPC and R. 55(c) EPC could only be decided in the context of each individual case (since various relevant factors, such as the complexity of the issues raised, varied from case to case). The board further pointed out that the **sufficiency** of the notice of opposition in this respect had to be distinguished from the **strength** of the opponent's case. On the one hand, an unconvincing ground for opposition might have been clearly presented and argued. Conversely, a deficient submission might be rejected as inadmissible even though, if properly drafted, it would have succeeded (**T 621/91**, **T 3/95**, **T 152/95**, **T 1097/98**). The facts presented in support of grounds for an opposition must be sufficient for the EPO and the patent proprietor to understand the case without further investigation (**T 2/89**, OJ 1991, 51).

In **T 925/91** (OJ 1995, 469) the board added that the third requirement of R. 55(c) EPC would only be satisfied if there was sufficient indication of the relevant facts, evidence and arguments (ie relevant to the extent to which the patent was opposed) for the reasoning and merits of the opponent's case in relation to the grounds of opposition relied upon to be properly understood by the opposition division and the patentee. This had to be **assessed on an objective basis**, from the point of view of a reasonably **skilled person** in the art to which the opposed patent related.

In **T 3/95** the respondent had challenged the admissibility of the opposition by arguing that a notice of opposition should have dealt with the contested claims feature by feature, ie it was not clear how a skilled person could arrive at the whole of the claimed subject-matter in an obvious way. The board found having regard to the relatively low level of complexity of the claimed subject-matter, the board considered that the "opponent's facts and arguments" enabled the reader to understand sufficiently why the claimed subject-matter was considered to lack an inventive step.

In **T 234/86** (OJ 1989, 79) the board found that the EPC nowhere required that an argument

brought in support of opposition had to be conclusive in itself for the opposition to be admissible. The board went on to say that considering the evidence - which in this case involved determining whether the documents adduced actually established the facts as maintained - was part of the process of ascertaining whether the opposition was well founded in substance. Under Art. 101(1) EPC, this could only be done if it had already been determined that the opposition was admissible (see also **T 453/87** and **T 2/89** (OJ 1991, 51)).

In **T 199/92** the board noted that a patentee had to be able to understand, without undue burden, the case that was being made against his patent in the notice of opposition. This requirement did not, however, exclude the possibility that a patentee might have to undertake **a certain amount of interpretation** (see also **T 934/99**).

In **T 934/99** the board stated that R. 55(c) EPC does not imply the requirement of a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition must be cogent or convincing. Rather, the criterion is whether the arguments presented are relevant and, where necessary as the result of a reasonable interpretative effort, specific enough for allowing a person skilled in the art to form a reasoned opinion of whether the line of reasoning on which the opponent apparently relies is (logically) correct ("convincing") or not (i.e. wrong).

In **T 204/91** the board stated that the term "indication" in R. 55(c) EPC had to be construed as requiring more than **a mere hint** at a number of possible attacks upon the patent and at the likely support for each such possible attack, which indication (or hint) might then be augmented by the subsequent late filing, possibly even at the appeal stage, of further evidence, arguments or other matter - even of fresh grounds of objection. Rather, the scope and depth of "indication" needed to be such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent, and what evidential support was being adduced for that attack. In other words, the patentee and the opposition division had to be put in a position of understanding clearly the nature of the objection submitted as well as the evidence and arguments in its support. This required the elaboration of the relevant circumstances of the case to such an extent that the patentee and the opposition division were able to form a definitive opinion on **at least one ground** of opposition raised, without the need to make further investigations (see **T 453/87**, **T 279/88**).

In **T 1069/96** the board pointed out the following: The German version of the EPO's Guidelines for Examination, D-IV, 1.2.2.1(v) says the notice of opposition must contain grounds enabling the patent proprietor and the opposition division "**abschließend**" (= "conclusively") to examine the alleged ground for revocation without recourse to independent enquiries. That adverb does not appear in the English and French texts ("as to enable ... to examine..."; "doit permettre ... d'examiner..."). The board held that R. 55(c) EPC did not prescribe such a complete "indication of the facts, evidence and arguments presented in support" as to permit a conclusive examination on that basis alone.

In **T 1019/92** the board stated that the question of whether a notice of opposition fulfilled the requirement of R. 55(c) EPC was an objective one which had to be judged at the expiry of the nine-month opposition period. The board emphasised that even if, as in this case, an opponent subsequently relied upon prior art material not mentioned in the notice of opposition

to support its line of argument, this could not render that notice of opposition inadmissible if at the **relevant date** it complied on an objective basis with the requirement stated above.

In **T 182/89** (OJ 1991, 391) the board held that in order to establish insufficiency, a mere statement by an opponent that one example in a patent had been repeated once "exactly as described" without obtaining exactly the described results as set out and claimed in the patent was clearly in principle quite inadequate to discharge the burden of proof. Indeed, if a notice of opposition alleged insufficiency under Art. 100(b) EPC as the **sole ground** of opposition, and contained such a **statement** as the only indication of "facts, evidence and arguments" in support of this ground, there would, in the board's view, be good grounds for rejecting such a notice of opposition as inadmissible, on the basis that it contained no sufficient indication of facts and evidence which, **even if subsequently proved**, could provide legal and factual reasons for revoking the patent.

If, as in the present case, a ground for opposition were alleged in the notice of opposition but **not per se properly supported** as required by R. 55(c) EPC within the nine-month period for opposition (in the sense that if it were the only ground for opposition alleged in the notice of opposition, the opposition would be rejected as inadmissible under R. 56(1)) EPC, then **that ground** for opposition should be rejected on the same basis as if it were inadmissible under R. 56(1) EPC. The board went on to say that if this course was not followed, the procedure could be easily abused, in that an opponent might allege more than one ground for opposition in his notice of opposition but only support one of these grounds in his notice of opposition; then, at a later stage in the opposition proceedings he might bring forward facts and evidence in support of the other alleged grounds for opposition, causing delay and an increase in costs. In the board's view this should not be allowable - R. 55(c) EPC in conjunction with R. 56(1) EPC clearly required that **every ground** for opposition alleged in the notice of opposition be supported by "facts, evidence and arguments" within the nine-month opposition period and the notice of opposition (at least to the extent that R. 55(c) EPC had not been complied with) be rejected as inadmissible if this had not been done.

In **T 534/98**, the board ruled that the substantiation requirements for an opposition did not include furnishing proof of purportedly common general knowledge. According to established case law, such proof was only required if another party or the EPO challenged the allegation in question. **T 85/93** had ruled that evidence of common general knowledge should be submitted early in opposition proceedings, but this did not have to be done in the actual notice of opposition.

8.5.2 Individual cases

a) Sufficient substantiation

Several decisions considered in greater detail what constitutes sufficient substantiation in the notice of opposition (i.e. in **T 875/96**).

In **T 134/88** the opposition did not deal with all the features of the contested claim, but still satisfied R. 55(c) EPC. The board summed up by saying that an opposition directed against alleged lack of inventive step in the case of a combination invention was generally

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inadmissible if it related only to the assessment of one individual feature - to be admissible, it would have to deal with the invention as a whole, or at least with its **essential** content, so that when the facts on which the opposition was based were indicated, circumstances became recognisable which enabled the patent proprietor and the assessing body to pass conclusive judgment on the asserted grounds for opposition without having to make enquiries of their own.

In **T 185/88** (OJ 1990, 451) the board of appeal ruled that grounds for opposition were in due form if the only document cited in support of the sole assertion of lack of inventive step (in this case a German patent specification), while actually published **after** the date of filing or priority, nevertheless contained a reference to a publication known **before** the date of filing or priority (in this case a German unexamined application or "Offenlegungsschrift").

In **T 533/94** and **T 534/94** the correlation between the individual features of the claimed invention and the relevant passages of the prior art documents in the notice of opposition had been made in the form of tables and it had not been explicitly indicated what particular statements therein were alleged to destroy the novelty of the invention or form a basis for an argument on obviousness. The board found that this did not affect the notice's admissibility. The board observed that a notice of opposition was addressed to the opposition division and the patentee who were not only skilled in the art but also competent in examining novelty and inventive step. Thus, in the board's judgment, a detailed and exhaustive discussion of matters which were implicit to such skilled persons was not needed to understand the opponent's case and, therefore, not an admissibility requirement.

In **T 406/92** the opponent claimed in the notice of opposition that D4 reproduced in writing what had been presented orally at a conference. Reference to this conference was made in a footnote in D4. The opposition division rejected the opposition. In its decision it argued *inter alia* that the talk represented as corresponding to document D4 could not be regarded as belonging to the state of the art in accordance with Art. 54(2) EPC as the footnote left open to what extent the talk corresponded to the later publication. The board decided that how accessible an oral description was to the public depended on the "how" (talk, discussion, radio or television programme, etc.) and the "where" (public conference, factory building, etc.). The notice of opposition had given information in this respect. Whether the said conference was actually public and whether the content of the talk really did correspond to the disclosure of D4 did not affect the **admissibility** of the opposition, but could be significant for assessing the **allowability** of the opposition in terms of substantive law. For these reasons the opposition was admissible (see **T 786/95**).

b) Insufficient substantiation

In **T 448/89** (OJ 1992, 361) the board of appeal followed decision **T 222/85** (OJ 1988, 128) and rejected the opposition as inadmissible. The board held that the requirement under R. 55(c) EPC for facts and evidence in support of the grounds to be indicated was not fulfilled if several different subject-matters were described in a document cited as prejudicial to novelty and it was neither stated nor readily discernible which of them incorporated all the features of the contested claim. In this case the objection of lack of inventive step had not indicated the facts, evidence and arguments. A general reference to all publications cited in

the European search report was not enough if it was neither stated nor readily discernible which document was being presented in support of which argument.

In **T 545/91** the board of appeal followed the case law established in **T 448/89** (OJ 1992, 361) and **T 222/85** (OJ 1988, 128). The opposition was rejected as inadmissible since the submitted document relied upon contained 200 pages and the notice of opposition made no specific reference to any of its passages. Even if the opponent's contention were correct that an expert would immediately find the relevant chapter in the index, the board held that further clarification was necessary as this chapter was 86 pages long and contained subjects not directly related to each other (see **T 204/91**).

In decision **T 550/88** (OJ 1992, 117) the board of appeal considered whether **national prior rights** could as a matter of law constitute "facts or evidence" relevant to the ground of lack of novelty under Art. 54(1) and (3) EPC. If not, such facts and evidence did not support the ground for opposition which had been alleged and therefore did not satisfy the requirement of R. 55(c) EPC. In the board's judgment, on the proper interpretation of Art. 54(3) EPC, national prior rights were not comprised in the state of the art, and only prior European patent applications filed under the EPC could be considered as such under Art. 54(3) EPC. The board of appeal decided in this case that the opposition was inadmissible because the only facts and evidence indicated in the notice of opposition were references to national prior rights.

8.6 Oppositions based on public prior use

8.6.1 Sufficiency of the notice of opposition and further evidence

For the boards to consider claims of public prior use they generally require that such allegations be substantiated, ie that they be presented in such a way that it is readily apparent how the prior use occurred (see **T 6/86**, **T 329/86**, **T 328/87** (OJ 1992, 701), **T 78/90**, **T 988/91**, **T 541/92**). A claim can be said to have been sufficiently substantiated if it can be understood by the EPO and the other parties without their needing to conduct their own investigations (see in general **T 222/85** (OJ 1988, 128) and **T 2/89** (OJ 1991, 51) (see **T 441/91**).

According to the case law of the boards of appeal if an opponent wishes to rely upon prior use as being part of the state of the art for the purpose of Art. 54(2) EPC and as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition must indicate within the opposition period all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use. Public prior use is only adequately substantiated if specific details are given of what was made available to the public, where, when, how and by whom (see decisions **T 328/87** (OJ 1992, 701), **T 93/89** (OJ 1992, 718), **T 1002/92** (OJ 1995, 605) and **T 212/97**).

In **T 538/89** the board stressed that the evidence specified could be submitted after expiry of the period for opposition since R. 55(c) EPC only requires that it be indicated (see also **T 752/95**, **T 249/98**). Nomination of a witness for a subsequent examination of witness was

deemed to constitute indication of evidence (see also **T 28/93, T 988/93**).

8.6.2 Examination by the EPO of its own motion

Under Art. 114 EPC the EPO has a limited obligation to undertake an examination of its own motion with regard to public prior use.

In **T 129/88** (OJ 1993, 598) the board noted that although a board of appeal had an obligation under Art. 114(1) EPC to investigate matters of its own motion, that obligation did not extend as far as investigating an allegation of public prior use, where the party previously making that allegation had withdrawn from proceedings and it was difficult to establish all the relevant facts without that party's co-operation. The reason for this was that the obligation to investigate of its own motion imposed on the EPO by Art. 114(1) EPC was not unlimited in its scope, but was confined by considerations of reasonableness and expediency. Therefore, if the opponents withdrew the opposition, thereby indicating that they were no longer interested in the outcome of the opposition, then, although the EPO might have the power, depending on the country of residence of relevant witnesses, to compel them to give evidence, either before the EPO or before the court of a contracting state, in the interests of procedural economy it should not normally investigate the issue any further. It would be different if a relevant public prior use had already been substantiated by documents of undisputed authenticity, or if the material facts with respect to the alleged public prior use were undisputed (see **T 830/90** (OJ 1994, 713), **T 887/90, T 634/91, T 252/93, T 34/94**).

8.6.3 Substantiation as a requirement for admissibility

In cases of alleged public prior use particular substantiation is required in the notice of opposition. However, a distinction must still be made between examining the admissibility of the opposition and its substantive merit. Decisions **T 194/86, T 328/87** (OJ 1992, 701), **T 93/89** (OJ 1992, 718), **T 232/89, T 538/89, T 754/89, T 78/90, T 600/90, T 877/90, T 441/91, T 602/91, T 988/91, T 541/92** and **T 927/98** held that to be able to determine whether an invention has been made available to the public by prior use, the following circumstances have to be clarified:

- a) when the act of prior use occurred
- b) what was made available to the public through that use
- c) the circumstances of the act of use, ie where, how and by whom the subject-matter was made public through that use

In **T 522/94** (OJ 1998, 42) the board explained that the overall purpose of the admissibility requirement was to allow the patent proprietor and the opposition division to examine the alleged ground for revocation without recourse to independent enquiries.

Establishing that this prior use was indeed public thus has little bearing on admissibility (**T 1022/99**).

9. Legal and factual framework of opposition

9.1 Introduction

In decisions **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board stated that a post-grant opposition procedure could be constructed in different ways - an opponent could, for example, be allowed to confine his action to making a simple request for a general re-examination of the patent on the basis of some general observations. However, the post-grant opposition procedure under the EPC was not constructed this way. As appeared from Art. 99 EPC in conjunction with R. 55c EPC, the notice of opposition had, inter alia, to contain a statement of the extent to which the European patent was opposed and of the grounds on which the opposition was based as well as an indication of the facts, evidence and arguments presented in support of these grounds.

The Enlarged Board thus considered that the core of the matter in the cases before it was whether the statement of the opponent under R. 55c EPC limited the power and obligation of the EPO in its examination of the case or whether such examination could or even should go beyond the opposition as filed and be extended to other parts of the patent and to other grounds for opposition than those covered by such statement.

The Enlarged Board held that R. 55c EPC made sense only when interpreted as having the **double function** of governing (together with other provisions) the **admissibility** of the opposition and of simultaneously establishing **the legal and factual framework** within which the substantive examination of the opposition was in principle to be conducted.

The **legal framework** of an opposition case is defined solely by (i) the extent to which the patent is actually opposed and (ii) the grounds upon which it is opposed, whilst its **factual framework** is determined by the facts, evidence and arguments adduced and set out in the notice of opposition pursuant to R. 55c EPC. It is thus self-evident that neither grounds not actually supported by such facts, evidence and arguments, nor claims not actually opposed (as distinct from being merely formally mentioned in the notice of opposition) can be properly regarded as making up the "legal and factual framework" of the opposition (**T 737/92**).

A distinction has to be made between the two main requirements of R. 55c EPC, ie the indication of the extent to which the European patent is opposed and the grounds for opposition.

9.2 Legal framework of an opposition

9.2.1 Extent to which the European patent is opposed

Art. 99(1) EPC provides, inter alia, that "notice of opposition shall be filed in a written reasoned statement". R. 55c EPC requires the notice of opposition to contain, inter alia, "a statement of the extent to which the European patent is opposed". Opposition proceedings constitute an exception to the general rule under the EPC that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated contracting states. Opposition proceedings are an exceptional

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procedure whereby, during a limited period of time, a centralised action for revocation of a European patent may be brought before and decided by the EPO. With this background in mind, the board in **T 9/87** (OJ 1989, 438) held that an opponent's statement pursuant to R. 55c EPC of "the extent to which the European patent is opposed", in combination with the grounds of opposition, provided a definition of the issues raised by the opposition and, therefore, of the extent of competence of the EPO in relation to the examination of the opposed European patent under Art. 101 EPC.

The case law of the boards of appeal had for some time been divided on the extent to which the opposition division (or, under R. 66(1) EPC, a board of appeal) could examine the patent in accordance with Art. 101 EPC and Art. 102 EPC. Some boards had advocated that examination be restricted to the contested claims (eg **T 9/87**, **T 192/88**). Others had favoured unrestricted examination of the grounds for opposition and the claims in accordance with Art. 114(1) EPC (eg **T 156/84** (OJ 1988, 372), **T 266/87**, **T 197/88** (OJ 1989, 412), **T 493/88** (OJ 1991, 380), **T 392/89**).

In **G 9/91** and **G 10/91** (OJ 1993, 408 and 420) the Enlarged Board pointed out that it was rather unusual for the opposition to be limited to only a certain part of the patent. If, however, this was the case, the examination of an opposition under Art. 101 EPC was limited by the statement in the notice of opposition of the extent to which the patent was opposed. It was further stated that neither the opposition division nor a board of appeal had the obligation or power to examine and decide on the maintenance of a European patent except to the extent to which it was opposed.

The Enlarged Board held that the requirement of R. 55c EPC to specify the extent to which the patent was opposed within the time limit prescribed by Art. 99(1) EPC would be pointless, if later on other parts of the patent could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC. Subject-matter not included by the opponent in his opposition was therefore not subject to any "opposition", nor were there any "proceedings" in the sense of Art. 114 EPC and Art. 115 EPC in existence concerning the non-opposed subject-matter. Consequently, the EPO had no competence to deal with them at all (see **T 443/93**).

However, the subject-matter of claims depending on an independent claim which had fallen in opposition or appeal proceedings could be examined as to patentability even if it had not been explicitly opposed, provided its validity was prima facie in doubt on the basis of information already available.

The possible effect of **G 9/91** (OJ 1993, 408) on the practice of the boards of appeal was discussed in **T 376/90** (OJ 1994, 906). As regards the requirement of R. 56(1) EPC in conjunction with R. 55c EPC that the notice of opposition contain a statement of the extent to which the European patent is opposed, the board proceeded on the accepted principle that statements were to be interpreted in the way that an addressee would understand them taking into account the surrounding circumstances (following **T 1/88**). However, the board added that, although it had been the general practice where patents were opposed without an explicit statement of the extent to which they were opposed to interpret the absence of such a statement as an indication of the opponent's intention to oppose the patent concerned

in its entirety, the continuance of this practice appeared questionable in the light of **G 9/91**. Indeed, in the extreme case where the extent to which a patent was opposed was in serious doubt, this might lead to a rejection of the opposition as inadmissible.

In **T 1019/92** the requirement of R. 55c EPC was found to be met by an explicit request that the patent be revoked in its entirety. The board held that, in these circumstances, if an opponent requested revocation of the patent in its entirety, then the fact that no specific prior art material had been cited against a dependent claim did not exclude that claim from the opposition.

In **T 1066/92**, claims 3, 4 and 5 (out of ten) were challenged by an opposition. Rejection of these claims was requested on the grounds of lack of novelty and lack of inventive step. The opposition division maintained the patent in amended form only on the basis of claims 1 and 2 as granted. The patentee lodged an appeal against the decision. The board noted that neither within the time limit for opposition nor even later in the proceedings before the opposition division had the opponent made any specific request to extend the opposition to granted claims 6 to 10. The opponent expressed his opinion that Art. 114(1) EPC gave the opposition division the power to extend the opposition, especially if non-extension would result in the maintenance of claims which were obviously not patentable. The board stated that, following **G 9/91**, the opposition division had no power to extend the opposition to granted claims 6 to 10 and therefore was not entitled to revoke these claims. Apart from the fact that the board did not consider the subject-matter of granted claims 6 to 10 to be, *prima facie*, not patentable, the opponent's opinion was not supported by **G 9/91**. It further stated that the decision of the Enlarged Board left no room for any extension of the opposition beyond the statement under R. 55c EPC (reason 10 of said decision). The board saw no reason to deviate from the conclusions laid down in **G 9/91** and held that granted claims 6 to 10 should have been maintained by the opposition division. The decision to revoke the non-opposed claims was therefore *ultra vires* and had to be set aside.

In **T 114/95** the respondent/patent proprietor contended that the appeal was not admissible in respect of the granted independent claim 4, because the appellant had not substantiated any reason in accordance with Art. 100 EPC in its notice of opposition against the subject-matter of this claim. The board held that if an opponent requested revocation of the patent in its entirety, it was **sufficient to substantiate** the ground(s) for opposition in respect of **at least one claim** of the patent for the requirements of R. 55c EPC to be met (see **T 926/93** (OJ 1997, 447), **T 1180/97**). R. 55c EPC did not refer to claims but rather required that the notice of opposition should contain a statement of the extent to which the patent was opposed. The board also found that there was no limitation set by the EPC on allowing an opponent whose opposition was considered admissible to support and use grounds, evidence and arguments for revocation of the patent that were submitted by other opponent(s). Therefore, in the case at issue, the appellant was allowed to rely on submissions for lack of inventive step brought forward against granted claim 4 by the other opponent, who did not appeal.

9.2.2 Grounds on which the opposition is based

In **G 10/91** (OJ 1993, 420) the Enlarged Board of Appeal turned to the second main

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requirement of the statement under R. 55c EPC, ie the indication of the grounds on which the opposition is based. Here the question referred was whether the opposition division, in the examination of the opposition, was obliged to consider all the grounds for opposition referred to in Art. 100 EPC or whether the examination should be restricted to the grounds referred to by the opponent in his notice of opposition.

The Enlarged Board noted that the problems here differed from those related to the first main requirement in that in the case of the extent to which the patent was opposed, it was a question of the formal competence of an opposition division or a board of appeal to deal with a non-opposed part, whilst the problems connected with the grounds for opposition were more concerned with the procedural principles to be applied where the European patent or part of it had been correctly opposed. It stated that Art. 114(1) EPC was **no** legal basis for an **obligatory** review of grounds for opposition not covered by the statement pursuant to R. 55c EPC. The board then went on to consider whether Art. 114(1) EPC actually **empowered** the opposition division or board of appeal to investigate such grounds at all. As far as the opposition division was concerned, the Enlarged Board held that an **opposition division** could, in application of Art. 114(1) EPC, **of its own motion** raise a ground for opposition not covered by the statement pursuant to R. 55c EPC. However, this should only take place where, prima facie, there were clear reasons to believe that such grounds were relevant and would in whole or in part prejudice the maintenance of the European patent.

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

In **T 736/95** (OJ 2001, 191) the ground referred to by the appellant under Art. 100(c) EPC was not raised in the notice of opposition. The question arose whether the fresh ground could be examined at all under Art. 114(1) EPC. The board noted that according to Enlarged Board case law (especially **G 10/91** and **G 1/95**) and the Guidelines for Examination, the main aim of first-instance proceedings was to avoid invalid patents. The Enlarged Board had seen no reason to change the practice of the first instance, which should therefore at least examine whether a fresh ground was relevant. So before declaring it inadmissible the opposition division should have examined under Art. 114(1) EPC whether the ground raised under Art. 100(c) EPC could prejudice maintenance of the patent.

In **T 128/98** the board held that the mere reference to Art. 100(c) EPC in the decision under appeal did not imply that the corresponding ground for opposition had been introduced into the proceedings, if it was not substantively dealt with in the decision under appeal. The section of the decision under attack referred formally to Art. 100(c) EPC, and substantively concerned whether an amendment of the granted claim complied with Art. 123(2) EPC.

In appeal proceedings fresh grounds for opposition may be considered only with the approval of the patentee (see p. 514).

In **T 986/93** (OJ 1996, 215) the board made it clear, firstly, that if an opposition division chose to disregard belated submissions concerning a new ground of opposition, this could not detract from the fact that the ground had been relied upon, ie introduced, during the opposition proceedings. Secondly, the procedural decision of an opposition division to disregard submissions formed an essential element of its decision-making process and as such was one of the issues subject to review if the final decision of the opposition division was challenged on its merits. The board stated that although it was reluctant to interfere with a discretionary decision of an opposition division pursuant to Art. 114(2) EPC, it would do so where necessary and appropriate (see **T 122/84**, OJ 1987, 177). The board held that the boards of appeal were not barred from considering a belatedly submitted ground for opposition which had been disregarded by the opposition division pursuant to Art. 114(2) EPC if they were of the opinion that the opposition division had exercised its discretion in this respect wrongly.

In **T 1066/92** an objection of insufficiency under Art. 100(b) EPC was raised by the opponent against granted claims 3 to 5 of the auxiliary request then on file only after the summons for oral proceedings before the board. The same objection applied equally to claims 3 and 4 of the patent in suit. The respondent argued that this objection was raised late because the objection became apparent only after the explanation given by the appellant in the course of the opposition appeal proceedings. The board held that, following the principles laid down in **G 9/91** and **G 10/91** (reasons, 18), it could not consider such a new ground without the consent of the appellant. In the absence of such consent, and further taking into account that the objection under Art. 100(b) EPC appeared prima facie highly relevant and should be decided upon before novelty and inventive step could be considered, the board exercised its power under Art. 111(1) EPC to remit the case to the opposition division, which under the principles laid down in **G 9/91** (reasons, 16), had the power to raise of its own motion a ground for opposition not covered by the statement pursuant to R. 55c EPC.

In **T 737/92** the board found that it was the judicial character of the appeals that limited the investigative power of the boards under Art. 114(1) EPC read in conjunction with the proviso "mutatis mutandis" in R. 66(1) EPC. Neither grounds not actually supported by facts, evidence and arguments, nor claims not actually opposed could be properly regarded as making up the "legal and factual framework" of the opposition. In the board's judgment, to permit the shifting of that framework in an appeal, in mistaken reliance on the wording of Art. 114(1) EPC, read in isolation from the rest of the EPC, and in particular R. 66(1) EPC, would clearly go against the legal principles contained and expressed in the EPC.

9.2.3 Legal concept of "grounds for opposition" under Article 100 EPC

A referral to the Enlarged Board of Appeal in **T 937/91** (OJ 1996, 25) asked whether in a case where a patent had been opposed on the basis of Art. 100(a) EPC, but the opposition had only been substantiated on the grounds of lack of novelty and inventive step pursuant to Art. 54 EPC and Art. 56 EPC, a board of appeal could of its own motion introduce into the proceedings the ground that the subject-matter of the claims did not meet the conditions of Art. 52(2) EPC.

A further question was referred in **T 514/92** (OJ 1996, 270) as follows: "In the case where a

patent has been opposed under Art. 100(a) EPC, on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal exclude the new allegation because it introduces a new ground of opposition?".

In **G 1/95** and **G 7/95** (OJ 1996, 615 and 626) (consolidated proceedings), before deciding on the questions referred to it, the Enlarged Board of Appeal had to decide on the meaning of the legal concept "grounds for opposition" under Art. 100 EPC. The Enlarged Board noted that the function of Art. 100 EPC was to provide, within the framework of the EPC, a limited number of legal bases, ie a limited number of objections on which an opposition could be based. The Enlarged Board observed that, on the one hand, all "grounds for opposition" mentioned in Art. 100 EPC had their counterparts in other articles of the EPC. On the other hand, whereas the grounds for opposition in paragraphs (b) and (c) of Art. 100 EPC each related to a single legal basis on which an opposition could be based, ie insufficient disclosure and unallowable amendment before grant respectively, the same did not apply to Art. 100(a) EPC. Art. 100(a) EPC referred not only to the general definition of patentable inventions according to Art. 52(1) EPC, and to the exceptions to patentability according to Art. 53 EPC, but also to a number of definitions under Art. 52(2) to (4) EPC and Art. 54 EPC to Art. 57 EPC ("invention", "novelty", "inventive step" and "industrial application") which, in conjunction with Art. 52(1) EPC, defined specific requirements and thus formed separate grounds for opposition. The totality of Art. 52 EPC to Art. 57 EPC in conjunction with Art. 100(a) EPC did not therefore constitute a single objection to the maintenance of the patent, but a collection of different objections (ie legal bases). For an opposition to be admissible within the framework of Art. 100(a) EPC, it followed that it had therefore to be based on at least one of the legal bases for an opposition, ie on at least one of the grounds for opposition set out in Art. 52 EPC to Art. 57 EPC.

9.2.4 Meaning of a "fresh ground for opposition"

In considering the proper application of Art. 114(1) EPC during opposition appeal proceedings, the Enlarged Board of Appeal also decided in **G 1/95** and **G 7/95** on the meaning of the legal concept "fresh ground for opposition" as used in paragraph 18 of **G 10/91** (OJ 1993, 420). It found that this term must be interpreted as having been intended to refer to a ground for opposition which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the opposition division in accordance with the principles set out in paragraph 16 of **G 10/91**. Having clarified the meaning of these two terms, the Enlarged Board of Appeal went on to decide on the questions referred to it.

In **G 1/95**, the Enlarged Board decided that, in a case where a patent had been opposed on the grounds set out in Art. 100(a) EPC, but the opposition had only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based on Art. 52(1) and (2) EPC was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee.

In **G 7/95**, the Enlarged Board decided that, in a case where a patent had been opposed under Art. 100(a) EPC on the ground that the claims lacked an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty vis-à-vis the said documents based on Art. 52(1) EPC and Art. 54 EPC was a fresh ground for opposition and accordingly could not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lacked novelty in view of the closest prior art document could be considered in the context of deciding on the ground of lack of inventive step. The Enlarged Board did not decide whether a board of appeal must - in case of lack of consent by the patentee - exclude the new allegation that the claims lacked novelty in view of a document introduced only during the appeal proceedings.

In **T 274/95** (OJ 1997, 99) the board held that, if a ground for opposition was substantiated in the notice of opposition but was subsequently not maintained during the opposition division proceedings (in the case in question, a statement to that effect had been made by the opponent during oral proceedings), the opposition division was under no obligation to consider this ground further or to deal with it in its decision, unless the ground was sufficiently relevant to be likely to prejudice maintenance of the patent (see **G 10/91**). The board further found that a ground for opposition which was substantiated in the notice of opposition but which was subsequently not maintained before the opposition division, if sought to be re-introduced during appeal proceedings was not a "fresh ground of opposition" within the meaning of opinion **G 10/91**, and could consequently be re-introduced into the appeal proceedings without the agreement of the patent proprietor, in the exercise of the board of appeal's discretion.

In **T 928/93** the opponent had alleged that the patented subject-matter lacked novelty. This objection failed, because the subject-matter known in the art and the claimed subject-matter did not have the same features, although they showed the same effect. According to consistent case law, the disclosure of prior art does not extend to the equivalents of the subject-matter described therein. Objections based on lack of an inventive step were raised for the first time by the appellant/opponent in his reply to the summons to oral proceedings. Having regard to the decisions of the Enlarged Board in **G 10/91** (OJ 1993, 420) and **G 7/95** (OJ 1996, 626), and since the respondent had also failed to give his consent, such a new ground for opposition was not to be taken into consideration.

9.3 Factual framework of an opposition

9.3.1 Late-filed new facts, evidence and arguments

In **T 1002/92** (OJ 1995, 605) the board stated that when considering the admissibility of a **further ground** for opposition not covered by the notice of opposition after expiry of the opposition period, both before an opposition division and before a board of appeal, the Enlarged Board was necessarily implicitly considering the admissibility of such a fresh ground in combination with at least an indication of the **fresh** "facts, evidence and argument" intended to support it. The mere stating of a fresh ground without any indication of the fresh facts, evidence and argument supporting it would obviously be inadmissible, either within or after expiry of the opposition period. It would be illogical to have one criterion for the admissibility of late-filed **new** facts, evidence and argument in combination with a fresh

ground, and a different criterion for judging the admissibility of late-filed new facts, evidence and arguments in support of a ground for opposition already covered by the opposition statement. Hence, in the board's view, it followed that the principles set out by the Enlarged Board as underlying the admissibility of fresh grounds for opposition (element ii of the notice of opposition under R. 55(c) EPC), were also generally applicable to the admissibility of late-filed new "facts, evidence and arguments" intended to support grounds for opposition already covered by the opposition statement (see p. 325).

In **T 623/93** the respondent/patentee had submitted that the substantiation of opposition dealt solely with the novelty of claim 1, with the result that the opposition was not admissible to the extent that it was directed at claims 2 to 12 and the existence of inventive step in claim 1. The board, however, found that the respondent had filed amended claims during the opposition proceedings and it was only this that had made it necessary for the appellant/opponent to argue against the existence of inventive step in the new claims. Under these circumstances there could be no objection to the opponent's submitting new citations and new arguments against the new claims. The examination by the opposition division of a new submission justified in this way was in keeping with Enlarged Board of Appeal decision **G 9/91** (reasons, 19).

9.3.2 Substantiation of new ground for opposition

In **T 433/93** the board held that, in all normal cases, if an opposition division decided to introduce a new ground for opposition into the proceedings in addition to the ground(s) for opposition which the opponent had raised and substantiated in the notice of opposition, this should be done in writing as early as possible in the proceedings. The written notification to the patent proprietor from the opposition division informing the proprietor that a new ground for opposition would be introduced into the proceedings should at the same time ensure that the proprietor was informed not only of the new ground for opposition (ie the new legal basis for the opposition), but also of the legal and factual reasons (ie its substantiation) that would in effect substantiate the new ground which would lead to a finding of invalidity and revocation, so that the proprietor was fully informed of the case which he had to meet, and had a proper opportunity to present comments in reply. If, in a very exceptional case, an opposition division decided for the first time during oral proceedings that a new ground of opposition should be introduced into the proceedings, it would in principle be appropriate, even during oral proceedings, for the opposition division to notify the proprietor in writing both of the introduction of the new ground and of the legal and factual reasons which substantiated such a new ground. In this way, possible misunderstandings would be avoided, and the notification would be part of the written file record of the case.

9.3.3 Obtaining evidence

In **T 154/95**, opponent 1's opposition was based on a prior use adduced after the opposition period had expired. The opposition division rejected this opposition as inadmissible. Opponent 2, whose opposition was considered admissible, cited on its own behalf the prior use alleged by Opponent 1.

The board ruled that in opposition or appeal proceedings it was basically irrelevant how an

opponent came across documents or other evidence made available to the public. So there was nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition was inadmissible.

9.3.4 Taking up objections made by other parties

T 270/94 concerned a situation similar to that just described in **T 154/95**. The opposition division did not give opponent 1, whose opposition was based solely on lack of novelty, the opportunity to comment on the inventive-step objection raised as the sole ground of opposition by opponent 2. The division argued that for Opponent 1 to introduce objections on inventive step - ie a new ground of opposition - for the first time in the oral proceedings would have been an abuse of the proceedings and a breach of the principles of good faith.

However, it is clear from Art. 99(4) EPC, which provides that "Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent", that several admissible oppositions do not initiate a corresponding number of parallel opposition proceedings. Therefore, to prevent Opponent 1 from commenting on an opposition ground duly submitted by opponent 2 and communicated to all the parties in accordance with R. 57(2) EPC was in breach of Art. 113(1) EPC. Furthermore, the board observed that Art. 114(2) EPC, relied on by the opposition division, was not applicable; it indicated only that the EPO could disregard late-filed facts or evidence, whereas the present case involved arguments submitted by one party to the proceedings regarding a ground of opposition submitted in due time by another party.

10. Amendments in opposition proceedings

10.1 Admissibility of amendments

10.1.1 General remarks

For the opposition procedure, the Implementing Regulations previously lacked a clear corollary to R. 86 EPC (amendment of the European patent application) governing the proprietor's right to amend his patent. R. 57a EPC, which entered into force on 1.6.1995, provides that, without prejudice to R. 87 EPC, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Art. 100 EPC, even if the respective ground has not been invoked by the opponent. The amendment applies to all proceedings pending on that date (see OJ 1995, 409).

Before R. 57a EPC entered into force, boards of appeal had allowed amendments only where occasioned by a ground for opposition actually relied upon by the opponent (see Case Law of the Boards of Appeal of the European Patent Office 1987-1992, page 140). R. 57a EPC extended the possibilities of amending the patent. Under R. 57a EPC, any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100 EPC. That is to say, amendments can be allowed only if they are required in order to meet a ground for opposition. It is not necessary, however, for the ground for opposition in question actually to be invoked by the opponent. For example, in opposition proceedings admissibly brought on the grounds of non-patentability, the patent proprietor can also submit

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amendments to remove added subject-matter (Guidelines D-IV, 5.3). Likewise, amendments in opposition proceedings which were proposed only in view of the existence of national prior rights were not allowable (**T 550/88**, OJ 1992, 117). Under R. 57a EPC, amendments occasioned by national prior rights - which are not included in the grounds for opposition specified in Art. 100 EPC - are also admissible during opposition proceedings. The reference to R. 87 EPC, which as a general provision of the EPC also applies to opposition proceedings, makes this absolutely clear.

R. 57a EPC created a *lex specialis* for amendments during opposition proceedings. It addresses the purely substantive aspects of the proprietor's entitlement to amend his patent, and does not specify the point in time up to which amendment is allowed: here existing practice remains unchanged. Its restriction of the right to amend is in line with the object and purpose of opposition proceedings (see Notice from the EPO dated 1.6.1995 concerning amendment of the EPC, the Implementing Regulations and the Rules relating to Fees, OJ 1995, 409).

10.1.2 Lack of clarity - clarification of ambiguities in the granted patent

The introduction of R. 57a EPC did not affect other legal aspects set out by the boards of appeal in previous decisions.

In **T 127/85** (OJ 1989, 271) the board held that it would be an abuse of opposition proceedings if the patent proprietor were allowed merely to tidy up and improve his disclosure by amendments not specifically necessitated by the grounds advanced for the opposition, even if those amendments were to comply with Art. 123 EPC. This applied equally to amendments during opposition proceedings intended merely to clarify ambiguities in the claims or description. The board went on to state that objections to clarity of claims or any consequent requests for amendment were only relevant to opposition proceedings insofar as they could influence the decisions on issues under Art. 100 EPC or arose in relation to matter to be amended in consequence of such issues (see **T 406/86** (OJ 1989, 302), **T 24/88**, **T 324/89**, **T 50/90**).

In **T 113/86** the board of appeal followed this principle, ruling against the admissibility of amendments proposed by the patent proprietor which were not necessary to take account of the grounds for opposition invoked by the opponent under Art. 100 EPC or by the board under Art. 114 EPC, if there were the slightest possibility of a different interpretation being given to the patent specification before and after the amendments. The protection conferred by the patent would actually be extended if, as a result of amendments to clarify the granted claims, the claims could be more widely construed than a court would have construed them by the application of Art. 69 EPC. However, the board was of the opinion that the removal of an inconsistency between a claim and the description should be allowed if the inconsistency arose from an error, provided that the error was so obvious to a skilled person in the light of the patent specification as a whole that an interested third party could have anticipated the extent of protection conferred by the amended claim. In these circumstances the request for the correction of an error did not represent an abuse of opposition proceedings. Moreover, the removal of the discrepancy was in the interest of legal certainty.

In **T 565/89** the board held that in opposition appeal proceedings the clarity of claims was irrelevant under Art. 102(1) EPC in conjunction with R. 66(1) EPC, since this was not a ground for opposition under Art. 100 EPC); it therefore refused to entertain a clarity objection to the claim in question. However, deciding on the claim's patentability meant looking closely at its content and - under Art. 69(1) EPC - using the description and drawings to interpret it. This principle was followed *inter alia* by **T 89/89** and **T 62/88**. In **T 16/87** (OJ 1992, 212) - where the patentee and the opponent disagreed on the interpretation of a term in a claim - the board also made it clear that under Art. 69(1) EPC stipulating that the description and any drawings were to be used to interpret the claims also applied to opposition proceedings when the meaning of a claim had to be objectively determined to assess the novelty and inventiveness of its subject-matter.

However, where a deficiency results from a discrepancy between the description and the claim, lack of clarity in the invention's disclosure can be objected to because that requirement comes under Art. 83 EPC, not Art. 84 EPC, and may therefore be taken into consideration in opposition proceedings (**T 175/86**).

It is well-established that an opponent may not oppose a patent on the grounds that the claims or description are unclear. In **T 23/86** (OJ 1987, 316), for example, the opponent alleged that an (unamended) claim was unclear. However, the board of appeal held that Art. 84 EPC was an EPC requirement concerning patent applications which, although it had to be taken into account in opposition proceedings whenever the patent proprietor made any amendments, was not itself a ground for opposition under Art. 100 EPC. The board explained that opposition proceedings were not a continuation of the examination proceedings involving third parties, but, like revocation proceedings, served as a substantive legal test of whether the patent still stood in the light of facts emerging after it had been granted (**T 792/95**).

10.1.3 Time of filing amendments

In **T 132/92**, after a first amendment to the claims during the oral proceedings, the Chairman stated that the opposition division would allow only one more amendment to the set of claims. An appeal against the decision of the opposition division was lodged by the appellant. The board noted that from R. 57a EPC it was apparent that in opposition proceedings the patentee had a right to amend the claims if the amendments were occasioned by grounds specified in Art. 100 EPC. The EPC did not specifically regulate the frequency and the ultimate filing time of amendments in opposition proceedings. R. 86(3) EPC, to which reference was made in the contested decision, only related to amendments of the European patent application in proceedings before the examining division. The case law of the boards of appeal had, however, derived in particular from R. 57(1) EPC the principle that the proprietor had no right to have amendments admitted in any stage of opposition proceedings. At the discretion of the opposition division or the board of appeal, amendments could be refused if they were neither appropriate nor necessary (**T 406/86**, OJ 1989, 302). In particular, late amendments could be refused if they were not a fair attempt to overcome an objection made. The board found that, in general, the question whether **an amendment was appropriate** could only be answered on the basis of its content, ie after it had actually been submitted. To refuse any further amendment would only be appropriate if it was evident after various unsuccessful amendments that the proprietor was not seriously trying to overcome

the objections but was only delaying the proceedings.

Claims filed late (ie just before or at the hearing) are subject to the same principles in opposition proceedings as in appeal proceedings. In **T 648/96** the amendments requested in oral proceedings before the opposition division were simply a response to arguments put forward. The board said EPO deciding instances have discretion to consider documents (including claims) filed in particular during oral proceedings, if they respond to the instance's or the opponent's objections, or are clearly grantable. Undesirable delays in the proceedings should however be avoided.

In **T 382/97** the appellant (patentee) came up with three auxiliary requests only at the beginning of oral proceedings, ie almost at the last moment. The appellant tried to justify disregarding the time limit set by the opposition division under R. 71a EPC by citing R. 57a EPC which, it asserted, "was created as a *lex specialis* for amendments during opposition proceedings" and did not "specify the point in time up to which the amendment is allowed".

The board agreed that R. 57a EPC established explicitly the patent owner's right to amend its patent according to the criteria laid down in that rule. However, the board could not accept the appellant's argument that the absence of a time limit in R. 57a EPC entitled a patent proprietor to submit amendments of its patent at any time, ie also during oral proceedings, without good reason. In the board's judgment, R. 57a and 71a EPC together governed the procedural preconditions for amendment of a patent by its proprietor before the opposition division, which amendments of course had to comply with Art. 123(2) and (3) EPC: R. 57a EPC created the legal basis for amendment, and R. 71a EPC governed the deadline for doing so. The board emphasised in this connection that amendments not complying with a time limit set under R. 71a EPC might nevertheless be admissible if there were good reasons for their late submission. Finally, the board noted that the patent owner's right to amend its patent under R. 57a EPC did not equate to an automatic right to file additional auxiliary requests. Any amendment had to be carried out in the most expedient manner, which had to be established by the opposition division, taking into due account the interests of all parties.

In **T 463/95** the opposition division refused the main request to maintain the European patent in amended form, for the reason that claim 29 had been submitted only one week prior to the oral proceedings and was not clearly allowable because the subject-matter of claim 29 did not involve an inventive step vis-à-vis the prior art. The board noted that the opposition division exercised a discretionary power in relation to requests for amendment in oppositions before it, and stated that consideration of a new or amended independent claim could reasonably be expected when such a new or amended claim resulted from a combination of features taken from granted claims which had been specifically opposed, since the opponents should already be familiar with the subject-matter. The board further noted that the appellant (patent proprietor) had indicated that he had become aware of a possible infringement only at a late stage and that he had to defend his legal interest within the scope of granted claims. The board concluded that under these circumstances the opposition division should have asked the parties to comment on claim 29. Only if there was a substantial difference in the subject-matter of claim 29 could it have been rejected as inadmissible by reason of not being clearly allowable. In the present case, however, the

patentee was acting within the normal framework to salvage as much as possible after granted claim 1 had fallen.

10.1.4 Filing additional dependent and independent claims

The principles for dealing with amendments to opposed patents developed by the boards of appeal also apply to the filing of additional dependent or independent claims in opposition or subsequent appeal proceedings.

As already set out in **T 829/93** and **T 317/90**, the addition of a dependent claim leaves unimpaired the scope of the independent claim to which such dependent claim refers. It neither limits nor amends the subject-matter claimed in the corresponding independent claim. The addition of a dependent claim is therefore no response at all to an objection against the patentability of the subject-matter claimed. The fact that dependent claims may constitute valuable fall-back positions should the corresponding independent claim subsequently be found unallowable does not justify their addition in opposition proceedings to a remaining broader independent claim.

In a number of recent decisions it was pointed out that the legal situation with regard to the addition of dependent or independent claims in opposition proceedings had not been changed by the introduction of new R. 57a EPC. For in the opposition procedure an examination of the validity of a patent had to be made on the basis of the objections raised under Art. 100 EPC. Opposition proceedings were not an opportunity for the patentee to propose amendments to the text of a patent for purposes not clearly related to meeting a ground for opposition raised under Art. 100 EPC. In particular, the addition of **new dependent claims** having **no counterpart** in the granted patent was neither appropriate nor necessary to meet a ground for opposition and was therefore not admissible (**T 794/94**, **T 674/96**).

In **T 24/96** (see Summary of facts and submissions, V.) the board pointed out that the addition of a new dependent claim 7 of the main request was an unnecessary, inappropriate and inadmissible amendment, even under R. 57a EPC, since the new dependent claim could not have any influence on the characteristics of the invention as set out in independent claim 1 on which new claim 7 depended.

The principles of this case law also applied to the filing of additional **independent** claims in opposition proceedings, as some recently issued decisions demonstrated.

In **T 610/95** the appellant failed to provide a reasoned argument to show that the filing of new independent claim 5 was indeed necessitated by a ground for opposition. The board referred to **G 1/84** (OJ 1985, 299), which made it clear that the opposition procedure was not designed to be, and was not to be misused as, an extension of the examination procedure. It would, in the board's opinion, contravene the principles set out in **G 1/84** if it was considered admissible to amend the text of a granted patent during opposition proceedings, while maintaining the sole independent claim under opposition, by incorporating an additional new independent claim which as such had no counterpart in the granted patent and, accordingly, was neither the subject of substantive examination in the examination procedure

nor open to opposition owing to its non-existence in the granted patent.

In **T 223/97** the board confirmed that the addition during opposition proceedings of one or more independent claims while maintaining the main claim in question could not be considered to be a restriction to the main claim in order to meet the ground for opposition raised against it. Thus the mere addition of new claims to the claims as granted was inadmissible because such amendments could not be said to meet a ground for opposition. These new claims were thus not admissible, even if they otherwise satisfied the dual conditions of Art. 123(2) and (3) EPC. If claim 1 covered two specific embodiments, the patentee could, in order to deal with the lack of patentability, restrict himself to these two embodiments and, consequently, file two independent claims, each protecting one of the two embodiments. If, as was the case in the auxiliary request, the main claim in question was cancelled, the two new independent claims 1 and 2 replacing it would comprise a restriction to the main claim, since only the two particular embodiments would still be protected. They were therefore admissible, as they met the dual conditions of Art. 123(2) and (3) EPC. The replacement of one independent claim as granted by several, eg two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted was admissible if the replacement was occasioned by grounds for opposition specified in Art. 100 EPC.

10.2 Examination of amendments

Amendments made during opposition proceedings to the claims or other parts of a patent must be fully scrutinised in accordance with Art. 102(3) EPC for compliance with the requirements of the EPC (**G 10/91**, OJ 1993, 420).

Where amendments are requested by a patentee in the course of opposition proceedings, Art. 102(3) EPC confers jurisdiction upon the opposition division as well as the boards of appeal, and thus the power to consider the whole of the EPC (**T 472/88**). This jurisdiction is thus wider than that conferred by Art. 102(1) and (2) EPC, which expressly limits jurisdiction to the grounds of opposition mentioned in Art. 100 EPC. When substantive amendments are made to a patent, both instances have the power to deal with grounds and issues arising from those amendments even if they were not (and could not be) specifically raised by an opponent pursuant to R. 55c EPC (**T 227/88** (OJ 1990, 292), **T 922/94**).

In **T 301/87** (OJ 1990, 335) the board held that when amendments were made to a patent during an opposition, Art. 102(3) EPC required them to be examined to ascertain if the EPC, including Art. 84 EPC, was contravened as a result. However, Art. 102(3) EPC did not allow objections to be based upon Art. 84 EPC if they did not arise out of the amendments made. It would be somewhat absurd if making a minor amendment were to enable objections outside Art. 100 EPC to be raised which had no connection with the amendment itself.

The board concluded also in **T 367/96** that Art. 102(3) EPC does not allow objections to be based upon Art. 84 EPC if such objections do not arise out of the amendments. Thus, Art. 102(3) EPC does not allow objections of lack of support by the description of an amended main claim if said claim results in substance from the combination of claims of the patent as granted in accordance with the cross-references therein and thus concerns a specific object

which as such was already claimed in the patent as granted.

In **T 648/96** the board found that the opposition division's failure, in the contested decision, to address the substance of the opponent's "lack of clarity" objections to the amended documents was a substantial procedural violation; under Art. 102(3) EPC, it should have examined of its own motion whether the amendments complied with Art. 84 EPC and Art. 123(2) and (3) EPC.

In **T 740/94** the failure of the opposition division to deal with an objection against an amended claim in its decision to maintain the patent in amended form was found to constitute a substantial procedural violation.

10.3 Additional search

In **T 503/96** the board considered the criteria for the need for an additional search in relation to restrictive amendments. It referred to the Guidelines B-III, 3.6, which state, "In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended...". The board stated that whether or not to commission an additional search in a particular case was a matter for the administrative discretion of the opposition division, but if an inappropriate criterion was invoked when exercising this discretion, doubt would inevitably be raised as to whether the discretion was reasonably exercised.

Since in case of amendment of the claims in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (**G 10/91**, OJ 1993, 420, reason 19), it was not inappropriate for an opponent to make observations on a possible need for an additional search to enable this full examination to be carried out (Guidelines D-VI, 5). The judgment on whether an additional search was necessary and the obligation to perform this search if it was judged to be necessary were administrative matters for the EPO.

11. Decision of opposition division

11.1 Revocation by decision

In **T 26/88** (OJ 1991, 30) the board of appeal had to rule on an appeal against a formalities officer's decision to revoke a patent under Art. 102(4) EPC because the printing fee had been paid late. The board considered whether the revocation should have been issued in the form of a decision at all, concluding that the loss of rights under Art. 102(4) EPC had occurred by operation of law ("automatically") and that the formalities officer should have issued a communication concerning loss of rights in accordance with R. 69(1) EPC. In revocation under Art. 102(4) and (5) EPC it saw an analogous situation to the grant procedure. The case law of other boards revoking patents by decision had not considered the alternative of automatic loss of rights.

The President of the EPO took the matter up under Art. 112(1)(b) EPC. In **G 1/90** (OJ 1991,

275) the Enlarged Board of Appeal stated that the revocation of a patent under Art. 102(4) and (5) EPC **required a decision**. It drew a comparison between the various procedural stages (grant, opposition and revocation, in connection with the future Community patent) and concluded that the wording of the regulations clearly indicated in each case whether a decision or a communication had to be issued concerning the loss of rights under R. 69(1) EPC. The Enlarged Board also considered the issue of legal certainty and, in the light of the "travaux préparatoires" relating to R. 69 EPC, discussed the question of when a loss of rights noted in accordance with that provision became non-appealable. It found that the procedure of pronouncing revocation by decision led neither to legal uncertainty nor to misunderstandings. Whereas, in the grant procedure, there was a clear basis for deemed withdrawal of an application, no such possibility existed with oppositions because the patent proprietor was **unable to abandon** his granted patent by making a declaration to the EPO. The Enlarged Board confirmed that it was up to the legislator to decide when to issue a communication pursuant to R. 69(1) EPC, which is followed on request by a decision (R. 69(2) EPC), and when a decision was not preceded by such a communication. If the EPC had laid down different provisions for grant and opposition, that did not constitute an inherent contradiction.

11.2 Interlocutory decisions

11.2.1 General remarks

In **T 376/90** (OJ 1994, 906) the first question to be decided was whether the opposition was admissible, and whether it was correct for the preliminary decision on this point to be made appealable only together with the final decision. As to the latter point, the opposition division decided on the admissibility in an interlocutory decision within the meaning of Art. 106(3) EPC, ie a decision which did not terminate the proceedings as regards one of the parties. In the board's view, according to the clear language of that provision, such an interlocutory decision could only be appealed together with the final decision, unless the decision allowed separate appeal. Whether to allow a separate appeal was within the discretion of the opposition division. The board held that this discretion under Art. 106(3) EPC was properly exercised by the opposition division with a view to enabling a decision on the substantive issues to be reached as soon as possible.

11.2.2 Maintenance of the European patent as amended

The long-established practice of the EPO of delivering interlocutory decisions subject to appeal when a patent is maintained as amended was described in detail by the Enlarged Board of Appeal in **G 1/88** (OJ 1989, 189).

According to Art. 102(1) to (3) EPC a decision on an opposition to a European patent can involve revocation of the patent, rejection of the opposition or maintenance of the patent as amended, the latter requiring the publication of a new European patent specification. Under Art. 102(3)(b) EPC a prerequisite for maintenance of the patent as amended is that the printing fee be paid.

With these regulations in mind, the EPO very early on adopted the device of an **interlocutory**

decision, for which there is no express provision, in order to establish in the first place the text of the amended specification. Only after this interlocutory decision has come into force are the fee for printing and a translation of the claims in the other official languages requested pursuant to R. 58(5) EPC. Once these requirements have been fulfilled what is then a non-appealable final decision on maintenance of the patent as amended is given and the new patent specification is published.

A decision to maintain the European patent - even an interlocutory decision - can of course only be given if there is a text "submitted or agreed" by the patent proprietor pursuant to Art. 113(2) EPC. In that connection Art. 102(3)(a) EPC states that it must be established, "in accordance with the provisions of the Implementing Regulations", that the patent proprietor approves the text. It has accordingly been standard practice for the EPO's opposition divisions always to proceed in accordance with the relevant R. 58(4) EPC, even where the text has already been "submitted or agreed" by the patent proprietor during the proceedings and rejected by the opponent.

In **T 89/90** (OJ 1992, 456) the board of appeal **examined the extent to which this practice is justified in opposition proceedings**, the opponents having lodged objections to an interlocutory decision which maintained the patent as amended. The board observed that the EPC contained no general rules as to when an interlocutory decision could or should be delivered. The relevant department therefore had to use its discretion in judging whether an interlocutory decision was appropriate in an individual case or whether the matter could only be settled in a decision terminating proceedings. This involved weighing up various considerations such as whether an interlocutory decision would accelerate or simplify the proceedings as a whole (clarifying a disputed question of priority, for example, could be of key importance for the form and length of the subsequent proceedings) and clearly also included the issue of costs. In the board's view, it was clear that the practice adopted early on by the EPO of delivering appealable interlocutory decisions where a patent was maintained as amended was based on the weighing up of such cost aspects. The board concluded that the EPO's established practice of delivering appealable interlocutory decisions under Art. 106(3) EPC to maintain a patent as amended was both formally and substantively acceptable.

Before **G 1/88** was decided a board held in **T 390/86** (OJ 1989, 30) that Art. 102(3) EPC and R. 58(4) EPC did not preclude that an opposition division could, in the course of opposition proceedings, make a (final) interlocutory decision in respect of a substantive issue raised by the opposition, before the sending of any R. 58(4) EPC communication. What was precluded by R. 58(4) EPC was that the opposition division should "decide on the maintenance of the European patent" in an amended form without first informing the parties of the amended text in which it was intended to maintain the patent and inviting their observations. However, neither Art. 102(3) EPC nor R. 58(4) EPC precluded an opposition division from giving **decisions on substantive issues** in the opposition before sending a communication under R. 58(4) EPC, and before "deciding to maintain the patent in amended form". For example, an opposition division could during the course of an opposition make a (final) interlocutory decision (either orally or in writing) that a particular proposed amendment contravened Art. 123 EPC. Similarly, in the board's view, an opposition division could make a (final) interlocutory decision during the course of an opposition that the main claim, for example, of

the opposed patent could not be maintained. Such a **substantive interlocutory decision** was not a decision actually to maintain the patent in amended form, but was preliminary to such a decision. The making of such substantive interlocutory decisions during the course of opposition proceedings was desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Art. 106(3) EPC, to allow a party to appeal such an interlocutory decision before the opposition proceedings were terminated. It was further held that in a case where a final substantive decision had been given, an opposition division had no power thereafter to continue examination of the opposition in relation to the issues which were the subject of that decision, either under R. 58(5) EPC or at all. Further submissions from the parties relating to such issues were inadmissible.

12. Apportionment of costs

12.1 Introduction

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

12.2 Taking of evidence

In **T 117/86** (OJ 1989, 401) the board said the phrase "taking of evidence" used in Art. 104(1) referred to the receiving of evidence by an opposition division or a board of appeal; the wording of Art. 117(1) made it clear that the phrase "taking of evidence" covered the giving or obtaining of evidence generally in proceedings before departments of the EPO, whatever the form of such evidence, and included in particular the "production of documents" and "sworn statements in writing". This interpretation has been repeatedly confirmed in the board of appeal case law (see **T 101/87**, **T 416/87**, **T 323/89** (OJ 1992, 169), **T 596/89**, **T 719/93**).

12.3 Equity of apportionment of costs

There is no definition of equity in the EPC. The boards of appeal therefore had to develop the criteria determining whether costs were to be apportioned on a case-by-case basis. In a number of decisions (see, for example, **T 765/89**, **T 26/92** and **T 432/92**) it has generally been stated that apportionment of costs is justified if the conduct of one party is not in keeping with the care required, that is if costs arise from culpable actions of an irresponsible or even malicious nature. However, according to **T 717/95** no abuse has taken place if a party to the proceedings misinterprets the content of a citation when comparing it with the subject-matter claimed in the disputed patent.

An analysis of the decisions of the boards of appeal reveals that requests for apportionment of costs are often filed in the following scenarios:

- (a) late submission of documents and/or requests (see 12.3.1);
- (b) request for oral proceedings withdrawn or postponement requested (see 12.3.2);

- (c) appeal or opposition withdrawn (see 12.3.3);
- (d) one of the parties does not appear at the oral proceedings (see 12.3.4);
- (e) cases of alleged abuse of procedure or abuse of oral proceedings (see 12.3.5).

12.3.1 Late submissions of documents and/or requests

G 10/91 (OJ 1993, 420) restricts the introduction of new grounds for opposition and, in appeal proceedings, makes this dependent on the patent proprietor's approval. However, this does not apply to the late submission of facts and evidence relating to grounds for opposition on which the opposition was based from the outset. Since **T 1002/92**, OJ 1995, 605, many boards of appeal have nevertheless come closer in their interpretation of Art. 114(2) EPC to the principles developed in **G 10/91**. For details of how late-filed requests are handled, see p. 545 et seq.

(a) Late submission not justified

A reapportionment of costs was ordered in those cases where documents or requests were filed late - unless there were good reasons for the delay - as it was assumed that higher costs had been incurred as a result. Whether or not the documents were relevant to the decision on the merits was considered to be immaterial (see **T 10/82** (OJ 1983, 407), **T 117/86** (OJ 1989, 401), **T 101/87**, **T 326/87** (OJ 1992, 522), **T 416/87** (OJ 1990, 415), **T 323/89** (OJ 1992, 169), **T 596/89**, **T 622/89**, **T 503/90**, **T 611/90** (OJ 1993, 50), **T 755/90**, **T 110/91**, **T 161/91**, **T 705/92**, **T 867/92** (OJ 1995, 126), **T 719/93**, **T 970/93**).

However, it should be pointed out that in a large number of cases of unjustified delay, requests for apportionment of costs were refused because there was no proof that higher costs had been incurred (see, for example, **T 297/86**, **T 212/88** (OJ 1992, 28), **T 443/90**, **T 582/90**, **T 267/92**, **T 306/93**, **T 486/94**, **T 9/95**). In **T 931/97**, it was only in the appeal proceedings that the opponent had submitted new evidence, which however the patentee knew about from earlier proceedings before the German Patent Office. The board held that in such a case - where the patentee knew the documents and could assess their prospects - apportionment of costs was not justified.

In **T 117/86** (OJ 1989, 401) the appellants had produced together with their statement of grounds two new documents and an affidavit in support of the contention that the opposed patent lacked an inventive step. The board concluded that the fact that new documents were presented after the nine-month period for filing opposition could itself give rise to additional expenditure for the other party, and that the costs should be apportioned for reasons of equity. The board accordingly decided, within the limits set by R. 63(1) EPC, to order an apportionment of costs on the following terms: the appellants to pay the respondents fifty per cent of the costs incurred by the respondents' representative for the preparation and filing of the reply to the appeal. A similar decision was taken in **T 323/89** (OJ 1992, 169). In **T 416/87** (OJ 1990, 415) the fact that the appellant relied in the statement of grounds of appeal on three new documents exclusively, and for the first time even raised the issue of novelty on the basis of a document already discussed in the patent in suit, was regarded by the board

as an abuse of the opposition procedure. By introducing arguments and documents which bore little relation to those filed in the original opposition, the appellant had produced virtually a new opposition at the appeal stage. This could not, by definition, be the purpose of an appeal. The late filing of documents must have considerably increased the costs incurred by the respondent, compared to what they would have been if all facts and evidence had been filed within the nine-month period. Although the respondent clearly envisaged requesting a decision on costs in the event of oral proceedings only, the abuse of procedure justified the apportionment of costs incurred during the taking of evidence. As provided in R. 63(1) EPC, such costs include the remuneration of the representatives of the parties.

In **T 83/93** the board ruled that submitting as evidence five new documents 40 months after the end of the opposition period (without giving reasons) and reviving an objection under Art. 100(c) EPC on the basis of new facts and evidence 51 months after the end of the opposition period was an abuse of appeal proceedings. It was therefore equitable to apportion the costs in the respondent's favour: as a result of the appellant's unsubstantiated late filing of evidence, the respondent had incurred higher costs than if all the evidence had been submitted within the nine-month opposition period, in which case all the items (prior art documents and comparison of the original documents with valid documents) could have been dealt with in a single operation. The board pointed out that under R. 63(1) EPC it could take into consideration only such costs as were necessary to assure proper protection of the rights involved. In the present case, this included the remuneration of the representatives of the parties. The board therefore ruled that the appellant should pay the respondent 50% of his representative's costs in preparing and filing the response to the appeal.

In **T 867/92** (OJ 1995, 126) the claims had been amended during the opposition proceedings. Eighteen months after the claims had been amended the appellant/opponent cited in the statement of grounds of appeal a new prior art document. The board held that the EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay with no special reason justifying the delay runs the risk of having to bear the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation. However, as there was no suggestion that the appellant/opponent wilfully abused the procedure in the present case, the board considered that it would be equitable to order the appellant to pay only half those costs.

According to **T 326/87** (ABI. 1992, 522) the degree of apportionment must depend on the circumstances of each case, but where a document successfully introduced at a late stage is of such relevance that the board decides to remit the case to the first instance in order to allow the patentee to have his case decided by two instances of jurisdiction, then in the absence of any convincing explanation for the late introduction of that document, the costs between the parties should be apportioned in such a way that the late-filing party should bear all the additional costs caused by his tardiness. Costs should only be shared between the parties if there exist strong mitigating circumstances for the late filing of facts, evidence or other matter, for example, where the document introduced was obscure and therefore difficult to get hold of. This decision was confirmed by **T 611/90**, OJ 1993, 50.

T 336/86 involved a special case. The appellants submitted a prior patent belonging to the

respondents for the first time in the appeal proceedings, which destroyed the novelty of the patent in suit. The respondents requested an apportionment of costs as the oral proceedings would not have been necessary had the patent been presented earlier. The board agreed that the late submission was not justified and that higher costs had been incurred as a result. However, as the respondents either had - or should have - been aware of the existence of their own patent, it took the view that an apportionment of costs was not justified.

(b) Late submission justified

In principle, costs are not apportioned differently if the late submission appears justified. Cases are always assessed individually on their merits. The boards have assumed in particular that belated submission is justified or that no abuse of procedure has taken place if new documents are filed for the first time at a later stage in the proceedings as a reaction to communications from the board, comments from the other party or amendments of the patent or decisions of the department of first instance which make such documents necessary in the first place (see **T 582/88**, **T 638/89**, **T 765/89**, **T 472/90**, **T 556/90**, **T 334/91**, **T 875/91**, **T 81/92**, **T 585/95**, **T 29/96**).

By way of exception, a different apportionment of costs was ordered in a case of justified late submission in **T 847/93**. The statement of grounds of appeal made no substantiated criticism of the reasons for the decision of the opposition division, and relied only on new prior art submitted for the first time in said statement. However, the statement was found to be admissible by the board. Mitigating circumstances for the late filing of new facts and evidence were put forward by the appellants and were held to be credible by the board. On the other hand, the board was also of the opinion that it was credible that the costs incurred by the respondents were higher as a result of the introduction of an entirely fresh case than if the facts and evidence had not been filed at a late stage. It therefore decided to order an apportionment of costs under Art. 104(1) EPC according to which the appellants had to pay the respondents 50% of the costs incurred by the respondents in respect of the subsequent oral proceedings and the taking of evidence before the department of first instance as well as in any subsequent appeal.

In **T 29/96** the request for a different apportionment of costs was refused. A document which was fairly simple and straightforward in content had been filed together with the statement of grounds of appeal. The board ruled that this was the earliest possible moment that the document could have been submitted. Secondly, it had not given rise to virtually a new opposition; it had not introduced new closest prior art, but was merely a new secondary information source. It was logical for the appellant, as the losing party in the opposition proceedings, to introduce the document into the appeal proceedings in an effort to improve his position by filling a gap referred to in the impugned decision.

In **T 712/94** the board allowed the appellant (opponent) to introduce facts and evidence on alleged prior use at the appeal stage, whilst refusing the respondent's (patentee's) request for apportionment of costs. The patentee had been made aware of the prior-use documents during negotiations conducted well before the first-instance decision was taken. So they had not taken him by surprise when later introduced into the appeal proceedings following failure of the negotiations. The board could therefore see no reasons of equity requiring a different

apportionment of costs.

(c) Late submission unjustified, but not disadvantageous

In a number of cases the board refused a different apportionment of costs despite unjustified late submission because it was of the opinion that the late submission was not disadvantageous to the other party (see **T 336/86**, **T 330/88**, **T 525/88**, **T 534/89** (OJ 1994, 464), **T 737/89**, **T 231/90**, **T 556/90**, **T 876/90**, **T 28/91**, **T 685/91**, **T 875/91**, **T 882/91**, **T 938/91**).

In **T 330/88** the respondents filed a new document two days prior to the oral proceedings. The board took the view that the late filing was unjustified but that an apportionment of costs would not be equitable as the appellants had had sufficient time to deal with the document, especially since the decision was not taken until four months after the oral proceedings and following the opportunity to present comments.

In **T 525/88** the late filing was unjustified, the request for apportionment of costs was rejected because the documents were of no relevance and did not affect the decision. The same applied in **T 534/89** (OJ 1994, 464) and **T 876/90**.

In **T 882/91** the request for apportionment of costs was refused even though the new documents had been submitted after expiry of the opposition period and the late submission was unjustified. The board did not look into whether the late submission had led to higher costs because it was of the opinion that the other party had not had to spend very much additional time and energy on the documents which had been submitted late and that there was therefore no reason to apportion costs. The same applied in **T 737/89** (very short document), **T 685/91** (no additional work involved in dealing with the new document), **T 556/90** (no additional effort involved in checking new document, remittal not necessary), **T 231/90** (drawings easy to check), and **T 875/91** (checking not difficult).

In **T 28/91** three documents which had already been submitted to the opposition division were re-submitted at a later stage in the appeal proceedings. The board ruled that the late submission was not disadvantageous as no new arguments had been introduced, and therefore no additional work had been necessary.

In **T 938/91** an alleged prior public use was filed for the first time, with drawings pertaining thereto, together with the statement of grounds for appeal. The patentees had requested a different apportionment of costs on the grounds that the complicated drawings required considerable extra effort. The board rejected this request, taking the view that the additional effort involved in studying the drawings would have been necessary even if they had been submitted in good time. No additional costs had therefore been incurred as a result of the late submission.

12.3.2 Request for oral proceedings withdrawn or postponement requested

In **T 154/90** (OJ 1993, 505) the opponents had initially insisted on oral proceedings, although the opposition division did not consider that they were necessary. However, eight days before

the arranged date the opponents informed the opposition division that they wished to cancel the oral proceedings. For reasons of internal organisation at the EPO, the opposition division did not receive this letter until after the date of the oral proceedings. The board of appeal ruled that eight days was a sufficient period of time for the oral proceedings to be cancelled, since, unlike in **T 10/82** (OJ 1983, 407), no evaluation of new facts or arguments was needed. Since the letter was received too late for purely internal reasons, the opponents were not at fault. They were not obliged to bear a part of the costs of the other party. A change of opinion regarding the necessity of oral proceedings could not be regarded as culpable conduct either.

In **T 432/92** postponement of the oral proceedings was requested two days prior to the agreed date as the father of the respondents' representative had died on the previous day. The appellants requested a different apportionment of costs because their representative had already travelled from America to the EPO, thereby incurring unnecessary costs. They argued that the respondents could have been represented by someone else from their patent attorney's firm. The board refused the request because there had been no recognisably wrongful or irresponsible conduct on the part of the other party. The board was of the opinion in particular that the respondents could not be expected to have themselves represented by a different patent attorney, who would have had to have prepared two oral proceedings in one day (one for an ongoing parallel case) and to travel as well.

In **T 556/96**, the appellant withdrew his request for oral proceedings early in the afternoon preceding the appointed day. By that time, the opposing party's representative had already set off. The board ruled that the appellant had withdrawn his request too late. That the other party had also unconditionally requested oral proceedings was irrelevant; it too could have withdrawn the request, had it known in time that the appellant would not be attending. The board therefore ordered the appellant to pay the costs incurred by the respondent in preparing and attending the oral proceedings.

12.3.3 Appeal or opposition withdrawn

In **T 85/84** the appellants withdrew the appeal in a telex to the EPO and the respondents' representative 48 hours before the date of the oral proceedings. The EPO forwarded this information, together with the decision to cancel the oral proceedings, to the respondents' representative, a member of its patent department, by telex sent at 16.17 hrs. The telex did not reach the patent department until the next day. By this time, however, the respondents' representative had already departed in order to prepare for the oral proceedings in Munich. He requested apportionment of costs. Although the opposition and the appeal had been withdrawn, a decision was given on the apportionment of costs (see also **T 765/89**). The board refused to apportion the costs as the respondents' representative had been informed in good time that the oral proceedings would not be taking place. Internal delays in forwarding the communication were not the fault of the appellants. The representative's departure for Munich a day before the oral proceedings was not warranted by the distance and therefore not necessary from the point of view of the oral proceedings. The appellants should have been able to assume that their communication had reached the representative in good time. There had been no culpable conduct.

In **T 614/89** the appellants withdrew the appeal for financial reasons four days before the date

set for oral proceedings. The respondents were notified the same day. Respondents I filed a request for apportionment of costs on the grounds that they had already prepared themselves for the oral proceedings and the appellants must have known long before the date set that the appeal stood no chance of success. The board took a decision on the request, rejecting it on the grounds that the appeal had been withdrawn sufficiently promptly that no costs had been incurred for the oral proceedings. It also ruled that the right to oral proceedings was subject to no restrictions and that the appellants had acted neither negligently nor with wilful intent (see also **T 772/95**).

12.3.4 One of the parties does not appear at the oral proceedings

In **T 591/88** both parties had requested that oral proceedings be held - both in fact filing an "unconditional" request. Without giving any advance notice, the respondents failed to appear. The appellants requested apportionment of costs on the grounds that the oral proceedings would not have been necessary had they known that the respondents would not be attending. The board rejected an apportionment of costs because the appellants had made an "unconditional" request for oral proceedings, ie also covering the eventuality that the other party would not appear.

In **T 632/88** the appellants had requested oral proceedings. The respondents did not reply to the board of appeal's opinion and announced that they would not be attending the proceedings. The board rejected the appellants' request for apportionment of costs as the respondents' failure to appear had not resulted in additional costs (see also **T 507/89**).

In **T 909/90** oral proceedings had been appointed at the appellants' request. Without giving the board or opponents any advance notice, the appellants did not attend the oral proceedings. Nor did they comment on the board's communication. For this reason in particular the oral proceedings contributed nothing new to the case. The board ordered the apportionment of costs without examining whether higher costs had been incurred as a result of the appellants' failure to appear. See also **T 693/95**, in which the cancellation took place one hour before the appointed time.

In **T 338/90** oral proceedings had been requested by both parties. However, the appellants did not appear. Their representative only notified the board as the oral proceedings were starting. The board **assumed** that costs had been incurred as a result of the party's failure to appear and ordered the appellants to reimburse the respondents the costs they had incurred for the oral proceedings.

In **T 275/89** (OJ 1992, 126) the appellant's representative filed a request that the oral proceedings scheduled for 09.00 hrs on 3 May be adjourned, on the grounds that the appellant was unable to attend the oral proceedings owing to illness. The request was submitted so late, ie in the afternoon of 30 April, that it was impossible in view of the public holiday the following day to notify the respondents in time: they had already set out during the afternoon of 1 May. The request was refused however and the oral proceedings took place without the appellant. The respondents requested a different apportionment of costs on the grounds that they would not have attended either had they known that the appellant would not be appearing. The board, however, took the view that the appellant could not be made

responsible for the fact that the respondents had chosen to make an early start to the journey. Furthermore, the only matter of importance was whether the appellant's absence rendered the oral proceedings unnecessary. This question had to be answered in the negative. The request for costs was rejected.

In **T 838/92** too, the appellants stayed away from the oral proceedings. The respondents requested a different apportionment of costs as they had appeared with seven witnesses. The board rejected the request because the witnesses had been summoned at the respondents' instigation in order to prove the prior uses alleged by the latter. There was therefore no reason to impose the costs on the appellant.

In **T 930/92** (OJ 1996, 191) the board held that there was an equitable obligation on every party summoned to oral proceedings to inform the EPO as soon as he knew that he would not be attending as summoned. This was the case whether or not that party had himself requested oral proceedings, and whether or not a communication had accompanied the summons to oral proceedings. If a party who has been summoned to oral proceedings fails to attend as summoned without notifying the EPO in advance that he will not attend, an apportionment of costs in favour of another party who has attended as summoned may be justified for reasons of equity in accordance with Art. 104(1) EPC.

In **T 434/95** the appellant had asked for oral proceedings as an auxiliary request, but then failed to turn up, without informing the EPO beforehand. The board ruled that the appellant should bear the respondent's oral proceedings costs, because he too had asked for them only as an auxiliary request, and they had therefore not needed to be held. The appellant had been at fault in not advising the Office in time that he did not intend to appear, and under established case law (see **T 338/90**, **T 909/90** and **T 930/92** (OJ 1996, 191)) had to reckon with an award of costs against him (see **T 641/94**). The board added that Enlarged Board of Appeal opinion **G 4/92** (OJ 1994, 149) on the right to be heard was not relevant to its decision on costs, which related to the procedural consequences of a party's action in choosing not to attend. The opinion applied to substantive decisions on patents in suit, but not to the present case, where the respondent had presented no new facts in the oral proceedings.

In **T 544/94** oral proceedings had been requested by both parties. The board ruled that a party requesting oral proceedings was not obliged to be represented at them; its duly announced absence could not be considered as improper behaviour. A party's non-appearance did not generally adversely affect the party which did attend, and the respondents had neither shown nor claimed that they had incurred additional costs because the appellants were not present.

In **T 29/96** the respondent informed the board and appellant, 4 working days before the date set for oral proceedings, that it was abandoning the patent and no longer requesting oral proceedings. However, the declaration abandoning the patent was not completely unambiguous. The board refused the appellant's request that costs be awarded against the respondent; it had been clear that the oral proceedings would probably be superfluous. Also, the appellant could have contacted the DG 3 Registry to find out about the course the proceedings would be taking. The board also dismissed the appellant's further argument that additional costs had been incurred in clarifying the legal position following abandonment of

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the patent; these would have arisen anyway, even without the (cancelled) oral proceedings.

In **T 849/95** the respondent submitted a request for apportionment of costs, as the appellant had not informed the EPO in good time that he would not be taking part in the oral proceedings which he too had requested. The board rejected the request, as the oral proceedings were arranged not only at the request of both parties, but also because the board itself required further airing of facts on the part of the respondent. The oral proceedings would not have been cancelled even if the appellant had informed the EPO in good time.

12.3.5 Cases of alleged abuse of procedure or abuse of oral proceedings

Even when the proceedings showed no exceptional features attempts were still made, on the basis of an alleged abuse, to have costs apportioned. (For abuse in the case of late submission of documents, see above.)

(a) Abuse of procedure

An apportionment of costs is often requested on the grounds that the notice of opposition or appeal has been incorrectly filed.

In **T 170/83** the opponents had used an incorrect form for payment of the opposition fee, thereby giving rise to a decision by formalities to reject the opposition; the opponents thereupon filed an appeal against this decision. The patent proprietors/respondents requested that the appeal costs be awarded against the appellants, since it was their error which had rendered the proceedings necessary. The board rejected the request, taking the view that the appeal proceedings were not improper. An abuse justifying the apportionment of costs could only be rooted in the party's conduct **during the proceedings**.

In a number of cases the boards took the admissibility or allowability of an opposition or an appeal to be an indication that no abuse had taken place (eg **T 7/88** and **T 525/88**). In **T 99/87** the board held that there had been no abuse as a discussion had taken place during the oral proceedings and the respondents had as a result formulated new claims. In **T 506/89** the board rejected an apportionment of costs because the opposition division had decided during oral proceedings to maintain the patent as amended; there could consequently be no question of an abuse of procedure by the opponents.

In **T 605/92** the principle was laid down that no abuse of procedure has taken place if an appeal is filed even though no new arguments are put forward.

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

In **T 1171/97** the board rejected a request for apportionment of costs because it was satisfied that the new documents which had become known to the appellants (opponents) in the course of another search had not been filed in order to obstruct the proceedings, but because they contained aspects which the opposition division said it had not found in the previously

available references.

(b) Abuse of oral proceedings

In **T 49/86** the board ruled that an apportionment of costs was justified if excessive costs were incurred for the oral proceedings and were caused mainly by one party.

The parties repeatedly tried to bring about an apportionment of costs on the grounds that no new arguments had been put forward during oral proceedings by the party which had requested them and that therefore there had been an abuse of the oral procedure. Although costs were apportioned on these grounds in **T 167/84** (OJ 1987, 369), the boards otherwise unanimously took the view that the right to oral proceedings was absolute and not subject to any conditions (**T 614/89**, **T 26/92**, **T 81/92**). The absence of new arguments was not a reason for apportioning costs. The same applied in **T 303/86**, **T 305/86**, **T 383/87**, **T 125/89** (where the opposition division had decided otherwise) and **T 918/92**.

According to decision **T 79/88**, the wording of Art. 116(1) EPC makes it clear that it is a genuine right of any party to request oral proceedings if it considers them to be necessary. Nor does the fact that one of the parties has to travel a longer distance than the other make the request for oral proceedings abusive. Furthermore, an objection of abuse based on the fact that the problems to be discussed in oral proceedings are simple ones and could easily be presented in writing cannot be sustained.

However, in **T 1022/93** the appellant had refrained from communicating in the written appeal procedure why, in his opinion, the amended process claims should be considered inventive and from specifying that the additional example described a process according to the amended set of claims. This made it impossible either to remit the case without oral proceedings or to deal with the substance of the case at the oral proceedings. For reasons of equity, therefore, the appellant was required pursuant to Art. 104(1) EPC to reimburse to the respondent the costs incurred as a result of the participation at the oral proceedings before the board.

In **T 905/91** the respondents had requested a different apportionment of costs on the grounds that the appellants had not brought prepared auxiliary requests to the oral proceedings, which had therefore continued into the afternoon. The board rejected the request for the following reasons. Firstly, the appellants had endeavoured to take account of the reservations expressed by the board and had filed new documents. Secondly, oral proceedings served specifically to clarify the situation completely through the direct exchange of arguments and, if necessary, to rephrase the patent application in the light of the outcome of the discussion. The duration of oral proceedings depended on the particular case; at any rate it was not unusual for such proceedings to continue into the afternoon, and the parties should be prepared for this.

In **T 297/91** it had, for a number of reasons, not been possible to decide all the issues during the first oral proceedings, with the result that the respondent/patent proprietor had requested that **further oral proceedings** be held and that the costs incurred be borne by the appellant. The board rejected the request for apportionment of costs because the further oral

proceedings had become necessary for reasons beyond the patent proprietor's control.

In **T 407/92** the appellants and opponents II as a party of right requested the apportionment of costs because they considered it an abuse that the respondents, after the first oral proceedings, had presented numerous additional sets of claims and requested additional oral proceedings, although the board, at the end of the first oral proceedings, had declared that the proceedings should be continued in writing on the basis of the three auxiliary requests presented by the respondents during the first oral proceedings. The board could not see any abusive conduct because, due to the relatively complex technical content of the patent in suit, the board itself considered it necessary to have a further oral discussion with the parties. The request was rejected.

In decision **T 461/88** (OJ 1993, 295) the board decided that the appellants' insistence on hearing witnesses was clearly compatible with the principle of responsible exercise of rights, as this may well have been the only means of proving the alleged public nature of the prior use. The board refused the request for apportionment of costs.

12.4 Costs to be apportioned

In **T 167/84** (OJ 1987, 369), **T 117/86** (OJ 1989, 401) and **T 416/87** (OJ 1990, 415) cited above, the boards confirmed that representatives' costs could be apportioned. In **T 326/87** (OJ 1992, 522) the board decided that all costs caused by remittal to the department of first instance should be apportioned. In **T 416/87** and **T 323/89** (OJ 1992, 169) it was **assumed** that costs had arisen.

In **T 930/92** (OJ 1996, 191) the board held that when fixing the amount of costs to be paid to a party, in addition to the remuneration of the professional representative of that party, the expenses incurred by an employee of that party in order to instruct the professional representative before and during oral proceedings may be taken into consideration under R. 63(1) EPC, if such instruction was necessary to assure proper protection of the rights involved.

In **T 323/89** (OJ 1992, 169) and **T 934/91** (OJ 1994, 184) the board made it clear that, under Art. 111(1) EPC, a board of appeal, when considering a request for the apportionment of costs, was empowered to specify the amount of costs to be paid, having regard to Art. 104(2) EPC.

In **T 715/95**, new documents were submitted only in the appeal proceedings. The delay was not justified. However, because the documents were so relevant the board admitted them and remitted the case to the department of first instance. But it also ordered the late-filing party to pay 50% of the cost of the oral proceedings, and 100% of that of the further first-instance proceedings.

In **T 45/98**, the appellant submitted new documents only in the appeal proceedings. They were admitted, but the case was not remitted. The board ordered that the appellant should pay 45% of the costs incurred by the opposing party's representative in these appeal proceedings.

12.5 Procedural requirements

In decision **T 212/88** (OJ 1992, 28) the board ruled that all requests by parties, including any request for apportionment of costs, should be made before announcement of the decision at the conclusion of oral proceedings.

In decision **T 193/87** (OJ 1993, 207) the board refused the apportionment of costs because it could not see any reasons of equity which could justify such an apportionment of the costs, nor had the respondent brought forward any evidence in this respect. Also, in many other decisions the boards insisted on the submission of evidence (eg **T 49/86**, **T 193/87**, **T 404/89**, **T 523/89**, **T 705/90**, **T 776/90**, **T 306/93**).

In **T 896/92** the request for a different apportionment of costs was rejected for lack of substantiation and because of the absence of obvious reasons.

In **T 789/89** (OJ 1994, 482) it was made clear that although the opponent/respondent who withdraws his opposition ceases to be a party to appeal proceedings as far as the substantive issues are concerned, he nevertheless remains a party if the question of apportionment of costs is still at issue.

In **T 765/89** it was stressed that the board was still responsible for deciding on the request that costs be awarded against the appellants even if the latter had withdrawn their appeal.

In **T 408/91** the board stated that there was no basis for deciding on a different apportionment of costs if the party which would benefit from the decision did not request apportionment and even made it known that it would not enforce any such decision. This applied even if the board considered an apportionment of costs to be equitable (see also **T 125/93**).

In **J 38/92** the board held that as a matter of principle costs are not apportioned in transfer proceedings.

12.6 Article 106(4) EPC

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

In **T 753/92** respondents I were adversely affected by the decision under appeal only in so far as their request for apportionment of costs was rejected. If respondents I had lodged an appeal against this decision, the appeal, with the apportionment of costs as its sole subject, would have been inadmissible under Art. 106(4) EPC. The fact that respondents I submitted the request for apportionment of costs merely as a party to the appeal proceedings as of right (Art. 107 EPC) could not, in the board's judgment, render such a request admissible without contravening the principle of equal treatment. This request therefore had to be rejected as inadmissible.

D. Appeal procedure

1. Legal character of appeal procedure

The provisions governing the appeal procedure are set out in Art. 106 EPC to Art. 111 EPC and R. 64 EPC to R. 67 EPC and in the Rules of Procedure of the Boards of Appeal. R. 66(1) EPC plays an important role since it stipulates that, unless otherwise provided, the provisions relating to proceedings before the department which took the decision under appeal are applicable to appeal proceedings *mutatis mutandis*. This application by analogy is, however, not automatically permissible in every case and for every provision (**G 1/94**, OJ 1994, 787). Criteria therefore had to be established for when such an analogy was permissible and when not. To this end it was necessary to analyse the legal nature of the appeal procedure.

Appeal proceedings are wholly separate and independent from the first-instance proceedings. Their function is to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (**T 34/90** (OJ 1992, 454), **G 9/91** (OJ 1993, 408), **G 10/91** (OJ 1993, 420), **T 534/89** (OJ 1994, 464), **T 506/91**). In **T 501/92** (OJ 1996, 261) the board deduced from this principle that any procedural request or statement made by a party during proceedings in the first instance was not applicable in any subsequent appeal proceedings, and had to be repeated during the latter if it was to remain procedurally effective.

In the recent decision **G 1/99** (OJ 2001, 381) the Enlarged Board held that the appeal procedure is to be considered as a judicial procedure (see point 18 of the reasons for the **G 9/91**, OJ 1993, 408) proper to an administrative court (see point 7 of the reasons for **G 8/91**, OJ 1993, 346; likewise **G 7/91**, OJ 1993, 356). In an older decision (**G 1/86**, OJ 1987, 447), the Enlarged Board also addressed this question. In **G 9/92** and **G 4/93** (both OJ 1994, 875) it was decided that the extent of appeal proceedings is determined by the appeal.

These characteristics of the appeals procedure not only serve as criteria when assessing whether a provision may be applied analogously in individual cases; they also have general legal consequences in many respects. It follows from the characteristics set out by the Enlarged Board that the general principles of court procedure, such as the entitlement of parties to direct the course of the proceedings themselves ("principle of party disposition"), also apply to appeals (see **G 2/91** (OJ 1992, 206), **G 8/91**, **G 8/93** (OJ 1994, 887), **G 9/92** and **G 4/93**), that a review of the decision taken by the department of first instance can, in principle, only be based on the reasons already submitted before that department (**G 9/91**,

G 10/91), and that the proceedings are determined by the petition initiating them (*ne ultra petita*) (see **G 9/92** and **G 4/93**). The Enlarged Board has also made it clear that the decision-making powers of opposition divisions, and of the boards in opposition appeal proceedings, are circumscribed by the statement under R. 55 (c) EPC of the extent to which the European patent is opposed. They have no powers to decide and thus investigate anything extending beyond that statement (see **G 9/91**, reasons, 10 and 11). This has defined the sphere of application of Art. 114(1) EPC, and clarified the distinction between the power to initiate and determine the object of proceedings, on the one hand, and the power to examine the facts then relevant, on the other. The individual procedural consequences and the Enlarged Board's decisions are discussed in greater detail below.

2. Suspensive effect of the appeal

Under Art. 106(1) EPC, an appeal has suspensive effect. The Legal Board of Appeal defined this effect in **J 28/94** of 7.12.1994 (OJ 1995, 742), in which a third party claimed entitlement to the grant of the patent and requested suspension of the proceedings for grant under R. 13(1) EPC. The board took the view that the appeal's suspensive effect meant the contested decision had no legal effect until the appeal was resolved. Otherwise appeal would be nugatory.

Thus, if a decision refusing to suspend the publication of the mention of grant of a patent were appealed, publication should be deferred until the appeal was decided. If (as here) this was not possible for technical reasons, the EPO should take all necessary steps to advise the public that the mention of grant was no longer valid (see also **T 1/92**, OJ 1993, 685, reasons, 3.1).

3. Devolutive effect of the appeal

On appeal, the first instance loses its competence for the further prosecution of the application for all contracting states - the appeal does not leave a part of the application pending in the first instance. Thus, deemed withdrawal of the application pursuant to Art. 110(3) EPC applies in the case of a failure to reply to a communication pursuant to Art. 110(2) EPC in *ex parte* appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request. The board reasoned that even if the appealed decision concerned only the designation of a state and not the application as a whole, according to the principle of unity of the application and of the patent in the proceedings the suspensive effect of the appeal affected the application as a whole. Since it was bound by the EPC, a deviation from the clear wording of a provision of the EPC could only be considered if the provision was in breach of a higher legal principle or was purely arbitrary. The board decided it was not, as the validity of a designation was part of the grant procedure - the decision to grant had to identify the states for which the patent was granted (**J 29/94** (OJ 1998, 147)).

4. Language of the proceedings

The same language arrangements apply to appeals as to all other EPO proceedings. Under R. 1(1) EPC any party may use any EPO official language in written proceedings (for the legal

position prior to the deletion of R. 3 EPC see **T 379/89** and **T 232/85**, OJ 1986, 19), and under R. 2(1) EPC any party to oral proceedings may use another EPO official language instead of the language of the proceedings, provided he either gives the EPO at least one month's notice or arranges for interpreting into the language of the proceedings.

In **T 34/90** (OJ 1992, 454) the respondent did neither. His representative argued that because he had lawfully used an alternative official language in oral proceedings before the opposition division, he should be allowed to use the same language in the hearing before the board. Although he did not actually say so, this plainly implied that appeal proceedings were simply a continuation of the first-instance (ie opposition) proceedings. From the principle that appeal proceedings were wholly separate and independent from first-instance proceedings for the purpose of deciding the admissibility of using an alternative official language under R. 2(1) EPC - and for other procedural purposes - the board inferred that a party could use such a language in oral proceedings before it only if he again gave the requisite notice (see also communication from the Vice-President DG 3, OJ 1995, 489).

In **J 18/90** (OJ 1992, 511) the board recognised that in written proceedings and decisions, organs of the EPO might also use an official language other than the language of proceedings, provided all parties to the proceedings had given their agreement (see also **T 788/91**).

In **T 706/91** the appeal had been drawn up in accordance with R. 1(1) EPC in one of the official languages, namely German. The appellant had therefore cited passages from the disputed European patent's claims and description in that language, even though they had been drawn up in French as the language of the proceedings. The board decided that these references were admissible.

See also chapter "Language privilege", p. 394.

5. Procedural status of the parties

5.1 Parties to appeal proceedings

Under Art. 107 EPC, the parties to proceedings before the department of first instance are also parties to the ensuing appeal proceedings, even if they have not personally filed an appeal. Pursuant to Art. 99(4) EPC, opponents as well as the patentee are parties to opposition proceedings. In addition, Art. 105 EPC makes provision for intervention by the assumed infringer.

For other proceedings, the general principle applies that the parties to them are those whose legal interests are affected by the decision at issue. In **T 811/90** (OJ 1993, 728), for example, opposition proceedings had been concluded and the time limit for lodging an appeal had expired. Only the patent proprietor lodged an appeal, but against a separate decision on a point incidental to the opposition. It was held that the other party had no right to be a party to the appeal as he had not been a party to the relevant decision. However, in a decision concerning an appeal against a Legal Division decision refusing to suspend grant proceedings under R. 13 EPC, the applicant is to be treated as a party to the proceedings.

The request for suspension cannot be separated from the grant proceedings. The applicant's legal position is directly affected by suspension, because for its duration he is denied the rights under Art. 64(1) EPC (**J 33/95**).

A patent applicant who is not heard when grant proceedings are suspended at a third party's request pursuant to R. 13 EPC may still challenge the justification for that suspension. He is a party as of right to any appeal proceedings initiated by the third party against rejection of the latter's request by the EPO (**J 28/94** dated 4.12.1996 (OJ 1997, 400)).

Art. 107 EPC states that where one party files an appeal, any other parties to the first-instance proceedings are parties to the appeal proceedings as of right. Nothing in the EPC enables an opposition division or board of appeal to exclude a party from ongoing proceedings (**T 838/92**).

In **T 643/91** the appeal of opponent 1 was rejected as inadmissible. Opponent 2 filed an admissible appeal. Opponent 1 was considered by the board to be "any other party to the proceedings" under Art. 107 EPC and, as a consequence, to be a party as of right in the appeal proceedings of opponent 2. However, in **T 898/91** it was held that an opponent whose opposition has been rejected as inadmissible by the opposition division and who has not filed an appeal against this decision is not entitled to be a party to any appeal by the patent proprietor, because he ceases to be a party to the opposition proceedings once the decision on the admissibility of its opposition takes full legal effect. Where a company is dissolved and thus ceases to be a legal person, it loses its capacity to be a party to any proceedings. If it was the original appellant, the appeal consequently lapses (**T 353/95**).

Third parties commenting under Art. 115 EPC on the patentability of the invention claimed are not parties to the proceedings before the EPO.

5.2 Transfer of party status

G 4/88 (OJ 1989, 480) ruled that a company's opponent status is transferable to the firm which has taken it over. Party status is transferable at any stage during pending appeal proceedings if transferred together with the business assets or part of the company in whose interests the appeal has been filed (**T 659/92** (OJ 1995, 519)). Transfer is also possible prior to appeal proceedings being commenced by the transferee (**T 563/89**, applying **G 4/88** (OJ 1989, 480)).

If the European patent is transferred during opposition proceedings the new patent proprietor entered in the Register of Patents takes the place of the previous patent proprietor both in the opposition and in the appeal proceedings. His entitlement may not be questioned in these proceedings (**T 553/90** (OJ 1993, 666)). However, transfer of opponent status must be factually substantiated and proven (**T 670/95**).

In **T 298/97** (OJ 2002, ***), the board held that the possession of a commercial interest in the revocation of a patent was not sufficient to allow a successor in business to take over and conduct opposition appeal proceedings in the absence of evidence of a transfer of the right to do so together with the related business assets of the opponent. In the absence of such

evidence, the transfer of an opponent's business assets to two separate persons could not give either of them the right to take over and conduct opposition or opposition appeal proceedings. When such evidence is present, only the transferee established by such evidence can acquire such a right.

A party to proceedings may change, provided the succession in title is documented for the EPO. Only then is it effective (R. 20(3) EPC, R. 61 EPC). It is not necessary for the other party to agree to the change. The previous party to the proceedings retains its rights and obligations until the transfer has been documented (**T 870/92**).

5.3 Rights of parties under Article 107 EPC

In appeal proceedings, the case law recognises the right of all parties to be heard (see **J 20/85** (OJ 1987, 102), **J 3/90** (OJ 1991, 550), **T 18/81** (OJ 1985, 166), **T 94/84** (OJ 1986, 337), **T 716/89** (OJ 1992, 132)), albeit within the limits of expediency (see **T 295/87**, OJ 1990, 470). The parties also have a right to oral proceedings (see p. 271 et seq.).

Furthermore, **G 1/86** (OJ 1987, 447) recognised the validity of the principle that all parties must be treated equally in similar legal situations in proceedings before the boards of appeal.

Decision **T 73/88** (OJ 1992, 557) deduced from this that all parties to proceedings had the right to continue appeal proceedings. If there was already one valid appeal, no further appeals were needed and the fees paid for appeals filed later had to be refunded. However, in decision **G 2/91** (OJ 1992, 206) the Enlarged Board disagreed. It took the view that from the legal point of view the status of parties who had filed an appeal was not comparable with that of those who had not. It was clear from generally recognised principles of procedural law that the appellant alone could decide whether the appeal filed by him was to stand. Art. 107 EPC, second sentence, only guaranteed non-appellants who were party to proceedings of the first instance that they were parties to **existing** appeal proceedings. A person who was entitled to appeal but did not do so, settling instead for being "automatically" a party to the appeal proceedings, had no independent right of his own to continue those proceedings if the appellant withdrew his appeal. He acquired that right only by filing an appeal himself and paying the associated appeal fee. By the same token, there was also no reason to refund the fee for any appeals filed after the first, unless the requirements of R. 67 EPC were met. The related issue of whether non-appealing parties can file substantive requests is dealt with in **G 9/92** and **G 4/93** (both OJ 1994, 875; see p.348).

The parties must be given equally fair treatment (**G 9/91**, OJ 1993, 408, reasons, 2). In **T 1072/93** the board held that the freedom of the board to offer specific advice to one of the parties as to how an objection might be overcome, even when such an objection stemmed from the board itself, was severely limited, especially in inter partes proceedings where the preservation of judicial impartiality was a paramount requirement. In **T 253/95**, the same board confirmed that boards of appeal in inter partes proceedings must be strictly impartial and found that alerting a party to a possible argument against him and on a ground on which the burden of proof rested on him, in advance of the oral proceedings, would amount to a clear violation of the principle of impartiality, irrespective of the fact that the communication setting out such an argument would also be sent to the other party.

5.4 Intervention

5.4.1 Admissibility of intervention

Under Art. 105 EPC, to intervene admissibly in opposition proceedings a party must show either that the patentee has instituted infringement proceedings against him or that in response to a request from the patentee to stop allegedly infringing the patent he has himself instituted proceedings for a court ruling that he is not in fact doing so.

In **T 195/93** the board held that if a patentee simply sent a legal warning letter asking the intervener to stop production and sale of a product covered by the patent, this could not be regarded as institution of proceedings for a court ruling even if under national law the addressee became liable for damages 30 days after receiving the letter. The intervention was therefore rejected as inadmissible. Similarly, according to **T 392/97**, Art. 105 EPC requires that an intervener should prove both that the patentee has requested that he cease alleged infringement of the patent **and** that he has instituted proceedings for a court ruling that he is not infringing the patent. Thus where the letter was sent not to the allegedly infringing company, but to an unrelated one which it was assumed was about to acquire it, the first requirement was not fulfilled and their interventions were inadmissible.

The question has arisen up to what stage in the proceedings intervention is still possible.

In **G 1/94** (OJ 1994, 787) the Enlarged Board concluded that Art. 105 EPC should apply to appeal proceedings. The term "opposition proceedings" was not restricted to the department of first instance, but could also refer to such proceedings at second instance. Intervention during appeal proceedings was therefore admissible. The Enlarged Board also examined the related question of whether an intervener could raise any of the grounds for opposition under Art. 100 EPC even if they had not yet been examined by the opposition division, and found in the affirmative. If a fresh ground for opposition was raised, the case should be remitted to the department of first instance unless the patent proprietor wished the board to rule on it there and then.

However, a notice of intervention filed during the two-month period for appeal has no legal effect if no appeal is filed (**G 4/91** (OJ 1993, 707), see p. 459 for further details).

The applicable starting point for calculating the three-month period for intervention under Art. 105(1) EPC is always the date of the institution of the **first** court action, when the sole available period for intervention starts to run. The two alternative starting points under Art. 105(1) EPC, first and second sentence respectively, for calculating the three-month period for intervention are mutually exclusive (**T 296/93** (OJ 1995, 627)). See also **T 144/95**.

Where an appellant's notice of withdrawal of appeal and a notice of intervention are both filed by fax on the same day, the chronological order in which they arrive must be taken into account. This is because the withdrawal of the appeal is effective from the precise time at which the EPO receives notice of it, if that can be established, and for a notice of intervention to be valid the appeal proceedings must be pending when it is filed (**T 517/97** OJ 2000, 515).

5.4.2 Intervener's rights, fees payable

Where a party intervenes only at the appeal stage, several decisions have stated that no appeal fee need be paid if the party is not seeking appellant status in his own right (see **T 27/92**, **T 471/93** and **T 590/94**). In **T 1011/92** and **T 517/97** (OJ 2000, 515, point 2) the board ruled that an intervener must pay the fee if he wants to have his own right to appeal proceedings, in the sense that he can continue them if the original appellant withdraws his appeal. However, in **T 144/95**, where an intervention was filed during appeal proceedings and an appeal fee paid, the board ordered the appeal fee to be refunded (at the request of the intervener) - under Art. 107 EPC, an admissible appeal could only be filed by a party who was already a party to the proceedings leading to the decision and who was adversely affected by it. Where the intervention was filed during appeal proceedings, the intervener could not satisfy these conditions, and, (referring to **G 1/94** (OJ 1994, 787)), could not be considered as an appellant. Whilst Art. 105 EPC provided an exception to the time limit for payment of the opposition fee under Art. 99 EPC, no such exception was made concerning the appeal fee.

In **T 195/93** the board held that the fact that the original appellant had withdrawn his appeal after the intervention was filed could not immediately lead to termination of the proceedings, and therefore considered the admissibility of the intervention; in **G 1/94** (OJ 1994, 787) it was stated that intervention by an assumed infringer during pending appeal proceedings could be based on any ground for opposition under Art. 100 EPC, including grounds not invoked by the original appellant(s). The board found that this statement would be meaningless if the intervention was not to be considered independently of the fate of the appeal. However, since the intervention was inadmissible the board did not have to decide whether the intervener could continue the appeal proceedings.

5.5 Observations by third parties

According to Art. 115 EPC any person may present observations concerning the patentability of the invention after the publication of the European patent application. This person shall not be a party to the proceedings before the EPO.

According to **T 908/95**, no account is taken of a submission in which a third party refers during appeal proceedings to a public prior use without sufficiently substantiating the necessary criteria, and if further studies would be needed which could only be carried out in collaboration with that third party (who is not a party to the proceedings).

6. Extent of scrutiny

Appeals give losing parties the opportunity to challenge first-instance decisions adversely affecting them, and to try to have them set aside or changed. The appeal constitutes the subject-matter of the proceedings (**G 9/91**, **G 10/91** (OJ 1993, 408, reasons, 18), **G 9/92** (OJ 1994, 875)). The board's power to decide is determined by the appellant's request(s). The legal and factual framework on which the contested decision was based determines the limits within which this power may be exercised (**G 9/91**, **G 10/91**, especially reasons, 18). In the case of an opposition, this means that the opponent's first-instance requests determine the

extent to which the patent is challenged, and the grounds for opposition to be considered, at both first and second instance. Beyond that, the boards have no power to decide. By way of exception to this principle, dependent claims can be examined if the material already available casts doubt prima facie on their validity, and a new ground for opposition can be considered with the patentee's consent (**G 9/91**, **G 10/91**, **T 362/87** (OJ 1992, 522)). The appellant's request also defines the limits for applying Art. 114(1) EPC; beyond it, there is no power to examine the facts (**G 9/92**, reasons, 3 and 4).

In admissible opposition appeal proceedings, in the absence of a "request" or reply from a respondent indicating that the decision of the opposition division should not be amended or cancelled, a board of appeal must still examine and decide whether the appeal is allowable, in accordance with Art. 110 EPC and Art. 111 EPC (**T 501/92** (OJ 1996, 261)). The board also upheld **T 34/90** (OJ 1992, 454), according to which the procedural statements made during the first-instance proceedings are not applicable to the appeal proceedings.

6.1 Binding effect of requests - no *reformatio in peius*

The question of law referred to the Enlarged Board of Appeal in **G 9/92** and **G 4/93** (both OJ 1994, 875) asked whether and to what extent a board of appeal could depart from the request formulated in the notice of appeal when deciding opposition appeal proceedings, to the disadvantage of the appellant.

The Enlarged Board took several factors into account. The aim of the appeal was to eliminate an 'adverse effect'. As the filing of an appeal was subject to a time limit, it would not be consistent to allow non-appealing parties the unrestricted right to alter the extent of the proceedings by submitting their own requests without limitation of time. A non-appealing party as a respondent had the opportunity to make what it considered to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the department of first instance.

The Enlarged Board thus concluded that:

1. If the **patentee** was **sole appellant** against an interlocutory decision maintaining his patent in amended form, neither the board of appeal nor the non-appealing opponent (as party to the proceedings as of right under Art. 107 EPC, second sentence) could challenge maintenance of the patent as thus amended.
2. If the **opponent** was **sole appellant** against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee was primarily restricted in the appeal proceedings to defending the patent as thus maintained. Amendments proposed by the patentee (as party to the proceedings as of right under Art. 107 EPC, second sentence) could be rejected by the board as inadmissible if they were neither appropriate nor necessary (see eg **T 321/93**).

Applying the principles expounded in **G 9/92** and **G 4/93** the board concluded in **T 856/92** that in a case where the patentee and sole appellant appealed only in respect of some of the claims held allowable in the opposition division's interlocutory decision, neither the board nor

the opponent might challenge those claims not questioned by the appellant.

In **T 752/93**, **T 637/96**, and **T 1002/95** the opposition division had maintained the patent in amended form and only the opponent had appealed. The non-appealing patentee proposed amendments during the appeal proceedings. In **T 752/93** and **T 1002/95** the board found that amendments proposed by a non-appealing patentee could, according to **G 9/92**, be rejected as inadmissible by the board of appeal if they were neither appropriate nor necessary, ie had not been occasioned by the appeal. According to **T 752/93** the patentee should therefore have the opportunity to correct erroneous amendments if these were detected later in the proceedings. Similarly, in **T 637/96**, the respondent/patentee was able to request restoration of the claim as granted, as the amendment made to it in opposition proceedings did not change its subject-matter (ie the claim as granted and amended meant the same thing) and was therefore unnecessary. In **T 752/93** and **T 637/96** the amendments were found not to worsen the sole appellant's position and the boards thus considered them appropriate and necessary. In **T 1002/95** the board pointed out that under R. 57a EPC, which came into force after decisions **G 9/92** and **G 4/93**, a patentee was entitled to make "appropriate and necessary" amendments occasioned by grounds for opposition specified in Art. 100 EPC, even if the respective ground was not invoked by the opponent.

The principles of **G 9/92** were applied in **T 169/93** to the situation where the patent had been revoked, not amended. The patentee appealed against the decision to revoke (for lack of inventive step). The opposition division had found the patent sufficiently disclosed and novel. The appellant submitted that these issues could not be reopened, as none of the opponents had appealed this finding, relying on decisions **G 9/91** (OJ 1993, 408), **G 10/91** (OJ 1993, 420) and **G 9/92** (OJ 1994, 875). The board disagreed, pointing out that the respondents were unable to file an appeal, not being adversely affected under Art. 107 EPC, their request for revocation having been granted. Moreover, as the patent had been revoked, it was not possible for the appellant to have an even worse outcome. It was thus open to the respondents to re-argue matters which had already been at issue before the opposition division.

Indeed, the doctrine of *reformatio in peius* cannot be extended to apply separately to each point decided by the opposition division (**T 327/92**). See also **T 401/95** and **T 583/95**.

Limited exceptions to the rule against *reformatio in peius* exist. In **G 1/99** (OJ 2001, 381) the Enlarged Board of Appeal answered the question referred to it in **T 315/97** (OJ 1999, 554), namely, "Must an amended claim which would put the opponent and sole appellant in a worse situation than if he had not appealed - eg by deleting a limiting feature of the claim - be rejected?".

The Enlarged Board held that **in principle** such a claim must be rejected. However, an exception to this principle might be made where the opposition division had allowed an inadmissible amendment. In the case at issue the opposition division had done just that with the agreement of the proprietor, who was thus not adversely affected by the decision and unable to appeal. The respondent/proprietor had filed during the appeal proceedings a main request including the added (and unallowable) limiting feature, and an auxiliary request deleting it (and thus widening the claim). The Enlarged Board found that the main request had

to be rejected because it did not meet the requirements of the EPC. Moreover, if the principle of *reformatio in peius* were to be applied without considering the specific circumstances of the case, the auxiliary request would also have to be rejected because it would put the opponent/appellant in a worse situation than if it had not appealed. The only possible course the board could then take would be to revoke the patent, there being no further remedy for the proprietor. The proprietor would thus definitively lose any protection as a direct consequence of an inadmissible amendment being held allowable by the opposition division. The Enlarged Board considered it inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgement made by the opposition division. The patent proprietor should thus be allowed to file requests in order to overcome this deficiency, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as amended.

- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Art. 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Art. 123(3) EPC, even if, as a result, the situation of the opponent/appellant is made worse.

According to an obiter dictum in **T 239/96**, the board took the view that, in the absence of a provision on cross-appeal (in German 'Anschlußbeschwerde'), *reformatio in peius* cannot be ruled out altogether under the EPC, as it might serve as a means of avoiding unnecessary litigation, while still satisfying the legitimate expectations of the parties for a fair hearing.

6.2 Subject-matter under examination in opposition appeal proceedings

No part of a patent's subject-matter (eg individual claims) not opposed within the nine-month time limit can be reviewed in either opposition or appeal proceedings. The opponent's statement under R. 55 (c) EPC establishes the extent to which the patent is contested and thus the formal competence of the opposition division or board of appeal (**G 9/91** (OJ 1993, 408)). See also **T 323/94**.

According to **T 896/90**, detailed grounds for opposition for a single granted independent claim do not mean that only that part of the patent is being contested, if the opponent has indicated that he wants the whole patent revoked. However, in **T 737/92** the board found that an opposition was filed only to the extent that it was substantiated.

Where two opponents lodge appeals contesting different sets of claims and one subsequently withdraws its appeal, it becomes a party as of right under Art. 107 EPC and the other opponent becomes the sole appellant. The scope of the appeal is defined by the latter's request, which the non-appealing party may not exceed and which binds the board (**T 233/93**).

Where the patentee appeals the revocation of the patent, the board is not bound by the findings of the opposition division; the whole case, including those claims considered novel by the opposition division, and objected to by the non-appealing opponent, must be considered (**T 396/89**).

Claims which remain unchanged after the removal of the references in dependent claims need not be examined in opposition appeal proceedings to see if they contain grounds for opposition raised for the first time in those proceedings, unless the patentee consents (**T 968/92**).

Where a request is withdrawn during opposition proceedings and is thus not the subject of the contested decision, a virtually identical request filed during appeal proceedings is not the subject of the appeal, because the appellant is not adversely affected by the decision of the opposition division as far as this request is concerned (**T 528/93**).

Reviewing and eliminating any ambiguities in the claims and description which are not necessary to refute substantiated grounds of opposition is not part of the review of the contested decision carried out during opposition appeal proceedings. In the event of ambiguities in the claims which are not connected to changes in the granted documents, Art. 69 EPC stipulates that the description and drawings must be used to interpret the claims, not that the claims must be changed (**T 481/95**).

6.3 Patentability requirements under examination

6.3.1 In opposition appeal proceedings

The boards' scrutiny as regards the grounds for opposition is circumscribed by the notice of opposition filed by the opponent. The Enlarged Board established in **G 10/91** (OJ 1993, 420) that only those grounds for opposition already cited at the opposition stage could be considered on appeal. New ones could be introduced only with the consent of the patentee, whose power of veto applied regardless of their relevance.

The boards have considered the effects of the above ruling as regards three particular problems: the meaning of "ground for opposition"; how to proceed where a ground for opposition has been examined by the opposition division of its own motion; and, how to proceed where a ground for opposition has been put forward during opposition proceedings but for some reason not examined by the opposition division.

(a) Definition of new ground for opposition

The Enlarged Board of Appeal was called upon to define the legal concept 'grounds for opposition' in **G 1/95** and **G 7/95** (OJ 1996, 615 and 626).

Regarding new grounds introduced only at the appeal stage, the Enlarged Board ruled that by "a fresh ground for opposition" **G 10/91** meant a new legal basis for objecting to maintenance of the patent which was neither raised and substantiated in the notice of opposition nor introduced into the proceedings by the opposition division under Art. 114(1)

EPC in accordance with the principles set out in **G 10/91** (reasons 5.4).

Thus where a patent has been opposed on the grounds set out in Art. 100(a) EPC (ie the subject-matter is not patentable within the terms of Art. 52 EPC to Art. 57 EPC), but the opposition has only been substantiated on the grounds of lack of novelty (Art. 54 EPC) and lack of inventive step (Art. 56 EPC), the ground of unpatentable subject-matter based upon Art. 52(1) EPC and Art. 52(2) EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee. (See referring decision **T 937/91** (OJ 1996, 25)).

Moreover, in a case where a patent has been opposed under Art. 100(a) EPC on the ground that the claims lack an inventive step (Art. 56 EPC) in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Art. 52(1) EPC and Art. 54 EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lack novelty in view of the closest prior art document may be considered in the context of deciding upon the ground of lack of inventive step. (See referring decision **T 514/92** (OJ 1996, 270)).

T 18/93 and **T 796/90** are now overruled as regards the definition of new grounds for opposition. For an example of the application of these principles, see **T 105/94**.

An objection of lack of novelty is implicitly contained in a notice of opposition, where an earlier European application is submitted with the opposition, even though no comments as to novelty are made. This is because, according to Art. 56 EPC, second sentence, such state of the art cannot be considered in deciding whether there is an inventive step, and so can only be relevant to novelty. It is not, therefore, a new ground for opposition within the meaning of **G 7/95 (T 455/94)**.

Similarly, although objections concerning the requirements of Art. 123(2) EPC were not expressly pleaded under R. 55 (c) EPC, but formed part of the opposition division's decision, the board in **T 922/94** held that the objection under Art. 123(2) EPC formed part of the legal framework of the decision under appeal and the appellant could not rely on **G 10/91** for its request not to admit this ground into the appeal proceedings.

It is not certain from **G 9/91** or **G 10/91** whether grounds for opposition which were considered by the opposition division on submission by one opponent only and then taken up by a different opponent as the sole appellant can only be examined by the board with the patentee's consent (**T 758/90**, where this point did not have to be decided).

It is, however clear that other considerations arise where amended claims are proposed:

G 10/91 (OJ 1993, 420) stresses that amendments must be examined fully for compatibility with the EPC. Thus, where the respondents/opponents first raised an objection under Art. 100(b) EPC (insufficient disclosure) during the appeal proceedings to an **amended** claim, the appellants could not refuse permission to discuss the new ground (**T 27/95**).

In **T 922/94**, the board stressed that Art 102(3) EPC in conjunction with R. 66(1) EPC conferred wide powers upon the boards to consider all possible objections under the EPC, pleaded or not pleaded, that might arise from an **amendment** of the claims originally filed.

(b) Ground for opposition examined by the opposition division on its own motion

If an opposition division has examined of its own motion a ground for opposition, then the board of appeal is empowered to rule on it (see eg **T 309/92**, **T 931/91** and **T 1070/96**). In the latter decision, the board stated that since appeal proceedings aimed at a judicial decision upon the correctness of a decision of the department of first instance, it was irrelevant which opponent raised a particular objection or whether this particular opponent was still party to the proceedings, provided that the objection was dealt with in the decision under appeal.

However, the mere reference to Art. 100(c) EPC in the decision under appeal does not imply that the corresponding ground for opposition was introduced into the proceedings, if the decision under appeal did not deal in a substantial way with this ground for opposition (**T 128/98**).

(c) Ground for opposition put forward but not examined during opposition procedure

In **T 986/93** (OJ 1996, 215) the question arose as to whether the board could examine - even without the patentee's consent - a ground for opposition advanced only after expiry of the opposition period (ie in oral proceedings before the opposition division) and which the division therefore refused to consider under Art. 114(2) EPC. The board found that it was thus empowered, if it felt that the opposition division had not exercised its discretion properly. It interpreted opinion **G 10/91** to the effect that "new grounds for opposition" meant all those grounds not put forward until the appeal stage, rather than those - as argued by the appellant - not submitted within the opposition period under R. 55 (c) EPC or else disqualified by the opposition division under Art. 114(2) EPC. Even if the division chose not to consider a ground, it had still been brought forward during opposition proceedings and was therefore not "new". Furthermore, the board could also review the opposition division's decision not to consider it, and - if it felt the division had erred - exercise its own discretion and examine the ground in question after all.

In **T 274/95** (OJ 1997, 99) the board held that a ground for opposition which was substantiated in the notice of opposition but which was subsequently not maintained before the opposition division, if sought to be re-introduced during appeal proceedings was not a "fresh ground for opposition" within the meaning of opinion **G 10/91**, and could consequently be re-introduced into the appeal proceedings without the agreement of the patent proprietor, in the exercise of the board of appeal's discretion.

6.3.2 ex parte proceedings

In **G 10/93** (OJ 1995, 172) the Enlarged Board ruled that, where the examining division had refused an application, the board had the power to examine whether the application or the invention to which it related met the requirements of the EPC. This also held good for requirements the division had not considered in the examination proceedings or had

regarded as fulfilled. The board should then, where appropriate, decide either to rule on the case itself or send it back to the examining division.

This followed from the fact that ex parte review was not of a contentious nature. It involved examination of the patentability requirements in proceedings in which only one party - the applicant - was involved. The departments involved at every instance had to ensure that these requirements were fulfilled. In ex parte proceedings, therefore, the boards of appeal were not restricted either to examination of the grounds for the contested decision or to the facts and evidence on which that decision was based, and could include new grounds even though in ex parte cases too the main aim of appeal proceedings was to review the contested decision.

This decision was based on case **T 933/92**, in which an examining division had refused an application for non-compliance with Art. 123(2) EPC. Whilst sharing the examining division's view with respect to Art. 123(2) EPC, the board felt the application should be refused for lack of inventive step. In the board's view, the question whether grounds could be added or replaced was not resolved by **G 9/91** and **G 10/91**.

The extent of the obligation to review a case where the appeal is partially withdrawn is discussed in VII.D.11.

6.4 Facts under examination - applying Article 114 EPC in appeal proceedings

Parties have no right to determine what facts will be taken into account in a board's decision. On the contrary, Art. 114(1) EPC - which applies in appeals proceedings too - requires the board to establish the facts of its own motion (see **T 89/84** (OJ 1984, 562) and **J 4/85** (OJ 1986, 205), the former superseded in so far as the view was taken that a respondent's 'cross-appeal' was not necessary).

As the Enlarged Board made clear in **G 8/93** (OJ 1994, 887), the board's obligation under Art. 114(1) EPC exists only once proceedings are pending (see also **T 690/98**). Earlier, **T 328/87** (OJ 1992, 701) had already ruled that the facts could be investigated only if the appeal was admissible (reasons, 4, at the end). There are, however, limits to this obligation, for example under Art. 114(2) EPC, where facts and evidence are submitted late. The same applies if an opponent/respondent withdraws his opposition: in **T 34/94** the board found that, "if in the event of withdrawal of the opposition the opponent is the respondent, the board may take into account evidence which was submitted by the opponent prior to withdrawal of the opposition. However, for reasons of procedural economy, the duty of the EPO to examine the facts of its own motion pursuant to Art. 114(1) EPC does not extend to its having to examine the submission of the opponent that a previous oral disclosure took place if the crucial facts are difficult to ascertain without his co-operation". This confirmed the case law in **T 129/88** (OJ 1993, 598), **T 830/90** (OJ 1994, 713), **T 887/90**, **T 420/91** and **T 634/91**. See also **T 252/93**.

T 182/89 (OJ 1991, 391) sets out what the obligation to investigate involves: Art. 114(1) EPC should not be interpreted as requiring the opposition division or board of appeal to ascertain whether there was support for grounds for opposition not properly substantiated by an opponent, but as enabling the EPO to investigate fully the grounds for opposition which were

both alleged and properly substantiated pursuant to R. 55 (c) EPC (see also **T 441/91** and **T 327/92**).

T 60/89 (OJ 1992, 268, reasons, 3.1.1) held that when alleged facts put forward without proof as causing lack of novelty had occurred a long time previously and the question was no longer pursued by the parties it was not obliged to investigate the matter ex officio under Art. 114(1) EPC. Nor did the board in **T 505/93** consider itself obliged to carry out any further investigation when the opponents refused to take part in oral proceedings where the content of a prior use was to be clarified.

If first instance departments and/or parties fail to take account of highly relevant matter which is clearly available in the EPO file and which relates to a ground of opposition, the board's competence extends to rectifying the position by consideration of that matter provided, of course, the parties' procedural rights to fair and equal treatment are respected. This is not only consistent with Enlarged Board decisions **G 9/91** (OJ 1993, 408) and **G 10/91** (OJ 1993, 420), but incumbent on the board as the last instance in proceedings concerning the grant or maintenance under opposition of European patents (**T 385/97**). It enhances acceptance of the boards' decisions and their standing as the only judicial body ruling on patentability with effect for all the designated contracting states, if those decisions based on all material are submitted during the appeal proceedings. A document presented in such proceedings should therefore be taken into account if it is not completely irrelevant or at odds with considerations of procedural economy (**T 855/96**).

In **T 715/94** the board held that it was entitled to find novelty-destroying a document submitted but considered irrelevant before the examining and opposition divisions, as novelty had already been questioned and the document cited in the appellant's notice of opposition.

6.5 Arguments under examination

The question of whether a party has discharged its onus of proof in relation to the availability to the public of a document is an argument and not a new ground of appeal. The prohibitions or restrictions on additions to the extent to which a patent is opposed, the raising of a new ground for opposition or the introduction of new facts or evidence, do not apply to the admission of a new argument. Indeed, the very purpose of appeal proceedings, particularly oral proceedings, is to provide an opportunity for a losing party to throw new light on relevant aspects of matters which have been decided to his detriment and/or to draw attention to facts in the reasoning of the first-instance department that resulted in a decision adverse to him. This can, in practice, best be achieved by reliance on new arguments. Whilst it is desirable that all relevant arguments be brought at the earliest possible stage of the proceedings, there is no requirement in Art. 108 EPC that the statement of grounds of appeal be exhaustive as to the arguments to be brought (**T 86/94**).

Similarly, in **T 432/94** the appellant was allowed to redefine the problem to be solved by the invention. The board stated that it could not be concluded from Art. 108 EPC, third sentence, that an appellant was bound to the line of argument he used in the statement of grounds for the whole appeal proceedings; this dealt with an admissibility requirement and did not limit the matter in dispute in appeal proceedings.

6.6 Review of first-instance discretionary decisions

If the way in which a first-instance department has exercised its discretion on a procedural matter is challenged in an appeal, it is not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the first-instance department, and to decide whether or not it would have exercised such discretion in the same way as the first-instance department. A board of appeal should only overrule the way in which a first-instance department has exercised its discretion if the board concludes it has done so according to the wrong principles, or without taking into account the right principles, or in an unreasonable way (**T 640/91** (OJ 1994, 918); see also **T 182/88** (OJ 1990, 287), **T 986/93** (OJ 1996, 215), **T 237/96** and **G 7/93**).

7. Filing and admissibility of the appeal

According to Art. 108(1) EPC a notice of appeal must be filed in writing within two months after the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid. The content of the notice of appeal is established in R. 64 EPC.

If no notice of appeal has been filed within the time limit the question arises whether merely paying the fee for appeal constitutes a valid means of lodging an appeal. In **T 275/86** the board had held that payment with EPO Form 4212 05.80 should be accepted as such a notice since it contains essentially the same information as is required in a notice of appeal within the meaning of R. 64 EPC. However, the board in **J 19/90** stated that merely paying the fee for appeal does not constitute a valid means of lodging an appeal. This applies even if the object of the payment is indicated as being a "fee for appeal" relating to an identified patent application and the form for payment of fees and costs is used. This was confirmed in **T 371/92** (OJ 1995, 324), **T 445/98** and also **T 778/00** (OJ 2001, 554), where the board also added that the failure to indicate the provisions of R. 65 EPC in the annex dealing with the possibility of appeal does not make this incomplete or misleading. Nor does notification of the case number and the responsible board of appeal by the registry constitute a decision under R. 69(2) EPC recognising that an appeal is pending (**T 371/92** (OJ 1995, 324)). See also **T 1100/97** and **T 266/97**.

Unless the translation of the notice of appeal in an official language of the EPO is filed in due time, the notice will be deemed not to have been received according to Art. 14(5) EPC and the appeal not to have been filed (**T 323/87**, OJ 1989, 343).

7.1 Appealable decisions

Under Art. 106(1) EPC, first sentence, appeals lie against **decisions** of the EPO **departments** listed in that article. Whether a document constitutes a 'decision' or not depends on the substance of its content and not on its form (**J 8/81** (OJ 1982, 10); see also **J 26/87** (OJ 1989, 329), **J 13/92** and **T 263/00**). A 'decision' needs to involve a reasoned choice between legally viable alternatives (**T 934/91** (OJ 1994, 184)). The boards can hear appeals only against the decisions taken by other EPO departments (**J 12/85** (OJ 1986, 155)).

Appeal procedure

The case law of the boards of appeal has established that the following are not regarded as appealable decisions by other EPO departments:

(a) A request under R. 89 EPC for correction of a contested decision. Not until the request has been decided at first instance can the matter be referred to the board (**J 12/85** (OJ 1986, 155)).

(b) The preparatory steps referred to in Art. 96(2) EPC and R. 51(3) EPC (**T 5/81** (OJ 1982, 249)).

(c) An order by a director of a department of first instance (such as an opposition division) rejecting an objection to a member of the division on the ground of suspected partiality. The composition of the division can, however, be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under Art. 106(3) EPC (**G 5/91** (OJ 1992, 617)).

(d) A 'decision' by a director on a request for inspection of file. Only the Examining Division charged with the technical opinion (Art. 25 EPC) or the Formalities Officer pursuant to the Notice of the DG2 Vice-President (OJ 1984, 317, revised and supplemented in OJ 1989, 178 and 1999, 504) has the competence to decide on a request for inspection of file. Such a 'decision' under appeal is therefore void ab initio and the appeal inadmissible (**J 38/97**). See also **T 382/92**.

(e) A communication under R. 69(1) EPC (**J 13/83**).

(f) A letter bearing the letterhead of an EPO Directorate-General and signed by an EPO Vice-President, if it is evident from its content that it does not constitute a decision and from its form that it does not emanate from any of the departments listed in Art. 21(1) EPC (**J 2/93** (OJ 1995, 675)).

(g) The minutes of oral proceedings (**T 838/92**). A correction to minutes of oral proceedings made on the initiative of the opposition division was not directly appealable (**T 231/99**).

(h) A communication from the opposition division finding that an opposition has been validly filed, and stating that the decision will be taken on that point at the oral proceedings (**T 263/00**).

T 26/88 (OJ 1991, 30), which held that a document stating that the patent was revoked under Art. 102(4) EPC and Art. 102(5) EPC did not constitute a decision, was overruled by **G 1/90** (OJ 1991, 275).

Under Art. 106(3) EPC a decision which does not terminate proceedings as regards one of the parties (interlocutory decision) can only be appealed together with the final decision, unless the decision allows separate appeal. Separate appeal is possible against interlocutory decisions regarding admissibility of the opposition (eg **T 10/82**, OJ 1983, 407) or maintenance of a patent in amended form (see eg **T 247/85** and **T 89/90** (OJ 1992, 456)).

An appeal was however found admissible where it was directed against a formalities officer's letter rejecting the opposition as inadmissible because it was not filed within the nine-month time limit. It did not matter whether formally the letter was a "decision"; what counted was its substance, not its form. Nor did it matter that the decision was taken not by the opposition division but by a formalities officer on its behalf, that being in accordance with the allocation of duties devised by the EPO for its own operational efficiency (**T 1062/99**).

In **J 3/95** (OJ 1997, 493) the Legal Board of Appeal referred to the Enlarged Board of Appeal the question of what administrative or jurisdictional measures should be taken in response to requests aimed at the revision of a decision taken by a board of appeal with the force of *res judicata*. In **T 456/90** the board of appeal had revoked a patent, without taking account of the patent proprietor's proposal to amend its claims in the light of possible objections by the board of appeal. The patent proprietor had then submitted two requests to the board. The first was for re-establishment of rights and the second was to have the entry recording the revocation of the patent deleted from the Register of European Patents. The chairman of the board of appeal that took the decision and subsequently the Vice-President responsible for the boards of appeal had both informed the professional representative that no action could be taken in response to the requests, since **T 456/90** was final and not subject to review. Having received these replies, the patent proprietor filed the same requests with the EPO Legal Division, which stated that it had no powers to decide on them. The patent proprietor had thereupon filed an appeal against the Legal Division's decision, and this had given rise to the decision in question, which referred questions on the matter to the Enlarged Board of Appeal. The Enlarged Board, in **G 1/97** (OJ 2000, 322), answered as follows:

1. In the context of the EPC, the jurisdictional measure to be taken in response to requests based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal having the force of *res judicata* should be the refusal of the requests as inadmissible.
2. The decision on inadmissibility is to be issued by the board of appeal which took the decision forming the subject of the request for revision. The decision may be issued immediately and without further procedural formalities.
3. This jurisdictional measure applies only to requests directed against a decision of a board of appeal bearing a date after that of the present decision.
4. If the Legal Division of the EPO is asked to decide on the entry in the Register of European Patents of a request directed against a decision of a board of appeal, it must refrain from ordering that the entry be made if the request, in whatever form, is based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision of a board of appeal.

This decision was followed in **J 16/98** and **J 3/98**.

7.2 Board competent to hear a case

The responsibilities and composition of boards are laid down in Art. 21 EPC. In **G 2/90** (OJ

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1992, 10) the Enlarged Board made it clear that under Art. 21(3)(c) EPC, the Legal Board of Appeal is competent only for appeals against decisions taken by an examining division consisting of fewer than four members and which do not concern refusal of the application or grant. In all other cases, ie those covered by Art. 21(3)(a) EPC, Art. 21(3)(b) EPC and Art. 21(4) EPC, the technical boards are competent. The provisions of Art. 21(3) EPC and Art. 21(4) EPC governing responsibilities and composition are not affected by R. 9(3) EPC.

An appeal from a decision of an examining division refusing a request under R. 89 EPC for correction of the decision to grant is to be decided by a technical board of appeal (**G 8/95** (OJ 1996, 481), overruling **J 30/94**).

An appeal against the decision of the examining division refusing a request for corrections under R. 88 EPC filed after grant of the patent, on the other hand, is to be decided by the Legal Board of Appeal. The appeal concerned the preliminary question of whether a request under R. 88 EPC could be made after grant. This was purely a question of law, and did not concern the refusal of a European patent application or the grant of a European patent. It was also consistent with **G 8/95**, as answering the preliminary question did not involve any consideration of the text with which the patent should be granted (**J 42/92**).

7.3 Entitlement to appeal

7.3.1 Entitlement to appeal - formal aspects

Under Art. 107 EPC, an EPO decision can be appealed only by a party to the proceedings which gave rise to it.

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

In **T 340/92** the appellant was a company that had obviously been named in the notice of appeal by mistake, instead of a subsidiary, which was the real opponent. The actual appellant was the only party adversely affected by refusal of the opposition, and was readily identifiable through its representative, who was named in the appeal dossier. The board held that this deficiency could be remedied under R. 65(2) EPC.

In **T 272/95** (OJ 1999, 590) the following questions were referred to the Enlarged Board of Appeal:

I. Is an opposition admissible which otherwise meets the requirements of Art. 99 EPC and R. 55 EPC if it is filed jointly by two or more persons and only one opposition fee is paid?

II. If the answer to question I is in the affirmative and a common representative was named under R. 100(1) EPC in the notice of opposition, is an appeal valid even if it is not filed by this person?

III. If the answers to questions I and II are in the affirmative, which other requirements, if any, have to be met by a joint opposition or a joint appeal in order to safeguard the rights of the

patent proprietor?

The matter is pending under **G 3/99**.

7.3.2 Party adversely affected

Under Art. 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected if the decision does not accede to his main requests or to auxiliary requests preceding the allowed auxiliary request (**T 234/89** (OJ 1989, 79), **T 392/91**). This is not the case if the patent proprietor withdraws his main request or preceding auxiliary requests and agrees with the allowed auxiliary request (**T 506/91**, **T 528/93** and **T 613/97**). In these cases the patent had been maintained in amended form by the opposition division. For more details about the relationship between main and auxiliary requests, see also p. 342. To establish whether a party has been adversely affected, it is necessary not only to compare his objective with the substance of the decision but also to check that he was thus affected at the time the contested decision was delivered and the appeal filed (see **T 244/85**, OJ 1988, 216).

In **T 298/97** (OJ 2002, ***), the board held that where the notice of appeal is filed by an adversely affected party but the grounds of appeal are filed by a natural or legal person who, although having economic connections with that adversely affected party, is not itself that party, the appeal cannot be held admissible.

(a) Applicant

In **J 12/83** (OJ 1985, 6) the board found that an applicant for a European patent might be "adversely affected" within the meaning of Art. 107 EPC by a decision to grant the patent, if the patent was granted with a text not approved by him under Art. 97(2)(a) EPC and R. 51(4) EPC. In **J 12/85** (OJ 1986, 155) the board held that he could be "adversely affected" within the meaning of Art. 107 EPC only if the grant decision was inconsistent with what he had specifically requested (see also **T 114/82** and **T 115/82** (both in OJ 1983, 323) and **T 1/92** (OJ 1993, 685)). **J 5/79** (OJ 1980, 71) ruled that an applicant whose priority right was found to have lapsed because he failed to file the priority documents was no longer adversely affected if re-established in his rights before the application was published.

An applicant was 'adversely affected' and thus able to file an appeal where the Examining Division had rectified its decision but refused to grant reimbursement of the appeal fee (**J 32/95** OJ 1999, 713).

The grounds forming the basis of a decision on rectification should not be interpreted to mean only the legal basis of the decision, but also the factual reasons supporting the legal basis. An applicant adversely affected by the factual basis was thus considered adversely affected in **T 142/96**.

(b) Patent proprietor

In **T 73/88** (OJ 1992, 557) the board ruled that if a patentee's request that his patent be

maintained was upheld by a decision of the opposition division, he could not appeal against adverse reasoning in the decision (here, regarding his claim to priority) because he was not adversely affected by it within the meaning of Art.107 EPC.

In **T 457/89**, by analogy with **G 1/88** (OJ 1989, 189), the board took the view that the appellant/patentee was adversely affected by the decision revoking his patent, despite failing to comment on a communication within the time specified in an opposition division's invitation under Art. 101(2) EPC and R. 58(1) EPC to R. 58(3) EPC. For according to **G 1/88**, wherever non-compliance could lead to loss of rights the EPC always expressly indicates this and Art. 101(2) EPC makes no provision for any loss of rights.

(c) Opponent

Under R. 58(4) EPC, before the opposition division decides on the maintenance of the patent in amended form, it shall inform the parties of its intention to do so and shall invite them to state their observations if they disapprove of the text.

The application of this rule by the department of first instance (see Guidelines of March 1985, D-VI, 6.2.1) and also in many appeal proceedings led to a referral to the Enlarged Board in **T 271/85** (OJ 1988, 341). In **T 244/85**, for example, the board had held that silence in respect of a communication within the meaning of R. 58(4) EPC was to be interpreted as a sign of agreement to maintenance of the patent in the proposed form; an appeal by an opponent who had not notified his disagreement to maintenance of the patent as amended within the time limit under R. 58(4) EPC was inadmissible, because he could not claim to have been adversely affected. The point of law referred to the Enlarged Board was: "Is the appeal of an opponent admissible in a case where, following notification of the communication pursuant to R. 58(4) EPC, he fails to make any observations within one month if he disapproves of the text in which it is intended to maintain the patent?" (The time limit is now two months).

The Enlarged Board found in **G 1/88** (OJ 1989, 189) that the fact that an opponent had failed, within the time allowed, to make any observations on the text despite an invitation to do so under R. 58(4) EPC did not render his appeal inadmissible.

It reasoned that to regard silence as betokening consent would be tantamount to withdrawal of the opposition with consequent surrender of the right to appeal. Surrender of a right could not, however, be simply presumed. Deeming silence to be equivalent to surrender would also be inconsistent with the logic of how the EPC operated, since it would be at odds with its basic drafting philosophy and with the way in which it dealt with losses of rights. Where the legal consequence of an omission was to be a loss of rights, this was expressly stated. It also had to be remembered that under Art. 164(2) EPC the Implementing Regulations had always to be interpreted in the light of the EPC. Consequently, the interpretation of the Implementing Regulations which corresponded most closely to the principles of the EPC prevailed. It was a principle of the EPC, however, that parties' rights were safeguarded by the possibility of appeal to at least one higher-ranking tribunal. The Implementing Regulations should therefore be construed in such a way that R. 58(4) EPC was not allowed to interfere with the right of appeal under Art. 106 EPC and 107 EPC. The teleological interpretation, that is to say interpretation in the light of the sense and purpose of the procedure under R. 58(4) EPC, lead

to the same goal.

In **T 156/90** the opponent had stated that he would have no objection to maintenance of the patent if the claims were amended in a specified way. The patent proprietor amended the claims accordingly. However, the opponent appealed against the interlocutory decision maintaining the patent as thus amended, arguing that the circumstances had changed and he was no longer bound by his consent. The appeal was dismissed as inadmissible.

In **T 266/92**, on the other hand, the opponent had declared in opposition proceedings that he would withdraw his request for oral proceedings if the patentee agreed to an amended wording of the patent, as indeed he did. The opposition division maintained the patent in amended form. The opponent appealed, requesting that the patent be revoked. The patentee took the view that the opponent had not been adversely affected because by withdrawing his request for oral proceedings he had implicitly approved the wording of the patent. The board of appeal disagreed, holding that withdrawal of a request for oral proceedings did not in itself imply withdrawal of any other existing request. There might be reasons other than consent - such as a wish to save costs or obtain a quicker decision - for a party who originally asked for oral proceedings to drop his request. Accordingly, the board concluded that the appellant was adversely affected within the meaning of Art. 107 EPC, and was entitled to appeal.

In **T 299/89** the board considered the extent of entitlement to appeal of an opponent who in his opposition had requested only partial revocation but in his appeal wanted the whole patent revoked. It decided that this was determined by the scope of the original request made in the opposition. The opponent was only adversely affected within the meaning of Art. 107 EPC to the extent that this request was not granted, and he could not on appeal file a wider request.

An opponent is not adversely affected by obiter dicta reasons given in a revocation decision and favourable to the patent proprietor, and which it is appropriate for the opposition division to include to obviate remittal in the event of revocation being reversed on appeal (**T 473/98** (OJ 2001, 231)).

In **T 273/90** the board concluded that legal uncertainty arising from inadequate adjustment of the description to amended claims constituted sufficient grievance under Art. 107 EPC, as the commercial interests of the appellant/opponent could be adversely affected (likewise **T 996/92**).

In **T 833/90** the board held that an appeal should be considered admissible if it was not clear or ascertainable whether the opponent/appellant had agreed to maintenance of the patent.

7.4 Form and time limit of appeal

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

For a notice of appeal to comply with Art. 108 EPC, first sentence, and R. 64(b) EPC, it must express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, ie conditional on the main request not being allowed by the department of first instance, is therefore inadmissible. This is because there should be legal certainty as to whether or not a decision is contested in view of, firstly, the time limit under Art. 108 EPC, secondly, the further steps to be taken by the first instance under Art. 109 EPC, and particularly in view of the suspensive nature of the appeal under Art. 106(1) EPC (**J 16/94** (OJ 1997, 331), confirmed by **T 460/95** (OJ 1998, 588)).

7.4.1 Form and content of notice of appeal

(a) Rule 64(a) EPC

In decision **T 483/90** the board held that the appellants were sufficiently identified if, in the notice of appeal, their name was incorrectly given and their address was missing but the number of the contested patent and the name and address of the professional representative were the same as those cited in previous proceedings and the appellants were referred to as the opponents in those proceedings. In **T 1/97** the board held that the notice of appeal should contain the true name of the appellant. If not, the deficiency could be corrected under R. 65(2) EPC.

In **T 613/91** the appellant's precise address was missing from the notice of appeal, but was known to the parties and the board from the opposition proceedings. The board held that there was sufficient information for identification within the meaning of R. 64(a) EPC.

In **T 867/91** the notice of appeal designated the patent in suit by its number and the decision under appeal by its date. It also contained the name of the patentee, as well as the name and address of the appellant's representative. It did not contain the address of the appellant and did not expressly state that the patentee was the appellant. The board held that the requirements of R. 64(a) EPC had been met since the notice of appeal provided sufficient information to identify the appellant and his address.

However, correction of the name of the appellant to substitute a natural or legal person other than the one indicated in the appeal is allowable under R. 65(2) EPC in conjunction with R. 64(a) EPC, if it was the true intention to file the appeal in the name of said person and if it could be derived from the information in the appeal, if necessary with the help of other information on file, with a sufficient degree of probability that the appeal should have been filed in the name of that person (**T 97/98** (OJ 2002, ***)).

(b) Rule 64(b) EPC

If the extent to which cancellation of the decision is requested is not expressly stated in the notice of appeal, the board will examine whether the relevant information can be determined from the totality of the appellant's submissions (see **T 7/81** (OJ 1983, 98) and **T 32/81** (OJ 1982, 225); see also **T 932/93**, **T 372/94**).

In **T 85/88** the appellant had filed the notice of appeal in due time. However, the statement

identifying the extent to which cancellation of the decision was requested, required by R. 64(b) EPC, was only submitted after expiry of the period for appeal. The board held that the extent of the request made on appeal could be inferred interpreting the notice of appeal in an objective way (see also **T 1/88**).

T 631/91, **T 727/91** and **T 273/92** confirmed the principle that the appeal's scope can be ascertained from the appellant's overall submissions if the request filed in the appeal proceedings does not make this clear. Since no indication was made to the contrary in the appellant's submissions, the board of appeal assumed that he wished to file a request in the appeal proceedings along the same lines as that filed in the opposition proceedings (see also **T 925/91** (OJ 1995, 469) and **T 281/95**).

According to **T 194/90**, this principle also applies where an appellant/patentee appeals against revocation of his patent by the opposition division but without formally specifying his request. He is then regarded as maintaining unchanged the request made at the opposition stage.

In **T 632/91** the notice of appeal did not explicitly identify the extent to which amendment or cancellation was requested of the decision under appeal, which refused the sole version of the patent application. The board found that the wording "... we hereby file notice of appeal to the decision ..." had to and could only be construed as a request to set aside entirely the decision under appeal and to grant a patent on the basis of the documents of the European patent application to which the decision under appeal referred. The appeal thus fulfilled the requirements of R. 64 (b) EPC and was admissible.

It is sufficient to establish admissibility of an appeal to put forward requests, accompanied by reasons why the decision under appeal does not meet the requests filed in the grounds of appeal (**T 445/97**).

7.4.2 Appeal filed within the time limit

In **T 389/86** (OJ 1988, 87) the board stated that an appeal which is filed after pronouncement of a decision in oral proceedings but before notification of the decision duly substantiated in writing complies with the time limit pursuant to Art. 108 EPC, first sentence.

7.5 Statement of grounds of appeal

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

7.5.1 General principles

In two decisions the boards of appeal established the principles applicable to statements of grounds.

In **T 220/83** (OJ 1986, 249) the board ruled that the grounds for appeal should specify the legal or factual reasons on which the case for setting aside the decision is based. The

arguments must be clearly and concisely presented to enable the board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the appellant bases his arguments, without first having to make investigations of their own. Whilst passages from the literature setting out the state of the art may - provided sufficiently precise reference is made to them in the grounds of appeal - be considered an integral part of the grounds, they cannot by themselves form a sufficient statement of grounds. This principle was expressly confirmed in many decisions, for example **T 250/89** (OJ 1992, 355), **T 1/88**, **T 145/88** (OJ 1991, 251), **T 102/91**, **T 706/91**, **T 493/95**, **T 283/97** and **T 500/97**.

Further to these decisions, in **T 213/85** (OJ 1987, 482) the board stated that grounds sufficient for the admissibility of an appeal must be analysed in detail vis-à-vis the main reasons given for the contested decision. If an opposition had been dismissed on the grounds of insufficient substantiation and the grounds for appeal merely disputed patentability without elaborating on the admissibility of the opposition, the appeal was inadmissible for lack of adequate substantiation (see also **T 169/89**).

Other decisions have since added to or applied these principles.

Grounds within the meaning of Art. 108 (2) EPC could be deemed to be sufficient if new facts were submitted which removed the legal basis from the decision. That also applied where the grounds for opposition were based on new facts and there was no discussion whatsoever of the grounds for the opposition division's decision (**T 252/95**).

In **T 45/92** the appellant disputed the accuracy of the decision of first instance because a mistake had been made when assessing inventive step. The board considered the appeal inadmissible for lack of grounds as the mistake was not very serious and the contested decision had only been based inter alia on this mistake, and the appellant had not discussed other considerations with respect to inventive step.

In **T 3/95** the opposition division had rejected the opposition, which was based on Art. 100(a) EPC. The opponent based his appeal on the argument that the problem was not disclosed and not solved and that the requirements of Art. 83 EPC were not met. The board found the appeal to be admissible since the second argument, although specifically referring to Art. 83 EPC, related not only to the sufficiency of disclosure but also to inventive step insofar as the problem and solution approach required that the problem to be solved be defined objectively, ie in such a way for it to be credible that this problem was solved by the claimed subject-matter.

The fact that the points made in the statement of grounds of appeal do not go beyond those made before the opposition division does not detract from the admissibility of an appeal. A requirement that new arguments be submitted to render an appeal admissible would imply that the appealed decision must have been correct. Nor need the appeal have a strong prospect of success. Moreover, the subsequent withdrawal of a relevant objection already substantiated in the statement of grounds of appeal cannot retrospectively detract from the admissibility of the appeal as filed (**T 644/97**). Irrelevancy and lack of cogency may lead to an unsuccessful outcome of the appeal, but do not of themselves render it inadmissible

(T 65/96).

7.5.2 Exceptions to these principles

In some cases, boards have considered appeals to be admissible even if their grounds did not meet the requirements described above.

(a) Appeal does not give detailed reasons

In **J 22/86** (OJ 1987, 280) the board made it clear that where the written statement did not contain such full reasons, the requirement for admissibility might be regarded as satisfied if it was immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside.

In **T 1/88** the board considered that the criteria of **T 220/83** and **T 213/85** were satisfied by a statement of grounds in which it was merely argued by the appellant that a document, which allegedly showed that the process of the patent in suit was obvious, had not been properly evaluated. The question of inventive step, on the lack of which the contested decision had been partly based, was not dealt with in detail.

In **T 925/91** (OJ 1995, 469) the board held that if the opposition division had considered the merits of a case but nevertheless rejected the opposition as inadmissible, and if the appellant had only dealt with the substantive arguments in his statement of grounds for appeal, the grounds for appeal were not adequately defined (see **T 213/85**, **T 169/89** and **T 534/89**). However, since the action of the opposition division was erroneous and misleading (its decision having examined the substance of the opposition although considering it inadmissible), the principle of good faith (**G 5/88**) dictated that the appeal should nevertheless be held to be admissible.

In **T 574/91** the appellant merely argued that the opposition division "had missed the point", without discussing the reasons for the decision. The board considered this statement of grounds admissible even though it did not discuss any of the arguments in the contested decision and the sole argument put forward bore no connection with the decision. In the absence of such specific objections on the part of the appellant, the appeal in this case was limited to a review of the grounds for revocation of the patent.

In **T 961/93** the board took the view that the opponent's appeal was sufficiently substantiated if the sole ground for the appeal was that the patent proprietor had submitted a request for the patent to be revoked (see also **T 459/88**, OJ 1990, 425).

In **T 898/96** an applicant did not approve the text of the patent (R. 51(4) EPC), but requested grant with an amended text. The examining division refused the application. On appeal the applicant stated that the appeal was "substantiated by the fact that the grant of the patent is now requested in the form that was previously allowed (see case **T 139/87**, OJ 1990, 69)." The appeal was held admissible.

(b) Appeal is based only on facts which existed already at the time the first instance

proceedings took place but which were not put forward during the proceedings (fresh case)

In **T 611/90** (OJ 1993, 50) the statement of grounds developed an entirely fresh case on lack of novelty based on a public prior use first put forward in the appeal stage and did not discuss the reasons upon which the contested decision was based. The board considered the appeal to be admissible because the fresh reasons presented, though unconnected with those in the decision under appeal, were still within the same opposition ground (see also **T 938/91**, **T 3/92**, **T 219/92**, **T 229/92**, **T 847/93**, **T 708/95**, **T 191/96**).

An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions **G 9/91** and **G 10/91** (OJ 1993, 408 & 420), according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible (**T 1007/95** OJ 1999, 733).

(c) Appeal is based only on evidence first introduced with the appeal even if it already existed and was known at the time the first instance proceedings took place

In **T 389/95** an appeal was filed on existing grounds for opposition but based solely on new evidence introduced in the grounds of appeal. The board found the appeal to be admissible because the issue of new factual framework was one of fact to be determined objectively as part of the substantive examination of the appeal. In the board's view, it followed from the fact that opinion **G 10/91** allowed even a fresh legal ground for opposition to be considered in appeal proceedings if the patentee approved, that an appeal based solely on such a ground was not ipso facto inadmissible; by the same token an appeal based on the same legal ground, albeit on a completely fresh factual framework, might be admissible.

(d) Appeal is only based on new requests

The board of appeal held in **T 729/90** that an appeal could be admissible if, despite its not being clear from the statement of grounds why the contested decision was incorrect, claims were put forward in auxiliary requests which overcame the objections of the department of first instance (see also **T 105/87** and **T 563/91**). For the question of whether the appellants are adversely affected see VII.D.7.3.2.

An appeal requesting maintenance in full of the patent in suit, yet submitting a new amended claim was found admissible in **T 162/97**. It was clear from the statement of grounds that the appellant considered the reasoning in the decision under appeal no longer applied in view of the amended claim. The statement of grounds also explicitly indicated a causal link between the amended claim and the reasons given in the decision under appeal.

However, where an application is refused under Art. 97 EPC and R. 51(5) EPC, on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to R.51(4) EPC nor proposed amendments within the meaning of R. 51(5) EPC within this period, a statement of the grounds of appeal which deals only with the issues of the admissibility and allowability of new claims filed with the statement is

inadmissible (**T 733/98**).

7.5.3 Change of circumstances after delivery of the decision

The above principles cannot be applied in cases where the facts change after the decision has been reached, so that the decision is based on reasons which are no longer valid.

In **J ./87** (OJ 1988, 323) the board considered that the grounds on which the appellant relied, although based on a new fact which it would have been more appropriate to refer to the first instance, represented sufficient grounds of appeal, given that if this new fact was confirmed, the contested decision would no longer have had any legal basis.

In **J 2/87** (OJ 1988, 330) and **T 195/90** the board took the view that the minimal requirements of Art. 108 EPC were satisfied when the notice of appeal could be interpreted as containing a request for rectification of the decision concerned on the grounds that, since the conditions enunciated in an earlier communication from the EPO were now fulfilled, the decision was no longer justified.

The circumstances must already have changed by the time the statement of the grounds of appeal is filed. In **T 22/88** (OJ 1993, 143), the board held that a written statement announcing only that the appellant will complete an omitted act does not comprise sufficient reasons, and therefore does not constitute a valid statement of the grounds of appeal. According to **T 387/88** it is sufficient to state that the act whose omission formed the basis of the decision has now been completed.

7.5.4 Reference to an earlier submission

The boards are often faced with the question of whether a statement of grounds which refers to submissions made in the first-instance proceedings is sufficient. In principle, a statement of grounds which merely refers generally to previous submissions is not considered sufficient (see **T 254/88**, **T 432/88**, **T 90/90**, **T 154/90** (OJ 1993, 505), **T 287/90**, **T 188/92**, **T 646/92**). The few decisions recognising such submissions as possible grounds for an admissible appeal concerned special cases in which the arguments presented at first instance already adequately addressed the grounds underlying the contested decision. Whether a statement of grounds met the requirements of Art. 108 EPC could only be decided on a case-by-case basis (**T 165/00**).

Some earlier decisions accepted referral to earlier submissions as sufficient, for example **T 355/86** and **T 140/88**. In **T 725/89** a written submission to the opposition division, commenting on the result of the oral proceedings and received by the opposition division before it sent out its written decision, was used as the statement of the grounds of appeal and was accepted by the board as a valid statement of grounds.

7.5.5 References to other documents

The question has also arisen as to whether a reference to other documents is an adequate statement of grounds.

Where attention was drawn in the statement of grounds to a passage in the description, but no submissions made in support of the allowability of the claim, the statement of grounds was held inadmissible **T 145/88** (OJ 1991, 251).

However, where the appellants alleged lack of inventive step, merely referring generally to several documents, the statement of grounds was held to be sufficient, as the conclusions which the appellants wished to be drawn from these documents were evident (**T 869/91**).

8. Conclusion of the decision-making process

8.1 Closure of the substantive debate

The EPC does not prescribe when the substantive debate should be regarded as closed. Particularly if oral proceedings take place but end without a decision being delivered, it often has to be decided whether or not subsequently filed documents should be taken into consideration. A distinction needs to be made between the following situations:

(a) the board does not announce its decision at the end of the oral proceedings, but reserves the right to deliver its decision subsequently in writing, but without explicitly stating that the debate is closed;

(b) the board declares at the end of the oral proceedings that the debate is closed and announces that the decision will follow in writing.

In the first case, the boards generally find that submissions filed after the oral proceedings are out of time and can be considered only if they are relevant (Art. 114(2) EPC). See, for example, **T 456/90** and **T 253/92**.

In the second case, two solutions have been adopted by the boards. One - adopted in **T 762/90** - consists of stating under "Summary of facts and submissions" that a document was filed after closure of the debate and that the board will not consider it. Under this option, the document is automatically excluded from the file. This solution was also adopted in **T 411/91**.

The other solution - adopted in **T 595/90** (OJ 1994, 695) - is to rule that submissions filed after closure of the debate cannot be taken into account unless the board decides to reopen the debate. Under this option the submission has by implication to be examined.

8.2 Decision taken as the file stands

In **T 784/91** the board took the view that if in ex parte proceedings the appellant indicated that he did not wish to comment on the case, this could be construed as signifying agreement to a decision being taken on the case as the file stands.

8.3 Proceedings after delivery of the decision

In **T 843/91** (OJ 1994, 818) of 17.3.1993 it was stated that once a decision had been taken the board was no longer empowered or competent to take any further action apart from

drafting the written decision (see also **T 296/93** (OJ 1995, 627), where the board disregarded statements filed after the announcement of the decision, and **T 515/94**). In **T 304/92** the respondent's request to file new claims after the chairman had announced the board's decision was rejected, but recorded (with the response) in the summary of facts.

However, in **T 212/88** (OJ 1992, 28) a request for apportionment of costs submitted after the substantive decision had been announced at the end of the oral proceedings was, exceptionally, admitted. Although the practice of the boards was that all requests by parties, including any request as to costs, should be made before any decision was announced in oral proceedings, this practice had not been published and so there was no reason why parties or their representatives should be aware of it. In **T 598/92** an error in a claim was corrected at the request of the appellant one day after the decision was delivered at the end of oral proceedings.

8.4 Interlocutory decisions of a board

The finding that an appeal is admissible may be given in an interlocutory decision. Art. 110(1) EPC and R. 65 EPC show that the boards have to examine whether an appeal is admissible before considering its merits. An interlocutory decision might be appropriate where the points of law concerning admissibility are of general significance and require a speedy decision (**T 152/82** (OJ 1984, 301), see also **T 109/86** of 20.7.1987).

The boards have also issued interlocutory decisions on re-establishment in respect of the time limits for appeal (**T 315/87** of 14.2.1989, **T 369/91** (OJ 1993, 561)), on the admissibility of an opposition (**T 152/95** of 3.7.1996), and to inform the public rapidly (pending the final decision) that a mention of grant in the European Patent Bulletin was incorrect because of the appeal's suspensive effect (**J 28/94**, OJ 1995, 742). Referral of a point of law to the Enlarged Board is also an interlocutory decision.

9. Remittal to the department of first instance

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

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

If there is no excuse for the late introduction of the document, but the outcome of the appeal is nevertheless unfavourable to the party which introduced it, then remittal is not ordered, as depriving the party of the opportunity to have the issues considered at two instances is not unfair in such a case (see **T 416/87** (OJ 1990, 415), confirmed in **T 626/88** and **T 527/93**).

If no new documents are introduced, but merely arguments presented from a different point of view, or if the claims are maintained on the basis of an auxiliary request which the

department of first instance has already indicated that it would be prepared to accept, then the desideratum of keeping the procedure as short as possible requires that there should be no remittal (**T 5/89** (OJ 1992, 348), **T 392/89** of 3.7.1990 and **T 137/90**).

The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under R. 86(3) EPC, final sentence. In a case where substantial amendments to the claims are proposed on appeal, which require substantial further examination, the case should be remitted to the examining division. In this way, the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under R. 86(3) EPC, and in relation to the formal and substantive allowability of the amended claims (see leading decision **T 63/86**, OJ 1988, 224). Several boards of appeal have applied this case law in their decisions: **T 200/86**, **T 296/86**, **T 98/88**, **T 423/88**, **T 501/88**, **T 47/90** (OJ 1991, 486).

Remittal to the department of first instance is normally also ordered where a substantial procedural violation occurred in the first instance proceedings (**T 125/91** and **T 135/96**), even where the violation affects only one of two opponents (**T 125/91**). This is required by Art. 10 RPBA, which provides that a board shall remit the case to the first instance if a fundamental deficiency is apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise (**T 135/96**). Infringement proceedings before the German courts did not constitute a special reason in **T 914/98**, where the board held that the fundamental right of the appellants to a fair hearing before the opposition division had to outweigh any advantage that might accrue to the respondents by having the board deal fully with the case rather than remit it.

Remittal is, however, not appropriate in all cases:

In **T 679/97**, despite a substantial procedural violation by the opposition division, the board decided not to remit, in view of the interest of the parties in having the case finally decided.

In **T 274/88** the board agreed that where an irregularity has been remedied during appeal proceedings, the matter should still normally be remitted to the department of first instance. However, in this particular case, which was *ex parte*, the board did not remit because, after correction, the subject-matter of the application was patentable, the appellants had expressly waived their right to have the issues considered at two instances, and the examining division had already indicated that it was favourably disposed on the question of patentability.

Nor does there seem to be an absolute right to have an issue decided upon by two instances. According to **T 83/97** it is not mandatory for the appellate instance to remit every time a fresh case is raised before it, ie the right to two instances might not in each and every procedural situation be an absolute right of the parties concerned. (In fact, the matter was remitted as the board found that it would have been a violation of Art. 113 EPC to have given a final decision on all outstanding substantive matters against the requests of the parties, who had had no advance warning of such a procedural possibility, and in view of the long-standing practice of the boards of appeal).

Similarly, in **T 249/93** the board held that remittal lay within the discretion of the board. Where

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remittal might mean that a final decision was not reached until after the expiry of the patent, the board would be inclined to decide the issue itself, unless there were strong reasons for not doing so.

Art. 32 TRIPS does not limit the board's discretion concerning remittal either. In **T 557/94** the board held that Art. 32 TRIPS (which provides for the judicial review of any decision to revoke a patent) did not oblige the reviewing instance to remit the case to the department of first instance, where the first instance did not revoke the patent and the reviewing instance intended to deviate from the decision of the first instance. Art. 111 EPC empowered the board to decide on the merits of the case without restriction and it would be alien to at least the majority of legal systems in the EPC contracting states to limit the power of the reviewing instance in such a way that - dependent upon the 'result' of the decision under attack - it would be bound to remit the case to the first instance. Nor could it be assumed that the states negotiating TRIPS intended the introduction of such a limitation.

Remittal to the department of first instance to bring the description into line with amended claims should be avoided if at all possible for reasons of procedural economy, and although Art. 111(1) EPC permits it (**T 977/94**).

In the interests of overall procedural economy and effectiveness, the board in **T 473/98** (OJ 2001, 231) also found it entirely appropriate and desirable that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC employing the standard decision formula, by way of obiter dicta, findings which could obviate a remittal in the event of the revocation being reversed on appeal. See also **T 915/98**. In **T 275/99** the board stated that, from a purely procedural point of view, no objection could be made to the fact that the Examining Division had left open in the appealed decision the issue of inventive step, and the case was remitted.

Although both the appellant and the respondents wished the board to make a final decision rather than remit the case to the opposition division, the board in **T 869/98** refused, pointing out that it is not normally the function of the appeal board to consider and decide upon questions which were raised for the first time during the appeal proceedings. As there had been no assessment of inventive step at all during the written appeal proceedings, the board exercised its discretion under Art. 111(1) EPC and referred the case back to the opposition division.

In **T 887/98**, on the other hand, the board held that remittal was not justified: *pace* the applicant/appellant, he had indeed been able to put forward his arguments in proceedings at both first and second instance, and had been given plenty of time to study a document (D2) before the oral proceedings. Furthermore, the examining division had found another document to be prejudicial to inventive step, so introducing D2 into the proceedings before it would not affect its decision. For these reasons, plus considerations of procedural economy, the board refused the appellant's request for remittal.

10. Binding effect

10.1 General principles

Under Art. 111(2) EPC the EPO department of first instance is bound by the ratio decidendi of the board of appeal if the case is remitted to the department whose decision was appealed in so far as the facts are the same.

The problem of being bound by an earlier board of appeal decision where a case is remitted also arises in connection with a subsequent appeal against the ensuing decision.

The boards of appeal take the view that a binding effect also exists in this case (see, for example, **T 21/89**, **T 78/89**, **T 55/90**, **T 757/91**, **T 113/92**, **T 1063/92**, **T 153/93**), often on the basis that board of appeal decisions are final and without appeal, so that no EPO body - not even boards of appeal - can take a new decision on facts which have already been decided.

In **T 690/91** the argument was that the same binding effect applied to any subsequent appeal proceedings since, according to Art. 111(1) EPC, the board might exercise the same power as was within the competence of the department which was responsible for the decision appealed.

Decisions of the boards of appeal are final, as a decision can only be contested where it is expressly provided for under statute. There are no provisions in the EPC allowing an appeal against a decision of a board of appeal (see Art. 21(1) EPC and Art. 106(1) EPC for appealable decisions). When the first board of appeal delivers its decision, the content and text of the patent claims become res judicata and can no longer be amended in proceedings before the EPO (**T 843/91** of 17.3.93 (OJ 1994, 818); see also **T 153/93**).

The fact that the boards of appeal are courts was established in **G 1/86** (OJ 1987, 447, reasons, 14, German and French versions - the board held that the English translation, "act as courts", was inaccurate).

The ratio decidendi of a decision under Art. 111(2) EPC is the ground or the reason for making it - in other words, the point in a case which determines the outcome of the judgment (**T 934/91**(OJ 1994, 184). It is not contained in the order but in the section "Reasons for the Decision" and it is thus of no importance for its binding effect that a particular matter is not mentioned in the order (**T 436/95**).

"Res judicata" means a matter finally settled by a court of competent jurisdiction, rendering that matter conclusive as to the rights of the parties and their privies, such a final judgment constituting an absolute bar to a subsequent legal action involving the same claim, demand or cause of action, and the same parties or their privies (**T 934/91**(OJ 1994, 184)). However, a board of appeal decision has the binding effect referred to in Art. 111(2) EPC only if the case is remitted to the department of first instance. A board of appeal decision in another case is not binding on the department of first instance (**T 288/92**; see also **J 27/94** (OJ 1995, 831)). Nor is a decision by a board of appeal on an appeal from an examining division decision binding in subsequent opposition proceedings or on appeals therefrom, having

regard both to the EPC and to the principle of res judicata (T 167/93 (OJ 1997, 229)). The binding effect is also not restricted to cases where the composition of the board remained unchanged (T 436/95).

Where the board, in the decision remitting the case to the department of first instance, is silent on the question of the adaptation of the description, this does not necessarily imply that no adaptation is required, but merely that the matter was not considered or decided. The point is therefore not res judicata and so can be raised in a subsequent appeal (T 636/97).

10.2 Type of remittal

The legal effects of Art. 111(2) EPC differ in scope according to the type of remittal.

10.2.1 Remittal only for adaptation of the description

In T 757/91 the board decided that if, after the case was remitted, the only issue still outstanding was the adaptation of the description to the amended claims which were held valid in the first appeal proceedings, that issue was the only one which could be considered in further appeal proceedings. When the first board of appeal delivered its decision, the content and the text of the patent claims became res judicata and could no longer be amended in proceedings before the EPO (see also T 55/90, T 843/91 (OJ 1994, 832) and T 113/92 of 5.8.1993).

Remittal for the description to be amended does not render it possible for an opponent to challenge substantive patentability again by appealing the opposition division's decision after remittal, where a final decision has been taken on this and the scope of the patent (T 1063/92).

On remittal the board had made no mention of any adaptation of the description that might be necessary. The patentee proposed amendments to the description which were accepted by the opposition division. The opponent appealed against this decision, challenging the novelty and clarity of the claims as already decided upon by the board of appeal. Following T 843/91 of 5.8.1993 (OJ 1994, 832), the board in T 153/93 found that all findings of fact that were a *conditio sine qua non* of the finally binding parts of the decision were res judicata with the result that new facts, evidence or arguments seeking to cast doubt upon these facts could not be considered either by the opposition division or the board of appeal.

10.2.2 Remittal for the continuation of proceedings

If a board of appeal has issued a decision rejecting certain claimed subject-matter as not allowable and remitted the case for further prosecution in accordance with an auxiliary request, under Art. 111(2) EPC, the examination for allowability of the rejected claimed subject-matter cannot be re-opened, either by the examining division during its further prosecution of the case, or by the board of appeal in any subsequent appeal proceedings (T 79/89 (OJ 1992, 283); see also T 21/89).

A board is bound in the second of two successive *ex parte* appeal proceedings by the ratio

decidendi of the decision in the first appeal proceedings where the facts remain the same. It is to be assumed that this is the case where there is no connection between a feature amended during the second proceedings and findings of the first board of appeal playing a key role in the decision (**T 690/91**).

Under Art. 111(2) EPC, if a board of appeal remits a case for further prosecution to the department whose decision was appealed, that department is bound by the ratio decidendi of the board in so far as the facts are the same. After grant, however, the opposition division is in no way legally bound by the previous decision of the board, on an appeal from the examining division, even in so far as the facts are the same, although it should not deviate from a previous decision of a board of appeal on such a point, unless there appear to be very clear reasons for doing so (**T 26/93**).

In the opposition proceedings following the remittal for continuation of the proceedings an amendment of the patent claims can change the actual basis of an appeal decision. In such a case the binding effect of Art. 111(2) EPC no longer applies. This differs from the situation where the case is remitted for adaptation of the description - here the previous instance is bound by the ratio decidendi of the board's decision, and the decision on the patentability of the claims is final, even if the facts have changed (**T 27/94**).

Art. 111(2) EPC states unambiguously that the first instance and the board of appeal which is again concerned with the case are bound by the ratio decidendi of the remitting decision only "in so far as the facts are the same". The opposition division is thus not bound by the first decision if new claims are submitted which are not in conflict with the ratio decidendi of the decision. The situation is different if the board has dismissed the decision under appeal and remitted the case to the first instance with the order to maintain a patent with claims whose wording has been defined by the board. In such a case the first instance is not entitled to admit amended claims, since they are part of the res judicata of the decision of the board (**T 609/94**).

In **T 255/92** the case was remitted by the board itself "for further prosecution". The board stated, "for the avoidance of doubt, it is pointed out that according to Art. 111(2) EPC the examining division is bound by the present decision only to the extent that it has been decided that the subject-matter of claim 1 as amended during the oral proceedings before the examining division on 15.10.1991 involves an inventive step over the prior art considered in the present decision" (see also **T 366/92**).

See also **T 720/93** for the extent to which a board considered itself bound by an earlier board of appeal decision in the same case. Although the claim pending before the board represented different facts from in the first proceedings since it was a different type of claim and contained a number of different features, the board found some findings of the first decision binding for the second proceedings.

11. Termination of appeal proceedings

Under the EPC it is possible to withdraw a patent application, opposition or appeal. Decision **J 19/82** (OJ 1984, 6) ruled that partial withdrawal is also possible. The consequences of such

a withdrawal for pending appeal proceedings are considered below.

11.1 Withdrawal of the appeal

In **G 7/91** and **G 8/91** (OJ 1993, 346 and 356) the Enlarged Board of Appeal ruled that as far as the substantive issues settled by the contested decision at first instance were concerned, appeal proceedings - whether ex parte or inter partes - were terminated when the sole appellant withdrew his appeal. The Enlarged Board found that the provision of Art. 114(1) EPC did not allow for continuation of the proceedings once the appeal had been withdrawn. This was evident from the legislative rationale of the EPC. If Art. 114(1) EPC applied to all withdrawal situations, then the R. 60(2) EPC exception for oppositions would be superfluous. Nor was withdrawal of the appeal covered by "relief sought" within the meaning of Art. 114(1) EPC, second part of sentence, to which the EPO would not be restricted in examining the facts; it constituted a procedural act not requiring the consent of the relevant board (reasons, 8). The appeal procedure was that proper to an administrative court, so any exception from general procedural principles such as the "principle of party disposition" had to be supported by much weightier grounds than in administrative proceedings. Neither Art. 114(1) EPC nor the interests of the general public or the respondent constituted arguments against this interpretation. Art. 114(1) EPC was restricted to the examination of the facts. The interests of the general public were primarily safeguarded by the opposition system. It could be assumed that the patent did not disturb those who had not filed an opposition, so there was no need to continue the appeal proceedings in order to safeguard their interests. Nor were the respondents' interests any more in need of protection if they had not themselves filed an appeal, as was explained in detail in **G 2/91** (OJ 1992, 206). Finally, the Enlarged Board pointed out that when the sole appellant withdrew his appeal, the suspensive effect of the appeal lapsed and the opposition division's decision thus became final as regards the substantive issue.

If the sole appellant says he has withdrawn his appeal, but the parties are in dispute as to whether he did so admissibly, then the board is empowered to rule on that issue (**T 659/92**, OJ 1995, 519).

After withdrawal of an appeal it is still permissible to decide on ancillary questions (**T 85/84**). Thus in **J 12/86** (OJ 1988, 83), **T 41/82** (OJ 1982, 256) and **T 773/91**, the board of appeal dealt with requests for reimbursement of the appeal fee filed after withdrawal of the appeal, and in **T 117/86** (OJ 1989, 401), **T 323/89** (OJ 1992, 169), **T 614/89** and **T 765/89** with requests for apportionment of costs.

According to **T 195/93**, the fact that the appellant withdrew his appeal after an intervention was filed could not immediately lead to termination of the proceedings. The board had to consider the admissibility of the intervention (see above, VII.D.5.4.1).

Partial withdrawal of an appeal by the sole appellant (opponent) following an allowable limitation of the patent's subject-matter under Art. 123 EPC during appeal proceedings deprives the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter. The patent must therefore be granted in its amended form (**T 6/92**).

11.2 Withdrawal of the opposition during appeal proceedings

The effects of this vary, depending on whether the opponent in the appeal proceedings is the appellant or the respondent.

In **G 8/93** (OJ 1994, 887) the Enlarged Board held that if the **opponent** as **sole appellant** filed a statement withdrawing his opposition this immediately and automatically terminated the appeal proceedings, irrespective of the patentee's consent. The proceedings were also terminated if in the board's view the requirements under the EPC for maintaining the patent were not met. The Enlarged Board emphasised the distinction between the power to initiate and continue proceedings and the power to clarify the facts in pending proceedings. According to its case law, in appeal proceedings the former is **exclusively** the province of the appellant, whereas the latter may be exercised by the board subject to Art. 114 EPC provided proceedings are pending.

This confirmed the earlier case law (see **T 117/86** (OJ 1989, 401), **T 129/88** (OJ 1993, 598), **T 323/89** (OJ 1992, 169), **T 381/89** and **T 678/90**). Any statements made following withdrawal of the opposition are irrelevant (see **T 381/89**). **T 544/89** is overruled.

If, however, the **opponent** is the **respondent**, withdrawal of the opposition does not affect the appeal proceedings (see, for example, **T 135/86**, **T 362/86**, **T 373/87**, **T 194/90**, **T 629/90** (OJ 1992, 654), **T 138/91**, **T 329/92**, **T 627/92**, **T 78/95**). However, under **T 789/89** (OJ 1994, 482) withdrawal of an opposition by the respondent means the respondent ceases to be party to the appeal proceedings in respect of the substantive issues; he remains party to them only as regards apportionment of costs (confirmed by **T 82/92**, **T 884/91**, **T 329/92**). **T 484/89** on the other hand found that the respondent remained party to the proceedings although not obliged to take an active part. The opposition division's decision is not examined 'by the Office of its own motion', but as a result of the appeal, ie on the basis of the "request" by the appellant for the contested decision to be revoked (**T 958/92**).

For the consequences of withdrawal of the opposition as regards the board's powers of ex officio examination of the facts, see "Facts under examination" above (VII.D.6.4).

11.3 Request for revocation of a patent

If the opponent is the appellant and the patent proprietor makes it clear that he no longer approves the text in which the patent was granted and will not be submitting an amended text, under established case law the appeal proceedings are terminated by a decision ordering revocation of the patent, without going into the substantive issues. This is supported by Art. 113(2) EPC, which provides that a patent may be maintained only in a version approved by the patent proprietor (see also chapter VI.1.2). If there is no such version, one of the substantive requirements for maintaining the patent is lacking (**T 73/84**, (OJ 1985, 241), **T 230/84**, **T 157/85**). This legal consequence ensues whatever the formulation the patentee uses (see eg **T 237/86**, OJ 1988, 261 (we herewith abandon the patent) or **T 92/88** (the patent has been allowed to lapse in all designated states)).

The request for revocation is in substance the same as stating disapproval of a given text of

the claims (see **T 186/84** (OJ 1986, 79), **T 315/91**, **T 370/91**, **T 936/91** and **T 820/94**).

Thus even a statement requesting withdrawal of the application should be interpreted as a revocation of the approval of the text of the patent under Art. 113(2) EPC (see **T 264/84**, **T 415/87**, **T 68/90**, **T 322/91**).

In **T 347/90** the **patent proprietor** was the **appellant**, and gave notice during the appeal proceedings that he was withdrawing his application. Here the board interpreted his statement as a request for the revocation of the patent, and dismissed the appeal without going into the substantive issues, so that the patent's revocation by the department of first instance was confirmed. In **T 18/92** the patent proprietor/appellant had specifically requested revocation of the patent. The board interpreted this request as a withdrawal of the appeal. Withdrawal of the appeal meant that the first-instance decision revoking the patent took effect. In **T 481/96** the board examined the two solutions and endorsed **T 18/92**.

Where the respondent/patent proprietor states that the patent has been abandoned 'since' a particular date, this cannot be considered a request for revocation, as it does not indicate that the patent has been abandoned ab initio. The case law on requests for revocation therefore do not apply and the appeal must be examined as to its merits (**T 973/92**).

11.4 Patent expired in all designated states

In **T 329/88** the board of appeal applied R. 60(1) EPC by analogy to appeal proceedings and terminated the proceedings without any decision on the issues, since during the appeal proceedings the European patent had expired in all the designated contracting states. The opponent/appellant had not requested continuation of the appeal proceedings (see also **T 762/89** and **T 714/93**, **T 165/95**). It should be noted here that termination of proceedings has no repercussions corresponding to those of revocation under Art. 68 EPC; instead, it is based on the fact that the patent has already expired without effect ab initio for each designated contracting state.

However, if the appellant/opponent expresses doubts concerning a respondent/patentee's claim that a patent has lapsed or been surrendered, then the lapse must be registered with the EPO or properly proved. Otherwise, R. 60(1) EPC is not applicable and the appeal procedure continues (**T 833/94**).

12. Interlocutory revision

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

In case **T 139/87** (OJ 1990, 68) the board of appeal made it clear that an appeal by an applicant for a European patent was to be considered well founded within the meaning of Art. 109(1) EPC if the main request of the appeal included amendments which clearly met the objections on which the refusal of the application had been based as indicated by the examining division. In such a case, the department that issued the contested decision **must** rectify the decision. Irregularities other than those that gave rise to the contested decision do

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not preclude rectification of the decision (see also **T 47/90** (OJ 1991, 486), **T 690/90**, **T 1042/92**, **T 1097/92**, **T 219/93**, **T 647/93** (OJ 1995, 132), **T 648/94**, **T 794/95**).

Any infringement of Art.113(2) EPC, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when the examining division does not make use of the possibility of granting interlocutory revision under Art. 109 EPC, after the mistake has been pointed out in the grounds of appeal (**T 647/93** (OJ 1995, 132)). See also **T 685/98** (OJ 1999, 346).

In **T 473/91** (OJ 1993, 630) the board made it clear that the admissibility question under Art. 109 EPC falls under the jurisdiction of the department of first instance only when this question can be decided immediately on the basis of the appeal submissions themselves. Consequently, the appellate instance has exclusive jurisdiction over a request for restitutio in integrum into a time limit relating to the appeal itself.

Before the department of first instance can review the admissibility and merits of a validly filed appeal, it must have available the documents stipulated in Art. 108 EPC. In **T 41/97**, the examining division decided not to rectify its decision **before** receiving the statement of grounds of appeal and before the time limit for filing it had expired. This was held to be a procedural violation.

In **T 691/91**, following the applicant's appeal, the examining division issued Form 2702, normally used for interlocutory revision and entitled "Decision on rectification", in which it made some formal corrections to the first decision but otherwise upheld its objections and its decision. The applicant filed a new appeal. The board held that the document entitled "Decision on rectification" was a final action by the examining division which had the consequence of depriving the appellant of all of his rights with regard to the invention. The appeal was therefore admissible. The board also found that a procedural violation had occurred. Art. 109 EPC provides for two legally viable alternatives: to maintain or to annul the decision which is appealed. In the case at issue, the examining division had chosen a third way: maintaining the earlier decision by issuing a decision on rectification. This alternative was not covered by the provisions of Art. 109 EPC.

Objections which are not the subject of the contested decision cannot preclude the application of Art. 109 EPC. Moreover, interlocutory revision is also appropriate if the appellant no longer seeks grant of the patent with a text corresponding to that which was rejected by the examining division, and if substantial amendments are proposed which are clearly intended to overcome the objections raised in the decision under appeal, so that the examination has to be continued on a new basis (**T 180/95**).

However, where the examining division considers that interlocutory revision will only be possible on condition several objections are overcome and these objections are unrelated to the refusal and clearly have no link at all to the decision under appeal, such an approach has no legal basis (**T 615/95**).

In **T 919/95** the appellant was of the opinion that an interlocutory revision must result in the appeal being allowed. A 'cassatory' revision that merely sets aside the contested decision

and resumes the suspended proceedings is not compatible with the EPC. The interlocutory revision must be a 'reformatory' revision, ie one that confers on the appellant something that the contested decision deprived him of. The board stated that the requirements of Art. 109 EPC are met if the reason for the contested decision is removed as a result of an admissible appeal; once the contested decision is set aside the requested decision can be taken, or the proceedings can be resumed since further examination is required of new grounds or facts. The latter does not rule out a subsequent refusal. The purpose of interlocutory revision is to speed up the procedure. If an examining division rectifies a decision under Art. 109 EPC merely in order to grant a patent according to an auxiliary request, even though the applicant insists on his main request, the procedure is not thereby accelerated but slowed down and this would constitute a substantial procedural violation. In **T 142/96** the practice of re-opening examination after rectification was held to be contrary to the principle of procedural economy underlying Art. 109 EPC and so constituted a substantial procedural violation.

Under Art. 109(2) EPC a case must be remitted to the boards of appeal without delay and without comments as to its merits if the decision under appeal is not rectified within one month of receipt of the statement of grounds of the appeal. Therefore, if further separate issues - such as the reimbursement of the appeal fee - arise out of the appeal, the department in charge of the case is obliged under Art. 109(2) EPC to take a separate decision on rectification before the end of the then one-month time period as soon as it realises that a decision on any further issue cannot be taken within that period (**T 939/95** (OJ 1998, 481)). Art. 109 EPC has subsequently been amended and the time limit extended to three months (OJ 1999, 1).

The appellant in **T 647/99** appealed against refusal of the patent application, requesting also that the appeal fees be reimbursed under R. 67 EPC. In fact, the examining division rectified its decision under Art. 109(1) EPC, but rejected the request for reimbursement of the appeal fee, which, according to **J 32/95** (OJ 1999, 713), became the sole subject of the subsequent appeal proceedings before the technical board of appeal.

13. Referral to the Enlarged Board of Appeal

Under Art. 112(1) EPC it is within the discretion of the boards of appeal to refer a case to the Enlarged Board of Appeal if this appears necessary for ensuring uniform application of the law or if an important point of law arises. It was made clear in **T 184/91** that only questions on a specific point, not entire cases, can be referred to the Enlarged Board of Appeal.

The following decisions concern mainly those cases in which the request for referral was refused, since the others have already been dealt with elsewhere.

(a) Ensuring uniform application of the law

In principle, the boards always refuse requests for referral where there is no contradictory case law and they see no reason for departing from earlier decisions (see eg **T 170/83** (OJ 1984, 605), **T 162/85**, **T 58/87**, **T 5/89**, **T 315/89**, **T 37/90**, **T 323/90**, **T 688/90**, **T 506/91**, **J 47/92** (OJ 1995, 180), **T 473/92**, **T 952/92**, **T 702/93**).

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There is in principle no contradiction where a different application of the same rule is justified by different circumstances (**T 143/91**).

According to **T 373/87** there is no contradictory case law where a single, unconfirmed decision departs from the case law established by several decisions.

(b) Important points of law

The board took the view in **T 601/92** that in certain cases there was no general interest in clarifying points of law; such points were consequently not important.

A purely theoretical interest in clarifying points of law is no justification for referral (**T 835/90**), nor, according to **T 118/89**, should hypothetical points be referred. Any question referred must, moreover, be of a legal nature and not just a question of fact. The board in **T 373/87** and **T 939/92** took the same view. Nor may technical questions be referred, according to the board's ruling in **T 181/82** (OJ 1984, 401), in which the appellants requested referral of the question whether a skilled person would readily understand the technical content of a prior art document on the strength of his own knowledge (see also **T 219/83** (OJ 1986, 211), **T 82/93** (OJ 1996, 274)). In **T 972/91** the board ruled that questions to which no general answer is possible cannot be referred. In this particular case the appellant had requested referral to the Enlarged Board of Appeal of the question how a patent claim was to be interpreted and understood in view of the content of the technical teaching.

The boards have not referred questions where they were of the opinion that the requirement on which the question was based had not been fulfilled (eg in **T 727/89**, where the question presupposed that the claim was not novel and the board took the view that it was, **T 162/90** and **T 921/91**).

Where a board intends to rule in favour of the party requesting referral to the Enlarged Board of Appeal, it on principle refuses the request (see **T 461/88** (OJ 1993, 295), **T 301/87** (OJ 1990, 335), **T 648/88**, **T 180/92**, **T 469/92**).

According to **T 26/88** (OJ 1991, 30) there is no important point of law to be clarified where the legal situation on which a question is based has changed in the interim and the question is therefore unlikely to arise again very often.

According to **T 247/85** the question of how permission to appeal against an interlocutory decision should be presented does not involve an important point of law.

Even where a question involving an important point of law has arisen, the boards have not referred it if they could resolve it themselves without any doubt (see **J 5/81** (OJ 1982, 155), **T 198/88** (OJ 1991, 254), **T 579/88**, **T 708/90**) or if the question was not relevant for deciding the specific case (see eg **J 7/90** (OJ 1993, 133), **J 16/90** (OJ 1992, 260), **J 14/91** (OJ 1993, 479), **T 72/89**, **T 583/89**, **T 676/90**, **T 297/91**, **T 485/91**, **T 860/91**).

In **T 82/93** (OJ 1996, 274) no referral was permitted since the question had already been decided by the Enlarged Board of Appeal. In **T 297/88** the board dealt in detail with the

question of when it was possible to refer a question which had already been decided by the Enlarged Board. It took the view that, in principle, any answer by the Enlarged Board on a point of law could be called into question if the Enlarged Board's arguments in the contested decision were so weak that doubts as to the correctness of the decision *per se* were unavoidable. This was also the case where the arguments were based on false premises so that for this reason there were doubts about the conclusion drawn. A decision could also be questioned where the premises were correct, the arguments were conclusive and therefore the conclusion was necessarily also correct, but legal or technical developments occurring in the interim made it seem desirable in the public interest to have the question reviewed again by the Enlarged Board.

In **T 208/88** of 20.7.1988 a question was referred, even though it was already pending before the Enlarged Board in other proceedings, because new aspects had emerged in this case which were useful for the decision. A referral was also made in **J 15/90**, although the question was already pending, as the board wished to give the Enlarged Board the opportunity to consider another type of case which might be affected by its answer. In **T 803/93** (OJ 1996, 204) the board referred the question whether a person other than an authorised representative could appear before a board in technical cases, thus complementing the question already pending before the Enlarged Board whether this was possible in legal cases. In **T 184/91** a question already pending was referred again in order to give the parties to the proceedings the opportunity to present their case to the Enlarged Board.

A board may only refer questions of law to the Enlarged Board of Appeal 'during proceedings on a case' and before it has decided on the issues in the appeal in relation to which such questions of law are considered to arise. Points of law having the force of *res judicata*, cannot be referred to the Enlarged Board of Appeal (**T 79/89** (OJ 1992, 283)). According to **G 8/92**, a referral is only possible if the appeal is admissible, unless the referral concerns a legal point arising in connection with the admissibility of the appeal.

13.1 Suspension of first-instance proceedings following referral to Enlarged Board

Whenever a decision of the examining division depends entirely on the outcome of proceedings before the Enlarged Board of Appeal on a legal question or point of law raised under to Art. 112 EPC - and this is known to the examining division - the further examination of the application must be suspended until the matter is decided by the Enlarged Board of Appeal. Failure to do so amounts to a substantial procedural violation under R. 67 EPC (**T 166/84** (OJ 1984, 489)).

14. Filing of amended claims in appeal proceedings

14.1 Admissibility of filing amended claims in appeal proceedings

There are no special rules on filing amended claims in appeal proceedings. Under R. 66(1) EPC, boards must therefore apply the provisions which governed the proceedings before the department which took the contested decision. That means R. 86(3) EPC for examination proceedings and R. 57a EPC for opposition (**T 63/86**, OJ 1988, 224). R. 86(3) EPC is the clearest expression of the principle that EPO proceedings must be conducted expeditiously,

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in the parties' and the public interest. Although not stated so clearly in Art. 101 EPC and Art. 110 EPC, this principle also applies to opposition and opposition appeal proceedings (**T 833/90**). Some decisions cite Art. 11(3) RPBA, which says that after oral proceedings before a board the case should be ready for a decision (**T 626/90, T 48/91, T 1150/97, T 1071/97**).

In **T 840/93** (OJ 1996, 335) the board pointed out that, as noted by the Enlarged Board of Appeal in **G 9/91** (OJ 1993, 408), the main purpose of inter partes appeal proceedings was to enable the losing party to challenge the first-instance department's decision on its merits. A patentee who had lost before the opposition division thus had the right to have the rejected requests reconsidered by the board of appeal. The board added that it was at odds with the purpose of the appeal procedure to file an appeal which not only sought to reverse the decision on a request already considered by the opposition division but also made new requests raising issues which the division had never looked at. Admitting amended requests was justified only if the patentee would otherwise be deprived of any opportunity of still getting a patent. If however this "last-chance" argument did not apply, the board should confine itself to its appellate role, deciding only on those requests already considered by the opposition division (see also **T 25/91**).

In some cases, the boards do admit amended requests or auxiliary requests in appeal proceedings if they are serious attempts at overcoming objections, or if their late filing can be justified and the board can see prima facie that they are admissible (**T 95/83**, OJ 1985, 75; **T 153/85**, OJ 1988, 1; **T 406/86**, OJ 1989, 302; **T 295/87**, OJ 1990, 470; **T 381/87**, OJ 1990, 213; **T 831/92**).

In **T 382/97**, the appellant submitted four amended sets of claims as auxiliary requests 4 to 7 two weeks before the oral proceedings before the board of appeal. The board held that the filing of additional auxiliary requests while maintaining already pending auxiliary requests unchanged can hardly be considered as being an amendment of already existing requests but amounts to submitting new requests which, on principle, is not desirable at a late stage of appeal proceedings.

Furthermore, amendment at a late stage of appeal proceedings should create as little extra work as possible for both the other party and the board. By filing new requests without commenting either on the need for filing them or on the admissibility of those already pending the appellant unduly multiplied the workload in connection with his case. The requests were held not to be admissible.

In **T 577/97** the respondent (patent proprietor) submitted an amended set of claims as an auxiliary request during oral proceedings at the appeal stage. The appellant objected that the auxiliary request was late-filed and therefore inadmissible.

The board held that the filing of amended claims in opposition proceedings was governed by Art. 123 EPC and R. 57a EPC, which did not specify a time limit for the amendments. Therefore, a board had discretion to accept amended claims at any stage of the appeal proceedings.

In exercising that discretion, the board did not need to consider whether or not the claim was

"clearly allowable"; in the board's view, there was no basis in the EPC for refusing auxiliary requests at oral proceedings under such a criterion. In contrast to the situation in examination proceedings, where under R. 86(3) EPC amendments submitted after the time limit set in the EPO's first communication were subject to the EPO's consent, R. 57a EPC contained no such requirement. Therefore, auxiliary requests should in principle only be refused in exceptional cases where they amounted to an abuse of procedural rights.

14.2 Criteria for taking amendments to claims into consideration

Over the years, the boards have laid down criteria for limiting the admissibility of amended requests (but see **T 577/97** above).

In **T 648/96** the board reaffirmed that claims filed late (ie just before or at the oral hearing) are subject to the same principles in opposition proceedings as in appeal proceedings (see also page 486).

14.2.1 Time of filing

The time of filing amended claims or auxiliary requests, in conjunction with the difficulty of the examination, is an important criterion for assessing whether they can be taken into consideration in the proceedings.

In **T 51/90** and **T 270/90** (OJ 1993, 725) it was emphasised that for reasons of fairness any new claims filed during appeal proceedings should be submitted at least one month prior to oral proceedings, unless they were simple and clear enough to be understood immediately and were obviously allowable.

In **T 831/92** the board held that, as a matter of principle, the filing of an auxiliary request in opposition proceedings during oral proceedings before a board of appeal is contrary to procedural fairness. It is difficult for an opponent to deal properly with a request not presented in good time before oral proceedings, and an adjournment, possibly to another day in order to allow further searches, might be necessary if the request were to be admitted.

In **T 95/83** (OJ 1985, 75) it was decided that amendments not submitted in good time before oral proceedings in appeal proceedings should only be considered on their merits where there is some clear justification both for the amendment and for its late submission (see also **T 153/85**, OJ 1988, 1).

In **T 482/89** (OJ 1992, 646), **T 543/89**, **T 297/91** and **T 252/92** the boards of appeal took account of claims submitted at the beginning of or in the course of oral proceedings as they were obviously clearly allowable.

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

circumstances, for example, if the amended text were obviously allowable (see also **T 304/92**).

In **T 794/94** the board stated that exceptional problems sometimes involved in patents in the **field of genetic engineering** can make formulation of a suitable request difficult, and accordingly amount to exceptional circumstances justifying late submission of requests formulated to meet objections which have already been considered at length. However, there is no right to file an endless succession of new requests in substitution for requests found inadmissible or unallowable by the board. The chances of a request being accepted even at a very late stage were much improved if it could quickly be checked that the request met the requirements of Art. 123 EPC and Art. 84 EPC and was necessary and appropriate to meet a ground for opposition. Thus it was advisable to submit not just a clean copy of the amended claims, but a copy of the claims as granted indicating the verbal additions and deletions by which the claims of the new request were derived from the claims as granted. In addition, for each amendment, all passages in the original description which were relied on as providing a fair basis for that amendment should be stated, and it should be stated what ground for opposition that amendment served to avoid. The addition of dependent claims which did not correspond to any claims as granted could not remove a ground for opposition but might well give rise to new objections and issues which would require discussion. Thus such addition could not be necessary and appropriate, and a request containing additional dependent claims was likely to be refused admission into the proceedings.

In **T 1148/97**, Claim 1 according to the auxiliary request was submitted only during oral proceedings before the board.

The board held that claims could still be admitted at a very late stage if the amendments limited the scope of protection in such a way that revocation could be avoided and the patent expeditiously maintained in amended form.

14.2.2 Difficulty of examination

According to **T 570/96**, requests for non-substantive amendment or mere limitation of claims may thus be admitted even at oral proceedings, especially if the board does not consider them *prima facie* unlikely to succeed and provided they raise no new novelty and inventive-step considerations compared with the claims as previously worded (see also **T 252/92**, **T 297/91**, **T 119/95**).

In the following decisions late-filed claims were not taken into consideration as they were filed only shortly before or during the oral proceedings.

In **T 92/93** the alternative set of claims included new claims containing subject-matter which had not previously been claimed. The board held that the claims were not clearly allowable, in the sense that they could quickly be seen by the board both to introduce no objections under the EPC and to meet all outstanding objections under the EPC. Likewise **T 631/92**, **T 655/93**, **T 644/89**, **T 443/87**, **T 110/85**, **T 401/95**.

In **T 25/91** the board refused to admit the amended claims because, even from a preliminary

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examination of the facts, it was clear that the amended claims represented a radical departure from the claims previously maintained (see also **T 234/92**, (where a feature from the description was introduced into claim 1, which might have entailed an additional search) and **T 1105/98** (where an additional search was necessary)).

In **T 48/91** the board rejected as inadmissible the late-filed claims, which contained one or more additional features the impact of which was either unclear or impossible to assess without further investigations, such as carrying out proper comparison tests.

In **T 17/97** the board held that, to be admissible, proposed amendments should be appropriate and necessary, namely they should be occasioned by grounds for opposition laid down in Art. 100 EPC.

14.2.3 Reasons for late filing

Another relevant criterion is the reason why the requests were filed late.

(a) Amendments caused by developments during the proceedings.

The boards generally admit amendments filed in response to observations made by the rapporteur or the other party (see **T 38/89**, **T 459/91**, **T 933/91**, **T 1059/92**, **T 69/94**, **T 240/94**).

In **T 626/90** the board decided to admit into consideration both sets of claims submitted by the respondent at the oral proceedings. The board was satisfied that the new versions of the claims were bona fide attempts to overcome the objections raised by the appellants in connection with the question of the inventive step of the claimed process, and that no question of the appellants being taken unfairly by surprise arose, because in both requests the amendments were nothing more than a limitation of the claimed subject-matter to preferred embodiments of the invention as described in the patent in suit.

In **T 833/90** the board held that the fact that the previously approved limitation was not necessary in technical terms could not be accepted as justification, since the technical facts remained the same.

In **T 152/95** the board of appeal took account of auxiliary requests only filed by the respondent (patent proprietor) during oral proceedings on the grounds that it was only during those proceedings that the board took a decision on the relevance of a document that differed from that of the department of previous instance and as a result ruled that the subject-matter of claim 1 according to the main request lacked an inventive step. Since the versions of the claims filed still had to be examined, the board decided to continue proceedings in writing and to issue a separate decision on the auxiliary requests.

In **T 610/94** the appellants filed a new set of claims during oral proceedings, stating that they had limited claim 1 in response to prior art from D12, which had not been cited until shortly before the proceedings, and that the new claims took account of the defects cited by the board in the appendix to the summons to oral proceedings. The respondents replied that they

had been surprised by the late-filed claims. The board decided to admit the new claims and to continue with the oral proceedings after an adjournment of some 90 minutes. In its decision it pointed out that the respondents could be expected to anticipate an amended, restricted claim, since they themselves had only cited D12 for the first time shortly before oral proceedings. The board held the new claim to be allowable, stating that under such circumstances amendments of this kind should be allowed as a matter of course, even during oral proceedings.

In **T 231/95** auxiliary request 2 was not filed until the end of oral proceedings on the grounds that the necessity of further restricting the claimed subject-matter had only become apparent during oral proceedings. The board however ruled that the discussion at the oral proceedings had been primarily restricted to the objections already raised in written proceedings without introducing any surprising new aspects which would have presented the respondents with a new case. There was therefore no clear justification for the late filing.

In **T 240/94** the late filing had been unavoidable because of a combination of circumstances, including the relatively short notice given by the board in its summons to oral proceedings, the fact that the annex to the summons contained an unexpected negative assessment of one of the technical advantages of the invention put forward by the appellant, the difficulties of communication over the Christmas period, and the unavailability of the client's technical expert. The board decided to admit the new request despite the fact that the amendment it proposed was new to the proceedings, and had clearly taken the respondents by surprise. The respondents' representatives therefore had to be given time to consult their clients and prepare a response. For these reasons, the board decided at the oral proceedings to continue proceedings on the auxiliary request in writing.

In **T 206/93** the appellant requested a further opportunity to file new claims, if the late-filed and not clearly allowable ones on file were not accepted after discussion. The board took the view that this was an auxiliary request which did not however specify the claims to be discussed. To have admitted it would have posed undue difficulties for the respondents in dealing properly with the new claims, and a possible adjournment would have led to an unacceptable delay in the proceedings. The board could see no exceptional circumstances which might have led to any other conclusion; nor had any such circumstances been advanced by the appellant. The board therefore refused to admit this unspecified request, as contrary to proper procedure.

(b) Change of party or representative

In **T 408/91** the representative of the new patent proprietor filed amended claims at the opening of the oral proceedings. The board stated that in the case in point, having regard to the recent change in ownership of the patent, which had occurred long after the date on which the grounds of appeal were filed, and to the fact that the claims according to the new request did appear to be a genuine attempt to meet the grounds on which the patent was revoked by the opposition division, the late-filing seemed to be justified.

In **T 830/90** the change of representative was not accepted as justification for the late requests. The board took the same view in **T 382/97**, where it stated that only if the change

of representative was necessitated by proven exceptional circumstances might a different conclusion be drawn.

In **T 1032/96** the board held that the case's late transferral to the representative because a colleague was ill did not fully justify not filing a set of claims until just three days before the date set for oral proceedings. The claims were late-filed and inadmissible.

c) Circumstances extraneous to the proceedings

Parties sometimes argue that amendments to the claims are justified by extraneous circumstances. The boards will not entertain them, as demonstrated by **T 160/89** (heavy workload), **T 148/92** (doubts about the definitive design of the invention, or the appellants' frequent travels), **T 626/90** (no instructions received in time), **T 583/93** (lack of communication between patentee and licensee, OJ 1996, 496), and **T 575/94** (new instructions).

14.3 Amended claims not admitted with divisional applications pending

In **T 840/93** (OJ 1996, 335) the board held that in the light of **G 9/91** and **G 10/91** (OJ 1993, 408, 420) on the purpose of appeals, special attention must be given to late-filed requests at the appeal stage when divisional applications are still pending. If the distinction between the subject-matter of the divisional applications is not clear and some of them are still pending before the department of first instance, it is inappropriate to admit, during oral proceedings at the appeal stage after opposition, new requests which are neither immediately allowable nor bona fide attempts to overcome objections raised.

In **T 28/92** the claims were not obviously allowable and the alternative of admitting the requests, but referring the matter back to the department of first instance for further examination, was not acceptable, particularly as there were still pending divisional applications of the application on which the patent in suit was based. The board would not wish to increase the number of proceedings in which much the same subject-matter was already being considered by various instances of the EPO.

14.4 Remittal to the department of first instance because of substantial amendments to claims

According to **T 63/86** (OJ 1988, 224), where substantial amendments to the claims are proposed on appeal and the amendments require further substantive examination, the case should be remitted to the examining division so that this examination can be carried out, if at all, by the examining division after it has exercised its discretion under R. 86(3) EPC. In this way the applicant's right to appeal to a department of second instance is maintained, both in relation to the exercise of discretion under R. 86(3) EPC, and in relation to the formal and substantive allowability of the amended claims (see also **T 341/86**, **T 47/90** (OJ 1991, 486), **T 184/91**, **T 919/91**, **T 599/92**, **T 1032/92**, **T 1067/92**, **T 96/93**, **T 186/93**).

In **T 746/91** the board applied the principles laid down in **T 63/86** and remitted the case to the opposition division for it to examine and decide whether discretion should be exercised in favour of the appellant, and if so, whether the claims complied with the EPC's provisions. The

board took this view in the particular circumstances because the opposition proceedings had themselves been comparatively brief and had not involved the holding of oral proceedings. It had thus adhered to the principle whereby it should be established swiftly whether or not a patent can be maintained. Moreover, the amended claims had been filed with the statement of grounds, ie at the earliest possible stage in the appeal proceedings.

In **T 462/94** the board stated that where in the appeal an entirely new situation had been created by the amendments made, the parties should be given the opportunity to defend their claims or submissions before two instances. The case was remitted to the department of first instance for further prosecution.

In **T 125/94** the board remitted the case to the department of first instance because the amended claims had not only substantially changed the factual framework of the contested decision, but could also require a search in an additional classification unit to determine the closest prior art.

15. Reimbursement of appeal fees

15.1 General issues

According to R. 67 EPC the reimbursement of appeal fees is ordered in the event of **interlocutory revision** or where the board of appeal deems an appeal allowable, if such reimbursement is **equitable** by reason of a **substantial procedural violation**.

The subsentence starting "if such reimbursement" read in its context refers both to interlocutory revisions and appeals. This means that for each of these stages it is a prerequisite that a substantial procedural violation has occurred and that reimbursement is found equitable in the discretion of the deciding body (**T 939/95**, OJ 1998, 481).

In certain cases the boards will, even in the absence of a request to this effect, examine whether the reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (**J 7/82** (OJ 1982, 391), **T 271/85**, **T 346/88**, **T 598/88**, **T 484/90** (OJ 1993, 448)). They do not, however, have the power to reimburse the appeal fee if the conditions of R. 67 EPC are not met (**T 41/82**, OJ 1982, 256).

It also has to be considered that R. 67 EPC applies only to a procedural violation by the instance whose decision is under appeal. Thus, in **T 469/92** the alleged procedural violation was not an act of the opposition division, whose decision was the subject of the appeal, but instead that of the examining division. Even if such an act were to be in breach of the procedural requirements of the EPC, it would not fall within the powers of a board of appeal to order reimbursement.

In the event of the **inadmissibility** or **withdrawal** of an appeal the EPC does **not** provide for reimbursement of the appeal fee (see also **T 372/99** and **T 543/99**). On the other hand, reimbursement of the appeal fee is ordered if an appeal is **deemed not to have been filed** because the appeal fee had not been paid in due time in accordance with Art. 108 EPC, second sentence. Here, since the purpose of the fee cannot be achieved, the fee must be

repaid without the board of appeal having to make any specific order to that effect (see **J 21/80** (OJ 1981, 101), **J 16/82** (OJ 1983, 263), **T 324/90** (OJ 1993, 33), **T 239/92**; for the distinction between the existence and admissibility of an appeal, see eg **T 445/98**, **T 460/95**, Reasons 4 ff, see also **T 778/00** (OJ 2001, 554)).

In **T 323/87** (OJ 1989, 343) the translation referred to in Art. 14(5) EPC had not been filed in due time and the appeal was deemed not to have been lodged. The board ordered that the appeal fee, if paid, be reimbursed.

The appeal fee cannot be refunded for the reason that a statement of grounds was not filed, or was filed too late (**T 13/82** (OJ 1983, 411), **T 324/90** (OJ 1993, 33)). This also applies where the grounds of appeal have deliberately not been filed in order to make the appeal inadmissible (**T 89/84**, OJ 1984, 562), or where the appeal, after due filing of the notice of appeal and payment of the appeal fee, is withdrawn before expiry of the period for filing the grounds of appeal (**J 12/86**, OJ 1988, 83). In **T 773/91** the only appellant had withdrawn his appeal before the board of appeal had started to examine the appeal. The board decided that the appeal fee could not be reimbursed, since the appeal had been effectively filed.

15.2 Allowability of the appeal

R. 67 EPC stipulates as a precondition for reimbursement that the appeal be allowable, ie that it be successful. It is clear from the wording and purpose of the provision that "allowable" is to be understood in the sense that the board of appeal, in substance at least, "follows" the relief sought by the appellants, in other words that it allows their requests (**J 37/89**, OJ 1993, 201). In **J 18/84** (OJ 1987, 215) the Legal Board of Appeal ordered the reimbursement of the appeal fee and indicated that the fact that the appeal was allowed only in part was no impediment to a refund.

15.3 Fairness

A number of decisions dealt with the term "equitable" within the meaning of R. 67 EPC.

In **J 22/85** (OJ 1987, 455) the board did not consider a reimbursement of the appeal fee to be justified, since the appellant had failed to provide the Receiving Section with the evidence subsequently submitted in the appeal proceedings.

In **T 893/90** the contested decision to refuse the application on the grounds of lack of novelty was based primarily on document 1, on which, in contrast to document 2, the appellant had had adequate opportunity to put forward comments. The board stated that the decision under appeal had been fully reasoned, and that the procedural violation as regards the reliance on document 2 was thus not sufficiently closely linked to the need to pay an appeal fee for it to be equitable to reimburse the fee. (When the appellant had no choice but to appeal on other issues unaffected by a procedural irregularity, see **T 4/98** (OJ 2002, ***)).

In **T 41/97**, a refund was not equitable because the procedural error (refusal of interlocutory revision prior to receipt of the statement of grounds of appeal and before expiry of the period for filing it) was not the reason the appeal had been filed. In **T 1198/97** and **T 1101/92** the

board observed that there was a causal link between the violation of the appellant's right to be heard and the necessity to appeal; thus reimbursement of the appeal fee was equitable.

In **T 601/92** the opposition division had not commented, either in a communication or in its decision, on the auxiliary request (5) submitted by the patent proprietor in good time before the decision was issued. Because auxiliary request (2), which was submitted in the appeal proceedings and which preceded auxiliary request (5), was allowed, the board did not see any reason, despite the procedural violation, to reimburse the appeal fee, as in this case it was not equitable to do so.

In **T 219/93** the board remitted the case to the department of first instance since it clearly called for revision under Art. 109 EPC. The contested decision had also been inadequately reasoned on one point within the meaning of R. 68(2) EPC. Nevertheless, the board decided not to reimburse the fee for appeal, since the refusal had been made principally on other grounds, and the board did not consider the procedural violation in this case as so substantial within the meaning of R. 67 EPC that the reimbursement would be equitable. In **T 167/96** the impugned decision did not meet the minimum requirements for a reasoned decision. Although there was no doubt that this lack of reasoning amounted to a substantial procedural violation, the board did not consider that a refund of the appeal fee would have been equitable. Indeed, from the file history it was clear that the proprietor had been afforded a very considerable period of time by the department of first instance to file appropriate amendments, but that it had not replied. It then filed on appeal amendments which, it believed, overcame the outstanding objections. In the judgment of the board the appellant had availed himself of the appeal procedure to file necessary amendments which the opposition division had sought in vain over a period of years to elicit from him. The decision was set aside and the case remitted to the department of first instance pursuant to Art. 10 RPBA (see also **T 908/91**).

In **J 18/96** (OJ 1998, 403) the Receiving Section had failed to observe the provisions concerning examination on filing. The proceedings were therefore marred by a procedural violation. Although the appeal was allowed on the ground, inter alia, of a procedural violation, the reimbursement of the appeal fee was not equitable because the appellants themselves had contributed to the failure of the proceedings before the Receiving Section.

In certain other cases, however, the board ruled that reimbursement of the appeal fee was justified for reasons of equity. **J 30/94** is one example. In the case at issue, the board referred to the principle of a fair procedure and held that after withdrawal of an appeal a reimbursement of the appeal fee could **exceptionally** be ordered if the appeal had not been remitted to the board of appeal within a reasonable time after the first-instance decision not to allow it. In the present case the appeal was only referred to the board of appeal seven years after its filing.

In **T 552/97** the patent proprietors and opponent 2 appealed against the decision of the opposition division that the patent, in view of the amendments made, fulfilled the requirements of the EPC. In the written decision it was stated that the patent proprietors had withdrawn their main request during the oral proceedings. However, the board found this assumption by the opposition division to be wrong. Since no decision had been taken on the supposedly withdrawn main request, there had been an infringement of Art. 113(2) EPC and

therefore a substantial procedural violation. Reimbursement of the appeal fee was ordered. The board also ordered reimbursement of the appeal fee paid by opponent 2, since it had not been possible to hear its appeal because of the remittal to the department of first instance by reason of the procedural violation. The board interpreted R. 67 EPC, looking in particular at the English text, as meaning that, where several appeals have been filed, the appeal fee of each appellant may be reimbursed if such reimbursement is equitable.

In **J 38/97**, the appellant had requested inspection of the complete file and complained because a technical opinion pursuant to Art. 25 EPC was not included in the file made available to him. He was informed that such opinions were not open to public inspection under Art. 128(4) EPC. The expressly requested appealable decision was not taken by the competent examining division, but consisted of a letter signed by a director in DG 2. The appeal was inadmissible, as it did not lie from a decision of any of the departments exhaustively enumerated in Art. 106(1) EPC. The board took the view that, having requested an appealable decision, the appellant could legitimately expect that the impugned decision was issued by the competent department and not by a person lacking legal authority. In accordance with the principle of good faith governing relations between the EPO and applicants, it was equitable in these circumstances to order the reimbursement of the appeal fee.

15.4 Substantial procedural violation

15.4.1 Definition

According to R. 67 EPC it is a precondition for reimbursement of the appeal fee that a substantial procedural violation has taken place. A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (**J 7/83**, OJ 1984, 211). According to **J 6/79** (OJ 1980, 225), the expression "substantial procedural violation" was to be understood, in principle, as meaning that the rules of procedure had not been applied in the manner prescribed by the EPC. However, the giving of incorrect information by the EPO about rules of procedure which, if followed by the applicant, could lead to the same consequences as the incorrect application of those rules, could also be considered as within the scope of "procedural violation".

In **J 14/99**, as in **J 15/99**, **J 21/98** (OJ 2000, 406), **J 22/98** and **J 6/99**, it was decided that a procedural violation which had not played any part in the decision could not be considered substantial.

In **T 5/81** (JO 1982, 249) it was stated that an alleged violation affecting a part of the decision other than its ratio decidendi cannot be a substantial violation within the meaning of R. 67 EPC.

In **T 712/97** the board held that the opposition division actually considered the respondent's experimental report, but did not rely on it in a way adverse to the appellant. Therefore, the refusal to allow the appellant's experimental report into the proceedings, while a violation of the appellant's right to present comments on the experimental report of the Respondent, had no influence on the decision reached by the opposition division. As the refusal had no

substantive effect on the outcome of the proceedings, it did not amount to a substantial procedural violation.

In **T 682/91** the board of appeal emphasised that a procedural violation which did not adversely affect anyone could not be considered substantial. The seriousness of a procedural violation derived from its adverse effects.

15.4.2 Request for oral proceedings

Normally, refusal of a request for oral proceedings amounts to a breach of the requirements of the right to be heard so that such a violation justifies reimbursement of the appeal fee (**T 283/88, T 598/88, T 668/89, T 663/90, T 766/90, T 795/91, T 35/92, T 686/92**).

As decided in **T 405/96**, there was a substantial procedural violation justifying reimbursement of the appeal fee where, despite a request by the appellants, no oral proceedings had been ordered, even if the department of first instance was unaware of the request since it had gone missing within the Office, so long as receipt of the request by the Office was proven by the appellants' producing a duly stamped acknowledgement of receipt. The board implied in this case that the fact that the department of first instance could not be held responsible for the loss was irrelevant. The same applied to the failure by the opposition division, because of an oversight, to hold oral proceedings in response to a clear request by the appellant (**T 671/95**).

Failure to summon the parties to oral proceedings was considered to be a substantial procedural violation in **T 209/88** and **T 93/88**. In **T 560/88** the board of appeal held that there was a substantial procedural violation where a clear auxiliary request by the appellant for oral proceedings to be held had not been granted (see also **T 543/92**).

In **T 19/87** (OJ 1988, 268), however, the board held that the finding - albeit wrong - that there had been no request for oral proceedings was not a procedural violation within the meaning of R. 67 EPC. Furthermore, failure to seek clarification from the appellant as to whether oral proceedings were being requested did not constitute a breach of any procedure.

In **T 182/90** (OJ 1994, 641), **T 119/91, T 523/91, T 366/92** and **T 397/94** the boards of appeal stated that it was **not** a substantial procedural violation within the meaning of R. 67 EPC if a request to be called back by or have an interview with the primary examiner was ignored. It was a matter for the examiner's discretion to decide whether to conduct such informal discussions in accordance with the Guidelines, bearing in mind the particular circumstances of the case (see Guidelines C-VI, 4.4 and 6, and **T 300/89**, OJ 1991, 480).

15.4.3 Right to be heard

In **J 14/82** (OJ 1983, 121), **T 716/89** (OJ 1992, 132), **T 197/91, T 640/91** (OJ 1994, 918), **T 734/91, T 880/91, T 392/92, T 892/92** (OJ 1994, 664), **T 951/92** (OJ 1996, 53), **T 1045/92, T 220/93, T 479/94** and **T 1101/92**, reimbursement of the fee for appeal was ordered since the principle of the right to be heard enshrined in Art. 113(1) EPC had been violated, particularly as there had been a lack of opportunity to present comments on the grounds for the contested decision.

In **T 18/81** (OJ 1985, 166) the board of appeal stated that the right to be heard had been infringed when a decision to refuse an application was based essentially on documents which, though supplied by the applicant in support of his case, had been used against him to produce an effect on which he had not had an opportunity to make observations.

In **J 7/82** (OJ 1982, 391) the Legal Board of Appeal ordered reimbursement of the appeal fee because the appealed decision had not taken account of any of the arguments put forward by the appellant and had been based on a ground on which he had not had an opportunity to present his comments. In this connection it was held in **T 197/88** (OJ 1989, 412) that causing one of the parties to be taken by surprise amounted to a substantial procedural violation.

In **T 783/89** the parties were given only 10 minutes to consider a new version of the main claim at the oral proceedings. The board held that this way of proceeding caught the appellants by surprise and thus amounted to a substantial procedural violation.

In **T 543/92** and **T 89/94** the opposition division overlooked amended claims presented in a submission. Reimbursement of the appeal fee was ordered.

The board of appeal in **T 740/94** held that the failure of the opposition division to deal with an objection under Art. 100(b) EPC against an amended claim in its decision to maintain the patent in amended form clearly constituted a substantial procedural violation (see **G 10/91**(OJ 1993, 420), reasons, 19).

In **T 33/93** the appellant argued that the decision under appeal was based on a substantial procedural violation, since it cited for the first time a board of appeal decision on which the appellant had been given no opportunity to present comments. The board stated that the citation of the decision in support of the refusal was not a fresh ground or piece of evidence within the meaning of Art. 113(1) EPC, but a mere repetition of arguments, since it only confirmed the position duly brought to the appellant's attention. In **T 990/91** the board held that since there was no need for the examining division to put forward this new argument in order to refuse the application, the lack of opportunity to reply to it could not be considered to be a procedural violation.

In **T 238/94** the board considered that, although the decision indeed contained no direct reference to the appellants' submissions concerning lack of inventive step, the opposition division had considered in its decision the disclosures of all the documents cited by the appellants and respondents, and also the possible combinations of their teachings. Thus, in the board's view, the appellants' submissions had actually been taken into account, albeit indirectly, in the process of arriving at the contested decision (see also **T 1004/96**).

In **T 666/90** the failure to clarify matters with regard to requests in oral proceedings before the opposition division was deemed to be a substantial procedural violation.

In **T 666/90**, **T 543/92**, **T 647/93** (OJ 1995, 132) and **T 89/94** reimbursement of the fee for appeal was ordered because there had been an infringement of the provision of Art. 113(2) EPC that the EPO consider and decide upon the European patent only in the text submitted

to it, or agreed, by the applicant for or proprietor of the patent (regarding Art. 113(2) EPC, see also **T 898/96**, sections VII.D.7 and VII.D.15.5).

In **T 960/94** the composition of the opposition division had changed between the orally announced decision and the written decision. The board decided that issuing the written decision on behalf of an opposition division whose first member was not present at the oral proceedings amounted to a substantial procedural violation of both Art. 113(1) EPC and Art. 116 EPC, as it had been issued on behalf of a first member before whom the parties had been given no opportunity to present their comments at oral proceedings. The written decision was to be set aside. The appeal fees of both appellants were reimbursed.

15.4.4 Inadequate reasons given in the decision at first instance

In several decisions the absence of adequate reasoning in the contested decision in accordance with R. 68(2) EPC was considered a substantial procedural violation justifying the reimbursement of the fee for appeal (**T 493/88** (OJ 1991, 380), **T 522/90**, **T 360/91** and **T 392/91**, **T 142/95**, **T 648/96**). In **T 292/90** it was stated that reasons given should enable the appellant and the board to understand whether the decision was justified or not (see also **T 52/90**).

Likewise, in **T 740/93** the board held that reasoned decisions should contain at least some reasoning on the crucial points of dispute in a 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 (see also **T 921/94**). This was especially true here, since the case had been sent back to the department of first instance by a first board of appeal decision because of a procedural violation, with the order for further prosecution by a correctly composed opposition division. Since the second decision was nearly identical to the first one, the decision 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 850/95** (OJ 1997, 152) the board observed that the form used to refuse the correction of errors in a decision (R. 89 EPC) contained pre-printed reasons of a very general nature and did not seem to provide for the possibility of adding more specific reasons taking account of the special circumstances of the case, which might easily have given the examining division the impression that further, more detailed, reasons were not necessary. Nor did the Guidelines give any indication that a detailed reasoning was required. However, a correctly reasoned decision would have given the appeal proceedings a more detailed factual basis and assisted the appellant as well as the board. The board held that it was the examining division's obligation to give substantive reasons for the decision on the request for correction, dealing with the specific facts of the case. The board therefore decided that the appeal fee should be reimbursed.

In **T 859/97** the board took the view that it was sufficient for the examining division, when deciding to refuse a European patent application under Art. 97(1) EPC, to state one ground only which in their opinion would prejudice the grant of a European patent. In the present case, the examining division was unable to grant a patent because it was of the opinion that the subject matter of claim 7 was not new. Consequently, the examining division was under no obligation to comment on the patentability of claims 1 to 6. The requirements of R. 67 EPC

were thus not met.

In **T 177/98** the board stated that Art. 113 EPC and R. 68(2) EPC require solely that decisions of the EPO "be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments" and "shall be reasoned ...". Therefore, contrary to the assertion of appellant, in their decisions, the instances of the Office have no obligation to consider in detail the arguments of the parties and to give an opinion on every combination of prior art made during the proceedings but are solely obliged to take a position on the grounds for opposition of Art. 100 EPC called upon by the parties. In the present case, where a large number of documents and arguments were brought forward, the opposition division did not consider all arguments as highly important and therefore did not discuss them all in their written decision. The board held that it was the task of each decision-taking body to grasp the relevant arguments and to reply to them. However, the more material was provided, with corresponding arguments, the more it might be likely that a choice of importance of the arguments was made. This was a question of discretion.

The decision not to consider the two requests filed one day before the oral proceedings was only based on the ground that they were filed too late according to R. 71a EPC. In **T 755/96** (OJ 2000, 174), however, in the board's judgment, this ground for not accepting the two requests could not be considered an adequate reason in support of the exercise of the examining division's discretion but rather constituted a mere reference to the power given to the examining division by the said rule.

Regarding the refusal to consider the request submitted during the oral proceedings, the examining division had merely stated in the minutes of the oral proceedings that this request could not immediately be assessed. This was a bald assertion, unsupported by any legal or factual reasons.

Therefore, the arguments given by the examining division could not provide an adequate basis for deciding on the exercise of discretion under R. 71a EPC. The board concluded that the decision under appeal was not reasoned in accordance with R. 68(2) EPC.

In **T 75/91** the board stated that the impugned decision enabled the reader to follow a line of argument for refusing the application. Whether these reasons were convincing and had to be accepted by the board or not was another question and had nothing to do with a substantial procedural violation. In **T 856/91** the board held that R. 68(2) EPC had been sufficiently complied with where some reasons, even if incomplete and inadequate, were given. The request for reimbursement was therefore rejected (see also **T 735/90**, **T 153/89**, **T 647/93** (OJ 1995, 132)).

15.4.5 Error of judgment by a department of first instance

A number of decisions discussed whether an error of judgment by a department of first instance could be regarded as a substantial procedural violation justifying reimbursement of the appeal fee (**T 19/87** (OJ 1988, 268), **T 863/93**).

Normally there is no procedural violation justifying reimbursement of the appeal fee if a wrong

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procedure is adopted in a situation where the EPC does not lay down clearly what procedure is to be followed, and the case law has not yet established any settled practice (**T 234/86**, OJ 1989, 79).

This principle was extended in a later decision (**T 208/88**, OJ 1992, 22) in which it was held that taking a different line from an as yet isolated appeal decision - as opposed to established board of appeal case law - could not be regarded as a substantial procedural violation. The fact that the board had come to a different conclusion from the department of first instance did not by itself mean that the latter had committed a substantial procedural violation (**T 87/88** (OJ 1993, 430), **T 538/89**, **T 182/92**). In **T 208/00** the board considered that the first-instance department had to be granted a certain degree of latitude in exercising its power of discretion, which in this case it had not overstepped in a clearly inappropriate manner. It stated that it was not equitable to reimburse the appeal fee especially as under the established case law of the boards of appeal not even "a gross error of judgment" by the department of first instance was regarded as justifying such reimbursement.

In **T 367/91** the board stated that to base a decision only on a wrong assessment of prior art and/or the claimed invention had to be regarded as a substantive error, not a procedural violation (see also **T 144/94**).

In **T 17/97**, the appellant's request for reimbursement of the appeal fee was based on the fact that the opposition division had disregarded document (5) pursuant to Art. 114(2) EPC and R. 71a(1) EPC. In the board's judgment this was caused by an erroneous assessment of the relevance of document (5). Such a misinterpretation, by its very nature, did not constitute a procedural violation within the meaning of R. 67 EPC.

It does not amount to a procedural violation if the examining division wrongly finds that a claim 1 is not sufficiently clear to comply with the requirements of Art. 84 EPC, even despite a possible error of judgment and the failure to seek clarification from the appellant (**T 680/89**).

The misinterpretation of a document does not constitute a procedural violation (**T 1049/92**, **T 162/82** (OJ 1987, 533)). In **T 588/92** the board pointed out that a different opinion on the specialist knowledge to be applied when interpreting the technical content did not represent a procedural violation. Even a gross error of judgment on the part of the examining division does not justify reimbursement of the appeal fee (**T 860/93**, OJ 1995, 47). A misinterpretation of a letter directed to the EPO body concerned constitutes an error of judgment and not a substantial procedural violation (**T 621/91**).

The failure of the examining division to follow a procedure set out in the Guidelines is not in itself a substantial procedural violation, unless it also constitutes a violation of a rule or principle of procedure governed by an article of the EPC or one of the Implementing Regulations, as the Guidelines are not legally binding (**T 42/84** (OJ 1988, 251), **T 51/94**, **J 24/96** (OJ 2001, 434)).

15.4.6 Other miscellaneous cases

In **J 5/81** (OJ 1992, 155) it was held that there was a substantial procedural violation where

the Receiving Section had ignored the **suspensive effect** according to Art. 106(1) EPC of an appeal.

T 227/95 related to a situation where a decision was taken by a board to remit the case to the department of first instance (opposition division) for further prosecution and not, as assumed by the division, with the instruction to maintain the patent. The fact that the opposition division had not carried out the board's order amounted to a substantial procedural violation with regard to Art. 111 EPC. The case was remitted again to the department of first instance, and the appeal fee was reimbursed.

The board of appeal ordered reimbursement of the appeal fee in **T 382/92**, because the **composition of the opposition division** had not complied with the requirements of Art. 19(2) EPC. The Chairman and one member of the opposition division had already been members of the examining division which had decided on the application leading to the patent concerned (see also **T 939/91**). A substantial procedural violation was also deemed to have occurred if the decision had been taken by a formalities officer who was not competent to decide (**J 10/82** (OJ 1983, 94), **T 114/82** (OJ 1983, 323), **T 790/93**).

In **T 225/96**, the board ruled that to issue the parties with a draft decision not approved by all opposition division members present at the oral proceedings was a substantial procedural violation.

In **T 231/85** (OJ 1989, 74) the board held that failure to take the applicant's requests into account as a **result of a delay within the EPO** (in this case six weeks) constituted a substantial procedural violation (see also **T 598/88**). Also, in **T 205/89**, due to a mistake by a formalities officer, a request for an extension of the time in which to submit comments in the opposition proceedings never reached the opposition division, which therefore decided without taking into account the argument presented in the later-filed submission.

In **J 20/96**, the application had been refused by the Receiving Section under Art. 91(3) EPC. The appellant had appealed against this decision, requesting reimbursement of the appeal fee under R. 67 EPC on the grounds that the EPO had waited one year and three months before requesting appointment of a professional representative and nearly another year before asking for the appellant's new address. Although conceding that the Receiving Section had been slow to request appointment of a professional representative, the Legal Board ruled that this was not a substantial procedural violation because appointment of a representative was a matter for the appellant; similarly, it was also up to him or his representative to provide his address.

In **J 3/87** (OJ 1989, 3) it was stated that if an EPO communication was not as clear and unambiguous as it ought to be, and led a reasonable recipient into error, that amounted to a substantial procedural violation, even if the ambiguity of the communication was partly due to an unfortunate provision of the law. In **J 17/92** the appellants complained that the examining division had used the wrong form for its communication, ie a form threatening that the application would be refused if a response was not filed. The examining division agreed that the form was wrong, but failed to withdraw it. The board considered that this failure to withdraw the wrong form, and then to withdraw the threatened sanction of a possible refusal

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of the application, amounted to a substantial procedural violation. The board ordered the reimbursement of the appeal fee as being equitable under R. 67 EPC.

In **J 3/91** (OJ 1994, 365) the Legal Board of Appeal refused the request for reimbursement of the appeal fee, stating that the **wrong transcription of a Japanese priority date** could not be considered a procedural violation. The Receiving Section was not obliged by procedural law to inform the applicant that the "Showa" year had been transcribed into the equivalent date in the Christian era. Such transcriptions were a routine matter familiar to practitioners dealing with industrial property rights.

In **T 804/94** the board ruled that there had been a substantial procedural violation as the opposition division had issued a decision rejecting the opposition before **expiry of the four-month period** it had set for responding to its communication.

In **T 425/97** the board decided 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 amounted to a procedural violation.

In **T 291/93** it was held that a simple reference by the appellant to an inadequate search of the prior art could not justify a substantial procedural violation. Also, remarks on substantive matters in a decision rejecting the opposition as inadmissible had no legal effect. Even if misleading, they did not represent a substantial procedural violation justifying the reimbursement of the appeal fee (**T 925/91** (OJ 1995, 469); see also **T 1051/92**).

In **J 32/97** the appellant argued that a procedural violation was committed by not sending a copy of the communications pursuant to R. 85a(1) EPC and R. 85b EPC to the international representative of the appellant, a new procedure applicable only to international applications with publication date on or after 31 October 1996, was rejected by the board. This new procedure was a courtesy service not required by the EPC. Therefore, the appellant was not entitled to base a claim on its omission or to claim that it should start earlier than actually foreseen.

The ground of appeal alleging that the different procedures for notifying documents to persons with residence in the contracting states and to those residing outside contravened Art. 2(1) of the Paris Convention (national treatment) was also not accepted by the board. The complaint of unfair treatment in view of Art. 4 of the TRIPS Agreement (most-favoured-nation treatment) was also rejected by the board.

The board refused the reimbursement of the appeal fee.

In **T 642/97**, a party alleged that the minutes were incomplete or wrong since essential submissions were not reflected in the file. The board held that the party 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.

15.5 Interlocutory revision

According to R. 67 EPC the reimbursement of appeal fees must be ordered in the event of interlocutory revision. However, reimbursement of appeal fees is not an automatic consequence of interlocutory revision. The proper interpretation of R. 67 EPC is that in the case of interlocutory revision there also has to have been a substantial procedural violation (see **T 79/91**, **T 536/92**). Otherwise, in **T 939/95**, the board interpreted R. 67 EPC to the effect that the words "if such reimbursement", read in their context, referred both to interlocutory revisions and appeals. This meant that for each of these stages it was a prerequisite that a substantial procedural violation had occurred **and** that reimbursement was found **equitable** in the discretion of the deciding body, be it the examining division or the board.

In **T 647/93** (OJ 1995, 132) it was pointed out that when the examining division did not make use of the possibility of granting interlocutory revision after the mistake had been pointed out in the grounds of appeal, this was normally deemed to constitute a procedural violation (see also **T 808/94**).

In **T 183/95** interlocutory revision was not granted under Art. 109 EPC and the appeal was remitted to the board. This might have constituted a substantial procedural violation if the department of first instance had mistakenly overlooked the fact that the applicant's submissions corresponded to suggestions by the department of first instance. Nevertheless, the board in this case pointed out that interlocutory revision could be granted at the discretion of the department of first instance when it was considering whether the appeal was "well founded". Thus, in this case, the remittal of the appeal could not be said to have been manifestly wrong from the procedural point of view.

As pointed out in **T 691/91**, the circumstances under which Art. 109 EPC empowers the examining division to rectify are narrowly circumscribed. This article provides for only two legally viable alternatives: maintaining the contested decision and remitting the case to the boards of appeal or annulling the decision and either granting the patent or, as the case may be, re-opening examination. In the case at issue, the examining division had chosen a third way: maintaining the earlier decision by issuing a decision on rectification. This alternative is not covered by the provisions of Art. 109 EPC. The fact that in order to do this the examining division had to amend the standard wording on Form 2702.2 for rectification by substituting "maintained in amended form" for "annulled" should have been a warning sign that it was exceeding its powers. The correct procedure would have been to remit the case to the board of appeal. Thus the way in which the examining division proceeded resulted in the appellant's having to file a second appeal against the decision on rectification. The board ordered reimbursement of the second appeal fee because the decision on rectification was *ultra vires*, and reimbursement of the first appeal fee because a violation of the right to be heard had occurred during the examination proceedings (see also **T 252/91**).

In **T 794/95** the board took the view that, under the circumstances of the case, the examining division should have rectified its decision under Art. 109(1) EPC and proceeded to the interlocutory revision expressly requested. The board did not, however, consider it equitable to order the reimbursement of the appeal fee, since the examination procedure up to the decision under appeal was not tainted with any failure and the necessity for the appellant to

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file an appeal emerged exclusively from the substance of the decision, not because of any procedural shortcomings up to this stage and equally not from the later incorrect handling of the appeal by the examining division (ie the failure to rectify its decision).

In **T 898/96** the board took the view that as soon as the applicant approved in the notice of appeal the text of the application as specified previously in a communication under R. 51(4) EPC, there was no reason why the patent should not have been granted, even if the applicant did not approve this text before filing the appeal. Thus the decision of the examining division to refuse the application having regard to Art. 113(2) EPC should have been rectified by way of interlocutory revision. The failure to rectify such a decision in this way was a substantial procedural violation. However, the board did not consider the refund of the appeal fee to be equitable, for the very reason that the applicant did not approve this text of the application until he filed an appeal.

In **T 685/98** (OJ 1999, 346) the board explained that provisions of Art. 109(1) EPC are tailor-made to enable the examining division to rectify expeditiously procedural irregularities of the kind which occurred in this case. However, it appeared that the examining division either failed to recognise that its decision to refuse when no reply within the meaning of Art. 96(3) EPC had been received was ultra vires or, despite this recognition, did not appreciate that it was mandatory in those circumstances to apply the said provisions and set its own purported decision aside. The pragmatic criterion of reasonable likelihood that the reopened procedure would lead to a patent being granted was not applicable where procedural rights were at issue as in the present case. In addition the precipitate decision of the examining division contravened Art. 113(1) EPC. Fundamental legal rights may not be subordinated to considerations of administrative efficiency.

Accordingly the board took this opportunity to stress the fact that where a fundamental procedural right has manifestly been violated in a refusal pursuant to Art. 97(1) EPC, or in the foregoing examination procedure, a further substantial procedural violation occurs if the examining division fails to grant interlocutory revision on appeal (following **T 647/93**, OJ 1995, 132) since such a right must be safeguarded irrespective of the substantive merits of the case.