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CONTENTS

Foreword to the fourth edition

This fourth edition of the "Case Law of the Boards of Appeal of the European Patent Office" updates the publication to the end of December 2001, whereby for the second half of 2001 mainly decisions which are scheduled for publication in the OJ EPO have been taken into account.

The same proven format has been used: dividing the case law into topics, then illustrating each by short summaries of selected decisions. Many chapters have been thoroughly revised, to give a full picture of the actual case law whilst keeping the publication to a manageable size.

The aim of the book is to help users pinpoint the decisions they need. No summary, however careful, can replace study of the actual decision. Nearly all DG 3's decisions are now available (in the language of proceedings) in the CD-ROM ESPACE-Legal series or in Internet; those published in the Official Journal can also be read in translation in the other two EPO official languages.

My special thanks go to the members of our Legal Research department who with great commitment have updated the text and revised the comprehensive index and table of cases. They go also to the EPO Language Service, without whose energetic co-operation simultaneous publication in our three official languages would not have been possible. Lastly, I wish to thank all the other EPO staff who have helped produce the present publication.

This latest report on the case law of the EPO boards of appeal will be a mine of information for everyone concerned with European patent law.

Peter Messerli
Chairman of the Enlarged Board of Appeal
Vice-President Directorate-General 3

Reader's Guide

1. Abbreviations

Art.	Article of the European Patent Convention
BlfPMZ	(Blatt für Patent-, Muster- und Zeichenwesen)
Budapest Treaty	Budapest Treaty on the International Recognition of the Deposit of Microorganisms
CAFC	US Court of Appeal for the Federal Circuit
Contracting States	Contracting States to the European Patent Convention
Corr.	corrigendum
EC	European Community
EPC	European Patent Convention
epi	European Patent Institute (Institute of Professional Representatives before the EPO)
EPO	European Patent Office
EQE	European Qualifying Examination
Guidelines	Guidelines for Examination in the European Patent Office
IP	Implementing provisions to the REE
IPEA	International Preliminary Examining Authority
IRB	International Patentinstitute
IRPI	French Institute for research into intellectual property
ISA	International Searching Authority
OJ	Official Journal of the EPO
Paris Convention	Paris Convention for the Protection of Industrial Property
PatG	Patent law (Patentgesetz)
PCT	Patent Cooperation Treaty
PIBD	Bulletin on intellectual property (Propriété industrielle Bulletin Documentaire)
R.	Rule of the Implementing Regulations to the EPC
RDR	Regulation on discipline for professional representatives
REE	Regulation on the European qualifying examination for professional representatives
rev.	revised
RFees	Rules relating to Fees
RPBA	Rule of procedures of the Boards of Appeal
RPC	Reports of Patent Design and Trademark cases
TRIPS	Agreement on Trade-related Aspects of Intellectual Property Rights
UPOV	International Union for the protection of new varieties of plants
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization

2. Citations

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

(b) The Official Journal of the EPO is cited as OJ, followed by the year of publication and page number (eg OJ 1993, 408).

(c) If a decision of a Board of Appeal has been **published** in the OJ the reference is given.

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

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

(d) The citation "**Special edition of the Official Journal 1999 - Case Law**", for example, refers to the Board's case law 1998, published as an OJ supplement in 1999).

3. Case numbers

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

G Decisions of the Enlarged Board

J Decisions of the Legal Board

T Decisions of a Technical Board

W Decisions of a Technical Board on protests under R. 40.2 or 68.3 PCT

D Decisions of the Disciplinary Board

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

Headnotes of decisions to be published in the OJ and which became available after final editing of the main text (only in the language of proceedings).

T 9/00 - 3.3.2 (18 December 2001)

Headnote:

Legt eine (juristische) Person durch zwei verschiedene Schriftsätze Einspruch gegen ein erteiltes Patent ein, so erlangt sie nur einmal die Rechtsstellung als Einspruchspartei, auch wenn beide Schriftsätze die Voraussetzungen der Art. 99 (1) EPÜ und der R. 55 EPÜ erfüllen (siehe Gründe 2.cc)).

Begründet der zuletzt gestellte Einspruch dieser Person keine Änderung des rechtlichen Rahmens im Einspruchsverfahren gegenüber dem zuerst gestellten Einspruch, so ist der später gestellte Einspruch mangels allgemeinen Rechtsschutzbedürfnisses unzulässig.

Ein allgemeines Rechtsschutzbedürfnis kann für den zuletzt gestellten Einspruch nicht daraus abgeleitet werden, daß er einem anderen Geschäftsbereich zugeordnet wird als der zuerst eingelegte Einspruch und nur dieser Geschäftsbereich an einen Dritten übertragen wird.

Ist der Gegenstand eines Einspruchs zwei verschiedenen Geschäftsbereichen des Unternehmens der Einsprechenden zugeordnet, wie im vorliegenden Fall, kann die Parteistellung der Einsprechenden nur durch Übertragung beider Geschäftsbereiche oder des gesamten Unternehmens auf einen Dritten übergehen.

T 789/96 - 3.4.1 (23 August 2001)

Headnote:

Est dépourvue de caractère thérapeutique au sens de l'art. 52(4) CBE une méthode appliquée au corps humain ou animal qui implique l'utilisation d'un stimulateur cardiaque produisant des effets thérapeutiques, dès lors que l'invention consiste à perfectionner ladite méthode, mais que le perfectionnement n'a pas pour effet de prévenir ou de traiter un état pathologique.

T 323/97 - 3.3.6 (17 September 2001)

Headnote:

I. An amendment to a patent by the introduction of a "negative" technical feature into a claim resulting in the exclusion of certain embodiments is, regardless of the name "disclaimer", none the less an amendment governed by Art. 123(2) and (3) EPC (point 2.2 of the Reasons for the Decision).

II. Re: Admissibility of disclaimers (point 2.3 to 2.5 of the Reasons for the Decision).

G 3/99 (18. Februar 2002)

Leitsätze:

1. An opposition filed in common by two or more persons, which otherwise meets the requirements of Art. 99 EPC and R. 1 and 55 EPC, is admissible on payment of only one opposition fee.

2. If the opposing party consists of a plurality of persons, an appeal must be filed by the common representative under R. 100 EPC. Where the appeal is filed by a non- entitled person, the Board of Appeal shall consider it not to be duly signed and consequently invite the common representative to sign it within a given time limit. The non-entitled person who filed the appeal shall be informed of this invitation. If the previous common representative is no longer participating in the proceedings, a new common representative shall be determined pursuant to R. 100 EPC.

3. In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it has to be clear throughout the procedure who belongs to the group of common opponents or common appellants. If either a common opponent or appellant (including the common representative) intends to withdraw from the proceedings, the EPO shall be notified accordingly by the connom representative or by a new common representative determined under R. 100(1) EPC in order for the withdrawal to take effect.

I. PATENTABILITY

European patents shall be granted for any inventions which are susceptible of industrial application, which are new and which involve an inventive step.

A. Patentable inventions

Art. 52(2) EPC contains a non-exhaustive list of things which shall not be regarded as inventions. It will be noted that the exclusions on this list are all either abstract (eg discoveries, scientific theories etc.) or non-technical (eg aesthetic creations or presentations of information). Art. 52(4) EPC provides that methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application.

1. Technical nature of an invention

An invention must have a technical character. In particular, this requirement is not met if the patent application or the patent relates to mathematical methods, rules and methods for performing mental acts or doing business, presentation of information or computer programs **as such** (see Art. 52(2), (3) EPC).

To assess the latter criterion a number of decisions have adopted the approach that an invention has a technical character if it provides a technical contribution to the art in a field not excluded from patentability under Art. 52(2) EPC (**T 121/85**, **T 38/86** (OJ 1990, 384), **T 95/86**, **T 603/89** (OJ 1992, 230), **T 71/91**, **T 236/91**, **T 833/91**, **T 77/92**).

However, recent decisions considered this approach not to be appropriate to assess whether or not an invention has technical character.

In **T 931/95** (OJ 2001, 441) the board stated that there was no basis in the EPC for distinguishing between "new features" of an invention and features of that invention which are known from the prior art when examining whether the invention concerned may be considered to be an invention within the meaning of Art. 52(1) EPC. Thus there was no basis in the EPC for applying the so-called contribution approach for this purpose. Indeed, this approach confused the requirement of "invention" with the requirements of "novelty" and "inventive step". Already in **T 1173/97** (OJ 1999, 609) it was held that determining the technical contribution an invention achieved with respect to the prior art was more appropriate for the purpose of examining novelty and inventive step than for deciding on possible exclusion under Art. 52(2) and (3) EPC.

According to **T 931/95,** criteria to decide whether or not the requirement of technical character or technicality was fulfilled by an invention as claimed may be a technical effect achieved by the invention (eg the "further technical effect" of a computer program within the meaning of **T 1173/97,** OJ 1999, 609 - see below I.A.1.1), or the fact that technical considerations were required to carry out the invention (cf. **T 769/92**, OJ 1995, 525 - see below I.A.1.4). On the other hand, the mere occurrence of technical features in a claim did thus not turn the subject-matter of the claim into an invention within the meaning of Art. 52(1) EPC. Such an approach would be too formalistic and would not take due account of the term "invention".

1.1 Computer-implemented inventions

The Guidelines for Examination in the European Patent Office (as revised in 2001) now use the term computer-implemented inventions to indicate claims which involve computers, computer networks or other conventional programmable apparatus whereby prima facie the novel features of the claimed invention are realised by means of a program or programs. The non-patentability of computer programs **as such** does not preclude the patenting of computer-implemented inventions. If the claimed subject-matter has a technical character it is not excluded from patentability by the provisions of Art. 52(2) and (3) EPC. Even after the criticism against the "contribution approach" for assessment of the technicality of an invention the case law starting with **T 208/84** (OJ 1987, 14) remains the basis for EPO practice with regard to computer-implemented inventions.

T 208/84 (OJ 1987, 14) set out the principles governing the patentability of computer-related inventions. Even if the idea underlying an invention may be considered to reside in a mathematical method, a claim directed to a technical process in which the method is used does not seek protection for the mathematical method **as such**. A claim directed to a technical process carried out under the control of a program (whether by means of hardware or software) cannot be regarded as relating to a computer program **as such**. A claim which can be considered as being directed to a computer set up to operate in accordance with a specified program (whether by means of hardware or software) for controlling or carrying out a technical process cannot be regarded as relating to a computer program **as such**.

The next leading case, decision **T 26/86** (OJ 1988, 19), examined whether an X-ray apparatus incorporating a data processing unit operating in accordance with a routine was patentable. The board considered that the claim related neither to a computer program on its own and divorced from any technical application, nor to a computer program in the form of a recording on a data carrier, nor to a known, general purpose computer in combination with a computer program. It found instead that the routine in accordance with which the X-ray apparatus operated produced a technical effect, ie it controlled the X-ray tubes so that by establishing a certain parameter priority, optimum exposure was combined with adequate protection against overloading of the X-ray tubes.

The invention was therefore patentable irrespective of whether or not the X-ray apparatus without this computer program formed part of the state of the art. The board held that an invention must be assessed as a whole. If it made use of both technical and non-technical means, the use of non-technical means did not detract from the technical character of the overall teaching. The EPC does not prohibit the patenting of inventions consisting of a mix of technical and non-technical elements.

The board therefore regarded it as unnecessary to weigh up the technical and non-technical features in a claim in order to decide whether it related to a computer program as such. If the invention defined in the claim used technical means, its patentability was not ruled out by Art.

52(2)(c) and (3) EPC and it could be protected if it met the requirements of Art. 52 to 57 EPC.

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

In **T 6/83** (OJ 1990, 5) the board found that an invention relating to the co-ordination and control of the internal communication between programs and data files held at different processors in a data processing system having a plurality of interconnected data processors in a telecommunications network, the features of which were not concerned with the nature of the data and the way in which a particular application program operated on them, was to be regarded as solving a problem which was essentially technical. The control program was therefore comparable to the conventional operating programs required for any computer to coordinate its internal basic functions and thereby permit the running of a number of programs for specific applications. Such an invention was to be regarded as solving a problem which was essentially technical and thus an invention within the meaning of Art. 52(1) EPC.

In **T 158/88** (OJ 1991, 566) the board stated that a method for the display of characters (eg Arabic characters) in a particular preset shape chosen from several possible character shapes did not in essence describe a technical method of operating a data processing system and its visual display unit, but an idea for a program. A computer program did not become part of a technical operating method if the teaching claimed was confined to changing data and did not trigger any effect over and above mere data processing. When examining whether the method in question served to solve a technical problem which could make the program defined in the claim patentable as part of a teaching on technical operations, the board came to the conclusion that where the data to be processed according to a claimed method represented neither operating parameters nor a device, nor had a physical or technical effect on the way the device worked, and no technical problem was solved by the claimed method, the invention defined in the claim did not make use of any technical means and in accordance with Art. 52(2)(c) and (3) EPC could not be regarded as a patentable invention within the meaning of Art. 52(1) EPC.

In **T 769/92** (OJ 1995, 525) the board held that an invention comprising functional features implemented by software (computer programs) was not excluded from patentability under Art. 52(2)(c) and (3) EPC if technical considerations concerning particulars of the solution of the problem the invention solved were required in order to carry out that same invention. Such technical considerations lent a technical nature to the invention in that they implied a technical problem to be solved by (implicit) technical features. An invention of this kind was considered not to pertain to a computer program as such under Art. 52(3) EPC. The decision set out that non-exclusion from patentability could not be destroyed by an additional feature which as such would itself be excluded, as in the present case features referring to management systems and methods which might fall under the "methods for doing business" excluded from patentability under Art. 52(2)(c) and (3) EPC.

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

In **T 953/94**, claim 1 of the main request related to a method of generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a plurality of plots relating two parameters to one another. The board held that such a method could not be regarded as a patentable invention, because an analysis of the cyclical behaviour of a curve was clearly a mathematical method excluded as such from patentability. The reference to a digital computer only had the effect of indicating that the claimed method was carried out with the aid of a computer, ie a programmable general-purpose computer, functioning under the control of a program excluded as such from patentability. The fact that the description disclosed examples in both non-technical and technical fields confirmed that the problem solved by the claimed mathematical method was independent of any field of application and could thus lie, in the case at issue, only in the mathematical and not in a technical field.

The fifth auxiliary request read as follows: "A method of controlling a physical process based on analysing a functional relationship between two parameters of the physical process comprising the steps of: measuring the values of the two parameters, and generating with a digital computer a data analysis of the cyclical behaviour of a curve represented by a plurality of plots relating the two parameters to one another, ..." The last feature was worded as follows: "(h) extending the range of said one parameter in accordance with the data generated for displaying on a visual display unit the prolongation of said curve for use in the control of said physical process."

The board emphasised that claim 1 of the fifth auxiliary request was not excluded from patentability only because of the insertion of the expression "for use in the control of said physical process". Contrary to the decision of the opposition division the board decided that this wording limited the claim in a technical sense. Claim 1 no longer referred to the mere possibility of using the mathematical method in a technical or physical process. It was agreed that if the expression "for use" were understood as merely indicating that the claimed extension of the range of a parameter for displaying the prolongation of the curve would be "suitable" for use in the process control, such an interpretation might cast doubt on the effectiveness of the limitation of the claim. However, in conjunction with the expressly intended restriction of the claimed method to a "method of controlling a physical process" the word "for", in the board's view, could no longer be interpreted as merely meaning "suitable" but as "used to control a physical process". The board concluded that the subject-matter of the fifth auxiliary request in its proper interpretation was not excluded from patentability.

In **T 1173/97** (OJ 1999, 609) and **T 935/97** the board of appeal examined the patentability of computer program products. The claims rejected by the examining division were directed, i. a., to computer program products directly loadable into the internal memory of a digital computer or stored on a computer usable medium or to a computer readable medium, having a program recorded thereon. The board pointed out that the only relevant source of substantive patent law was the EPC. However, the recent developments in the U.S. and Japan relating to patent protection for computer program products (although the legal situation in these countries differed greatly from that under the EPC) and the TRIPS agreement (even though this treaty was not directly applicable to the EPC) represented a useful interpretation of modern trends and might contribute to a world-wide harmonisation of patent law.

The board started from the assumption that for an invention to be patentable under the EPC it must have a technical character. Programs for computers could be considered as patentable inventions if they have a technical character. Their technical character could not however be acknowledged for the sole reason that programs cause physical modifications of the hardware (eg electrical currents) deriving from the execution of the program instructions. A technical character might however be found in further effects deriving from the execution by the hardware of the instructions given by the computer program: Where these further effects had a technical character or where they cause the software to solve a technical problem, an invention which brought about such an effect might be considered an invention, which could, in principle, be the subject-matter of a patent.

However, every computer program product only produced and showed in physical reality an effect if the program concerned was made to run on a computer. The computer program product itself only possessed the "potential" to produce also a "further" technical effect. As the board saw no good reason for distinguishing between a direct technical effect and the potential to produce a technical effect it held that a computer program product having this potential to cause a predetermined further technical effect was, in principle, not excluded from patentability under Art. 52(2)(3) EPC. Thus, a computer program claimed by itself was not excluded from patentability if the program, when running on a computer or loaded into a computer, brought about, or was capable of bringing about, a technical effect which went beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it was run. The board has not yet decided how such a claim is to be formulated.

In **T 513/98** the invention addressed the problem of making it possible to use the mailer stations having computer controllable databases interconnected, by a communication link, with a computerized central data station in a more efficient and economical manner. The problem arose in the use of a system which was technical per se and thus not excluded from patentability (Art. 52(2) and (3) EPC). Even if the new features of the system did not change the hardware of the known system, the required software changes would nevertheless cause the system to be technically different with respect to the dividing, storing and transmitting of mail handling data. Moreover, the board pointed out that, although these changes might be essentially inspired by methods for doing business, they nevertheless involved technical considerations relating to the field of mailing, such as the overall operation of the interconnected system, the provision of storage area for mail handling categories, the prevention of unauthorized access to the categories and the transmission of information from these categories. Therefore, these features had to be considered as technical features in the meaning of R. 29(1) EPC which contributed to solving a problem arising in mailing systems and which for these reasons, could not be disregarded when judging inventive step (see also **T 769/92**, OJ 1995, 525, point 3.3 and **T 1173/97**, OJ 1999, 609, points 7.4 and 8).

1.2 Word-processing

Decision **T 115/85** (OJ 1990, 30) related to a method for displaying one of a set of predetermined messages comprising a phrase made up of a number of words, each message indicating a specific event which might occur in the input-output device of a word processing system which also included a keyboard, a display and a memory.

The board observed that giving visual indications automatically about conditions prevailing in an apparatus or a system was basically a technical problem. The application proposed a solution to such a technical problem involving the use of a computer program and certain tables stored in a memory. It adopted the principle laid down in decision **T 208/84** (see also I.A.1.1): an invention which would be patentable in accordance with conventional patentability criteria should not be excluded from protection by the mere fact that for its implementation modern technical means in the form of a computer program are used. However, it did not follow from this that conversely a computer program could under all circumstances be considered as constituting technical means. In the case in question the subject-matter of the claim, phrased in functional terms, was not barred from protection by Art. 52(2) EPC and Art. 52(3) EPC.

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

In **T 38/86** (OJ 1990, 384) the board first of all had to assess the patentability of a method for automatically detecting and replacing linguistic expressions which exceeded a predetermined understandability level in a list of linguistic expressions. The board was of the opinion that a person who wished to carry out such a task using his skills and judgment would perform purely mental acts within the meaning of Art. 52(2)(c) EPC; the schemes, rules and methods used in performing such mental acts are not inventions within the meaning of Art. 52(1) EPC. The board stated that the use of technical means for carrying out a method, partly or entirely without human intervention, which, if performed by a human being, would require him to perform mental acts, may, having regard to Art. 52(3) EPC, render such a method a technical process or method and therefore an invention within the meaning of Art. 52(1) EPC. Since patentability is excluded only to the extent to which the patent application relates to excluded subject-matter or activities as such, it appeared to be the intention of the EPC to permit patenting in those cases in which the invention involves a contribution to the art in a field not excluded from patentability. In the case in point this condition was not satisfied: once the steps of the method for performing the mental acts in question had been defined, the implementation of the technical means to be used in those steps involved no more than the straightforward application of conventional techniques and had therefore to be considered obvious to a person skilled in the art. In the case of a claim for an apparatus (here, a word processing system) for carrying out a method which did not specify any technical features beyond those already comprised in a claim pertaining to said method and furthermore did not define the apparatus in terms of its physical structure, but only in functional terms corresponding to the steps of that method, the board stated that the claimed apparatus did not contribute anything more to the art than the method. Thus, in spite of the fact that the claim was formulated in a different category, in such cases, if the method was excluded from patentability, so was the apparatus.

Decision **T 38/86** was confirmed by decision **T 121/85**. The claims related to word processing carried out by a word processing system including a processor controlled by a computer program. The board concluded that nothing in the disclosure pointed to a contribution, such as a program, going beyond the fields of linguistics and computer functioning directly derived from the linguistic rules to be applied (the applicant had claimed software solutions to the linguistic problem of checking the spelling of a word). Thus the claim was excluded from patentability under Art. 52(2)(c) and (3) EPC.

The patentability of computer-related inventions was again considered in decision **T 95/86**. The applicant had claimed a method of text editing. The board found the activity of editing a text to be principally concerned with its linguistic and layout features. The editing of a text as such - even performed with the aid of a machine - therefore fell within the category of schemes, rules and methods for performing mental acts which under Art. 52(2)(c) and (3) EPC are not patentable. The board took the view that the mere setting out of the sequence of steps necessary to perform an activity - excluded as such from patentability - did not import any technical considerations, even if those steps were described as functions or functional means to be implemented with the aid of conventional computer hardware elements.

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

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

The interrelationship of excluded and non-excluded features was considered in **T 236/91**. Following **T 208/84** (OJ 1987, 14), **T 38/86** (OJ 1990, 384) and **T 26/86** (OJ 1988, 19), the board reiterated that while the EPC does not prohibit the patenting of inventions consisting of a mix of excluded and non-excluded features, and since patentability is excluded only to the extent to which the patent application relates to excluded subject-matter or activities as such, it appeared to be the intention of the EPC to permit patenting (only) in those cases in which the invention involved a contribution to the art in a field not excluded from patentability.

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

1.3 Presentations of information

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

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

In **T 77/92**, the invention concerned a method of selecting, in emergency situations, the correct patient treatment values, namely drug dosage, defibrillation technique energy and/or apparatus size. The method comprised measuring the body length of the emergency patient using a particular tape and rapidly selecting the said correct patient treatment values without the exercise of clinical expertise, calculation or reference to other data sources. The particular tape used had increments of heel-to-crown length, each increment bearing indications of the correct treatment value appropriate to that increment and predetermined by a co-relation between the measured heel-to-crown height of a patient and a correct treatment value. According to the established case law, for an invention not to be excluded from patentability, the board in **T 77/92** had to consider whether the subject-matter claimed, which had to be assessed as a whole, was technical in character or provided a technical contribution to the prior art, i.e. a contribution in a field not excluded from patentability. After having defined the prior art, the board concluded that the decision under appeal did not adequately evaluate the co-relation between the heel-to-crown length of a patient and each of the treatment values provided on the measuring tape. This co-relation between the measured length and the information on the tape measure resulted in the tape used in the claimed methods becoming a new gauge for directly measuring the patient treatment values, just as an altimeter is obtained merely by replacing the scale of a pressure gauge with a scale indicating altitude. Such a new gauge for directly measuring the patient treatment values was clearly technical in character.

Further to **T 115/85** (see p. 6) the board ruled in **T 362/90** that automatic visual display of the conditions prevailing or desirable in an apparatus or system was basically a technical problem. A claim directed to a device displaying (especially in heavy goods vehicles) both the gear in use and (by evaluating signals about engine performance) the best gear to be in was not unpatentable under Art. 52(2)(d) EPC even if it did involve non-technical features relating to the presentation of information.

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

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

In **T 599/93** a configuration for simultaneously displaying several images on one (computer) screen was claimed. The screen was divided into four sections, for example by means of one horizontal and one vertical demarcation line. The size of the sections could be altered by moving a setting mark located at the intersection of the demarcation lines. The surfaces of the setting mark located inside the windows could each be selected separately to indicate particular contents of the window concerned, eg by a change of colour, even if the window in question was not, or not fully, visible at the time.

The board was of the view that imparting information on events in a screen window by changing the colour of the relevant surface of the setting mark was not of a technical nature (no information was given for example on the operating status of the claimed configuration), but merely drew the user's attention to particular contents of the relevant images and thus served to present information within the meaning of Art. 52(2)(d) EPC. This feature could not therefore contribute to inventive step.

In **T 1194/97** (OJ 2000, 525) the patent application concerned a two-part picture retrieval system comprising a record carrier and a read device, ie two separate but cooperative articles which may be sold separately, but each of which was specially adapted to implement complementary aspects of the same inventive idea. Claim 1 was directed to the system while claim 4 sought to protect the record carrier per se. In accordance with a standard claiming practice with inventions of this kind - colloquially referred to as "bow and arrow" or "plug and socket" inventions - the record carrier of claim 4 was specified as being "for use in the system as claimed in claim 1".

The examining division had interpreted claim 4 as specifying a known record carrier having data stored thereon, said data having no unambiguous technical function, and had concluded, with reference to Art. 52(2)(d) EPC, that "for the purposes of assessing the technical merits of the record carrier, what is stored on the record carrier is effectively a mere presentation of information". The board regarded the examining division's interpretation of claim 4 as a misconstruction of the effect of the "for use" phrase. It pointed out that, on a proper construction of this phrase the record carrier of claim 4 had technical functional features - line numbers, coded picture lines and addresses and synchronisations - which were adapted to cooperate with corresponding means in the read device to provide a picture retrieval system.

Applying and extending the ratio decidendi of **T 163/85** by analogy, the board held that the record carrier of claim 4 was not excluded by Art. 52(2)(d) and (3) EPC, since it had functional data recorded thereon, in particular a data structure of picture line synchronisations, line numbers and addresses. In order to lend additional support to its view in relation to a data structure product, the board also referred to decision **T 1173/97** (OJ 1999, 609) and, in particular, to the observation made in that decision at point 9.4 of the reasons to the effect that the predetermined potential technical effect of a program recorded on a carrier could endow such a product with technical character sufficient to overcome the exclusions under Art. 52(2) and (3) EPC.

In addition, the board pointed out that the passage in the Guidelines for examination at the EPO (version before September 2001) at C-IV, 2.3 under the heading "Presentations of information" extended unduly the exclusion from patentability contained in Art. 52(2)(d) and (3) EPC, insofar as it did not distinguish between presentations of information which were characterised by cognitive content and recordings of information which comprised functional data as explained under points 3.3 to 3.6 of the decision. The passage concerned reads as follows: "Any representation (sic) of information characterised solely by the content is not patentable and the examples given there of excluded matter including magnetic computer tapes characterised by the data or programs recorded".

1.4 Methods for doing business

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

In **T 636/88** claim 1 was for a method of distributing material transported in bulk by ship: on the quayside a weighing and bagging apparatus was mounted which could be shipped in standard containers and was used to unload and bag the material before moving on to the next port. The other claims were directed to the bagging apparatus itself.

The opponent argued that the patent proprietor's commercial success derived merely from a method for doing business within the meaning of Art. 52(2)(c) EPC, namely contract bagging of bulk material in a manner permitting offloading at ports (eg in developing countries) which did not have any bagging plant on site. The board however took the view that the method claimed clearly did have technical character, involving as it did the use of technical equipment (bagging apparatus) to achieve a technical end (the production of sealed, weighted bags of the material in question). It also necessitated the use of bagging apparatus which had no counterpart in the prior art.

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

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

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

In the view of the board, restricting the application to financial and inventory management did not give rise to an objection under Art. 52(2)(c) EPC. By this restriction, the claimed subject-matter only gained, in addition to the combination of features which were not excluded from patentability, a further feature which, as such, would be excluded. However, it was established board of appeal practice to allow patentability for a mix of technical and non-technical features.

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

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

In **T 931/95** (OJ 2001, 441) the board addressed the patentability of inventions relating to business methods. It reaffirmed that Art. 52(2) and (3) EPC were to be understood as implying a "requirement of technical character" or "technicality" which is to be fulfilled by an invention as claimed in order to be patentable. Thus an invention may be an invention within the meaning of Art. 52(1) EPC if for example a technical effect is achieved by the invention or if technical considerations are required to carry out the invention. The board also referred to **T 1173/97** (OJ 1999, 609) where it had decided that a computer program product that had technical character was not a computer program as such and was, therefore, not excluded from patentability but represented a patentable invention.

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

The board added that the individual steps defining the claimed method amounted to no more than the general teaching to use data processing means for processing or providing information of purely administrative, actuarial and/or financial character, the purpose of each single step and of the method as a whole being a purely economic one. Using technical means for a purely non-technical purpose and/or for processing purely non-technical information did not necessarily confer technical character to any such individual steps of use or to the method as a whole. The mere occurrence of technical features in a claim did not turn the subject-matter of the claim into an invention within the meaning of Art. 52(1) EPC.

In the present case the board reviewed several other decisions including **T 208/84** (OJ 1987, 14) pointing out that the then claimed method for digitally processing images was considered to be a technical process essentially for the reason that it was carried out on a physical entity. The method produced a technical result by applying particular digital image processing methods for example for enhancing and restoring images. In **T 769/92** (OJ 1995, 525) the method for operating a general-purpose computer menagement system had technical character because it implied a need for technical considerations when carrying out that invention. A technical invention could not lose its technical character, because it was used for a non-technical purpose like, eg, financial management. The purpose of such a method and of its individual steps remained a technical one, namely operating a technical system and in **T 1002/92** (OJ 1995, 605) the system for determining the queue sequence for serving customers at a plurality of service points was decided to be a three-dimensional apparatus and, therefore, clearly technical in nature.

With respect to the appellant's first auxiliary request seeking protection for an apparatus for controlling a pension benefits system, the board held that a computer system suitably programmed for use in particular field, even if that was the field of business and economy had the character of a concrete apparatus. An apparatus constituting a physical entity or concrete product suitable for performing or supporting an economic activity, was an invention within the meaning of Art. 52(1) EPC.

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

1.5 Aesthetic creations

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

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

In decision **T 119/88** (OJ 1990, 395) the subject-matter of the application in question related to a flexible disk jacket made of a plastic sheet presenting to the outside world a surface colour of a certain minimum light intensity. The board first of all stated that the feature of having a specific colour as such did not constitute a technical feature indicating that an object or device was entirely or partly covered by that colour; however, the board did not rule out the possibility that this did not hold in all circumstances. The feature taken by itself might not seem to reveal any technical aspect, but its technical or non-technical character could be decided by the effect it brought about after being added to an object which did not comprise the feature before. In the case in point, the board concluded that the alleged resistance to fingerprints was a purely aesthetic effect which contributed nothing technical to the invention concerned (Art. 52(2)(b) EPC) and the advantage of easy classification by colour represented a non-technical effect in the form of a presentation of information. As such it was excluded from patentability under Art. 52(2)(d) and (3) EPC.

1.6 Lack of technical character in general

As already stressed in previous decisions, an invention must be technical in character, ie it must solve a technical problem to be patentable under Art. 52 EPC (see also supra I.A.1.).

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

In **T 222/89** the board found that where the sole characterising feature lacked causal significance for achieving the invention claimed, it did not constitute patentable technical teaching. The board thus followed **T 192/82** (OJ 1984, 415) which had ruled that the amending feature must not only characterise the invention, ie distinguish it from the prior art, but also - if the invention consists of altering known subject-matter to enhance its known effect - make a causal contribution to improving that effect. In the claim for optimising the design of a piston drive, the board considered the sole characterising feature not to be a technical feature which caused the improvement, but rather a description of the desired configuration in geometric terms since the optimisation would require design ideas other than the teaching as per the claim.

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

In **T 833/91** the board stated that all the different matters or activities listed in Art. 52(2) EPC seemed to have in common the fact that they implied something non-technical and, secondly, that from Art. 52(3) EPC it would appear to be the EPC's intention to permit patenting (only) in those cases in which the invention involves some contribution to the art in a field not excluded from patentability. The board thus concluded that, in accordance with the consistent case law of the Boards of Appeal, it could be said that the technical contribution to the art rendering a claimed invention an invention within the meaning of Art. 52(1) EPC and thus patentable, might lie either in the problem underlying, and solved by, the claimed invention, or in the means constituting the solution of the underlying problem, or in the effects achieved in the solution of the underlying problem. In the case in point the claimed invention concerned the designing or developing of application (or user) programs for computers, ie it addressed a program designer or programmer. The board pointed out that programs for computers as such were expressly excluded from patentability and a programmer's activity would involve performing mental acts and therefore also fell within the exclusions under Art. 52(2)(c) EPC. Furthermore, displaying data was presentation of information and thus excluded by Art. 52(2)(d) EPC. The board held that the contribution to the state of the art made by the invention was not technical, that the subject-matter did not make any contribution to the art in a field not excluded from patentability and was not therefore to be regarded as an "invention" within the meaning of Art. 52(1) EPC.

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

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

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

2. Medical methods

2.1 Introduction

Art. 52(4) EPC states that methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body are not to be regarded as inventions which are susceptible of industrial application. The wording of Art. 52(4) EPC implicitly recognises that such methods are susceptible of industrial application as a matter of reality, but provides that they "shall not be regarded as" inventions which are susceptible of industrial application, by way of legal fiction. In other words, for the particular methods defined in Art. 52(4) EPC, Art. 52(4) EPC takes precedence over Art. 57 EPC (**T 116/85**, OJ 1989, 13).

The methods set out in Art. 52(4) EPC are excluded from patentability as a matter of policy. This exclusion is not a new provision under the EPC. Before the EPC came into force, such methods were excluded from patentability under the national laws of many European countries. The policy behind the exclusion of such methods was clearly to ensure that those who carry out such methods as part of the medical treatment of humans or the veterinary treatment of animals should not be inhibited by patents (see **T 116/85** (OJ 1989, 13), **T 82/93** (OJ 1996, 274)).

According to **G 5/83** (OJ 1985, 64) the intention of Art. 52(4) EPC was only to prevent non-commercial and non-industrial medical and veterinary activities from being restrained by patent rights (see **T 245/87**, OJ 1989, 171). In **T 385/86** (OJ 1988, 308) the board stated that Art. 52(4) EPC, first sentence, represented an exception to the general obligation to patent inventions. Like any exclusion clause, Art. 52(4) EPC, first sentence, had to be **narrowly construed**, and should not apply to treatments which were not therapeutic in character (see **T 144/83**, OJ 1986, 301), or did not constitute a surgical or diagnostic method - a fact underscored by the statement in the second sentence that the exclusion from patentability did not apply to products for use in such methods.

2.2 Allowability of claims under Article 52(4) EPC

2.2.1 General remarks

The recent case law of the boards of appeal concerning inventions excluded by Art. 52(4) EPC has made it clear that the exclusion of one feature under Art. 52(4) EPC is sufficient to exclude the whole claim from patentability. It is important to draw a clear distinction between this principle and the established case law under Art. 52(2) and (3) EPC concerning the patentability of a mix of technical and non-technical features because the reasons for exclusion from patentability of medical methods and of the subject-matter under Art. 52(2) and (3) EPC are different. Art. 52(4) EPC prevents the methods specified from being patented, even though otherwise they might be considered as inventions susceptible of industrial application as required by Art. 52(1) EPC. By way of contrast, Art. 52(2) and (3) EPC is based on the assumption that only technical inventions can be protected by patents and, consequently, excludes subject-matter and activities without technical character (see **T 116/85** (OJ 1989, 13), **T 769/92** (OJ 1995, 525 Headnote 2)).

To answer the question whether a method claim is allowable under Art. 52(4) EPC, it is necessary to ascertain, according to the jurisprudence of the boards of appeal, whether none of the steps of the method fall under the prohibition of Art. 52(4) EPC (**T 820/92**, OJ 1995, 113) or in other words, whether there is any disclosure of a method falling under the prohibition of the said provision. If so, such a method cannot be subject-matter or part of the subject-matter covered by a method claim (**T 438/91**). A claim is not allowable if it includes at least one feature defining a physical activity or action which constitutes a method for treatment of the human body by therapy (**T 82/93,** OJ 1996, 274). Here, the purpose of the claimed subject-matter and inevitable effect of the feature under consideration is the most relevant criterion (**T 329/94**, OJ 1998, 241).

2.2.2 Multi-step methods and Art. 52(4) EPC

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

The board observed that while the treatment of the female mammal with a given effective amount of an LHRH composition was carried out to produce the desired contraceptive effect, the concurrent treatment with the oestrogenic and progestational steroids was carried out not to produce any contraceptive effect but as a prophylactic treatment to avoid the consequences for health which would otherwise occur as a result of the use of the LHRH composition. The latter step, therefore, was a treatment by therapy within the meaning of Art. 52(4) EPC. The board noted that in the case of a method involving the administration of two or more substances, the question for the purposes of Art. 52(4) EPC was not whether the main or even the only reason for carrying out the whole of the claimed method was non-therapeutic. Rather, a method claim fell under the prohibition of Art. 52(4) EPC merely if the purpose of the administration of one of the substances was a treatment by therapy, and the administration of this substance was a feature of the claim (see also **T 1077/93**).

In **T 82/93** (OJ 1996, 274) the board, after making it clear that claims including both features relating to physical activities and features relating to physical entities were also possible, held that under Art. 52(4) EPC a claim was not allowable if it included at least one feature defining a physical activity or action (eg a method step) which constituted a "method for treatment of the human body by therapy".

In **T 182/90** (OJ 1994, 641), method claims were allowed even though one step of the method included a **surgical step** on a living animal. But they were allowed on the basis that the method used in that case consciously ended in the laboratory animal's death, and this prevented the surgical step from being considered unpatentable treatment by surgery. The board stated that normally the presence of a surgical step in a multi-step method for treatment on the human or animal body confers a surgical character on that method, which would bring it within the prohibition of Art. 52(4) EPC.

In **T 385/86** (OJ 1988, 308) the board held that the only **diagnostic methods** to be excluded from patent protection were those whose results immediately made it possible to decide on a particular course of medical treatment. This meant that to answer the question whether a method was a diagnostic method for the purposes of Art. 52(4) EPC, first sentence, it was necessary to ascertain whether the method claimed contained all the steps involved in reaching a medical diagnosis. Methods providing only **interim results** were thus not diagnostic methods in the meaning of Art. 52(4) EPC, first sentence, even if they could be utilised in making a diagnosis.

2.2.3 Therapeutical or technical purpose of a feature

In **T 82/93** (OJ 1996, 274) the opponent had argued that the claimed method was a method of treating the human body by therapy, which, pursuant to Art. 52(4) EPC, was to be regarded as not susceptible of industrial application and therefore not patentable. The opposition division in its decision rejected this objection on the grounds that the defined method of operating a pacer included steps which necessarily implied that an algorithm was implemented in the pacer and used to control the pacing rate. Since such control of the pacing rate was "a technical operation performed on a technical object", the opposition division held that the claimed method could not be considered as a method for treatment of the human body by therapy within the meaning of Art. 52(4) EPC, and that it was a method which was susceptible of industrial application within the meaning of Art. 57 EPC. The board noted that whether or not the claim included features directed to "a technical operation performed on a technical object" was legally irrelevant to the application of Art. 52(4) EPC. In fact, a claim could contain nothing but technical features directed to a technical operation performed on a technical object and a subsequent technical operation performed on a human or animal body, but such a claim would be unallowable under Art. 52(4) EPC if it defined a method for treatment of such a body by therapy or surgery.

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

In **T 329/94** (OJ 1998, 241) the object of claim 12 was principally a method for facilitating sustained venous blood flow to a blood extraction point located in the vein of a human upper limb by alerting the blood donor to help in maintaining the desired blood flow through a selective automated tactile stimulus. The board firstly noted that in the light of established EPO practice it was appropriate to refuse protection for a blood extraction method considered per se, since otherwise a large part of medical activities would be hampered. However, it made it clear that in determining whether the features under consideration constituted a medical method, the purpose of the claimed subject-matter was to be defined in accordance with the patent application, as understood in the light of the description and drawings (Art. 69

EPC and the Protocol thereto). In the board's view, it mattered little whether the measure was performed by a medical practitioner or another person having medical knowledge or under the supervision of such a person (see also **T 24/91**, OJ 1995, 512). This sole criterion was not sufficient to decide whether the method step was objectionable under Art. 52(4) EPC, though the medical competence of the practitioner could be, at first sight, a useful indication. Much more important was the **purpose** and inevitable **effect** of the feature under consideration. The board observed that if the claimed subject-matter was actually confined to operating an apparatus for performing a method with the **technical aim** of facilitating blood flow towards a blood extraction point, the operating method had no therapeutic purpose or effect and, therefore, was not excluded from patentability.

In deciding the case, the board observed that method claim 12 relating to operating a blood extraction assist apparatus conferred protection which was already covered by the scope of the device claim 1 directed to said apparatus; thus its subject-mater was covered by the exception provided for in Art. 52(4) EPC, second sentence. Should, nevertheless, claim 12 be regarded as a plain method claim, the object of this claim was merely to give the donor an order, in the form of a stimulus, to operate the apparatus, so as to facilitate blood flow through the blood extraction point. The method did not produce any therapeutic or prophylactic effect on the donor himself, that is with a view to maintaining or restoring his health by preventing or curing diseases. It was of **merely technical nature**, with the **sole aim** of improving the efficiency of taking blood from a donor. Claim 12 therefore did not fall within the ambit of subject-matter excluded under Art. 52(4) EPC .

2.2.4 Medical character of the excluded methods

As seen above, whether a measure was performed by a medical practitioner or another person having medical knowledge or under the supervision of such a person is not sufficient to decide whether the method step is objectionable under Art. 52(4) EPC (see **T 24/91** (OJ 1995, 512) and **T 329/94** (OJ 1998, 241)). The medical competence of the practitioner could, however, be a useful **indication**.

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

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

In **T 426/89** (OJ 1992, 172) the board came to the conclusion that Art. 52(4) EPC did not prejudice the patentability of claims relating to a product, namely a pacemaker for arresting a tachycardia. The board could not agree with the appellants' argument that enforcement of the rights ensuing from these claims could hinder a doctor from programming a legitimately acquired freely programmable pacemaker so as to perform the claimed steps of the method and could thus restrict him inadmissibly in the exercise of his professional skills. The programming of a pacemaker was no more than an act performed on an apparatus. And although that act could be performed by a doctor in the exercise of his professional skills, it did not constitute direct treatment by therapy of the human or animal body, which alone was excepted from patentability by Art. 52(4) EPC. Equally, every valid patent for a product for the treatment by therapy of the human or animal body could prejudice the manufacture of this product by a doctor without automatically constituting an inadmissible restriction on the exercise of his professional skills.

In **T 24/91** (OJ 1995, 512) the board considered whether or not the claimed invention, involving a process for reprofiling the anterior curvature of a synthetic lenticule, secured to the cornea of the human eye for correcting vision, by ablating (ie removing) with a laser portions of said lenticule, represented a method for treatment of the human body by surgery or therapy within the meaning of Art. 52(4) EPC, first sentence. The board stated that a method for treatment of the human body could normally be said to fall within the exclusion of Art. 52(4) EPC, first sentence, at least in those cases where, in view of the **health risk** connected with such a treatment, it had to be performed by, or under the supervision of a physician. The board noted that the claimed process was and had to be carried out by the ophthalmologist or ophthalmic surgeon himself, or at least under his supervision, so that the claimed process did fall under the exclusion of Art. 52(4) EPC. Directing the laser beam to the lenticule bore the serious risk of damaging the neighbouring tissue of the eye, and the physician was bound to exercise extreme care both during the medical treatment and during the use of medical-technical apparatus and was responsible for the surveillance of his medical and non-medical staff. The board further stated that the lenticule having been secured to the cornea of the eye, was a real implant, in contrast to, for example, an arm or leg prosthesis. Therefore, the claimed process represented a treatment by therapy.

In **T 655/92** (OJ 1998, 17) the board stated that the patentability of a diagnostic method depended on the nature of the diagnostic method itself. Thus, it was legitimate not to derive the character of a medical diagnostic activity from its diagnostic purpose when such a method comprised steps which as a whole were non-medical (see eg **T 385/86**, OJ 1988, 308). However, the diagnostic character of a process, within the meaning of Art. 52(4) EPC, could be recognised in that such a process for which protection was sought did include **essential steps** which were to be implemented by medical staff or under the responsibility of a doctor (see also **T 469/94**).

2.2.5. The exclusion of industrial applicability under Article 52(4) EPC

The methods set out in Art. 52(4) EPC are excluded from patentability, even though such methods are capable of being applied industrially, as a matter of policy. In contrast, the subject-matters which are set out in Art. 52(2) EPC are excluded primarily because they have traditionally been regarded within national patent laws as more in the nature of ideas than industrial manufactures The difference in wording between paragraphs (2) and (4) of Art. 52

EPC results from the nature of the subject-matters that are being excluded from patentability in the respective paragraphs (**T 116/85**, OJ 1989, 13).

In **T 116/85** (OJ 1989, 13) the board held that under the proper interpretation of Art. 52 EPC and Art. 57 EPC in their context, even though the therapeutic treatment of animals is commonly an aspect of agriculture, and agricultural methods in general are potentially patentable subject-matter, nevertheless the particular methods of treatment of animals defined in Art. 52(4) EPC are excluded from patentability. For the particular methods of treatment of animals defined in Art. 52(4) EPC, the prohibition against patentability set out in Art. 52(4) EPC takes precedence over Art. 57 EPC. If a claimed method requires the treatment of an animal body by therapy, it is a method which falls within the prohibition on patentability set out in Art. 52(4) EPC. It is not possible as a matter of law to draw a distinction between such a method as carried out by a farmer and the same method as carried out by a veterinarian, and to say that the method when carried out by a farmer is an industrial activity and therefore patentable under Art. 57 EPC, and when carried out by a veterinarian is a therapeutic treatment not patentable under Art. 52(4) EPC. Nor is it possible as a matter of law to distinguish between the use of such a method for the treatment of ectoparasites and endoparasites.

In **T 1165/97** the board examined whether the exclusion of industrial applicability under Art. 52(4) EPC applied in a method of using a vaginal discharge collector. The board came to the conclusion that the mere placement in and collection of the discharge device in the vaginal canal of a female, even if performed by a medically trained person or a doctor, was not a method of treatment of the human or animal body by surgery or therapy. A prerequisite therefor was the act of surgery or the curative or preventive treatment of illness or the alleviation of the symptoms of pain and suffering, which was not the case with the method of the invention. Neither was there the necessity of particular medical skills in positioning and removing the discharge collector, as these actions were identical to the placement and removal of a contraceptive device such as a pessary, which is performed by women themselves. Neither was there a case of a diagnostic method practised on the human or animal body, since that exclusion only applies to diagnostic methods of which the results make it directly possible to decide on a particular course of medical treatment. To fall under this exclusion the method claimed should contain all the steps involved in reaching a medical diagnosis.

2.3 Therapeutic methods

2.3.1 Meaning of "therapy"

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

It is established case law that a prophylactic treatment, aimed at maintaining health by preventing ill effects that would otherwise arise, amounts to a method for treatment by therapy as referred to in Art. 52(4) EPC, and that therapy is not limited to treatments which restore health by curing diseases which have already arisen (see eg, **G 5/83**, OJ 1985, 64). Both prophylactic and curative methods of treating disease are covered by the word therapy, since both are directed to the maintenance or restoration of health (**T 19/86** (OJ 1989, 24), **T 290/86** (OJ 1992, 414), **T 438/91**, **T 820/92** (OJ 1995, 113)).

In **T 81/84** (OJ 1988, 207) the question arose whether or not the character of menstrual discomfort manifesting itself for instance in intense headaches and other painful symptoms was such that its treatment should fall under the category of therapeutic treatment. The board found that the concept of therapy should **not** be confined **narrowly**. There were many chemical agents which were used by physicians to relieve pain, discomfort and incapacity. Although at least some of such and similar experiences might have been caused by natural circumstances (eg menstruation, pregnancy or age, etc.) or by a reaction to situations in the human environment (eg atmospheric conditions provoking tiredness, headaches, etc.), these overlapped with and were often indistinguishable from symptoms of a disease or an injury. The board noted that It would be impossible and undesirable to distinguish between basic and symptomatic therapy, ie healing or cure and **mere relief**. The use of medicaments might be called for whenever the human body was suffering from a disease, illness, pain or discomfort or incapacity, and the administration thereof could provide or contribute to either full or partial healing, or relief or restoration of fitness. The board concluded that **irrespective of the origin** of pain, discomfort or incapacity, its relief, by the administration of an appropriate agent, was to be construed as therapy or therapeutic use within the meaning of Art. 52(4) EPC.

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

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

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

In **T 74/93** (OJ 1995, 712) the claimed invention related to alicyclic compounds and their contraceptive use. The product claims and a claim for the process of preparation of a contraceptive composition by formulating the claimed compounds with a non-toxic carrier were not objected to. However, the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (eg a cream) comprising these compounds for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC in so far as the compound was to be applied to the cervix of a human female.

The board took the view that a method of contraception was not excluded per se from patentability under the aspects of industrial application as stipulated in Art. 57 EPC and Art. 52(4) EPC, first sentence. Pregnancy was not an illness and therefore its prevention was not in general therapy according to Art. 52(4) EPC (for a specific case see **T 820/92**, OJ 1995, 113). It seems to have been widely accepted in the contracting states that such methods may be susceptible of industrial application (Schering AG's appl. (1971) R.P.C. 337 (P.A.T.); Bruchhausen in Benkard, 9th ed. 1993, 5 PatG, point 13; Cour d'appel de Paris, 24 septembre 1984, PIBD 1984 III, 251). However, it was not sufficient for such methods to be susceptible of industrial application in general. Rather, the invention as claimed in the specific case had to fulfil the requirement of Art. 57 EPC (see Chapter E. on the requirement of industrial applicability under Art. 57 EPC).

In **T 241/95** (OJ 2001, 103) the board held that the selective occupation of a hormon receptor could not be considered as a therapeutic application; the discovery that a substance selectively binds the serotonin receptor, even if representing an important piece of scientific knowledge, still needs to find a practical application as a defined, real treatment of any pathological condition to make a technical contribution to the art and to be considered as an invention eligible for patent protection.

2.3.2 Methods with both therapeutic and non-therapeutic indications

Whether or not a claimed invention is excluded from patentability under Art. 52(4) EPC may depend upon the wording of the claim in question.

In **T 820/92** (OJ 1995, 113) the board had to decide whether a claimed non-therapeutic treatment comprising a patentable step and an inevitable therapeutic step was non-patentable in its entirety by virtue of Art. 52(4) EPC. It was stated however that exclusion from patentability under Art. 52(4) EPC could not be prevented by a purely **formal rewording** of the claim to qualify the purpose of the process, in its indivisible entirety, as non-therapeutic. A further, different consideration has been made by the boards of appeal, that is, whether the non-therapeutic effect according to the application in question is **distinguishable** from the therapeutic effect or, on the contrary, whether it is inextricably linked to said therapeutic effect. In the latter situation, the claim would necessarily include a therapeutic treatment as well and would be excluded from patentability in its entirety by virtue of Art. 52(4) EPC as already set out in equivalent cases such as decisions **T 290/86** (OJ 1992, 414), **T 780/89** (OJ 1993, 440) or **T 1077/93**).

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

In **T 116/85** (OJ 1989, 13) the board observed that when the method at issue is applied to individual animals it had the nature of veterinary treatment, and when applied to herds of animals it also had the nature of an industrial activity. The board went on to say that there was no doubt that the rearing of livestock such as herds of pigs was a farming activity, and that farming was in the broad sense a part of agriculture and therefore in turn an industrial activity for the purposes of the EPC. Thus it was easy, as such, to draw a distinction between individual veterinary treatment on the one hand and large-scale treatment activities normally carried out by a farmer on the other hand - as was put forward by the appellant. Nevertheless, if the method defined in the claims covered both forms of activity, the drawing of such a distinction would not help the appellant's case. The board made it clear that any therapeutical treatment of a farm animal could also be considered as an industrial activity, in so far as farming was clearly an industrial activity, and the medical treatment of disease in both individual farm animals and herds of farm animals was intended to increase the efficiency of such industrial activity. To prevent the death of a farmyard pig from disease by a medical treatment, or to cure it of a disease by such a treatment and thus to increase its yield of meat, was in each case both an industrial activity and a therapeutic treatment. It was therefore clear that the therapeutic treatment of animals was commonly an aspect of agriculture. The board held that a claimed method was excluded from patentability within the meaning of Art. 52(4) EPC, if it rendered the therapeutic treatment of animals necessary, even though the therapeutic treatment of animals was commonly an aspect of agriculture, and agricultural methods were in general potentially patentable subject-matter. Here, the board, however, did not consider it possible as a matter of law to draw a distinction between such a method as carried out by a farmer and the same method when carried out by a veterinarian, and to say that the method, when carried out by a farmer, was an industrial activity and, when carried out by a veterinarian, was a therapeutic treatment not patentable under Art. 52(4) EPC.

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

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

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

In **T 1077/93** the opposition division had concluded that the claimed invention was not a non-patentable therapeutic method within the meaning of Art. 52(4) EPC, but a cosmetic treatment. Claims 1 and 11 related to the use of the cupric complex of 3,5-Diisopropyl salicylic acid (referred to in the following as CuDIPS) as a cosmetic product or in a cosmetic composition, and to a cosmetic treatment process, based on the use of this complex, for the protection of the human epidermis. The purpose of the patented composition was to protect the human epidermis against ultraviolet radiation: notably, to reduce the intensity of erythema, recognised as the most spectacular form of damage to the skin by sunlight, and of skin-level cellular changes such as the formation of degenerated and necrotised keratinocytes, generally known by the term "sunburn cells (SBC)". The appellant lodged an appeal against this decision of the opposition division. In its ruling, the board cited the point, already explored in **T 820/92** (OJ 1995, 113) (see above), that exclusion from patentability under Art. 52(4) EPC could not be prevented by a purely formal rewording of the claim to qualify the purpose of the process, in its indivisible entirety, as non-therapeutic. The board took the view that the examination as to patentability of claims 1 and 11 necessitated an examination of the mechanism by which CuDIPS acted, and of the relationship between all its effects. The board concluded that at least part of the protective effect did not derive from a simple filtering at the level of the skin surface, but rather from an interaction with the cellular mechanisms in the epidermis, with the purpose of preventing a pathological state (erythema); therefore the process had a genuine therapeutic effect.

(b) Therapeutic and non-therapeutic effects distinguishable

In **T 144/83** (OJ 1986, 301) the board accepted the patentability of a claim worded in such a way that it clearly sought protection for a method of treating the human body for cosmetic purposes but not for the therapeutic application which was also possible. The board pointed out that the language of the claim in question "clearly covers a method of cosmetic use and is unrelated to the therapy of a human or animal body in the ordinary sense. This was because loss of weight, like gain of weight, is normally not dictated as a desirable effect by medical considerations at all". On the facts of the case, the board considered that it might be **difficult to distinguish** between loss of weight to improve bodily appearance (cosmetic treatment) and loss of weight to treat obesity (therapeutic treatment), but that this should not be allowed to work to the disadvantage of an applicant who, according to the **wording of his claim**, sought patent **protection for cosmetic treatment** but not for the therapeutic treatment as such. Therefore, the board held that the fact that a chemical product had both a cosmetic and a therapeutic effect when used to treat the human or animal body did not render the cosmetic treatment unpatentable (see reasons, 4). Art. 52(4) EPC was to be construed narrowly so that it did not disadvantage an applicant seeking patent protection for the cosmetic treatment only.

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

In **T 584/88**, claim 1 was directed to the use of a substance to manufacture a means for the treatment by therapy of unhealthy snoring, and claim 15 to the use of the substance against irritating snoring. Claim 1, by describing the snoring as "damaging to health", ensured that it only covered use of the substance to manufacture means serving to treat symptoms of morbidity. Claim 15 covered only irritating as opposed to morbid snoring; this use could not therefore be considered a method for treatment by therapy. The board allowed both claims: snoring was generally considered irritating rather than morbid, but some medical specialists had warned that frequent loud snoring was unhealthy. If so, then combating snoring was a preventive (prophylactic) method for treatment by therapy; otherwise it was more comparable with cosmetic treatment of the human body. The dividing line between irritating and unhealthy snoring was difficult to draw. The board, following **T 36/83** (OJ 1986, 295) and **T 144/83** (OJ 1986, 301), therefore decided to allow both types of claim together.

In **T 774/89**, cited above, the board accepted the patentability of using a medication to increase milk production in cows, because it was evident that the success of the treatment did not depend on the animals' state of health, and the insertion in the claim of the term "non-therapeutic" served as a **disclaimer**, excluding the therapeutic effects of the medication.

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

2.4 Surgical methods

In **T 182/90** (OJ 1994, 641) the application at issue related to a method for measuring the blood flow of a laboratory animal. The method comprised steps clearly representing surgical treatment and the step of sacrificing the animal involved. The board stated that the presence of a surgical step in a multi-step method for treatment of the human or animal body would normally confer a surgical character on that method. In this case, however, it took the view that the method, which consciously ended in the laboratory animal's death, could not be regarded as a method for the treatment of an animal by surgery.

The board pointed out that when interpreting Art. 52(4) EPC, it is decisive to know what is to be understood, in the medical and legal usage of the language, by the expression "treatment of the human or animal body by surgery". The board observed that the term "surgery" appears to be inconsistent with the fact that in today's medical and legal linguistic usage, the non-curative treatments such as cosmetic treatment, the termination of pregnancy, castration, sterilisation, artificial insemination, embryo transplants, treatments for experimental and research purposes and the removal of organs, skin or bone marrow from a living donor are, if carried out by surgery, regarded as surgical treatments. The board observed that the term "treatment by surgery" had undergone a change in meaning insofar as it nowadays may also comprise particular treatments which are not directed to the health of the human or animal body. In the board's view, however, the semantic change in the terminology could not extend so far that the opposite of the original meaning fell within its scope: a method involving the deliberate killing of a laboratory animal was not in the nature of a method of surgical treatment. It was noted that the Guidelines (see C-IV, 4.3) stated that the term "surgery" defined the **nature** of the treatment rather than its **purpose**. The board, however, observed that this might **not** be true in all cases. The board held that a method which included a surgical step practised on a living animal and the additional step of sacrificing the animal, which step was necessary to carry out the method, could not be regarded **in its entirety** as a method for treatment of an animal by surgery within the meaning of Art. 52(4) EPC (see **T 329/94**, OJ 1998, 241, above).

In **T 35/99** (OJ 2000, 447) the board held that, in contrast to procedures whose end result was the death of the living being "under treatment", either deliberately or incidentally (eg the slaughter of animals or methods for measuring biological functions of an animal which comprised the sacrificing of said animal, cf. **T 182/90**, OJ 1994, 641), those physical interventions on the human or animal body which, whatever their specific purpose, gave priority to maintaining the life or health of the body on which they were performed, were "in their nature" methods for treatment by surgery within the meaning of Art. 52(4) EPC. The terms "treatment" and "surgery" in Art. 52(4) EPC could not be considered as constituting two distinct requirements for the exclusion provided therein. The exclusion encompassed any surgical activity, irrespective of whether it was carried out alone or in combination with other medical or non-medical measures.

In **T 775/97** the applicants submitted a claim directed to the use of a (known) device for the manufacture of a device, which use involved a surgical method step; they submitted a further claim directed to a device defined by a construction only arrived at in the human or animal body following a surgical method step.

The board observed that such claims were actually directed to a surgical method. The use of a known material as, so to say, starting material for a medical activity, was quite different from the use of a known composition for manufacturing a medicament, which was an industrial process. Thus, as regards the exclusion under Art. 52(4) EPC, no analogy could be drawn between the use of materials or devices in a surgical method and the second medical use of substances or compositions patentable with the claim format allowed by **G 5/83**. Therefore, the board held that no European patent could be granted with claims directed to a new and even possibly inventive way of using materials or devices, in particular endoprotheses, involving treatment by surgery. This was equally true for product claims defined by a construction only arrived at in the human or animal body following a surgical method step.

2.5 Diagnostic methods

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

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

In **T 385/86** (OJ 1988, 308) the board ruled that the only diagnostic methods to be excluded from patent protection were those providing results which immediately **enabled** a decision to be taken on a particular line of medical treatment, ie methods containing all the steps required to make a medical diagnosis. Methods providing only **interim results** were thus not diagnostic methods within the meaning of Art. 52(4) EPC, first sentence, even if they could be utilised in making a diagnosis.

The board ruled that where the facts showed a particular subject-matter to be covered by the first sentence of Art. 52(4) EPC, both the **examination** (measurement of actual value) and the **establishing of symptoms** on the basis of the examination results - ie the deviation measured from the norm - had to be carried out on a living human or animal body.

The board indicated that the systematic list of the steps leading to a diagnosis contained in the relevant literature included:

- recording the case history, observing, palpating and auscultating various parts of the body and carrying out numerous medical and technical examinations and tests (the examination and data gathering phases);

- comparing the test data with normal values, recording any significant deviation (symptom) and,

- attributing the deviation to a particular clinical picture (deductive medical decision phase)

The board pointed out that even **if only one** of the last three steps was lacking, there was no diagnostic method but at best a method of data acquisition or data processing that could be used in a diagnostic method. The board also stated that the practice of a diagnostic method on the human or animal body within the meaning of Art. 52(4) EPC, first sentence, presupposed that even a deviation from a norm that must be regarded as a symptom was directly discernible on the body itself. Typical examples of such methods were, in the board's opinion, an allergy test in which the abnormal deviation could be detected from a change to the skin; a method for determining the patency of a body duct whereby liquid was injected into the uterus with a catheter and the pressure build-up in the uterus observed; a method in which scarlet-fever spots were directly observed or photographed; or an endoscopic examination carried out to ascertain liver damage.

The board further observed that it was not sufficient simply that an investigation into the state of a human or animal body be carried out for medical purposes. The condition ascertained must of itself demonstrate the pathological deviation. A measurement of blood pressure is an absolute value which only revealed any irregularity when compared with a norm. It was only the comparison and the explicit indication of how great the deviation must be to be characteristic of a particular disease or group of diseases that made the measuring method a diagnostic one. Thus a radiographic examination with X-rays did not make the internal condition discernible on the body itself but only on a screen after the X-ray quanta had been converted into visible fluorescent light outside the body. And even then a pathological condition could only be ascertained when the density structure was compared with normal values.

In the case at issue the invention was concerned with a method for determining chemical and/or physical conditions inside a living animal or human body using magnetic resonance. The board had to determine whether the temperature measured as claimed in claim 1 or the pH value measured as claimed in claim 2 was directly readable from parts of the body. It found that the measures described in independent claims 1 and 2 resulted in a measured value only visible outside the body in the high-resolution resonance spectrum that appeared on a screen or plotter page in the final stage of the diagnostic apparatus. The data on temperature and pH value thus obtained were therefore visible on a data carrier detached from the body only after further technical measures which took place outside the body. Any further step, which as a result of comparison with a norm revealed an abnormal deviation, did not require the patient's presence. The board therefore held that neither the features described in claim 1 nor those in claim 2 defined a method "practised on the human body" (confirmed in **T 83/87, T 400/87**).

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

In **T 530/93** the board confirmed the established case law of the EPO boards of appeal and found that methods which only comprised the data-gathering phase of a diagnosis and only provided interim results which would require a further step in order to attribute the data to a particular clinical picture, were not diagnostic methods within the meaning of Art. 52(4) EPC. The method according to claim 1 corresponded to this definition and was therefore not excluded from patentability under Art. 52(4) EPC.

In **T 964/99** the board held that Art. 52(4) EPC was meant to exclude from patent protection all methods practised on the human or animal body which relate to diagnosis or which are of value for the purposes of diagnosis. The board found that the taking of a body sample for the purpose of a medical examination belongs to a fundamental diagnostic activity, regardless of the technical means used. Thus, the claimed step of sampling a substance related to diagnosis and constituted in this context an essential diagnostic measure practised on the living human or animal body. The board noted that it was immaterial that the claimed methods could be performed by the patient himself and that their execution would not have a significant impact on the body or involve a serious health risk. What was decisive was the fact that all method claims on file comprised the step of taking a body sample for the purpose of diagnosis and that such a step was to be regarded as an essential activity pertaining to diagnosis and practised on the living body.

The board noted that the appellant's view that the case law on diagnostic methods had consistently adopted a restrictive interpretation of **T 385/86** was not correct (see for instance **T 329/94** and **T 655/92**). The board pointed out that the restrictive interpretation of the patent exemption for diagnostic methods adopted by **T 385/86** amounted to setting a different standard for diagnostic methods than that established for methods of surgery or therapy, the latter being excluded from patent protection if they comprised only a single step of a surgical or therapeutic nature (see for instance **T 35/99** (OJ 2000, 447) and **T 82/93** (OJ 1996, 274)). In the board’s view, the expression "diagnostic methods practised on the human or animal body" in Art. 52(4) EPC should not be considered to relate to methods containing all the steps involved in reaching a medical diagnosis.

2.6 Products for use in medical methods

Art. 52(4) EPC expressly allows the patenting of products for use in methods for the treatment of the human or animal body by surgery or therapy and in diagnostic methods (Art. 52(4) EPC, second sentence).

In **T 712/93** the claim at issue was concerned with an apparatus for use as the socket portion of a prosthetic ball and socket joint. The respondent argued in the oral proceedings before the board of appeal that the claim did not comply with Art. 52(4) EPC, since these claims contained a method step for treatment of the human body by surgery which step depended on the professional decision by a surgeon. It contended that a claim was not allowable if it included at least one feature defining a physical activity or action which constituted a method for treatment of the human body. The board noted that the claim was directed to an apparatus, which was defined partly by functional features. This way of defining the scope of protection was allowable in so far as it had met the conditions under the EPC and was necessary in order to give the applicant adequate protection. The board found that the fact that some features were functional did not in itself transform the claim into a method claim. Consequently the claim complied with Art. 52(4) EPC, second sentence.

B. Exceptions to patentability

1. Introduction

Art. 53 EPC defines the exceptions to patentability as follows:

(a) inventions the publication or exploitation of which would be contrary to 'ordre public' or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States; and
(b) plant or animal varieties or essentially biological processes for the production of plants or animals; this provision does not apply to microbiological processes or the products thereof.

The new R. 23b to 23e EPC concerning biotechnological inventions came into force on 1.9.1999 (OJ 1999, 437 ff). These give guidance on the definition of certain terms and provide that the relevant provisions of the EPC shall be applied and interpreted in accordance with the provisions of these rules. Directive 98/44/EC of 6.7.1998 (OJ 1999, 101) on the legal protection of biotechnological inventions shall also be used as a supplementary means of interpretation.

The case law indicates that any exceptions to patentability must be narrowly construed (in respect of Art. 53(a) EPC, see **T 356/93** (OJ 1995, 545); in respect of Art. 53(b) EPC, see **T 320/87** (OJ 1990, 71) and **T 19/90** (OJ 1990, 476)). The latter decision also stated that the object and purpose of the law ("ratio legis") was not merely a matter of the legislators' intention at the time when the law was adopted, but also of their presumed intention in the light of changes in circumstances which had taken place since then.

Living matter is not generally excluded from patentability under the EPC. Referring to Art. 53(b) EPC, the board in **T 49/83** (OJ 1984, 112) stated that no general exclusion of inventions in the sphere of animate nature could be inferred from the EPC. It was held in **T 356/93** (OJ 1995,545) that seeds and plants per se should not constitute an exception to patentability under Art. 53(a) EPC merely because they represented 'living' matter, or on the ground that plant genetic resources should remain the 'common heritage of mankind'. Furthermore, according to **T 19/90**, the exception to patentability under Art. 53(b) EPC applies to certain categories of animals but not to animals as such.

The Enlarged Board stated in **G 1/98** (OJ 2000, 111) that a claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Art. 53(b) EPC, even though it may embrace plant varieties.

2. Inventions contrary to "ordre public"

The first decision to deal with ethical issues under Art. 53(a) EPC was **T 19/90**. The claims concerned a transgenic non-human mammalian animal whose germ cells and somatic cells contain in the genome an activated oncogene which increases the probability of neoplasm development in the animal, and a method for producing such an animal. The board held that there were compelling reasons to consider the provisions of Art. 53(a) EPC in relation to the question of patentability. As this had not been done at the level of the first instance, the board remitted the case to the examining division with the instruction to carry out a careful weighing up of the suffering of animals and possible risks to the environment on the one hand, and the invention's usefulness to mankind on the other, before deciding whether to grant or refuse the patent application. In its decision (OJ 1992, 588) the examining division finally granted the patent. Oppositions have since been filed and are still pending before the opposition division.

The Implementing Regulations have been amended since this decision. New R. 23d EPC provides that patents shall not be granted in respect of biotechnological inventions which concern processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

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

The board acknowledged that it might be difficult to judge whether or not a claimed subject-matter was contrary to "ordre public" or morality, but that nonetheless, the provisions of Art. 53(a) EPC could not be disregarded. Each particular case had to be considered on its merits.

The board defined the concept of **"ordre public"** as covering the protection of public security and the physical integrity of individuals as part of society. It also encompassed the protection of the environment. Accordingly, inventions the exploitation of which was likely to seriously prejudice the environment were to be excluded from patentability as being contrary to "ordre public".

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

Thus, the question to be decided in respect of Art. 53(a) EPC was whether the exploitation of any of the claimed subject-matter was likely to seriously prejudice the environment or whether it related to a misuse or destructive use of plant biotechnological techniques.

In the view of the board, the revocation of a patent under Art. 53(a) EPC on the grounds that the exploitation of the invention would seriously prejudice the environment presupposed that the threat to the environment be sufficiently substantiated at the time the decision to revoke the patent was taken by the EPO.

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

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

For these reasons, the board concluded that Art. 53(a) EPC did not constitute a bar to patentability in this particular case.

3. Patentability of plants and plant varieties

According to Art. 53(b) EPC, a patent shall not be granted if the claimed subject-matter is directed to plant varieties. In the absence of the identification of a specific plant variety in a product claim, the subject-matter of the claimed invention is not directed to a plant variety or varieties within the meaning of Art. 53(b) EPC. Thus, a patent shall not be granted for a single plant variety but can be granted if varieties may fall within the scope of the claims. If plant varieties are individually claimed, they are not patentable, irrespective of how they were made (**G 1/98** (OJ 2000, 111). The term 'plant variety' is now defined in the new R. 23b (4) EPC as:

"any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety are fully met, can be:
(a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
(b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
(c) considered as a unit with regard to its suitability for being propagated unchanged."

The Enlarged Board came to the conclusion in **G 1/98** that a correct interpretation of Art. 53(b) EPC does not exclude the granting of patents for transgenic plants, where specific plant varieties are not identified, even if the claims embraced inter alia plant varieties. The Enlarged Board took the view that Art. 53(b) EPC defined the borderline between patent protection and plant variety protection. The extent of the exclusion for patents was the obverse of the availability of plant variety rights. Since plant variety rights were only granted for specific plant varieties and not for technical teachings which could be implemented in an indefinite number of plant varieties, it was not sufficient for the exclusion from patent protection in Art. 53(b) EPC to apply that one or more plant varieties were embraced or might be embraced by the claims of the patent application.

The Enlarged Board further held that Art. 64(2) EPC should not be taken into consideration when a claim to a process for the production of a plant variety is examined, in conformity with the established case law according to which the protection conferred by a process patent is extended to the products obtained directly by the process, even if the products are not patentable per se (see II.B.6.1 and 6.2).

Finally, the Enlarged Board held that the exception to patentability in Art. 53(b) EPC, 1st half-sentence, applies to plant varieties irrespective of the way in which they were produced. Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology are excluded from patentability. The underlying reason for this is that the exclusion in Art. 53(b) EPC was made to serve the purpose of excluding from patentability subject-matter which is eligible for protection under the plant breeders' rights system. It does not make any difference for the requirements under the UPOV Convention or under the Regulation on Plant Variety Rights, whether a variety is obtained by traditional breeding techniques or genetic engineering. This meant that the term 'plant variety' was appropriate for defining the borderline between patent protection and plant breeders' rights protection irrespective of the origin of the variety. The argument that the legislator of the EPC did not envisage the possibility of genetically modified plant varieties and for this reason could not have had the intention of excluding them from patentability could not be accepted - laws are not restricted in their application to situations known to the legislator.

The earlier decisions on this issue are now mainly of historical interest:

T 49/83 (OJ 1984, 112) first defined the term 'plant varieties' as a multiplicity of plants which were largely the same in their characteristics and remained the same within specific tolerances after every propagation cycle. Following on from this, the board in **T 320/87** (OJ 1990, 71) concluded that hybrid seed and plants, lacking stability in some trait of the whole generation population, could not be classified as plant varieties within the meaning of Art. 53(b) EPC.

In **T 356/93** (OJ 1995, 545) the board held that plant cells as such, which modern technology allows to culture much like bacteria and yeasts, could not be considered to fall under the definition of a plant or of a plant variety. This was confirmed by **G 1/98**, which stated that plant cells should be treated like microorganisms.

However, the board's conclusion in **T 356/93** that a product claim which embraced within its subject-matter “plant varieties” was not patentable under Art. 53(b) EPC, first half-sentence, was overruled by **G 1/98**.

4. Patentability of animals and animal varieties

The board of appeal has asserted the general principle that the exception to patentability under Art. 53(b) EPC applies to certain categories of animals, but not to animals as such (**T 19/90** OJ 1990, 476).

In interpreting the term "animal varieties" the board in this decision emphasised the narrow interpretation to be given to the provisions of Art. 53(b) EPC. Bearing in mind that for animals - unlike plant varieties - no other industrial property right was available, the board decided that the exception to patentability under Art. 53(b) EPC applied to certain categories of animals but not to animals as such. It thus constituted no bar to patentability for subject-matter which was not covered by any of the terms “animal varieties", “races animales” or “Tierarten”.

In the same decision the board stated that under Art. 53(b) EPC, the general principle of patentability contained in Art. 52(1) EPC was restored for inventions involving microbiological processes and the products of such processes. The bar on patenting under Art. 53(b) EPC, first half-sentence, does not extend to the products of a micro-biological process which are patentable under Art. 53 (b) EPC, second half-sentence. Thus patents were held to be grantable for animals produced by a microbiological process, although this term was not defined.

5. Essentially biological processes

Processes for the production of plants or animals are not patentable if they are essentially biological processes. Non-essentially biological processes, on the other hand, are patentable.

According to decision **T 320/87** (OJ 1990, 71), whether or not a (non-microbiological) process was to be considered as "essentially biological" within the meaning of Art. 53(b) EPC had to be judged on the basis of the essence of the invention, taking into account the totality of human intervention and its impact on the result achieved. The necessity for human intervention alone was not a sufficient criterion for its not being “essentially biological”. Human interference might only mean that the process was not a “purely biological” process, without contributing anything beyond a trivial level. It was further not a matter simply of whether such intervention was of a quantitative or qualitative character.

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

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

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

The Implementing Regulations have been amended since these decisions were handed down. New R. 23b(5) EPC now states that a process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.

6. Microbiological processes and the products thereof

In **T 356/93** (OJ 1995, 545) the board referred to **T 19/90** (OJ 1990, 476), which held that animal varieties were patentable if they were the product of a microbiological process within the meaning of Art. 53(b), second half-sentence, EPC, and concluded that this principle applied mutatis mutandis to plant varieties. The board then defined the term "micro-organism" as including not only bacteria and yeasts, but also fungi, algae, protozoa and human, animal and plant cells, ie all generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory, including plasmids and viruses.

Accordingly, the board interpreted the term "microbiological" as qualifying technical activities in which direct use was made of micro-organisms. These included not only traditional fermentation and biotransformation processes, but also the manipulation of micro-organisms by genetic engineering or fusion techniques, the production or modification of products in recombinant systems, etc., ie briefly all activities in which an integrated use is made of biochemical and microbiological techniques, including genetic and chemical engineering techniques, in order to exploit the capacities of microbes and cultured cells.

The board thus defined the concept of "microbiological processes" under Art. 53(b) EPC as processes in which micro-organisms are used to make or modify products or in which new micro-organisms are developed for specific uses. The concept of "the products thereof" encompassed, in the board's view, products which were made or modified by micro-organisms as well as new micro-organisms as such.

Although the Enlarged Board confirmed in **G 1/98** (OJ 2000, 111) the above definition of "microorganism", it went on to say that processes of genetic engineering are not identical with microbiological processes. The term microbiological processes in Art. 53(b) EPC was used as synonymous with processes using micro-organisms. Micro-organisms are different from the parts of living beings used for the genetic modification of plants. To treat genetically-modified plants as products of microbiological processes within the meaning of

Art. 53(b), second half-sentence, EPC, would disregard the purpose of the exclusion of plant varieties in Art. 53(b) EPC, ie excluding from patentability subject-matter which was eligible for protection under the plant breeders' rights system. Therefore, the Enlarged Board took the view that it did not make any difference for the requirements under the UPOV Convention or under the Regulation on Plant Variety Rights, how a variety was obtained. Whether a plant variety was the result of traditional breeding techniques, or whether genetic engineering was used to obtain a distinct plant grouping, did not matter. This meant that the term "plant variety" was appropriate for defining the borderline between patent protection and plant breeders' rights protection irrespective of the origin of the variety.

Examining the patentability of the then claimed plant grouping, in **T 356/93** the board also addressed the issue whether **multi-step processes** for producing plants which include at least one microbiological process step (eg the transformation of cells with recombinant DNA) as a whole could be considered to represent "microbiological processes" within the meaning of Art. 53(b) EPC, second half-sentence, and whether, owing to this, the products of such processes (eg plants) might be regarded as being "the products thereof" for the purposes of this provision.

The board held that "technical processes including a microbiological step" could not simply be equated with "microbiological processes". Nor could the resulting final products of such a process (eg plant varieties) be defined as "products of a microbiological process" within the meaning of the said provision.

The particular plant claimed was produced by a multi-step process which, in addition to the initial microbiological process step of transforming plant cells or tissue with recombinant DNA, comprised the step of regenerating plants from the transformed plant cells or tissue and the step of reproducing the plant material. The board held that the plant was not the product of a microbiological process. Although the initial microbiological process step undoubtedly had a decisive impact on the final result because by virtue of this step the plant acquired its characterising feature which was transmitted throughout generations, the claimed plant was not merely the result of this (microbiological) initial step. The subsequent steps of regenerating and reproducing the plants had an important added value and contributed, although in a different manner, to the final result as well.

The board therefore concluded that, regardless of the decisive impact that the microbiological process step had on the final result, the multi-step process whereby the claimed plant was produced was not a microbiological process within the meaning of Art. 53(b) EPC, second half-sentence, and that, accordingly, such a plant could not be considered to be “the product of a microbiological process”.

New R. 23b(6) EPC defines a “microbiological process” as any process involving or performed upon or resulting in microbiological material. The boards have not yet issued a decision interpreting this definition.

C. Novelty

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

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

1. Defining the state of the art

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

1.1 Relevant point in time

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

According to the boards' established case law, the prior art's content is to be interpreted in the manner in which it would have been understood by the skilled person at the time it was made available. In particular, for ascertaining the disclosure of a document forming part of the state of the art within the meaning of Art. 54(2) EPC, the relevant date is that of publication. Interpreting a document using knowledge which only became available to the relevant experts between the publication date of the cited prior art and the filing or priority date of the application to be examined or the patent in dispute is an inventive-step issue, not a novelty one (see **T 205/91**, **T 965/92**, **T 590/94**). In **T 74/90** the board did however consider how a skilled person would have understood a citation on the filing date of the patent in suit. It concluded that this disclosure did not comprise a possible interpretation which, because of technical prejudice, such a person would have considered unperformable on the filing date.

1.2 European prior rights

Under Art. 54(3) and (4) EPC the state of the art comprises the content of other European applications filed earlier than, but published under Art. 93 on or after the date of filing of the application being examined, to the extent that the earlier and later applications validly (R. 23a) EPC designate the same state or states.

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

In **T 447/92** the whole contents of an earlier document within the meaning of Art. 54(3) and (4) EPC had to be considered as forming part of the state of the art as far as novelty was concerned. The board pointed out that the boards of appeal had consistently applied a very restrictive interpretation of disclosure in order to reduce the risk of self-collision. To do otherwise would, in the board's view, undesirably undermine the exclusion from consideration of documents within the meaning of Art. 54 EPC when deciding whether there had been an inventive step under Art. 56 EPC, second sentence.

1.3 PCT applications as state of the art

An international application not yet published and for which the EPO is a designated Office is considered as comprised in the state of the art in accordance with Art. 54(3) EPC ie with effect from its filing or priority date, as soon as it has been filed at the EPO in an official language and the national fee has been paid (Art. 158(2) and (3) EPC).

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

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

1.4 Excluded national prior rights

In **T 550/88** (OJ 1992, 117) (see p. 473) the board made it clear that, on the proper interpretation of Art. 54(3) EPC, prior national rights were not comprised in the state of the art. As to the references to Part VIII of the EPC made by the appellants, the board found that they rather confirmed that the effect of a prior national right upon a European patent was a matter purely for national law, whereas the effect of a prior European application upon a European patent was specifically provided for in Art. 54(3) EPC (which might also be a ground for revocation under national laws by virtue of Art. 138(1)(a) EPC). In other words, the combined effect of Art. 138(1) EPC and Art. 139 EPC was to provide an additional possible ground for revocation under national laws based upon the existence of a prior national right, which was not available under Art. 54 EPC.

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

1.5 Article 55 EPC

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

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

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

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

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

1.6 Availability to the public

The state of the art comprises what has been made available to the public.

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

Particular problems may arise, depending on how the information is made available.

1.6.1 Publication

In **T 611/95** a research institute known in the field was in possession of a **report** anticipating the invention, which anyone could view at the institute or order from it on request. Two papers published prior to the priority date referred to this report and indicated where it could be obtained.

In the board's view, the report was therefore publicly available. As far as availability to the public was concerned, the institute was not to be equated with a library, but the information in the documents had indicated to experts in the field that anyone could inspect or order the report there. It was thus available to the public.

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

In **T 37/96** the board had to decide on the public availability of some prior-art documents. Two of them were **typical company papers.**

The board held that unlike scientific or technical journals, such papers could not be assumed to have automatically made their way to the public. On the contrary, whether they had indeed been available to the public on a given date depended on the particular circumstances and the evidence available.

T 877/98 raised the question whether a **German patent** had become publicly available upon notification of the grant decision if the application had not been published previously.

The board took the view that the patent had not become available until publication of grant in the patent bulletin; only from that point on was the file open for inspection. It thus endorsed the view of the German Federal Patents Court (decision of 23.12.1994, 4W(pat)41/94, BlfPMZ 1995, 324).

In **T 165/96**, technical information about a feature of the invention had been disclosed, prior to the date of filing of the European patent application in question, in an insert in a **minor small-ads newspaper** (circulation: 24 000) distributed in the suburbs of Copenhagen.

The patent proprietor argued that in view of the newspaper's limited circulation and readership ("man on the street" in suburban Copenhagen) the information in question had effectively remained confidential and could not be regarded as forming part of the state of the art within the meaning of Art. 54(2) EPC; the document should therefore not be admitted in the appeal proceedings. He also felt that scientific or technical information published before filing in a non-technical or non-scientific context outside the scope of the art concerned, and with no references or distinguishing features enabling it to be found again afterwards, should not be regarded as directly available to the public without undue burden as per **G 1/92**.

The board ruled that, pace the patentee, publication in such a manner fulfilled the necessary and sufficient conditions for citing a disclosure against the patent. Information was "available" once people could theoretically become aware of it. A publication did not have to fulfil any specific criteria of form or layout in order to qualify as a citable disclosure.

On the "undue burden" argument, the board noted that the patentee's interpretation would introduce into the consideration of novelty precisely that subjective element which in **G 1/92** the Enlarged Board had sought to exclude. That argument was therefore not valid.

1.6.2 Abstracts of documents

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

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

1.6.3 Repetition of oral disclosures

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

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

1.6.4 Prior use

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

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

In **T 327/92**, the patentee claimed an expanded film laminate characterised by the feature that it be expanded by monoaxially drawing it. The product of the process of a citation comprised a laminate which was stretched in one direction and then, within a short time, further stretched at right angles to this direction; in this process a monoaxially stretched laminate existed, at least, for 60 seconds. The board held that the **intermediate product** which existed only for some 60 seconds before being further processed destroyed the novelty of the patentee's claim because it met all technical characteristics required by the claim. It allowed, however, a claim directed to a not yet disclosed use of the monoaxially stretched laminate.

For the preconditions for claiming prior use, see p. 358 and p. 473 ff.

1.6.5 Biological material

In the field of microbiology, in **T 576/91** the board conceded that an unwritten rule may exist within the scientific community whereby biological material referred to in a scientific publication can be freely exchanged. However, this does not amount to an obligation, so that any biological material which is the subject of a publication can be considered as being publicly available. The board further stated that if contractual obligations between parties resulted in access to biological material being deliberately restricted to a group of persons bound either by a research contract or a licence, it could not be concluded that this material had been made "available to the public" under the terms of Art. 54(2) EPC. In **T 128/92** the board stated that for a complex biochemical to be made available to the public, the minimum that would seem to be required for publication was a notice to those in the field that samples of the biochemical could be obtained on request, and clear evidence of exactly what the biochemical was.

1.6.6 The concept of "the public"

Over the years, the boards have arrived at a clear definition of "the public". Information is said to be "available" to the public if only a single member of the public is in a position to gain access to it and understand it, and if there is no obligation to maintain secrecy.

This was the opinion in **T 482/89** (OJ 1992, 646), where the board said that a single sale was sufficient to render the article sold available to the public within the meaning of Art. 54(2) EPC provided the buyer was not bound by an obligation to maintain secrecy. It was not necessary to prove that others also had knowledge of the relevant article.

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

Parties sometimes try to argue that information was not publicly available because the person who received it was **not skilled in the art**.

In the opinion of the board this was the case when the article was sold to a man not skilled in the art (likewise **T 482/89** (OJ 1992, 646)**, T 953/90**, **T 969/90** and **T 462/91**). In **T 809/95**, the board did not accept the argument by the patentee that his invention (used in bottle-making) had not been disclosed through a test because although the participants had taken home bottles made using the invention they were not specialists in the field concerned. According to the board, the word "public" in Art. 54(2) EPC did not necessarily mean the skilled person (see also **T 482/89**, OJ 1992, 646). Furthermore, the bottles' inventive features were obvious, and could be appreciated without technical knowledge.

In **T 165/96**, the board held that "the public" within the meaning of Art. 54(2) EPC did not presuppose a minimum number of people or specific educational qualifications; the residents of a Copenhagen suburb sufficed.

The word "public" in Art. 54(2) EPC does not necessarily refer to the man in the street according to **T 877/90** and **T 406/92**: a disclosure before a skilled person makes it "public" in the sense that the skilled person is able to understand the disclosure and is potentially able to distribute it further to other skilled members of the public (see also **T 838/97**).

Another argument sometimes used is that information was given only to a **limited circle of people** and therefore not publicly available.

In the opinion of the board the information is publicly available where it was made available to a limited circle of people (**T 877/90** - congress; **T 228/91** - course; **T 292/93** - demonstration for potential customers conducted on the premises of a company with close links to the opponent).

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

On the other hand, in **T 300/86**, the board took the view that the fact that the report of the invention was passed on to a large, but limited, circle of persons did not of itself make the document available to the public if all the recipients of the document were bound to secrecy, and there was nothing to indicate that the recipients broke their pledge of secrecy.

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

T 11/99 too confirmed that information was publicly available even if only a single member of the public could obtain and understand it, and was not bound to secrecy. The respondent had argued that 8 700 members of a Japanese society of chemical engineers was not "the public" in Japanese terms.

1.6.7 Obligation to maintain secrecy

If the person who was able to gain knowledge of the invention was under an obligation to maintain secrecy, the invention cannot be said to have been made available to the public, provided the person did not breach that obligation.

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

(a) Distribution of prospectuses, technical descriptions, etc

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

(b) Displaying the invention

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

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

(c) Sub-contracting

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

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

(d) Demonstrating products for presentation purposes

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

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

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

In **T 823/93**, the opponent had sold a company a packaging apparatus with characteristics similar to the patented apparatus. Delivery had been made after the patent's date of priority, but the apparatus had been presented to the company's employees prior to that date. The packaging apparatus had been developed on the basis of an order from the client. The order did not relate to a finished product but to a complex system needing to be adapted to the purchaser's requirements. The apparatus had been developed as the solution to a specific technical problem envisaged by the client himself. The question was whether the client had required the employees to whom the apparatus had been presented to treat the presentation as confidential.

According to the board, the development of a new apparatus is usually kept secret from competitors. In the case at issue, the development of the apparatus had to be regarded as the result of co-operation between the opponent and the client. The board therefore took the view that, on the basis of these facts, it could be assumed that none of the parties had an interest in disclosing any information about the apparatus and it was likely that the technical reports exchanged between the parties were tacitly required to be treated as confidential. The board also held that the general conditions of business, which had become the conditions of contract and required the plans, designs and other documents to be handled confidentially, also extended to verbal information and details given during the presentation of the apparatus. In these circumstances, the board decided that the employees to whom the apparatus had been presented could not be considered as members of the public within the meaning of Art. 54(2) EPC.

(e) Presenting the product in writing

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

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

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

In **T 818/93** the relevant prior art document was a declaration made by the inventor before the USPTO, plus Exhibits 1 and 4 mentioned therein. Several companies had been contacted in an (unsuccessful) attempt to interest them in developing and funding research into the intraluminal graft outlined in Exhibit 1. Exhibit 4 had been sent to the inventor's superior, a professor at the University of Texas Health Science Center at San Antonio, after which discussions had been held with him and a research assistant at this university with a view to obtaining the necessary equipment for carrying out the research and fabrication and for testing the graft. In the board's judgment, all these steps and approaches had been taken within the context of business relationships which were necessary to bring the project to a successful conclusion. Such negotiations were confidential by nature in view of the comparable interests of the parties involved and implied a secrecy agreement. In the board's view and contrary to the respondent's assertion, a written agreement was not necessary to rule out any involvement of a third party so that, in the case at issue, implicit confidentiality had not been breached by the meetings and negotiations prior to the filing date of the contested patent.

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

(f) Making available for test purposes

A product made available for test purposes is to be treated as confidential. Sale of the product in a limited quantity is regarded as sale for test purposes, if the product is normally sold in large quantities (see **T 221/91**, **T 267/91** and **T 782/92).**

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

In case **T 809/95** the granted patent was inter alia for a plastic bottle whose special features related to its foldability. One of the opponents alleged two cases of prior use. One of these had occurred in connection with a "market test" performed by a market research company on behalf of the third party to gauge the market for such bottles. The patent proprietor claimed that both prior uses had been subject to confidentiality rules.

As far as the prior use through market research was concerned, the board held that the very fact that the third party had chosen a test variant allowing the test participants to take the bottles home indicated that it attached no particular value to confidentiality in the patent sense. Nor was there any circumstantial obligation to maintain secrecy since the market research institute did not employ or have a business relationship with the test persons. Allowing the bottles to be taken home and used freely was rather evidence against any obligation to maintain confidentiality.

In **T 1054/92** of 20 June 1996, the opponent had alleged and proved that the claimed invention, an absorbent structure for diapers, had been tested in public tests carried out by several hundred members of the public at several places in the USA over several weeks. The appellant (patent proprietor) had admitted not being certain that the tests were confidential but he was of the opinion that it was up to the respondent to prove without doubt that there was no bar of confidentiality. In the absence of such proof, the board should find on the balance of probabilities that the tests were confidential. The board was convinced in the light of common experience that it was very unlikely that these tests had been kept confidential, particularly since some of the used diapers had not been returned to the appellant. The board confirmed, against the opinion of the appellant, that the burden of proof for the existence of a secrecy agreement was on the patent proprietor. Since he could not prove the existence of secrecy agreements with the participants in these tests, the board found that they were not confidential.

(g) Conferences

In **T 739/92** an oral description of the invention had been given in a conference. The question was whether the participants at this conference were bound to secrecy and could therefore not be seen as the public within the meaning of Art. 54(2) EPC. The list of participants showed that the conference was open to every specialist active in the relevant field. The participants were not prohibited from disseminating oral information from the conference, or from publishing information from it provided that they omitted any reference to the conference. Recording the lectures on tape, etc. and photographing slide material were prohibited. Guests were not permitted to attend the conference lectures and discussions. The board held that under these conditions the participants at this conference were to be regarded as normal members of the public since there was no secrecy agreement. In contrast to the situation in **T 300/86**, the participants were not licensees of the organisers, nor subject to a blanket contractual prohibition from communicating the information they obtained to third parties.

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

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

(h) Joint venture agreement

A joint venture agreement obliges the parties to secrecy even without an explicit clause to that effect (**T 472/92**).

1.7 Issues of proof

1.7.1 Nature of the evidence

In **T 611/97** the appellant/opponent had listed various gun alignment systems which he alleged had been made available to the public in various ways (through being advertised, manufactured or sold, or through the distribution of catalogues).

The board stated that it was immediately obvious that a variety of actions, eg describing the system in a catalogue and selling it, usually meant that a different product was made available to the public. A person skilled in the art could, for example, dismantle and analyse a system which had been made unrestrictedly available to the public by being sold in order to obtain technical information not necessarily contained in the catalogue. The alleged availability of a product based on the distribution of catalogues and the alleged sale of a system described in such catalogues therefore represented different cases of availability, each of which had to be proved separately.

1.7.2 Burden of proof

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

According to **T 766/91** (point 8.1) and **T 919/97** (point 4.4), evidence of general technical knowledge need be submitted only if the latter's existence is disputed.

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

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

In **T 326/93**, the board held that in assessing public prior use the burden of proof lay with the opponent, who had to show, on the balance of probabilities, firstly that the invention had been publicly demonstrated before the priority date and secondly that the skilled person would have drawn the necessary teaching from the demonstration (see also **T 472/92**, OJ 1998, 161, **T 750/94,** OJ 1998, 32 and **T 848/94**).

Ruling on an objection of prior public use in **T 221/91** the board took the line that it was for the patent proprietors to prove the existence of an obligation to maintain secrecy when the opponents had proved that the invention had been made available to the public and the patent proprietors had claimed the existence of a secrecy agreement (see also **T 969/90** and **T 1054/92** of 20.6.1996).

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

Both parties dispensed with oral proceedings and no witnesses were heard; the board did not in these circumstances consider the alleged public prior use.

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

In **T 472/92** (OJ 1998, 161) the board ruled that the existence of a joint venture agreement implied an obligation to maintain secrecy.

1.7.3 Standard of proof

In **T 48/96** the board stated that, in order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody.

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

In **T 729/91**, one relevant document was an issue of a monthly periodical, intended for hoteliers and caterers and which could be bought in South Africa. In accordance with the evidence brought forward in the case, a copy of this periodical was received by a particular library on 9.8.1984, ie before the priority date (13.8.1984) of the patent in suit. The librarian stated that publications were "generally available to the public as of the date of receipt". There was no absolute certainty that this was the case with the publication in question. The board was of the opinion that the EPO must decide what happened having regard to the available evidence on the balance of probabilities, ie it must decide what was more likely than not to have happened. In the present case, it was, in the board's view, clearly much more likely that the publication was available to the public as from the date of receipt. In the absence of evidence to the contrary, the board accepted that what in fact happened was what the librarian stated would "generally" happen. So the publication was considered to have been made available to the public before the priority date.

For more details regarding proof in connection with public prior use, see also chapter VI.J. on "Law of evidence".

1.7.4 Obligation of the EPO to examine of its own motion

A number of cases of alleged prior use called upon the boards to define the extent of the

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

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

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

2. Determining the content of the relevant prior art

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

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

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

2.1 General rules of interpretation

In **T 600/95**, the board held that the interpretation of the technical disclosure contained in a given document does not normally depend on the **purpose** it serves, be it as representing state of the art, priority document or the application as filed.

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

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

In **T 158/96,** in the examining division's opinion the use of the compound "sertraline" for the manufacture of a medicament to treat obsessive-compulsive disorder (OCD) was not novel with regard to a document disclosing that sertraline was undergoing clinical trials for OCD shortly before the priority date. The examining division stressed that, for the purposes of patent disclosure, it was common practice to accept any pharmacological test as the disclosure of a medical use, as long as this test was commonly accepted as an indicator of potential therapeutic utility.

The board did not share the examining division's conclusion in the case at issue. For a prior-art document to be recognised as prejudicial to the novelty of a claimed subject-matter, the information conveyed by this document could not be interpreted on the basis of rules, which, though normally valid, did not necessarily apply to the specific situation and therefore might lead to **speculative conclusions**.

The information in a citation that a medicament was undergoing a clinical phase evaluation for a specific therapeutic application was not prejudicial to the novelty of a claim directed to the same therapeutic application of the same medicament if such information was plausibly contradicted by the circumstances and if the content of said citation did not allow any conclusion to be drawn with regard to the actual existence of a therapeutic effect or any pharmacological effect which directly and unambiguously underlay the claimed therapeutic application.

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

In **T 378/94** the board ruled that facts which could be inferred from a source of information only by a process that could be described as "**obverse inference**" were not immediately recognisable. A subject-matter could be regarded as having been disclosed by a specific information source only if it could be directly and unambiguously inferred from that source. The board also found that other embodiments too came under the general concept mentioned above. It then went on to explain the relationship between the scope of protection of the claims and their disclosure. The board was of the opinion that the scope of protection of a patent claim giving the technical features of an invention, which claim consisted of one or several concepts serving mostly to generalise one or several specific examples disclosed in the description and drawings, could not be equated with the disclosure resulting directly from the wording of that claim. The scope of protection was connected with the extent of the concept or concepts defined in the claim, ie with the totality of every individual subject-matter showing all the features of such concept(s), whereas the disclosure was connected with the content of such concept(s), ie with the totality of features that made it possible to group together at an intellectual level each individual subject-matter. If a claim dealt with general concepts, it disclosed only these general concepts and not all the specific examples that came under these general concepts.

Decisive for novelty in **T 464/94** was a citation disclosing a preliminary test to transform plant protoplasts with selective markers. The opposition division had considered it probable that this document anticipated the patent in dispute.

In the board's view, it was not justifiable to decide whether a document was prejudicial to novelty on the **basis of probability**. When a patent was revoked for lack of novelty, the department concerned had to be sure, having taken all the facts and arguments put forward during the proceedings into consideration, that the revocation was justified. If in doubt, further evidence had to be adduced, otherwise the patent could not be revoked for lack of novelty.

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

2.2 Combinations within a prior art document

In **T 305/87** (OJ 1991, 429) the board considered it expedient to state that in order to assess novelty it was not sufficient to limit oneself to the contents of a single document taken as a whole but rather it was necessary to consider separately each entity described therein. The subject-matter of the patent under appeal was a shear. The opponents maintained that the features, taken as a whole, of two shears which were disclosed in a catalogue, had to be regarded as a single state of the art because those shears were described in one and the same technical context and in one and the same document. They argued that, when taken as a whole, this set of known features anticipated the invention. The board, however, made it clear that it was not permissible to combine **separate items belonging to different embodiments** described in one and the same document merely because they were disclosed in that one document, unless of course such combination had been specifically suggested there. The two shears known from the catalogue were therefore definitely two separate entities forming two independent bases for comparison which ought to be considered in isolation when assessing novelty, and it was not admissible to piece together artificially a more relevant state of the art from features belonging to one or both of these entities, even if they were both disclosed in one and the same document (see **T 901/90**, **T 931/92** and **T 739/93**).

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

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

In view of the objection as to lack of novelty, the question to be answered in decision **T 610/95** was whether or not the proposed solution in the patent was derivable directly and unambiguously from the disclosure of citation (2), which contained **cross-references** to the entire content of **three patent specifications** without giving priority to any of these references. Each of these references offered a plurality of different options for preparing pressure-sensitive layers of medical dressings.

The board held that, under these circumstances, it could not be said that the use of the specific product acting as pressure-sensitive material in the claimed invention was directly and unambiguously derivable from the wholly general reference to the three different prior documents quoted in citation (2) and had therefore already been made available to the public.

2.3 Taking implicit features into account

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

Any prior-art disclosure is novelty-destroying if the subject-matter claimed can be inferred directly and unequivocally from that disclosure, including features which for the skilled person are implicit in what is explicitly disclosed (see **T 677/91**, **T 465/92** (OJ 1996, 32) and **T 511/92**).

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

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

In **T 624/91** it was held that exact **disclosures for alloy compositions** in the state of the art had to be interpreted as average or nominal values within a small range in view of known fluctuations in reproducibility and in analytical results, unless there was evidence available to the contrary. The board pointed out that whenever a metallurgist aimed at producing an alloy in accordance with a given nominal composition, the composition of the final product would deviate somewhat from this target or even be undefined within certain narrow limits. The metallurgical production process was not ideally reproducible and the actual composition of different batches aiming at the same nominal composition would be spread over a certain area around this target. Consequently, the nominal composition of a cited alloy not only disclosed the composition as a specific point which nobody would be able to realise in practice, but also a certain range around this average or nominal composition into which the majority of the analyses of those alloys fell which had been prepared aiming at the nominal composition and using the care usual in this art when producing and analysing an alloy.

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

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

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

2.4. Taking intrinsic features into account

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

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

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

2.5 Taking equivalents into account

The case law of the boards of appeal is based on a narrow concept of novelty, ie the disclosure of a prior document does not include equivalents of the features which are explicitly or implicitly disclosed; equivalents can only be taken into account when it comes to considering inventive step (see **T 517/90**). This narrow concept of novelty, which excludes equivalents, is of particular importance for the application of Art. 54(3) EPC. In **T 167/84** (OJ 1987, 369) the board commented that conflicting applications within the meaning of Art. 54(3) EPC were included in the state of the art solely from the point of view of novelty, but were considered in the light of their "whole contents". In order to mitigate the harsh effects of the "whole contents approach", its application was confined to novelty (see Art. 56 EPC, second sentence). Further, in order to reduce the risk of "self-collision", it had always been considered justified to adopt a strict approach to novelty. For this reason C-IV, 7.2 of the Guidelines expressly stated that "when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the document; this is a matter of obviousness". Accordingly, the board held that the "whole contents" of an earlier document did not also comprise features which were equivalents of features in the later document (see also **T 928/93**).

2.6 Taking drawings into account

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

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

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

2.7 Taking examples into account

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

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

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

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

2.8 Assessment of prior uses

Several decisions have concerned the information content of prior uses.

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

In **T 363/90** a machine fitted with a sheet feeder corresponding to the claimed invention had been exhibited and demonstrated at trade fairs. The board concluded that, under the circumstances, it was impossible for the skilled person to recognise - or to infer on the basis of further information - the technical features and the functions of the exhibited sheet feeder to an extent which would have enabled him to copy its design, let alone develop it further (see also **T 461/88** (OJ 1993, 295).

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

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

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

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

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

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

In **G 1/92** (OJ 1993, 277) already mentioned above the Enlarged Board of Appeal held that, "Where it is possible for the skilled person to discover the composition or the internal structure of the product and to reproduce it without undue burden, then both the product and its composition or internal structure become state of the art."

In **T 952/92** (OJ 1995, 755) the board held that prior use of a product provided access to what the skilled person would be able to ascertain from that product by means of known analytical techniques. Whether such an analysis could be performed without undue burden was irrelevant to the question of whether the composition of a product had been made available to the public. In giving its reasons the board stated that the original English of **G 1/92** (OJ 1993, 277) was not entirely clear in terms of grammar, since the phrase "without undue burden" could qualify just the reproduction of the product, or both the discovery of its composition or internal structure and its reproduction. The reference to "without undue burden" was not strictly necessary in order to provide an answer to the referred questions and could not therefore have been intended to alter or add to the existing law concerning what constitutes "the state of the art". Reproducing a product "without undue burden" was a problem associated with Art. 83. Furthermore, to apply the concept of "undue burden" would introduce a subjective element into the determination of novelty, something which the Enlarged Board had specifically sought to reject in **G 1/92**.

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

In **T 472/92**, the problem to be solved by the subject-matter of the patent in suit was the provision of a laminate suitable for the fabrication of sleeves which could be heat-shrunk onto bottles, where the outer surface of the laminate should have a good printability. This problem was solved, according to the patent in suit, by the use of polystyrene. A further element of the solution was the manufacture of the two layer laminate by coextrusion. The appellant/opponent contended that coextruded polystyrene laminates had been delivered to a customer and that a skilled person would have been aware of their good printability and encouraged to replace, in the laminates known in the state of the art, the ethylene polymer composition based non-cellular layer by a non-foam layer made of polystyrene. The board referred to **G 1/92** point 3 and concluded that the printability characteristic of the material was not a property that became available to the public by their mere delivery, since this was clearly an extrinsic characteristic requiring interaction with specifically chosen outside conditions. Thus, such characteristic could not be considered as already having been made available to the public (see also **T 267/92**).

In case **T 301/94**, the patent concerned green glass bottles with a high filtering power for ultraviolet light and having a defined composition. It was proved that bottles with the claimed characteristics had been sold and delivered by the respondents (opponents) to a customer before the priority date. The appellants contended that the bottles produced of glass of said composition by the respondents had not been made available to the public, inter alia for the following reasons:

1) the sulphide concentration of the glass was a secret or a "hidden" feature within the meaning of decisions **G 1/92** and **G 2/88**, since it was not common general knowledge at the priority date that a green glass having a high UV absorption might contain a very low amount of sulphides. Thus, when analysing such a glass the skilled person would not have paid attention to the sulphide concentration, high sulphide concentrations being known only in connection with amber glass; 2) a skilled person would not have been able on the basis of what was generally known on the priority date to reproduce the green glass without undue burden because a tremendous number of experiments would have been necessary to find out the temperature and the reducing conditions leading to the desired optical properties by continuous production in an industrial plant.

The board held that the optical parameters represented intrinsic characteristics of the glass composition and not characteristics depending on a particular use or application of the glass. The situation considered by the Enlarged Board in decision **G 2/88** was different from that of the case on issue, since it concerned a claim relating to a new use of a known compound reflecting a newly discovered technical effect and not a claim to the compound itself. It was the new technical effect which constituted a hidden or secret feature, not the composition itself or one component thereof. Furthermore, the board held that the appellants in fact introduced an additional requirement for the chemical composition to be available to the public, ie that the skilled person should be able to recognize a priori, on the basis of the common general knowledge at the priority date, which components the commercially available product might contain and in which amounts. Such an additional requirement would not be in agreement with the essence of opinion **G 1/92**, where only analysability and reproducibility of the commercially available product were required for its chemical composition to be state of the art. Furthermore, the board held that the skilled person would have been able to reproduce the green glass without undue burden and that this was sufficient to meet the requirement of reproducibility set out in **G 1/92**. What was required in **G 1/92** was not that continuous production on an industrial scale be possible without undue burden, but that a skilled person be able to prepare the product without undue burden on the basis of his general technical knowledge and knowing the composition or internal structure of the product, whatever the scale of production (laboratory, pilot or industrial scale).

In **T 515/98** the invention related to an epilation device. The proceedings involved inter alia a claim of prior use.

The board ruled that any prior use had to be considered as a whole, just as parts of a prior-art document could not be taken out of context so as to arrive at different technical information from its teaching as a whole. Here too, certain components regarded as essential to a device's basic design for normal use as intended by the manufacturer could not be omitted.

In the present case, the prior-use epilation device - as even the appellant/opponent conceded - exhibited all the features of Claim 1 only if certain essential components were omitted, thus changing the kinematics of its operating elements.

In the board's view, the appellant thus implicitly acknowledged that the device as marketed was not identical with that according to the invention; what was identical with the latter was a modified version, newly constructed using only some of the original components, so that the epilation elements in the two versions differed as regards both structure and kinematics. Since, in order to move from the prior-use device to the one according to the invention, the skilled person had to perform several acts (dismantling the marketed device, omitting components, partial reconstruction) which would not arise from normal use of the device on sale, the subject-matter of Claim 1 was not directly and unambiguously derivable from the prior teaching.

2.9 Broad claims

In **T 607/93** the board decided that when novelty and inventive step were being assessed, there was no reason for using the description to interpret an excessively broad claim more narrowly if it was a question not of understanding concepts that required explanation but rather of examining an excessively broad request in relation to the state of the art.

2.10 Mistakes in a disclosure

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

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

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

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

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

2.11 Accidental disclosure

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

In **T 601/92** a radial ventilator was claimed, characterised in that the ventilator wheels were mounted on the ventilator shaft and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. The prior art comprised fans, during the assembly of which no attention was paid to the angle of rotation of the spokes of the two ventilator wheels in relation to each other. The probability that such fans, which coincidentally had the spoke arrangement claimed, had been sold was extremely high. The board held that this was evidence of an anticipatory prior use of the claimed product, stating that in the case of anticipation of a chance nature where there was no common technical problem, particular care had to be taken when considering what could be deemed to be part of the claim and what was derived from the prior publication. In contrast to **T 161/82** (OJ 1984, 551), in which the claimed subject-matter was also structurally the same as the prior subject-matter, but had a different function, there was no recognisable difference in function in this case. **T 208/88** (OJ 1992, 22) was not comparable since in the present case a product was claimed and not a new possible use for a known substance based on a previously unknown effect or function of that substance. The auxiliary request related to a process for manufacturing low-noise radial ventilators, characterised in that the ventilator wheels were systematically mounted on the ventilator shaft and offset against each other in such a way that the spokes of one ventilator wheel, viewed in the direction of the axle, were arranged opposite the gaps between the spokes of the other ventilator wheel. In the board's view this claim was clearly delimited from the prior art by the feature "systematically". This feature clearly referred to a procedural step and could acquire significance as a substantial distinguishing feature vis-à-vis the prior art only within a process claim. The fact that the claim for a manufacturing process contained predominantly product features was a logical consequence of the close connection between product and process and did not prevent the claim from being allowed.

In **T 608/96**, the board ruled that a disclosure was "accidentally novelty-destroying" if it would not be considered by the skilled person faced with the problem underlying the application or patent, whether because it belonged to a distant technical field or because its subject-matter suggested it would not help solve the problem. This also meant that a disclosure was "accidentally novelty-destroying" only if completely irrelevant for assessing inventive step.

2.12 Reproducibility of the content of the disclosure

A disclosure is novelty-destroying only if the teaching it contains is reproducible.

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

For selection inventions (see p.72 et seq.) the requirement of a reproducible disclosure also plays a significant role. In **T 26/85** (OJ 1990, 22) the board pointed out that anything comprised in the state of the art could only be regarded as having been made available to the public in so far as the information given to the person skilled in the art was sufficient to enable him to practise the technical teaching which was the subject of the disclosure, taking into account also the general knowledge in the field to be expected of him. In this particular case, the ranges of a certain parameter as defined in the claim fell within the broader ranges stated for the same parameter in a prior art document. According to the above-mentioned conclusion, the board considered that a realistic approach when assessing the novelty of the invention under examination over the prior art in a case where overlapping ranges of a certain parameter existed would be to consider whether the person skilled in the art would, in the light of the technical facts, seriously contemplate applying the technical teachings of the prior art document in the range of overlap; if it could be fairly assumed that this would be the case, it had to be concluded that no novelty existed. Such was not the case in the matter under consideration, since there existed in the prior art a reasoned statement clearly dissuading the person skilled in the art from using the range under a certain value, and the range of overlaps was under this value; the claimed range was therefore considered novel.

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

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

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

3. Ascertaining differences

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

3.1 Comparing each individual item from the prior art

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

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

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

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

In **T 866/93** the board had to decide whether the invention was anticipated by Document 1. The section of Document 1 relating to the prior art which the invention sought to improve on made reference to another document (Document 16) which was not cited in the descriptive part of the claimed invention.

The board held that, whilst the actual contents of a document (the "primary" document) might encompass the contents of another document (the "secondary" document), any reference in the primary document to the secondary document nevertheless had to be made in the appropriate context.

In decision **T 56/87** (OJ 1990, 188) the board emphasised that the technical disclosure in a document should be considered in its entirety, as it would be by a person skilled in the art, and that there could be no justification for arbitrarily isolating parts of the document in order to derive therefrom an item of technical information which would be distinct from or even contradict the integral teaching of the document. Therefore, the board considered that a particular feature relating to the positioning of the outer electrodes of a transmission ion chamber, in such a way that they partially lay in the shadow of a collimator, for implementing a process for correcting alignment errors of a divergent beam of rays, was not disclosed in a prior art document which, however, contained a figure in which such positioning could be identified. The reason was that the figure in question was obviously a schematic illustration showing neither the proportions nor the dimensions of the actual apparatus. In order to be able to interpret it correctly, the skilled technician therefore had to refer to the other figures and to the written description of the document; he would have deduced from the latter, however, that the outer electrodes should be positioned entirely in the radiation field, and not partially in the shadow of the collimators, as set out in the claims examined (see **T 332/87**, **T 441/91** and **T 657/92**).

3.2 Distinguishing features

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

3.2.1 Difference in wording

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

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

In **T 826/94** the board was of the opinion that a claimed measuring device, which showed all the constructive features of a known measuring device and differed from the latter only in name, ie in the dimensions to be measured, was novel within the meaning of Art. 54 EPC if it was only at the level of abstract thought, when the basic principles of the two measuring devices were compared with each other, that the conclusion could be drawn that the two measuring instruments were of the same type.

In **T 870/95** it was decided that the **general term "base"** used in the citations was novelty-destroying of the more specific one "permanganate in aqueous solution" if it were shown that in the light of the skilled person's general technical knowledge the former could only be understood to mean the latter.

In **T 79/96**, an extract from an handbook (D1) disclosed all the features of the claim 1 of the patent in issue apart from the use of a "countercurrent gas/gravity classifier". Thus, with respect to novelty it only had to be decided whether a vibrating fluidized bed with an upwards gas flow through the bed of particles as described in D1 should be regarded as a countercurrent gas/gravity classifier. The definition of a countercurrent gas/gravity classifier was given in an extract from another standard handbook on chemical technology (D3). The proprietor of the patent was of the opinion that the definition given in D3 was too broad and that a person skilled in the art would not consider a fluidized bed, being a rather inefficient classifier, as a countercurrent gas/gravity classifier.

The board did not share this view. It held that when assessing novelty of the claimed subject-matter an expression in a claim should be given its broadest technically sensible meaning. On that basis, any gas/gravity classifier, including a fluidized bed, satisfied the classification requirements of the claim 1 of the patent on issue. The subject-matter therefore lacked novelty over D1.

3.2.2 Differences in values

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

In **T 262/96,** regarding the issue of novelty, the appellant/opponent contended that the ZN40 material was commercially available before the priority date and that these products had the composition, microstructure and properties indicated in claim 1 of the patent in suit. The silica content of this sample of ZN40 material was lower than the lower limit of 0.05 wt% stated in claim 1 of the patent in suit. The appellant's argument that the difference between the said numerical values was only 0.007, and thus not significant, was not convincing for the board. As the silica content of this ZN40 material was itself relatively low, this difference represented in fact 16%. A difference of 16% in the silica content was sufficient to distinguish two products from each other if such low silica contents could be determined with sufficient accuracy by the method of measurement used. The appellant did not provide information about the standard deviation or the degree of accuracy of the method used. Instead, he argued at the oral proceedings that the value of 0.043. wt% was in fact lower than the actual value since the analysis was effected on the sintered body and such an analysis was more problematic than an analysis performed on the starting powder because of the additional components formed during sintering. In the board's view the fact that an analysis might be more difficult on the sintered product did not mean that the result of the analysis was necessarily too low.

Furthermore, the appellant's affirmation that the silica content measured in the sintered body was lower than the actual value was not supported by evidence and was contested by the respondent. If it were to be assumed for the sake of argument that the value given for ZN40 was too low, then the appellant would still have had to prove that the actual value lay within the claimed range of 0.05 to 0.5 wt%. Evidence to this effect was not provided by the appellant, although the burden of proof rested with him. In these circumstances, the board considered that, in the absence of evidence to the contrary, the silica content disclosed lay outside the claimed range and would not destroy the novelty of the claimed ceramic bodies.

3.2.3 Difference in composition

In **T 80/96** (OJ 2000, 50), claim 3 of the main request read as follows: "Preparation containing L-carnitine in the form of tablets, capsules, powders or granules, in particular for external application, characterised in that it contains L-carnitine-L-tartrate with an auxiliary substance or auxiliary substances and, possibly, one or more further active agents." An acqueous solution of the claimed tartrate compound was described in the prior art. The board held that, in the case of an active agent which was known as such to be water-soluble, it was clear to a person skilled in the art that describing and claiming the active agent as a solution did not add to or change the definition of that active agent. Without further specification, the mere characterisation of a solvent or diluent as liquid or solid in a claim did not change the assessment of the novelty of the subject-matter of the claim.

Analogously, in a claim directed to a preparation of a known structurally defined active agent with at least one auxiliary substance, in which the feature "with an auxiliary substance or auxiliary substances" meant that something was added to the active agent, the admixture of an unspecified auxiliary substance could not, in view of the unlimited number of substances which might enter into consideration, be deemed a substantive and distinctive addition to the active agent, unless this feature, which was necessary if novelty was to be recognised, was specified in such a way that a person skilled in the art could recognise what it was that should be added to the active agent. The claim was therefore not new.

3.2.4 Inevitably obtained products

In **T 270/97** the claimed product was considered by the opposition division and the respondent/opponent as anticipated by the agent produced and inevitably obtained by repeating Examples 1 and 2 of a prior-art document.

The board however found that the method disclosed in the text of Example 2 implied a way of acting not envisaged in the method according to the patent in suit. The parties' attempts to show that the particles obtained according to Example 2 were, or were not, identical to the products of the patent in suit, produced highly contradictory results. Therefore the board could only conclude that depending on experimental conditions not disclosed in Example 2 different products might be obtained. Thus the claimed product was not inevitably obtained by following the method of Example 2. As to Example 1, the board found that it did not disclose an essential feature of the method of making the product of the patent in suit. Under these circumstances, it was not tenable to argue that the product according to the patent in suit was the inevitable result of repeating Example 1.

3.2.5 Functional features

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

3.2.6 Generic disclosure

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

3.2.7 Product claim with process features

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

4. Chemical inventions and selection inventions

The state of the art often includes documents containing technical teachings described in general terms; these teachings in turn subsume a number of more specialised technical teachings. In assessing the novelty of subject-matter that can be subsumed under a general term in the state of the art, the question arises whether the general term makes the claimed matter fully or partially accessible to the public. In other words, it has to be established whether the general term used in the citation discloses the subject-matter defined by the special term in the claim. The prior-art disclosure needs to be ascertained especially carefully in such cases. General terms of this kind occur particularly frequently in the chemical literature, which is why the relevant case law usually relates to this field. There are two types of case here:

(a) assessing the novelty of chemical substances and groups of substances in respect of general formulae (Markush formulae) under which they fall (see below, Chapter I.C.4.1), and (b) assessing the novelty of products or processes defined by parameter ranges as against known products or processes characterised by wider or overlapping parameter ranges (see below, Chapter I.C.4.2).

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

4.1 Novelty of chemical compounds and groups of compounds

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

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

- A substance selection can come about if an unmentioned compound or group of compounds having a formula covered by the state of the art is found, in the absence of any information as to the starting substance or substances. The subject-matter in the case in question, however, did not involve a selection of that kind in an area which, although marked out by the state of the art, was nonetheless virgin territory.

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

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

The board held that the combination between starting substances and process variants, however, was quite a different matter from a combination of two starting substances and thus not comparable. At its simplest, if the starting substances were regarded as fragments of the end product, then every conceivable combination of a given starting substance in the first list with any starting substance in a separate second list of additionally required starting substances involved a true substantive modification of the first starting substance, since in every combination it was supplemented by a different fragment of the second starting substance to become a different end product. Each end product was thus the result of two variable parameters.

However, combining a given starting substance from a list of such substances with one of the methods of preparation given did not result in a real substance alteration of the starting substance but only an "identical" alteration. In the case in question, for example, no matter which of the processes described in detail was used, the end product was always the particular starting substance's hydrogenation product, which differed from the starting substance itself only in that it contained two additional hydrogen atoms. The process parameter was thus - seen in terms of the end product - not a variable parameter that would result in an immense widening of the range of possibilities, so that precisely in this case the end product was not the result of two variable parameters.

4.1.1 Anticipation of certain compounds

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

In **T 12/81** (OJ 1982, 296) the board stated (see above, I.C.4.1) that it is permissible to make the definition of a chemical substance more precise by additional product parameters such as melting point, hydrophillic properties, NMR coupling constant or product-by-process claims if it cannot be defined by a sufficiently accurate **generic formula**,. From this it necessarily follows that patent documents using such definitions will be prejudicial to the novelty of later applications claiming the same substance defined in a different and perhaps more precise way.

In **T 352/93** it was decided that a claim for an ionic compound (salt) that was defined only by structural parameters, ie the structural formulae of the cation and anion of the compound, was not novel over prior art disclosing an aqueous solution that contained a base corresponding to the cation and an acid corresponding to the anion.

In **T 767/95** the patent related to purified interleukin-1 having a specified molecular weight, a specified pI and a specified amino acid sequence. The appellant/opponent could not show that the substance disclosed in prior art document (1) and the claimed interleukin-1 were the same protein. The board stated (a) that there were differences as to the molecular weight, (b) that a comparison between the pI's of the substance described in document (1) and the claimed substance was not possible under the given circumstances, and (c) that document (1) suggested a mixture of proteins. The semipurified nature of the preparation of document (1) was confirmed by statements in the scientific literature. There was thus a blockage preventing the skilled person from sequencing the material of document (1). Regardless of whether it arose from the semipurified nature of these preparations or from the process yielding only traces of the protein, this blockage prevented the teaching of document (1) from making available to the public a protein having the amino acid sequence specified in the patent in suit. In conclusion, since there was no evidence before the board that the material of document (1) exhibited the features of claim 1 of the patent in suit, this document did not affect the novelty of the purified interleukin-1.

(b) Selection of starting substances from different lists

In **T 401/94** the board again adopted one of the criteria for selection inventions laid down in decision **T 12/81** (OJ 1982, 296), namely, that if two classes of starting substances were required to prepare the end products, and examples of individual entities in each class were given in two lists of some length, the substance resulting from the reaction of a specific pair from the two lists could be regarded for patent purposes as a selection and, hence, as new. The board applied the above criterion to the case in question and stated that although **T 12/81** concerned the synthesis of a chemical product, whereas the case in question involved the preparation of a **mixture**, the claimed subject-matter was defined on the basis of two chemical entities, each of which had been selected from a list of compounds. Hence the criteria defined in **T 12/81** were applicable in this case. By analogy, the board held that in this case the claimed composition had to be viewed as a selection, and therefore as novel, as it corresponded to a specific combination of constituents, each of which had been selected from a relatively long list. The board therefore concluded that there had been no implicit disclosure of the mixture of these constituents.

In **T 427/86**, the prior document described a process of synthesis characterised on the one hand by the starting substances and on the other by the catalytic system comprising the metal constituent and the catalytic promoter; taking into account the number of alternatives in the list of metal constituents and list of promoters in this document 36 different catalytic systems could be contained. The invention claimed aimed at improving the operation of the catalytic system. It comprised the selection of a very small number of alternatives (one and two respectively) from the list of metal constituents and list of promoters according to the prior document, the combination of which was not mentioned anywhere in the latter. The board was of the opinion that a substance resulting from the reaction of a specific pair from the two long lists was for patent purposes a selection and could be regarded as new because this specific combination chosen from the wide range of possibilities had not been disclosed by the citation. The board added furthermore that in view of the earlier decision **T 198/84** (see I.C.5.2.1), an objective reading of the prior art document suggested constituents of the catalytic system different from the claimed ones. Therefore, the claimed components were not implicitly disclosed. The board concluded that the condition of novelty had been satisfied.

In **T 366/96** the patent related to a detergent composition comprising a peroxidase, hydrogen peroxide, and a surfactant. Prior art document (12) disclosed a detergent composition comprising surfactants, enzymes and a bleaching agent. In the list of suitable enzymes, peroxidases were mentioned. The list of suitable bleaching agents comprised, i. a., inorganic peroxide.

The board found that document (12) taught a detergent composition comprising a peroxidase and a bleaching agent. As was generally known in the art, peroxidases act on hydrogen peroxide as a substrate. This implied that if the presence of peroxidases was specified, there would also be the simultaneous presence of hydrogen peroxide. In other words, even if one were to accept for the sake of argument that in document (12) the peroxidase on the one hand was enumerated in one list (i.e. that of the enzymes) and the hydrogen peroxide was mentioned in another list (i.e. that of the bleaching agents), to arrive at the compositions of the patent in suit would not require a "twofold" selection from two lists which could render the resulting combination of features novel. On the contrary, as soon as a person skilled in the art contemplated a detergent composition containing peroxidase, he or she must also contemplate the hydrogen peroxide precursors also disclosed in document (12) in order to ensure the supply of the necessary peroxidase substrate hydrogen peroxide. It was not comparable to a "twofold" selection which could render a resulting combination novel if compelling technical necessities made a particular second component mandatory as soon as the first component was chosen.

(c) Selection on the basis of a general formula

Prior-art disclosure is also of key importance here. In **T 181/82** (OJ 1984, 401) the board confirmed that the products of processes which were the inevitable result of a prior description of the starting materials and the process applied thereto belonged to the state of the art. This was true even if one of the two reactants manifested itself as a chemical entity (C_1 alkyl bromide) from a group of generically defined compounds (C_1 - C_4 alkyl bromides). The board took the view that the description of the reaction of a certain starting material with C_1 to C_4 alkyl bromides disclosed only the C_1-substituted product, and was not prepared to recognise the disclosure of a particular butyl substituent on the grounds that four isomeric butyl radicals existed.

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

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

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

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

4.1.2 Novelty of groups of substances

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

The board pointed out that a distinction had to be drawn between two situations:

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

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

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

Case (b) was extensively discussed in **T 124/87** (OJ 1989, 491). This decision dealt with the problem of assessing the novelty of a class of compounds defined with parameters within numerical ranges. The patent in suit claimed a class of compounds defined by parameters within numerical ranges while the prior document disclosed a process by which a class of compounds could be prepared - comprising those claimed in the patent in suit - having the combination of parameters required by the main claim of the latter.

In that particular case, the specifically described example in the prior document did not disclose the preparation of any particular compounds within the class defined in the claims of the disputed patent. However, it had been accepted by the patentee that a skilled man would have no difficulty in preparing such compounds within the class defined by the claims of the disputed patent using the process described in said prior document, in combination with his common general knowledge, so that the disclosure of the prior document had to be regarded as not only limited to the particular compounds whose preparation was described in the examples, but also comprising the general class of compounds made available to the skilled man in that technical teaching, even though only certain compounds within this class were described as having been prepared. Since the compounds as defined in the claims of the disputed patent formed a major part of this general class, they formed part of the state of the art and therefore lacked novelty.

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

4.1.3 Novelty of enantiomeres

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

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

In **T 1046/97** the claim was directed to a specific pure enantiomer. The examining division found that prior art document (B) disclosed a compound of the same formula as the one claimed by the applicant but without giving any information on its stereochemical configuration. However, in (B) it was also stated that "all optically active forms of the compounds described therein were enclosed in the teaching thereof." Since it belonged to the skilled person's general knowledge to identify such mixtures and to separate them, in the examining division's view the claimed enantiomer was not novel.

The board saw no reason to believe that a skilled person would not combine the disclosure of that compound with the reference to the racemic, meso and optically-active forms. However, it was established case law of the boards of appeal that the novelty of an individual chemical compound could only be denied if there was a direct and unambiguous prior disclosure of this very compound in the form of a technical teaching (see **T 181/82**, OJ 1984, 401; **T 296/87**, OJ 1990, 195). It was thus not sufficient for denying novelty that the claimed enantiomer belonged conceptually to the group of possible optically-active forms mentioned in (B) unless there was a pointer to the individual member of the group at stake. Thus, the claimed specific enantiomer being incontestably neither a racemate nor a meso form, the assessment of novelty crystallised on the question, whether it was directly and unambiguously derivable from the disclosure of the compound when combined with the reference to the optically active forms.

The board held that the term "optically-active forms" was to be interpreted as embracing any stereochemical form of the compounds disclosed in (B), independently of whether such property was obtained by a pure stereochemical isomer or by any mixture of such isomers. Since (B) provided no information about any specific stereochemical form this disclosure must be regarded as undifferentiated, with the effect that the reference to "all optically active forms of the compounds described therein" could not be equated to an individualised disclosure of a specific enantiomer. The board thus held that the specific configuration of the claimed enantiomer was not directly and unambiguously derivable from the teaching of (B) and novelty not destroyed.

4.1.4 Achieving a higher degree of purity

In **T 990/96** (OJ 1998, 489), it had to be examined whether the feature under dispute, which in fact represented a **specific degree of chemical purity** (in particular diastereomeric purity) constituted a "new element" imparting novelty to the claimed subject-matter.

The board stated that it was common general knowledge that any chemical compound obtained by a chemical reaction would normally contain impurities for various reasons and that it was not possible for thermodynamical reasons to obtain a compound, which was - in the strict sense - completely pure, ie totally free of any impurity. It was, therefore, common practice for a person skilled in the art of preparative organic chemistry to (further) purify a compound obtained in a particular chemical manufacturing process according to the prevailing needs and requirements. Conventional methods for the purification of low molecular organic reaction products, which could normally be successfully applied in purification steps, were within the common general knowledge. It followed that, in general, a document disclosing a low molecular chemical compound and its manufacture made this compound available to the public within the meaning of Art. 54 EPC in **all grades of purity** as desired by a person skilled in the art.

Exceptional situations could exist which could justify a different conclusion. One such exceptional situation could be a situation where it was proved on the balance of probability that all prior attempts to achieve a particular degree of purity by conventional purification processes had failed.

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

The board found, however, that the applicant, who bore the burden of proving this allegation, had not provided the necessary evidence. In fact, the prior-art teaching yielded significant, even if small, quantities of the substantially pure compound using conventional purification methods. The general rule therefore applied that achieving a particularly high level of purity of a known compound was not a feature to be regarded as imparting novelty to such a product over the prior art.

4.2 Selection of parameter ranges

4.2.1 Selection from a broad range

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

(a) the selected sub-range should be narrow;
(b) the selected sub-range should be sufficiently far removed from the preferred part of the known range (as illustrated for instance in the examples given in the prior art);
(c) the selected sub-range should not be an arbitrarily chosen specimen from the prior art, ie not merely one way of carrying out the prior teaching, but must provide a new invention (purposive selection).

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

With reference to the third criterion, the board in **T 198/84** was of the opinion that this view of novelty really entailed more than just a formal delimitation vis-à-vis the state of the art. There would be delimitation only in respect of the wording of the definition of the invention, but not in respect of its content, if the selection were arbitrary, ie if the selected range only had the same properties and capabilities as the whole range, so that what had been selected was only an arbitrary specimen from the prior art. This was not the case if the effect of the selection, eg the substantial improvement in yield, occurred in all probability only within the selected range, but not over the whole known range (purposive selection).

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

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

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

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

In **T 209/94**, in spite of the fact that the temperature ranges of pyrolysing steps to be carried out for preparing fibres overlapped ("greater than about 1600°C" according to the invention and "from 900 to 1800" according to the prior art document), the functional limitation of the pyrolysing step established by the statement introduced into claims 1 and 2 of the application at issue - "for a period of time sufficient to reduce oxygen and/or nitrogen content of the fibres to below about 0.5 % by weight" - distinguished the claimed process from the process according to prior art document. Indeed, from the latter document the board concluded that the presence of nitrogen (and boron) in the fibres in certain amounts was essential for their temperature stability. Since this improved thermal stability of the fibres was the very object of the invention disclosed in the prior art, fibres which would not have met this requirement could not have been considered to be within the teaching of this document. This meant, by implication, that fibres having a nitrogen and/or oxygen content which was too low to produce the desired thermal stability were not within the scope of the invention disclosed in the prior art: the lowest value disclosed in the prior art document was 3.89%, whereas according to the application at issue the maximum amount permitted was 0.5%.

In **T 610/96** the patentee/respondent claimed a magnetoresistive material comprising magnetic and non-magnetic metallic thin film layers. The board found that the claimed ranges defining the composition of said layers must be considered as a narrow selection of the generic disclosure of prior art document D10 which did not overlap with the sub-ranges preferred in D10 and which further selected a specific non-magnetic layer among a group of possible layers. This selection also was sufficiently far removed from the specific examples of D10. Furthermore, the claimed material showed different characteristics of the magnetoresistance change, so that the specific sub-range was not simply an arbitrary part of the generic disclosure of D10, but was of a different nature and therefore novel. The criteria for selection inventions set out in **T 279/89** were thus satisfied. Moreover, since a passage of D10 might be seen as a statement dissuading the skilled person from applying the concept of D10 in the sub-range of the contested patent, the person skilled in the art would not seriously contemplate applying the teaching of D10 in this range (see **T 26/85**, OJ 1990, 22).

4.2.2. Overlapping ranges

In decision **T 666/89** (OJ 1993, 495) the board gave a ruling on novelty assessment in cases of overlapping numerical ranges. The patent related in particular to a shampoo comprising 8-25 % anionic surfactant and 0.001-0.1 % cationic polymer. In an earlier patent application a shampoo composition had been disclosed containing 5-25 % anionic surfactant and 0.1-5.0 % cationic polymer.

The board held that the composition was not new. In the board's view, there was no fundamental difference between examining novelty in situations of so-called "overlap" or "selection", and in doing so in other situations, although it might be helpful, in order to verify a preliminary conclusion of a novelty examination in cases of overlap, to investigate whether or not a particular technical effect was associated with the narrow range in question. It needed to be stressed, however, that such a particular effect was neither a prerequisite for novelty nor could it as such confer novelty; its existence could merely serve to confirm a finding of novelty already achieved. The term "available " in Art. 54(2) EPC clearly went beyond literal or diagrammatical description, and implied the communication, express or implicit, of technical information by other means as well. Thus it was clear that matter that was hidden, not in the sense of being deliberately concealed but rather in the sense of being reconditely submerged in a document, would not have been "made available" in the above sense. In the case of overlapping ranges of physical parameters between a claim and a prior art disclosure, what would often help to determine what was "hidden" as opposed to what had been made available, was whether or not a skilled person would find it difficult to carry out the prior art teaching in the range of overlap. A similar approach was to consider whether a person skilled in the art would, in the light of all the technical facts at his disposal, "seriously contemplate" applying the technical teaching of the prior art document in the range of overlap.

Realising that the concept of "seriously contemplating" moving from a broad to a narrow (overlapping) range seemed akin to one of the concepts used by the boards for assessing inventive step, namely, whether the notional addressee "would have tried, with reasonable expectation of success" to bridge the technical gap between a particular piece of prior art and a claim whose inventiveness was in question, the board added that its novelty concept was fundamentally different from this "inventive-step concept" because, in order to establish anticipation, there could not be a gap of the above kind. Novelty was carefully analysed on the basis of comparable considerations in **T 366/90** and **T 565/90**.

Decision **T 26/85** suggested, as a specific test for determining whether a technical teaching had been made available to the public, posing the question whether the person skilled in the art would in the light of the technical facts **seriously contemplated** applying the technical teaching of the prior art document in the range of overlap. If it could be fairly assumed that he would do so, it had to be concluded that no novelty existed. This formulation of the question was adopted inter alia in **T 279/89**, **T 666/89**, **T 255/91** (OJ 1993, 318), **T 369/91** (of 7 October 1992), **T 631/92** and **T 660/93**.

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

4.2.3 Multiple selection

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

In case **T 653/93**, the appellant (applicant), whose patent was refused by the examining division, argued that the process of claim 1 was novel as it referred to a combination of three process features with selected ranges and product features with specific limits, which combination was not disclosed in the prior art document.

The board of appeal emphasised that in such situations the question of novelty could not be answered by contemplating the ranges of the various parameters separately. This would, in the board's judgment, be an artificial and unjustified approach, since it was not the specified ranges of the three parameters or their agglomeration that formed the subject-matter of claim 1, but the group of processes defined by the combination of these ranges, which was rather small when compared with the group of processes disclosed in the prior art document.

Thus the group of processes claimed, which was characterised by the combination of three specific process parameters, was not explicitly disclosed in the prior art document and therefore could be said to result from a "multiple (ie threefold) selection". The person skilled in the art, when applying the teaching of the prior art document, would not have had any reason to concentrate on the combination of the sub-ranges as defined in claim 1, eg because the omitted parts of the ranges disclosed in the prior art document could be recognised as of lesser interest. Since there was no indication to this effect, the "combined selection" did not emerge from the prior art document as being implicitly disclosed for the skilled person.

The novelty of the technical teaching of claim 1 was corroborated by experimental evidence showing that the products resulting from the claimed processes couldn't have been obtained by processes which were close to but nevertheless outside the range of the processes claimed. Moreover, the combination of properties of the products obtained by the claimed processes was not the inevitable result of the process disclosed in the prior art document but was obtained only by a particular combination of process parameters. It followed that the subject-matter of claim 1 was not considered as having been disclosed in the prior art document.

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

Furthermore, closer examination of D2 showed that the parameters of amount of rubber and particle size of rubber were merely disclosed as independent ranges without any indication as to how, or indeed whether, they might vary with one another. Whilst it was conceded by the respondent at the oral proceedings that D2 disclosed ranges partly overlapping with those defined in the solution of the technical problem, the latter required the simultaneous fulfilment of three values of the same parameters.

The board came to the conclusion that the claimed solution was not arbitrary since it solved a specific technical problem compared with the products according to D2. Hence, the claimed solution, to the extent that it overlapped with the general disclosure of D2 at all, represented a narrow selection therefrom and fulfilled all the requirements of a true selection (see **T 198/84**, OJ 1985, 209).

4.3 Subject-matter group

T 763/89 looked at selection from a generically defined group of multilayer materials. The patent related to a reversal colour photographic material comprising three layers having differing colour sensitivity, each layer comprising a further three layers having the same colour sensitivity but differing photographic sensitivity. The closest prior art consisted of a reversal material with "at least two" layers. The opponent had argued that the multilayer materials disclosed by this prior art also included the three-layer material claimed, therefore causing lack of novelty. The board, however, held that it was new: although "at least two" was synonymous with a multilayer material and set the lower limit in the form of a double-layer material (the description related to any multilayer material without specifying an upper limit for the number of possible layers), the only theoretical examples given for such multilayer materials were double-layer materials. Nor did the documents cited in support of the opposition as much as hint at a three-layer material. It might appear logical for a three-layer material to form part of the group of multilayer materials in the cited documents, but this did not mean that it was thereby disclosed. On the contrary, it was a new material forming part of this group and selected from it.

The board gave this ruling in the context of previous case law on selection inventions involving chemical substances. This had laid down that a technical teaching was prejudicial to novelty if it disclosed a substance in individualised form, ie one clearly distinguishable from structurally similar substances. This principle for assessing the novelty of individuals as distinct from a group could be applied to things such as the photographic material in question, which was clearly distinguishable from other things forming part of the same generically described group.

5. Novelty of use

5.1 First medical use

5.1.1 Introduction

Methods for the surgical or therapeutical treatment of the human or animal body and diagnostic methods practised on the human or animal body ("medical methods") are not regarded as inventions susceptible of industrial application (Art. 52(4) EPC, first sentence). Art. 54(5) EPC provides that the general rules of law relating to novelty (Art. 54(1) to (4) EPC) do not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Art. 52(4) EPC, provided that its use for any method referred to in that paragraph is not comprised in the state of the art. Thus in addition to the general concept of novelty (Art. 54(1) to (4) EPC) this article introduces, in respect of substances and compounds used in surgical and therapeutic treatment and in diagnostic processes carried out on humans and animals, a **special concept of novelty** unknown in other technical fields (**T 128/82** (OJ 1984, 164)).

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

5.1.2 Scope of a purpose-related product claim

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

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

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

In **T 9/81** (OJ 1983, 372) it was held that combined preparations the individual components of which represented known therapeutic agents might be protected in a formulation corresponding to Art. 54(5) EPC even when claimed as a kit-of-parts, providing those components formed a functional unity (true combination through a purpose-directed application. Claim 1, which was drawn up in the form stipulated in Art. 54(5) EPC, referred to a combined preparation containing an oxazaphosphorin cytostatic agent and the sodium salt of 2-mercapto-ethane-sulphonic acid as therapeutic active ingredients. The first-mentioned component of the product was known, and the second was a known mucolytic agent. According to the documentary prior art available to the board, the two active ingredients had never been used together for a **new joint effect** and were **unknown as a composition**. The active ingredients which were administered preferably at the same time according to the invention did not therefore represent a mere aggregate of known agents, but a new combination with the surprising, valuable property that the severe side-effects to be expected when administering the cytostatic agents were absent as a result of the detoxifying effect of the sodium 2-mercapto-ethane-sulphonate.

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

5.2 Second (further) medical use

5.2.1 Formulation of claims

(a) Use of a substance or composition for the manufacture of a medicament

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

The Enlarged Board did not accept claims directed to the use of a known substance X for the treatment of disease Y, because such a claim would relate to a medical method which was not patentable under Art. 52(4) EPC. However, it allowed claims of the type "use of substance X for the manufacture of a medicament for therapeutic application Y". The Enlarged Board derived the novelty of such claims from their sole new feature, that is the new pharmaceutical use of that known substance. The Enlarged Board found that no intention to exclude second (and further) medical indications generally from patent protection could be deduced from the terms of the EPC. As a result, the Enlarged Board considered that it was legitimate in principle to allow claims directed to the use of a substance or composition for the manufacture of a medicament for a specified new and inventive therapeutic application, even where the process of manufacture as such did not differ from known processes using the same active ingredient.

(b) Process for the manufacture of a medicament

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

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

In **T 958/94** (OJ 1997, 242), the examining division had refused the claims for Greece and Spain on the grounds that because they were directed to a process rather than an application or use they were not in the "second medical indication" form stipulated by the Enlarged Board of Appeal in **G 6/83** (OJ 1985, 64). The examining division had taken the view that the novelty of "the use of a substance for the manufacture of a medicament" was linked to formal requirements and that given the order of decision **G 6/83** on the protection of the second medical indication, only **use** claims - not **process** ones - fulfilled those requirements. The appellant (applicant) had filed an appeal against that decision, requesting that the decision to refuse the application be set aside.

The board noted that Enlarged Board decisions **G 1/93, G 5/83** and **G 6/83** made no mention of requirements of form or category governing claims directed to a medicament's second therapeutic indication. In the board's view the French wording "revendications ayant pour objet" used in decision **G 6/83** referred not to the formal aspect of the category of a claim but rather to its substance, ie the definition of the claimed invention in terms of its essential features. Parallel decisions **G 1/83** and **G 5/83** in German and English used the words "Patentansprüche gerichtet auf" and "claims directed to" rather than "Gegenstand" or "subject-matter", which also showed that the determining factor was not the wording or category chosen for the claim but its substance, namely the technical feature which formed the essence of the invention claimed (use of the substance in question). This interpretation was confirmed by the reasons for decisions **G 1/83, G 5/83** and **G 6/83**.

In point 11 of decision **G 5/83** (first paragraph) the Enlarged Board held that an invention relating to an activity could be claimed either as the application or use of a thing for a stated purpose (eg to achieve a technical result) or as a method or process to achieve the same result using the same thing, depending on the applicant's preference. Either type of claim also involved a sequence of steps giving rise to the final effect. In terms of use, therefore, there was no difference of substance. This general rule also applied in the field of therapy. There was no discernible substantive difference between a claim for the use of a substance or composition for the treatment of the human or animal body by therapy and a claim directed to a method of treatment of the human or animal body by therapy. The sole difference was in the wording, as was emphasised by the Enlarged Board in point 13 of decision **G 5/83**. Thus, manufacturing a medicament did indeed involve a sequence of common and obligatory steps, irrespective of the form of the claims which circumscribed its manufacture, and whether the claims were for the "application of a substance to obtain a medicament intended for a new therapeutic use" or for a "process to obtain a medicament intended for the new application, characterised in that the substance is used". Although the active substance per se, the medicament and the process for its manufacture were already known, the Enlarged Board in decisions **G 1/83, G 5/83** and **G 6/83** allowed a claim for preparing the medicament for the new therapeutic indication and directed to the substance's use in manufacturing the medicament intended for that new therapeutic indication. In the same conditions - ie where the active substance, the medicament and the process for its manufacture all lacked novelty - it would therefore be unjustified to regard a claim of the type "method for manufacturing the medicament intended for the new therapeutic indication" as not patentable, given that a claim for the use of a substance to manufacture a medicament intended for a new therapeutic use and a claim for a method of manufacturing the medicament intended for the new use and characterised in that the same substance was used were substantively equivalent. This decision endorses the approach already outlined in **T 893/90** of 22 July 1993.

(c) Further issues relating to the second medical use claim

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

In **T 143/94** (OJ 1996, 430) the board found that a claim directed to the use of a substance or composition for the production of a medicament for a therapeutic application did not conflict with Art. 52(4) EPC or Art. 57 EPC (see **G 1/83**, **G 5/83**, **G 6/83**); this was true irrespective of what purpose the claim served (protection of a first medical use of a substance or composition, or protection of a further medical use). Accordingly, prior evidence of a further medical use was not required for this form of claim to be included in a patent application.

In **T 4/98** (OJ 2002, ***) the independent claims were drawn up in the form of “Swiss type” claims. The board had difficulties however in accepting the opposition division's opinion that these claims reflected in fact a second (further) medical use and that some particular features in the claims constituted a specified therapeutic application from which novelty for the claims could be derived in accordance with the principles of decision **G 5/83** (OJ 1985, 64). The board held that in accordance with the principles in **G 5/83** and subsequent case law, the concept of second or further medical use can only be applied to claims to the use of substances or compositions for the preparation of a medicament intended for use in a method referred to in Art. 52(4) EPC. It noted that the concept of "therapy" or "therapeutic application" includes treatment of a particular illness or disease with a specified chemical substance or composition in a specified human or animal subject in need of such treatment and that in the absence of the identification of at least (i) the illness or disease to be treated or the ailment to be cured or (ii) the nature of the therapeutic compound used for treating or curing the disease or (iii) the subject to be treated, a mere process feature could not be construed as specifying a particular method of treatment or therapeutic application within the meaning of Art. 52(4) EPC (see Reasons, paragraphs 8.1 and 8.2). Thus the board came to the conclusion that the subject-matter of the independent claims was accordingly to be understood as relating to a non-therapeutic technical activity (process).

5.2.2 Novelty of the new therapeutical application

(a) Identification of the subject to be treated

The board of appeal applied the principles of decision **G 5/83** in case **T 19/86** (OJ 1989, 24). It had to decide whether the application of a known medicament for the prophylactic treatment of the **same disease** in an **immunologically different** population of animals of the same species could be considered a new therapeutic application from which novelty for the claims could be derived. According to decision **T 19/86** the question of whether a new therapeutic use was in accordance with decision **G 5/83** should not be answered exclusively on the basis of the ailment to be cured but also on the basis of the subject (in the case in question, the new group of pigs) to be treated. A therapeutic application was incomplete if the subject to be treated was not identified; only a disclosure of both the disease **and** the subject to be treated represented a complete technical teaching. The proposal according to the application to protect animals which could not hitherto be protected from the disease in question, by intranasally administering to them a known serum, could not be considered disclosed in the prior art and therefore constituted a novel therapeutic application in accordance with the above-mentioned decision of the Enlarged Board (see also **T 893/90**).

(b) Distinguishing between group of subjects

In **T 233/96** the board held that if the use of a compound was known in the treatment or diagnosis of a disease of a particular group of subjects, the treatment or diagnosis of the same disease with the same compound could nevertheless represent a novel therapeutic or diagnostic application, provided that it is carried out on a new group of subjects which is distinguished from the former by its physiological or pathological status (**T 19/86**, OJ 1989, 25; **T 893/90**). This does not apply, however if the group chosen overlaps with the group previously treated or the choice of the novel group is arbitrary which means that no functional relationship does exist between the particular physiological or pathological status of this group of subjects (here humans who are unable to exercise adequately) and the therapeutic or pharmacological effect achieved.

(c) Difference in the prescribed regimen of two drugs

In **T 317/95** the issue of novelty concerned both the question of whether the mere difference in the course of the administration of two drugs (ie the prescribed regimen) could indeed confer novelty on claim 10, and the objections to this claim which appeared to imply the issue of patentability under the terms of Art. 52(4) EPC. The invention involved the treatment of exactly the same category of patients by separately administering to them the same two commercial drugs in the same concentration, dosage and formulation for the treatment of the same illness or disease, with the sole exception that the prescribed regimen for this treatment was slightly modified (BNS and cimetidine were administered to the patient within five minutes of each other).

The board observed that in **G 5/83** (OJ 1985, 64) the Enlarged Board had stated that it was the purpose of the exclusion of medical treatments from patentability according to Art. 52(4) EPC to free from restraint non-commercial and non-industrial medical and veterinary activities. The board did not question the appellants' submission that the pharmaceutical industry was engaged in optimising the use of drugs and medicaments by investigating the optimum regimen for their administration to achieve the maximum possible therapeutic effect. However, the board pointed out that determination of the best individual treatment schedule, in particular the prescribing and modification of drug regimens used for administering a particular medicament, so as to comply with the specific needs of a patient, appeared to be part of the typical activities and duties of the doctor in attendance in exercising his professional skills of curing, preventing or alleviating the symptoms of suffering and illness. These were typical non-commercial and non-industrial medical activities which Art. 52(4) EPC intended to free from restraint. The board found that before the priority date of the contested patent, the medical practitioner was aware of the possibility of treating gastrointestinal disorders using the particular combination of drugs defined in claim 10. He was similarly in a position to prescribe an effective regimen for treating each patient according to his or her individual needs. It therefore appeared questionable to the board whether the feature at issue could indeed be considered to represent a further medical indication from which novelty could be derived on the basis of the principles set out in decision **G 5/83.** In any case, inventive step was lacking.

(d) Difference in the mode of administration

In **T 51/93** a European patent application relating to the use of human HCG for the manufacture of a medicament for subcutaneous administration was refused by the examining division because prior art document D(1) implicitly disclosed the subcutaneous administration, and because the subcutaneous administration of HCG was an obvious alternative to intramuscular administration. D(4) (cited by the board) disclosed vials for injection containing HCG and diluent, obtained by mixing HCG with a carrier and/or diluent. The only difference between the invention as claimed and the disclosure of D(4) was that the claim was directed to an intended method of subcutaneous administration. The claim was drafted in the form approved in decision **G 5/83** for claims where the novelty was solely that of the intended use, so the only question was whether a difference in the mode of administration of a medicament could be treated as a new therapeutic use. The board, relying on **T 290/86**, observed that the mode of administration might be a critical factor in a medical treatment and no reason could be seen for any **a priori** bar to relying on this difference when distinguishing over the prior art. Rather, patentability should be treated as depending only on whether this modification was in fact novel and inventive. Thus, it was possible to acknowledge novelty over D(4) (see **T 143/94**, OJ 1996, 430).

(e) Novelty based on the different technical effect

In decision **T 290/86** (OJ 1992, 414) the board had to give a ruling on the novelty of a claim drawn up in the form of a second medical use. The claim's subject-matter was the use of a lanthanum salt for the preparation of a composition intended to remove dental plaque (according to the patent proprietor, plaque removal had the effect of preventing caries). The closest prior art disclosed compositions comprising salts containing various elements, including lanthanum, to depress the solubility of tooth enamel in organic acids, and thus to inhibit tooth decay. The board considered the claimed invention new. The grounds for its decision were as follows: "When a prior document and a claimed invention are both concerned with a similar treatment of the human body for the same therapeutic purpose, the claimed invention represents a further medical indication as compared to the prior document within the meaning of decision **G 5/83** if it is based upon a different technical effect which is both new and inventive over the disclosure of the prior document". In this case the technical effect considered new was the removal of dental plaque, whereas the prior art only disclosed the depression of enamel solubility in organic acids.

(f) Statement of purpose

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

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

(g) Discovery of a previously unknown property of a compound

In **T 254/93** (OJ 1998, 285) an application relating to the use of a retinoid compound in association with the use of corticosteroids in the prevention of skin atrophy was refused by the examining division.

The board noted that it was a basic consideration in **G 2/88** that the recognition or discovery of a previously unknown property of a compound, such property providing a new technical effect, could involve a valuable and inventive contribution to the art. This was apparently the reason why the Enlarged Board of Appeal accepted that the use related to such a property could be regarded as a technical feature appropriate for establishing novelty. The board stated that it had no difficulty in accepting that the prevention of skin atrophy had to be regarded as a pharmaceutical feature and, following the conclusions of the Enlarged Board of Appeal, that the effect underlying this feature was not made available to the public in written form by any of the cited literature. Nevertheless, the question arose whether, in the case at issue, this effect represented a **technical effect** within the meaning of decisions **G 2/88** and **G 6/88**, which was necessary to establish novelty, under Art. 54(1) EPC, of the claimed subject-matter over the prior art. Although it concerned a specific aspect of the known use, the use specified in claim 1 (prevention of skin atrophy) was not finally different from the known use (treatment of dermatoses). The board observed that when a second medical indication was claimed in relation with the use of a constituent in the preparation of a known composition and the final effect was apparent in using the known composition for the known purpose, a technical problem could be seen neither in the obtention of the final effect nor in the preparation of the composition. The only remaining question could be the explanation of the phenomenon underlying the treatment according to the known process. However, the mere explanation of an effect obtained when using a compound in a known composition, even if the explanation related to a pharmaceutical effect which was not known to be due to that compound in the known composition, could not confer novelty on a known process if the skilled person was already aware of the occurrence of the desired effect when applying the known process.

5.2.3 Inventive step of the new therapeutical application

In **T 913/94** the appellant had argued that gastritis and ulcer were distinct diseases characterised by a different pathology. In the appellants' view, no class of medicaments existed, with the exception of the anti-acids, suitable for treating both diseases. In fact, the leading drugs for peptic ulcer were not used by the medical profession for treating gastritis.

In the context of assessing the **inventive merit** of the claimed use of GGA for the treatment of gastritis the board came to the conclusion that ulcer does not develop independently of gastritis and according to an exclusive mechanism, which would justify the occurrence of ulcer without any previous occurrence of gastritis, but, on the contrary, that the two diseases develop through the same mechanism, or at least through some common, early stages, on a scale of progressive, increasing severity of symptoms depending on the severity of the aggressive agent. The board also found that on the priority date of the application, the skilled person was aware that the leading and most widely employed anti-ulcer medicaments, ie anti-acids and H2-histamine receptor antagonists, were also effective against gastritis. While admitting that GGA represented a different class of anti-ulcer medicaments, the board considered this point as immaterial. In the board's judgment, what was decisive was the elucidation of the mechanism of action of GGA. The board held that GGA was known for the treatment of experimentally induced ulcer; its use for the preparation of a medicament for the treatment of gastritis did not involve any inventive merit (cf. chapter D.6.18).

5.3 Second (further) non-medical use

5.3.1 Novelty criteria for non-medical use claims

(a) General issues decided in the decision of the Enlarged Board of Appeal

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

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

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

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

In decisions **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114), the Enlarged Board stated that the patentability of a second non-medical use of a product was already recognised in principle in **G 5/83** which concerned the second medical use of a substance. However, in that earlier decision the exclusion from patentability of therapeutic and diagnostic methods had caused the Enlarged Board to allow only a special type of claim. These specific difficulties did not arise in the non-medical field; there the question was of a general nature, concerned primarily with the question of interpretation of Art. 54(1) EPC and Art. 54(2) EPC. In **G 2/88** and **G 6/88**, therefore, it was pointed out that a claimed invention lacked novelty unless it included at least one **essential** technical feature which distinguished it from the state of the art. A basic initial consideration, when deciding upon the novelty of a claim, was therefore to analyse it in order to determine its technical features. The Enlarged Board took the view that the proper interpretation of a claim whose wording clearly defined a new use of a known compound would normally be such that the attaining of a new technical effect on which the new use was based was a technical feature of the claimed invention. Thus, where the particular technical effect underlying such use was described in the patent, the proper interpretation of that claim would require a functional feature to be implicitly contained in the claim as a technical feature - eg the compound actually achieved the particular effect.

Referring to the facts of **T 231/85** (see above) as an example, the Enlarged Board explained that the claim directed to the use of a substance (known as a growth regulator) as a fungicide implicitly included a **functional** technical feature, namely that the said substance when used in accordance with the described means of realisation in fact achieved the effect (ie performed the function) of controlling fungus. The claim should not be interpreted literally as only including by way of technical features "the substance" and "the means of realisation of the claimed purpose", but should in appropriate cases be interpreted as also including as a technical feature the function of achieving that purpose, because that was the **technical result**. When determining novelty the decisive question of what had been made available to the public was one of fact in each case. A line had to be drawn between what was in fact made available and what remained hidden or had not otherwise been made available. In that connection the distinction between lack of novelty and lack of inventive step also had to be emphasised: information equivalent to a claimed invention may be "made available" (lack of novelty), or it may not have been made available but is obvious (novel, but lack of inventive step), or was not made available and is not obvious (novel and inventive). Thus, in particular, what is hidden may still be obvious. Under Art. 54(2) EPC the question was not what might have been "inherent" in what was previously made available to the public under the EPC. Under the EPC, the hidden or secret use, because it had not been made available to the public, was not a ground of objection to the validity of a European patent. In that respect, the provisions of the EPC might differ from the earlier national laws of some contracting states, and even from the current national laws of some non-contracting states. Thus, the question of "inherency" did not arise as such under Art. 54 EPC. Any vested right derived from prior use of an invention was a matter of national law.

The Enlarged Board thus concluded that with respect to a claim to a new use of a known compound, such new use might reflect a newly discovered technical effect described in the patent. The attaining of such a technical effect should then be considered as a **functional technical feature** of the claim (eg the achievement in a particular context of that technical effect). Had that technical feature not previously been made available to the public by any of the means set out in Art. 54(2) EPC, then the claimed invention was novel, even though such technical effect might have inherently taken place in the course of carrying out what had previously been made available to the public. The final decisions in cases **T 59/87** (OJ 1991, 561) and **T 208/88** (OJ 1992, 22) both held that the claimed use inventions were novel and inventive.

(b) Non-therapeutic treatment of animals

In decision **T 582/88** the board applied the principles set out in decision **G 2/88** in slightly different circumstances. The invention's subject-matter was a method of non-therapeutic treatment of animals for the purpose of improving their milk production and comprising oral administration of a propionate-increasing amount of glycopeptide antibiotics. In the board's view the technical effect produced by the invention - in this case an improvement in milk production - was new and had to be construed as a new technical feature sufficient to make the invention novel. The claim's subject-matter was a method of non-therapeutic treatment of animals, not - as in decision **G 2/88** - use of a known product to achieve a new effect.

(c) Non-therapeutic use distinguishable from the known therapeutic use

In **T 469/94** a European patent application on the basis of a set of claims directed to the protection of the second medical indication of choline or a choline derivative was refused by the examining division because it considered that the known treatment with choline of muscle diseases and hardness was equivalent to or even a synonym for the treatment for reducing muscle fatigue which was claimed in the application in suit. In response to a communication from the board, the appellant filed a new set of claims having the form of the protection of the second non-therapeutic use of a product.

Examining the case, the board concluded that the ability of choline to reduce the perception of fatigue had not been made available to the public. The first use of choline, in the therapeutic field, was known from two prior art documents. The board held that an independent invention could be based on the newly discovered effect if such an effect led to a new technical application which was clearly distinguishable from the previous known application. The prior art documents did indeed describe the use of choline on groups of patients having manifest diseases: either epilepsy or muscle diseases and injuries. Likewise in the case of the prophylactic use of choline envisaged in a prior art document for muscle rheumatism or muscle troubles arising from thyroidal diseases, the prophylaxis did not appear to mean the prevention of the disease itself, but simply the prevention of the acute phase of a chronic disease. The board observed that fatigue arising from major exercise was not of a pathological nature, and that the performance itself of major exercise appeared to be quite incompatible with the situations envisaged in the prior art documents, specifically that of muscle injuries. The non-therapeutic use of choline according to the invention was therefore independent of, and distinguishable from, the known therapeutic use because it was **directed to a distinct group of persons**. The subject-matter of the claim at issue was therefore found to be novel.

(d) Discovery of a new use of a known apparatus

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

In **T 637/92** the board held that according to established case law the statement of purpose of a claimed device (or product) was to be interpreted as meaning that the device was suitable for the stated purpose and that a known device that served another purpose but otherwise possessed all the features listed in the patent claim was not prejudicial to the novelty of the subject-matter of the claim if the known device was unsuitable for the purpose referred to in the claim (see Guidelines C-III, 4.8, and **T 287/86**, reasons, 2.2). In the case in question, however, these conditions had not been met since the device known from the citation did not possess one of the features of claim 1.

(e) New use functional feature in a known process

In **T 848/93** the application claimed a process which differed from the prior art only in its use. The examining division had understood the claim to mean that the process claimed was suitable for the use described, and had considered that it lacked novelty because the process known in the prior art was also suitable for that use, even if this was not expressly stated.

The board did not agree: if a claim concerned e.g. an apparatus which differed from a known apparatus only as regards the use indicated, then the use was not an apparatus feature. This meant that the two pieces of apparatus were identical in terms of structure. If the known apparatus was suitable for the claimed use, the application lacked novelty. If the claim was directed to an object, a substance or a composition, the same applied. If however the claim was for a process, the situation was not comparable. In such a case, the use feature was a functional process feature comparable in category with the other features (steps) of the process. The teaching of **T 69/85** or Guidelines C-III, 4.8 was therefore not transferable to the present case.

(f) Claim directed to the use of a known process for a particular purpose

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

(g) Discovery of properties in a known product

In **T 279/93** a claim directed to the use of a first compound in a process for preparing a second compound was revoked by the opposition division for lack of novelty. In particular, the claims were directed to the use of the alkanolamines for reducing the formation of isomelamine impurities. According to the appellant, this purpose, even if it might have been inherently attained by following the teaching of a prior art document, should have rendered the subject-matter of the claims novel, since, in application of the reasoning in decision **G 2/88**, inherency did not destroy the novelty of the new use, which had to be regarded as a functional technical feature of the claims.

In the board's judgment, the use of a compound in a process for preparing another compound in order to reduce the formation of impurities was not necessarily a functional technical feature in the sense of decision **G 2/88**, and did not therefore in all circumstances confer novelty on the subject-matter of a claim containing it. The facts of the case at issue differed significantly from those underlying decision **G 2/88**, since the claim did not appear to contain any new technical effect or technical purpose in the sense required by that decision. In the board's view, noticing that an old product had the property of containing fewer isomelamine impurities was a mere discovery. To convert this into a patentable invention, and to show the characteristics of a new technical effect, the use referred to in the claim would have to be some new use of the product which exploited the discovery that the isomelamine impurities were low for some new technical purpose. However, the patent in suit disclosed no such new use; it did not teach the skilled person to do something which would not have been done without knowing the content of the patent. The patent merely gave the person skilled in the art reasons for preferring one known product over other known ones for the uses for which it had already been suggested

(h) Discovery of a new technical effect

In **T 892/94** (OJ 2000, 1) the board noted that according to **G 2/88** (OJ 1990, 93), novelty within the meaning of Art. 54(1) EPC could be acknowledged for a claim directed to the use of a known substance for a hitherto unknown, ie new, non-medical purpose reflecting a newly discovered technical effect. However, a newly discovered technical effect did not confer novelty on a claim directed to the use of a known substance for a known non-medical purpose if the newly discovered technical effect already underlay the known use of the known substance.

The disclosure in citation (1) was, in the board's judgment, prejudicial to the novelty of the claim in question. It was immaterial for the purposes of prejudice to novelty that the actual technical effect exhibited by "aromatic esters" in deodorising compositions was not described in the cited document. The ex post facto discovery that the deodorising effect of "aromatic esters" when used as an active ingredient in deodorising products could result from their capability of inhibiting esterase-producing micro-organisms might possibly be regarded as a (potentially surprising) piece of knowledge about the known use or application of such esters but could not confer novelty on a claim, since the latter would require that the newly discovered effect indeed ended in a new technical application or use of the "aromatic esters" which was not necessarily correlated with the known application or use and could be clearly distinguished therefrom.

In **T 706/95** the board held that the discovery that the same known means lead to an additional effect when they are used for the same known purpose (i.e. known use) of reducing the concentration of nitrogen oxides in the same effluent could not confer novelty to this known use.

In **T 189/95** the board ruled that a new property of a substance, ie a new technical effect, did not necessarily signal or give rise to a new use for that substance. For example, the new property might merely explain the mechanism behind the use already described in the prior art, as in **T 892/94** (OJ 2000, 1). Here again the board ruled that discovering a new property or activity did not in itself render novel a claim for the use of a known substance for a known non-medical use, if the discovery only showed what formed the basis of the known use of the known substance.

In **T 1073/96** the board noted that under **G 2/88** (OJ 1990, 93) and **G 6/88** (OJ 1990, 114) novelty can only be acknowledged if the requirements as follows are met: (I) the claimed use as such was new, and (ii) if it reflected a newly discovered technical effect described in the patent. Concerning the question of whether the particular intended use stated in the claim at issue ("to provide an improved structural gum surface for a confectionery coating") reflected a technical effect that had not previously been made available to the public, the board found that it could not reasonably be considered based on or to reflect a technical effect described for the first time in the contested patent and, as such, could be distinguished from the known effects already described in (2) and (3) in association with the known use of PalatinitR. The finding that the known use of PalatinitR claimed in the patent in suit possibly resulted in an improved structural gum surface for a confectionary coating could merely be regarded as the ex post facto attempt to explain the known effects resulting from the known use of PalatinitR already disclosed in paragraph 1.3 of the document (3). The above considerations were, in the board's judgment, in line with the conclusions in decision **T 254/93** (OJ 1998, 285, see especially Reasons, point 4.8). A definite distinguishing technical feature, which confers novelty on the subject-matter of claim 1 within the meaning of Art. 54(1) EPC was not recognisable in the patent in suit.

5.3.2 Statement of purpose in non-medical use claims

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

5.3.3 Disclosure of an equivalent article without an indication of the particular use claimed

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

D. Inventive step

1. Introduction

An invention is considered to involve an **inventive step** if, having regard to the **state of the art**, it is not **obvious** to a **person skilled in the art** (Art. 56 EPC, first sentence). The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) EPC; it does not include later published European applications referred to in Art. 54(3) EPC (for full details see Guidelines, C-IV.9).

Technical progress is not a requirement for patentability under the EPC. Therefore, technical progress shown in comparison with marketed products as an alleged support for inventive step cannot be a substitute for the demonstration of inventive step with regard to the relevant closest state of the art (see **T 181/82** (OJ 1984, 401), **T 164/83** (OJ 1987, 149) **T 317/88** and **T 385/94**).

The extent of the monopoly conferred by a patent should correspond to and be justified by the technical contribution to the art. This general principle of law, applied in **T 409/91** (OJ 1994, 653) and **T 435/91** (OJ 1995, 188) (albeit to determine the scope of protection justified under Art. 83 EPC and Art. 84 EPC), also applies to decisions under Art. 56 EPC, because everything covered by a legally valid claim has to be inventive. Otherwise the claim has to be amended, by deleting anything obvious to ensure that the monopoly is justified (**T 939/92** (OJ 1996, 309), **T 930/94**, **T 795/93** and **T 714/97**).

2. Problem and solution approach

To assess inventive step, the boards normally apply the "problem and solution approach". This consists essentially in (a) identifying the "closest prior art", (b) assessing the technical results (or effects) achieved by the claimed invention when compared with the "closest state of the art" established, (c) defining the technical problem to be solved as the object of the invention to achieve these results, and (d) examining whether or not a skilled person, having regard to the state of the art in the sense of Art. 54(2) EPC, would have suggested the claimed technical features for obtaining the results achieved by the claimed invention (see also Guidelines, C-IV, 9.5). The boards frequently cite R. 27(1)(c) EPC as the basis for the problem and solution approach. R. 27(1)(c) EPC requires that the invention be disclosed in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood. Problem and solution are thus component parts of any technical invention. The problem and solution approach was primarily developed to ensure objective assessment of inventive step and avoid ex post facto analysis of the prior art.

According to board of appeal case law (see **T 1/80** (OJ 1981, 206), **T 20/81** (OJ 1982, 217), **T 24/81** (OJ 1983, 133) and **T 248/85** (OJ 1986, 261)), the assessment of inventive step has to be based on the objective, not subjective, achievement of the inventor. By starting out from the objectively ruling state of the art, the technical problem is to be determined on the basis of objective criteria and consideration given to whether or not the disclosed solution was obvious to the skilled person. The correct use of the problem and solution approach rules out an **ex post facto analysis** which inadmissibly makes use of knowledge of the invention (**T 564/89**, **T 645/92**, **T 795/93** and **T 730/96**).

In **T 465/92** (OJ 1996, 32) the board did not take the problem and solution approach when assessing inventive step, and said this was merely one possible approach, with advantages and drawbacks. This however is a one-off decision.

3. Closest prior art

3.1 Determination of closest prior art - general

In accordance with the problem and solution approach, the boards have developed certain criteria for identifying the closest prior art to be treated as a starting point. After the relevant prior art has been identified, careful consideration must be given to the question whether, in the case concerned, the skilled person, taking into account all the available information on the technical context of the claimed invention, would have had good reason to take this prior art as the starting point for further development. The boards have repeatedly pointed out that the closest prior art for assessing inventive step is normally a prior art document disclosing subject-matter conceived for the same purpose or aiming at the same objective as the claimed invention and having the most relevant technical features in common, i.e. requiring the minimum of structural modifications (**T 606/89, T 686/91, T 834/91, T 482/92, T 298/93, T 380/93, T 59/96, T 730/96**). A further criterion for the selection of the most promising starting point is the similarity of technical problem (**T 495/91, T 570/91, T 439/92** ,**T 989/93, T 1203/97, T 263/99**). The prior art has to be assessed from the point of view of the skilled person on the priority date applicable (**T 24/81** (OJ 1983, 133), **T 772/94, T 971/95**).

3.2 Same purpose or effect

In selecting the closest prior art, the first consideration is that it must be directed to the same purpose or effect as the invention. Otherwise, it cannot lead the skilled person in an obvious way to the claimed invention. According to **T 606/89** the closest prior art for the purpose of objectively assessing inventive step was generally that which corresponded to a **similar use** requiring the minimum of structural and functional modifications (see **T 574/88**, **T 834/91**, **T 897/92**, **T 380/93**, **T 1040/93** and **T 795/93**). In **T 273/92** the board of appeal confirmed the established case law of the boards according to which a document could not qualify as the closest prior art to an invention merely because of similarity in the composition of the products; its suitability for the desired use of the invention also had to be described (see also **T 327/92**). According to **T 506/95**, the closest prior art was therefore that most suitable for the purpose claimed by the invention, not that superficially showing structural similarities with the solution as claimed. Ideally that purpose or objective should be something already mentioned in the prior art document as a goal worth achieving (**T 298/93**).The aim was that the assessment process should start from a situation as close as possible in reality to that encountered by the inventor. If it was not clear from this criterion what the closest prior art was, the problem and solution approach should be repeated taking possible alternative starting points (**T 710/97**).

In **T 176/89** the board concluded that the closest prior art was two documents in combination with each other. It found that **exceptionally** the two documents had to be read in conjunction; they had the same patentee, largely the same inventors, and clearly related to the same set of tests. As a rule, however, when assessing inventive step, two documents should not be combined if in the circumstances their teaching is clearly contradictory (see also **T 487/95**).

3.3 Similarity of technical problem

A document serving as the starting point for evaluating the inventive merits of an invention should relate to the same or a similar technical problem or, at least, to the same or a closely related technical field as the patent in suit (**T 989/93, T 1203/97, T 263/99**).

In **T 439/92** (dividing wall for a corner or circular shower) the board pointed out that although there was freedom in the choice of the starting point on which an objection of lack of inventive step was based, there were certain criteria that should be adhered to if the prior art chosen was to be the closest. One such criterion was the problem already stated in the patent. Clearly in many cases it was reasonable for there to be a link between this problem and the prior art chosen as being closest (**T 495/91, T 570/91**).

In **T 325/93** the application related to an epoxy resin dispersion which provided a cured resin with improved impact resistance. The board stated that the problem addressed by the application was neither derivable nor indeed recognisable from the disclosure of D2 relating to compositions having a low coefficient of friction and which, according to the department of first instance and the appellant, represented the closest prior art. As early as **T 686/91**, another board had observed that, when ascertaining the closest prior art, ex post facto considerations should be avoided. Thus a document not mentioning a technical problem which is at least related to that derivable from the patent specification does not normally qualify as the closest prior art for inventive step purposes, however many technical features it may have in common with the subject-matter of the patent concerned (see also **T 410/93**, **T 708/96** and **T 59/96**). In **T 644/97** the board concluded that a technical problem arising from a "closest prior art" disclosure which was irrelevant to the claimed subject-matter (in the sense that it did not mention a problem that was at least related to that derivable from the patent specification) had a form such that its solution could practically never be obvious, because any attempt by the skilled person to establish a chain of considerations leading in an obvious way to the claimed subject-matter was bound to fail. It followed that the respective claimed subject-matter was non-obvious in the light of such art (see also **T 792/97**).

3.4 Most promising springboard

T 254/86 (OJ 1989, 115) described the objectively closest prior art as the "most promising springboard" towards the invention which was available to the skilled person (see also **T 282/90, T 70/95, T 644/97**).

Where several cited documents all belonged to the same technical field as the claimed invention, the closest prior art was the one which on the filing date would most easily have enabled the skilled person to make the invention (**T 656/90**).

According to **T 870/96** when trying to evaluate a skilled person's capabilities and behaviour in the problem and solution approach, as closest prior art a "bridgehead" position should be selected, which said skilled person would have **realistically** taken under the "circumstances" of the claimed invention insofar as these circumstances can be retrieved in one item of the prior art. Consequently, among these "circumstances", aspects such as the designation of the subject matter of the invention, the formulation of the original problem and the intended use and the effects to be obtained should generally be given more weight than the maximum number of identical technical features (see also **T 66/97**).

3.5 Selection of most promising starting point

Some decisions (especially from mechanics board 3.2.4) explained how to ascertain the closest prior art which constituted the easiest route for the skilled man to arrive at the claimed solution or the most promising starting point for an obvious development leading to the claimed invention.

In **T 570/91** the board emphasised that although a person skilled in the art was completely free in choosing a starting point, he would of course be bound afterwards by that choice. If, for instance, the skilled person preferred and decided to start from a specific compressor piston, he could further develop that piston but at the end of that development the normal result would still be a compressor piston and not an internal combustion engine piston. In **T 439/92** it was explained that a conscious choice of starting point, made in the knowledge of the respective benefits and drawbacks of the various types concerned, not only determined the subject-matter serving as a starting point but also defined the framework for further development, ie a further development within this particular type. A change of type during the further development of the consciously chosen type, to another type, which was previously known but had not been chosen, could then only be seen as the result of an ex-post-facto analysis (see also **T 1040/93**, **T 35/95, T 739/95**). It is unlikely, and normally not obvious, for the invention type originally chosen to be changed during development (**T 817/94**). A generically different document cannot normally be considered as a realistic starting point for the assessment of inventive step**, T 870/96** (see also **T 1105/92**, **T 464/98**).

In **T 487/95** it was clear from the description of the contested patent and of the original application that the invention was the result of further development of a military protective helmet. In its assessment of inventive step the board therefore chose a military protective helmet as the closest prior art, pointing out however that this did not mean that documents describing protective helmets of a different kind (such as workers' safety helmets) could not be said to form part of the knowledge of a person skilled in the art. In this case, adopting the problem and solution approach, the information contained in the patent which related to a known military protective helmet (D9) represented the **primary** source of information, ie the most promising point of departure, from which the skilled person would attempt to arrive at the claimed subject-matter. The other documents could however represent important **secondary** sources of information (in this case workers' safety helmets) from which the skilled practitioner could obtain indications and suggestions with regard to the problem being addressed.

However, when applying these principles, care must be taken to avoid an ex-post-facto-approach. A skilled person endeavouring to arrive at a simple construction is unlikely to begin by using prior art relating to an exceptional embodiment with a complex mechanism, and then to omit this mechanism from the invention (**T 871/94**).

3.6 Improvement of a production process for a known product

Where the invention concerned improving a process to manufacture a known chemical compound, then the closest prior art was confined to documents describing that compound and its manufacture. Comparison with these alone would show whether an improvement had been achieved which could thus be taken into account in formulating the problem the invention sought to solve (**T 641/89**, **T 961/96, T 713/97**). This accurately and objectively reflects the actual situation in which the skilled person found himself on the priority date of the contested patent (**T 793/97**).

The above considerations regarding the closest prior art also apply to production processes for subject-matter other than a chemical compound. In **T 325/97** the patent related to a method for manufacturing a device for controlled delivery of nicotine from an adhesive reservoir. Also in **T 373/94** the board applied the principles and conclusions laid down in **T 641/89** where the invention related to the improvement of a manufacturing process for prefilled plastic syringes.

3.7 Old prior art documents as closest prior art

Some decisions concerned determining the closest art by taking old prior publications as a realistic starting point for identifying the technical problem to be solved.

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

In **T 1000/92** the board referred to its case law, according to which a document should be considered as the closest state of the art only if a skilled person would have had good reason to select its content as a basis for further development. In the board's judgment the selection of document (1) as the closest state of the art did not meet this criterion because the disadvantages of the process described in document (1), which had been published about 30 years before the priority date of the application, were so evident and well known that a skilled person would not have tried to improve and develop such an old process (see also **T 616/93**).

In **T 153/97** it was stated that there was no plausible reason why the skilled person should have disregarded a document only because the publication date lay 30 years in the past. The situation in **T 1000/92** was quite different, since well-known disadvantages of the prior art would have deterred the skilled person from taking this starting point.

T 69/94 also pointed out that Art. 54(2) EPC defined the state of the art as comprising everything made available to the public, clearly without any time restriction. Thus a document which related to an antiquated technology no longer used in industry comprising a teaching disapproved by those skilled in the art at the filing date of the patent in suit could not simply be disregarded as closest prior art only because of its publication date about 20 years before the filing date of the application documents.

4. Technical problem

4.1 Determination of the technical problem

R. 27(1)(c) EPC stipulates that an application's description must "disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effect of the invention with reference to the background art". As long ago as **T 26/81** (OJ 1982, 211), R. 27(1)(c) EPC was recognised as clearly binding. The boards' case law, and correct application of the problem and solution approach (see **T 1/80** (OJ 1981, 206) and **T 24/81** (OJ 1983, 133)), show that objective criteria must be used to determine the technical problem, ie the problem which can be seen to have been actually solved in the light of the closest prior art which may be different from the prior art which was at the disposal of the inventor (**T 576/95**). These objective criteria may be concretely defined by assessing the technical progress made in the subject-matter of the application against the closest prior art (**T 20/81,** OJ 1982, 217, **T 910/90**). A comparison of the problem indicated in the application with that indicated in a prior document must avoid an unduly abstract approach far removed from the practical thinking of the person skilled in the art (**T 5/81**, OJ 1982, 249).

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

In **T 931/95** (OJ 2001, 441), the board denied the presence of an inventive step since the objective problem was not of a technical character. The board stated that the improvement envisaged by the invention according to the application was an essentially economic one i.e. lay in the field of economics, which, therefore could not contribute to inventive step (see also **T 1053/98**).

4.2 Ex-post-facto analysis - no pointers to the solution

According to decisions **T 229/85** (OJ 1987, 237) and **T 99/85** (OJ 1987, 413) the technical problem addressed by an invention had to be formulated in such a way that it did **not contain pointers to the solution** or partially anticipate the solution, since including part of a solution offered by an invention in the statement of the problem necessarily had to result in an ex post facto view being taken of inventive step when the state of the art was assessed in terms of that problem (**T 322/86**, **T 184/89**, **T 289/91** (OJ 1994, 649), **T 957/92**, **T 422/93** (OJ 1997, 24), **T 986/96**, and **T 313/97**). Decision **T 910/90** added that this did not mean that determination of the inventive step could be based on a very general problem unrelated to the invention. Instead, when assessing the objective problem, the closest prior art and any technical advance achieved by the characterising features of the invention had to be taken into account. In so doing, it was not important whether this problem had already been mentioned in the closest prior art; what mattered was what the skilled person objectively recognised as the problem when comparing the closest prior art with the invention.

4.3 Problem formulated in the contested patent

Furthermore it had to be considered that an objective definition of the problem to be solved by the invention should normally **start from** the problem described in the contested patent. Only if examination showed that the problem disclosed had not been solved or if inappropriate prior art were used to define the problem, was it necessary to investigate which other problem objectively existed. The definition of **artificial** and **technically unrealistic problems** was to be avoided (see **T 246/91**, **T 495/91**, **T 731/91**, **T 741/91**, **T 334/92, T 881/92**, **T 380/93**, **T 813/93** and **T 68/95, T 644/97, T 747/97**). This legal principle is also applicable to ex parte proceedings (**T 881/92**, **T 882/92** and **T 884/92**). In **T 419/93** it was added that, when determining the problem, the statements relating thereto in the application should be examined for correctness with regard to the prior art and for their de facto relevance to the claimed features of the solution. Only if the problem described in the application did not meet prior art requirements and/or was not solved in accordance with the features of the invention, should it be adapted to the prior art and/or actual technical success. In this connection, **T 800/91** emphasised that in any event the formulated problem should be one which the skilled person knowing only the prior art would wish to solve. It should not be tendentiously formulated in a way that unfairly directed development towards the claimed solution.

4.4 Alleged advantages

According to the boards' case law, alleged advantages to which the patent proprietor/ applicant merely refers, without offering sufficient evidence to support the comparison with the closest prior art, cannot be taken into consideration in determining the problem underlying the invention and therefore in assessing inventive step (see **T 20/81**(OJ 1982, 217), **T 181/82** (OJ 1984, 401), **T 124/84**, **T 152/93**, **T 912/94, T 284/96, T 325/97, T 1051/97**).

In **T 355/97** the patent related to an improved hydrogenation process for preparing 4-aminophenol. The technical problem as indicated in the patent in suit consisted in improving the performance index of the preparation process without loss of selectivity. The patent proprietor, however, did not demonstrate properly that the purported advantages , ie improvement of the performance index without loss of selectivety, of the claimed invention have successfully been achieved. The Board referred to the above mentioned jurisprudence and held that since the alleged advantages lacked the required adequate support, the technical problem needed reformulation. Therefore, the objective problem could only be seen in providing merely a further method for preparing 4-aminophenol.

4.5 Reformulation of the problem

It is established case law that an applicant or patentee may restate the specific problem set out in the description if in particular the objective assessment of inventive step draws on newly introduced prior art which is closer to the invention than that cited in the original application or granted patent. In **T 184/82** (OJ 1984, 261) the board said that "regarding the effect of the invention" reformulation of the problem could be allowed "provided the skilled man could recognise the same as implied or related to the problem initially suggested". The problem may thus be restated to meet a less ambitious objective (see also **T 106/91**). It was also ruled in **T 13/84** (OJ 1986, 253) that a reformulation of the problem was not precluded by Art. 123(2) EPC if the problem could be deduced by the skilled person from the application as filed when considered in the light of the closest prior art (**T 469/90**, **T 530/90, T 547/90**, **T 375/93, T 687/94**). In **T 818/93** the board added that it sufficed if the reformulated problem could be deduced later by comparing the application with the closest art. Since features from the drawings might be incorporated into the claims, and also into the description in support of the claims (**T 169/83**, OJ 1985, 193), those features' effects and advantages might also be used as a basis for reformulating the problem, provided this problem could be clearly deduced from the above comparison. **T 162/86** (OJ 1988, 452) added that it should still be possible in appeal proceedings to define the original problem more precisely, within the limits of the original description. According to **T 339/96** a reformulation of the technical problem solved by the invention is permissible to take account of prior art which becomes known to the applicant after filing the patent application, when the reformulated problem represents a less ambitious goal which was also foreseen - at least implicitly - in the original disclosure.

According to **T 39/93** (OJ 1997, 134), the technical problem as originally presented in the application or patent in suit, which was to be regarded as the "subjective" technical problem, might require reformulation on the basis of objectively more relevant elements originally not taken into account by the applicant or patentee. This reformulation defined the "objective" technical problem. The latter represented the problem ultimately remaining, ie the technical effect achieved by the subject-matter (features) as defined in the claim.

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

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

In **T 440/91** the board pointed out that R. 27 EPC did not rule out the possibility of additional advantages - not themselves mentioned in the application as filed but relating to a mentioned field of use - being furnished subsequently in support of patentability for the purposes of Art. 52(1) EPC, as such advantages did not alter the character of the invention. Thus, the character of the invention was not altered if the technical problem specified in the application as filed was supplemented by such advantages, since the skilled person might consider them on account of their close technical relationship to the original problem (see also **T 1062/93**). The board made a distinction with regard to the situation in **T 386/89** and **T 344/89**, where there was no such technical relationship. In **T 386/89** the board had found that the solution to the technical problem derivable from the application as filed was in no way associated with a technical effect subsequently invoked. This additional effect had thus not been taken into consideration. The alleged effect of a described feature could not be taken into account when determining the problem underlying the invention for the purpose of assessing inventive step, if it could not be deduced by the skilled person from the application as filed considered in relation to the closest prior art. Similarly in **T 344/89**, the board had refused to take account of a subsequently invoked technical effect on the grounds that to do so would have altered the character of the invention.

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

4.6 Alternative solution to a known problem

In **T 92/92** the board noted that Art. 56 EPC did not require that the problem to be solved should be novel in itself. The fact that the underlying problem of the patent had already been solved by the prior art does not necessarily require redefinition of the problem for the assessment of inventive step, if the subject-matter of the patent represented an **alternative** solution to this problem. In this context the board referred in particular to decision **T 495/91**. In this case too, the problem stated in the patent specification had already been solved. The problem to be objectively solved was the provision of an **alternative** process and of apparatus which made it possible to produce a floor covering with specific properties by simple and low-cost means (see also **T 780/94, T 1074/93**).

According to **T 588/93**, for an inventive step to be present, it was not necessary to show improvement - substantial or gradual - over the prior art. Thus an earlier solution to a given technical problem did not preclude later attempts to solve the same problem in another, non-obvious way.

5. Skilled person

5.1 Definition of the skilled person - team of experts

5.1.1 Definition

According to the boards' case law, **the person skilled in the art** should be presumed to be an **ordinary practitioner** aware of what was common general knowledge in the art at the relevant date (average skilled person). He should also be presumed to have had access to everything in the **state of the art**, in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation (Guidelines, C-IV, 9.6). **T 39/93** (OJ 1997, 134) explained that whilst generally accepted definitions of the notional "person skilled in the art" did not always use identical language to define the qualities of such a person, they had one thing in common, namely that none of them suggested he was possessed of any inventive capability. It was the presence of such capability in the inventor which set him apart from the notional skilled person.

Regarding the role of the skilled person, the board gave the following ruling in **T 32/81** (OJ 1982, 225): "If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability" (**T 141/87**, **T 604/89**, **T 321/92**).

According to **T 422/93** (OJ 1997, 25), when examining for inventive step using the "problem and solution approach", the starting point for defining the appropriate skilled person was the technical problem to be solved on the basis of what the prior art disclosed, irrespective of any other definition of the skilled person suggested in the contested patent. Since the technical problem addressed by an invention had to be so formulated as not to anticipate the solution, the skilled person to be considered could not be the appropriate expert in the technical field to which the proposed solution belonged if this technical field was the one considered when formulating the technical problem. Nor did the appropriate skilled person's basic knowledge include that of a specialist in the different technical field to which the proposed solution belonged if the closest prior art gave no indication that the solution was to be sought in this other technical field.

5.1.2 Group of people as "skilled person"

Sometimes the "skilled person" may be a group of people, such as a research or production team. For the purposes of Art. 56 EPC the person skilled in the art is normally not assumed to be aware of patent or technical literature in a remote technical field. In appropriate circumstances, however, the knowledge of a team consisting of persons having different areas of expertise can be taken into account (**T 141/87, T 99/89**). This would be the case in particular if an expert in one particular field was appropriate for solving one part of the problem, while for another part one would need to look to another expert in a different area (**T 986/96**).

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

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

Further comments on the concept of the "team of experts" are to be found in the following decisions: **T 57/86**, **T 222/86** (in advanced laser technology, the "skilled person" as a production team of three experts in physics, electronics and chemistry respectively), **T 141/87, T 460/87**, **T 295/88**, **T 825/93**, **T 2/94, T 402/95** and **T 986/96** (team consisting of a first expert in the field of mail processing and a second expert acquainted with information in the field of weighing).

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

The person skilled in the art in the field of biotechnology is well defined by the case law of the boards of appeal. His attitude is considered to be conservative. He would never go against an established prejudice, nor try to enter unpredictable areas nor take incalculable risks. The notional skilled person would perform a transfer of technology from a neighbouring field to his specific field of interest, if this transfer involved routine experimental work comprising only routine trials (**T 455/91** (OJ 1995, 684), **T 500/91**, **T 387/94**, **T 441/93**).

In **T 60/89** (OJ 1992, 268) the board took the view that the skilled person in genetic engineering in 1978 could not be defined as a Nobel prize winner, even if a number of scientists working in this field at that time actually were awarded that prize. Rather he should be assumed to be a scientist (or team of scientists) working as a teacher or researcher in the laboratories which made the transition from molecular genetics to genetic engineering at that time.

This case law was confirmed in the "Biogen II" decision (**T 500/91**). The board ruled that the average skilled person - who might also be a team of specialists in the relevant field - operated at a practical level, and the technical development which might normally be expected of him did not include solving technical problems through scientific research.

From the notional skilled person nothing more can be expected than the carrying out of experimental work by routine means within the framework of the normal practice of filling gaps in knowledge by the application of existing knowledge (**T 886/91**, **T 223/92**, **T 530/95**, **T 791/96**).

It had to be assumed that the average skilled person would not engage in creative thinking (**T 500/91**). Yet he or she could be expected to react in a way common to all skilled persons at any time, namely that an assumption or hypothesis about a possible obstacle to the successful realisation of a project must always be based on facts. Thus, in the board's view, an absence of evidence that a given feature might be an obstacle to carrying out an invention would not be taken as an indication that this invention could not be achieved, nor that it could (**T 207/94**, OJ 1999, 273).

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

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

In **T 455/91** (OJ 1995, 684) the board set out considerations on the skilled person's likely attitude to possible changes, modifications or adjustments in known products (eg a plasmid) or procedures (eg an experimental protocol). Its aim was to answer, objectively and avoiding any ex post facto analysis, the question whether it would be obvious to the skilled person to make given changes in a structure or procedure. The skilled person in this field was well aware that even a small structural change in a product (eg a vector, protein, or DNA sequence) or procedure (eg a purification process) could produce dramatic functional changes. He would therefore adopt a conservative attitude. For example, he would neither go against an established prejudice, nor venture into "sacrosanct" or unpredictable areas, nor take incalculable risks. However, within the normal design procedures, he would readily seek appropriate, manifest changes, modifications or adjustments involving little trouble or work and no or only calculable risks, especially to obtain a handier or more convenient product or simplify a procedure. In particular, the skilled person working in one field (eg expression in yeast) would regard a means conveniently adopted in a neighbouring field (eg the bacterial art) as readily usable also in his own field, if this transfer of knowledge involved nothing out of the ordinary.

If on the other hand he would expect to have to perform scientific research rather than routine work in order to transfer a technology previously set up in one field of research (method of transforming Saccharomyces cerevisiae whole cells) to a neighbouring field (method of transforming Kluyveromyces whole cells), then inventive step could be acknowledged (**T 441/93**).

5.2 Neighbouring field

Two landmark decisions, **T 176/84** (OJ 1986, 50) and **T 195/84** (OJ 1986, 121) addressed in detail the problem of the relevant technical field, ie the question of the extent to which neighbouring areas beyond the specific field of the application might be taken into consideration when assessing inventive step. According to **T 176/84**, when examining for inventive step, a skilled person would, as well as considering the state of the art in the specific technical field of the application, look for suggestions in neighbouring fields or a broader general technical field if the same or similar problems arose, and if he could be expected to be aware of such general fields. **T 195/84** added that the state of the art also had to include prior art in a non-specific (general) field dealing with the solution of any general technical problem which the application solved in its specific field. Such solutions of general technical problems in non-specific (general) fields had to be viewed as forming part of the general technical knowledge which a priori was to be attributed to those skilled persons versed in any specific technical field. These principles were applied in a large number of decisions.

In **T 560/89** (OJ 1992, 725) the board took the view that the skilled person would also draw on prior art in other fields which were neither neighbouring nor broader general fields, if prompted to do so because the materials used were related or because of public debate about a technical problem common to both fields. Expanding on this, **T 955/90** added that in practice the person skilled in a broader general field would also draw on the narrower, more specialised field of the known main application of the general technology in search of a solution to a problem lying outside the special application of that technology (**T 379/96**).

According to **T 454/87** a skilled person specialising in a particular technical field (gas chromatography equipment) would in the course of his normal professional activity also observe developments in equipment used in a related technical field (absorption spectral analysis).

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

In **T 767/89**, regarding carpets, the board ruled that wigs were neither a neighbouring technical field nor a broader general one which included the former field. So wigs were not a related technical field in which the person skilled in carpets would have been prompted to seek solutions. The two inventions addressed different problems; the user requirements were not comparable.

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

Further comments on the concept of relevant field are to be found in several other decisions, including the following: **T 277/90** (in dentistry, moulding technology and prosthodontics are neighbouring technical fields); **T 358/90** (discharging the content of a portable toilet did not lead the skilled person to the field of filling a tank of a chain saw by means of a special kind of container); **T 1037/92** (a person skilled in the art of making fuse links for programmable ROMs would also have consulted the documentation in the field of ultraminiaturised integrated switches), **T 838/95** (the pharmaceutical and cosmetic fields were immediate neighbours), **T 365/87**, **T 443/90**, **T 47/91**, **T 244/91** and **T 189/92**.

On a different aspect, with regard to the applicant's reference to a remote state of the art, the board gave the following ruling in **T 28/87** (OJ 1989, 383, headnote): "If reference is made in the introduction to the description of an application or a patent to a state of the art which cannot objectively be classified as a relevant field, that state of the art cannot in the course of examination for patentability be rated to the applicant's or proprietor's disadvantage as a neighbouring field merely on account of that reference". The document to which the proprietor of the patent had himself referred in the introduction to the description was therefore not taken into account in the assessment of inventive step.

5.3 Skilled person - level of knowledge

The same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step have to be considered (**T 60/89**, OJ 1992, 268, **T 373/94**). **T 694/92** (OJ 1997, 408) added that although the same level of skill is applied for both Art. 56 and 83 EPC, the two starting points differ: for inventive step purposes, the skilled man knows only the prior art; for sufficiency of disclosure, he knows the prior art **and** the disclosed invention (see also p. 145).

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

In **T 766/91** the board summarised the normally accepted view that common general knowledge was represented by basic handbooks and textbooks on the subject in question. It was knowledge that an experienced person in this field was expected to have, or at least to be aware of to the extent that he knew he could look it up in a handbook if he needed it. Statements in such works were used as convenient references to show what was common knowledge. The information as such did not as a rule become such knowledge through publication in a given handbook or textbook; rather, by the time it appeared in such works it was already generally known. For this reason, publication in an encyclopaedia, say, could normally be taken as proof that the information was not only known but was common general knowledge. The assertion that something was part of the common general knowledge therefore needed only to be substantiated if challenged by another party or the EPO (**T 234/93**, **T 590/94**, **T 671/94, T 438/97**).

In **T 378/93** the board confirmed this case law, adding that the same applied to articles in scientific periodicals addressed primarily to qualified professionals and enjoying worldwide repute.

In **T 939/92** (OJ 1996, 309) it was explained that the state of the art could also perfectly well reside solely in the relevant common general knowledge, which, in turn, need not necessarily be in writing, ie in textbooks or the like, but might simply be a part of the unwritten "mental furniture" of the average skilled person. In the case of any dispute, however, the extent of the relevant common general knowledge had to be proven, eg by documentary or oral evidence.

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

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

5.4 Everyday items from a different technical field

In **T 1043/98** the patent concerned an inflatable gas-bag for a vehicle restraint system, one part being club-shaped and the other generally butterfly-shaped. The edges of the two parts were sewn together along a continuous seam. According to the appellant, the skilled person would immediately arrive at the claimed gas-bag from his knowledge of tennis-ball or baseball construction. This raised the issue of the application of features or solutions drawn from another technical field but which could be considered "everyday items".

In **T 397/87** the board had already pointed out that there was no obvious reason why a skilled person trying to solve a non-trivial problem should have been led to the claimed process by simple examples from everyday life which were unrelated to the problem in question. In **T 349/96**, too, the board was unable to see why the fact that different transport containers are used for beer bottles in an everyday context should prompt a skilled person to invent a spinning/winding machine combination with an integrated transport system even if the many citations from the relevant technical field were unable to do this (see also **T 234/91**).

In **T 234/96,** however, the board concurred with the examining division's view that the skilled person dealing with the practicalities of motorising a dispenser drawer for washing powder had in mind as a model the disc tray of a CD player with push-button electromotor operation which at the time of filing the application was familiar to anyone and which therefore suggested the subject-matter of claim 1. In the board's view, the fact that washing machines and CD players were intrinsically different items serving different purposes did not suffice to prevent the skilled person concerned with the construction of washing machines from taking into consideration the basic principle of automatic tray operation in CD players when designing a dispenser drawer for washing powder.

From a comparison of the above-mentioned decisions, the board in **T 1043/98** concluded that the relevance of such items for inventive step depended very much on the circumstances of the individual case. It agreed that persons skilled in developing the gas-bags in question would include tennis or baseball players. It could not however share the appellant's view that to solve the problem addressed by the invention the skilled person would draw on what he might know about tennis-ball or baseball construction. The main reason was that the gas-bag was not intended to be spherical in shape. It was therefore unlikely that the skilled person would take as his starting point an object which was the epitome of a sphere (see **T 477/96**, where the board also concluded that everyday experience was not relevant to the technical field of the invention).

6. Proof of inventive step

6.1 "Could-would approach" and ex post facto analysis

Many decisions of the Boards of appeal warn against an ex post facto approach when assessing inventive step (see also the Guidelines, Chapter C-IV, 9.9). This applies especially to inventions which at first sight seem obvious, to combination inventions and where the proposed solution is supposedly "simple". Correct application of the problem and solution approach avoids this inadmissible ex post facto analysis which draws on knowledge of the invention (**T 24/81** (OJ 1983, 133), **T 564/89**, **T 645/92**, **T 795/93**).

When assessing inventive step, an interpretation of the prior art documents as influenced by the problem solved by the invention while the problem was neither mentioned or even suggested must be avoided, such an approach being merely the result of an a posteriori analysis (**T 5/81**, OJ 1982, 249, **T 63/97, T 170/97, T 414/98**).

It is the boards' established case law that the question is not whether the skilled person **could** have carried out the invention, but whether he **would have done** so in the hope of solving the underlying technical problem or in the expectation of some improvement or advantage ("could-would approach", **T 2/83** (OJ 1984, 265), **T 90/84**, **T 7/86** (OJ 1988, 381), **T 200/94** and **T 885/97**). So the point is not whether the skilled person could have arrived at the invention by modifying the prior art, but rather whether, in expectation of the advantages actually achieved (ie in the light of the technical problem addressed), he would have done so because of promptings in the prior art (**T 219/87**, **T 455/94, T 414/98**).

It has been held that once an invention existed, it could often be shown that the skilled person could have made it by combining different elements in the prior art, but such arguments had to be disregarded as the product of ex post facto analysis (**T 564/89).**

According to **T 939/92** (OJ 1996, 309), the answer to the question what a skilled person would have done depended in large measure on the technical result he had set out to achieve. In other words, the notional "person skilled in the art" was assumed to act not out of idle curiosity but rather with a specific technical purpose in mind.

Technical feasibility and the absence of obstacles were only necessary requirements for reproducibility but were not sufficient to render obvious **what was actually achievable** for the skilled person (**T 61/90**). The fact that the inherent properties of a technical means were known to the skilled person, so that he had the intellectual possibility to apply this means in a conventional device, merely established the **possibility** of using such technical means in such a manner, ie that the skilled person **could** have used it. However, if it was to be established that such intellectual possibility was also a technical measure which it was obvious for the skilled person to use, it was necessary to show that there was a recognisable pointer in the state of the art to combine the known means and conventional device for achieving the intended technical aim, ie that the skilled person **would** have made such a combination. The existence of such a technical reason was dependent on the known properties not only of the means but also of those of the device (**T 203/93** and **T 280/95**).

6.2 Expectation of success, especially in the field of genetic engineering and biotechnology

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

In some decisions in the field of genetic engineering the board asked whether in the cases in point it was obvious for the skilled person to try a suggested approach, route or method with a **reasonable expectation of success** (**T 60/89**, OJ 1992, 268). For more about biotechnological inventions and the definition of the skilled person, see page 111 et seq.

In **T 296/93** the board held that, in relation to inventive step, the fact that other persons or teams were working contemporaneously on the same project might suggest that it was "obvious to try" or that it was an interesting area to explore, but it did not necessarily imply that there was a "reasonable expectation of success". **A reasonable expectation of success should not be confused with the understandable "hope to succeed"**; it implied the ability of the skilled person to predict rationally, on the basis of the knowledge existing before a research project was started, the successful conclusion of the said project within acceptable time limits. The more unexplored a technical field of research was, the more difficult it was to make predictions about its successful conclusion and, consequently, the lower the expectation of success (**T 694/92**, OJ 1997, 408). According to **T 207/94** (OJ 1999, 273), the "hope to succeed" was merely the expression of a wish, whereas a "reasonable expectation of success" presupposed scientific appraisal of available facts.

In **T 187/93** it was stated that even if it was obvious for the skilled person to try an experiment, it was not necessarily true that this person would have any reasonable expectation of success when embarking on it.

In **T 223/92** the board said that in 1981, given the state of the art at that time, the skilled person would have opted for DNA-recombination technology only if relying, eg, on his own good luck and inventiveness to overcome the known (and as yet unknown) problems involved, which would have caused the average skilled person to expect to fail.

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

In **T 923/92** (OJ 1996, 564) the board had to decide whether the skilled person would have attempted, with reasonable expectation of success, to produce cDNA coding for human t-PA, or whether in this instance he would have known from his technical knowledge, before even embarking on the research, that he would be able to complete his project within acceptable time. The board bore in mind that, as stated in **T 816/90**, "even when it is possible to theoretically conceive a straightforward approach to solve a specific technical problem, the skilled person might be confronted with unexpected difficulties when trying to put the conceived strategy into practice". The board stated that, although hoping to succeed, the skilled person embarking on this project would have known that its successful conclusion depended not only on technical skill in putting into practice the sequence of precise steps of the theoretical experimental protocol, but to a large extent also on the ability to take the right decisions along the way whenever a difficult experimental situation so required. Under these circumstances, it could not be said that the skilled person had a reasonable expectation of success.

In **T 386/94** (OJ 1996, 658), again citing **T 816/90**, the board ruled that in gene technology inventive step could not be acknowledged if, at the priority date, a skilled person could expect to perform the cloning and expression of a gene in a fairly straightforward manner, and the cloning, although requiring much work, did not pose such problems as to prove that the expectation of success was ill-founded.

Where the expression of a cloned DNA in a chosen foreign host constituted the subject-matter of the claimed invention, the question whether a reasonable expectation of success existed or not could be evaluated only by taking into account real difficulties relating to that step. Thus, in order to be considered, any allegation that features jeopardised a reasonable expectation of success had to be based on technical facts (**T 207/94**, OJ 1999, 273).

In **T 737/96** the board was of the opinion that it was not appropriate to attempt to evaluate the expectation of success of a random technique such as mutagenesis where results depended on chance events. This was because the skilled person knew that, unless a specific selection method could be developed, which was not the case in the patent in suit, perseverance and chance played a key role in achieving success, as no form of control could be exerted over the mutation events. Under these circumstances, as in a lottery game, the expectation of success always ranged irrationally from nil to high, so it could not be evaluated in a rational manner based on technical facts. This was at variance with technical situations in which more predictable methods were relied upon to solve a particular problem, such as methods of genetic engineering like cloning or expressing a DNA sequence. In such situations, it was often possible to make rational predictions about the likelihood of success, and "reasonable expectation of success" was then a meaningful and reliable criterion for assessing inventive step (see also **T 694/92**, OJ 1997, 408).

Decisions **T 455/91**, **T 412/93, T 915/93, T 63/94** and **T 856/94** also consider this topic.

6.3 Technical disclosure in a prior art document

In line with the established case law of the boards of appeal, when investigating inventive step it should be borne in mind that the technical disclosure in a prior art document should be considered in its entirety, as it would be done by a person skilled in the art and that it is not justified arbitrarily to isolate parts of such document from their context in order to derive from them technical information which would be distinct from the integral teaching of the document (**T 56/87** (OJ 1990, 188), **T 768/90**, **T 223/94**, **T 115/96**, **T 717/96, T 414/98**, see also page 68 et seq.). According to **T 95/90**, **different parts of text in a document** can be combined if there is nothing to stop the skilled person from doing so.

6.4 Combination invention

6.4.1 Existence of a combination invention

In assessing the inventive step involved in an invention based on a combination of features, consideration must be given to whether or not the state of the art was such as to suggest to a skilled person precisely the combination of features claimed. The fact that an individual feature or a number of features were known does not conclusively show the obviousness of a combination (**T 37/85** (OJ 1988, 86), **T 656/93**, **T 666/93, T 1018/96**). The question is not whether the skilled person, with access to the entire prior art, **could** have made the combination according to the invention, but whether he actually **would** have done so in expectation of an improvement (**T 2/83** (OJ 1984, 265), **T 713/93, T 223/94, T 406/98**). When assessing inventive step in a combination invention the decisive criterion is not whether individual elements of the combination were known and obvious from prior art, but whether the state of the art would lead a skilled person to this particular overall combination of (possibly already known) features. Were this not so, it would be impossible for a combination consisting exclusively of known individual features to involve an inventive step (**T 388/89**, **T 717/90**, **T 869/96**).

A mere aggregation of features must be distinguished from a combination invention. The existence of a combination invention requires that the relationship between the features or groups of features be one of **functional reciprocity** or that they show a combinative effect beyond the sum of their individual effects (see also 6.4.2, Partial problems).

In **T 406/98** the board found that as a rule, particularly when large numbers of citations were involved, it was necessary to ask **why** the skilled person would consider documents in that specific combination, and whether, **not knowing the invention**, he had reason to do so. In this case, a complete solution to the problem required deliberate selection from a large number of citations.

In **T 55/93** the appellant's argument, according to which the alleged invention should have been regarded as a mere aggregation of solutions of two independent partial problems which were not interrelated, was not accepted by the board. In the case in point, not only could the primary problem underlying the contested patent neither be found nor be derived from the prior art documents, but also the claimed features complemented each other. The board stated that the features were functionally linked together, which was the actual characteristic of a combination invention. It was wrong to select, on the basis of a plurality of partial problems to be solved, the respective constructional means used in the apparatus combination, or the steps of the method worded in terms of functional features, which by working together provided a solution to the problem taken as a whole. The non-obviousness of a combination claim turned on the simultaneous application of all its features (**T 175/84**, OJ 1989, 71). A combination effect was also acknowledged in **T 120/88, T 731/94, T 434/95** and **T 897/95**.

6.4.2 Partial problems

In patent law terms, the existence of a combination of features, ie of a combination invention, is to be viewed differently from the mere existence of partial problems, ie of an aggregation of features. According to current case law, partial problems exist if the features or sets of features of a claim are a mere aggregation of these features or sets of features which are not functionally interdependent, ie do not **mutually influence each other** to achieve a technical success over and above the sum of their respective individual effects, in contrast to what is assumed in the case of a combination of features (**T 389/86** (OJ 1988, 87), **T 387/87**, **T 294/90, T 363/94**). Also to be borne in mind is that solutions to partial problems in differing technical fields must be assessed on the basis of the knowledge and expertise of the person skilled in the art where the solution is found (**T 32/81** (OJ 1982, 225) and **T 324/94**).

In **T 389/86** (OJ 1988, 87) the relationship between the two groups of features was not one of functional reciprocity. The board ruled that in such circumstances no combinative effect could be advanced in support of inventive step; rather the question was whether each group, taken singly, was obviously derivable from the prior art. For the subject-matter of the claim to be inventive, it sufficed if one of these groups was (**T 345/90**, **T 701/91).**

Also in **T 130/89** (OJ 1991, 514) the technical problem intended to be solved by the claimed invention consisted of two technically independent partial problems, each solved independently by one of the claimed subject-matter's features. The board held that the independence of the claimed subject-matter's features (each producing a different effect) meant that in assessing inventive step two closest states of the art had to be considered to enable each of the two partial problems to be defined. It concluded that since each of the partial problems was solved by means which merely performed their known functions, each partial solution was obvious and the invention thus lacked inventiveness. In **T 597/93** the board again saw no inventive step in combining the claim's two features - both known per se - since they related to the solving of two entirely separate partial problems. It cited **T 687/94** which held that in such cases the solutions could be assessed separately against the prior art (see also **T 315/88** and **T 65/90**).

In **T 711/96** the board found that characterising features (a) and (b) functioned completely independently of each other; there was no functional interplay (combination) between them. Although the setting for one value (eg spread) could indirectly affect that for the other (eg quantity), in that spread and quantity could both be adjusted upwards to maintain constant distribution, the two features were not directly related. In other words, the characterising features did not necessarily influence each other, although they could do. The board therefore assessed the inventive step of the two features separately, and concluded that both partial problems were obvious.

In **T 410/91** the board of appeal stated that no inventive step was involved since, although all the measures in claim 1 contributed to an increase in the efficiency of the plant, that contribution was based on known, different individual effects which resulted in these measures being executed in a manner expected by the skilled person. The subject-matter of claim 1 therefore involved the stringing-together of known measures which displayed their characteristic effects; no synergistic effect based on a combination of the individual measures was discernible in the sense of a mutual influence on their respective operation (see also **T 144/85**, **T 141/87**, **T 407/91**).

6.5 Features not contributing to the solution of the problem

According to the established case law of the boards of appeal, features which do not contribute to the solution of the problem set in the description are not to be considered in assessing the inventive step of a combination of features (**T 37/82**, OJ 1984, 71). According to this decision, in assessing the inventive step of a combination of features, consideration had to be given to a feature only if the applicant had provided evidence that it contributed, either independently or in conjunction with one or more of the other features, to the solution of the problem set in the description (see also **T 65/87**, **T 144/90, T 206/91**, **T 574/92**, **T 226/94**, **T 912/94** and **T 15/97**). Therefore, only those claimed features are to be considered which contribute causally to the solution of the problem (**T 285/91**). In **T 294/89** the board stated that the additional feature provided no surprising advantage and did not make any contribution to solving the problem indicated. Hence, the said additional feature was not relevant for assessing the inventive step of the combination of features claimed.

In **T 589/95** the terms of the solution of the technical problem extended into an area of use where it had been admitted that the relevant problem was known not to arise in practice. The board stated that, for such an area, the features of the solution did not contribute to the solution of the technical problem and could not be taken into account in the assessment of inventive step.

6.6 Foreseeable disadvantageous or technically non-functional modifications

In some decisions the subject-matter was found not to involve an inventive step, when the invention was the result of a foreseeable disadvantageous modification of the closest prior art (**T 119/82** (OJ 1984, 217), **T 155/85** (OJ 1988, 87), **T 939/92** (OJ 1996, 309), **T 72/95**).

The board in **T 119/82** (OJ 1984, 217) had already found that disadvantageous modifications did not involve an inventive step if the skilled person could clearly predict these disadvantages, if his assessment was correct and if these predictable disadvantages were not compensated by any unexpected technical advantage.

With reference to **T 119/82,** Board 3.3.5 in **T 72/95, T 157/97, T 176/97** and **T 158/97** held that similar considerations applied to technically non-functional modifications. An inventive step could not be claimed on the basis of a non-functional modification of a known device. If a known device was modified by adding a feature which had no technical function, this modification could not be inventive. However, the board was obliged to assess the existence of a technical function alleged to be relevant to inventive step. The board was aware of **T 1027/93,** in which another board had observed (obiter) that the EPC does not require that an invention, to be patentable, must entail any useful effect, and that the apparent futility of a given modus operandi could rather be said to render it completely non-obvious. The board emphasised that the concept of "invention" implied a technical character. Technically non-functional modifications were therefore irrelevant to inventive step, even if the skilled person would never think of such a modification. A parallel could be drawn here with a new design based on a known technical concept. The new design might be a surprise and thus "not obvious" for professional designers. Nevertheless if the modifications had no technical relevance and were, from a technical point of view, arbitrary, the new design was not patentable and did not involve an inventive step.

6.7 Substitution of materials - analogous use

According to **T 21/81** (OJ 1983, 15), a skilled person's selecting from the materials known to him as suitable for a certain purpose the one which was the most appropriate had to be regarded as forming part of his normal activities. The skilled person should therefore be at liberty, within the constraints of standard technical progress, to use alternative means known by him to have the same effect (**T 324/94**). In **T 410/92** the board also held that using higher-quality materials in the design of single-phase synchronous motors with a double-pole permanent-magnet rotor was obvious. The appellants had argued that the skilled person using the superior materials available to him would be confronted with baffling starting problems. The board however concluded that the skilled person's encountering known problems when using newly developed materials would not deter him from using them in order to achieve specific, desired improvements, particularly since the means of overcoming such problems could be derived from the prior art.

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

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

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

6.8 Combination of documents

It would not be obvious to a skilled person to combine an isolated, very old document (ie 50 year old document), which had not given rise to a trend in the art and whose teaching ran counter to the present trend, with the document reflecting the closest state of the art (**T 261/87**, **T 366/89**, **T 404/90**).

In **T 745/92** the board pointed out that the disclosure of two prior documents - even if they were classified under the same IPC classification - could only be combined so as to result in a finding of lack of inventive step if such combination would have been obvious to a skilled person seeking to solve the problem underlying the claimed invention (**T 104/95**).

In **T 552/89** the board confirmed that, when assessing inventive step, it was not permissible to combine the teachings of different documents within the state of the art in order to establish the obviousness of a claimed invention, unless it would have been obvious for the skilled person to do so at the time of filing. When a problem defined by reference to the closest prior art as disclosed in a primary document consisted of individual problems, board of appeal case law stated that the skilled person could be expected to take account of solutions to the individual problems proposed in different secondary documents in the same or neighbouring technical fields. Thus, the teachings of secondary documents might be combined with the disclosure of the closest prior art if such secondary documents provided solutions to specific individual problems forming part of the objective problem in progressing from the closest prior art, in particular when such individual solutions were merely aggregated together in the claimed invention.

6.9 Chemical inventions

6.9.1 Structural similarity

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

In **T 643/96** the board held that the concept of bioisosterism did form part of the common general knowledge of those skilled in the art, but that it had to be applied with caution when deciding upon inventive step. In the field of drug design, any structural modification of a pharmacologically active compound was, in the absence of an **established** correlation between structural features and activity, expected a priori to disturb the pharmacological activity profile of the initial structure. This also held true for an alleged case of bioisosterism, which was one option of a structure-activity relationship, as long as it was not an **established case** of bioisosterism (see also **T 548/91**). In **T 643/96** it was held that, "When deciding upon inventive step in relation to pharmacologically active compounds, what was essential was not whether a particular substructure of a chemical compound was replaced by another known isosteric one, but whether information was available on the impact of such a replacement on the pharmacological activity profile of the specific (group of) compound(s) concerned" (see also **T 467/94, T 156/95**).

In **T 930/94** the board held that knowledge of the fact that one specific member of a class of chemical compounds did not lead to the effect achieved by several other members of this class, did not, without additional indications, mean that such an effect could be attributed to all the compounds in this group. In such circumstances, the effect in point did not lead to a recognition of the existence of a technical concept that could be generalised.

In **T 989/93** the board stated that, in the absence of the appropriate common general knowledge, no conclusions are possible on the basis of the known properties of one group of chemical compounds (here: benzene derivatives) regarding the properties of a different group of chemical compounds (here: naphthalene derivatives).

6.9.2 Broad claims

Art. 56 EPC requires the claimed invention, ie the proposed technical solution for a given technical problem, not to be obvious to a skilled person from the state of the art. If the inventive step of a claimed invention is based on a given technical effect, the latter should, in principle, be achievable over the whole area claimed (**T 939/92** (OJ 1996, 309), **T 694/92** (OJ 1997, 408) and **T 583/93** (OJ 1996, 496)).

T 939/92 (OJ 1996, 309) contained fundamental rulings on broad claims in the field of chemistry. The board held that in view of the state of the art the technical problem which the patent in suit addressed was provision of further chemical compounds with herbicidal activity. It was necessary for all the claimed compounds to possess this activity. The question as to whether or not such a technical effect was achieved by all the chemical compounds covered by such a claim might properly arise under Art. 56 EPC was posed, if this technical effect turned out to be the sole reason for the alleged inventiveness of these compounds. The appellants' submission that the test results contained in the description showed that **some** of the claimed compounds were indeed herbicidally active could not be regarded as sufficient evidence to lead to the inference that substantially **all** the claimed compounds possessed this activity. In such a case the burden of proof rested with the appellants. The requirements of Art. 56 EPC had not therefore been met.

The board, following **T 939/92** (OJ 1996, 309), stated in **T 668/94** that the technical problem could only be taken into account in the assessment of inventive step if it could be accepted as having been successfully solved, ie if it were credible that substantially all claimed compounds possessed the plant growth regulating activity. When only some and not substantially all claimed compounds exhibited a particular technical effect, the conclusion had to be that the invention as broadly defined in the independent claim was not a solution to the technical problem of achieving the given technical effect, with the consequence that the alleged technical effect of some of the claimed compounds was to be disregarded when determining the objective problem underlying the invention and thus when assessing inventive step.

6.9.3 Intermediate products

In key decision **T 22/82** (OJ 1982, 341) the board ruled that the preparation of new intermediates for a surprisingly advantageous complete process for the preparation of known and desired end products was inventive.

Again in **T 163/84** (OJ 1987, 301) intermediate chemical products were held to be patentable on the grounds that their further processing to the known end products involved an inventive step. The board however held that a new chemical intermediate did not become inventive merely because it was prepared in the course of an inventive multi-stage process and was further processed to a known end product; there had to be other factors as well, such as that the process for preparing the new intermediate had enabled it to be prepared for the first time and had done so inventively and other methods of preparing it had appeared to be ruled out.

In **T 648/88** (OJ 1991, 292) the board disagreed with the view expressed in **T 163/84,** pursuing instead the line taken in **T 22/82**. An intermediate intended for the preparation of a known end product was deemed to be inventive if its preparation took place in connection with inventive preparation or inventive further processing or in the course of an inventive complete process.

In **T 65/82** (OJ 1983, 327) it was explained that new intermediates which take part in (non-inventive) analogy processes for sequent products (i.e. end products or intermediates of various kinds), must - in order to qualify as intermediates - provide a structural contribution to the subsequent products. Even where this condition is met, such intermediates are not thereby unconditionally inventive, i.e. not without taking the state of the art into consideration. As state of the art in relation to intermediates there are two different areas to be taken into account. One is the "close-to-the-intermediate" state of the art. These are all compounds identified from their chemical composition as lying close to the intermediates. On the other hand the "close-to-the-product" state of the art must also be taken into account, i.e. those compounds identified from their chemical composition as lying close to the subsequent products.

In **T 18/88** (OJ 1992, 107) the applicants had argued that the insecticidal activity of the known end products was significantly superior to that of another known insecticide with a similar structure; this was sufficient to establish an inventive step for the intermediate products, even if the end products were not novel and/or inventive. The board, referring to **T 65/82** (OJ 1983, 327), rejected the applicants' argument on the following grounds: claimed intermediates must themselves be based on an inventive step to be patentable. Whether, under certain circumstances, new and inventive subsequent products might support an inventive step of intermediates was not the question here, because the subsequent products in this case were either not novel or not inventive. The superior effect of subsequent products which were neither novel nor inventive was not sufficient to render the intermediates inventive.

6.10 Equivalents

According to established board of appeal case law, equivalents which are not disclosed in a published document must not be considered in assessing novelty as this properly belongs to the examination for inventive step (**T 167/84** (OJ 1987, 369), **T 446/88** and **T 517/90**, see also Guidelines C-IV, 7.2). In **T 697/92,** the board dealt with the concept of "equivalent means", according to which two means were equivalent if, despite having different embodiments, they fulfilled the same function with regard to the same result. Both means performed the same function if they shared the same basic idea, ie if they applied the same principle in the same way. The result was the totality of the technical effects produced by the means. In order to be considered as equivalents, the means had to achieve the same kind and quality of result. A means was thus not equivalent if, because of its different embodiment, it led to a result of the same kind but of a different quality or degree of effectiveness. The result did not necessarily even have to be better; it was sufficient for it to be different, since it was not the result itself which was patentable but the means by which it was achieved (see also **T 818/93**).

6.11 Problem inventions

The discovery of an unrecognised problem may in certain circumstances give rise to patentable subject-matter in spite of the fact that the claimed solution is retrospectively trivial and in itself obvious (see **T 2/83** (OJ 1984, 265) and **T 225/84**). The posing of a new problem did not represent a contribution to the inventive merits of the solution if it could have been posed by the average person skilled in the art (**T 109/82**, OJ 1984, 473). It also had to be taken into consideration that it was the normal task of the skilled person to be constantly occupied with the elimination of deficiencies, the overcoming of drawbacks and the achievement of improvements of known devices and/or products (see **T 15/81** (OJ 1982, 2) and **T 195/84** (OJ 1986, 121)). In **T 532/88** the board confirmed the established principle that to address a problem simply by looking for ways of overcoming difficulties arising in the course of routine work did not constitute inventiveness. Following this case law, the boards held in **T 630/92**, **T 798/92**, **T 578/92, T 610/95** and **T 805/97**, that the posing of the problem could not confer any inventive merit on the claimed subject-matter. Inventive step was however acknowledged in **T 135/94** und **T 540/93** (pet doors) on the ground (also) that the posing of the problem was not obvious.

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

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

6.12 New use of a known measure

When determining inventive step in the case of a new use of a known measure, the boards of appeal examine whether or not the problem which has been solved with a known measure in a known case differs from the problem posed in the case to be decided. If this examination reveals that there is no fundamental difference between the two problems, it can in principle be concluded that there is no inventive step if the known measure is adopted (see in particular **T 39/82** (OJ 1982, 419), **T 142/84** (OJ 1987, 112), **T 332/90**, **T 485/91, T 25/97**). In **T 39/82** (OJ 1982, 419) the board stated that it could not be considered obvious for the skilled person to use a known measure in a different context since the problems differed fundamentally from one another.

Referring to **T 39/82** (OJ 1982, 419) the board confirmed in **T 818/93** that in a **combination invention** all the features might be known per se - the invention resided in the way the features were interrelated, both structurally and functionally. In assessing the inventive step of the combination in question it was therefore of no consequence that a suitable structure was already known, provided its use and application in the conditions, and circumstances disclosed in the patent were not suggested by the cited prior art.

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

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

In **T 590/90** the respondents argued that both the measures taken that distinguished the technical teaching of the contested patent from that of document 1 were already part of the prior art, and their application to the process described in document 1 was obvious. However, the board held that the application of a measure known as such, contrary to warnings given in several documents, was not obvious. Since this measure involved an inventive step, the overall process of claim 1 encompassing that measure likewise involved an inventive step: the modification of a known process by two measures, at least one of which was not obvious, rendered the entire process inventive.

6.13 Obvious new use

In **T 112/92** (OJ 1994, 192) document (1), as the closest prior art, referred to the use of glucomannan as a thickener for an ungelled processed food product, but did not mention its function as a stabiliser. The board applied the principles set out in **T 59/87** (OJ 1991, 561) to the present case and stated that even if glucomannan did act as an emulsion stabiliser in preparing the product in accordance with document (1), this use would have been a hidden use. It came to the conclusion that the use of a substance as a stabiliser for emulsions, if not inextricably linked with its use as a thickening agent, was at least very closely related. The board held that it would have been obvious for the skilled person, knowing that glucomannan was effective as a thickening agent for emulsions, at least to try to find out if it was also effective as a stabiliser. Although **T 59/87** had found that a claim to an inherent but hidden later use of a known substance could be novel, the subject-matter of such a claim would still lack inventive step if the prior art indicated a well-established link between the earlier and later uses (see also **T 544/94**).

6.14 Need to improve properties

In its headnote to **T 57/84** (OJ 1987, 53) the board stated: "If a product is required to manifest a particular property (in this case a highly fungicidal effect) under various conditions, the superiority of the invention will depend on whether or not that property is improved under all conditions liable to be encountered in practice and particularly under the various conditions evolved in order to test it (in this case exposure to water and wind). If comparative tests are cited in support of that superiority, it is their combined results that have to be considered. The decisive factor is whether the invention outperforms the substance used for comparison in the tests as a whole (in this case, results in the need to use a significantly lower concentration of the pollutant substance), even if the substance used for comparison proves better in one of the tests".

Following **T 57/84**, it was stated in **T 254/86** (OJ 1989, 115) that an invention which relied on a substantial and surprising improvement of a particular property did not also need to show advantages over the prior art with regard to other properties relevant to its use, provided the latter were maintained at a reasonable level so that the improvement was not completely offset by disadvantages in other respects to an unacceptable degree or in a manner which contradicted the disclosure of the invention fundamentally (see also **T 155/85**, OJ 1988, 87). It was thus not necessary for there to be an improvement in every respect (**T 302/87**, **T 470/90**).

In **T 155/85** (OJ 1988, 85) it was further pointed out that subject-matter falling structurally between two particular embodiments of cited disclosure and displaying, in all relevant respects, effects substantially between those known for the same embodiments, lacked inventive step in the absence of other considerations.

6.15 Disclaimer

According to **T 4/80** (OJ 1982, 149) and **T 433/86**, in cases where what is claimed in general overlaps with the state of the art it is permissible to exclude a special state of the art from the claimed invention by means of a disclaimer, even if the original documents give no (specific) basis for such an exclusion (see however **T 323/97** (OJ 2002, ***) where it was stated obiter dicta that the practice of permitting disclaimers having no support in the application as filed could not be maintained, see p. 161).

Whereas a disclaimer can be used to make an inventive teaching which overlaps with the state of the art novel, it cannot make an obvious teaching inventive (**T 170/87** (OJ 1989, 441), **T 597/92** (OJ 1996, 135)). In **T 710/92** the board stated that the latter was also valid in cases where the disclaimer was introduced for novelty reasons, since the excision, in the form of a disclaimer, of part of a claim could not change the content of the original teaching.

In **T 871/96** the board held that therefore, the limiting clause represented by the disclaimer is meaningless in assessing the inventive step. For this reason, the invention without discontinuities between the claimed subject-matter and that part of the original subject-matter excised by way of a disclaimer has to solve uniformly what is regarded as the underlying technical problem (see also **T 434/92**).

In **T 308/97** the disclaimer was intended to differentiate between cited documents in the same technical field and was not introduced in order to establish novelty, since novelty was present even without the disclaimer. The purpose of the disclaimer was to make obvious subject-matter non-obvious, thereby making it a different invention. The board therefore concluded that the introduction of the disclaimer was not allowable and was in breach of Art. 123(2) EPC.

For further information on disclaimers, see pages 101 et seq. and 210 et seq.

6.16 Optimisation of parameters

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

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

In a number of other decisions, all of which referred to **T 36/82** (OJ 1983, 269) the subject-matter was found not to involve an inventive step, particularly when the problem addressed was to find a suitable compromise between different parameters (**T 38/87**, **T 54/87**, **T 655/93** and **T 118/94**). In **T 410/87** the board stated that it was part of the activities deemed normal for the skilled person to optimise a physical dimension in such a way as to reach an acceptable compromise, serving the intended purpose, between two effects which were contingent in opposing ways on this dimension (see also **T 409/90** (OJ 1993, 40), **T 660/91, T 218/96, T 395/96**).

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

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

6.17 Small improvement in commercially used process

In **T 38/84** (OJ 1984, 368) the board of appeal pointed out that the achievement of a numerically small improvement in a process commercially used on a large scale (here enhanced yield of 0.5%) represented a worthwhile technical problem which should not be disregarded in assessing the inventive step of its solution as claimed (see also **T 466/88** and **T 332/90**). In **T 155/85** (OJ 1988, 87) the board added that it was correct to say that even small improvements in yield or other industrial characteristics could mean a very relevant improvement in large-scale production, but the improvement had to be significant and therefore above margins of error and normal fluctuations in the field in consequence of other parameters. In **T 286/93** the invention related to a process for manufacturing wrapping paper and board. The results for the process had shown that the machine speed and the mechanical quality of the paper obtained had improved by some 3 % vis-à-vis a process in which the order in which aluminium polychloride and cationic starch were added had been reversed. Since a process of this kind was obviously intended for the production of paper on an industrial scale, even a small improvement had to be regarded as significant.

6.18 Evidence of inventive step in the field of medicine

In **T 619/94** the board held that features that were known or obvious in the field of sandblasting could not automatically be transferred to the medical field without considering the particular situation in the latter field, since in the case in point the consistency of the human tissue to be removed by abrasion was different from that of the material normally removed by sandblasting.

In **T 913/94** the invention relates to the use of a specific agent in the preparation of a medicament against gastritis. In the board's view, though gastritis and ulcer are distinct diseases, they have common aspects in relation to their causative factors. In the case in point the board investigated, whether, an anti-ulcer medicament would also have been expected to be active against gastritis. It arrived at the conclusion that if the manifestations of the second more serious disease (ulcer) are known to run through the manifestations of the first disease, and this assumption reliably substantiated was not confuted, then the activity of a medicament against the more serious disease would already strongly suggest an effect also against the less serious one. Thus, said agent is known for the treatment of experimentally induced ulcer; its use for the preparation of a medicament for the treatment of gastritis does not involve any inventive merit.

6.19 Analogy process/Envisageable product

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

According to **T 2/83** (OJ 1984, 265), so-called analogy processes in chemistry are only claimable if the problem, ie the need to produce certain patentable products as their effect, is not yet within the state of the art.

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

In **T 233/93** the combination of properties defining the claimed products had been a desideratum which the skilled community had striven to achieve. These properties, however had been considered to be irreconcilable. The board stated that such a desired product, which may appear obvious per se, may be considered non-obvious and be claimable as such, if there is no known method in the art to make it and the claimed methods for its preparation are the first to produce it and do so in an inventive manner.

6.20 Examples of the denial of inventive step

6.20.1 Reversal of procedural steps

The mere reversal of procedural steps in the production of component parts could not provide justification for inventive step (**T 1/81**, OJ 1981, 439).

6.20.2 Purposive selection

If, for a particular application of a known process, the skilled person could obviously use a material generally available on the market and suitable for the purpose, and was also highly likely to use it for reasons irrespective of its characteristics, such use should not be considered as inventive on account of those characteristics alone. It stood to reason that if carrying out such a step was itself already obvious for other reasons, the natural choice of the particular means on the market-place was devoid of mental or practical effort, or of "purposive selection", in the absence of anything to the contrary (**T 513/90**).

6.20.3 Automation

In **T 775/90** the board ruled that mere automation of functions previously performed by human operators was in line with the general trend in technology and thus could not be considered inventive.

The mere idea of executing process steps automatically, eg replacing manual operation by automatic operation, was a normal aim of the skilled person (**T 234/96**).

6.20.4 Routine experiments

Work involving mere routine experiments, such as merely conventional trial-and-error experimentation without employing skills beyond common general knowledge, lacked inventive step (**T 455/91** (OJ 1995, 684), **T 104/92**).

In **T 253/92** the subject-matter of claim 1 related to a process for the manufacture of a permanent-magnet alloy. In the board's view a skilled person would have regarded it as obvious to try out a variety of alloys known from the prior art to be of similar composition to those of the better examples and to measure their magnetic properties. During such routine experiments the skilled person would have come upon those alloys, which combined excellent stability with an energy product of at least 28.1 MGoe, since these were not hidden properties, but precisely the ones being sought.

6.20.5 Simplification of complicated technology

In **T 61/88** the board indicated that in the face of an optimal but sophisticated solution to a technical problem the skilled person could not be denied the capacity to recognise that less complicated alternatives generally achieved less perfect results and consequently to envisage such alternatives, at least in situations in which the advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance (**T 817/94)**.

In **T 505/96** the board concluded that the simplification of complicated technology in situations in which advantages of decreased complexity could reasonably be expected to outweigh the resulting loss of performance must be considered to be part of the normal work of the person skilled in the art.

7. Secondary indicia in determining inventive step

7.1 General issues

According to established case law, a mere investigation for indications of the presence of inventive step is no substitute for the technically skilled assessment of the invention vis-à-vis the state of the art pursuant to Art. 56 EPC. Where such indications are present, the overall picture of the state of the art and consideration of all significant factors may show that inventive step is involved but this need not necessarily always be the case (see **T 24/81** (OJ 1983, 133) and **T 55/86**). Secondary indicia of this kind are only of importance in cases of doubt, ie when objective evaluation of the prior art teachings has yet to provide a clear picture (**T 645/94, T 284/96, T 71/98**). Indicia are merely **auxiliary considerations** in the assessment of inventive step (**T 1072/92**, **T 351/93**).

In the "**Epilady**" case (**T 754/89**) the board detailed its reasons for ruling that an inventive step was involved. Although factors such as commercial success, the overcoming of prejudice, the age of the documents cited, the cost of advertising and the creation of a new market segment, the satisfaction of a long-standing need, the existence of imitations and forms of infringement had received considerable attention, particularly in the parties' written submissions, the technical facts of the case were such that secondary indications of inventive step had lost any relevance.

7.2 Prejudice in the art

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

A prejudice in any particular field relates to an opinion or preconceived idea widely or universally held by experts in that field. The existence of such prejudice is normally demonstrated by reference to the literature or to encyclopaedias published before the priority date. The prejudice must have existed at the priority date, any prejudice which might have developed later is of no concern in the judgment of inventive step (**T 341/94**, **T 531/95** and **T 452/96**).

Generally speaking, prejudice **cannot** be demonstrated by a statement in a single patent specification, since the technical information in a patent specification or a scientific article might be based on special premises or on the personal view of the author. However, this principle does not apply to explanations in a standard work or textbook representing common expert knowledge in the field concerned (**T 19/81** (OJ 1982, 51), **T 104/83**, **T 321/87**, **T 392/88**, **T 601/88**, **T 519/89**, **T 453/92**, **T 900/95**). In **T 515/91** the board regarded "ABC Naturwissenschaft und Technik" as a standard work (see also **T 461/92**, **T 152/93**). In **T 943/92** the existence of a prejudice was supported by a specialist book which reflected the technical knowledge in the special field of the contested patent. This book did not contain the opinion of just one specialist author, but that of experts in the field, as it had resulted from the collaboration of "numerous recognised scientists, technicians and practicians as well as associations and institutes". General critical remarks in one textbook were not sufficient for substantiating an alleged prejudice, if a plurality of prior art documents pointed to the opposite (**T 134/93**).

Generally established board of appeal case law is **very strict** on recognising the existence of a prejudice. A solution put forward as overcoming a prejudice must clash with the prevailing teaching of experts in the field, ie their unanimous experience and notions, rather than merely citing its rejection by individual specialists or firms (**T 62/82**, **T 410/87**, **T 500/88**, **T 74/90**, **T 943/92, T 531/95** and **T 793/97**). The fact that a disadvantage is accepted or the prejudice simply ignored does not mean that a prejudice has been overcome (**T 69/83** (OJ 1984, 357), **T 262/87**, **T 862/91**).

In **T 550/97** the respondent (patent proprietor) had argued that, years after the invention, technically less advanced solutions had been filed for and marketed as a means of integrating different mobile radio networks. However, the board did not consider the fact that arguably less advanced solutions had been developed later to be evidence of inventive step, as there was no reason to assume that later development was attributable to a technical prejudice which the present invention had needed to overcome.

In **T 347/92** the board pointed out that the finding of a relatively small operating window in an area which, according to the teaching of the most recent publications, was considered inaccessible, could not be considered obvious to a person skilled in the art. The existence of a prejudice was also confirmed in **T 57/98**.

One form of secondary indicia in the nature of a "technical prejudice" is a **development of the art in a different direction** (see also **T 2/81**, OJ 1983, 133, **T 650/90**, **T 330/92**). In **T 872/98** the board pointed out that the presence of secondary indicia might also be attested by the fact that a competitor had, shortly after the priority date, filed a patent application with the German Patent Office in which the invention took an entirely different direction to the European application.

7.3 Age of documents/time factor

The age of documents known long before the filing date might only be an indication of inventive step if a need for the solution of an unsolved problem had existed for the whole time between the date of the documents and that of the invention (**T 79/82** and **T 295/94**). Nevertheless, the long period of time to be considered was not the period that had elapsed between the publication of a document and the filing of the European patent application disclosing the teaching of that document, but that between the time the problem became apparent and the date of filing of the European patent application providing a solution (**T 478/91**).

A period of 23 years between the publication date of the document deemed to be the closest prior art and the priority date of the contested patent in an economically significant and frequently studied field could normally be viewed as an indication of the presence of inventive step (**T 273/92**). In **T 203/93** and in **T 795/93** a period of 11 years was considered to be an indication in support of inventive step, in **T 986/92** a period of 70 years, in **T 478/91** 80 years and in **T 626/96** 60 years (see also **T 774/89, T 540/92**, **T 957/92, T 697/94, T 322/95, T 255/97, T 970/97**).

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

In **T 1077/92** the board faced the unusual situation of a problem and its ready solution having co-existed for 100 years in general, and more recently in a field of intensive research, and still the seemingly obvious step had not been taken. The board concluded that, as no other explanation could be found, this must have been because inventive insight was needed (**T 617/91**).

In **T 123/97** the failure to adopt an obvious solution to the technical problem underlying the patent in suit may have resulted from a variety of causes: for example there may have been a commercial reason for not adopting this new technique, because the old technique was found satisfactory by the clients and could also be improved, thus avoiding considerable investment costs involved in the adoption of a new technique on an industrial scale.

7.4 Satisfaction of a long-felt need

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

In **T 605/91** the board stated that it was not sufficient if only one individual skilled person discovered a "long-felt need". Only if various and repeated attempts to deal with the relevant disadvantages could be identified would such a long-felt need appear to have persisted.

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

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

7.5 Commercial success

In principle, commercial success alone is not to be regarded as indicative of inventive step.

The following requirements must first be met (see Guidelines, C-IV,9.9): a long-felt need must have been fulfilled, and the commercial success must derive from the technical features of the invention and not from other influences (eg selling techniques or advertising).

In **T 110/92** the board did not dispute that the heating assembly according to claim 1 might have been a commercial success. However, such a commercial success alone, with the technically relevant examination of the claimed subject-matter leading to a negative result, could not be regarded as forming the basis for an indication of inventive step even if the board were convinced that the success derived from technical features of the heating assembly and not from other causes such as those of a commercial nature (see **T 5/91**, **T 219/90, T 373/94**).

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

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

In **T 626/96** the invention had likewise achieved great commercial success and gained widespread recognition in a number of countries. Furthermore, the success was achieved in a very short space of time, so that there seemed to be a pressing commercial need for this simple solution. Furthermore, the success was directly attributable to the structure of the product claimed and was not due to marketing techniques or advertising skills.

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

The case was slightly different in **T 812/92**: the situation might arise where, shortly before the filing date of the contested patent, **one of the patent proprietor's competitors** offered a customer a technical apparatus without reducing to practice the advantageous technical solution according to the invention. This might be an indication that an inventive step was involved.

7.6 Simple solution

In a technical field of commercial importance to which considerable attention is directed the simplicity of a proposed solution may indicate inventive step. The difficulty of developing a simple solution without sacrificing quality may therefore indicate inventive step (**T 106/84** (OJ 1985, 132), **T 229/85** (OJ 1987, 237), **T 9/86** (OJ 1988, 12), **T 29/87**, **T 44/87**, **T 528/89, T 73/95**). This did however presuppose the absence in the prior art of anything that hinted at the proposed solution (**T 712/92**).

In **T 234/91** it was pointed out that experience in structural engineering showed that with the same or even an improved effect - in the case in point an increase in reliability - it was often much more difficult to identify and achieve a simple solution than complicated embodiments. In view of the large number of solutions suggested in the technical literature, the board came to the conclusion that the improvement achieved by the simple structural measure suggested in the contested patent had not been obvious (see also **T 330/87**).

In **T 349/95** the subject-matter at issue related to a simple form of a simple device, a device which, however, had brought about a surprising major functional improvement. In the board's view, this surprising improvement and the fact that the prior art gave no clear hint of the solution constituted evidence of the inventiveness of the claimed solution.

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

7.7 Surprising effect

7.7.1 "Bonus effect"

An effect which may be said to be unexpected can be regarded as an indication of inventive step (**T 181/82**, OJ 1984, 401). However, certain preconditions have to be met. In **T 21/81** (OJ 1983, 15) the board considered that if, having regard to the state of the art, it would already have been **obvious** for a skilled person to arrive at something falling within the terms of a claim, because an advantageous effect could be expected to result from the combination of the teachings of the prior art documents, such claim **lacked** inventive step, irrespective of the circumstance that an extra effect (possibly unforeseen) was obtained (see **T 365/86**, **T 350/87**, **T 226/88**). This case law was also confirmed in **T 69/83** (OJ 1984, 357). Where, because of an essential part of the technical problem being addressed, the state of the art obliged a skilled person to adopt a certain solution, that solution was not automatically rendered inventive by the fact that it also unexpectedly solved part of the problem. Therefore, an unexpected bonus effect does not confer inventiveness on an obvious solution (**T 231/97**).

Furthermore, in **T 192/82** (OJ 1984, 415) the board stated that the skilled person had to be free to employ the best means already available for his purposes, although the use of means leading to some expected improvements might well be patentable in relying on an additional effect, provided this involved a choice from a multiplicity of possibilities. The lack of alternatives in this respect might therefore create a **"one-way-street"** situation leading to predictable advantages which remained obvious in spite of the existence of some unexpected "bonus" effect. The board also pointed out in **T 506/92** that an additional effect achieved inevitably by the skilled person on the basis of an obvious measure without any effort on his part simply represented a bonus under EPO case law which could not substantiate inventive step, even as a surprising effect (see also **T 766/92**, **T 431/93**, **T 703/93**, **T 681/94**).

The board in **T 936/96** held that, once a realistic technical problem had been defined and once it had been established that a particular solution to such a problem **would** have been envisaged by a skilled person in the light of the relevant state of the art, that solution could not be said to involve an inventive step, and this assessment was not altered by the fact that the claimed invention inherently also solved further technical problems. In the case in point the claimed surprising effect could not be regarded as an indication of the presence of an inventive step.

In **T 227/89** the board stated that in determining which effect was crucial and which was merely accidental (the so-called "bonus effect"), a realistic approach had to be taken, considering the relative technical and practical importance of those effects in the circumstances of a given case (see also **T 732/89** and **T 729/90**). When assessing chemical substances for inventive step, it is often their surprising properties that are considered (see in this connection **T 20/83**, OJ 1983, 419).

In **T 848/94** the solution of the existing technical problem required a combination of measures that was not suggested by the prior art in such a manner that it would have been adopted by the person skilled in the art. Therefore, the person skilled in the art was not in a "one-way-situation".

In **T 154/87** it was pointed out that the achievement of a surprising effect was no precondition for the existence of inventive step. All that was necessary was to ascertain that the respective subject-matter could not be derived by the skilled person in an obvious manner from the available prior art (**T 426/92**, **T 164/94, T 960/95, T 524/97**).

In **T 551/89** the board stated that an effect which was to be expected as the result of an obvious measure could not contribute to recognition of the required inventive step, even if the scale of this effect was surprising to the skilled person. In this case an effect whose scale surpassed the skilled person's hopes merely represented a bonus effect following inevitably from the use of an obvious measure and obtained by the skilled person without any inventive effort on his part (**T 506/92**, **T 882/94**).

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

7.7.2 Comparative tests

In certain cases an effect demonstrated by means of a comparative test may be regarded as indicating that an inventive step has occurred. According to the case law of the boards of appeal, if comparative tests are chosen to demonstrate an inventive step on the basis of an improved effect, the nature of the comparison with the closest state of the art must be such that the said effect is convincingly shown to have its origin in the distinguishing feature of the invention (**T 197/86**, OJ 1989, 371) and alleged but unsupported advantages cannot be taken into consideration in respect of the determination of the problem underlying the application (**T 20/81** (OJ 1982, 217) and **T 561/94**).

In **T 197/86** (OJ 1989, 371) the board supplemented the principles laid down in earlier decision **T 181/82** (OJ 1984, 401), according to which, where comparative tests were submitted as evidence of an unexpected effect, there had to be the closest possible structural approximation in a comparable type of use to the subject-matter claimed. In the case in point the respondent (proprietor of the patent) strengthened support for his claim by voluntarily providing comparisons with variants which, although not expressly belonging to the prior art, differed from the claimed subject-matter only by the distinguishing feature of the invention. The board summarised its position by stating, that in cases where comparative tests were chosen to demonstrate an inventive step with an improved effect over **a claimed area**, the nature of the comparison with the closest state of the art had to be such that the effect was convincingly shown to have its origin in the distinguishing feature of the invention. For this purpose it might be necessary to modify the elements of comparison so that they differed only by such a distinguishing feature (**T 292/92**, **T 412/94, T 819/96**).

Already in **T 35/85** the board stated that an applicant or patentee may discharge his onus of proof by voluntarily submitting comparative tests with newly prepared variants of the closest state of the art identifying the features common with the invention in order to have a variant lying closer to the invention so that the advantageous effect attributable to the distinguishing feature is thereby more clearly demonstrated (**T 40/89, T 191/97**).

In **T 390/88** the board addressed the question of the circumstances under which the production of comparative examples was unnecessary. In the above-mentioned earlier cases the invention had been obvious prima facie because the products, although novel, were very close structurally to the prior art products. The case in point was different. Here, the board said that the production of comparative examples was not essential to establish inventiveness, as the invention had not been obvious from the outset (**T 656/91**).

In **T 172/90** the comparative examples produced did not constitute suitable evidence of inventive step. The board said that the products adduced as a basis of comparison were commercially available and had evidently been selected at random. Technical progress shown in comparison with products of this kind could not be a substitute for the demonstration of inventive step with regard to the closest prior art (see also **T 164/83**, OJ 1987, 149, **T 730/96**).

E. The requirement of industrial applicability under Article 57 EPC

1. Notion of "industrial application"

Art. 57 EPC provides that "An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". This Article defines and explains the nature of the requirement in Art. 52(1) EPC that the subject-matter is "susceptible of industrial application". In particular, this Article makes it quite clear that, under the EPC, agriculture is a kind of industry, and that agricultural methods are therefore, in general, methods which are susceptible of industrial application (**T 116/85**, OJ 1989, 13).

In **T 144/83** (OJ 1986, 301) the board stated that under Art. 57 EPC an invention was to be considered as susceptible of industrial application if it could be made or used in any kind of industry. Enterprises in the cosmetic field - such as cosmetic salons and beauty parlours - were part of industry within the meaning of Art. 57 EPC, since the notion of "industry" implied that an activity was carried out continuously, independently and for financial gain. A board had already decided that the professional use of such inventions in a cosmetic salon was an industrial application within the meaning of Art. 57 EPC. In **T 36/83** (OJ 1986, 295) the board also found that the professional use of the invention in a beauty parlour was an industrial application within the meaning of Art. 57 EPC.

In **T 204/93** the board held that commercial use excluded from patentability under Art. 52(2)(c) and (3) EPC (in so far as it was not construed as a method for doing business) was a feature which might be understood to fall under the requirement that an invention had to be susceptible of industrial application (Art. 52(1) EPC), ie that it could be made or used in any kind of industry (Art. 57 EPC); reference was made in particular to the German word "gewerblich" in that provision of the Convention. The board noted that it was not disputed that computer programs could be exploited commercially. The exclusions from patentability defined in Art. 52(2) EPC and in Art. 52(3) EPC did not in any way refer to the requirement in Art. 52(1) EPC of "industrial application" but to the requirement in that Article that the subject-matter claimed had to be an "invention". The exclusions in Art. 52(2) and (3) were generally understood to have in common that the excluded matters lacked technicality but not that they could not be made or used, eg traded.

In **T 953/94** the board stated that as the Convention showed (Art. 52(1) EPC), the requirement (defined in Art. 52(2) and (3) EPC) of claimed subject-matter being an "invention" was distinct from the requirement (defined in Art. 57 EPC) of the claimed invention being "susceptible of industrial application". Even though the former requirement might, cum grano salis, be equated with a requirement for a "technical" contribution, this was not the same as a requirement for an "industrial" applicability; at least in this context, the terms "technical" and "industrial" were not synonyms. In Art. 57 EPC, the meaning of "industrial" was evidently intended to cover commercial applications; this was made clear, for instance, by the German version ("gewerblich"). In the context of Art. 52(2) EPC, this was clearly not the case for the meaning of "technical". This was because, in the context of "controlling a ... process", the adjective "industrial" should, other than in the context of Art. 57 EPC, be understood to relate only to technical processes usually occurring in "industry" (this latter term in its present context being understood in the narrower sense of what in German would be called "Industrie") and thus not as including "commercial", or even "financial", applications.

In **T 541/96** the board noted that according to Art. 52(1) EPC a European patent could be granted for an invention which was, inter alla, susceptible of industrial application. This concept was related to the obligation on an applicant to give a sufficient description of the invention, as required by Art. 83 EPC. An invention or an application for a patent for an alleged invention which would not comply with the generally accepted laws of physics would be incompatible with the requirements of Art. 57 EPC and Art. 83 EPC because it could not be used and therefore lacked industrial application. The description would moreover be insufficient to the extent that the applicant would not be able to describe how it could be made to work.

The board went on to observe that the EPC did not prevent the patentability of "revolutionary" inventions. However, Art. 83 EPC made the amount of information required for a sufficient disclosure of an invention somewhat dependent on the actual "nature" of the invention. If the latter lay in a well-known technical field and was based on generally accepted theories, the description did not need to comprise many specific technical details which would anyway be implicit to a skilled person. However, if the invention seemed, at least at first, to offend against the generally accepted laws of physics and established theories, the disclosure should be detailed enough to prove to a skilled person conversant with mainstream science and technology that the invention was indeed feasible (ie susceptible of industrial application). This implied, inter alia, the provision of all the data which the skilled person would need to carry out the claimed invention, since such a person, not being able to derive such data from any generally accepted theory, could not be expected to implement the teaching of the invention just by trial and error.

In the case at issue, the gist of the invention consisted in inducing nuclear fusion between light nuclei and heavy unstable nuclei at low temperature by means of an electric field. The appellant had provided neither experimental evidence nor any firm theoretical basis which would enable the skilled person to assess the viability of the invention; the description was essentially based on general statements and speculations which were not apt to provide a clear and exhaustive technical teaching, Thus, it was irrelevant to consider whether the fusion reactions referred to in the description might be theoretically possible, or whether they might indeed occur under certain conditions.

In **T 718/96** the board ruled that although disclosure objections could be raised under Art. 57 EPC, on the grounds that an invention which cannot be carried out is not susceptible of industrial application, they should rather be based on Art. 83 EPC or Art. 100(b) EPC which specifically relate to the performability of inventions.

2. Indicia in determining industrial applicability

2.1 Methods applied in the private and personal sphere

In **T 74/93** (OJ 1995, 712) the application was refused by the examining division because claim 5, which was directed to the use of a contraceptive composition (eg a cream) for applying to the cervix of a female capable of conception, was not susceptible of industrial application as required by Art. 57 EPC in so far as the compound was to be applied to the cervix of a human female. The appellant had argued essentially that many inventions in the field of daily needs were used privately and their patentability should not be restricted.

The board noted that since "industry" in the field of industrial property was widely understood in its broadest sense (Art. 1(3) of the Paris Convention), such a liberal interpretation could also apply to Art. 57 EPC. However, the board stated that in determining the borderline between industrial activities, in which the effects of patents had to be respected, and private and personal activities, which should not be adversely affected by the exercise of these rights, the board took into consideration the fact that Art. 57 EPC might be regarded as an expression of the general idea that any natural person had the right to have his or her privacy respected. The core of this right was not to be taken away from anybody. Therefore the fact that for some women contraception was connected with professional activities did not give an act, which was in essence private and personal, an industrial character. The board noted that this did not apply to contraception in general, but to the specific type of application of a composition as claimed in claim 5.

The board was unable to ascertain any field of industrial application for the direct use defined in claim 5, for which the requirement of Art. 57 EPC had to be met. The question as to whether it would be sufficient for an industrial application to be expected in future could be left unanswered. Even if the board were to accept the appellant's position in this respect, it would not be sufficient simply to make an unsubstantiated allegation to this effect. Without any specific indication the board was not in a position to accept that the requirement of Art. 57 EPC was fulfilled.

2.2 Possibility of services offered by an enterprise

In **T 1165/97** the board held that a method of using a vaginal discharge collector and disposing of the collector after a single use could be considered susceptible of industrial application if it was imaginable that these steps were carried out as a paid service and were not exclusively dependent for their execution on the instructions of the woman in question. The board noted that, for the purposes of Art. 57 EPC, what was relevant was the possibility that such a service might be offered by an enterprise. In that case, the board decided in the affirmative, pointing out that - in contrast to the case in **T 74/93** - the service was not one satisfying only the strictly personal needs of the woman in question. Collecting a sample could be caused by external reasons, eg on the advice of a medical practitioner to have such a sample taken for further diagnosis.

3. Other criteria - Formulation of claims

In **G 5/83** (OJ 1985, 64), claims directed to substances or compositions for use in any methods for treatment of the human or animal body were unquestionably directed to inventions which were susceptible of industrial application within the meaning of Art. 52(1) EPC. This was not only expressly made clear in Art. 52(4) EPC, last sentence, but could also be inferred from the definition of "susceptible of industrial application" in Art. 57 EPC, namely that the invention "can be made or used in any kind of industry, including agriculture". The last sentence of Art. 52(4) EPC appeared to be a statement of the obvious, stemming from an abundance of caution.

In **T 80/96** (OJ 2000, 50), the board found that the use of a substance to make a new pharmaceutical product without delimitation to an indication did not contravene the requirements of Art. 57 EPC in conjunction with Art. 52(1) EPC. In the board's view, the requirement for clarity of the claims (Art. 84 EPC) likewise did not mean that a claim for a process for preparing a particular product could not be drafted in the form of a use claim. No other meaning could be given to the individual process steps (see, for example, **T 279/93** of 12 December 1996, not published in OJ , reasons No. 4).

II. CONDITIONS TO BE MET BY AN APPLICATION

A. Sufficiency of disclosure

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

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

It has been consistent case law of the boards of appeal since at least **T 14/83** (OJ 1984, 105) that sufficiency of disclosure within the meaning of Art. 83 EPC must be assessed on the basis of the application as a whole - including the description and claims - (see also **T 169/83** (OJ 1985, 193)) and not of the claims alone (see eg **T 202/83**, **T 179/87** dated 16.1.1990, **T 435/89**, **T 82/90**, **T 126/91**).

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

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

(a) The disclosure is aimed at the skilled person.

The skilled person may use his common general knowledge to supplement the information contained in the application (**T 206/83** (OJ 1987, 5), **T 32/85**, **T 51/87** (OJ 1991, 177), **T 212/88** (OJ 1992, 28), **T 580/88**, **T 772/89**, **T 231/92, T 818/97**). He may even recognise and rectify errors in the description on the basis of such knowledge (**T 206/83** (OJ 1987, 5), **T 171/84** (OJ 1986, 95), **T 226/85** (OJ 1988, 336)). Textbooks and general technical literature form part of the common general knowledge (**T 171/84**, **T 51/87**, **T 580/88** and **T 772/89**). However, information which can only be obtained after a comprehensive search is not to be regarded as part of the common general knowledge (**T 206/83** and **T 654/90**).

Patent specifications cannot normally contribute to the sufficiency of the disclosure unless they are available to the skilled reader of the patent in question (**T 171/84**, OJ 1986, 95). By way of exception, however, patent specifications and scientific publications may be considered to form part of the common general knowledge where the invention is in a field of research so new that the relevant technical knowledge is not yet available from textbooks (**T 51/87** (OJ 1991, 177), **T 772/89** and **T 676/94**).

Finally, the same level of skill has to be applied when, for the same invention, the two questions of sufficient disclosure and inventive step are being considered (**T 60/89**, OJ 1992, 268) **T 694/92**, **T 187/93**, **T 412/93**).

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

For example, features not mentioned in the application documents themselves but in a document to which they refer may be incorporated into a patent claim if they unequivocally form part of the invention for which protection is sought. However, all the essential structural features thus disclosed which belong together must be incorporated into the claim; it is not permissible to single out a particular one (**T 6/84** (OJ 1985, 238).

Where an invention relates to the improvement of prior art originally cited in the description of the invention, a feature described in broad terms in the cited document but not mentioned expressly in the invention is sufficiently disclosed if it is realised in the examples of the invention in the form of an embodiment also mentioned in the reference document (**T 288/84** OJ 1986, 128).

An invention is also sufficiently disclosed if reference is made to another document in the patent specification and the original description, and the skilled person can obtain from this cross-reference the information required to reproduce the invention but not disclosed in so many words in the description itself (**T 267/91, T 611/89**). This applies irrespective of the language in which it is drafted (see **T 920/92**, where the document referred to was in Japanese).

However, a reference to another document can only be taken into account if it was available to the relevant addressees of the document containing the reference. This means that the document referred to must be unambiguously identified and that the relevant addressees must have ready access to it. Whether or not this is so depends solely on the facts of the case. Neither Art. 123(2) EPC nor the Guidelines for Examination require or imply that a patent application referred to has to be identified by a number in order to be taken into account for the purposes of Art. 83 EPC (**T 737/90**).

The reference in **T 156/91** presented a special case. The contested patent related to a process involving the use of a catalyst whose composition and method of manufacture had been kept secret by the manufacturers. The board expressed doubts about the sufficiency of disclosure of an invention that could be carried out only with products whose method of manufacture was not disclosed but which were commercially available, although their availability was not guaranteed for any identifiable period. Since the process lacked inventive step, however, the board did not ultimately have to resolve the question of reproducibility.

3. Clarity and completeness of disclosure

It must be possible to reproduce a claimed step using the original application documents without any inventive effort over and above the ordinary skills of a practitioner (**T 10/86**). Where an applicant did not furnish details of the production process in the description in order to prevent the invention from being copied easily and the missing information could not be supplied from the general knowledge of a person skilled in the art, the invention was held to be insufficiently disclosed (**T 219/85** (OJ 1986, 376)).

An invention is in principle sufficiently disclosed if at least one way is clearly indicated enabling the person skilled in the art to carry out the invention. If this is the case, the non-availability of some particular variants of a functionally defined component feature of the invention is immaterial to sufficiency as long as there are suitable variants known to the skilled person through the disclosure or common general knowledge which provide the same effect for the invention (**T 292/85** (OJ 1989, 275)). This has been confirmed by many decisions: **T 81/87** (OJ 1990, 250), **T 301/87** (OJ 1990, 335), **T 212/88** (OJ 1992, 28), **T 238/88** (OJ 1992, 709), **T 60/89** (OJ 1992, 268), **T 182/89** (OJ 1991, 391), **T 19/90** (OJ 1990, 476), **T 740/90**, **T 456/91** and **T 242/92**.

Moreover, according to **T 281/86** (OJ 1989, 202), there is no requirement under Art. 83 EPC that a specifically described example of a process must be exactly repeatable. Variations in the constitution of an agent used in a process are immaterial to the sufficiency of the disclosure provided the claimed process reliably leads to the desired products. As long as the description of the process is sufficiently clear and complete, ie the claimed process can be put into practice without undue burden by the skilled person taking his general knowledge into consideration, there is no deficiency in this respect (see also **T 292/85** (OJ 1989, 275), **T 299/86** (OJ 1988,88), **T 181/87**, **T 212/88** (OJ 1992, 28), **T 182/89** (OJ 1991, 391) and **T 19/90** (OJ 1990, 476)).

Fulfilling the requirement of R. 27(1)(e) EPC that the description shall describe in detail at least one way of carrying out the invention claimed, does not automatically mean that the application as filed is sufficiently disclosed in accordance with Art. 83 EPC. This has to be decided by appraising the information contained in the examples as well as other parts of the description in the light of the skilled person's common general knowledge at the relevant date (**T 322/93**). However, where the requirements of Art. 83 EPC are fulfilled, it follows that there is at least one way of carrying out the invention disclosed in accordance with R. 27(1)(e) EPC (**T 561/96**). In this decision, the fact that the examining division, despite an objection under Art. 83 EPC, nevertheless acknowledged novelty and inventive step, indicated to the board that the invention was unambiguously understandable for a skilled person and thus sufficiently disclosed.

However, the disclosure of one way of performing an invention is only sufficient if it allows the invention to be performed **in the whole range claimed** rather than **only in some** members of the claimed class to be obtained (**T 409/91** (OJ 1994, 653) and **T 435/91** (OJ 1995, 188)). This was considered a question of fact. Sufficiency of disclosure thus presupposes that the skilled person is able to obtain substantially **all** embodiments falling within the ambit of the claims. This was also the view taken by the board in decisions **T 19/90** (OJ 1990, 476), **T 242/92**, **T 418/91**, **T 548/91**, **T 659/93,** and **T 923/92** (OJ 1996, 564). More technical details and more than one example may be necessary in order to support claims of a broad scope (**T 612/92**, **T 694/92** (OJ 1997, 408), **T 187/93**). This must be decided on a case-by-case basis.

The objection of lack of sufficient disclosure also presupposes that there are serious doubts, substantiated by verifiable facts (**T 19/90** (OJ 1990, 476)).

Where a disadvantage of an invention (in this case the risk of injury to users) could prevent its use, this is not an obstacle to reproducibility provided that the otherwise desired result is achieved by the technical teaching disclosed in the patent in suit (**T 881/95**).

In **T 449/90**, the board considered that the requirements of Art. 83 EPC had been satisfied where the claimed degree of inactivation ("substantially') of the Aids virus could be demonstrated with sufficient certainty. Complete inactivation of the life-threatening virus - which the opponent had argued was necessary - was indeed highly desirable, but not an issue under Art. 83 EPC, given the claim as worded.

4. Reproducibility without undue burden

The disclosure must be reproducible without undue burden.

Even though a reasonable amount of trial and error is permissible when it comes to sufficiency of disclosure, eg in an unexplored field or where there are many technical difficulties, the skilled person has to have at his disposal, either in the specification or on the basis of common general knowledge, adequate information leading necessarily and directly towards success through the evaluation of initial failures (**T 226/85** (OJ 1988, 336), following **T 14/83** (OJ 1984, 105), and **T 48/85** and **T 307/86**). Where the skilled person can only establish by trial and error whether or not his particular choice of numerous parameters will provide a satisfactory result, this amounts to an undue burden (**T 32/85**).

It suffices for the disclosure of an invention that the means intended to carry out the invention are clearly disclosed in technical terms which render them implementable and that the intended result is achieved at least in some, equally realistic, cases (**T 487/91**). The occasional failure of a process as claimed does not impair its reproducibility if only a few attempts are required to transform failure into success, provided that these attempts are kept within reasonable bounds and do not require an inventive step (**T 931/91**). Nor is reproducibility impaired if the selection of the values for various parameters is a matter of routine and/or if further information is supplied by examples in the description (**T 107/91**).

According to **T 256/87** all that has to be ensured is that the skilled person reading the specification will be able to carry out the invention in all its essential aspects and know when he is working within the forbidden area of the claims. The possibilities of indirect empirical investigation referred to in the specification were, in the board's view, an acceptable solution which sufficed to fulfil the requirements of Art. 83 EPC without undue burden.

There is no requirement in the EPC that the claimed invention may be carried out with the aid of only a few additional non-disclosed steps. The only essential requirement is that each of those additional steps be so apparent to the skilled person that, in the light of his common general knowledge, a detailed description of them is superfluous (**T 721/89**).

Experiments constitute an undue burden if they have first of all to find the solution to the problem and are not carried out just to determine the numerical limits of a functionally defined range (**T 312/88**). They should quickly give a reliable picture of how the products can be produced or manufactured (**T 475/88**). However, it is not necessary for the experimental data filed with the patent in suit to be an exact repetition of the worked examples of the patent, as long as the experimental work can be regarded as being within the scope of the invention (**T 674/96**).

Where it is obvious that a skilled person would select a particular analytical measuring method, (none being disclosed in the patent), balancing its simplicity and convenience against the required accuracy, the requirements of Art. 83 EPC are met (**T 492/92**). This is the case even if the two different analytical methods proposed by the patentee give significantly different results with the same composition. However, where there are different measuring methods which do not always lead to the same result, this can amount to an undue burden, as in **T 225/93** (see also II.B.1.1.3).

5. Biotechnology

5.1 Clarity and completeness of disclosure

The principles elucidated under II.A. 3 above are also applicable to biological inventions.

5.1.1 The extent to which the invention must be reproducible

Decisions **T 281/86** (OJ 1989, 202), and **T 299/86** of 17.8.89 are dealt with in II.A. 3 above.

As stated above, an invention is sufficiently disclosed if at least one way is clearly indicated enabling the skilled person to carry out the invention (**T 292/85** OJ 1989, 275). The invention concerned a recombinant plasmid comprising a homologous regulon, heterologous DNA and one or more termination codons for expression in bacteria of a functional heterologous polypeptide in recoverable form. The application was refused by the examining division on the grounds that not all embodiments falling within the broad functional wording of the claims were available. The claims also embraced the preparation of future products, whereas they should be limited to what was available at the priority date. The board disagreed, holding that the non-availability of some particular variants was immaterial as long as there were suitable variants known which provided the same effect.

Similarly, in **T 386/94** (OJ 1996, 658) the patent specification provided a technically detailed example for the expression of preprochymosin and its maturation forms in E. coli. It suggested the possibility of expressing these proteins in micro-organisms in general. The board held that the invention was sufficiently disclosed because one way to carry out the invention was clearly indicated and the state of the art contained no evidence that foreign genes could not be expressed in organisms other than E. coli.

An invention may also be sufficiently disclosed where results are not exactly repeatable. In **T 301/87** (OJ 1990, 355) the invention provided a route through recombinant DNA technology to certain types of interferons but in a manner that would not provide identical results each time when repeated. The board concluded that variations in construction within a class of genetic precursors, such as recombinant DNA molecules claimed by a combination of structural limitations and functional tests, were immaterial to the sufficiency of disclosure provided the skilled person could reliably obtain some members of the class without necessarily knowing in advance which member would thereby be made available.

However, if the essence of the invention is the achievement of a given technical effect by known techniques in different areas of application and serious doubts exist as to whether this effect could readily be obtained for the whole range of applications claimed, more technical details and more than one example may be required (see **T 612/92**, **T 694/92**, **T 187/93** and **T 923/92**, discussed in the next section).

An application may only be objected to for lack of sufficient disclosure if there are serious doubts, substantiated by verifiable facts. The mere fact that a claim is broad is not in itself a ground for considering the application as not complying with the requirement of sufficient disclosure under Art. 83 EPC (**T 19/90** OJ 1990, 476). In this case the claimed invention was defined by the incorporation of an activated oncogene sequence into the genome of non-human mammalian animals in general. The examining division refused the application on the grounds that in the light of the differences among different animals, it could not be assumed that the sole example given - mice - could be extended to all other non-human mammalian animals and the claims were thus unrealistically broad. The board disagreed.

Furthermore, even where the claims are supported by the description from a purely formal point of view, they may still not be considered allowable if they encompass subject-matter which in the light of the disclosure provided by the description can be performed only with undue burden or application of inventive skill. As for the amount of detail needed for a sufficient disclosure, this depends on the correlation of the facts of the case to certain general parameters, such as the character of the technical field and the average amount of effort necessary to put into practice a certain written disclosure in that technical field, the time when the disclosure was presented to the public and the corresponding common general knowledge, and the amount of reliable technical details disclosed in a document. (see **T 158/91** and **T 639/95**).

5.2.2 Reproducibility without undue burden

A number of factors contribute to a finding of undue burden.

In **T 187/93**, for example, there were experimental uncertainties in the patent application. The invention concerned a method for producing, by expression in eukaryotic cells, a truncated membrane-free derivative of a viral polypeptide, which provided protection in an immunised subject against in vivo challenge by a viral pathogen. Examples were only given of truncation of HSV glycoprotein gD. No general technique allowing extrapolation of the results to any other glycoprotein from any other virus were disclosed. The board found that the skilled person, when trying to obtain the same technical effect with a different glycoprotein would have experienced lack of predictability, which amounted to an undue burden.

Similarly, in **T 727/95**, the board found that the invention relied too much on chance. The claimed subject-matter included a “microorganism designated Acetobacter and having the ability of microorganisms ATCC 53264, ATCC 53263 and ATCC 53524 to ...”. The board observed that by including the phrase "having the ability of", the claim covered not only Acetobacter microorganisms derived from the deposited strains, but also Acetobacter microorganisms which had the stated characteristics in common with the deposited strains. In the board's judgment, finding other stable, cellulose high-producing Acetobacter strains in nature was a chance event, and relying on chance for reproducibility amounted to an undue burden in the absence of evidence that such chance events occurred and could be identified frequently enough to guarantee success. The board concluded that the claim was not repeatable without undue burden over the entire breadth of the claim.

In **T 694/92** (OJ 1997, 408), incomplete guidance was given. The claimed subject-matter concerned a method for genetically modifying a plant cell. In fact, the board held that the experimental evidence and technical details in the description were not sufficient for the skilled person to reliably achieve, without undue burden, the technical effect of expression in any plant cell of any plant structural gene under the control of any plant promoter. Sufficient support for a claim broadly directed to such a method was not provided.

The claimed subject-matter in **T 639/95** concerned a method for producing PHB biopolymers in a host transformed with genes encoding the enzymes ß-ketothiolase, acetoacetyl-CoA reductase and polyhydroxy butyrate (PHB) synthetase. The board found that the experimental plan for identifying and isolating the PHB gene was very general. Some references were missing and/or incomplete. There were no results and no details which could facilitate the repetition of the work. The board thus held that the total amount of experimental effort necessary to advance successfully step by step towards the desired final goal amounted to an undue burden for the skilled person.

However, in **T 412/93**, where errors and omissions prejudiced the reproducibility of one of the examples in toto and of another example in part, the reproducibility of the invention was not affected, as the examples were alternatives to previous ones.

In **T 612/92**, further scientific research would have been necessary in order to carry out the invention in some of the areas claimed. The claimed invention related to a method for incorporating foreign DNA into the genome of monocotyledonous plants via T-DNA. The patent suggested applying to monocotyledonous plants the same technique as known from the prior art for dicotyledonous plants. Examples of the transformation of two monocotyledonous species were given, but no new technique was suggested, nor were any indications given of any adaptations necessary to make the known method work in monotyledonous species. Later work resulted in lack of success in other monocotyledonous species. The board held the requirements of Art. 83 EPC were not fulfilled because there were serious doubts as to whether such a method could be performed over the whole range that was claimed. See also **T 694/92** (OJ 1997, 408) above.

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

However, in **T 223/92** the board rejected an objection by the appellant (opponent) that the provision of a DNA sequence coding for human interferon-gamma was in itself not sufficient and that it amounted to an undue burden for the skilled person to repeat the invention on the basis of this knowledge. The board was well aware of the fact that even with the full disclosure of the DNA sequence, reproducibility of the whole process of expressing the gene to produce the desired interferon gamma was still a difficult, complex and time - consuming task in 1981. Nonetheless, the board was convinced that the provision of the DNA sequence in 1981 enabled those skilled in the art to reproduce the invention, possibly in a time - consuming and cumbersome way, but, in the given circumstances, without undue burden of experimentation and without needing inventive skill. (See also **T 412/93**).

5.3 Deposit of living material

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

5.3.1 Substantive questions

In decision **T 418/89** (OJ 1993, 20) the board had to decide whether the deposited hybridoma enabled the skilled person to carry out the invention as claimed. The board found that the characteristics of the monoclonal antibodies produced by the deposited strain were different from those mentioned in the claims and that it was not possible to produce monoclonal antibodies from the deposited hybridoma using techniques recommended by the depository institution. The requirements of Art. 83 EPC were thus not met. A disclosure could not be regarded as sufficient if and when it was only possible to reproduce the invention after repeated requests to the depository institution and by applying techniques considerably more sophisticated than those the latter recommended. Nor could the scope of the patent be restricted to what had been deposited, as the characteristics of the deposit differed from the written disclosure in the patent. The true characteristics of the monoclonal antibodies produced by the deposited hybridoma were nowhere described and thus not available to the public. Thus a mere deposit of a hybridoma without any corresponding written description did not provide a sufficient disclosure. Similar conclusions were reached in decisions **T 495/89** and **T 498/94**.

In **T 349/91** the board held that an application was not sufficiently enabling where a laborious screening process was necessary to produce a hybridoma cell line secreting an antibody corresponding to a specific deposited antibody.

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

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

With respect to the question whether the reproducibility of specific micro-organisms (eg plasmids or viral strains) was assured by the written description in the absence of a deposition, the board, after careful examination of the written disclosure, held in some cases that the information provided in the application was sufficient to lead the skilled person reliably to the same micro-organisms (**T 283/86**, **T 181/87**); in other cases it was not (**T 815/90**, **T 816/90**).

5.3.2 Procedural questions

(a) Identity of applicant and depositor

The previous EPO practice established by **T 118/87** (OJ 1991, 474) that the patent applicant and depositor must, in principle, be one and the same has been changed by the insertion of a sub-paragraph (d) into R. 28(1) EPC. Now biological material **may be deposited by a person other than the applicant** if the name and address of the depositor are stated in the application and a document is submitted satisfying the EPO that the latter has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the material being made available to the public in accordance with R. 28 EPC.

(b) Deficiency in deposit

R. 28(1) EPC stipulates that a culture of the micro-organism must have been deposited with a recognised depository institution not later than the date of filing of the application.

T 39/88 (OJ 1989, 499) affirmed the principle that one important purpose of R. 28 EPC is to make the availability of the deposited organisms independent of any consent by the depositor. The board observed that the proper way of bringing a deposit originally filed for another purpose (here a US application) into line with the requirements of the EPC system was to formally convert the deposit into a deposit under R. 28 EPC (in the case of a deposit made on the basis of a special agreement between the EPO and the depositary institution) or into a deposit under the Budapest Treaty (which automatically covers R. 28 EPC), as the case might be. See also decisions **T 239/87**, **T 90/88** and **T 106/88**.

(c) Late submission of deposit number

According to R. 28(1)(c) EPC, the application must state the depositary institution and the file number of the culture deposit. In decision **G 2/93** (OJ 1995, 275) the Enlarged Board of

Appeal held that the provisions of R. 28 EPC were subordinate to the requirements of Art. 83 EPC. The indication of the file number (accession number) of a culture deposit in a patent application was substantive because, under the EPC, it was instrumental in enabling a person skilled in the art to carry out the invention. The Enlarged Board therefore held that, contrary to the ruling in **J 8/87** (OJ 1989, 9), the information concerning the file number may not be submitted after expiry of the time limit set out in R. 28(2)(a) EPC (ie sixteen months after the date of filing of the application or, if priority is claimed, after the priority date).

See **T 227/97** (OJ 1999, 495) for the board's decision that reestablishment of rights may be available for the time limit set by R. 28(2)(a) EPC and R. 13bis.4 PCT.

6. The relationship between Article 83 EPC and Article 84 EPC

6.1 Article 83 EPC and support from the description

The patent claims must clearly define the subject-matter for which protection is sought under Art. 84 EPC. In **T 94/82** (OJ 1984, 75) it was held that this requirement was fulfilled in a claim to a product when the characteristics of the product were specified by parameters relating to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art. In such a product claim, it sufficed to state the physical properties of the product in terms of parameters, since it was not mandatory to give instructions in the claim itself as to how the product was to be obtained. The description, however, had to fulfil the requirements of Art. 83 EPC and thus enable the person skilled in the art to obtain the claimed product described in it (see also **T 487/89**, **T 297/90** and **T 541/97**).

It is of relevance whether a problem falls within Art. 83 EPC or Art. 84 EPC, as examination in respect of the requirements of Art. 83 EPC is still permitted during opposition proceedings, whereas in respect of Art.84 EPC it is limited during opposition proceedings to those cases where there has been an amendment (**T 127/85** (OJ 1989, 271), see also **T 301/87** (OJ 1990, 335, reasons, 3)). For examination in respect of Art. 84 EPC during opposition proceedings see p. 484.

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

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

The invention at issue in **T 409/91** related to mineral oils containing paraffin wax such as diesel fuel. In the description of the application in suit the use of certain additives was presented as an essential constituent of the fuel oil composition, but this feature was missing in the claims. The board found that the claims defined some other invention which was not supported by the description.

In the inter partes case **T 435/91** (OJ 1995, 188), one of the essential technical features of claim 1, an additive which forced a detergent composition into the hexagonal liquid crystal phase, was defined only by its function. The patentee admitted that it was not possible to identify, on the basis of the information contained in the patent specification or of common general knowledge, compounds other than those specifically mentioned as bringing about the desired effect. The board was of the opinion that the compositions must all be available to the skilled person if the definition was to meet the requirements of Art. 83 EPC.

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

6.2 Article 83 EPC and clarity of claims

When undefined parameters are used in the claims and no details of the measuring methods are supplied, the question arises whether there is a problem with respect to Art. 83 EPC or Art. 84 EPC. The answer to this question is important because in opposition proceedings the patent can be examined for compliance with Art. 83 EPC without restriction. Examination for compliance with Art. 84 EPC is limited to cases where there has been an amendment.

In some decisions (**T 123/85**, **T 124/85**, **T 172/87**, **T 358/88**, **T 449/90**, **T 148/91**, **T 267/91**, **T 697/91**, all inter partes proceedings) the absence of information in the application on methods for measuring undetermined parameters in the application was considered a problem with respect to Art. 83 EPC. This problem was also addressed with reference to Art. 83 EPC in two ex parte proceedings, (**T 122/89** of 5.2.1991 and **T 503/92**). In **T 860/93** (OJ 1995, 47), also ex parte proceedings, it was decided that the absence of methods for measuring a relative quality in the claim was a problem with respect to the clarity of the claim under Art. 84 EPC (see also **T 230/87**, **T 176/91**, **T 917/92**).

In **T 1055/92** (OJ 1995, 214) the examining division had rejected the patent application under Art. 84 EPC because **in the claim** it was not clear how certain values were to be computed. The board held that the requirements of Art. 84 EPC, that the claims shall define the matter for which protection is sought, should be clearly distinguished from the requirement under Art.

83 EPC that the European patent application must disclose the invention in such a way that it enables a person skilled in the art to carry out that same invention. Under Art. 83 EPC, sufficient disclosure is required of a European patent application, ie of the application as a whole, comprising the claims, together with the description and the drawings, but not of an individual claim as such. A claim, on the other hand, must comprise the essential features of the invention; the essential features should comprise those features which distinguish the invention from the closest prior art. The primary function of a claim is to set out the scope of protection sought for an invention, which implies that it is not always necessary for a claim to identify technical features or steps in detail.

7. Evidence

In order to establish insufficiency, the burden of proof is upon an opponent to establish on the balance of probabilities that a skilled reader of the patent, using his common general knowledge, would be unable to carry out the invention (**T 182/89**, OJ 1991, 391). A mere statement that one of several examples in a patent has been repeated once "exactly as described" without obtaining exactly the results claimed in the patent is in principle inadequate to discharge that burden (see also **T 406/91**, **T 418/91**, **T 548/91** and **T 588/93**). For more details see the chapter on the burden of proof, p. 350 et seq.

As proof that an invention has been insufficiently disclosed, the boards require that the attempt to repeat it must fail despite following the conditions given in the examples. This requirement is not fulfilled where the opponent repeats the patented process under conditions covered by claim 1 but differing in many respects from those applying in the contested patent's examples (**T 665/90**).

An invention should be reproduced using the examples given. Insufficiency cannot be proven on the basis of laboratory trials when the only embodiment exemplified in the patent is an industrial fermentation process (**T 740/90**). The disclosure was also considered sufficient where the opponent had only used equivalents of the surfactants given in the patent, as he had not discharged his burden of proof (**T 406/91**).

B. Claims

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

As explained in decision **G 2/88** (OJ 1990, 93, corr. 469), Art. 84 EPC provides that the claims of a European patent application "shall define the matter for which protection is sought". R. 29(1) EPC further requires that the claims "shall define the matter for which protection is sought in terms of the technical features of the invention". The primary aim of the wording used in a claim must therefore be to satisfy such requirements, having regard to the particular nature of the invention, and the purpose of the claims. The purpose of claims under the EPC is to enable the protection conferred by the patent (or patent application) to be determined (Art. 69 EPC), and thus the rights of the patent owner within the designated contracting states (Art. 64 EPC), having regard to the patentability requirements of Art. 52 EPC to Art. 57 EPC. There are basically two different types of claim, namely a claim to a physical entity (eg product, apparatus) and a claim to a physical activity (eg method, process, use). These two basic types of claim are sometimes referred to as the two possible "categories" of claim. Within the above two basic types of claim various sub-classes are possible (eg a compound, a composition, a machine; or a manufacturing method, a process of producing a compound, a method of testing, etc.). Furthermore, claims including both features relating to physical activities and features relating to physical entities are also possible. There are no rigid lines of demarcation between the various possible forms of claim. The technical features of the invention are the physical features which are essential to it. The technical features of a claim to a physical entity are the physical parameters of the entity, and the technical features of a claim to an activity are the physical steps which define such activity.

G 2/88 was followed by the board of appeal in **T 337/95** (OJ 1996, 628), which confirmed that claims had to be clear for the sake of legal certainty, as their purpose was to enable the protection conferred by the patent to be determined (see also **T 338/95)**.

1. Clarity

1.1 Text of the claims

1.1.1 General principles

The protection sought should normally be indicated in the claims by technical features (see **T 4/80**, (OJ 1982, 149)). Furthermore the claims, per se, must be free of contradiction (see **T 2/80**, (OJ 1981, 431)).

Moreover, in decision **T 165/84** it was considered that the claims lacked clarity if the exact distinctions which delimited the scope of protection could not be learnt from them. Similarly, in **T 480/98** the board considered that a trade mark product referred to in the characterising portion of Claim 1 did not have a clear technical meaning, in that it could refer to a plurality of products having different compositions and properties. In consequence there was a lack of clarity, and the claim was not allowable.

In decision **T 94/82** (OJ 1984, 75) the board ruled that the requirement of clarity could be fulfilled in a claim to a product if the characteristics of the product were specified by parameters related to the physical structure of the product, provided that those parameters could be clearly and reliably determined by objective procedures which were usual in the art (see also **T 452/91**).

However, complexity as such is not equivalent to a lack of clarity - clarity under Art. 84 EPC is not at stake in a case of mere complexity of a claim provided the subject-matter for which the protection is sought and the scope thereof are clear and unambiguous for a person skilled in the art, either per se or in the light of the description (**T 574/96**).

In addition, the boards established two further general principles with regard to the requirements to be met by the text of the claims - in **T 150/82** (OJ 1984, 309) the board ruled that claims relying on references to the description in the specification in respect of all their technical features (so called "omnibus claims") were unallowable as contrary to R. 29(4) EPC and R. 29(6) EPC, unless absolutely necessary, eg when a plurality of conditions would not lend themselves to verbal expression without such a reference. Examples of such exceptions included inventions containing features or limitations which could only be expressed by means of drawings or graphs defining a particular shape or a plurality of conditions.

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

On the other hand, in **T 237/84** (OJ 1987, 309), the board stated that the purpose of reference signs in a claim (R. 29(7) EPC) was to make the claims easier for all to understand. They did not limit the scope of the claim but did affect its clarity and might enable it to be expressed more concisely than would otherwise be possible. In **T 986/97** the board allowed a reference to the drawings.

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

1.1.2 Essential features

In **T 115/83** and **T 32/82** (OJ 1984, 354) it was stated that Art. 84 EPC had to be interpreted as meaning not only that a claim had to be comprehensible from a technical point of view, but also that it had to define clearly the object of the invention, that is to say indicate all the **essential** features thereof. All features which were necessary for solving the technical problem with which the application was concerned had to be regarded as essential features. Both decisions were confirmed in **T 269/87** and **T 409/91** (OJ 1994, 653).

In **T 409/91** the invention related to mineral oils containing paraffin wax such as diesel fuel. The inventors found that waxy fuels having wax crystals of sufficiently small size at low temperatures to pass through paper filters used in diesel engines could be obtained by using additives with a structure described in the application by a general formula. The claims did not mention the additives.

The board held that the claims did not define the matter for which protection was sought by reference to **all** its essential technical features as required by Art. 84 EPC, first sentence: in the description of the application in suit the use of certain additives was presented as an essential constituent of the fuel oil composition. As this feature was missing in the claims, the board found that they defined some other invention which was not sufficiently disclosed. The board further held that the requirement that the claims be supported by the description (Art. 84 EPC, second sentence) reflected the general legal principle that the extent of a patent monopoly, as defined by the claims, should correspond to the technical contribution to the art. Claims should not therefore extend to subject-matter which would still not be at the disposal of a skilled person after reading the description. Consequently, a technical feature described and highlighted in the description as being an essential feature of the invention also had to be part of the claims.

The board's opinion in **T 32/82** was also confirmed in **T 622/90**, where it was held that lack of clarity could be caused not only by the presence of an ambiguous feature, but also by the absence of a feature which was necessary for clarity (see also **T 630/93** in 1.1.3 below (p. 160)).

In **T 586/97** the claim directed to an aerosol composition mentioned the feature 'active ingredient', which was neither defined in the description nor was a generally applicable qualitative definition known. The applicant's argument that the active ingredient was there to satisfy the function of the composition could not overcome the board's clarity objection, because this intended function was no technical feature characterising the claimed composition.

1.1.3 Clarity of broad claims

It was stated in decision **T 238/88** (OJ 1992, 709) that the clarity of a claim is not diminished by the mere breadth of a term of art (eg "alkyl") contained in it, if the meaning of such term - either per se or in the light of the description - is unambiguous for a person skilled in the art. (With regard to the problem of the interpretation of claims in general, see p. 168 et seq.).

In **T 523/91** the board held that the wording "plastics in combination with inserts" and "this insert is combined with the plastics granules in a wound or folded manner" did not cause the subject-matter of the claim to be unclear within the meaning of Art. 84 EPC. Although the nature of the combination covered many possibilities, the resulting subject-matter of the claim was broad rather than unclear. The broadness of a claim could not be contested on its own but only in conjunction with other criteria such as novelty, inventive step or reproducibility.

Likewise in **T 688/91** the board stated that a broad claim was not to be equated with one lacking clarity. In this instance the claim was worded as follows: "Integrated microprogrammed apparatus ... with apparatus to generate the T-states T0 ..., T1 ..., ... characterised in that ... the generation both of the T-states T0, T1 ... and of the further T-states ... is in each case effected as a function of preceding T-states and of state parameters **such as** the instantaneous values of state and/or mode signals and ...". The board held that, even if the words "such as" were understood to mean "for example", with the result that the subsequent information was not to be interpreted in a restrictive sense, the words "state parameters" were clear in as much as they conveyed the fact that T-state generation was to be effected as a function of any parameters representing one of the states of the apparatus. Although the claim was to be regarded as broad, since the terms used were open to general interpretation, breadth was not to be equated with an absence of clarity.

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

1.1.4 Categories of claim

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

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

In **T 426/89** (OJ 1992, 172) the board decided that a claim relating to a "method for operating" a device was not "clear" (Art. 84 EPC) if the claimed features only described how the device worked.

In **T 841/95** the board found that where a claim for an apparatus sought to define the invention by reference to features of the use to which the apparatus was to be put, a lack of clarity could result. However, if the subject-matter of the application was an apparatus and it was not viable to define the apparatus other than by reference to the said use, an apparatus claim directed to a combination of apparatus and use and defining the apparatus unambiguously could be clear.

In case **T 410/96** concerning a data processing system the question arose whether it was permissible for a claim to a system to refer back to a claim to a method. The examining division had refused the application on the ground that such a claim was an independent claim and must therefore define all the essential features of the invention. The board held that, although R. 29(4) EPC mentioned a reference only in the context of a claim including all the features of the claim it referred to, this did not imply a contrario that a reference which did not fulfil this condition was necessarily impermissible. The board found that there was no a priori objection under Art. 84 EPC to an independent claim which partially drew its features from preceding claims of a different category. The essential features were thus incorporated in the disputed claim by reference, the claim thus complying with R. 29(3) EPC.

1.2 Exceptions to the principles

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

1.2.1 Admissibility of disclaimer

(a) General

In accordance with decision **T 4/80** (OJ 1982, 149), disclaimers are admissible if the subject-matter remaining in the claim cannot technically be defined directly more clearly and concisely.

This principle was confirmed in decision **T 433/86** and the cases where disclaimers are applied were specified in greater detail: when there is an overlap between the prior art and the claimed subject-matter defined in generic terms, a specific prior art may be excluded even in the absence of support for the excluded matter in the original documents. Such an exclusion may be achieved by way of a disclaimer or, preferably, in positive terms if this leads to clearer and more concise language. See also **T 173/96**.

The same principles apply when a smaller partial area of the generally defined subject-matter of the invention is to be excluded not in view of the state of the art but because it does not solve the technical problem (see **T 313/86**, **T 623/91** and **T 1050/93**).

However, in **T 323/97** (OJ 2002, ***) the board held that an amendment to a patent by the introduction of a “negative” technical feature into a claim resulting in the exclusion of certain embodiments was, regardless of the name “disclaimer”, none the less an amendment governed by Art. 123(2) EPC and Art. 123(3) EPC.

By way of obiter dictum, the board added that the practice of permitting disclaimers having no support in the application as filed to make a claimed subject-matter novel by delimiting it against an accidental anticipation could not be maintained in the light of the Enlarged Board of Appeal’s opinion **G 2/98** (OJ 2001, 413).

Any amendment of a claim not having support in the application as filed and aiming at distancing the claimed subject-matter further from the state of the art, in particular by way of a disclaimer, contravened Art. 123(2) EPC.

In **T 124/90**, where the excluded subject-matter reflected an enabling aspect of the disclosure, the board allowed the disclaimer even though its terms were more comprehensive than the specific prior art excluded.

However, a disclaimer introduced in order to establish novelty should exclude only that subject-matter which is disclosed in the state of the art (**T 434/92**, **T 653/92** and **T 426/94**).

In **T 11/89** the board held that claims containing a disclaimer should clearly have shown the technical features by which the claimed subject-matter was distinguished from the excluded subject-matter. The publication number of a patent specification was obviously not a technical feature and was therefore not appropriate for determining the scope of a disclaimer. The claim in question was of the type "X-derivatives of the general formula I ... with the exception of the X-derivatives of the general formula I disclosed in patent specification N°...".

(b) Novelty and inventive step

In **T 188/83** (OJ 1984, 555) the board made it clear that the range was not rendered novel by the fact that the values calculated from the examples described in a citation were accepted by means of a disclaimer if these values could not be regarded as individual.

In **T 170/87** (OJ 1989, 441) the board established that a disclaimer could render new an inventive teaching which overlapped the state of the art, but could not impart inventive step to a teaching which was obvious (see also **T 857/91** and **T 710/92**).

In **T 597/92** (OJ 1996, 135) the board confirmed this, stating that there was no basis in the EPC for the substantiation of inventive step by way of a disclaimer. This method might only be used by way of exception for avoiding anticipation, if the subject-matter of a claim could not be restricted on the basis of the original disclosure in positive terms without unduly impairing its clarity and conciseness. A hypothetical novelty attack in possible proceedings before a national court, unsupported by pleadings or evidence on file before the EPO, was not a sufficient reason under the EPC for allowing a disclaimer. This decision was confirmed in **T 653/92**.

(c) Application to ranges

In **T 623/91** the board stated that the effect relied upon for patentability had to operate throughout the whole range of compositions being claimed and if the evidence before the board showed that this was not the case, albeit only in a minority or an extremely small proportion of instances, the compositions which did not provide the effect had to be disclaimed. The board concluded that the exclusion of a composition by reference to the trade mark or trade designation would not introduce uncertainty and therefore not offend against Art. 84 EPC, as changes in the range of chemical composition would not be likely without a corresponding change in the trade name or trade mark.

1.2.2 Broad claims

(a) Functional features

In **T 68/85** (OJ 1987, 228) the board found that functional features defining a technical result were permissible in a claim if, from an objective viewpoint, such features could not otherwise be defined more precisely without restricting the scope of the invention, and if these features provided instructions which were sufficiently clear for the expert to reduce them to practice without undue burden, if necessary with reasonable experiments. The board further pointed out that the effort to define a feature in functional terms had to stop short where it jeopardised the clarity of a claim as required by Art. 84 EPC. The following decisions agreed with these findings: **T 139/85**, **T 292/85** (OJ 1989, 275), **T 293/85**, **T 299/86** (OJ 1988, 88), **T 322/87**, **T 418/89** (OJ 1993, 20), **T 707/89**, **T 752/90**, **T 822/91**, **T 281/92**, **T 488/92** and **T 104/93**.

T 332/87 offers an interpretation of the Guidelines C-III, 4.8 where it is said that a claim directed to a product for a particular use has to be construed as defining a product suitable for this use. According to the board this meant only that it might be admissible in appropriate cases to introduce functional language into a claim for defining a product. However, a product defined inter alia by means of a functional feature could only be considered as novel if this functional feature differentiated the product in substance from known products.

In **T 361/88** the board distinguished between two types of functional feature as follows: "... the first type of functional feature is related to process steps which are known to the man skilled in the art and may easily be performed in order to obtain the desired result ... the second type of functional feature consists of process steps defined by the result which is aimed at. This is also allowable as long as the man skilled in the art knows, without exceeding his normal skills and knowledge, what he has to do in order to obtain said result. Another situation arises if said result is obtained for the first time, in which case the man skilled in the art does not know how to achieve the result."

In **T 243/91** it was stated that a functional feature was allowable if that feature provided a clear instruction to a skilled person to reduce it to practice without undue burden. In **T 893/90** the feature "being present in amounts and proportions just sufficient to arrest bleeding" was held to be a functional feature which defined a technical result which also constituted a testable criterion to be satisfied by the claimed pharmaceutical composition. Because such testing involved only routine trials, the adopted functional language was allowable. The introduction of a reference to specific amounts and/or proportions of the components would limit the claim and was not necessary.

The situation in **T 893/90** was distinguished from the one before the board in **T 181/96**. Although in the former case the testing might appear prima facie bothersome, it was nothing out of the ordinary for the field of medicine, involving only routine trials, so no limitation was necessary. In the case in suit, however, which concerned an apparatus for hydrostatically testing a sealing element of a threaded connection between two connected sections of pipe, there was no general type of pipe connections with generally well-defined ranges of dimensions which were thus generally available for verification of the functional features as such.

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

In case **T 720/92** the application was refused inter alia because claim 1 was held not to be clear since it used the obscure terms "metal promoted oxidation" and "oxidizable organic polymer"; the indication of a maximum oxygen permeance was considered a definition by the result to be achieved which could not represent a technical feature. The board disagreed, holding that the term "clarity" in Art. 84 EPC referred to the practical meaning of the language of the patent claims. Claims with functional features which did not enable the skilled person to carry out the invention in the light of the disclosure and on the basis of common general knowledge did not meet the requirement of clarity according to Art. 84 EPC. However, a claim combining functional definitions limited to features, which a skilled person would have had no difficulty in determining on the basis of common general knowledge, and a structural definition of the essential contribution to the art was not contrary to Art. 84 EPC.

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

In **T 241/95** (OJ 2001, 103) the Swiss-type second medical use claim defined the disease or disorder to be treated with substance X as “condition which is capable of being improved or prevented by selective occupation of the serotonin receptor”. The board held that this functional definition was unclear because no test was at hand to determine whether the therapeutic effects were a result of the newly discovered property of X of occupying the serotonin receptor or any other known or unknown property of that substance.

(b) Unspecified features

Unspecified features are permitted as follows:

(aa) To avoid an undue limitation of the scope of the claim where the person skilled in the art can verify the result by tests involving nothing more than trial and error (**T 88/87**).

(bb) To render the meaning of the feature intelligible from the actual claim.

Thus, the objection in case **T 487/89** was based on the fact that the claim had indicated both tenacity and toughness with a lower but no upper limit. The opposition division took the view that such "open-ended" parameters were always objectionable if they related to an inherently desirable characteristic. The board, however, held that whether the absence of an upper or lower limit was acceptable in a claim in any individual case depended on all the surrounding circumstances. Where, as in the case in question, the claim sought to embrace values as high as could be attained above a specified minimum level, given the other parameters of the claim, then such open-ended parameters could not normally be objected to. This decision was confirmed by **T 129/88** (OJ 1993, 598), **T 87/84**, **T 92/84** and **T 136/84**.

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

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

(a) a length which corresponds at least to the circumference of the shell face of the pressing to be covered,

(b) an overall breadth sufficient to cover the shell face and both end faces of the pressing, and

(c) a fold such that ... the breadth ... corresponds to the breadth of the shell face of the pressing ...".

The board did not see this as a breach of Art. 84 EPC, since reference had been made to a physical entity which was known; hence the range of sizes was definable in so far as it excluded packaging materials for other physical entities. Furthermore, it was self-evident to a skilled person in this field that the size of the packaging material (the covering) was dependent on the physical entity to be packed (for the interpretation of claims see p. 168).

2. Conciseness

In **T 79/91** the board stated that lack of clarity of the claims as a whole could arise from lack of conciseness. The invention in this case had been set out in at least ten independent claims of different scope. The board was of the opinion that this presentation made it difficult, if not impossible, to determine the matter for which protection was sought, and placed an undue burden on others seeking to establish the extent of the monopoly. Citing this case, the board found in **T 596/97** that, prima facie, a total of seven independent claims could be undesirable for reasons of conciseness and clarity. However, on the facts of the specific case before it, the board found the independent claims to be acceptable.

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

However, where a single main claim having to present a multiplicity of alternatives corresponding to the plurality of processes claimed would have lacked clarity, multiple claims could be concise within the meaning of Art. 84 EPC (**T 350/93)**. Overlapping method and use claims were allowed by the board in **T 433/99**, as the emphasis and thus scope of the claims was slightly different. Moreover, such a method allowed for differences in claim interpretation in the different contracting states of the EPC, particularly during infringement and revocation proceedings in national courts, where opportunities for amendment were limited. The Guidelines for Examination at the EPO, C-III, 3.2 also discouraged an over-academic or rigid approach to the presence of claims that were differently worded but apparently of similar effect.

3. Claims supported by the description

Art. 84 EPC stipulates that the claims must be supported by the description. This requirement means that the subject-matter of the claim must be taken from the description and it is not admissible to claim something which is not described.

In decision **T 133/85** (OJ 1988, 441) the board took the view that a claim which did not include a feature described in the application (on the proper interpretation of the description) as an essential feature of the invention, and which was therefore inconsistent with the description, was not supported by the description for the purpose of Art. 84 EPC. See also **T 409/91** (OJ 1994, 653) above (p. 158).

In case **T 332/94** the board, confirming **T 409/91** (OJ 1994, 653), stated that the claims, in order to fulfil the requirement of Art. 84 EPC, had not only to contain all the features indicated as essential in the description, but had also to reflect the effective contribution to the art by enabling a skilled person, after reading the description of the application as filed, to carry out their teaching throughout the field to which they applied.

In **T 939/92** the board held that it did not follow from Art. 84 EPC that a claim was objectionable just because it was "unreasonably broad". The expression "supported by the description" meant that the technical features stated in the description as being essential features of the invention described must be the same as those used to define the invention in the claims, for otherwise the claims would not be true definitions but mere descriptions. The facts of the case in question differed from those underlying **T 409/91** and so an objection of lack of support could not be validly raised. In **T 586/97**, the board found that the absence from any independent claim of any upper limit on the amount of a particular detrimental but necessary component in the chemical composition claimed was at variance with the aim of the invention as set out in the description, namely, to decrease the percentage of the undesirable ingredient in the claimed composition. The claim was thus so broad it went beyond the scope of the invention as disclosed in the description.

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

In ex parte proceedings **T 484/92**, the board concluded that, in contrast to **T 409/91**, the requirement of support by the description had been met and the appellant was entitled to claim the alleged invention in broad functional terms, ie in terms of the desired end effect, because, having disclosed one mechanism for achieving that goal, there were alternative ways of performing the invention at the disposal of the person skilled in the art, which would become apparent to him upon reading the description, based on his common general knowledge (for the problem of the relationship between Art. 83 EPC and Art. 84 EPC see p. 154 et seq. above).

In **T 1055/92** the board stated that since the primary function of a claim was to set out the scope of protection sought for an invention this implied that it was not always necessary for a claim to identify technical features or steps in detail. This primary function of the claims should be clearly distinguished from the requirement that the European patent application had to disclose the invention in such a way that it enabled a person skilled in the art to carry out that same invention. The board considered that it was sufficient if the application as a whole described the necessary characteristics of an invention in a degree of detail such that a person skilled in the art could perform the invention. This requirement, however, related to Art. 83 EPC and was not relevant to Art. 84 EPC. Under Art. 83 EPC sufficient disclosure was required of a European patent application but not of an individual claim as such. A claim had to comprise the essential features of the invention; the essential features should in particular comprise those features which distinguished the invention from the closest prior art (see also **T 61/94)**.

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

In decision **T 435/89** an allegedly essential process feature was missing from the apparatus claim. The board held that a claim for an apparatus per se need not contain information about the most efficient way of operating it, ie process features. The apparatus and the process for its use were to be kept strictly separate.

Similarly, in **T 888/90** (OJ 1994, 162), the appellants had removed from their claim 1 a feature deemed to be necessary to the solution of the technical problem. The board stressed that the omission of a feature in a combination could mean that a claim related merely to a sub-combination of an invention. Such a sub-combination with no function other than that of an intermediary building block for providing an inventive full combination might also be patentable in principle, if expressly presented as such in the application as filed and if it otherwise satisfied all conditions for patentability. Such sub-combinations were analogous to intermediate compounds in a chemical synthesis. However, in the board's view, it could not be assumed that assemblies from the outset directly and unequivocally implied their own sub-combinations. Thus, without express disclosure in this respect, including the particular use, the support for such claims would be inadequate.

In **T 977/94** the board decided that if the patentee amended his claims he had also to bring the description into line with them, because of its fundamental importance. An invention was only claimable to the extent that it was supported by the description (Art. 84 EPC, second sentence), and the claims were interpreted in the light of the description (Art. 69 EPC). So it was necessary to check that the essential elements of the invention claimed were also described as such in the description.

4. Interpretation of claims

4.1 General

The skilled person, when considering a claim, should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity, ie building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Art. 69 EPC). The patent must be construed by a mind willing to understand, not a mind desirous of misunderstanding (**T 190/99**).

4.2 Meaning of terms

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

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

In **T 762/90** a lack of clarity was found in the use of a trade mark designating a whole series of products which differed from one another depending on phases in their industrial development. Moreover, the board expressed doubts about the use of such a designation, since it was uncertain whether the meaning of the trade mark would remain unaltered up to the end of the patent term (see also **T 939/92** on p. 166)

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

In **T 409/97** the board held that an erroneous statement in the introduction to the description was of no assistance in interpreting the claim and establishing the subject-matter for which protection was being sought, where this statement contradicted its actual content.

4.3 Relevance of Art. 69 EPC

The subject-matter of claims is governed by Art. 84 EPC and their function by Art. 69 EPC. According to Art. 84 EPC the claims define the invention for which protection is sought. Under Art. 69 EPC the claims determine the extent of the protection which will be conferred by the patent, through their definition of the invention. Under Art. 69 EPC the description and drawings are used to interpret the claims. The question arises whether it is possible to interpret the claims in the light of the description and drawings as provided in Art. 69 EPC merely in order to determine the extent of protection or whether it is also possible to do so in order to establish whether the conditions governing patentability and clarity have been satisfied.

In a number of decisions, such as **T 23/86** (OJ 1987, 316), **T 16/87** (OJ 1992, 212), **T 62/88**, **T 89/89**, **T 121/89**, **T 476/89**, **T 544/89**, **T 565/89** and **T 952/90**, the boards of appeal laid down the principle whereby the description and drawings are used to interpret the claims when an objective assessment of the content of a claim has to be made to judge whether its subject-matter is novel and not obvious. In decision **T 50/90** the board pointed out that the description and drawings are used to interpret relevant terms contained in the claims when the extent of protection has to be determined. In **T 238/88** the board stated that the fact that the features were not in fact usual terms of art does not rule out clarity and conciseness, since according to Art. 69 EPC the description should be used to interpret the claims.

In a large number of decisions (eg **T 23/84**, **T 327/87**, **T 238/88** (OJ 1992, 709), **T 416/88**, **T 194/89**, **T 264/89**, **T 430/89**, **T 472/89** and **T 606/91**), the boards interpreted the claims in the light of the description and drawings in order to establish whether they were clear and concise within the meaning of Art. 84 EPC and to determine the subject-matter of the patent.

In **T 1129/97** (OJ 2001, 273), the board held that the mere fact that the precise meaning of an unclear term ("low alkyl") was expressly disclosed in the description but not in the claims did not mean that the latter met the clarity requirement. The clarity stipulation under Art. 84 EPC concerned only the claims, and therefore - according to the established case law of the EPO boards of appeal - required that they be clear in themselves, without there being any need for the skilled person to refer to the description. True, under Art. 69(1) EPC the description was to be used to interpret the claims. But Art. 69 EPC concerned only the extent of protection where this was at issue, eg with third parties, and not (as in Art. 84 EPC) the definition of the matter to be protected by a claim.

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

In **T 2/80** (OJ 1981, 431), the board pointed out that a claim did not comply with the requirement of clarity laid down in Art. 84 EPC if it was not, per se, free of contradiction. It had to be possible to understand the claims without reference to the description.

In decision **T 454/89** the board shared this view and explained that Art. 84 EPC requires that claims must be clear in themselves when read using normal skills, including knowledge of the prior art but not any knowledge derived from the description contained in the patent application or the amended patent. While it was true that Art. 69 EPC allowed the description to be used to interpret the claims, it was only concerned with the extent of protection conferred as one of the effects of an application or patent whenever that extent had to be determined, particularly for third parties. It was not concerned with a claim's definition of the matter for which protection was sought, as was Art. 84 EPC. In the course of the examination of an opposition, therefore, the applicant or patentee could not rely on Art. 69 EPC as a substitute for an amendment which would be necessary to remedy a lack of clarity. The board took the same line in decision **T 760/90**.

In **T 728/98** (OJ 2001, 319) the board held that it followed from the requirement of legal certainty that a claim could not be considered clear within the meaning of Art. 84 EPC if it comprised an unclear technical feature (here “substantially pure”) for which no unequivocal generally accepted meaning existed in the relevant art. This applied all the more if the unclear feature was essential for delimiting the subject-matter claimed from the prior art. In this case the description did not give any indication as to how the term should be interpreted. See also **T 752/94**.

However, in **T 416/87** (OJ 1990, 415) the board was confronted with the situation where a feature was not included in the claims which the description on its proper interpretation specified to be an overriding requirement of the invention. The board held that, following Art. 69(1) EPC and its Protocol, the claims might be interpreted as requiring this as an essential feature, even though the wording of the claims when read in isolation did not specifically require such feature.

Likewise, in **T 860/93** (OJ 1995, 47) the board assumed that the description might be used to determine whether the claims were clear. It accepted the reasoning in **T 454/89,** namely that the description could only be used to determine the extent of the protection conferred and not to establish clarity, only in the case of claims which were self-contradictory, but not in general. See also **T 287/97**.

In **T 442/91** the respondents wanted the board to rule on the extent of the protection conferred by what they considered to be broad claims. The board, however, felt that it should not concern itself in opposition appeal proceedings with the extent of the protection conferred by a patent (except for the purposes of Art. 123(3) EPC), as this was the responsibility of the national courts dealing with infringement cases. Whilst the EPO made it clear how terms of art used in the claims should be understood, it should not proffer any further interpretation of the patent's future scope beyond that. See also **T 740/96**.

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

When the technical content of the claims and the description clearly establish how an invention operates, these features cannot be disregarded for the purposes of assessing patentability by interpreting them merely as defining an intended use (**T 458/96**).

5. Form of the claims

R. 29(1) EPC provides that claims must contain, wherever appropriate, a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art, and a characterising portion stating the technical features which, in combination with the features stated in the first part, it is desired to protect.

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

In decision **T 13/84** (OJ 1986, 253), the board ruled that a claim in two-part form had to be regarded as appropriate if a clearly defined state of the art existed from which the claimed subject-matter distinguished itself by further technical features. It could not be accepted as a general rule that the piece of prior art used for the preamble of the claim should be concerned with the same problem as the invention. Generally, the apparatus or process constituting the prior art which was nearest to the invention would have to figure in the preamble of the claim, stating such features of it as were necessary for the definition of the claimed subject-matter and which were in combination already part of this prior art. R. 29 EPC made no reference to the necessity or desirability that the characterising portion of the claim should fairly set out the inventive step. It was the subject-matter of the claim as a whole which embodied the invention and the inventive step involved. This decision was confirmed by **T 162/82** (OJ 1987, 533), where the board added that the extent to which prior art was cited in the description could not be a determining factor in deciding whether the one-part or the two-part form of a claim was appropriate in a given case. Likewise, in **T 850/90**, it was confirmed that examination for inventive step should also take account of the features in the preamble, since the invention was defined by the claims as a whole. In **T 980/95** it was held that there was no explicit requirement in R. 29(1)(a) EPC that a claim in two-part form be set up on the basis of the "closest" prior art, since the rule made no reference to the necessity or desirability for the characterising portion of the claim to set out the inventive step. Thus the mere fact that a particular state of the art turned out, in later proceedings, not to be the "closest" state of the art for the assessment of inventive step did not in itself result in a two-part form based on that art contravening R. 29(1)(a) EPC.

In **T 170/84** (OJ 1986, 400) it was pointed out that where a two-part claim would lead to a complex formulation it was no longer appropriate. In a one-part claim, the features required for the definition which belonged to the state of the art had to be sufficiently clear from the description. This principle has been upheld inter alia in **T 269/84**, **T 120/86**, **T 137/86** and **T 278/86**. The latter two decisions stipulated that a two-part claim was not justified if it gave an incorrect picture of the state of the art. In **T 735/89** the board did not accept a one-part claim because it gave the impression that there was no closer state of the art.

In **T 99/85** (OJ 1987, 413) the board held that in opposition proceedings there was no reason officially to insist on a change in the wording of the claim simply because one feature in the preamble to a two-part claim did not belong to the state of the art. Furthermore, the board saw R. 29(1) EPC as an implementing regulation which did not constitute a ground for opposition (a similar view was held in **T 168/85, T 4/87** and **T 429/88**).

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

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

6. Product-by-process claims

6.1 Introduction

Under Art. 64(2) EPC the protection conferred by a process patent extends to the products obtained directly by the process, even if they are not patentable per se. Certain applicants tried to acquire protection for known products by using process claims to define them and arguing thus - it follows from Art. 64(2) EPC, which expressly states that protection will be granted for the direct product of a patentable process, that, under the EPC, a product is rendered novel by the fact that it is produced by means of a new process. This is notwithstanding the fact that such product is not new per se, by virtue of its physical characteristics (see **T 248/85** (OJ 1986, 261), similarly **T 150/82** (OJ 1984, 309)).

The boards of appeal did not accept this line of argument and made a distinction between claims to a new and inventive product defined by its method of manufacture and claims to a new and inventive process, the protective effects of which also extended to the direct products of this process.

The first decision in this regard was **T 150/82** (OJ 1984, 309). The board stated that claims for products defined in terms of processes for their preparation (known as "product-by-process" claims) were admissible only if the products themselves fulfilled the requirements for patentability and there was no other information available in the application which could have enabled the applicant to define the product satisfactorily by reference to its composition, structure or some other testable parameter.

The boards of appeal have further clarified and developed these requirements in their case law.

6.2 Requirement that the claimed product must be patentable

In decision **T 248/85** (OJ 1986, 261) it was stated that a product could be defined by the use of various parameters, such as its structure or its process of preparation. The use of a different parameter by which to define a particular product could not by itself give the product novelty. Furthermore Art. 64(2) EPC did not confer novelty upon a claim which was formulated as a "product-by-process" when no novelty existed in such product per se, and did not entitle or enable an applicant for a European patent to include such claims in his patent which did not satisfy the requirements for patentability of Art. 52(1) EPC.

In **T 219/83** (OJ 1986, 211) the board stated that "product-by-process" claims had to be interpreted in an absolute sense, ie independently of the process. If their subject-matter as such was new, they still did not involve an inventive step merely because the process for their preparation did so. In order to be patentable, the claimed product as such had to be a solution to a separate technical problem which was not obvious in the light of the state of the art.

These criteria were confirmed by many decisions (see **T 251/85**, **T 434/87**, **T 171/88, T 563/89**, **T 493/90**), including **T 664/90**, where the board stated that "once the product itself is part of the state of the art and is thus not novel according to the criterion of novelty as set out in Art. 54(1) EPC, the fact of defining this product by reference to a new process is irrelevant to the question of novelty. The use of a different parameter for defining a known product does not confer novelty on the product".

The board clarified the conditions for novelty of product-by-process claims in decision **T 205/83** (OJ 1985, 363). It stated that the polymer product of a known chemical process was not rendered new merely by virtue of a modification to the process. If a chemical product could not be defined by structural characteristics but only by its method of manufacture, novelty could be established only if evidence was provided that modification of the process parameters resulted in other products. It was sufficient for this purpose if it was shown that distinct differences existed in the properties of the products. This evidence might not include properties which could not be due to the product's substance parameters (see also **T 279/84** and **T 151/95**).

In decision **T 300/89** (OJ 1991, 480) it was stated that the application lacked novelty if the claim neither defined the product structurally nor mentioned all the specific conditions needed to obtain necessarily the products whose novelty could be demonstrated, eg by means of comparative tests.

6.3 Requirement that the claimed product cannot be described in any other way

The criterion that it must be impossible to define the claimed product other than in terms of a process of manufacture was discussed specifically in the following decisions.

The board stated in decision **T 320/87** (OJ 1990, 71) that product-by-process claims were admissible for hybrid seeds and plants when they were not individually definable biological entities which could be characterised by their physiological or morphological features.

In decision **T 130/90** the board had to rule on recombinant monoclonal antibodies having two different specificities and produced by a process involving trioma cells formed by somatic cell fusion of a hybridoma cell and a lymphocyte or quadroma cells formed by somatic cell fusion of two hybridoma cells. The patentability of the process was not questioned; at issue was the validity of the product claim. The prior art did not disclose how fully re-associated molecules, ie with the same structure as native antibodies, which might be contained in the mixture of hybrids, could be screened out and isolated from molecules which might be bispecific but otherwise artificial because misfolding, mispairing or deamination might have occurred during the harsh chemical treatment of the starting materials. The board allowed a claim for bispecific recombinant monoclonal antibodies comprising intact immunological chains produced by the process claimed in the independent process claims of the patent in suit. Defining the antibodies by their process was the only way of delimiting them vis-à-vis the prior art. The board emphasised that the established case law of the boards of appeal, which states that a product is not rendered novel merely by the fact of being produced by means of a new process, was not called into question.

The board held in **T 487/89** that, although in general product-by-process claims were to be avoided, there might be circumstances where, although the product might be capable of being defined in terms of specific parameters, there were no such parameters available to the patentee for introduction into the claim, whereas process features taken from a sub-claim might overcome an objection of lack of novelty or lack of inventiveness.

In **T 552/91** (OJ 1995, 100) it was held that where a European patent application relates to chemical substances originally defined by an incorrect chemical structural formula, correction of which is not allowable under R. 88 EPC, replacement of the incorrect formula by the correct one infringes Art. 123(2) EPC (see p. 207). Nevertheless, the submission of a "product-by-process" claim is compatible with Art. 123(2) EPC if it contains all the measures required to obtain this result (starting materials, reaction conditions, separation).

6.4 Combination of product and process features

In decision **T 148/87** the board stated that it was admissible to combine product parameters and process parameters in the same claim. In **T 129/88** (OJ 1993, 598) the board was of the opinion that the inclusion in a product claim of one or more process features might be permissible if their presence was desirable having regard to the impact of the national laws of one or more contracting states.

6.5 Extension of protection conferred by product-by-process claims

In decision **T 411/89** the board had to decide whether the amendment of a product-by-process claim from "obtained" to "obtainable" extended the protection conferred by the patent. The board took the view that the protection was not extended because the amendment did not modify the definition of the product which was claimed per se from the beginning and because the process used for its characterisation remained the same.

In decision **T 423/89**, by restricting the claim to only one of a number of manufacturing processes specified in the original claim and disclosed in the description, the patent proprietors had ceased to claim absolute product protection and had undertaken a significant limitation of their claim. There were therefore no objections under Art. 123(3) EPC. The change in category from a product-by-process claim to a manufacturing process claim was also admissible in this case, as the protection afforded by the granted patent had to extend to all those methods of manufacture covered by the processes described in the claim and disclosed in the patent specification.

In **T 20/94**, however, objections under Art. 123(3) EPC led to the board's refusing a change from process claims to a product-by-process claim by way of amendment, as despite the fact that a product-by-process claim was characterized by the process for its preparation, it nevertheless belonged to the category of claim directed to a physical entity and was a claim directed to the product per se. The scope of protection conferred by a product claim exceeded the scope conferred by a process claim under Art. 64(2) EPC.

7. Claims fees

R. 31(1) EPC lays down that any European patent application comprising more than ten claims at the time of filing must, in respect of each claim over and above that number, incur payment of a claims fee.

The Legal Board of Appeal ruled in case **J 9/84** (OJ 1985, 233) that R. 31(1) EPC is to be interpreted as meaning that claims numbered 1 to 10 upon filing of the European patent application - or transmittal to the EPO of the international application under the PCT - were exempt from fees, and that claims numbered 11 onwards were not. Accordingly, abandoning a fee-exempt claim after filing - or transmittal - did not have the effect that its fee exemption was transferred to another claim.

The question has arisen on a number of occasions as to whether part of, or an annex to, the description of a European patent application comprising a series of numbered paragraphs drawn up in the form of claims should be regarded as claims for the purposes of R. 31(1) EPC.

In **J 5/87** (OJ 1987, 295) the application contained, under the heading "Claims", ten claims; however it contained 33 further claims which were annexed to the description as preferred, numbered embodiments presented in the form of claims. The addendum appeared in form as well as in substance only to consist of claims within the meaning of Art. 84 EPC and R. 29

EPC. Furthermore, the appellant had admitted that the addendum had been included in the application in order to maintain the possibility of making its content a basis for substantive examination. As a result, the applicant was required to pay a claims fee - applicants are not at liberty to ignore the provisions on the form and content of the description and claims contained in R. 27 EPC and R. 29 EPC.

In decision **J 15/88** (OJ 1990, 445), the board decided in a similar case that although the 117 disputed "clauses" in question were numbered and arranged as claims and seemed to define matter in terms of technical features, they were not to be regarded as such since the fact remained that they were never referred to as claims and there were claims elsewhere which were referred to as such.

Decisions **J 16/88**, **J 29/88**, **J 25/89**, **J 26/89**, **J 27/89**, **J 28/89**, **J 34/89** and **T 490/90** all confirmed this opinion, pointing out that the case dealt with in **J 5/87** differed from the others since the applicant had indicated an intention to regard the annexes as claims. The intention of the appellant not to have this part considered as claims is more important than the form of the text.

C. Unity of invention

1. Introduction

Under Art. 82 EPC, the European patent application may relate to one invention only or to a group of inventions so linked as to form a **single general inventive concept**. R. 30 EPC gives an interpretation of the concept of unity of invention where a group of inventions is claimed. This rule was amended by decision of the Administrative Council of the European Patent Organisation dated 7.12.90 (OJ 1991, 4), which entered into force on 1.6.91, but the principles set out by board of appeal case law can still be applied. The amended text of R. 30 EPC includes the minimum guarantees set out in the previous text of the rule (see Notice from the EPO dated 3.6.91, OJ 1991, 300).

The boards of appeal are responsible for judging unity of invention when they decide on a protest made by an applicant against an additional fee charged by the EPO as ISA or IPEA (see Art. 154(3) EPC, 155(3) EPC). Harmonisation of the definitions regarding the requirement of unity of invention in the PCT (R. 13 PCT, amended like R. 30 EPC) and the EPC (Art. 82 EPC together with R. 30 EPC) means that the criterion of unity of invention in both systems will be subject to uniform assessment by search examiners and boards of appeal alike. The principles involved in unity of invention will therefore be dealt with as one.

2. Plurality of independent claims

2.1 General issues

Under Art. 82 EPC and new R. 13.1 PCT, the international application must relate to one invention only or a group of inventions so linked as to form a single general inventive concept. The second of these alternatives, ie, the single-concept linked group, may give rise to a plurality of independent claims in the **same or different categories**.

In **W 5/92** the board considered it to be implicit in the definition of R. 13.1 PCT that the "invention" be considered in the broadest sense. Thus, according to Chapter VII, 5 of the PCT Search Guidelines (PCT Gazette No. 30/1992, Sec. IV; No. 29/1993, Sec. IV), the mere fact that an international application contained claims of different categories or several independent claims of the same category was in itself no reason for objection on the grounds of lack of unity of the invention.

2.2 Independent claims in different categories

R. 30(1) EPC and R. 13.2 PCT state that where a group of inventions is claimed in one and the same European patent application, the requirement of unity of invention referred to in Art. 82 EPC is fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The previous R. 30 EPC (old version in force until 31.5.91), like the previous R. 13 PCT, specified three cases in which a combination of independent claims in **different** categories was to be considered as having unity in the above-mentioned sense. The combinations were as follows:

(a) a product, a process adapted for the manufacture of the product and a use of the product;
(b) a process and an apparatus for carrying out the process;
(c) a product, a process for its manufacture and an apparatus for carrying out the process.

The list was not exhaustive and other combinations were permitted if they had met the requirements of Art. 82 EPC (**T 861/92**). The same applied to the old version of R. 13.2 PCT (**W 3/88** (OJ 1990, 126), **W 28/88**, **W 3/89**). In **T 702/93** it was held that this old version of R. 30 EPC did not provide for such a fictitious unity in case of independent claims in the **same** category.

The principles laid down in previous board rulings on unity of invention were based on this fiction, which no longer exists now that R. 30 EPC and R. 13 PCT have been amended. However, as decision **W 13/89** expressly stressed, the principles set out in this case law remain unchanged (see also **T 169/96**).

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

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

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

In **W 32/88** (OJ 1990, 138) the board was of the opinion that an invitation to pay an additional fee on the grounds that an international application concerning a process and an apparatus related to two different inventions, whereas the **apparatus was specifically designed for carrying out the process**, had no legal basis, even if the claims for the apparatus were not restricted to such use (see also **W 16/89**).

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

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

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

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

3. Dependent claims

R. 13.4 PCT expressly provides that dependent claims must fulfil the requirement of unity in accordance with R. 13.1 PCT. The EPC makes no comparable express provision. The question has therefore arisen as to whether dependent claims have to be treated differently under the two provisions. Board of appeal case law on PCT cases has been uniform: the boards have repeatedly confirmed the principle that the requirement of unity must also be met by dependent claims (see inter alia **W 3/87**, **W 2/88**, **W 30/89**, **W 32/89**, **W 26/90**, **W 8/91** and **W 54/91**). In EPC cases the boards likewise assume that dependent claims have to meet the requirement of unity. As distinct from the PCT procedure, under the EPC the approach is not as strict as in the case of independent claims, where the examination is always carried out in accordance with the express requirement, but only in those cases where unity could be problematical (see **T 140/83** and **T 249/89**).

In **W 8/91** it was decided that, where claims were formally dependent, the ISA had to **state expressly** why they lacked unity; it was not enough simply to say that this was shown directly by the subject-matter as defined by the ISA.

In **W 6/98** the board held that anticipation of the subject-matter of an independent claim might well lead to a situation of non-unity a posteriori, which however could only be established by showing that there was indeed no unifying novel inventive concept common to all dependent claims. The board noted that lack of novelty of the subject-matter of an independent claim did not automatically lead to a posteriori lack of unity for the claims directly or indirectly appended to said independent claim. This became immediately apparent when two specific cases were considered: if all the associated dependent claims only referred back to their respective preceding claim, then lack of novelty of the subject-matter of the corresponding independent claim could not cause a situation of non-unity on an a posteriori basis since in an assessment of unity the first novel dependent claim would replace the independent claim, the remaining claims being then dependent on said first novel dependent claim (see Annex B to the Administrative Instructions, Part 1(c)(i), published in PCT Gazette Section IV No. 24/1996, 9474). On the other hand, if each of the dependent claims directly referred back to a fully anticipated independent claim, then there might be lack of unity a posteriori, but only in case there was no inventive link between the remaining dependent claims, which issue had to be carefully considered (see Annex B to the Administrative Instructions, Part 1(c)(ii)). An analogous conclusion could be drawn from the passage of the above-mentioned PCT Guidelines cited in the IPEA's invitation: "If the common matter of the independent claims is well known and the remaining subject-matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention

4. Intermediate products

In **T 57/82** (OJ 1982, 306) it was stressed that the subject-matter of an application relating to new chemical end-products, processes for their preparation, and to new intermediates for those end-products at all events had unity within the meaning of Art. 82 EPC if all these subject-matters were technically interconnected and integrated into a single overall concept by being oriented towards the end-products. In this context, starting materials which were used in a process for preparing end-products and which were themselves products of a disclosed, albeit unclaimed, production process were also considered to be intermediates. This principle was confirmed in **T 110/82** (OJ 1983, 274) for low-molecular products. According to that board, an invention relating to new low-molecular end-products and to several groups of new low-molecular intermediates invariably had unity if the groups of intermediates prepared and oriented towards the end-products were technically closely interconnected with the end-products by the incorporation of an essential structural element into the end-products and if due account was taken of the regulatory function of Art. 82 EPC (prohibition of unjustified saving of fees, need for ready comprehensibility).

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

In **W 35/91** the board ruled that the requirements of unity of invention as set out in R. 13.1 PCT and R. 13.2 PCT were met if the novel intermediates designed to give rise to the novel end-products were technically sufficiently closely related by their contribution to an essential structural element of the end-products.

In **W 7/85** (OJ 1988, 211) the board stated that there was sufficient technical information to justify a prima facie finding of unity of invention between a claim to a **mixture** and a claim to one essential component of that mixture or a narrowly defined version thereof. If a finding of unity was justified in cases of chemical intermediates and end-products even when, as was often the case, only a part of the intermediate structure was actually incorporated, there was all the more reason to view the intact components and the corresponding compositions in a mixture as technically interconnected by incorporation. The former were not even destroyed when the admixture was prepared and fully retained their properties and functions in the product, unlike typical intermediates, which lost their identity in the process. Thus, both inventions could be considered to fall within the same general inventive concept. In such cases the requirement that the means for preparing the end-product should be "specially designed for carrying out the process" appeared to be fulfilled since none of the means led or was related to an end-product outside the scope of its definition. In view of this the character of the invention in the component was, prima facie, also dependent on the existence of an invention in the end-product.

5. Basis for lack of unity assessment

5.1 General issues

According to Art. 3(4)(iii) PCT, an international application must comply with "the prescribed requirement of unity of invention".

The determination of unity of invention must be made on the basis of the contents of the claims as interpreted in the light of the description and of the drawings, if applicable (Part 1(b) of Annex B of the Administrative Instructions under the PCT, which are binding not only on the ISA but also on the board of appeal acting as the "three-member board" according to R. 40.2(c) and (e) PCT (see decision **G 1/89** (OJ 1991, 155) and **W 6/97**).

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

Neither in the PCT itself, nor in the Rules under the PCT, were there any provisions specifying how to decide whether or not an international application complied with the prescribed requirement of unity of invention. However, in the PCT Search Guidelines, it was stated, inter alia, that lack of unity of invention might be directly evident "a priori", ie before considering the claims in relation to any prior art, or might only become apparent "a posteriori", ie after taking prior art into consideration (**G 1/89**, OJ 1991, 155).

5.2 Assessment of lack of unity by the International Search Authority

Lack of unity may be directly evident a priori, ie before the examination of the merits of the claims in comparison with the state of the art revealed by the search (**W 1/96** and **W 6/90**, OJ 1991, 438). If the objection of lack of unity of invention is raised a priori, the technical problem must be defined solely on the basis of the description and not of the prior art (see **W 50/91**, **W 22/92** and **W 52/92**).

For international applications the question arose as to whether the ISA had the power to assess unity of invention a posteriori, ie after an examination of the application. In **W 3/88** (OJ 1990, 126) the board had answered this question in the negative, interpreting the expression "a single general inventive concept" of R. 13.1 PCT as being simply the general concept of what the applicant subjectively claimed to be his invention. By contrast, in **W 44/88** (OJ 1990, 140) and **W 35/88**, the answer was in the affirmative. In the latter cases the boards had referred to the PCT Search Guidelines which permitted assessment of unity a posteriori. Both a board of appeal and the President of the EPO had then referred the question to the Enlarged Board of Appeal (**G 1/89** and **G 2/89**).

The Enlarged Board of Appeal delivered a decision in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166). It decided that the EPO in its capacity as an ISA might, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application was considered to lack unity of invention a posteriori. The Enlarged Board first noted that the problems involved were mainly due to the fact that, under the PCT, as well as under the EPC, search and (substantive) examination were carried out in sequentially different steps and by different examiners. This procedural separation of search and examination led inevitably to a certain overlapping, because of the functional relationship between search and examination. Thus, although the objective of the search was in principle limited to discovering and reporting on relevant prior art for the purpose of assessing novelty and inventive step, which was ultimately the task of the examining authority (ie the IPEA and/or the designated Office under the PCT and the examining division under the EPC respectively), it was obvious that in many instances the search examiner needed to form a provisional opinion on these issues in order to carry out an effective search. Otherwise, he would simply be at a loss how to judge the relevance of the documents in the prior art and how to arrange the search report accordingly. This overlapping was inherent in the PCT and the EPC and was in contrast to the system of most national patent laws, where search and examination were carried out in one combined operation, normally by the same examiner, and where consequently there was no separation of fees for search and examination as under the PCT and the EPC. It further noted that the requirement of unity of invention under the PCT applied equally to the procedure before the ISA and to the procedure before the IPEA according to Art. 17(3)(a) PCT and Art. 34(3)(a) PCT, which was in conformity with the procedural separation of search and examination as referred to above and reflected the principle that the normal fees for search and examination were related to one invention (or a single general inventive concept) only. This led, in the view of the Enlarged Board, to the conclusion that the requirement of unity of invention under the PCT had in principle to be judged by the **same objective criteria** by both the ISA and the IPEA.

The Enlarged Board observed that the PCT Search Guidelines contained a direct reference to the consideration of unity of invention by the ISA on an a posteriori basis, ie after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. A comparison with the corresponding EPO Guidelines, which was of particular interest in this context because of the similarity of the PCT and the EPC in respect of the separation of search and examination, showed that under the EPC it was also clearly foreseen that consideration of unity of invention by the search divisions might be carried out on an a posteriori basis (B-VII, 5; see R. 46 EPC). In the view of the Enlarged Board, this was a consequence of the special structure of the PCT and the EPC. Therefore, the guidelines had on this point to be considered as consistent with the PCT and the EPC. As to the PCT Search Guidelines, it was noted that such guidelines were based on Art. 56 PCT dealing with the task of the Committee for Technical Cooperation (see in particular Art. 56(3)(ii) PCT and the reference to the need for uniformity of, inter alia working methods). The PCT Search Guidelines, Chapter VII, 9 (PCT Gazette No. 30/1992, 14025), set out how this was to be applied in practice and were the basis for a uniform practice on the part of all International Searching Authorities.

In **W 21/89** the board found that since, under the terms of R. 33.1(a) PCT, the prior art consisted of everything that had been made available to the public before the date of filing of the international application, the ISA could use such documents as grounds for a decision of lack of unity a posteriori even if it was not possible to cite these documents against a corresponding national patent application in one of the contracting states designated.

5.3 Assessment of lack of unity in examination proceedings

According to the wording of Art. 82 EPC the requirement of unity of invention has to be satisfied not only by the patent application as filed but also by the patent application at later stages of the patent granting procedure, ie before the examining division, until grant of the patent. R. 46(2) EPC refers to the possibility that the examining division might disagree with the search division concerning lack of unity of a particular patent application and that then the examining division's opinion is decisive in that the latter may order refund of any further search fee at the applicant's request. It lies within the discretion given to the examining division to decide that a patent application lacks unity of invention within the meaning of Art. 82 EPC, even if the search division did not raise a similar objection under R. 46.1 EPC (**T 178/84** (OJ 1989, 157).

In **T 87/88** (OJ 1993, 430) the board noted that the Enlarged Board of Appeal had ruled that when the EPO carries out an international search, an international application may also be considered, under Art. 17(3)(a) PCT, not to comply with the requirement of unity of invention "a posteriori", ie after prior art is taken into consideration and a provisional opinion on novelty and inventive step is thereby formed (**G 1/89** (OJ 1991, 155), **G 2/89** (OJ 1991, 166)). This principle applied equally when carrying out a European search (Art. 92 EPC) because in both cases the searches and search reports were virtually identical (see Guidelines B-III, 4.4). The appellants' objection that a search division was not entitled to decide that the claimed invention lacked unity "a posteriori" as well was therefore unfounded.

In **T 94/91** it was added that Art. 82 EPC clearly provided that European patent applications must satisfy the criteria of unity of invention without any restriction. There was no difference in the EPC between "a priori" and "a posteriori" lack of unity. Therefore, European patent applications had to fulfil the condition of unity and it was of no importance whether the non-unity appeared immediately or only in view of a document found during the search or during the examination.

In **T 544/88** (OJ 1990, 429) the board ruled that if an applicant, in response to an objection of lack of unity under Art. 82 EPC, filed new claims allegedly relating to an invention meeting the unity requirement, examination should be continued even if the other application documents had not been limited to the subject-matter of those claims. However, the examining division might request the applicant to bring the description and drawings into line with the valid claims (R. 27(1)(d) EPC) and to delete from the patent documents those parts of the description and drawings which did not refer to claimed inventions (R. 34(1)(c) EPC). It would then be necessary to check in each individual case whether such adjustments ought to be deferred until allowable claims were submitted.

In **J 24/96** (OJ 2001, 434) the appellant raised the issue of whether, in its decision, the examining division should have dealt with the alleged incompleteness of the partial search report. The board held that within the framework of R. 46 EPC it is the task of the examining divisions (and the boards of appeal) to examine whether communications of the Search Divisions under R. 46(1) EPC asking for further search fees were justified. R. 46(2) EPC does not, however, refer to any acts of the Search Divisions other than communications issued under R. 46(1) EPC. It was therefore not necessary for an examining division to deal in a **decision under Rule 46(2) EPC** with other objections raised by the applicants in connection with the search such as for example the objection that the partial search report was not drawn up in accordance with the Guidelines. To avoid any misunderstanding, the board observed that the examination divisions of course have the possibility of arranging for an additional search to be performed, if they consider a search report delivered by the Search Division incomplete. The board made clear that this had nothing to do with a formal decision issued under R. 46(2) EPC concerning refund of further search fees upon request.

5.4 Assessment of lack of unity in opposition proceedings

In **G 1/91** (OJ 1992, 253) the Enlarged Board held that unity of invention did not come under the requirements which a European patent and the invention to which it related had to meet under Art. 102(3) EPC when the patent was maintained in amended form. It was consequently irrelevant in opposition proceedings that the European patent as granted or amended did not meet the requirement of unity. It was clear from the "travaux préparatoires" not only that lack of unity was deliberately excluded as a ground for opposition, but also that any lack of unity arising during opposition proceedings as a result of amendment of the patent had to be accepted.

The Enlarged Board noted inter alia that although unity of invention under Art. 82 EPC was a material requirement, it was still merely an administrative regulation. It served a number of administrative purposes, particularly in demarcating the respective responsibilities of the departments. The administrative purposes of unity were fulfilled in the main up to the time the patent was granted. The purpose and intention of opposition proceedings was to give a competitor the opportunity of opposing unjustified protective rights. Since this served the competitor's interests, he did not also need to be given the opportunity of contesting a patent on the ground of lack of unity. Lack of unity did not in fact rule out patent protection; it could only result in an application being divided to produce two or more patents.

6. Criteria for determining lack of unity

6.1 Determination of the technical problem underlying the invention

According to the established case law of the boards of appeal, determining unity of invention requires as a precondition an analysis of the technical problem or problems underlying the respective group of inventions (see **W 11/89** (OJ 1993, 225) and **W 6/97**). In **W 6/91** the board held that the determination of the technical problem underlying the invention was a mandatory precondition for the assessment of unity of invention, ie whether or not the subject-matter claimed as the solution to such a problem represented a single general inventive concept. The disregard of this principle would be in itself sufficient justification for the reimbursement of the additional search fees. In **W 8/94** the board held that a discussion of the problem underlying the claimed subject-matter was required, because only then was it possible to decide whether or not a common special technical feature within the meaning of R. 13.1 PCT and R. 13.2 PCT existed for different embodiments (see **W 11/89** (OJ 1993, 225), **W 14/89**, **W 59/90**, **W 14/91** and **W 17/91**).

In **W 6/97** the board found that establishing the technical problem underlying a claimed invention or group of inventions in relation to the state of the art should start, as a rule, from what was considered in the description as having been achieved by the claimed invention, since claims directed to compositions of matter at least were normally silent on the technical effects to be achieved by such compositions. As soon as the search revealed prior art which was clearly more relevant than that already acknowledged in the description of the international application, it was necessary to determine what was to be considered as the particular technical problem in view of both the disclosure of the international application as a whole and the prior art thus revealed (see **W 6/91**). Unity of invention might be assessed only after the technical problem had been determined in such a manner.

The boards have on several occasions stressed that an alleged **lack of clarity** in a claim cannot be used as a reason for an objection based on lack of unity (see **W 31/88** (OJ 1990, 134), **W 7/89** and **W 59/90**).

6.2 Examination as to novelty and inventive step

In **W 12/89** (OJ 1990, 152) the board had examined the legal position and, given the difference of opinion between the boards, had referred, inter alia, the following questions to the Enlarged Board of Appeal (**G 1/89**):

"Does an International Searching Authority have the power to carry out a substantive examination of an international application in respect of novelty and inventive step when considering under Art. 17(3)(a) PCT whether the application complies with the requirement of unity of invention set forth in R. 13.1 PCT?

If an International Searching Authority does have such power, in what circumstance does it have an obligation to carry out such a substantive examination?"

The Enlarged Board of Appeal delivered its decision in **G 1/89** (OJ 1991, 155) and **G 2/89** (OJ 1991, 166). It found that in accordance with normal terminology, the term "examination" or "substantive examination" referred to the activities of the authorities responsible for deciding on patentability, such as the examining division of the EPO, or, in the case of the PCT, to the activities of the IPEA and/or the designated Office. Obviously, an ISA did not have any power to carry out such activities. The Enlarged Board held that an ISA might only form a **provisional opinion** on novelty and inventive step for the purpose of carrying out an effective search. This opinion was in no way binding on the authorities referred to above. The same principle applied also when an ISA considered that an international application did not comply with the requirement of unity of invention set forth in R. 13.1 PCT on an "a posteriori" basis. Such consideration had only the procedural effect of initiating the special procedure laid down in Art. 17 PCT and R. 40 PCT and was, therefore, not a "substantive examination" in the normal sense of that term. According to the decision an assessment of whether a single general inventive concept existed was to be undertaken only **in so far as** this was necessary to establish whether the invention complied with the requirement of unity when implementing the procedure laid down in Art. 17 PCT and R. 40 PCT. Such an assessment was **provisional** and did not constitute a substantive examination in the sense of an examination as to patentability (see **W 6/90**, OJ 1991, 438).

The Enlarged Board further noted that consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in **clear cases**. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in border-line cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see **W 24/90, W 23/91, W 43/91**).

In **W 1/97** the board held that there was no such clear case where the ISA, having already searched part of the subject matter, was still not in a position to identify several separate inventions.

After the Enlarged Board of Appeal's decision, the boards repeatedly used a lack of novelty or inventive step in the general inventive concept underlying the invention to justify a finding of lack of unity of invention (see **W 17/89**, **W 27/89**, **W 18/90** and **W 19/90**).

In **W 2/92** the board pointed out that according to the PCT Preliminary Examination Guidelines to be carried out under the PCT, Chapter III, 7.6, which is binding for the EPO acting as IPEA (see decisions **G 1/89** and **G 2/89** (OJ 1991, 155 and 166)), although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted with on the basis of a narrow, literal or academic approach. Moreover, the benefit of any doubt should be given to the applicant. These Guidelines also state that reasons of economy may make it advisable for the examiner to avail himself of the option referred to in R. 68.1 PCT by choosing not to invite the applicant to restrict the claims or to pay additional fees (see PCT Preliminary Examination Guidelines, Chapter III, 7.10, Chapter VI, 5.9) (see **W 6/96**).

In **W 10/92** the board stressed that the **problem-solution** approach was to be applied to unity of invention (**W 16/91, W 21/91**).

7. The single general inventive concept

7.1 A single general concept

When deciding on unity of invention, it is mandatory under R. 13.1 PCT to determine whether or not a group of inventions claimed in an international application forms a single general inventive concept. Thus, when seeking to establish at the search stage whether inventions comply with the requirement of unity, the first question to be considered is whether the inventions are linked by a single general concept.

In **W 19/89** the board decided that the application clearly lacked unity of invention, since the four possibilities comprised by claim 1 related to a further development of the state of the art in different directions, namely by employing different classes of dehalogenation agents having no new technical feature in common. Where at least one solution of the underlying technical problem already formed part of the state of the art, the requirement of a "single general inventive concept" implied that the further solutions to that problem proposed in the application must have at least one new element in common, this new element being normally represented by at least one new technical feature. Since the absence of such a unifying new technical feature was admitted by the applicant, the application related to more than one invention.

A useful analysis of the single general concept was made in **W 6/90** (OJ 1991, 438). The board found that this concept manifested itself in features common to different teachings expounded individually in the same application. It observed that a teaching for the purposes of patent law encompassed not only the immediate **subject-matter** representing the solution to the problem as defined in the relevant claim, but also its **technical consequences** which were expressed as **effects**. It was noted that any subject-matter was defined by structural features and the relationship between them. The relevant effects, ie the outcome or results achieved by the invention as claimed, would usually already be apparent from the problem as stated. A single general concept might therefore be said to be present only if a partial identity existed between the teachings in an application deriving from the structural features of the subject-matters claimed and/or the outcome or results associated with those subject-matters.

Where subject-matters of the **same category** were concerned, a partial identity, generating unity of invention, could result from the structural features of these subject-matters and/or their associated effects. The absence of such an **element common** to all the different teachings in the application, and hence a lack of unity, might be established **a priori** under certain circumstances. A lack of unity might, however, also be established **a posteriori** between the subject-matters of different independent claims or in the remaining subject-matters if the subject-matter of a linking claim was clearly not novel or inventive vis-à-vis the state of the art. The board gave an example of what was meant by the abstract term "single general concept": a product, a process specially adapted for the manufacture of the said product, and a use of the said product, for example, embodied a single general concept because, on the one hand, the partial identity between the product and its use derived from the structural features of the product and, on the other hand, the partial identity shared by the product and the process specially adapted for its manufacture also derived from the product which was to be considered as the effect or result of this process (see **T 119/82** (OJ 1984, 217), reasons, 11).

The board also noted that the criteria governing unity of invention for the purposes of R. 13.1 PCT elucidated above also applied in principle where the inventive step was based chiefly on the discovery of an **unrecognised problem** (see **T 2/83**, OJ 1984, 265). If the common problem, ie the effects to be achieved, was itself already known or could be recognised as generally desirable (a mere desideratum) or obvious, there would be no inventive merit in formulating the problem. If the common structural features were to be found only in the prior art portions of the claims, and if these known features did not help to solve the problem of the combined whole, this might also indicate a lack of unity.

In **W 38/90** the sole common link between the subject-matter of claims 1, 2 and 4 was that the respective features all contributed to the realisation of the same device - a viewing assembly for a door. The board observed that this common pre-characterising feature was confined to indicating the designation of the invention, as part of the prior art; it was not, however, a specific feature interacting with the remaining characterising features and thereby contributing to the various inventions and their effects. Therefore, this sole link had to be rejected as irrelevant as regards any possible contribution to inventiveness. As already concluded, in the absence of any kind of common relevant feature, no unity "a priori" could be recognised.

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

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

7.2 Inventive character of the single general concept

R. 13.2 PCT defines the method for determining whether the requirement of unity of invention is satisfied in respect of a group of inventions claimed in an international application. It states: "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in R. 13.1 PCT shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a **contribution** which each of the claimed inventions, considered as a whole, makes over the prior art."

In **W 17/89** the board found that once such a single, ie common, concept was established, it was necessary to consider whether or not the same could contribute to the inventiveness of the various subject-matters claimed in the case. Nothing indicated that this concept was known or belonged to the general knowledge of the man skilled in the art. Since the search examiner did not indicate that the documents cited in the case could exclude such a contribution, it could not be assumed that this could not be the case (see **W 6/90** above). In view of this, a single inventive concept had to be attributed to all claims linking all their subject-matters (see **W 22/91**).

In **W 6/90** (OJ 1991, 438) (see above) the board further noted that for the purposes of unity of invention, R. 13.1 PCT also stipulated that the single general concept had to be inventive. Even with a given single general concept there was lack of unity if the concept had no inventive character. The boards of appeal have confirmed the above decision on several occasions (see, for example, decisions **W 31/91**, **W 29/92**, **W 34/92**, **W 45/92**, **W 8/93** and **W 6/97**).

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

In **W 45/92** the board stated that the term "inventive" could not be interpreted as a requirement for the common part to be inventive per se and therefore claimable as such. The investigation in this respect should concentrate on whether or not all or some of such features could contribute to the later detailed consideration of the inventive steps. Only if the already taught state of the art or common general knowledge showed, without reasonable doubt, that this was not possible in the circumstances, should non-unity be declared. It further held that the term "same or corresponding **special** technical features" recognised that the features should define a **contribution** to the invention vis-à-vis the prior art. As the features in question were also part of the most relevant state of the art, where they were set out in an identical manner, they could not provide such a contribution. Thus, the various inventions, if any, had to lie in the unshared specific characterising features in each case. Since the claims contained no other common feature between them in the characterising part, this confirmed the conclusion of lack of unity (see **W 32/92,** OJ 1994, 239 above).

In **W 38/92** the board confirmed **W 6/90** (above) and noted that the common features in the claim groups represented the "sole concept" linking the various subject-matters. The board stated that the remaining question was whether or not any of these specific features in the claim groups or their combination could make a contribution to the inventive steps relating to each claimed subject-matter; if so, this would render the said concept linking the various subject-matters inventive. The board observed that the new R. 13 PCT also required such a contribution by the suggested common "special technical features" over the prior art, ie that more than novelty be provided. In **T 94/91** the board made it clear that the general inventive concept could not be equated with the features cited in a claim or in a particular combination of claims. What should be considered was the inventive concept as defined in the claims with due regard to the description and any drawings (see **W 2/95**).

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

In **T 957/96** the application described a number of processes which did not have any process step in common. The board found that in this case the decisive fact for the question of unity of invention was that all the processes claimed shared a common technical feature, namely the use of the substantially pure regioisomer, which was essential for solving the technical problem addressed by the application. It was this **use of the intermediate** compound which formed the common "inventive" concept of all the claimed process variants. In other words, this feature constituted a **special** technical feature which defined the contribution that the claimed invention made over the prior art as required by R. 30(1) EPC.

In **W 11/99** (OJ 2000, 186) the board held that if, in an international patent application, there are **claims directed to products and to a process for the manufacture thereof**, it could not be assumed that there were no corresponding special technical features within the meaning of R. 13.2 PCT simply because the process could also be used to manufacture other products.

The board interpreted the requirement for the presence of "corresponding special technical features" under R. 13.2 PCT in cases where a manufacturing process and products were being claimed in the same application to mean that they could usually be assumed to be present where the production process is new and actually suited to making the claimed products (where appropriate in addition to further products) accessible. In such cases the board regards the process as being "specially adapted" to the manufacture of the claimed products. A narrower interpretation of the terms "specially adapted" and "corresponding special technical features" would not fulfil the legislative purpose of Art. 34(3) PCT and associated R. 13.1 PCT, which, in the board's view, was the same as that of Art. 82 EPC, namely to prevent subject-matters which were not interconnected being claimed in one and the same application. This interpretation accorded with Annex B to the Administrative Instructions under the PCT mentioned in PCT Guideline III-7.2 in the version of 1 July 1998, where it is stated in Part 1, item (e), that a process is specially adapted for the manufacture of a product if it inherently results in the product. If this condition was met, it was irrelevant whether other products could be obtained using the process.

7.3 Unity of single claims defining alternatives ("Markush claims")

The situation involving the so-called "Markush practice" wherein a single claim defines alternatives is also governed by R. 13.2 PCT. According to R. 13.3 PCT, the determination of whether a group of inventions is so closely linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims, or as alternatives within a single claim (see **W 35/91**).

Paragraph 1 of Chapter VII of the PCT Search Guidelines on unity of invention requires that when assessing unity in accordance with the principles set out in R. 13.2 PCT to R. 13.4 PCT, Section 206 and Annex B of the Administrative Instructions under the PCT as in force from 1 July 1992 must be observed. Annex B, Part 1(f) specifies certain criteria for assessing the unity of Markush claims, and in particular that for alternatives contained in such claims the requirement of a technical interrelationship and the same or corresponding special technical features as defined in R. 13.2 PCT are to be considered to be met when the alternatives are of a similar nature (see **W 3/94**, OJ 1995, 775).

In **W 1/94**, the EPO acting as ISA had found that the compounds according to the "inventions" it had identified did not have a new structural element. Nevertheless the board concluded that the absence of such an element did not automatically destroy the unity of the invention. On the contrary, it was clear from the Administrative Instructions under the PCT that a technical relationship must be recognised for a group of alternative chemical compounds, such as all the compounds having a common property or activity, and such a **common activity** existed in the case in point. The new use could therefore form the general inventive concept linking the subject-matters of the claims in accordance with R. 13.1 PCT and had to be treated as a functional characteristic linking the compounds claimed.

In **W 6/95** the board noted that it follows from Part 1(f)(i) of Annex B of the Administrative Instructions under the PCT, which were binding not only for the ISA but also for the board of appeal acting as the "three-member board" according to R. 40.2(c) PCT (see decision **G 1/89**, OJ 1991, 155) that it was not sufficient, in order to establish unity of invention "a posteriori" for all alternatives of chemical compounds covered by a Markush claim to have a common property or activity, ie be suitable for solving a common technical problem, because according to item (B)(1) they had, in addition, to have a "significant structural element" in common in order for the alternatives to form unity. The board made it clear that it was, however, not in agreement with the explanation given in Part 1(f)(ii) of Annex B of the

Administrative Instructions under the PCT to assume that the said "significant structural element" hat to be novel per se. Rather, this expression meant that in relation to the said **common property or activity** there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity (see also **W 6/97**).

In **T 169/96** the examining division was of the opinion that in the case before it such a single general inventive concept was not present, since the structural alternatives comprised by formula A, which had a common property, did not share a common significant structural element, and, according to the Guidelines, C-III, 7.4a, which referred to the text of R. 30 EPC (old version), a common new use of known and novel chemical compounds was not in itself sufficient to establish a common inventive concept within the meaning of Art. 82 EPC . The board noted that the fact that one claim also comprised a known compound, not covered by another claim 2, was of no relevance to the question of unity, because R. 30(b) EPC (old version in force until 31.5.91) (also under its new version) did not require that there must be a common concept unifying different "means" according to it. In other words, it was not relevant in these circumstances that the three different classes of chemical compounds identified by the examining division comprised completely different chemical structures of a residue. The board observed that the above-mentioned Chapter of the Guidelines, as well as the corresponding Part 1(f) of Annex B of the Administrative Instructions under the PCT concerning the examination of unity of invention of so-called Markush-type claims rightly stated that the said significant structural element might consist of a combination of individual components linked together. It was not stated there that the combination of individual structural elements had to be novel per se, nor did such a requirement follow from Art. 82 EPC. Rather it followed from that guideline that this expression meant that in relation to the said common property or activity there had to be a common part of the chemical structure which distinguished the claimed compounds from known compounds having the same property or activity. In the present case no state of the art was cited which related to chemical compounds which were known to be useful for the production of polymeric compositions of enhanced oxidative stability. The combination of the peroxide group and the residue "An" which was responsible for conferring the oxidative stability, however, distinguished the compounds of claim 2 from all chemical compounds conventionally used as antioxidants in polymeric compositions, on the one hand, and from all compounds conventionally used as polymerisation initiators, on the other hand.

In **W 4/96** (OJ 1997, 552) the board of appeal noted that the requirement of a technical relationship as defined in R. 13.2 PCT, first sentence, might be met when all claimed alternatives belong to a class of compounds which might be expected to behave in the same way in the context of the claimed inventions ("Markush claims"). The technical relationship involved those common **special** technical features that defined a contribution over the state of the art (R. 13.2 PCT, second sentence)(see also **W 6/96**). However, such contribution could not be recognised on the basis of this expectation if members of the class had already been shown in the prior art to behave in the manner disclosed in the application. The board added that if at least one Markush alternative was not novel over the prior art, the question of unity had to be reconsidered by the examiner, ie a posteriori (see Annex B to the Administrative Instructions under the PCT Part l (f)(v) in conjunction with the PCT Search Guidelines).

The board also held that an objection of lack of unity could be raised a posteriori with regard to all categories of grouping of alternatives of chemical compounds. An a posteriori assessment of unity had to be made in all circumstances in the same way, since the legal requirement of R. 13 PCT was the same for all cases. Therefore, the a posteriori assessment of unity in cases of a **functional relationship** within a group of compounds had to be made in a manner corresponding to the assessment in cases of a **structural relationship**. This was appropriate for compounds related by their structure as well as for compounds related by their function. The structural relationship within the meaning of Annex B, Part I (f)(i)(B)(1) and the relationship within the meaning of Annex B, Part I (f)(i)(B)(2) and (iii) served the **same purpose**: both tests were intended to show whether the alternative compounds were of a similar nature, as was said in the introductory part of Annex B, Part I (f)(i). These tests were only tools in order to determine whether there was unity of invention as defined in R. 13 PCT.

8. Plurality of inventions and further search fees

8.1 Consequences of non-payment of a further search fee

If the search division raises the objection of lack of unity of invention a further search fee must be paid in accordance with R. 46(1) EPC or Art. 17(3)(a) PCT for each invention involved. If the fee is paid in due time the applicants may select the single invention or group of inventions they wish to retain in the main application.

The consequences of non-payment of the further search fee for the procedure for the grant of a European patent have been the subject of conflicting interpretations on the part of the boards. While it was stated in **T 178/84** (OJ 1989, 157) that in the case of non-payment of the further search fee under R. 46(1) EPC the subject-matter not searched was regarded as abandoned and accordingly could not be pursued in the parent application, in **T 87/88** (OJ 1993, 430) it was expressly stated that non-payment could not result in abandonment. The board stated that non-payment of the further search fee in no way prejudiced the future legal fate of the unsearched parts and that R. 46(1) EPC merely provided that in the case of non-payment of further search fees the search division was to draw up a European search report only for those parts of the application that related to the invention for which the search fees had been paid.

The President of the EPO therefore referred the following point of law to the Enlarged Board of Appeal: "Can an applicant who fails to pay further search fees for a non-unitary application when requested to do so by the search division under R. 46(1) EPC pursue that application for the subject-matter in respect of which no search fees have been paid or must he file a divisional application for it?"

In **G 2/92** (OJ 1993, 591) the Enlarged Board of Appeal decided that the application could not be pursued for subject-matter in respect of which the applicants had not paid the further search fees. Instead the applicants had to file a divisional application for that subject-matter if they wished to continue to protect it. In the view of the Enlarged Board, it was clear from the procedural system of the EPC that the invention which was to be examined for patentability had to be an invention in respect of which a search fee had been paid prior to the drawing up of the European search report. Part IV of the EPC envisaged that an application progressed after filing from the search division to the examining division. One object of R. 46 EPC was to implement this procedure by ensuring that an appropriately extensive search was completed in respect of each individual application before it was examined by the examining division. To this end, in response to an invitation from the search division to pay one or more further search fees in respect of one or more further inventions to which the application related, applicants had to pay such further search fees if they wished to ensure that one of the further inventions could become the subject of the claims of that application. That was the proper interpretation of R. 46(1) EPC in context. This confirmed the practice according to **T 178/84** (see Guidelines C-VI, 3.2a).

In **T 319/96** the initial application lacked unity, but no further search fee was paid. The applicant took the view that, because of the international-type search (Art. 15(5)a) PCT) carried out by the EPO for the subject-matter of the original claims 4 to 10, it had not forfeited its right to choose and could therefore continue pursuing this subject-matter. It had paid a search fee for each of the two inventions, and two search reports had been prepared by the Office. Since the appellant insisted on pursuing the second invention further, the application was refused under Art. 97(1) EPC in conjunction with Art. 82 EPC and R. 46 EPC.

The board stated that, under R. 46(1) EPC, a search fee was to be paid for each further invention if the European search report was to cover that invention. It was true that an international-type search report had been drawn up under Art. 15(5)(a) PCT for the subject-matter of the second invention in the context of another procedure, ie the national procedure for the purpose of establishing priority; however, this could not simply replace the European search report. R. 46 EPC did not provide that a search report from another procedure could be substituted for the European search report. Rather, the Rules relating to Fees (RFees) provided that a search report on the same subject-matter, if prepared by the Office outside the context of the European grant procedure acting in a different capacity on the basis of other treaties, should be taken into consideration in so far as the European search fee was partly or wholly refunded (Art. 10(2) RFees). The restitution was therefore made by "rolling back", not by waiving the European search fee. For this reason, R. 46 EPC did indeed apply here, and the appellant would have been obliged to pay the further search fee in order to retain the option of pursuing the second invention in the application at issue.

In **T 631/97** (OJ 2001, 13) the board held that R. 46(1) EPC on its proper interpretation does not prohibit a review by the examining division of the search division's opinion on lack of unity of invention where further search fees are not paid. A narrow interpretation of R. 46(1) EPC whereby the finding of lack of unity of invention by the search division is considered as final where the additional search fees are not paid would deprive the applicant of an opportunity to dispute the finding of the search division during the examination proceedings and would also unjustifiably restrict the power of the examining division on the question of unity of invention to the subject matter for which search fees were paid. Thus the board did not share the view held in **T 1109/96.** The board found that the above interpretation of R. 46(1) EPC was in agreement with that of the Enlarged Board of Appeal in Opinion **G 2/92.** It also found that the Guidelines were fully consistent with **G 2/92** and R. 46 EPC.

The board noted that the present practice of search and examination of international applications under the PCT where the EPO is elected or designated office were also consistent with the above view : R. 112 EPC which entered into force on 1 March 2000 (OJ 1999, 660-667) requires that the EPO examines the requirement of unity of invention of an international application entering the EPO as a Euro-PCT application, also for the case when the ISA considered that the application did not comply with the requirement of unity of invention (R. 13.1 PCT and R. 13.2 PCT), and the applicant did not pay additional search fees according to Art. 17(3)(a) PCT.

8.2 Dispensing with further search fee

In **W 36/90** and **W 19/89** the board observed that where there was lack of unity in an international application, in particular if the objection was evident a posteriori, the search examiner might decide to supplement the international search with a search on the additional inventions as well as on the first invention. This was so particularly if the concepts of the inventions were very close and none of them required a search in different classification units, so that the search could be performed for all the inventions without creating too much extra work (see PCT Search Guidelines as agreed upon by the Interim Committee for Technical Cooperation at its seventh session in Geneva in October 1977 (PCT/INT/5)). In such a case no objection of lack of unity should be raised because charging further fees would be incompatible with the principle of equity vis-à-vis the applicant (see **G 1/89**).

8.3 Further invitations to pay additional search fees

According to the PCT Search Guidelines (PCT Gazette No. 30/1992, 14025), if the ISA considers that the international application does not comply with the requirement of unity of invention, it must search and draw up the international search report for those parts of the international application which relate to the invention (or group of inventions forming unity) first mentioned in the claims and those parts of the international application which relate to inventions for which additional fees have been paid.

In **W 1/97** (OJ 1999, 33) during the pending procedure on the applicants' protest concerning the first invitation to pay an additional search fee, the ISA sent a second and a third invitation to pay further additional search fees. The board noted that these invitations were only valid if the relevant provisions provided a legal basis for further invitations. The board could see no such basis. The board noted that although Art. 17(3)(a) PCT and R. 40 PCT did not deal expressly with the question whether a series of successive invitations was possible, the matter was covered by the PCT Search Guidelines (PCT Gazette No. 30/1992, 14025). According to Chapter VII, 2, second sentence, of these Guidelines the invitation to pay additional fees "must identify the separate inventions and indicate the amount to be paid". This had to be seen in connection with the provision that the search report had to be made on those parts of the international application for which additional search fees had been paid (see above). This meant that the search report had to be made on those separate inventions identified in the invitation for which additional fees had been paid. This system prevented further separate inventions being identified in a later stage of the proceedings for the purpose of collecting further search fees. The PCT Search Guidelines repeated the above general requirements expressly for the situation of an a posteriori finding of non-unity (Chapter VII, 10), stating even more clearly that the number of additional search fees to be paid had to be indicated. The obligation of the ISA to identify in the first and only invitation the separate inventions for which the applicant had to pay additional fees in order to receive **a complete search report** served the purpose of giving the applicant a sound basis for his decision whether the payment of the additional fees was in his interest. Such a basis was only given if he knew what he was to receive in return for the fees to be paid.

The board concluded that within the current system under the PCT it was not possible to use the final search result as a basis for charging additional fees. On the contrary, the invitation to pay additional search fees had to be sent before the search report was established. This implied that the result of the search on those parts of the international application for which fees had been paid might entail a posteriori objections of non-unity not considered in a previous invitation to pay additional search fees. In addition, the ISA was obliged to establish the international search report within three months from receipt of the search copy or nine months from the priority date (R. 42.1 PCT). In most cases this left no time for successive invitations to pay additional search fees on the basis of the result of the search at the time of each invitation. As the present case illustrated, successive invitations to pay additional search fees could have the consequence that the question of unity of invention became pending before different instances at the same time. This could be in conflict with basic principles of procedural law which also applied to protest cases (see **W 53/91**). Once a protest was filed, the EPO acting as ISA remained competent only for the prior review of the justification of the invitation already issued (R. 40.1(e) PCT). It was not entitled to raise the question of non-unity a second or third time in the same search procedure.

III. AMENDMENTS

A. Article 123(2) EPC

According to Art. 123(2) EPC a European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.

1. Content of the application as originally filed

1.1 General issues

Regarding the concept of the content of the application, **G 11/91** (OJ 1993, 125) laid down (see Reasons, point 1.4) that it related to the parts of the European patent application which determined the disclosure of the invention, namely the description, the claims and the drawings. Similarly, it was recently reaffirmed that the description, claims and any drawings in the application documents determined the content of the application as filed (**G 2/95**, Reasons, point 4 (OJ 1996, 555), **T 382/94**, Reasons, point 7 (OJ 1998, 24)).

In **T 246/86** (OJ 1989, 199), the board decided that as the abstract was intended solely for documentation purposes and did not form part of the disclosure of the invention, it could not be used to interpret the content of the application for the purposes of Art. 123(2) EPC. For the purpose of Art. 123(2) EPC, "the content of the application as filed" also did not include any priority documents, even if they were filed on the same day as the European patent application (**T 260/85**, OJ 1989, 105).

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

In **T 382/94** (OJ 1998, 24) a European patent application was filed with a description and claims in German, accompanied by 25 drawings. Three of the drawings contained so-called flow sheets with text matter in English. The application was published in this form.

In the board's view, this raised the question whether text matter in drawings which was couched in an official language other than the language of proceedings was part of the content of the application as filed, and whether in this respect it was possible to correct the application.

The board argued that, under Art. 80(d) EPC, the accordance of the date of filing depended on whether the documents filed by the applicant contained "a description and one or more claims" in an EPO official language. However, the EPC did not make the accordance of the date of filing dependent on whether any text matter in the drawings was in a language in accordance with Art. 14(1) and (2) EPC. If drawings were submitted in full on the date of filing, the establishment of the filing date could not be dependent on whether they contained text matter in a language other than the language of proceedings. The special provision under Art. 91 EPC in conjunction with R. 43 EPC related exclusively to the question of whether any drawings were filed at all on the date of filing.

The accordance of a date of filing could relate only to the whole of the application documents. And under Art. 123(2) EPC, the limits for changing or correcting the parts of an application affecting the disclosure were defined by what a skilled person would derive from the whole of these documents as filed. It appeared to be alien to the EPC not to consider certain parts of the description, claims or drawings actually filed on the date of filing to be part of the documents as filed. The amendment of the application, based on the English-language text matter in the drawings as filed, did not represent an infringement of Art. 123(2) EPC.

In **T 287/98**, the word "scrap" originally comprised in the disputed passage of the English version of the application, which means "refuse or waste in general" had been replaced in claim 1 by "scrap metal". The original application in Dutch contained the word "schroot", which means scrap metal, as substantiated by the copies of various dictionaries provided by the appellant.

According to the board, this word was not correctly translated into English and nothing other than "scrap metal" was meant in the application as originally filed. The board further decided that the replacement of the word "scrap" by "scrap metal" was allowable under Art. 123(2) EPC since Art. 70(2) EPC provides that in a case referred to in Art. 14(2) EPC, i.e. in which the European patent application is filed in a language of a contracting state other than English, French or German, the original text must be taken into account in proceedings before the European Patent Office, in order to determine whether the subject-matter of the application extends beyond the content of the application as filed.

In **T 792/94** the board ruled that since the teaching of claim 1 as amended was ambiguous (Art. 84 EPC), allowing scope for an interpretation which extended beyond the overall teaching of the initial application, the amendment contravened Art. 123(2) EPC.

Decisions **T 673/89** and **T 685/90** prohibited the later inclusion of **equivalents**. **T 673/89** concerned a dual circuit braking system. The board held that the mere fact that the original claim did not indicate how the signals were transmitted in the brake circuits was not a basis for deliberately supplementing its teaching with a further embodiment not referred to in the application documents as originally filed. In **T 685/90** the board stated that specific equivalents of explicitly disclosed features did not automatically belong to the content of a European patent application as filed, when this content was used as state of the art according to Art. 54(3) and (4) EPC against a more recent application. It therefore concluded that such equivalents could not belong to the content of a European patent application either, when this content was assessed to determine whether an amendment was admissible under Art. 123(2) EPC. In **T 265/88** the board refused to allow originally undisclosed equivalents to be added by using a wider technical term in place of the single technical means originally disclosed. **T 118/88** had concluded that the obviousness of a feature was no replacement for the original disclosure.

In **T 40/97** the board considered what the originally filed application taught the person skilled in the art and took the view that in a case where a number of generally similar embodiments were discussed in equivalent terms, the person skilled in the art would, in normal circumstances and when nothing pointed to the contrary, notionally associate the characteristics of an element of one embodiment described in some detail with the comparable element of another embodiment described in lesser detail.

In **T 284/94** (OJ 1999, 464) the board stated that an amendment of a claim by the introduction of a technical feature taken in isolation from the description of a specific embodiment is not allowable under Art. 123(2) EPC if it is not clear beyond any doubt for a skilled reader from the application documents as filed that the subject-matter of the claim thus amended provides a complete solution to a technical problem unambiguously recognizable from the application. Nor is an amendment allowable under Art. 123(2) EPC which replaces a disclosed specific feature either by its function or by a more general term and thus incorporates undisclosed equivalents into the content of the application as filed.

In **T 243/89** the applicant had originally claimed a catheter only for medical use; during examination proceedings he filed a further claim for its manufacture. The board of appeal saw no reason to refuse the filing of an additional method claim for forming the apparatus, in view of the similar wording and thus of the close interrelationship between both independent claims. Provided the result of the activity was in itself patentable, such methods were also patentable unless the disclosure was insufficient.

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

In **T 906/97** the board stated that an a posteriori demonstration that the original claims, considered in isolation from the rest of the application documents, could possibly be construed in such a way as to cover a specific type of apparatus failed to provide convincing evidence that such specific apparatus was actually disclosed to the skilled person.

In **T 770/90** the board ruled that an unduly broad claim not supported by the description as originally filed was not a suitable "reservoir" for amendments. In **T 296/96**, on the issue of Art. 123(2) EPC, the board stated that the content of a document was not to be viewed as a reservoir from which features pertaining to separate embodiments could be combined in order to artificially create a particular embodiment. When assessing whether a feature had been disclosed in a document, the relevant question was whether a skilled person would seriously contemplate combining the different features cited in that document. That was not the case in the application as filed.

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

Expanding on **T 13/84** (OJ 1986, 253) it was stated in **T 547/90** and **T 530/90** that reformulating the technical problem was not in breach of Art. 123(2) EPC provided the problem as clarified and the solution proposed could have been deduced from the application as a whole in the form originally filed.

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

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

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

T 201/83 (OJ 1984, 481) and **T 17/86** (OJ 1989, 297) started from the assumption that a limitation could also constitute an inadmissible extension of the subject-matter of the application. In **T 201/83**, however, the board came to the conclusion that the amendment of the concentration range for a component of a claimed alloy was allowable on the basis of a value described in a specific example since the skilled person could have readily recognised that this value was not so closely associated with the other features of the example as to determine the effect of that embodiment of the invention to a significant degree. The new limit could therefore be deduced from the original documents. In **T 17/86** the examining division took the view that, although the introduction into a claim of a particular technical feature constituted a limitation, it nevertheless contravened Art. 123(2) EPC since the feature concerned had been described in the application solely in association with another feature not included in the claim. The board, however, stated that the application as filed unmistakably showed that the combination of technical features in the new claim thus amended was sufficient to produce the result sought in the application.

In **T 1067/97** the board confirmed that if a claim was to be restricted to a preferred embodiment, it was normally not admissible under Art. 123(2) EPC to extract isolated features from a set of features which had originally been disclosed in combination for that embodiment. An amendment of this nature would only be justified in the absence of any clearly recognisable functional or structural relationship among said features.

In **T 582/91**, the respondent/opponent was of the opinion that when restricting a granted claim by introducing subject-matter from the dependent claims all the features of the dependent claims in question should be incorporated in the new independent claim. Contrary to this opinion the board considered that one feature of a dependent claim could be readily combined with a preceding independent claim as long as the skilled person recognised that there was clearly no close functional or structural relationship between the one feature of that dependent claim and its other features, or between that one feature and the teaching of other dependent claims referred to in that dependent claim. If this was the case, no objections under Art. 123(2) EPC arose (confirmed in **T 938/95**, see also **T 288/89**).

In **T 615/95** there were three independent lists of sizeable length specifying distinct meanings for three residues in a generic chemical formula in a claim. One originally disclosed meaning was deleted from each of the three independent lists.

The board stated that the present deletions did not result in singling out a particular combination of specific meanings, i.e. any hitherto not specifically mentioned individual compound or group of compounds, but maintained the remaining subject-matter as a generic group of compounds differing from the original group only by its smaller size. Such a shrinking of the generic group of chemical compounds was not objectionable under Art. 123(2) EPC, since these deletions did not lead to a particular combination of specific meanings of the respective residues which was not disclosed originally or, in other words, did not generate another invention.

1.2 Technical contribution: addition or deletion of a feature

G 1/93 (OJ 1994, 541) stated that the underlying idea of Art. 123(2) EPC was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. If, however, an added feature merely excluded protection for part of the subject-matter of the claimed invention as covered by the application as filed, the adding of such a feature could not reasonably be considered to give any unwarranted advantage to the applicant. Nor did it adversely affect the interests of third parties. Therefore, a feature which had not been disclosed in the application as filed but which had been added to the application during examination was not to be considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC, if it merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, without providing a technical contribution to the subject-matter of the claimed invention (see also **T 112/95**).

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

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

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

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

In case **T 64/96**, a patent relating to a cover for automobile sun visor mirrors comprising rectangular plates overlapping and connected together in chain-like succession was revoked by the opposition division. The third auxiliary request of claim 1 was amended in that it was included as an additional feature that lugs were "integrally formed in said plates".

The appellant/patent proprietor argued first that this feature was disclosed, at least implicitly, in the original application. Indeed since the plates were described according to the appellant as being of plastics, the person skilled in the art would not seriously consider forming the plates without lugs and then attaching the lugs thereafter, for to do so would unnecessarily increase the production costs of what was after all a mass-produced article. The appellant also argued in the alternative that the requirement that the lugs be "integrally formed in said plates" was of this class of feature allowed (in short: no technical contribution) by **G 1/93** (OJ 1994, 541). In particular the appellant argued in this respect that all he was doing was limiting the scope of protection of the patent by means of non-inventive selection since the original application covered both integrally formed lugs and separately formed lugs subsequently attached to the plates.

In the board's opinion the first line of argument confused two essentially different questions, namely what the person skilled in the art would do on the basis of his general common knowledge when seeking to put the teachings of the original application into practical effect and what the original application directly and unambigously disclosed to him. The answer to that second question was that the skilled person was told that the plates "are provided" with lugs, nothing else. That statement certainly included the possibility of forming the lugs integrally with the plates but did not disclose it.

The board then examined the second line of argument and came to the conclusion that applying the criterion, set out in **G 1/93** (OJ 1994, 541) and **T 384/91** (OJ 1995, 745), to the present case it could be seen that the feature in question did indeed make a technical contribution to the subject-matter of the claim since forming the lugs integrally with the plates led to a simpler and cheaper construction of cover which, at least by implication, was the technical problem which the invention set out to solve. Thus the addition of this feature to claim 1 of the third auxilliary request offended against Art. 123(2) EPC.

Another question which arose was whether deleting a feature could constitute a technical contribution to an invention.

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

The board allowed the deletion of this feature in the method claims. It explained that the aim of the invention was to make photovoltaic cells with certain abilities. This aim was achieved by the use of three different semiconductor layers formed of at least four different elements.

In the board's view, it followed from the description that the presence of ohmic contacts did "not provide a technical contribution to the subject-matter of the claimed invention". Therefore, the presence or absence of such ohmic contacts did not affect the carrying out of the described invention since they were not an essential part of it. The board invoked the principles underlying the interpretation of Art. 123(2) EPC set out by the Enlarged Board in **G 1/93** (OJ 1994, 541, see above). According to the board in this case these considerations were equally applicable to cases where a feature had been removed from a claim or omitted, so as to broaden its protection. Thus the removal from a claim of a feature which did not provide a technical contribution to the subject-matter of the claimed invention and whose removal merely broadened the protection conferred by the claim did not contravene Art. 123(2) EPC.

In **T 10/97** not all the compounds listed in the original claim were included in amended claim 1. However, since the claimed group of compounds was obtained not by restricting an originally disclosed generic definition of a substituent in a generic formula to a specific one selected from worked examples, but by deleting some members from a list of individualised equally useful compounds in order to improve the chances of patentability over the available prior art, the board found that such deletions must be considered admissible in accordance with the case law of the boards of appeal (see **T 393/91**). For the remaining compounds, no particular technical effect was either disclosed or alleged.

1.3 Disclosure in drawings

The case law according to **T 169/83** (OJ 1985, 193), **T 523/88** and, more recently, **T 818/93** showed that the EPC did not prohibit the amendment of claims to include features from drawings, provided the structure and the function of such features were clearly, unmistakably and fully derivable from the drawings by the skilled person and not at odds with the other parts of the disclosure. Nor could any element be dropped.

Indeed, in **T 169/83** (OJ 1985, 193), **T 465/88** and **T 308/90** it was pointed out that where drawings existed they were to be regarded as an integral part of the documents disclosing the invention. Drawings were to be treated on an equal footing with the other parts of the application. Further, the fact that features were disclosed solely in the drawings did not preclude these features from becoming essential in the course of the proceedings (**T 818/93**). The features for which a skilled person could clearly derive the structure and function from the drawings could be used to define more precisely the subject-matter for which protection was sought (**T 372/90**).

In **T 398/92**, the board made particular reference to the case law on this subject. In the case at issue the patent claims as amended contained features that had not been mentioned expressis verbis in the written part of the original application but had been derived from the figures for the application as filed. In this case the drawings in question illustrated the curves in a system of Cartesian co-ordinates with a precise, defined scale. The curves therefore could not be compared to the schematised representation of an invention given by a graph. The board recognised that the points of these curves were not purely intellectual graphic constructions but, on the contrary, corresponded to real experimental values, representing the percentages of a particular drug released in solution. Although these percentages were not mentioned *expressis verbis* in the original document, the board was of the opinion that for a skilled person they would have been clearly and unambiguously derivable from the scale given on the Y-axis, since the figures were sufficiently precise for the ordinate values to be read exactly and thus for the same numerical features as introduced in the claims to be derived from them. The incorporation into the text of the claims of the numerical features derived from the curves therefore did not contravene Art. 123(2) EPC. As far as **a graph representing a mathematical equation** is concerned, see **T 145/87**. This case related to a process for regulating the print quality of printers which could only be carried out using statistical calculations. On the basis of a formula given expressis verbis, its representation as a graph according to the Cartesian co-ordinate system and a basic knowledge of statistics, the possible values of two parameters in the formula, though not expressly disclosed, could be deduced.

In **T 191/93** amendments were based exclusively on the original drawings and introduced only some of the features disclosed in the drawings. The board held that the subject-matter of the patent had been extended compared to the application as filed because it was not derivable from the drawings that the two newly introduced features could be isolated from the other features shown in the drawings. The subject-matter defined in the claims thus amended was ambiguous. In this case, however, the ambiguity could be removed by also introducing into the claim a third feature, disclosed in the drawings as filed, together with the other two features.

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

In **T 497/97** the board noted that, since drawings were often approximate and therefore unreliable, they could only be used in interpreting amended claims if the description did not contain a more precise indication of what was meant. Moreover, in the case at issue, the drawings showed only a preferred embodiment of the invention, which did not rule out the possibility of other embodiments covered by the claimed subject-matter. The board concluded that the contested wording, inserted in the characterising portion of claim 1, had been validly based on the description according to the application, ie that the wording had been inferrable from its context without extending its meaning.

In **T 748/91** the board reached the conclusion that size ratios could be inferred even from a **schematic drawing** as long as the delineation provided the relevant skilled person with discernible and reproducible technical teaching. In the board's view, schematic drawings depicted all the essential features.

However, a figure which served only to give a schematic explanation of the principle of the subject-matter of the patent and not to represent it in every detail did not allow the sure conclusion that the disclosed teaching purposively excluded a feature not represented. A "negative" feature of this sort (in this case: "with no internal fittings") could not subsequently be incorporated into the claim (**T 170/87**, OJ 1989, 441). Regarding the absence of a feature in a figure which served only to give a schematic explanation of the principle of the invention, see also **T 264/99**, in which the board found the circumstances to be different from those in **T 170/87**.

Likewise, in **T 906/97** the board held that the parent application as filed failed to disclose unambiguously the position of a door. The only indication of this position could be found in some figures, and in the board's view there was no suggestion whatsoever in the description itself that this detail of the schematic representation was actually meant to correspond to a technical feature of the apparatus shown in the figures, rather than being merely an expression of the draughtsman's artistic freedom.

1.4 Cross-references

In **T 6/84** (OJ 1985, 238) the subject-matter of the application was a chemical process solely characterised in that the catalyst was synthetic offretite having a silica/alumina mole ratio of 5 to 10. For the definition of synthetic offretite the description referred to a Canadian patent specification in which the offretite used was defined as aluminosilicate having the given mole ratios for the oxides and a characteristic X-ray powder diffraction pattern. The board took the view that structural features of a means for performing a chemical process (here the catalyst "offretite"), which were not mentioned in the application documents themselves but in a document (here a Canadian patent specification) to which they referred, could be incorporated into a patent claim if they unequivocally formed part of the invention for which protection was sought (see **T 590/94**). However, it was not permissible to single out a particular one of their number (here a silica/alumina ratio) in the absence of evidence that this feature alone was a sufficient characterisation. It was instead necessary to recite fully the other essential components of the structure and the diffraction pattern figures which belonged together, as originally disclosed and defined in that document.

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

In **T 689/90** (OJ 1993, 616), however, the description of the invention as originally filed did not in any way suggest that the "further details" of a certain feature to be found in a document D1 referred to and now to be included in the main claim were intended to identify features of the invention for which protection might be sought or that such features implicitly clearly belonged to the description of the invention. The board decided that features disclosed only in a cross-referenced document which was identified in the description as filed were prima facie not within "the content of the application as filed". Only under particular conditions would adding them to a claim not be an infringement of Art. 123(2) EPC - namely if the description of the invention as filed left the skilled reader in no doubt that protection was sought for those features, that they helped achieve the invention's technical aim and thus formed part of the solution to the technical problem underlying the invention claimed, that they implicitly clearly belonged to the description of the invention contained in the application as filed and thus to the content of the application as filed, and that they were precisely defined and identifiable within the total technical information contained in the reference document. In the case at issue these requirements were not fulfilled.

1.5 Errors in the disclosure

1.5.1 Calculation errors

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

1.5.2 Incorrect structural formula

In **T 552/91** (OJ 1995, 100) the question arose - apparently for the first time - as to whether and in what form protection could be obtained for groups of chemical substances and individual compounds whose originally disclosed structural formula proved incorrect. The applicant's main request was aimed at securing such protection by a further substance claim for the group of compounds with the structural formula subsequently found to be correct. This request was refused on the grounds that it would violate Art. 123(2) EPC. The board defined "content" within the meaning of Art. 123(2) EPC as "the entire technical disclosure derived by a skilled person from the application". Thus it was not enough to prove that as a result of amendments to the original patent application nothing other than the originally disclosed subject-matter was claimed; what was more important was that technically relevant information which the skilled person could not derive from the original documents was not thereby added to the application. In this case, the subsequently amended general formula gave the skilled person for the first time crucial information about the true chemical structure of the group of substances. This led to conclusions regarding properties that could be put to use. The information added to the application through the amendment of the general formula and relating to the true composition of the group of substances could not have been obtained from the application as originally filed.

1.5.3 Amendment based on errors

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

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

1.5.4 Elimination of contradictions

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

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

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

In **T 609/95** the board took the position that where a drafting defect or inconsistency in an application would be evident to a reader skilled in the art, the person to whom the application is addressed, it is reasonable to suppose that he would, in the light of the content of the application, attempt to formulate a notional amendment which would enable him to make sense of what he reads, and to the extent that the amendment might be said to leap to the mind of the reader, although perhaps only after close study of the document, it can be regarded as implicit in the application and would not contravene Art. 123(2) EPC, if effected in practice (see also **T 887/97** for such amendment during opposition appeal proceedings).

1.6 Subsequent addition of details

1.6.1 Amendments in the description of the prior art

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

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

In **T 450/97** (OJ 1999, 67) the board confirmed that the mere addition of a reference to prior art did not contravene Art. 123(2) EPC. It added that after limitation of the claims, also at the opposition stage, a document which subsequently proved not only to be the closest state of the art, but also to be essential for understanding the invention in the meaning of R. 27(1)(b) EPC was to be introduced in the amended description.

In **T 889/93** the appellant/applicant explained that the closest prior art was shown in two figures of the contested application. In his reply to the board's objection of obviousness he submitted that these figures did not show the state-of-the-art device correctly as they were misleadingly oversimplified. The board allowed originally filed drawings to be replaced by better ones since this only removed an inaccuracy in the representation of the state of the art and did not affect the disclosure of the invention per se. **T 1039/93** found along similar lines. In the case at issue, certain figures of the application as filed had been erroneously labelled as prior art while in fact representing in-house technical knowledge of the appellant that had not been made available to the public. The board did not object to the deletion of the labels "prior art" from the relevant figures since such deletion neither infringed Art. 123(2) EPC nor affected the disclosure of the state of the art; on the contrary such amendment was necessary to avoid giving an inaccurate representation of the state of the art. After the amendment the description correctly indicated the prior art as required by R. 27(1)(b) EPC.

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

1.6.2 Subsequent addition of effects

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

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

1.6.3 Disclaimer

In **T 898/91** the board held that the purpose of a disclaimer was to re-establish the novelty of a claim over the teaching of a prior art document without introducing new subject matter, so that a precise basis for what was disclaimed had to exist either in the original application or in the prior art document.

In **T 982/94**, claim 1 was amended during appeal procedure by changing the original lower limit of 40° for the twist angle to a new lower limit of 60°, which was not explicitly disclosed in the original application documents. This modification which amounted to disclaiming the values between 40° and 60° from the originally claimed range for the twist angle, was introduced in order to overcome the novelty objection based on the contents of document D1 in which the limit of 60° was explicitly disclosed as the upper limit of the preferred range of between 20° and 60° for the twist angle. For this reason among others the board was convinced that the disclaimer introduced into claim 1 as amended was adequately supported by the disclosure of document D1, and the amendment therefore complied with the requirements of Art. 123(2) EPC.

However, in **T 898/91** the board held that if the appellants' intention were to re-establish novelty over document (1) , then it should be noted that the newly introduced expression "less than 25 wt. %" would not achieve this goal. This was because in document (1) the range 25 to 65 % by weight was merely given as an example of "low fat". There seemed thus no reason why the skilled person would not regard something below but close to 25 wt. % as also falling within the teaching of document (1), so that the feature below 25 wt. % could not be regarded as a disclaimer of any overlap with any precise range required by document (1). Claim 1 was thus objectionable under the terms of Art. 123(2) EPC.

In **T 863/96** (see also **T 43/99**) the board referred to the case law of the Boards of Appeal according to which it would be allowable under Art. 123(2) EPC to formulate a disclaimer which is precisely defined and limited to the prior art disclosure, provided this disclosure is an accidental novelty-destroying disclosure. It clearly appeared that the disclaimer to be formulated on the basis of this disclosure was only allowable if the cited document containing the said disclosure had no relevance for any further examination of the claimed invention and it must then disappear from the prior art field to be taken into consideration. The board referred to **T 4/80** (OJ 1982, 149), and **T 170/87** (OJ 1989, 441) where the disclaimer was not allowed because the subject-matter to be disclaimed was considered relevant to the assessment of inventive step (see also **T 596/96**).

In **T 1071/97** board pointed out that excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed or the patent as granted by disclaiming a certain anticipation in prior art which was not referred to in the originally filed documents was acceptable under the terms of Art. 123(2) EPC only if the following conditions were met: (i) the subject-matter disclaimed had to be precisely defined and strictly limited to the actual scope of the anticipation; and (ii) said anticipation had to be a so-called "chance anticipation", which meant that it would be regarded as accidentally falling within the terms of the claims of the application or the patent in question.

Condition (ii) specifically referred to cases where what was disclosed in the prior document could fall within the wording of the claims of the application or the patent to be assessed for novelty without there being a common or related technical field, or a common technical problem or solution. In other words, the prior document had to form part of an entirely remote and unrelated state of the art which the skilled person, faced with the assessment of inventive step, would normally never take into consideration. In each case, a particularly careful comparison was to be made between what could fairly be considered to fall within the wording of the claim and what was effectively shown in the document.

The board stated that since the state of the art in the present case was highly relevant to the subject-matter claimed in the patent in suit, condition (ii) was clearly not met. Accordingly, the disclaimer was not allowable under Art. 123(2) EPC and, consequently, the first auxiliary request as a whole was not acceptable (see also **T 608/96**, **T 917/94**, **T 159/95**, **T 13/97**, **T 645/95**).

In **T 596/96** the board came to the conclusion that the first condition for a disclaimer to be admissible was that the prior art document must be **indisputably novelty-destroying**. In the present case, no novelty objection was raised on the basis of the documents cited by the appellant in support of the disclaimer.

As explained in **T 426/94**, the incorporation into a disclaimer of features not disclosed in either the contested patent or the originally filed documents, in order to exclude any accidental novelty-destroying prior description of parts of the claimed subject-matter, was, according to current board of appeal practice, not contrary to Art. 123(2) EPC. The disclaimer had, however, to adhere as closely as possible to the wording of the disclosure of the novelty-destroying document.

In **T 893/96** the board judged that the originally allowed disclaimer on which the claim was maintained according to the decision under appeal was not allowable, because it was broader than the prior art it purported to overcome and so was in breach of the provisions of Art. 123(2) EPC (see also **T 915/95**).

In **T 65/97** the appellant introduced a disclaimer to exclude the disclosure of prior art document D1, thereby trying to make the claimed subject-matter novel. However, the disclaimer was not allowable because it did not disclaim all of what was disclosed by D1.

In **T 541/97** the invention related to a filter for a smoking article comprising a water disintegrative paper. The parameter of the moisture disintegration index (MDI) was the only characterising feature used to define the invention. After examination the board concluded that this MDI parameter and the associated test were not publicly known at the date of priority and/or filing. The board further decided that the test for determining this unusual parameter, which had to be sufficiently defined to produce an acceptably accurate and repeatable result, was also not sufficiently defined in the patent application as filed. In particular, it was important to use the correct type of measuring cylinder for the MDI test in order to arrive at the correct value for the parameter.

The appellant specified the type of measuring cylinder to be used by amending the claim and the description. He saw this as a disclaimer, ie excluding all other cylinders from use.

The board however found that the effect of changing the type of cylinder was to change considerably the value of MDI measured with it. Thus the type of cylinder used played an essential role in determining the scope of protection.

The board held that specifying the type of cylinder after filing the application was not a disclaimer in the accepted sense: it did not exclude protection for part of the subject-matter otherwise covered by the claim, nor did it make the claim novel over cited prior art or limit the claim to one of the previously disclosed alternatives. Instead, it chose something which had never been specifically mentioned before, thereby extending the subject-matter of the originally filed application. The applicant furthermore relied on the argument that legal certainty was increased by the amendment. The board did not agree. A competitor might have obtained different test results by using a measuring cylinder other than the one now mentioned in the claim.

The amendment, which provided a technical contribution to the subject-matter of the claimed invention, would have given an unwarranted advantage to the appellant which was contrary to the purpose of Art. 123(2) EPC, as explained in **G 1/93**.

In the recent decision **T 323/97** (OJ 2002, ***) the board held that disclaimers not based upon application as filed are not admissible.

2. Divisional applications

European divisional applications may only be filed in respect of subject-matter which does not extend beyond the content of the parent application (Art. 76(1) EPC, second sentence). All features disclosed in the divisional application must have been indicated in the description, claims or drawings of the parent application as filed.

In decisions **T 527/88** and **T 514/88** (OJ 1992, 570), the boards extended the principles set out in rulings on Art. 123(2) EPC to the relationship between divisional and parent applications. The subject-matter of the amended application or patent (in this case the divisional application) had to be directly and unambiguously derivable from, and consistent with, the original disclosure (in this case the parent application). Following the idea expressed in **T 873/94** (OJ 1997, 456), the board in **T 1221/97** stated that a divisional application has to meet - inter alia - both the requirements of Art. 76(1) EPC and those of Art. 123(2) EPC: it has neither to extend beyond the parent application nor be amended after filing in such a way that it contains subject-matter which extends beyond the content of the divisional application as filed.

In **T 276/97** the arguments of the appeal may be summarised as follows: given that the terms of the French version of Art. 76(1) EPC, second sentence, are different from those of Art. 123(2) EPC, it is wrong to follow the EPO case law, according to which the interpretation of Art. 123(2) EPC is applicable to Art. 76(1) EPC as well. The appellant concluded that, by basing its ruling on the German and English wordings, the examining division had incorrectly interpreted and applied Art. 76(1) EPC.

The board decided that the purpose of Art. 76(1) EPC, second sentence, was the same as the purpose of Art. 123(2) EPC, ie to guarantee the legal certainty of third parties taking the content of the parent application as their basis and to create a fair balance between the interests of applicants and other parties (see **G 1/93**, OJ 1994, 541, points 8, 9 and 16). Moreover, the case law of the boards of appeal confirms that Art. 76(1) EPC is to be equated with Art. 123(2) EPC. The term "éléments" in the French wording of Art. 76(1) EPC does not justify a different interpretation of the terms "Gegenstand" and "subject-matter" respectively in the German and English wordings of Art. 76(1) and 123(2) EPC. The board also confirmed that the French wording of Art. 76(1) EPC translates the same intentions as the German and English versions of the article, ie to prohibit extension of the content of the parent application by the introduction of new subject-matter in the divisional filing, just as by any amendment subsequent to the date of filing of the parent application.

In **T 289/95** the board held that the question of whether or not a claim in a patent deriving from a divisional application "covers" or "embraces" something which was not specifically disclosed in the parent application was not the proper standard of comparison for determining whether there had been an inadmissible extension of subject-matter. The board stated that what was required was an analysis of whether the subject-matter of the contested patent was directly and unambiguously derivable from, and consistent with, the disclosure in the parent application.

T 176/90 was based on the principle that the parent application should disclose the invention of the divisional application in a manner sufficiently clear and complete for it to be carried out by the skilled person. For an invention relating to a generic class of chemical compounds this required the disclosure of the structure of the class, usually by means of a general formula, and an indication of a method of preparation. In the opinion of the department of first instance, the ethers and esters referred to in the divisional application could not be derived from the parent application since the latter only disclosed the corresponding alcohols. The board took the view that although the parent application described alcohols only as individual compounds, the teaching was not restricted only to this. Rather, it also encompassed ethers and esters of the alcohols specifically defined by the general formula. Since the specific alcohols referred to in the parent application fell within the definition of the general formula and served to illustrate the general formula, the skilled person could infer from the total disclosure of the parent application the generic ethers and esters of these individual alcohols.

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

The board stated that it was a generally accepted principle of patent law that, once a divisional application had been validly filed, it became separate and independent from the parent application. Thus, once the conditions of Art. 76(1) 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.

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

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

Equally no objection arose from the fact that the divisional application as originally filed claimed a different invention from that specified in the amended claims. While the content of an application must not be extended after filing, the protection sought by the claims might be extended beyond that sought in the claims as originally filed as long as the application was pending; in this respect, there was no distinction between a normal application and a divisional application.

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

In **T 542/94** the examining division refused a divisional application because its subject-matter extended beyond the parent application, but on the basis of Art. 123(2) EPC when it should have been on the basis of Art. 76(1) EPC. The board noted that the requirement for admissibility of the claims of a divisional application under Art. 76(1) EPC corresponded to that set out in Art. 123(2) EPC (see also **T 441/92**). Since the examining division's arguments were essentially based on a comparison between the subject-matter of the parent application and that of claim 1 of the divisional application, its finding was in fact based on Art. 76(1) EPC. Hence, the imprecise ground for refusal given in the decision under appeal did not put the appellant in a disadvantageous position and there was therefore no case for reimbursement of the appeal fee under R. 67 EPC .

In **T 211/95** the examining division had refused a divisional application on the ground that a set of features from the original claim 1 of the parent application was entirely missing from claim 1 of the divisional application. This omission was said to violate the provisions of Art. 76(1) EPC. The board was unable to accept this. There were two technically unconnected teachings which could be claimed for separately. The skilled person would clearly see that the set of features according to the subject-matter claimed in the parent application was not essential to the subject-matter claimed in the divisional application. The subject-matter of the divisional application was directly and unambiguously disclosed in the parent application.

In **T 58/86** it was decided that the independent claims of a divisional application exceeded in an impermissible way the disclosed content of the original application, since in each of them an essential feature of the relevant subject-matter of the original application was omitted; reinstating this feature would have led to a subject-matter that was already protected in the original application (double patenting).

3. "Tests" for the allowability of an amendment

3.1 The "novelty test"

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

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

However, in decision **T 873/94** (OJ 1997, 456) the board pointed out that where a proposal for amending an application involved the addition of a limiting feature to a claim, applying a "novelty test" was not appropriate for determining whether or not the amendment complied with Art. 123(2) EPC. Following **G 1/93**, the board pointed out that the underlying idea of Art. 123(2) EPC was clearly that an applicant should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application. In the light of these considerations the addition to a claim before grant of an undisclosed limiting feature might or might not violate Art. 123(2) EPC, depending on the circumstances.

3.2 The "is it essential" test

The second test developed by the boards of appeal for the allowability of an amendment, having regard to Art. 123(2) EPC concerns the deletion of a feature. In **T 66/85** (OJ 1989, 167) it was pointed out that if a technical feature was deleted from a claim in order not to exclude from protection certain embodiments of the invention, the broadening of the claim did not contravene Art. 123(2) EPC as long as there was a basis for a claim lacking this feature in the application as originally filed. It was immaterial whether or not the feature in question was relevant to the inventive concept of the claimed subject-matter (see also **T 228/98**, Reasons 3.4.5).

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

On the other hand, in **T 260/85** (OJ 1989, 105) it was stated that it was not permissible to **delete** from an **independent claim** a feature which the application as originally filed consistently presented as being an **essential feature** of the invention, since this would constitute a breach of Art. 123(2) EPC. **T 496/90**, **T 189/94**, **T 628/91** and, more recently, regarding deletion of the feature "substantially pure", **T 728/98** (OJ 2001, 319), confirmed this case law. In **T 628/91**, however, the disclosure was such that a structural feature could be replaced by a functional one, firstly because it was not disclosed as essential, secondly because its function was described.

In **T 415/91**, the board refused to allow the deletion of the feature "three-phase" alternating current. It argued that the low and high AC voltages were consistently referred to in the description and claims as being three-phase: the expression "three-phase" appeared about 200 times in the application as originally filed and no other number of phases was mentioned at all. The skilled person reading the application as originally filed would not necessarily have regarded the numerous references to "three-phase" as being purely by way of examples. Although it was possible that upon reflection, and using his imagination, it might occur to him that it was not essential to use three phases, this would be his own idea, resulting from his own thinking. It was not part of the content of the application as originally filed. In **T 236/95** the board examined whether, considering the problem derivable from the original description, three deleted features were represented as essential features of the invention. If the problem could not be solved without the features concerned, they could not be considered unimportant.

That the original disclosure is the determining factor is also clear from **T 331/87** (OJ 1991, 22), in which deletion of a non-essential feature was allowed: the replacement or removal of a feature from a claim may not be in breach of Art. 123(2) EPC if the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it was not, as such, indispensable for the function of the invention in the light of the technical problem it served to solve, and (3) the replacement or removal required no real modification of other features to compensate for the change (see also **T 60/90** in chapter III.A.1.5.4).

Applying the above mentioned criteria in **T 396/95**, the board considered that whereas it was not expressly mentioned that the deleted feature ("carbonation") was essential for the invention this followed implicitly from the whole presentation of the invention. This feature was seen by the board to be indispensable for the function of the invention in the light of the technical problem it served to solve. Indeed the skilled person would not have regarded the carbonation feature as indispensable for the function of the invention, if the invention concerned the obtaining of chilled beverages and the problem underlying the invention consisted only of how to improve the cooling of the water in order to provide cooled beverages. But in the present case the application as originally filed related to "a water carbonator system" and the problem underlying the invention also comprised the improvement of gas/liquid mixing. In this case, the skilled person would regard the carbonation feature as indispensable for solving the problem underlying the invention.

In **T 374/93** the opponent argued before the board that the amount of polymer to be added to the suspension as defined in claim 1 of the original application was an essential feature, and that the deletion of this feature was not allowable under Art. 123(2) EPC. The board did not agree, holding that the original application as a whole unambiguously taught that the amount of cationic polymer to be added to the suspension depended on various parameters and could easily be experimentally determined. In the board's judgment, a skilled person would therefore interpret the relevant passage, in the light of the original specification as a whole, as an instruction to facilitate the finding of the optimum amount of cationic polymer, or as an advantageous embodiment of the originally disclosed invention. In view of these considerations, the deleted feature of the originally filed claim 1, suggesting the need to raise in steps the amount of polymer to be added if the amount of cationic binder were reduced from a value just above 0.5% to a value just below this value, appeared to be inconsistent with the teaching of the original application. In any case, in the board's view, the skilled reader would not immediately and unambiguously recognise from the passage containing several relative terms and expressions such as "in some instances", "eg", "normally" and "usually", that the feature as deleted from the original claim 1 was a mandatory feature.

In **T 784/97** the patent proprietor alleged that a prior art document would have made the skilled person aware that the disputed feature was not essential. The board held that whether or not a feature of an independent claim had to be seen as "essential" could not be a question of the prior art disclosure. Rather, what had to be decided was what a skilled person was taught by the originally filed documents. In the present case, a skilled person having considered the originally filed documents was aware that the particle size was part of the alleged invention, so that this feature could not be omitted from an independent claim at a later stage without contravening the requirements of Art. 123(2) EPC and Art. 100(c) EPC.

Any attempt to interpret Art. 123(2) EPC such that the introduction into a claim of features previously described as non-essential would not be permissible, must fail. The board based this statement in **T 583/93** (OJ 1996, 496) on the consideration that the EPC contained no requirement that forbade the redefinition of an invention provided that Art. 123(2) and (3) EPC were complied with. Such a redefinition was often necessary in order to take into account prior art not known to the applicant at the priority date. It was therefore possible that features described as optional at the priority date later became essential in the sense that they were necessary to delimit the invention from the prior art. The introduction of such features was permissible provided that, first, the application as originally filed contained an adequate basis for such limitations and, second, the resulting combination of features was still in line with the teaching of the application as originally filed.

3.3 Deducibility of amendments from the application as filed

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

Decision **T 194/84** (OJ 1990, 59) related to amendments leading to the generalisation of the subject-matter of an application or to the omission of a feature (in this instance, the use in an electrode of a storage battery cell of cellulose fibres in general instead of natural cellulose fibres). The patentee had taken the view that the amendment was admissible because the original application could properly be cited against the novelty of a more generic claim to cellulose fibres. The board took the view that this approach was based on a misapplication of the novelty test. The test for additional subject-matter corresponded to the test for novelty only in so far as both required assessment of whether or not information was directly and unambiguously derivable from that previously presented in the originally filed application or in a prior document respectively. An amendment was not allowable if the resulting change in content of the application, in other words the subject-matter generated by the amendment, was novel when compared with the content of the original application or, looked at another way, if the said change in content would be novelty-destroying for a hypothetical future claim when the original content would not be. It was important that it was the change in content which was tested, ie the amended content minus the original content, so that the test was applicable to amendment by generalisation or omission of a feature.

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

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

It is also clear from **T 288/92** and **T 187/91** (OJ 1994, 572) that the decisive question is whether the amendment can be directly and unambiguously deduced from the application documents as filed. In **T 288/92** the appellant/applicant contended that the amendment resulted in a limitation of the original claim. The board rejected this argument on the grounds that the expression "subject-matter which extends beyond the content of the application as filed" in Art. 123(2) EPC prohibited the introduction of any technical information which a skilled person would not have objectively derived from the application as filed, so that the examination of the allowability of an amendment according to Art. 123(2) EPC was directed to the process of "derivation" (see also **T 383/88**), as distinct from a simple comparison of the scopes of amended and unamended subject-matters. In the view of the board this provided **a definitive method** for deciding the allowability of an amendment. Any other "test", such as the "novelty test", necessarily posed hypothetical questions. On the facts of the case the board held that it was not permissible to amend a generic formula defining a class of chemical compounds by restricting an originally disclosed generic definition of a substituent to a specific (individual) one which was arbitrarily selected from chemical entities, such as in the examples, without some support for such restriction in the general part of the description (see also **T 859/94**).

In **T 187/91** the appellant requested that a patent on a fibre optic amplifier be granted. The claims in the application as filed referred to "a plurality of pump light sources",ie **two** or more light sources; the amended claims referred to "a pump light source" and, thus, sought protection for a fibre optic amplifier including **one** or more light sources. The board conceded that there was clearly a close conceptual correlation between the assessment of novelty and the assessment of what was an allowable amendment under Art. 123(2) EPC. It further explained, however, that two considerations which underlay Art. 123(2) EPC were different from those that underlay Art. 54 EPC: firstly, a reader of an application published pursuant to Art. 93(1) EPC after 18 months would be informed of the maximum extent of its subject-matter and therefore its maximum content some time before the text of the application including the claims was finalised, having regard to the drawing up of the European search report and the subsequent examination of the application. Secondly, the relationship between the claims and content of the European patent application was determined by the idea that, after appropriate amendment if necessary, the granted claims should give a fair protection for the inventive subject-matter contained in the application as filed.

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

In several decisions, the boards were required to give an opinion on interpreting the term "clearly and unambiguously derivable". These decisions also show how this criterion is applied in practice.

T 367/92 gives an example of an amendment rejected under Art. 123(2) EPC because it contained a specific term which, in the board's view, could not be considered to be clearly and unambiguously derivable from the originally disclosed generic term. In this case the issue of admissibility under said article boiled down to the question whether the generic term "polyester" could be equated with the specific term "polyethylene terephthalate". The sole document added by the appellant/patent proprietor in support of this interpretation proved only that polyethylene terephthalate was a polyester (which was never under discussion), but did not show that "polyester" could be interpreted as implicitly meaning "polyethylene terephthalate".

In **T 925/98** the originally filed documents of the patent in suit disclosed a general range of 30% to 60% and a preferred range of 35% to 50%. Referring to **T 2/81**, OJ 1982, 394, point 3; **T 201/83**, OJ 1984, 481, **T 53/82**, **T 571/89**, **T 656/92**, **T 522/96**, **T 947/96** the board stated that in the case of a disclosure of both a general and a preferred range a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range on either side of the narrower range was unequivocally derivable from the original disclosure of the patent in suit. Thus, claiming a range from 30-50 % did not contravene Art. 123(2) EPC. In the present case, further, graphs indicated that the claimed range was in fact the most efficient one.

In **T 823/96**, the question whether or not a composition containing zero percent of a UV absorber was disclosed in the application as originally filed had, in the board's judgment, to take account of the whole content thereof and could not solely be based on the isolated parts of the description relied upon by the appellant. The board also observed that the term "implicit disclosure" should not be construed to mean matter that does not belong to the content of the technical information provided by a document but may be rendered obvious on the basis of that content. In the board's judgment, the term "implicit disclosure" relates solely to matter which is not explicitly mentioned, but is a clear and unambiguous consequence of what is explicitly mentioned. Therefore, whilst common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implied by the disclosure of that document. On the contrary, these two questions must be strictly separated. The board therefore did not agree with the appellant's submission that the decision under appeal was based on an underestimation of the common general knowledge.

In **T 329/99** the board stated that a clear distinction must be made between the questions of whether a particular embodiment was disclosed by an application, be it explicitly or implicitly, or whether this embodiment was merely rendered obvious by the application's disclosure: A particular technical embodiment might be rendered obvious on the basis of the content of an application as filed without, however, belonging to its explicit or implicit disclosure and, therefore, without serving as a valid basis for amendments complying with the requirements of Art. 123(2) EPC.

In **T 917/94** the board decided that the omission of a feature of a claim did not contravene Art. 123(2) EPC, if this feature was implicitly defined by two other features and, being therefore redundant, its omission created no subject-matter extending beyond that of the application as filed.

B. Article 123(3) EPC

Art. 123(3) EPC prohibits amendments to granted claims during opposition proceedings in such a way as to extend the protection conferred by a European patent.

1. General issues

In **T 325/95** the patent proprietor amended a granted claim by introducing limiting features disclosed only in the description. The appellant/opponent argued that claim 1 as granted did not actually afford any scope of protection whatsoever, because the claim was invalid, its subject-matter lacking an inventive step. Since the features added to claim 1 were not set out in any of the dependent claims as granted, the subject-matter now covered by amended claim 1 was not covered by any of the claims. Therefore, by introducing features disclosed only in the description the scope of the claims had been extended within the meaning of Art. 123(3) EPC.

The board pointed out that this argumentation was based on the assumption that the extent of protection referred to in Art. 123(3) EPC would depend not only on the actual wording of the claims, but also on their validity in view of the prior art. This assumption however was not supported by the explicit statement in Art. 69 EPC that "the extent of the protection conferred by a European patent ... shall be determined by the terms of the claims".

Appellant's submissions in effect also implied that claims amended in opposition proceedings should always have a counterpart in the set of claims as granted. This was not in line with the consistent case law of the EPO either. Attention was drawn for instance to decision **G 2/88** (OJ 1990, 93), which ruled that replacement of a granted claim to a compound or composition by a claim directed to a new use of the compound or composition was admissible under Art. 123(3) EPC.

In **T 1149/97** (OJ 2000,259) the board decided that, without opposition, issue of a decision to grant a European patent normally constituted a cut-off point for making amendments to the application documents in the European proceedings. If an opposition has been filed, cut-off effects due to the grant of a patent might be seen in the restrictions which R. 57a EPC, R. 87 EPC and Art. 123(3) EPC imposed on further amendment of the patent specification. Although Art. 123(3) EPC addressed only the claims of the European patent, amendments to the description and the drawings might also extend the protection conferred in accordance with Art. 69(1) EPC.

If, in view of Art. 84 and 69 EPC, the application documents were adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule subject-matter deleted for this reason could not be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) EPC. An analogous finding applied to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention.

In **T 666/97** the product claim of the auxiliary request no longer included a process feature which was included in the product claim as granted. In the board's view it followed from the fact that the subject-matter for which protection was claimed in the auxiliary request was a product that it could only be characterised by features manifest in/on the product itself. That meant that manipulations taking place during product manufacture but not resulting in product features were of no relevance to the definition of the claimed product and hence to the scope of protection of the claim. That was an unavoidable implication of the established case law of the boards of appeal, under which the subject-matter of a product-by-process claim derives its novelty not from new procedural steps but purely from structural features (see **T 205/83**, OJ 1985, 363).

Thus, to resolve the issue of compliance with the requirements of Art. 123(3) EPC, what had to be decided was whether the omitted product-by-process feature was technically significant for the definition of the claimed product, ie whether it was a product feature. The board found that in the present case the omitted feature was not a product feature. Thus the claim had not been extended within the meaning of Art. 123(3) EPC.

2. Generalisation of a feature

The board of appeal held in its decision **T 371/88** (OJ 1992, 157) that Art. 123(3) was not contravened if a restrictive term in a granted claim which in its strict literal sense did not embrace an embodiment set out in the description was replaced by a less restrictive term. The restrictive term should not, however, be so clear in its technical meaning in the given context that it could be used to determine the extent of protection without interpretation by reference to the description and drawings. Moreover, it had to be quite clear from the description and drawings and also from the examination procedure up to grant that the further embodiment belonged to the invention and that it was never intended to be excluded from the protection conferred by the patent.

In **T 795/95** the board did not share the appellant's view that deleting the feature "preferably polyvinyl or polyethylene" from the preambule of granted Claim 1 extended the protection conferred.

The formulation "preferably polyvinyl or polyethylene" had no bearing on the scope of protection, which was determined by the more general term "plastic" and not the specific preferred substances polyvinyl or polyethylene. Deleting a "preferred" feature did not extend the scope of protection if such feature was encompassed by an earlier and general one (in this case: "plastic") which determined the protection conferred.

3. Moving features from preamble to characterising portion

In **T 16/86** the board pointed out that it was the subject-matter of the claim as a whole which embodied the invention. Therefore, in so far as a change in the position of a feature inside a claim did not alter its meaning, the extent of protection conferred remained unchanged and such an amendment contravened neither Art. 123(2) EPC nor Art. 123(3) EPC.

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

In **T 96/89** the board of appeal again allowed the transposition of features from the preamble of a claim to its characterising portion. This did not alter the subject-matter claimed, and thus did not extend the scope of protection. Nor was it in breach of Art. 123(3) EPC if terms were first generalised in the preamble, then trimmed back in the characterising portion to the subject-matter originally disclosed. R. 29(1) EPC required that claims be delimited against the nearest prior art; before the preamble to an independent claim could be drafted at all it was often necessary to select from two restrictive terms (the subject-matter claimed and the closest prior art) a general term covering both.

In **T 49/89** the subject-matter of granted claim 1 had been limited during opposition proceedings to a special embodiment according to granted dependent claim 2. The board of appeal held that the protection had not been extended because new claim 1 indicated all the features in granted claim 1 and the newly incorporated features were merely elaborations on those contained in granted claim 1. The extent of protection conferred by a European patent was determined by the content of **all** claims, not that of one or several only. Thus, for example, even though an independent claim lacked novelty a claim dependent on it could still be valid and the patent proprietor could restrict himself to that claim. It was, moreover, irrelevant when determining the extent of protection whether features were referred to in the prior art portion or characterising portion. The transposition of information from one to the other did not therefore contravene Art. 123(3) EPC.

4. Change of claim category

Enlarged Board decision **G 2/88** (OJ 1990, 93) related to a change of claim category in opposition proceedings, and in particular to the change from a product claim to a use claim. It stated that a change of category of granted claims in opposition proceedings was not open to objection under Art. 123(3) EPC, if it did not result in extension of the protection conferred by the claims as a whole, when they were interpreted in accordance with Art. 69 EPC and its Protocol. In this context, the national laws of the contracting states relating to infringement should not be considered, for there was a clear distinction between the protection which was conferred and the rights which were conferred by a European patent. The protection conferred by a patent was determined by the terms of the claims (Art. 69(1) EPC), and in particular by the categories of such claims and their technical features. In contrast, the rights conferred on the proprietor of a European patent (Art. 64(1) EPC) were the legal rights which the law of a designated contracting state might confer upon the proprietor. In other words, in general terms, determination of the "extent of the protection conferred" by a patent was a determination of what was protected, in terms of category plus technical features; whereas the "rights conferred" by a patent were related to how such subject-matter was protected.

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

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

In **T 912/91** the appellant/patentee claimed the use of graphite for obtaining a sintered composite ceramic body having certain characteristics. The board held that the change of claim category from the granted product claims for composite bodies to these use claims did not broaden the scope of protection of the granted claims. Even if it were considered that the use claim was notionally equivalent to a claim to a process including the step of using the graphite in the sintered body and that the effect of Art. 64(2) EPC was to confer protection on the product resulting from this process as well, this would not represent an extension of protection within the meaning of Art. 123(3) EPC, since the sintered composite body was defined in the use claim in a more restricted way than the composite body of the granted claim (narrower range of the graphite content, etc.).

In **T 134/95** a patent had been granted in respect of a "container for medical use". The claimed apparatus was designed to permit the separate storage and the mixing, at the time of use, of three predefined and different compounds. The protection conferred therefore related to the apparatus and, necessarily, to its use at least for the purposes of storage and mixing. After amendment, the claim became a use claim, covering only the use of the container and no longer protecting the apparatus as such.

Having pointed out that inventions of this kind were designed with a particular object in mind and could not normally be used for other purposes, the board noted that in this case, the change of category, replacing the granted claim with a claim for the use of the container, had the effect of limiting the scope of protection. The amendment was therefore allowable.

Contrary to the opponents' allegation that a "drip solution" was obtained, the board concluded that the use of the container did not lead to the manufacture of a product; on the contrary, its purpose was to carry out two successive handling operations (the separate and sterile storage of each of the three solutions, and then the sterile compound mixing of these solutions at the time when they were administered) as explicitly stated in the granted claim (in respect of compartments for "separate storage and subsequent mixing, immediately before use" of the three solutions). The intended purpose was to conserve each of the three solutions during the storage phase (and to mix them immediately before use, avoiding any premature change of the mixture). The two stages of the process therefore in no way had the effect of modifying the starting solutions with a view to obtaining or manufacturing a product. This use therefore fell into the category "use of a physical entity to obtain an effect or result", and on this basis the change of category was allowable.

In **T 279/93** the board found that a claim to the use of a compound A in a process for preparing compound B had no broader scope than a claim to a process for preparing compound B from compound A. It had already been stated in **G 2/88** (see point 2.5) that the technical features of a claim to an activity were the physical steps which defined such activity. In this case, the board considered that process claim 1 as filed, process claim 1 as granted and use claim 1 filed on appeal all related to the same physical steps, and that the claims were therefore of the same scope. On this view, the scope of protection conferred by this use claim was not broader than that conferred by the granted process claim (see **T 619/88**).

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

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

In **T 276/96** the board decided in view of **G 5/83** (OJ 1985, 64) that the change of claim of the type "Method of fabricating item A using item B providing effect C" to a claim of the type "Use of item B in a method of fabricating item A to provide effect C" did not extend the protection conferred, since with both formulations the same activity would be forbidden to competitors.

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

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

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

In **T 20/94** the patent in suit in the form as granted exclusively comprised process claims for preparing a product. In the form as amended it comprised a product claim relating to the product per se.

The board stated that the protection conferred by a claim directed to a process for preparing a product covered that process. Pursuant to Art. 64(2) EPC, a product directly obtained by that process was also protected, but it was not protected when obtained by any other process. However, the protection conferred by a claim directed to a product per se was absolute upon that product. The product claim thus conferred protection on that product regardless of the process by which it was prepared.

The appellant attempted to overcome this objection by formulating the product claim as amended in the form of a product-by-process claim using the term "directly obtained". The board did not agree with this line of argument, stating that a product-by-process claim was interpreted as a claim directed to the product per se, since the only purpose of referring to a process for its preparation was to define the subject-matter for which protection was sought, which was a product. Whether or not the term "directly obtained" or any other term, such as "obtained" or "obtainable", was used in a product-by-process claim, the category of that claim did not change. Thus amended claim 1 in the case in question contravened Art. 123(3) EPC.

In **T 426/89** (OJ 1992, 172) the claim related to a process for operating a pacemaker. An actual operating method for a pacemaker for arresting a tachycardia would necessarily be a method for treating the human (or animal) body by therapy using a pacemaker, and would not be patentable. However, the patentee maintained that the claim referred to the steps in a technical method which did not define a method of treatment but rather, in functional terms, the structural features of a pacemaker. The board agreed. If correctly interpreted in accordance with Art. 69(1) EPC, second sentence, claim 1 did not define a method but rather an apparatus (pacemaker) in terms of the functions of its components. Since the reference to a method in the designation of the subject-matter of claim 1 did not make this explicit, the board regarded claim 1 as not "clear" within the meaning of Art. 84 EPC. The differences between the patent according to the auxiliary request and the granted version were that in claim 1 the title of the invention, "Method for the operation of a pacemaker", had been replaced by "Pacemaker". The board pointed out that the amendment of claim 1, including its change of category, did not contravene Art. 123(3) EPC. Claim 1 as granted was already a product claim containing a functional definition of a pacemaker. So the seeming change of category did not alter the content of the claim but simply served to clarify it (see also **T 378/86**, OJ 1988, 386).

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

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

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

1. Cases of conflict

In **T 384/91** (OJ 1994, 169) the question was referred to the Enlarged Board whether, given the requirements of Art. 123(2) and (3) EPC, a patent could be maintained in opposition proceedings if its subject-matter extended beyond the content of the application as filed, whilst at the same time the added feature limited its scope of protection. The conflict here was that the "limiting extension" had to be deleted as a breach of Art. 123(2) EPC, but to do so would broaden the scope of the patent and thus contravene Art. 123(3) EPC. The case was dealt with under reference number **G 1/93** (see above, III.A.1.2).

This problem was extensively discussed for the first time in **T 231/89** (OJ 1993, 13). In this decision, an additional, limiting feature was added to the claim during grant proceedings. The opposition division revoked the patent on the grounds that the feature had not been disclosed in the application as originally filed but its deletion would contravene Art. 123(3) EPC.

The board of appeal held it to be inappropriate to take paragraphs 2 and 3 of Art. 123 EPC as independent of each other while applying them in conjunction to revoke the patent. This "paradoxical result" could be avoided by interpreting the two paragraphs in terms of their mutual relationship, where one was predominant, ie independent, and the other subordinate, ie dependent:

(a) If Art. 123(2) EPC was predominant, the added feature would have to be deleted in spite of Art. 123(3) EPC;

(b) If Art. 123(3) EPC was to be taken as independent, the added feature could remain.

If the limiting feature was irrelevant for novelty and inventive step, it seemed reasonable to opt for alternative (b); protection of third parties was then crucial. If, on the other hand - as was the case here - the added feature had no technical significance, then alternative (a) seemed appropriate and, thus, the deletion of the feature justified.

In **T 10/91** a neutral feature of no particular value for the skilled person was added during the examination proceedings. The feature had no technical significance. It could therefore stay in the claim, but could not be taken as delimiting when examining for novelty and inventive step.

In **T 938/90**, however, the addition was technically significant and it had to be taken into account in the examination for novelty and inventive step. The board therefore declined to apply the principles developed in **T 231/89** and dismissed the patent proprietor's appeal against the revocation of the patent (see **T 493/93**).

2. Decision of the Enlarged Board of Appeal

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

If a European patent as granted contained subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC and which also limited the scope of protection conferred by the patent, such patent could not be maintained in opposition proceedings unamended, because the ground for opposition under Art. 100(c) prejudiced the maintenance of the patent. Nor could it be amended by deleting such limiting subject-matter from the claims, because such amendment would extend the protection conferred, which was prohibited by Art. 123(3) EPC. Therefore, in principle, if the European patent as granted contained a "limiting extension", it had to be revoked. Paragraphs 2 and 3 of Art. 123 EPC were mutually independent of each other. In this sense, it had to be admitted that Art. 123(2) EPC in combination with Art. 123(3) EPC could operate rather harshly against an applicant, who ran the risk of being caught in an inescapable trap and losing everything by amending his application, even if the amendment was limiting the scope of protection. However, as submitted by the opponent, this hardship was not per se a sufficient justification for not applying Art. 123(2) EPC as it stood in order to duly protect the interests of the public. Nor did it, in principle, matter, that such amendment had been approved by the examining division. The ultimate responsibility for any amendment of a patent application (or a patent) always remained that of the applicant (or the patentee).

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

- If the added feature could be replaced by another feature disclosed in the application as filed without breaching Art. 123(3) EPC, the patent could be maintained (in amended form). This might turn out to be a rare case in practice (see infra, **T 166/90**).

- An added undisclosed feature without any technical meaning could be deleted from a claim without violating Art. 123(3) EPC.

- An added feature, which did not provide a technical contribution to the subject-matter of the claimed invention but merely limited the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, was not considered as subject-matter which extended beyond the content of the application as filed within the meaning of Art. 123(2) EPC. In this case also the patent could be maintained (see III.A.1.2).

3. Resolving the conflict in exceptional cases

In some cases the conflict between Art. 123(2) and (3) EPC can be resolved. In **T 166/90** the board allowed an inadmissible feature in a granted claim to be replaced by other disclosed features, since this did not extend the scope of protection. The invention concerned an opaque plastic film. The product claim as granted contained a feature stating that the density of the film was less than the arithmetical density from the type and proportion of the individual components. In opposition proceedings the patent proprietor claimed a process for manufacturing the film, but without including in his process claim the density-related feature. The board examined whether this would broaden the scope of the patent, asking if the process claim features which replaced the deleted feature necessarily limited the claim to films - like that in the granted product claim - with a density less than the arithmetical one. The board concluded that, with a probability bordering on certainty, the process now claimed would produce an opaque film of a density less than that arithmetically derivable from the type and proportion of its individual components. Thus, deleting the density-related feature had not in fact extended the scope of protection.

In **T 108/91** (OJ 1994, 228) the board concluded that Art. 123(3) EPC was not contravened when an incorrect technical statement which was evidently inconsistent with the totality of the disclosure was replaced by an accurate statement of the technical features involved. This case concerned a container-closure arrangement, which, according to information later included in the claim, was unstressed, whereas it was clear from the description that this part was in fact under tension. **T 673/89**, **T 214/91** followed **T 271/84** (OJ 1987, 405), **T 371/88** (OJ 1992, 157) and **T 438/98**, in ruling that amending a claim to remove an inconsistency did not contravene Art. 123(2) or (3) EPC if the claim as corrected had the same meaning as the correct interpretation of the uncorrected claim in the light of the description.

In **T 553/99** the board stated that if a claim as granted contained an undisclosed, limiting feature in contravention of Art. 123(2) EPC it could be maintained in the claim without violating Art. 123(2) EPC provided that a further limiting feature was added to the claim which further feature was properly disclosed in the application as filed, and deprived the undisclosed feature of all technical contribution to the subject-matter of the claimed invention.

D. Rule 88 EPC, second sentence

In **J 42/92** the board had to decide whether a request under R. 88 EPC, second sentence, can be made after grant. It came to the conclusion that a request under R. 88 EPC for amendments to the description or claims may only be filed during the pendency of application or opposition proceedings. Under Art. 97(4) EPC, the decision to grant a European patent takes effect on the date on which the European Patent Bulletin mentions the grant. After this date, R. 88 EPC can only be applied while opposition proceedings are pending. In the case at issue, the decision to grant the patent had already taken effect, and no opposition had been filed. The appeal had therefore been dismissed, since the EPO had ceased to have jurisdiction to consider a request under R. 88 EPC at the time when the request was filed.

The board also pointed out that there is no reason why, once no application or opposition proceedings are pending before the EPO, decisions on the question of corrections (bearing in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question may arise.

1. Relation to Article 123(2) EPC

The boards have been called upon several times to discuss the question whether a correction under R. 88 EPC, second sentence, could be allowed even if the requested amendment would constitute an extension of protection within the meaning of Art. 123(2) EPC over the disclosure made on the date of filing. In decisions **T 401/88** (OJ 1990, 297) and **T 514/88** (OJ 1992, 570) the answer was negative. In **T 200/89** (OJ 1992, 46) the board took a similar view with regard to Art. 123(3) EPC and concluded that requests for correction under R. 88 EPC and requests for amendment under Art. 123 EPC had to be considered separately.

A further question was whether, for the purposes of correction under R. 88 EPC, second sentence, the evidence that nothing else would have been intended than what was offered as the correction could take the form of documents filed only after the application. On this point a different conclusion was reached in **T 401/88** (OJ 1990, 297) than in **J 4/85** (OJ 1986, 205). As a result of referrals by the President of the EPO (**G 3/89**, OJ 1993, 117) and by a board of appeal (**G 11/91**, OJ 1993, 125) both questions came to be decided by the Enlarged Board. The Enlarged Board's conclusion was that the parts of a European application or patent relating to the disclosure (description, claims and drawings) could be corrected only within the limits of what the skilled person would derive directly and unambiguously, using common knowledge and seen objectively and relative to the date of filing, from the whole of these documents as originally filed. Such a correction was of a strictly declaratory nature and thus did not infringe the prohibition of extension under Art. 123(2) EPC. Other documents - notably priority documents and the abstract - could not be used for correction purposes even if filed together with the application, but could, however, be adduced as evidence of common general knowledge on the date of filing. Evidence of what constituted such knowledge on that date could be furnished in any suitable form. And documents not relating to the disclosure could, under certain circumstances, be included partially or wholly in the disclosure by means of reference.

No correction was possible if there was any doubt as to whether a mistake existed, or whether nothing else could have been intended other than what was offered as the correction.

In **T 1008/99**, the request for correction of errors concerned a European divisional application which had been filed with a wrong description not related to the earlier (parent) application. The wrongly filed description should therefore be replaced by the description of the parent application.

A divisional application under Art. 76 EPC is, according to established case law, to be examined quite separately from its parent application and must itself comply independently with all the various requirements of the EPC. The board held that for the purposes of R. 88 EPC, the error therefore had to be **apparent from the divisional application itself**, and the parent application could not be used to demonstrate that the error was obvious. Even if it was apparent from the filed description, claims and drawings that they did not belong together, it was not immediately clear from the divisional application itself which of these parts was not correct. For that reason alone the requested correction under R. 88 EPC, second sentence, was not allowable.

Moreover, according to decision **G 2/95** (OJ 1996, 555), point 2 of the reasons, the interpretation of R. 88 EPC, second sentence, had to be in accord with Art. 123(2) EPC, which meant that a correction under R. 88 EPC was bound by Art. 123(2) EPC, in so far as it related to the content of the European patent application as filed. A correction could therefore be made only within the limits of the content of the parts of the application which determined the disclosure of the invention, namely the description, claims and drawings. Other documents could only be used for proving what was common general knowledge on the date of filing. As far as a divisional application pursuant to Art. 76 EPC was concerned, the content of the application which determined the disclosure was that of the divisional application as filed, rather than that of the earlier (parent) application.

2. Obviousness of the error and the correction

In the past, the boards have allowed corrections under R. 88 EPC, second sentence, provided it was immediately evident to the skilled person that an error had occurred and how it should be corrected. In **T 640/88** and **T 493/90** the required correction to an error in the claim was evident from the description. In **T 488/89** the reference to a parallel application enabled the skilled person to establish without difficulty the correct limit values. In **T 365/88** it was ruled that an abbreviation in the claim could be corrected because it appeared correctly in the description; an additional Roman numeral I in the abbreviation of an enzyme was implicitly disclosed because at the time of filing only one enzyme of this type was known, and clarification prevented confusion with enzymes of the same type discovered at a later date.

In **T 990/91** the board allowed the correction of a chemical name on the grounds that an obvious error had been made in naming a salt which was the subject-matter of the application - the molecular formula of this salt was clear from the application. However, the molecular formula corresponding to the name was different. Guided by the content of the application and taking into account cited documents which were published before the priority date of the application in question, the correction required would be immediately evident to the skilled person.

In **T 417/87** the board of appeal allowed the number of a publication cited in the original description to be corrected under R. 88 EPC, second sentence. In **T 158/89**, however, correction of a percentage range of a component was not allowed. In the board's view, the skilled person could have deduced from inconsistencies in the claims and description that an error had occurred. However, there were two plausible ways of correcting it. Since the skilled person would have regarded both alternatives as equally plausible, it was not immediately obvious that nothing else had been intended other than the proposed correction.

In **T 606/90** the board allowed a correction pursuant to R. 88 EPC, second sentence, in the opposition proceedings although the correction was not so obvious from the published text of the patent that it was immediately evident that nothing other than the proposed correction could have been intended. The applicant had filed typed amendments to the claims and the description and had also submitted the "working document" with the handwritten corrections for the dossier. The typed version of claim 1 omitted the detail which was now the subject of a request for correction pursuant to R. 88 EPC; the same detail was present in the corresponding passage in the description. When the text was being prepared for publication of the patent, the detail in question was also omitted from the description owing to an error by the EPO. The board concluded that the omission in the description should not be taken into account when considering the admissibility of the correction and stated:

"It is therefore clear that the phrase in question was omitted from the typed version of claim 1 as a result of an error by the applicant and that the reader of the patent would immediately have noticed the need for correction of this error if a transcription error had not likewise been committed by the EPO. The correction requested is therefore admissible within the terms of R. 88 EPC".

In **T 955/92** the appellant requested that under R. 88 EPC the words "silica" and "alumina" in the claims and description be replaced by "silicon" and "aluminium" respectively. It argued that the ambiguous expression "silica to alumina atomic ratio" could only have two meanings, either "silicon to aluminium atomic ratio" or "silica to alumina molar ratio" and that it was evident to a skilled person that the correction could only be as requested.

The board did not share this view. It accepted that a mistake was obvious and that the interpretation according to the correction sought was more likely than the alternative. However, referring to **G 3/89** (OJ 1993, 117), it emphasised that the correction should be unambiguously derivable by a skilled person, using common general knowledge, from the description, claims and drawings of the patent application on the date of filing. The board held that in the case in point the reasons given by the appellant to show that only the requested correction could have been intended were not based on the level of general knowledge on the date of filing. In order to arrive at the conclusion that the requested correction was the only physically meaningful one, experiments had had to be performed which needed more than common general knowledge, and the results thereof would not have been available on the date of filing.

E. Standard of proof for allowing amendments and corrections

In **T 383/88** the board held that the normal standard of proof in proceedings before the boards of appeal, namely "the balance of probability", was inappropriate for determining the allowability of an amendment under Art. 123(2) EPC. Instead, a rigorous standard, ie one equivalent to "beyond reasonable doubt" was considered by the board to be the right one to apply in such a case, since applying a lower standard could easily lead to undetected abuse by allowing amendments on the basis of ostensibly proven common general knowledge.

It had frequently been argued that certain technical features could be directly and unambiguously derived from a specification as filed by reading it in the light of common general knowledge. However, the board recommended viewing this approach with considerable caution. Firstly, the issue of the allowability of an amendment under Art. 123(2) EPC had to be decided by reference to what could be derived from the patent application as filed in the light of common general knowledge and not vice versa. Secondly, it was notoriously difficult to prove common general knowledge. For example, information might be generally disseminated, and therefore known within the community of skilled addressees, but it might well, at the same time, not be commonly accepted. Furthermore, too much reliance could not be placed on affidavit evidence from over-qualified persons, for the relevant knowledge was that of a notional, ie average, skilled addressee, and not that commanded by leaders in the relevant scientific discipline or field. The board added that it could not normally be the case that an affidavit by a single person was sufficient to discharge the burden of proof to the strict standard that was required.

In **T 581/91** the board held that the balance of probabilities was not an appropriate criterion to be applied in a case where a correction under R. 88 EPC was at stake. Following decision **T 383/88**, the board stated that a more rigorous standard, that is one equivalent to "beyond reasonable doubt", ought to be applied.

In **T 795/92** the board stated that Art. 123(2) EPC clearly precluded allowing an amendment if there was any doubt as to whether or not it was derivable from the original application. In the case at issue an upper limit of 89% indicated in claim 1 of the main request for the degree of nickel reduction was not expressly mentioned in the application as filed. The board decided that, in spite of a certain probability in favour of the appellant/patentee's position, the amendment was not allowable because there were various known methods for calculating this value, not all leading to identical results, and the application did not directly and unambiguously disclose which method had to be used.

As to extension of the protection conferred, see **T 113/86** (VI.J.5 c); VII.C.10.1.2).

IV. PRIORITY

The EPO does not normally check the validity of a priority right during examination. A check must be made, however, if relevant prior art has been made available to the public within the meaning of Art. 54(2) EPC on or after the priority date claimed and before the date of filing or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3) EPC, such other application claiming a priority date within that period and definitively designating one or more of the same states (see Guidelines C-V, 2.1).

Arts. 87 to 89 EPC provide a complete, self-contained code of rules on claiming priority for the purpose of filing a European patent application (see **J 15/80**, OJ 1981, 213). However, since the EPC - according to its preamble - constitutes a special agreement within the meaning of Art. 19 of the Paris Convention, it is clearly intended not to contravene the basic principles concerning priority laid down in the latter (see **T 301/87**, OJ 1990, 335, Reasons for the Decision, 7.5; **G 3/93**, OJ 1995, 18, **G 2/98**, OJ 2001, 413).

A. Applications giving rise to a right of priority

1. National deposit of industrial design

In **J 15/80** (OJ 1981, 213) it was held that a priority right based on the deposit of an industrial design was not recognised for a European patent application. As the EPC was a special agreement within the meaning of Art. 19 of the Paris Convention, a general understanding by the contracting states to the EPC that the deposit of an industrial design clearly gave a priority right for a national patent application could, by application of Art. 4 of the Paris Convention, lead to an interpretation of Art. 87(1) EPC going beyond its terms and permitting such deposits to give priority rights for European patent applications. However, in the absence of such a general understanding there was no reason to read Art. 87(1) EPC more broadly than its express terms and scope required.

In the board's opinion it was the law under the Paris Convention that, in relation to patent applications, a right of priority under that Convention existed if the prior application was for the protection of an invention as such and contained a disclosure of it. The deposit of an industrial design in essence protected aesthetic appearance. Although the deposited design might incorporate an invention, according to national design laws the deposit would not protect the invention as such.

2. Postdating of the previous application

Swiss patent law allows a patent application to be postdated if it is subsequently amended. In **T 132/90** the patent proprietor had claimed 11.3.1983, the original filing date of the earlier Swiss application, as the priority date for their European application dated 9.3.1984. In 1985 the Swiss Patent Office ordered that the filing date of the Swiss patent application be set at 1.7.1983 following subsequent completion of the technical documentation.

The board of appeal concluded that the original application should serve as the basis for claiming a priority right and that the priority date was the filing date of the original application. The postdating order did not have ab initio effect, and the subsequent fate of the original application was immaterial as far as the priority date was concerned. Furthermore, the patent proprietor had only claimed a priority right with respect to the Swiss patent application with the filing date of 11.3.1983, not for the subsequently filed amendments.

B. Identity of invention

In accordance with Art. 87 EPC a European patent application is only entitled to priority in respect of the same invention as was disclosed in the previous application.

1. Disclosure in the earlier application of the invention claimed in the subsequent application

1.1 Interpretation of the concept of "the same invention" referred to in Art. 87(1) EPC

In opinion **G 2/98** (OJ 2001, 413) the Enlarged Board of Appeal addressed the whole concept of "the same invention" in Art. 87(1) EPC. In recent years, boards have applied different yardsticks to assess identity of invention between a previous and subsequent application. One was to check whether all the features of the invention claimed in the European patent application were disclosed in the priority document ("novelty test"). In **T 311/93** and **T 77/97** in particular, boards looking at the validity of priority claims continued to apply the criterion of at least implicit disclosure used for the disclosure test under Art. 123(2) EPC. Other decisions however followed the principle, developed in "Snackfood" (**T 73/88**, OJ 1992, 557), that adding non-essential features which merely limited the scope of protection did not invalidate the priority claim. **T 73/88** allowed a claim to enjoy priority despite containing an additional feature not disclosed in the earlier application.

In **G 2/98** the Enlarged Board of Appeal, ruling on points of law referred by the President regarding the interpretation of Art. 87(1) EPC, first considered whether interpreting "the same invention" narrowly was consistent with the relevant Paris Convention and EPC provisions. A narrow interpretation means that the subject-matter of a claim which defines the invention in a European patent application - ie the specific combination of features in that claim - has to be at least implicitly disclosed in the application whose priority is claimed. The Enlarged Board held that a broad interpretation, distinguishing between those technical features which related to the function and effect of the invention and those which did not - with the result that an invention could still be considered "the same" even if a feature were amended, deleted or added - was inappropriate and inconducive to proper exercise of priority rights. To ensure a practice fully consistent inter alia with equal treatment for applicants and third parties, legal certainty and the principles for assessing novelty and inventive step, "the same invention" had to be interpreted narrowly and in a manner equating it to "the same subject-matter" in Art. 87(4) EPC. This interpretation was underpinned by the Paris Convention and the EPC, and was entirely consistent with opinion **G 3/93** (OJ 1995, 18). The Enlarged Board therefore ruled as follows on the points of law referred to it:

The requirement for claiming priority of "the same invention", referred to in Art. 87(1) EPC, means that priority of a previous application in respect of a claim in a European patent application in accordance with Art. 88 EPC is to be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.

The principles laid down by the Enlarged Board in **G 2/98** mean that many statements made in decisions based in particular on **T 73/88** (holding that adding non-essential and merely scope-limiting features did not invalidate a priority claim) are no longer relevant (eg **T 16/87**, OJ 1992, 212, **T 582/91**, **T 255/91**, OJ 1993, 318, **T 669/93**, **T 1056/93** and **T 364/95**, see also Case Law of the Boards of Appeal, 3rd edition, points IV.B.1.3.3, "Routine choice" and IV.B.4, "Limiting the extent of protection").

The older case law which devised the "novelty" and "disclosure" tests still applies following **G 2/98**. This is that two applications relate to "the same invention" within the meaning of Art. 87 EPC when they both contain "the same subject-matter". The invention or subject-matter of a previous application is to be considered identical to that of a subsequent one if the disclosure of both applications is the same (**T 184/84**). Disclosure in the previous application means that the subject-matter of the claims of the European application must be clearly identifiable in the documents of the previous application taken as a whole (**T 81/87,** OJ 1990, 250, **T 359/92**, **T 469/92**, **T 597/92, T 296/93** and **T 620/94**). Identical wording is not required (**T 81/87** (OJ 1990, 250) and **T 184/84**).

In **T 136/95** (OJ 1998, 198), the board stated that identity of invention has to be assessed by reference to the skilled person. A patent application is a technical document, addressed to the skilled person, not a work intended for the general reader. However, the skilled person is not familiar, unlike in the assessment of inventive step, with all the prior art, but only with those elements of it which form part of his general knowledge, and it is on the basis of this knowledge, or by carrying out simple operations derived from it, that he may infer whether or not there is identity of invention.

The board came to the conclusion that it was necessary to give some flexibility to the requirement for identity of invention between the two applications. Some features claimed in the European application need not be expressly mentioned in the previous application whose priority is claimed, provided that the skilled person is able, purely on the basis of his knowledge or by performing simple operations to carry out the invention, to infer these features from the prior application. In the case in question a structural feature claimed in the European patent application was supported by a general functional feature described in the prior application.

1.2 Disclosure in the previous application as a whole

Under Art. 88(4) EPC it suffices if the features claimed in the later application are disclosed by the earlier application taken as a whole (**T 497/91**, **T 184/84** and **T 359/92**). Art. 88(4) EPC cannot be construed as meaning that a priority document must comprise claims in order to form a regular national filing within the meaning of Art. 87(3) EPC which can give rise to a right of priority. If the priority document does not include any claims, this does not mean that the conditions of Art. 88(4) EPC are not fulfilled (**T 469/92**). Features of the invention may also be disclosed in the drawings (**T 169/83**, OJ 1985, 193, Reasons for the Decision, point 4.2).

1.3 "Essential" features

1.3.1 Disclosure of the essential features in the priority document

In order to give rise to priority all the essential elements, ie features of the invention in the priority document must be either expressly disclosed or directly and unambiguously implied by the text as filed. The question therefore arises as to what constitutes the essential elements, ie features of the invention, claimed in the European patent application, and whether or not these features are disclosed in the respective priority documents (see Art. 88(4) EPC, **T 81/87**, OJ 1990, 250, **T 65/92**, **T 127/92** and **T 296/93**).

In **T 923/92** the board maintained a patent on a process comprising the preparation of a protein with (further specified) human tissue plasminogen activator function. The subject-matter of the claim was defined by means of reference to an amino acid sequence. The sequence contained in the European application was disclosed for the first time in the third priority document (P3). It differed from the sequence reported in the first and second priority documents (P1 and P2) in respect of three amino acids in positions 175, 178 and 191.

The board held that only the priority of P3 could be claimed. In the board's judgment, the skilled person would consider the primary amino acid structure of a protein to be an essential feature thereof because it represented its chemical formula. He would therefore consider the reference to the amino acid sequence of a protein as having not merely an informational character but as being a primary technical feature linked to the character and nature of the product. When comparing the sequences reported in P1/P2 and in P3, the skilled reader, could not know whether, in spite of the differences, the sequences were identical in their physical and biological characteristics; at least on paper the quoted replacements of amino acids could imply important structural and functional differences. The evidence submitted by the patentee was understandably restricted to the testing of a limited number of parameters and left open the possibility that the two polypeptides could differ in many other properties.

In **T 172/95** the appellent/opponent challenged the validity of a priority claim, arguing that for the copolymer the subsequent European application contained information not to be found in the priority document. The board did not follow this argument. As to the objections concerning the fractionation method the appellant could provide no evidence whatsoever for his allegation that the differences which were present would result in different ethylene polymers being claimed in the priority document and in the patent in suit. In contrast, the respondent provided evidence of the contrary.

Regarding the calculation methods for two parameters defining the claimed copolymer the board pointed out that the passage not present in the priority document did not change anything in the actual method of determination of these parameters, but merely specified how a person skilled in the art would normally operate. Therefore, the introduction of the above passage into the application as filed did not change anything in the definition of the copolymer, hence did not in substance modify the teaching of the priority document. Whereas in the priority document the copolymer could have one or more melting points, in the subsequent European application the possibility of two melting points was excluded.

The board found, however, that a comparison of the descriptions of the previous and the subsequent application showed that the objectives of the invention remained the same. The features which were decisive for the desired balance of properties were not the number of melting points, but other ones. There was no evidence that the number of melting points would play a technical role in the sense of being essential to achieve the invention's objectives. Accordingly, a change in the character and nature of the invention as defined in the priority document could not be identified.

1.3.2 Lack of disclosure of an essential feature

Essential elements missing in the priority document and recognised as essential only later on, are not part of the disclosure of the previous application and there is then no right to priority (**T 81/87**, OJ 1990, 250, **T 301/87**, OJ 1990, 335, Reasons for the Decision, point 6.3, **T 269/87** and **T 296/93**).

In **T 1054/92** of 20.6.96, claim 1 contained the feature that the absorbent structure had a moisture content of less than 10%. This feature could not be derived from the disclosures in the first and second priority documents. The said upper limit was only introduced by the third priority document. The board could accord to the subject-matter of claim 1 only the third priority date. The feature concerning the moisture content of less than 10% was an essential element. This was made clear by the statement in the description that "in order to ensure that the structure remains substantially unbonded the moisture content of the absorbent structure must be less than about 10% by weight of the dry absorbent structure". Furthermore, the relevant feature appeared in claim 1 as originally filed and was relied upon by the appellant in the examination proceedings when seeking to distinguish the subject-matter of this claim from cited prior art (cf. **T 1052/93**).

In **T 828/93**, priority was denied because three features added to Claim 1 were not disclosed in the priority documents and did not purely limit the extent of protection by, for example, omitting a number of given alternatives or part of a range of numbers (without any special effect being thus obtained); rather they affected the course of the claimed process and the arrangement of the claimed apparatus.

1.3.3 Error margins and definitions of limits

Prior to **G 2/98**, it was sometimes possible to claim error margins or definitions of limits which differed in the subsequent application from the original one. How far such decisions may still apply is not yet clear. This concerns in particular **T 212/88** (OJ 1992, 28), **T 957/91, T 65/92** and **T 131/92** (see also "Case Law of the Boards of Appeal", 3rd edition, points IV.B.1.3.4 and 1.3.5).

1.4 Disclosure in the claims of the previous application

T 409/90 (OJ 1993, 40) showed that a broad claim in the previous application was not necessarily a suitable basis for a priority right. This decision was based on the principle that what was disclosed by a priority document was what could be deduced from the priority document as a whole by a person skilled in the art. However, when considering what was disclosed in a priority document's claim it was necessary to bear in mind the purpose of the claim, ie to define the protection sought. The fact that a claim in a priority document was broad enough to cover specific subject-matter filed for the first time in a later application was not by itself sufficient evidence that such subsequently filed subject-matter had already been disclosed in the priority document, or that subsequent claims based on the later-filed subject-matter still defined the same invention as that which was the subject of the priority document.

1.5 Selection from generic formula

T 77/97 related to a case in which two dependent claims 4 and 5 of a European application related to individual compounds which were part of the group defined by the generic formula of claim 1. Claim 3 of the priority document defined by means of a generic formula a group of four chemical compounds, including the compounds according to the two claims 4 and 5 of the subsequent European application.

The board acknowledged that the priority document contained sufficient information for a skilled person to obtain without difficulty the four chemical compounds according to the generic formula of claim 3. However, this affirmative conclusion could not automatically lead to the recognition of the priority in relation to claims 4 and 5 concerned. With reference to decision **T 409/90** (OJ 1993, 40, see above), the board pointed out that it was not sufficient to establish that the compounds concerned fell within the scope of the claims of the previous application, and that they could be prepared without difficulty in accordance with the information contained in this application.

The expression "the same invention" as used in Art. 87(1) EPC had to be interpreted in conformity with the requirements of Art. 88(2) to (4) EPC. Before a decision on the claimed priority could be taken, it was first necessary to **establish the elements** for which this priority was being claimed and whether these elements of the invention were **revealed in a precise manner** in the priority document. The applicant claimed the right of priority not only in respect of the element which distinguished all the compounds claimed in all the claims of the European application from the prior art, but also in respect of the specific combination of individual substituents which precisely defined the actual chemical compounds. It was therefore necessary to examine whether these elements, this set of features, had been revealed precisely by the documents of the prior application, as required by Art. 88(4) EPC.

A strict distinction had to be drawn between this purely intellectual content of the definitions and their information content in the sense of a specific technical teaching. In the case in point, each of the compositions of claims 4 and 5 of the European application was part of the "purely intellectual content" of claim 3 of the priority document, but for all that did not belong to its actual teaching. There was no identity of technical content between claim 3 of the priority application and claims 4 and 5 of the European application as the disclosure of a group of chemical compounds was not exactly equivalent to a list or table showing individual chemical compounds (see **T 7/86**, OJ 1988, 381 and **T 12/81**, OJ 1982, 296). Although there was no doubt that the priority document described a very narrow group as being preferred, it did not, however, distinguish between the four compounds of this group, and neither did it specify that the formula of claim 3 had to be considered as an "abridged" formulation of a list or table indicating four individual chemical compounds. As a consequence, claims 4 and 5 could not be granted the claimed priority right (see also **T 295/87**).

2. Claiming the invention disclosed in the earlier application in the subsequent application

The features of the invention disclosed in the priority application must also characterise the invention claimed in the subsequent application.

2.1 Implicit features of the technical teaching

In **T 809/95**, the opponents submitted that the "thin-walled" feature, which was disclosed in the first priority application as essential, was not contained in granted claim 1. The board of appeal was of the opinion that granted claim 1 was based on a "collapsible" plastic bottle "produced by the blow-moulding method" which had folds "to facilitate a reduction of volume upon the exertion of a pressure applied to the walls by hand". This description in itself implied that the bottle would have to be made from thin-walled plastic flexible enough to be collapsible by hand when empty, as required by independent claim 3 in the first priority application.

2.2 Features missing with respect to the earlier application

2.2.1 Omission of non-essential features

In **T 809/95**, the opponents claimed with respect to claim 1 of the auxiliary request that the claim did not contain all the features which a skilled person would recognise as essential from the second priority document, with the result that the claim was directed to another invention. The board established, however, that the features which the opponents thought were missing were not connected in any recognisably close way with the problem put forward in this priority document. This problem was not solved by the missing features, but by other features, all of which could be found in claim 1 according to the auxiliary request. Thus the subject-matter of this claim was entitled to claim the second priority.

2.2.2 Extension over the earlier application

In **T 134/94** the priority document disclosed a process which worked under specific conditions indicated as features (a) to (d). Requirements (a) and (c) did not appear in the granted claim of the patent in suit.

The board held that this claim was not entitled to priority. As requirements (a) and (c) did not appear in the granted claim the scope of the invention as defined thereby comprised areas which, according to the priority document, did not belong to the invention. Thus the invention defined by granted claim 1 was not the same as the invention defined in the priority document. On the priority date the technical problem underlying the invention was considered to be solved only if each of the conditions (a) to (d) was satisfied; according to granted claim 1 features (a) and (c) were no longer necessary for solving the problem underlying the invention.

The board argued that the respondent's position, which was that the priority claim should be acknowledged whenever the disclosure of the priority document would destroy the novelty of the claims of the later application or patent ("novelty test"), had no basis either in the EPC or in the EPO case law. Such a position would imply that essential features of an invention disclosed in a priority document could be omitted in a later application based thereon without loss of priority right. However, if an essential feature of an invention was so omitted, the invention was no longer the same, ie the requirement of Art. 87(1) EPC was not fulfilled.

In **T 552/94**, the patent's claim 1 lacked four features which according to the priority document were indispensable for carrying out the invention. In other words, they were no longer essential to the invention as now defined. Citing **T 134/94** and **T 1082/93**, the board found that without those features the invention according to claim 1 could not be the same as that described in the priority document, and the requirements of Art. 87(1) EPC were therefore not met. Priority rights cannot be granted if an essential condition - identity of invention - is not fulfilled (**G 3/93**, OJ 1995, 18).

In **T 1052/93** it was an essential feature of the wash adjunct products claimed in the European patent that they contained sodium perborate monohydrate in conjunction with a functionally defined activator. The priority document only mentioned certain activators complying with the functional definition in the European patent; these specific compounds could not be considered to disclose the broad group of activators functionally defined in claim 1 of the European patent.

In **T 1050/92** the disclosure of the invention in the earlier application provided an adequate basis for replacing the term used in said application with a more general one in the European application.

3. Enabling disclosure in the priority document

Art. 87 EPC requires that the European patent application and the application whose priority is claimed relate to the same invention. Thus, the main criterion in this respect is whether the claimed invention is disclosed in the priority document as a matter of substance, i.e. with all its essential features. In addition, the disclosure of the essential elements must be either express, or be directly and unambiguously implied by the text. Missing elements which are to be recognized as essential only later on are thus not part of the disclosure. This view was confirmed in a number of decisions of the boards of Appeal (**T 81/87**, OJ 1990, 250, **T 301/87**, OJ 1990, 335, **T 296/93**, OJ 1995, 627).

The boards of appeal require a cited document to contain an enabling disclosure for it to cause lack of novelty (**T 206/83**, OJ 1987, 5). According to this principle, the priority document must also disclose the invention claimed in the subsequent application in such a way that a skilled person can carry it out (**T 193/95**).

In **T 81/87** (OJ 1990, 250), concerning living cells capable of expressing bovine preprorennin, only the priority claim of the second previous application was valid because in the first one the steps leading to the desired bovine preprorennin gene were not sufficiently disclosed. The board took the view that in order to give rise to priority rights the essential elements, ie the features of the invention, in the priority document had to be either expressly disclosed or directly and unambiguously implied in the text as filed; missing elements recognised as essential only later on were not part of the disclosure, and gaps with regard to basic constituents could not be retrospectively filled by relying on knowledge acquired in this manner. It could become a misuse of the priority system if some parties in a competitive situation were allowed to jump ahead of others on the basis of mere expectations and by omitting the critical features of the invention altogether.

In **T 296/93** (OJ 1995, 627) the board examined whether the priority document was deficient in respect of relevant technical information necessary for reducing the claimed invention to practice by the person skilled in the art without undue burden. Equally, in the recent case **T 207/94** (OJ 1999, 273) the board took the view that the requirements of Art. 87 EPC that the same invention be claimed in the priority application and the European patent application were fulfilled if the priority application disclosed the invention claimed in the subsequent European application in an enabling manner.

In **T 767/93** claim 1 of the European patent related to a process which comprised expressing from a recombinant DNA vector in a suitable host organism a polypeptide capable of raising HCMV-neutralising antibodies in humans (HCMV being the acronym for human cytomegalovirus). The board found this invention to be the same as that disclosed in the first priority document: the reported DNA and amino acid sequences were identical and the teaching of the priority document, as it would be read by a skilled person, was not limited to a specific example but was of more general scope, since it referred to the expression of a protein from the isolated genome fragment by using conventional genetic engineering techniques in suitable vectors and also mentioned the possibility of expressing discrete portions of the protein.

The lack of actual human clinical data with respect to "the capability of raising HCMV-neutralising antibodies in humans" did not necessarily lead to the conclusion that essential elements were missing in the disclosure of the first priority document. The patent in suit showed that by proceeding experimentally as taught in the first priority document, HCMV-neutralising antibodies were developed in rabbits. This made it plausible that the same effect could be obtained in humans. Thus, in the absence of any challenge to this by the opponents, the board had no reason to believe that the first priority document was deficient in respect of some relevant technical information necessary for reducing to practice the subject-matter of claim 1.

In **T 919/93,** claim1 of the European patent comprised a reference to the inactivation of a virus related to Acquired Immune Deficiency Syndrome (AIDS) which was neither cited expressis verbis in the priority document nor implicitly derivable therefrom.

The board referred to **T 449/90** where it was stated that the feature of inactivation of the NANB- hepatitis or AIDS virus upon dry heating had to be testable by the skilled person in order for the European application to fulfil the requirement of sufficiency of disclosure. It was acknowledged in **T 449/90** that before the filing date of the patent in suit, there were no techniques to cultivate the NANB-hepatitis or AIDS virus so that consequently no means for a direct detection of these viruses in a living entity or a cell culture or indirect tracing by measuring the antibodies possibly raised against these viruses was at hand. But there were passages in the application as filed, relating to a method for testing virus inactivation in dry heated blood clotting factor preparations based on the use of thermally highly stable viruses (eg the sindbis virus) as virus inactivation indicators. This technical information was considered by the board in that case to be sufficient for the skilled person to evaluate whether NANB-hepatitis or AIDS virus had been substantially inactivated by the heat treatment and thus the requirements of Art. 83 EPC were found to be fulfilled.

In **T 919/93** however, these passages in the European application as filed, essential for the patent application to meet the requirements of Art. 83 EPC had no counterpart in the priority document, which was thus not enabling for the claimed subject-matter. Thus in the case in point the priority could not validly be claimed.

C. First application in a Paris Convention country

In principle, only the first application filed in a state party to the Paris Convention can form the basis of a priority right. In the EPC, this is made clear in Art. 87(1) EPC.

If, apart from the application whose priority is being claimed in the subsequent European application, an earlier previous application was also filed, it must be established whether the invention claimed in the subsequent application was disclosed in the earlier application, which would render a priority claim based on the later previous application invalid. The same principles have to be applied as when establishing identity of invention between the application forming the basis of priority and the application claiming priority. The question is whether the invention claimed in the subsequent application was already disclosed in the earlier previous application taken as a whole or only in the later one.

In **T 323/90** the board compared the alleged first application with the subject-matter of the European patent and concluded that the former disclosed a different invention to that in the European application and the application from which priority had been claimed: the claimed process (for increasing the filling power of tobacco lamina filler) differed as regards both the moisture content of the tobacco for processing and the first step in the process.

In **T 400/90** priority had been claimed from a US application in respect of a European application concerning an electromagnetic flowmeter. The opponents submitted that the same invention was already the subject of an earlier US application filed by the same applicant outside the priority period: the earlier US application disclosed all the features contained in the European application with the exception of the use of saddle-shaped coils; however, the latter were already known and used frequently. In the board's opinion, the question to be answered was whether the use of saddle-shaped coils had been disclosed in the earlier US application, and not whether it was obvious to use such coils in place of the magnets disclosed in the earlier application. The board came to the conclusion that the inventions claimed in the US applications were different and priority had rightly been claimed from the later application because, according to the teaching of the earlier application, coils of any shape could be used, whereas according to the teaching of the priority document saddle-shaped coils had to be used.

In **T 184/84** a method of producing a single crystal of ferrite was claimed in a Japanese application, the priority of which was claimed in respect of a European application, and in a previous Japanese application. The starting materials were defined differently in the two Japanese applications. The method disclosed in the later application and the European application was clearly more advantageous than that forming the subject-matter of the earlier Japanese application. The board held that the significant differences in properties were indicative of the presence of different materials and therefore found that the earlier Japanese application was not the first filing of the invention claimed in the European patent application. It based its finding on **T 205/83** (OJ 1985, 363, Reasons for the Decision, point 3.2.1), which stated that the novelty of products prepared using a modified process could be established by the fact that according to an empirical principle in chemistry, a product's properties were determined by its structure, so that differences in the properties of products indicated a structural modification.

The subject-matter in **T 107/96** of the patent in suit contained the feature "angle of contact greater than 120", which feature was disclosed in the later previous US application P2. In P2 a particular advantageous effect was also attributed to the large extent of the said "angle of contact". The earlier previous US application P1 was totally silent about the aforementioned feature "angle of contact" and its advantageous effect. However, the figures of P1 represented diagrammatic and schematic drawings. The board stated that, therefore, in line with the established jurisprudence of the boards of appeal, they could not serve as a basis for determining the extent of a minimum "angle of contact" because dimensions obtained merely by measuring a diagrammatic representation of a document did not form part of the disclosure. Hence, the said feature "angle of contact greater than 120 ", was not disclosed in the earlier previous US application P1 but only in the later previous US-application P2. This meant that the priority from US application P2 claimed by the patent in suit was valid.

D. Partial and multiple priorities

In cases where partial or multiple priorities can be validly claimed the subject-matter of the subsequent application has two or more operative priority dates. In the case of a partial priority that part of the subsequent application's subject-matter disclosed in the previous application has the priority date of the previous application; for the remaining part the date of filing of the subsequent application applies. Where the priority of two or more previous applications is claimed, claims in the subsequent application have the priority date of the previous application in which the matter subsequently claimed was disclosed. Multiple priorities may be claimed for any one claim (Art. 88(2) EPC, second sentence). In such situations the question arises as to whether publication of the content of an application forming the basis of a priority during the priority period belongs to the state of the art which can be cited against those parts of the subsequent application which have a priority date after the date of publication.

1. Publications during the priority interval

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

The Enlarged Board emphasised that the existence of a right of priority depended, inter alia, on the fulfilment of the requirement of identity of invention, that is whether the previous application disclosed the same invention as that claimed in the subsequent European application. Where priority was claimed but could not be allowed because the inventions were not the same (despite the fact that the unity requirement was fulfilled), there was no right to priority. Consequently, any publication of the contents of a priority document during the priority interval constituted prior art citable against elements of the European application which were not entitled to priority (see **T 441/91**, **T 594/90**, **T 961/90** and **T 643/96**; for another view see **T 301/87**, OJ 1990, 335, Reasons, point 7.4).

2. Different priorities for different parts of a European patent application

In **T 828/93** the board stated that it followed from Art. 88(3) EPC that different priorities (including no priority, ie only the date of the European application) could be conferred on different parts of a European application. All that had to be checked was whether the subject-matter to be compared with the prior art, ie the subject-matter of the independent patent claims, corresponded to the disclosure of the documents of the priority application as a whole (see Art. 88(4) EPC). Only one (or, as the case may be, no) priority could be conferred on each claimed subject-matter as a whole, insofar as the subject-matter was defined by the given elements as a whole. This subject-matter as a whole represented the invention, which either corresponded to the disclosure of a priority application or not.

T 132/90 concerned a case in which claim 1 of the contested patent contained a feature B not disclosed in the Swiss priority document. The board held that a priority right therefore subsisted only with regard to part of the subject-matter of the claim, ie claim 1 without feature B, but not with regard to the subject-matter of that claim as a whole. The part of the subject-matter entitled to priority did not involve an inventive step. The subject-matter as a whole of claim 1 of the European application, which only had the priority status of the filing with the EPO, was no longer new because the patent proprietors had published all its features after filing the Swiss application.

In **T 127/92** a European patent application claimed the priority of two German utility models, which had been published during the priority interval (documents D1 and D2). The board of appeal took the view that priority had been validly claimed from D1 for claim 1 and several dependent claims.

It was necessary to establish whether those sub-claims that also contained elements not disclosed in D1 were entitled to claim partial priority from D1 for the subject-matter of claim 1 contained within them. On the basis of the principles developed in **G 3/93** (OJ 1995, 18), the board came to the conclusion that D1 and D2 formed part of the state of the art in respect of these claims and that, consequently, the subject-matter of these claims no longer involved an inventive step. The patent proprietor therefore deleted them.

3. Multiple priorities for one claim

In **T 828/93** (see above) the board confirmed that, because of the legal situation explained above, the possibility mentioned in Art. 88(2) EPC of multiple priorities for any one patent claim related only to instances where, unlike in the case at issue, the claim contained alternatives and could therefore be split into several subject-matters.

In **T 620/94** it became apparent that the granted **claim 1 covered two alternatives** A and B of the invention. Only alternative B was disclosed in the priority document; alternative A was contained only in the subsequent European application. Prior art published during the priority interval rendered obvious alternative A. The patent could thus only be maintained in amended form, ie limited to alternative B.

In **T 441/93** the European patent related to a process for preparing a strain of the yeast Kluyveromyces, which comprised transforming Kluyveromyces yeast cells with a vector comprising, inter alia, a DNA sequence encoding a polypeptide. The invention disclosed in the priority document was a process for the preparation of new strains of the yeast Kluyveromyces, characterised in that protoplasts of such yeast were mixed with and transformed by vector molecules which contained at least one gene for a selectable property and which could be cloned and expressed within the host cells; the protoplasts were regenerated to complete cells with a cell wall; the cells transformed by the vector could be distinguished by means of the selectable property from the other cells and were separated therefrom. The appellant/opponent argued that the generic claim 1 of the European patent did not enjoy the priority of the previous application because the priority document did not mention the transformation of whole cells, which alternative was covered by claim 1 (and other claims) of the subsequent application.

On the evidence put before it, the board concluded that the references to protoplasts in the priority document were of crucial importance and that no mention had been made in the priority document of the possibility of transforming whole cells. The board held that it was decisive what process had been disclosed in the previous application since claim 1 of the subsequent application was directed to a process. In so far as claim 1 covered whole cell transformation, it could only be entitled to the filing date of the European application. It might be the case that all transformed cells which could be made using a whole cell transformation process could also be made using the protoplast transformation process of the priority document. But even this would not mean that claim 1 was entitled to the priority date for process aspects neither disclosed nor enabled by the priority document. Accordingly, claim 1 was entitled to the filing date of the priority application only in so far as it related to the transformation of protoplasts. The claims could thus be divided into two groups with regard to priority: Group A, enjoying priority rights from the previous application and comprising claim 1 in so far as directed to a process for the transformation of Kluyveromyces protoplasts, and the related further claims; and Group B, only enjoying the priority of the subsequent European application, and comprising claim 1 in so far as not directed to a process for the transformation of protoplasts, and the related further claims.

Both the Group A and Group B claims were held to be novel and inventive. However, the closest prior art for the Group B claims was a document corresponding substantially to the contents of the priority document and published by the inventors during the priority interval. This ruling was based on the principles set out in **G 3/93** (OJ 1995, 18).

V. RIGHT TO A EUROPEAN PATENT

In **G 3/92** (OJ 1994, 607), the Enlarged Board of Appeal was called upon to consider the application of Art. 61(1)(b) in the following circumstances:

The appellant had lodged a European patent application in 1988. The search report revealed the existence of a prior application filed in 1985 for substantially the same invention by a third party, to whom the appellant had revealed the invention in confidence in 1982. This prior application had been published, and in 1986 deemed to be withdrawn for non-payment of the examination fee. Thereupon the appellant claimed from the UK Patent Office Comptroller, and was granted, entitlement to a patent for the invention disclosed in the prior European application under Section 12(1) of the UK Patents Act 1977. The appellant was thus allowed under Section 12(6) of the UK Patents Act to file a new application in the UK to be treated as having the same filing dates as the prior European application. The appellant then filed a new European patent application in respect of the invention disclosed in the prior application under Art. 61(1)(b) in 1990.

The referring Legal Board of Appeal took the view in its interlocutory decision **J 1/91** of 31.3.1992 (OJ 1993, 281) that the Comptroller's decision was a final decision within the meaning of Art. 61. However, whilst entitlement to a patent was a matter for national courts to decide, those courts had no power directly to provide a remedy under the EPC, that being a matter to be dealt with by the EPO under Art. 61.

The referring board then went on to consider whether pendency was required under Art. 61. As the article was open to differing interpretations, the board decided to refer the question to the Enlarged Board.

The Enlarged Board of Appeal held that when it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the specific requirements of Art. 61, files a new European patent application in respect of the same invention under Art. 61(1)(b), it is not a pre-condition for the application to be accepted that the earlier original usurping application is still pending before the EPO at the time the new application is filed.

The Legal Board of Appeal therefore ruled in **J 1/91** of 25.8.1994 that the conditions of Art. 61(1)(b) had been met and accordingly remitted the patent application to the Receiving Section for further prosecution.

VI. RULES COMMON TO ALL PROCEEDINGS

A. The principle of the protection of legitimate expectations

1. General issues

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

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

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

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

The Enlarged Board observed in **G 2/97** that the notice sent by the registry of the boards of appeal was a standard form, nothing more than an administrative notice to inform the parties on the reference number of the appeal proceedings. It has no legal consequences ; it is not a "communication" within the meaning, eg, of Art. 110(2) EPC. Such a notice cannot be considered to give rise to any misunderstanding.

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

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

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

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

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

Similarly, several decisions have specified the **sources** of legitimate expectations. In **T 905/90** (OJ 1994, 306, Corr. 556) the board held that specific communications or other actions within the framework of particular proceedings and official statements such as guidelines were not the only sources of legitimate expectations; these could also properly arise from the actual general conduct or established practice of organs of the EPO. All changes in these practices should be officially announced at the earliest possible moment in order to avoid misleading the parties. In **J 25/95** (and similar decisions given the same day, namely **J 14/95, J 15/95, J 16/95, J 17/95** and **J 24/95**) the board drew up a list of these sources in the light of the case law. It was pointed out that the source of legitimate expectations must be confined to some categories of information: information by the EPO in the framework of individual cases, information contained in official statements of general applicability and published by the EPO, eg in the OJ, established practice of departments of the EPO, and decisions of the Enlarged Board because of its special role. The users' confidence in the continuity of a practice based on a decision of the Enlarged Board might be considered particularly legitimate since all boards of appeal were expected to follow the Enlarged Board's interpretation of the EPC. In **J 25/95** the board also stressed that, whereas the appellant submitted, inter alia, that the Receiving Section be obliged to follow **J 11/91** (OJ 1994, 028) because this decision had been published in the OJ as well as in the "Case law of the boards of appeal of the EPO", the publication of **J 11/91**, in the board's view, did not create a legitimate and reasonable expectation that a divisional application could be filed up until the decision to grant. There was no case in which legitimate expectations, justifying a deviation from the law in its correct interpretation, had been accepted only on the basis of the publication of a single decision of a board of appeal. Moreover, the board observed that decisions of the boards were not published because the EPO wanted to announce that its users could rely on them in the future cases, but just because the **boards** themselves considered them to be of general interest in respect of the development of the case law. If there was any doubt whether established practice in this respect existed, it was up to the appellants to seek clarification by means of an enquiry to the EPO which would have revealed quickly in this case that the first instance did not apply **J 11/91**.

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

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

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

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

In case **T 343/95**, dealing with the content of a telephone call on which the appellant based its allegation in respect of principle of good faith, the board was of the opinion that even if it was not possible to establish beyond any reasonable doubt a posteriori the call's content, in a case like the present one it was sufficient that the board was satisfied on the basis of a balance of probabilities (ie that one set of facts was more likely to be true than the other). There were indeed many circumstances in favour of the submission by the appellant, among them the fact that the appellant had had a similar problem in a parallel case where he reacted immediately. The board could find no logical reason, especially taking into account the fact that his interest in the file had made him contact the EPO, why he would not have made the payment, had he known it was not to be processed automatically. The board held that the conditions for the application of the principle of legitimate expectation were fulfilled.

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

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

2. Obligation to draw attention to easily remediable deficiencies

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

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

On the other hand, the Legal Board of Appeal in **J 13/90** (OJ 1994, 456) decided that if, having regard to the principle of good faith, the applicant could expect to receive a communication warning him of an impending loss of rights, but that communication was not issued in due time, the EPO must set a new period allowing the applicant to remedy the deficiency and perform the omitted procedural act in due time.

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

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

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

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

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

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

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

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

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

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

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

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

J 2/94 involved a letter comprising a request without the necessary payment. According to the board the appellant could not have expected to be informed of the missing fee. Referring to **J 41/92**, the board in this case held that a party could not expect a warning in respect of any deficiency occurring in the course of the proceedings. There had been no evident indication in the appellant's submission which made a clarification or reminder necessary. Indeed, as emphasised by the board, in practice the EPO could often establish whether a specific fee had been paid only after the relevant time limit had expired, once the complete data on all payments made during that period was available.

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

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

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

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

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

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

3. Courtesy services performed by the EPO

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

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

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

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

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

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

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

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

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

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

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

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

B. Right to be heard

1. Introduction

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

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

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

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

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

In **T 385/97** the board held that if first instance departments and/or parties had failed to take account of highly relevant matter which was clearly available in the EPO file and which related to a ground of opposition, the board's competence extended to rectifying the position by consideration of that matter, provided that the parties' procedural rights to fair and equal treatment were respected. The board appreciated that, in the exceptional circumstances of the case, the parties had to have sufficient opportunity to consider a document which, although mentioned in the patent description, had not been considered during examination and opposition proceedings, so that its "re-introduction" by the board of appeal without adequate time for the parties to give full instructions to their representatives might amount to "surprise". The case was therefore remitted.

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

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

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

In the present case, the examining division believed that the applicant, by making a simple procedural request by return of post, had somehow forfeited his right to present comments during the remainder of the 4-month term set for reply. Such a view would seem to imply that any letter the applicant sent after receipt of the R. 51(2) EPC communication was to be treated as his definitive reply even if the time limit set for reply had not expired. However, on a proper interpretation of the letter of the applicant, he had neither exercised nor waived his right under Art. 113(1) EPC to present comments on the substantive issues. Nor, as the time set for reply had not expired, could he have forfeited this right. Thus the precipitate refusal, while there were still some two months of the term for reply unexpired, did indeed contravene Art. 113(1) EPC by depriving the applicant of an opportunity to present such comments (see also chapter "examination procedure", Nr. 3.8).

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

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

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

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

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

In **T 195/84** (OJ 1986, 121) the representative objected at the oral proceedings that new grounds were being presented, challenging the existence of an inventive step, to which he had not previously had an opportunity to reply. The board could not share this opinion as the representative had been aware that such prior art existed, and he had thus had sufficient time to consider it in full. Furthermore, he had not requested any additional time to examine this art in greater detail and had not asked for an adjournment.

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

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

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

2. Right to be heard in oral proceedings

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

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

In **T 253/95**, the board referred to **G 4/92** and found that the principles concerning the basis of decisions in case one party was absent in oral proceedings also applied when the other party was present: new arguments could be used in the reasons for the decision as long as they did not rely on new facts, since they did not constitute new grounds or evidence and did not distort the factual framework, but were reasons based on facts and evidence already put forward. Indeed in **T 253/95**, during the oral proceedings, the board raised the question of the admissibility under Art. 123(2) EPC of the weight range for the rubber component(s) present in claim 1 as granted. The respondent (proprietor) protested against this issue being raised as it had not been discussed earlier in the proceedings. Thus it had to be determined in which of the categories of grounds, facts, evidence and arguments the objection against the introduction of the weight range for the rubber component(s) fell. The board came to the conclusion that it was neither a new ground since an objection under Art. 123(2) EPC had been raised by the opponent at the outset, nor a new fact or likewise new evidence since the facts of the issue - that is claim 1 as originally filed, claim 1 as granted and the disclosure in the original description including the examples (the basis of the amendment was allegedly to be found in the examples) - had all been present at the beginning of the opposition proceedings. Therefore, the objection to the introduction of the weight range could at most constitute a late argument, which according to **G 4/92** could always be raised by an opponent and hence a fortiori by the board.

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

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

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

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

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

EPC had taken place.

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

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

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

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

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

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

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

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

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

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

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

In **G 4/92** (OJ 1994, 149) the Enlarged Board of Appeal held that, in view of the right to present comments, a decision against a party who had been duly summoned but who failed to appear at oral proceedings could not be based on facts put forward for the first time during those oral proceedings. Evidence put forward for the first time during oral proceedings could not be considered unless it had been previously notified and it merely supported the existing assertions of the party which submitted it. However, new arguments could - in principle - be used in the reasons for the decision as they did not constitute new grounds or evidence, but were reasons based on the facts and evidence already put forward. This opinion related only to inter partes proceedings.

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

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

In **T 133/92** the board concluded that considering and deciding in substance on the maintenance of the patent on the basis of claims as amended during oral proceedings in the absence of the appellants (opponents) did not conflict with the opinion of the Enlarged Board of Appeal in **G 4/92**. The board stated that the respondent's (patentee's) restrictions to the claims removed objections already raised by the appellants. In such a situation the appellants could not have been taken by surprise, because they had reasonably to expect that the respondent would try to overcome all objections. The submission of auxiliary requests was clearly not a "fact" within the meaning of **G 4/92**. Were it otherwise, no decision could ever be issued at the end of a hearing where, as is usually the case, auxiliary requests are filed and, as is also frequently the case, the opponent does not attend the hearing, thereby rendering such hearings pointless and a waste of time, as well as offending against the general principle of legal certainty, ie the general interest of the public in the termination of legal disputes. Likewise, the board held In **T 771/92** that the decision to maintain the patent on the basis of a set of claims amended during oral proceedings in the absence of the appellant did not conflict with the principles described in **G 4/92**. The submission of restricted claims was neither a fact nor could it be evidence. The appellant could not be taken by surprise by the amendment made, because he had reasonably to expect that the respondent would try to overcome the objections made. The amendments resulted from the novelty objection made by the appellant during the written procedure.

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

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

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

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

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

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

4. Article 113(2) EPC

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

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

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

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

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

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

In **T 666/90** the status of the requests on file was not clarified during oral proceedings before the opposition division. This resulted in a disagreement in the period between oral proceedings and the drafting of the written decision. The board pointed out that in a case such as this the appropriate action to take was to request a written copy of the final version of the requests and clarification of the order in which they were to be ranked prior to the decision being issued. Failure to clarify the position was in breach of Art. 113(2) EPC and hence constituted a substantial procedural violation. In **T 552/97** the opposition division had taken no decision on the main request being under the incorrect impression that it was no longer in the proceedings. The board pointed out EPO instances should clarify the position before issuing decisions, especially if requests had been amended in oral proceedings.

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

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

C. Oral proceedings

1. Right to oral proceedings

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

The board applied this principle in **T 556/95** (OJ 1997, 205) specifying that the discretion of an examining division to allow amendments up to the decision to grant the patent did not mean that that department had discretion to refuse requested oral proceedings dealing with such amendments. The examining division had to exercise its discretion under R. 86(3) EPC in the case of amendments requested after a R. 51(6) EPC communication in such circumstances having regard to Art. 116(1) EPC. The board continued that the right to be heard in oral proceedings (Art. 116 EPC) subsisted so long as proceedings were pending before the EPO. Lastly, the board added that the Enlarged Board of Appeal - which in **G 7/93** (OJ 1994, 775) had given some guidance as to how an examining division should exercise such discretion (R. 86 EPC after R. 51(6) EPC) - could not limit the application of Art. 116(1) EPC by means of such guidance.

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

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

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

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

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

2. Oral proceedings before the Receiving Section

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

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

3. Request for oral proceedings

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

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

3.1 Wording of request

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

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

In **T 433/87** the board interpreted the patent proprietor's request "to conclude the opposition proceedings and if necessary arrange oral proceedings as soon as possible" to mean that oral proceedings were requested only in the event of their being considered necessary by the opposition division. The statement "If there are any outstanding problems, the writer would welcome an opportunity to discuss the case with the examiner" could not be understood as a valid request for oral proceedings either (see **T 88/87**).

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

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

3.2 Withdrawal of request

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

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

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

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

In **T 686/92** the patent proprietors' silence following a communication from the opposition division, asking whether they maintained the request for oral proceedings, had also been interpreted by the opposition division as a withdrawal of that request. The board stated that in the case of an auxiliary request for oral proceedings by a party there was no room for discretion on the part of the opposition division. The board held that the opposition division had no power to issue a decision adversely affecting the party without first appointing oral proceedings. In a similar case (**T 795/91**) the board added that a withdrawal required an unambiguous expression of the party's wish to withdraw (see also **T 766/90, T 879/92**).

3.3 Further oral proceedings

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

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

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

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

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

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

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

In **T 731/93** the board stated that where fresh evidence had been admitted into the proceedings, the "subject" of such proceedings, as construed by reference to the text of Art. 116(1) EPC in all three official languages, could no longer be the same. In this case the refusal of a request for further oral proceedings constituted a substantial procedural violation.

3.4 Auxiliary request for oral proceedings

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

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

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

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

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

3.5 Request for oral proceedings in further prosecution proceedings

In **T 892/92** (OJ 1994, 664), the appellants submitted that after the case had been remitted to the opposition division for further prosecution, the oral proceedings they had originally requested had never taken place. The board considered the question whether the original request for oral proceedings had been revived on remittal and was therefore legally effective and stated that "further prosecution" proceedings on remittal by the board of appeal were to be regarded as a continuation of the original opposition proceedings, particularly where the original interlocutory decision had been set aside by the board and was therefore no longer legally effective. Consequently, the patent proprietors' original request, which had never been withdrawn or amended, became effective again after remittal, so that the opposition division should not have taken a decision adversely affecting the proprietors without giving them an opportunity to present their case orally (Art. 116(1) EPC).

4. Infringement of Article 116 EPC

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

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

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

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

5. Non-appearance at oral proceedings

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

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

5.2 Obligation to give notice if not attending oral proceedings

In **T 653/91** the board made the following statement: "If, having been summoned to oral proceedings, a party does not wish to attend such proceedings, both the board (through its Registrar) and any other parties to the proceedings should be notified in writing of this fact as early as possible before the appointed day. Except in special circumstances, telephone communications concerning such matters are inappropriate, especially in inter partes proceedings".

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

6. Preparation and conduct of oral proceedings

6.1 Fixing or postponing the date for oral proceedings

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

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

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

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

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

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

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

6.2 Curtailment of notice in the summons

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

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

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

6.3 Communication under Article 11(2) RPBA

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

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

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

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

6.4 Interpretation and application of Rule 71a EPC

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

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

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

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

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

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

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

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

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

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

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

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

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

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

In **T 484/99** the appellant (patentee) alleged that the refusal, under R. 71a EPC, by the opposition division to consider or even look at amendments to the requests presented on the day of the oral proceedings before them amounted to a procedural violation.

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

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

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

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

6.5 Taking of minutes

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

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

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

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

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

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

6.6 Interpreting costs during oral proceedings

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

In **T 473/92** the respondents asked the EPO, three days before the oral proceedings, to arrange for and bear the cost of interpreting services. According to the respondents, the period of one month stipulated in R. 2(1) EPC had not been observed because the EPO had failed to issue a corresponding invitation: they submitted that the EPO ought to have drawn their attention to the period of notice mentioned in R. 2(1) EPC. The board, however, decided that the respondents had to bear the costs of interpreting at the oral proceedings. If the parties were being offered a free interpreting service, the EPO should at least be enabled to minimise its costs by having sufficient time to organise the interpreting efficiently. Obviously, only the EPO could assess how much preparation time was needed. Nor was the EPO under any obligation to draw the respondents' attention to the notice period of one month. A professional representative before the EPO was supposed to be familiar with both the EPC and its Implementing Regulations.

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

D. Time limits

1. Calculation of time limits

1.1 Calculation problems (Rule 83 EPC)

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

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

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

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

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

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

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

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

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

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

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

In **J 5/98** the board held that the occurrence of a national holiday on the last day of the period of grace for payment of designation fees pursuant to R. 85a(2) EPC did not have the effect of extending that period. Having examined all relevant provisions the board pointed out that the case was concerned with the expiry of a period of grace and not an initial time limit and the law did not allow the extension of the expiry of a period of grace. The board observed that the period of grace, as its name indicates, exists to allow those who miss the initial time limit to comply belatedly, provided they pay a surcharge. To extend such periods of grace to allow for national holidays in contracting states would be to add a second period of grace to the first. That would be contrary to the intention behind the present R. 85a EPC which was to regularise the practice relating to payment of fees after expiry of the initial time limit.

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

2. Extension of time limits

2.1 Relevant criteria

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

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

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

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

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

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

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

3. Interruption of proceedings - Rule 90 EPC

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

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

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

The EPO must apply this Rule of its own motion (**J ../87**, OJ 1988; **J 23/88**; **T 315/87**). The consequence of interruption of proceedings is that the time limits in force as regards the applicant or patentee at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings were resumed (cf. R. 90(4) EPC). However, the time limit for making the request for examination and the time limit for paying renewal fees are only suspended (see below, 3.7 - Consequences of interruption of proceedings).

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

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

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

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

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

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

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

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

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

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

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

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

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

In **T 315/87** of 14.2.1989 the board lent credence to the assertion that during the time in question the previous representative had found himself in the unusual situation described, particularly as the circumstances (proceedings concerning professional conduct, the need to organise his office's work) had also been made known officially to the European Patent Office. It further accepted that he had been suffering from physical and mental disorders during that time. Indeed, the medical documents submitted by the previous representative himself pointed to a psychosomatic condition.

3.5 Legal incapacity of a representative from outside the Contracting States

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

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

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

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

In **J 9/90** the Legal Board held that for R. 90(1)(b) EPC (interruption of proceedings because of insolvency) to be applied in the light of Art. 60(3) EPC and R. 20(3) EPC, the applicant entered in the Register of European Patents and the insolvent person (here a limited company) had to be legally identical; for the possibility of having rights re-established see p. 322.

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

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

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

In **J 7/83** (OJ 1984, 211) the board held that in the event of proceedings for grant of a European patent being interrupted because the applicant company has gone into receivership (R. 90(1)(b) EPC), the period prescribed by Art. 94(2) EPC for payment of the **examination fee** is suspended as from the date on which payments were discontinued by court order up to the date on which proceedings for grant are resumed (R. 90(2) EPC). The period then resumes for the part remaining to elapse, or for at least the two months prescribed by R. 90(4) EPC, second sentence. In **J ../87** (OJ 1988, 323) the board stated that such an interpretation could not be applied to **renewal fees** for which the EPC did not prescribe a time limit for payment but simply dates on which they fell due. The only time limit affecting renewal fees that might be suspended was the six-month period for paying the renewal fee together with an additional fee referred to in Art. 86 EPC. R. 90(4) EPC had to be interpreted as deferring until the date proceedings are resumed the payment date for renewal fees which had fallen due during the period of the representative's or applicant's incapacity.

4. Interruption in the delivery of mail

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

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

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

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

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

E. Re-establishment of rights

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

1.1 The meaning of "time limit"

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

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

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

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

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

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

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

In **J 7/93** (see chapter PCT, p. 587) the EPO did not tell the appellant to ignore its previous communications issued in connection with a time limit supposed to be missed; this would have enabled the appellant to recognise that its request for re-establishment was unnecessary. Instead, the EPO continued the proceedings for re-establishment of rights and finally refused restitutio without taking into account the fact that these proceedings had been unnecessary from the very beginning. The board found that this amounted to a substantial procedural violation within the meaning of R. 67 EPC. The board held that it was equitable to order reimbursement of the appeal fee, even though the appellant had not applied for this (**J 7/82**, OJ 1982, 391). The board held that since there was no longer any legal ground to request re-establishment of rights, the fee for re-establishment was wrongly accepted by the EPO and, therefore, had to be refunded to the appellant (see confirming **J 1/80, T 522/88**).

1.3 Omission of acts by applicant

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

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

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

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

In **T 210/89** (OJ 1991, 433) the board ruled that an opponent/appellant was not entitled to have his rights re-established when he missed the two-month time limit for **filing an appeal** (Art. 108 EPC, first sentence). An opponent (appellant) seeking to have his rights re-established under Art. 122(1) EPC could not rely on the principle of "equality before the law" (applying Art. 125 EPC) where the appeal did not exist for procedural reasons (distinguishing **G 1/86)**. The applicant or proprietor, having failed to set in motion his appeal, would find himself at the end of the legal road; by contrast, an opponent could, if he wished, seek revocation in the national courts into whose jurisdiction the European patent would have passed (see also **T 323/87**, OJ 1989, 343, and **T 128/87**, OJ 1989, 406).

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

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

2. Admissibility of applications for re-establishment of rights

2.1 Department competent to decide upon the application

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

In **T 428/98** (OJ 2001, 485) it was stated that where a communication from the Office notifies an applicant that he has missed a time limit, the cause of failure to complete the omitted act within the meaning of Art. 122(2) EPC, first sentence, is as a rule removed on the date when the applicant actually receives the communication, provided that failure to complete the act was purely due to previous unawareness that the act had not been completed. The legal fiction of deemed notification under R. 78(3) EPC (in the version in force until 31 December 1998) has no effect on the date of removal of the cause of non-compliance, even if this works against the applicant because the actual date of receipt of the communication precedes the date calculated according to R. 78(3) EPC.

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

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

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

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

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

2.3 Making good the omitted act

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

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

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

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

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

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

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

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

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

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

In **J 8/95** the appellants argued that the German-language version of Art. 122(3) EPC did not stipulate that the statement of grounds for an application for re-establishment of rights had to be filed within the time limit laid down in Art. 122(2) EPC. For this, no definite time limit had been prescribed. The appellants claimed that the case law in question was based entirely on the English and/or French versions of the EPC, and was not supported by the German version of Art. 122(3) EPC, first sentence. According to Art. 177(1) EPC, the three texts of the EPC were equally authentic. In the current case, the language of the proceedings was German; clearly, therefore, the decision had to be based on the German version, which was less strict. The board however decided that Art. 177(1) EPC assumed a uniform legislative intent, which could only be identified on the basis of all three texts of the EPC. This prevented an applicant from invoking the supposedly less strict wording of a provision of the EPC in the language of the proceedings (see also **T 324/90,** OJ 1993, 33).

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

2.5 Correction of deficiencies in the application for re-establishment

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

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

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

3.1 General issues

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

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

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

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

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

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

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

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

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

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

European or the Euro-PCT route.

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

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

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

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

4. Article 48(2)(a) PCT

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

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

In **W 3/93** (OJ 1994, 931) the request for re-establishment of rights was to enable the protest to be deemed to have been filed within the time limit fixed by the ISA under Art. 17(3)(a) PCT and R. 40.1 PCT, and, in substance, for examination of the protest. The board held that by analogy with the principles developed by the Enlarged Board of Appeal in decision **G 5/83** (OJ 1985, 64, points 5 and 6 of the reasons) for interpreting the EPC, Art. 8(2) PCT should be construed to mean that in the event of a delay in meeting the time limit laid down in R. 40.3 PCT the same legal remedies were available as in the case of failure to observe other comparable time limits under the PCT or EPC (see also **W 4/87**). The board stated that when re-establishment of rights was granted, the legal situation was restored to that existing prior to the noting of the loss of rights which ensued from failure to observe the time limit. The board of appeal's decision based on failure to observe the time limit was thus rendered invalid, even though it was a final decision. In other words, the granting of re-establishment of rights destroyed the legal validity of the decision, which accordingly did not need to be set aside or amended. As a result, the protest was admissible and had to be examined on its merits.

5. Merit of applications for re-establishment of rights

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

5.1 Due care

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

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

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

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

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

5.1.1 Exceptional circumstances

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

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

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

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

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

5.1.2 A satisfactory system for monitoring time limits

a) General principles

An isolated mistake in a normally satisfactory system is excusable; the appellant or his representative must plausibly show that a normally effective system for monitoring time limits prescribed by the EPC was established at the relevant time in the office in question (**J 2/86**, **J 3/86**, OJ 1987, 362) (see **J 23/92**). The fact that this system operated efficiently for many years was evidence that it was normally satisfactory (see **J 31/90**, **J 32/90**, **T 309/88** and **T 30/90**).

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

b) Small office

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

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

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

In **T 73/89** the board rejected the application for re-establishment of rights because, in order to work properly, the normally satisfactory diary system required a qualified attorney to check whether, in any particular case, an extension was necessary or possible; in this case no such check was made.

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

c) Large firm

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

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

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

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

5.2 An oversight or inability to observe a time limit

5.2.1 Tactical considerations

Art. 122(1) EPC requires that the party in question must have been unable to observe a time limit. In **T 413/91** of 25.6.1992 the board stated that the word "unable" implied an objective fact or obstacle preventing the required action, eg a wrong date inadvertently being entered into a monitoring system. The appellants' reasons for not filing any statement of grounds were that they had expected an agreement with the proprietor, which however did not come about. The board stated that such a reason did not justify re-establishment of rights, pointing out that it was an extraordinary means of judicial remedy. It offered no choice to a party as a substitute for the proper action to be taken, nor did it imply any right to have the fatal effect of an intentional step cancelled, even if this step later on proved to have been a mistake. A party who had deliberately chosen not to file a statement of grounds for the appeal could not achieve an appellate review through the back door of a request for re-establishment. The board therefore refused the request for re-establishment of rights.

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

5.2.2 Financial difficulties

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

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

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

5.3 Persons required to exercise due care

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

5.3.1 Due care on the part of the applicant

a) General principles

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

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

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

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

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

b) Using an non-authorised representative

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

5.3.2 Due care on the part of the professional representative

a) General issues

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

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

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

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

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

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

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

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

In **J 3/88** the board noted that account should be taken of the fact that under Art. 134(1) EPC the contracting states had in principle confined representation of applicants before the EPO to "professional representatives" who, by virtue of their qualification should guarantee the best possible representation. The board stated that it followed that a representative could not relieve himself of responsibility for carrying out tasks which, by reason of his qualification, fell upon him personally, such as, for example, the interpretation of laws and treaties. If he delegated such tasks to an employee and if the latter made an error in the course of that work which resulted in the failure to observe a time limit, the representative could not claim that he had taken all due care required by the circumstances (see also **J 33/90**).

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

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

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

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

In **T 516/91** the mistake made by the representative was that he requested an extension of two months for submitting the grounds of appeal. The board emphasised that the time limits set by Art. 108 EPC could not be extended. In mistakenly believing that an extension of these time limits was possible, the representative failed to exercise due care (see also **T 248/91** and **T 853/90**). In **T 601/93** the appellant was not aware of the need to file a statement of grounds within the time limit. The board held that any legal error which might have led the appellant to believe that the requirement was not to be observed would exclude the application of due care, considering the unequivocal provision in Art. 108 EPC.

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

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

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

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

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

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

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

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

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

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

5.3.4 Fee payments by service companies

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

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

5.3.5 Due care in dealing with assistants

(a) Introduction

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

The case law concerning due care on the part of professional representatives' assistants was established in **J 5/80** (OJ 1981, 343). This key ruling by the Legal Board of Appeal lays down that a request for re-establishment of rights can be acceded to in the event of a culpable error on the part of the assistant, if the professional representative is able to show that he has chosen for the work a suitable person properly instructed in the tasks to be performed, and that he has himself exercised reasonable supervision over the work. Where an assistant has been entrusted with carrying out routine tasks such as typing, posting letters and noting time limits, the same strict standard of care is not expected as is demanded of the representative himself (**J 16/82** (OJ 1983, 262), **J 26/92**). Decision **J 5/80** also pointed out that, if other than routine tasks are delegated which normally would fall to the representative by virtue of his professional qualification, the representative would not be able to establish that he exercised all due care (see **J 33/90** (see also **T 191/82** (OJ 1985, 189), **T 105/85**, **T 110/85** (OJ 1987, 157), **T 11/87, T 176/91**, **T 715/91** and **T 43/96**).

(b) Selection, instruction and supervision

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

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

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

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

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

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

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

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

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

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

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

(i) were particularly urgent

(ii) needed particular attention and further steps by the representative himself to ensure that the necessary acts were still performed in time

(iii) could result in an irrevocable loss of rights if any error or delay occurred.

The following circumstances which applied in the present case made it all the more appropriate for the representative not to leave the case solely to a docketing system or an assistant but personally to check in time whether or not instructions had been received:

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

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

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

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

(c) Technically qualified assistant

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

(d) Substitutes replacing assistants

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

In **T 324/90** (OJ 1993, 33) the board held that in a large firm, where a considerable number of deadlines had to be monitored at any given time, it had normally to be expected that at least an effective system of staff substitution in the case of illness and for absences in general was in operation in order to ensure that official documents such as decisions by the EPO, which started periods within which procedural steps had to be carried out, were properly complied with. From the facts submitted in this case it had to be concluded that no appropriate precautions had been taken in the event of unexpected absences on the part of staff responsible for monitoring time limits. In **J 41/92** (OJ 1995, 93) the Legal Board of Appeal found that, in the case of a **professional working alone** and having a much smaller number of time limits to comply with, less strict standards in this respect could be applied. However, the board went on to say that a careful and diligent professional representative had, in any case, to be expected to take into account that he or she might fall ill and be prevented for some time from taking care of time limits. Therefore, if a professional representative ran a one-person office, appropriate provisions needed to be made so that, in the case of an absence through illness, the observance of time limits could be ensured with the help of other persons. If there was no substitute or assistant at the representative's office, co-operation with colleagues or with a professional association could, for example, be sought for this purpose.

5.3.6 Due care in using private mail delivery services

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

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

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

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

In **J 5/79** (OJ 1980, 71) the board stated that according to Art. 122(6) EPC, third party rights of user arose only where the restoration related to an already published European patent application or a European patent; those whose commercial interests were at stake should be entitled to be sure that protection, the existence of which was public knowledge, and which had fallen into the public domain, no longer had effect. This principle was already to be found in Art. 156(6) EPC of the "Preliminary draft for a Convention on a European Patent Law", published in 1962, and was set out both in Art. 142(6) EPC of the "Second preliminary draft of a Convention establishing a European System for the Grant of Patents", published in 1971, and in the provisions of the first Preliminary draft for the Implementing Regulations "Re Art. 142, No. 1, second paragraph". The board stated that the basis of this rule had never been questioned. In the case at issue, the restoration related to an application that was unpublished at the material time, so on that ground alone there could be no third party rights of user.

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

7. Restitutio in integrum - Interruption of proceedings

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

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

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

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

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

9. Principle of proportionality

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

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

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

F. Late submission

1. The meaning of "late"

1.1 Delaying the proceedings

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

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

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

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

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

2. Consideration of late submissions

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

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

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

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

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

(b) In contrast to the first-instance procedure, the appeal procedure is a judicial procedure and therefore "less investigative". Therefore, as regards proceedings before the **boards of appeal**, new facts, evidence and related arguments which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to R. 55c EPC in support of the grounds of opposition on which the opposition is based should only **very exceptionally** be admitted into the proceedings if such new material is **prima facie highly relevant** in the sense that it is highly likely to prejudice maintenance of the European patent. Also, other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause should be taken into account. In general the later that such new material is filed, the greater the degree of procedural complication that it is likely to cause (confirmed in **T 212/91**, **T 951/91** (OJ 1995, 202), **T 255/93**).

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

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

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

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

3. Exercising discretion over admitting late submissions

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

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

3.1 Examination as to relevance

3.1.1 Examination as to relevance - general principles

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

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

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

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

However, the late-filed evidence had to be admitted into the case and taken into account if it was relevant - ie if it might cause the patent to be revoked or its scope to be limited (**T 164/89**, **T 1016/93**).

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

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

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

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

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

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

3.1.3 Examination as to relevance and abuse of procedure

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

In **T 951/91** (OJ 1995, 202) the board refused to take account of late-filed evidence **even before it was actually submitted** and pointed out that the discretionary power given to the departments of the EPO pursuant to Art. 114(2) EPC served to ensure that proceedings could be concluded swiftly in the interests of the parties, the general public and the EPO, and to forestall tactical abuse. Parties had to take into account the possibility that late-filed material would be disregarded and do their best to submit the facts, evidence and arguments relevant to their case as early and completely as possible. If a party failed to do so without adequate excuse, and admitting the evidence would lead to an excessive delay in the proceedings, the boards of appeal were fully justified in refusing to admit it in exercise of the discretion provided by Art. 114(2) EPC. The board informed the parties in a communication that the submission of further fresh experimental data proposed to be filed by the appellant (opponent) at some unspecified later date, some 20 months after the statement of grounds of appeal had been filed and at a time when the decision was substantially completed, was regarded as an abuse of procedure.

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

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

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

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

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

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

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

3.1.4 Procedural abuse in the case of public prior use

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

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

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

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

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

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

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

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

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

3.1.5 Examination as to relevance, and justified late submission

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

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

In **T 49/85** the board stated that a reference filed by an opponent for the first time with its statement of grounds was not submitted in due time unless representing the effective counter evidence to a newly emphasised reason given in the decision (see also **T 172/85** and **T 561/89**). The same applied if the party reacted to its opponent's submission, eg in **T 705/90**, where documents I to N were cited by the appellant in its observations in support of an argument presented in response to the respondent's statement of grounds. Also, in **T 238/92** the board of appeal did not consider a document presented for the first time with the statement of grounds of appeal as "late-filed", since it served as the first evidence of a feature considered in the contested decision as essential for the assessment of inventive step (see also **T 117/92**).

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

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

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

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

4. Late submission and the right to be heard

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

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

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

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

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

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

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

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

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

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

5. Late-filed arguments

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

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

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

6. Documents cited in the patent or the search report

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

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

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

In **T 541/98**, document 04 - referred to in the introduction of the patent in suit - had not been cited by the opponent or considered by the opposition division, and was mentioned for the first time by the board after the opposition proceedings. The appellant (patent proprietor) felt that was at odds with the judicial nature of proceedings before the boards.

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

7. Remittal to the department of first instance

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

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

(a) Patent in jeopardy

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

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

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

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

(b) New facts

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

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

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

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

8. Apportionment of costs

According to board of appeal case law, if a party introduces important facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into account in the apportionment of costs (see p. 492, and **T 117/86** (OJ 1989, 402), **T 326/87** (OJ 1992, 522), **T 97/90**, **T 611/90** (OJ 1993, 50), **T 110/91**, **T 705/92**, **T 847/93**, **T 1016/93**).

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

G. Rules relating to Fees

1. Payment of fee

(a) Incorrect debit orders

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

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

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

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

(b) Designation fees

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

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

(c) Indication of purpose of payment

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

(d) Methods of paying

The remittance of German Patent Office fees vouchers does not comply with Art. 5 RFees and thus cannot be regarded as payment of a fee (**T 415/88**).

2. Date of payment

Art. 8 RFees as amended stipulates that the date on which payment shall be considered to have been made shall be the date on which the payment is "actually" entered in an account held by the EPO. (See **J 24/86** (OJ 1987, 399) for a summary of the previous case law on this matter).

Under Art. 8(3) RFees, the period for payment of a fee is considered to have been observed even if payment is not received until after expiry of the period in which it should have been made, on condition that the following requirements are met (see eg **T 842/90**):

(a) the person who made the payment must provide evidence to the EPO that within the period within which the payment should have been made he effected the payment in a contracting state, for example through a Giro account held by the EPO;

(b) the person who made the payment must pay a surcharge of 10% on the relevant fee unless he effected payment not later than ten days before the expiry of the period for payment.

Under Art. 8(1)(a) RFees, where an amount is transferred to a bank account, the date on which the amount of the payment or transfer is actually entered in the EPO's bank account is considered to be the date on which the payment has been made to the EPO. Thus, where an appeal fee is mistakenly **transferred to a bank account** held by the German Patent Office ('GPO'), neither the date on which the transfer is entered in the GPO's account nor the date on which the order to transfer the amount to the GPO is issued may be taken into account to establish whether a fee due to the EPO has been paid in due time (**T 45/94** and **T 1130/98**). The boards pointed out that, in the Administrative Agreement between the German Patent Office and the EPO concerning procedure on receipt of documents and payments dated 29.6.1981, as amended on 13.10.1989 (OJ 1991, 187), there are no provisions regarding the passing on of the payment or notification of the EPO for erroneous bank transfers. Sums of money payable to the EPO and paid into one of the accounts held by the German Patent Office are, under the terms of the Administrative Agreement, repaid to the payer (**J 49/92**). On the other hand, according to Art. 1(5) of the Administrative Agreement, payments sent by **post** to the GPO are accepted on behalf of the EPO and set aside for daily collection by an EPO employee.

3. Small amount lacking

Under Art. 9(1) RFees, a time limit for payment is in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO is given the discretion (fourth sentence), where this is considered justified, to overlook any small amounts lacking without prejudice to the rights of the person making the payment.

The justification for overlooking a small fee underpayment has been considered by the boards of appeal in several cases. In **T 130/82** (OJ 1984, 172) the board decided that it was justified to overlook an underpayment of just over 10%. In **J 11/85** (OJ 1986, 1) the board stated that an underpayment of about 10% may as a rule be considered as a small amount (see also **T 109/86** of 20.7.1987).

In **T 290/90** (OJ 1992, 368) the board found that this question must be decided on an objective basis, having regard to all the relevant circumstances of the case, and not on a subjective basis. The board reached the conclusion that in the circumstances of that case, 20% of the opposition fee could properly be regarded as a small amount for the purpose of Art. 9(1) RFees, because it was inappropriate to punish the appellant for contending he was entitled to a reduction in the opposition fee and the missing 20% was paid soon after expiry of the period.

However, in **T 905/90** (OJ 1994, 306, Corr. OJ 1994, 556) the board found that the meaning of 'smallness' could best be determined by comparing the amount of shortfall with the amount of the full fee. When viewed in this light, and regardless of its absolute quantity or its quantity in relation to the ability to pay, or the consequences of not paying it, a difference of 20% clearly could not, on purely arithmetical grounds, be regarded as small. It was with very small or trifling amounts that Art. 9(1) RFees was designed to deal so as to prevent a loss of rights where an inadvertent error of some kind had led to a slight underpayment of an amount due in respect of the relevant proceedings.

In **J 27/92** (OJ 1995, 288) the examination fee was underpaid by about 20%, amounting to DEM 560. Distinguishing **T 905/90**, the board defined the concept of a "small amount lacking" in Art. 9(1) RFees as a fixed proportion of the amount of the particular fees to be paid. At most, 20% of the fee to be paid might be regarded as small within the meaning of the said provision. Moreover, the choice of 20% as the percentage to be considered a "small amount" would achieve the desirable end of making it possible to apply Art. 9(1) RFees to cases where a party paying fees mistakenly sought to take advantage of the 20% reduction in fees available in relation to Art. 14(2) and (4) EPC under R. 6(3) EPC and Art. 12 RFees. In the case in point the board decided that it was justified to overlook the deficit as the applicant not only paid it without delay, but also appeared to have been misled into paying only 80% of the fees as a result of information provided by the EPO.

H. Procedural steps

1. General principles

A procedural step is an act, performed by a party to the proceedings, which falls under procedural law as regards the conditions governing it and its effect, and which influences the course of the proceedings.

The decisions of the boards of appeal have developed a number of principles regarding procedural steps.

In proceedings before the EPO a distinction can be made between two kinds of procedural step: those affecting the scope, subject-matter and effect of the requested decision, and those affecting the form of the proceedings. This chapter looks at general principles applying to both types of procedural step. The special features relevant to opposition and appeal statements, to requests for a different apportionment of costs, reimbursement of the appeal fee and appointment of oral proceedings, and to the filing of amended claims are dealt with in the appropriate chapters.

To be effective, declarations regarding procedure need to be clear; ambiguous declarations are ineffective (**J 11/94**, OJ 1995, 596).

Procedural statements may not be subject to any conditions. In **J 27/94** (OJ 1995, 831) the applicant, replying to the communication under R. 51(4) EPC, approved the text of the patent and also made the following statement : " The applicant ... will file in due course a divisional application". After filing the response it filed the divisional application. The Receiving Section refused to treat the application as a divisional application. The decision was based on opinion **G 10/92** which stated that an applicant could only file a divisional application on the pending earlier application up to the approval in accordance with R. 51(4) EPC. The applicant filed an appeal against the decision of the Receiving Section, stating inter alia that the reply to the communication under R. 51(4) EPC did not contain a clear and final approval of the text because it expressed the clear intention to have the previously deleted subject-matter protected by means of a divisional application. The board was of the opinion that the two statements could not be separated from each other without neglecting their correlation and mutual dependence. Hence, the examining division should not have treated the letter as a valid approval, because it contained a condition which made the approval invalid. In the interests of legal security procedural statements had to be unambiguous. This implied that a statement should not be subject to any condition, leaving it unclear whether or not the EPO could proceed further on the basis of it.

Procedural statements are open to interpretation (**G 9/91**, OJ 1993, 408). They are not valid if they are filed by a person who is not entitled to do so (**J 28/86**, OJ 1988, 85). Statements filed during proceedings before the department of first instance are not valid in the subsequent appeal proceedings (**T 34/90**, OJ 1992, 454; **T 45/92**; **T 501/92**, OJ 1996, 261).

According to **T 212/88** (OJ 1992, 28) all requests by parties, including any request for apportionment of costs, should be made before announcement of the decision at the conclusion of oral proceedings. In **T 552/97** the board ruled that, before issuing its decision, the department responsible should clarify the position, ascertaining exactly what was requested and verifying the correctness of its assumption that a request had been withdrawn. An objective lack of clarity at the end of the oral proceedings constituted a substantial procedural violation.

The issue in **J 12/95** was whether the filing of a procedural statement was valid. A European patent application was filed on 19.4.1994 as a divisional application. The Receiving Section refused to treat the application as a divisional application because it was filed after approval had been indicated in respect of the earlier pending application. The approval had been received by fax on 18.4.1994 and as a confirmation copy on 19.4.1996. The applicants/appellants submitted that the transmission of the approval by fax on 18.4.1994 was contrary to their representative's true intentions and occurred in contravention of his express instructions. The board held that a valid procedural declaration required that it be set down in writing, signed and communicated to the EPO by the person responsible. In the present case the content of the declaration was attributable to the appellant's representative whereas the fax transmission was not because there was convincing evidence that this transmission took place against the express order of the authorised representative and could not therefore be treated as a valid approval. The divisional application had to be considered to have been filed within the time limit laid down in R. 25(1) EPC.

Requests relating to ancillary proceedings (eg apportionment of costs) remain pending, even if the appeal is withdrawn (**T 265/93** and, similarly, **T 789/89**, OJ 1994, 482).

2. Signatures

In **J 25/86** (OJ 1987, 475), the board held that the signing of the authorisation is to be considered to be the legal act from which an application ultimately originated.

In **T 960/95**, the board ruled that under Rule 61a EPC in conjunction with R. 36(3) EPC, first sentence, an opposition had to be signed. A missing signature was a deficiency which could be remedied under R. 36(3) EPC, second sentence. According to **T 850/96**, the same had to apply to signatures which were not legible. An opposition signed by a non-authorised third party should be treated like an unsigned one (**T 665/89**).

3. Main and auxiliary requests

3.1 Admissibility

The appellant in **T 382/96** had filed ten auxiliary requests featuring proposals for amending the claims. Some of these auxiliary requests contained no more than broadly outlined alternatives with no proper verbal formulation, and one of the requests was even said to require consultation with the board before it could be more accurately defined. There were a total of 400 alternative versions for the claims.

The board stressed that one of the fundamental principles of European patent law was that responsibility for defining the subject-matter of a patent rested with the applicant (in opposition proceedings the proprietor). That was clear for example from the provisions of R. 51(4) to (6) EPC and R. 58(4) and (5) EPC. The applicant/proprietor could not offload this responsibility de facto on to the European Patent Office or any other parties to the proceedings by filing a multitude of requests, let alone incompletely formulated request variants. In the board's view, doing so constituted an abuse of procedure, as it overburdened the European Patent Office and any other parties to the proceedings with work not originally theirs to perform and thereby hampered the orderly conduct of proceedings. The auxiliary requests in question were rejected as inadmissible for lack of concrete verbal form because they did not identify the extent to which amendment/cancellation of the impugned decision was requested (see R. 64(b) EPC).

In **T 792/92** the board considered as inadmissible the appellant's request at the end of the oral proceedings that, should the outcome of the discussions be negative for him, he be given the opportunity to formulate new requests.

3.2 Examination procedure

According to **T 1105/96** (OJ 1998, 249)**,** an applicant had a right both to file one or more auxiliary requests in addition to a main request, and to maintain all such requests even if the examining division communicated its view that all except the last auxiliary request were inadmissible or unallowable, and he was then entitled to a reasoned appealable decision in respect of rejection of each such request. Where an examining division had communicated its view that a further request in the form of an amended text of a claim would be allowable, the rejection in advance of such a further request unless all preceding requests were abandoned was an unlawful exercise of discretion under R. 86(3) EPC and a substantial procedural violation within R. 67 EPC (see **T 155/88**).

At oral proceedings before the examining division in **T 549/96** the appellant was given the opportunity to withdraw his main request and his auxiliary requests 1 and 2, so as to allow the examining division to grant a patent on the basis of the third auxiliary request. The appellant refused and submitted that according to the principle of reformatio in peius the applicants should have received a decision allowing the third auxiliary request while explaining the grounds on which the other requests were refused, instead of a decision to refuse the patent application.

In this context the board noted that Art. 113(2) EPC required the examining division to decide upon an application only in the text agreed by the applicant. It followed therefrom that an applicant had to indicate clearly at the end of the proceedings which text he wished to be used. Otherwise the examining division would be unable to decide which version should be the basis for its proceedings. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, eg by express disapproval or by maintaining one or more unallowable higher-preference requests, the examining division could refuse the application under Art. 97(1) EPC.

The board noted that the situation in opposition proceedings differed from that in grant proceedings. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC to the effect that the European patent met the requirements of the EPC, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the Convention. The purpose of such an interlocutory decision in opposition proceedings was to save the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in ex parte appeal proceedings the principle of examination ex officio applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the application in a certain version met the requirements of the Convention, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113).

3.3 Opposition procedure

According to **T 234/86** (OJ 1989, 79), the opposition division can - and in certain circumstances must - maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be substantiated (see also **T 488/94**).

In **T 5/89** (OJ 1992, 348) the board confirmed that a decision may confine itself to rejecting the main request only if all subordinate requests have been withdrawn. This principle was further confirmed in **T 785/91**.

4. Maintenance in the case of prior European rights

In **T 117/90**, during the opposition and appeal proceedings, a European patent application was found to be part of the state of the art under Art. 54(3) and (4) EPC and thus caused lack of novelty for all the designated states except Austria and Luxembourg. The board revoked the contested patent for all states, including Austria and Luxembourg, on the grounds that the respondents had requested only the rejection of the opponents' appeal and not the maintenance of the patent in Austria and Luxembourg (see also **T 796/90**).

In comparable situations maintenance of the patent for some of the originally designated states was examined by the boards. This was the case in decisions **T 622/89**, **T 368/90**, **T**

755/90 and **T 806/90** on the basis of requests to that effect from applicants or patentees, some of whom had submitted separate sets of claims for the various (groups of) states.

I. Withdrawal of application and surrender of patent

1. Withdrawal of patent application as a whole

A request for withdrawal of a European application should only be accepted without question if it is completely unqualified and unambiguous (**J 11/80**, OJ 1981, 141). In **J 11/87** (OJ 1988, 367) the board added that where there was even the slightest doubt as to the proprietor's actual intent it had always considered that such a declaration should be construed as a declaration of withdrawal only if the subsequent facts confirmed that such had been his true intent.

In **J 7/87** (OJ 1988, 422) the Legal Board of Appeal ruled that an effective withdrawal of a European patent application did not depend on whether the applicant had used the term "withdrawal". The language used had to be interpreted having regard to the surrounding circumstances from which it had to be clear that the applicant really wanted immediate and unconditional withdrawal rather than passive abandonment leading in the course of time to deemed withdrawal.

In **J 15/86** (OJ 1988, 417) the board stated with regard to the declaration of withdrawal that, in practice, in the operation of the European patent system, there was a recognised difference between passive abandonment and active withdrawal of a European patent application. Each case in which there was a dispute as to the applicant's intention had to be considered on its own facts. A written statement of the applicant or his representative had to be interpreted in the context of the document as a whole and of the surrounding circumstances. It was too late to ask for retraction of a notice of withdrawal once the withdrawal had been published in the European Patent Bulletin (see Legal Advice No. 8/80, OJ 1981, 6, point 2).

In **J 6/86** (OJ 1988, 124) the board considered the statement "the applicant wishes to abandon this application" as an unambiguous withdrawal of a European patent application, since nothing in the circumstances under which the statement had been made could be taken as qualifying such an interpretation.

In **J 4/97**, the applicants withdrew their application by letter filed on 9 September 1996. On 12 September 1996 the applicants informed the EPO that their request for **withdrawal was erroneously made** and should be cancelled. The EPO notified the applicants that the withdrawal had come into force and could not be corrected. On 6 November 1996 a notification was published in the European Patent Bulletin according to which the application was withdrawn. The board held that the withdrawal of the application could be corrected under R. 88 EPC. The legal considerations contained in decision **J 10/87** concerning the retraction of a withdrawal of a designation of a contracting state equally applied to the withdrawal of a patent application as a whole. In particular, it had to be ascertained that the withdrawal had been due to an excusable error and that the retraction of the withdrawal had not adversely affected the public interest or the interest of third parties.

In the circumstances of the case at issue, the board held that the fact alone that the withdrawal was retracted after only three days was a strong indication that it had indeed been made in error. The error resulted from a confusion between two similar reference numbers assigned by the appellants to their patent applications. In the board's opinion this mistake could be considered as an excusable oversight. The public interest was not affected because the withdrawal was retracted before the corresponding entry was made in the Register of European Patents and more than six weeks before the withdrawal was officially notified to the public in the European Patent Bulletin. The interests of third parties could be protected if a national court applied Art. 122(6) EPC mutatis mutandis.

2. Surrender of patent as a whole

In the key decision **T 73/84** (OJ 1985, 241), when the patent was revoked at the instigation of the patent proprietor, the board stated that "the patent proprietor cannot terminate the proceedings by telling the EPO that he is **surrendering** the European patent, since this is not provided for in the EPC. Thus he would only be able, as far as national law permitted, to surrender the patent vis-à-vis the national patent offices of the designated contracting states under the relevant national law". If the proprietor of a European patent stated in opposition or appeal proceedings that he no longer approved the text in which the patent had been granted and would not be submitting an amended text, the patent was to be revoked. The board held that in such a case there was no text of the patent on the basis of which the board could consider the appeal: under Art. 113(2) EPC the EPO must consider the European patent only in the text submitted to it or agreed by the proprietor of the patent.

Following Legal Advice No. 11/82 (OJ 1982, 57) and **T 73/84**, the board stated in **T 186/84** (OJ 1986, 79) that if in opposition proceedings the proprietor of a patent requested that his patent be revoked, it was to be revoked without substantive examination. According to this Legal Advice, a European patent was revoked (without any further examination as to patentability) if the proprietor stated that he no longer approved the text in which the patent was granted and did not submit an amended text. This was assumed also to apply if the proprietor requested that the patent be revoked (see **T 237/86** (OJ 1988, 26), **T 347/90**). In **T 459/88** (OJ 1990, 425) the board added that there was no public interest in maintaining a patent against the patent proprietor's will.

See also page 540.

3. Abandonment of parts of an application or patent

3.1 Abandonment of subject-matter of the application or patent

If an applicant or patent proprietor abandons claims the question arises whether his aim is the **substantive abandonment** of the relevant subject-matter of his application or patent, or whether his intention is to file a **divisional application** in respect of the subject-matter involved or whether the action is merely an **attempt to reformulate the claims** to take account of objections made by the EPO or an opponent.

3.1.1 Abandonment with substantive effect

If the abandonment has substantive effect, there is no possibility of reinstating the abandoned subject-matter, either as part of pending grant or opposition proceedings or by filing a divisional application. This is the assumption if the relevant parts of the description are also abandoned.

In **T 61/85** the applicant had amended the claims before the examining division and requested during appeal proceedings that the claims be granted as originally filed. The board refused this request since the applicant had expressly and unambiguously abandoned the entire original claim and the relevant parts of the description.

In **J 15/85** (OJ 1986, 395) the applicant had submitted new claims to dispel objections by the examining division and had declared that the other claims should be deleted. The applicant had, however, not stated that such deletion should be without prejudice to the filing of a divisional application (see reasons, 3). After the communication pursuant to R. 51(4) EPC, based on the new claims, had been issued, the applicant's representative had filed a divisional application in respect of the claims that had been dropped. The board did not allow such reinstatement. At the date of abandonment of the claims the parent application had already been published so that the public had access to the file and were entitled to assume that the appellant had irrevocably abandoned the claims and would not thereafter seek to obtain protection for them.

A declaration of abandonment could, however, be interpreted to the effect that there was no intention to abandon definitively the subject-matter of the application or patent.

In **T 910/92** the applicants had expressly abandoned several claims in their application, but later retracted their declaration and requested that the claims deleted from the application be reinstated in a divisional application. The board considered under what circumstances it was possible to retract a declaration of abandonment. It referred to the case law, which required that the real intention of the party making the declaration be established, taking into account all the circumstances of the case, and came to the conclusion that in this case the appellants' real intention was not to abandon part of the original disclosure altogether, but to avoid the lack of unity that had arisen as a result of the change in the protection sought. In contrast to the case in **J 15/85** the board did not see any need in this case to protect the public interest by generally prohibiting the retraction of a declaration of abandonment. It could be expected that any third parties interested in the proceedings relating to the application in question would have asked to inspect the files at suitable intervals up until the conclusion of the proceedings.

In **J 13/84** (OJ 1985, 34) the board applied the same criteria to the interpretation of a declaration of abandonment as the case law had developed for declarations of withdrawal of an application (see above). In particular, all the circumstances had to be taken into consideration and not just the preceding declarations. In the case in question the applicants had deleted their claim 21 in response to a communication from the examining division, adding that "in accordance with the examiner's suggestion, we are filing a divisional application for the intermediate products ... and for their method of preparation". The

Receiving Section took the view that the divisional application, with the former claim 21 as its subject-matter, was not filed within the period of two months prescribed in R. 25(1)(b) EPC (old version). It argued that claim 21, which had already been divided out from the application on 6.6.1983 and therefore no longer formed part of the parent application on 31.8.1983 (the date of filing of the divisional application), could no longer be converted into a divisional application. The board did not share this view and called for the declaration of abandonment to be interpreted in the same way as a declaration of withdrawal of an application, ie taking into account all the circumstances. It added that, generally speaking, and as stated in the summary of the Legal Board's decision in **J 11/80** (OJ 1981, 141), "a request for withdrawal should only be accepted without question if it is completely unqualified and unambiguous". The board also referred to decisions **J 24/82**, **J 25/82** and **J 26/82** (OJ 1984, 467), in which it was found that, where claims were withdrawn specifically under R. 25(1) EPC, the applicant's restrictive intention was not to be interpreted in isolation on the strength of particular statements but in the context of the entire procedure. The board took the view that in this case no express intention to drop the claim ensued from the circumstances. The divisional application was therefore admissible.

In **T 118/91** the board ruled that the inclusion of a particular claim in a divisional application did not mean that claim had been dropped from the parent application.

3.1.2 Abandonment without substantive effect

The limitation of claims may represent attempts to respond to objections by the EPO or an opponent without necessarily involving any immediate intentions of substantive abandonment. In this case the question arises of whether the applicant or patent proprietor can reinstate broader claims which had been proposed at an earlier stage of the proceedings.

(a) Examination proceedings

In **T 472/91** the board allowed the reinstatement during ex parte appeal proceedings of claims amended during the examination procedure.

However, aspects of procedural law could present obstacles to the reinstatement of dropped claims or the filing of a divisional application involving such claims.

In **T 12/81** (OJ 1982, 296), the application had been refused. In their statement of grounds of appeal the applicants requested that claim 5 be deleted. During the oral proceedings, however, the applicants requested that this claim be reinstated in the application. The board refused this request on the grounds that allowing such a late request contravened the ratio legis of R. 86(3) EPC in conjunction with R. 66(1) EPC, which was to prevent proceedings becoming unduly prolonged.

In **T 92/85** (OJ 1986, 352) the applicants had amended their claims several times and finally proposed "to limit the application to the embodiment of Figure 6 which had been the subject-matter of the original claim 8". They had then filed correspondingly limited claims. After the communication pursuant to R. 51(4) and (5) EPC (old version) had been sent out the applicants' representative requested the extension of the claims and submitted a set of amended claims and an amended description. He also requested permission to file a divisional application. The board held that after the issue of the communication pursuant to R. 51(4) and (5) EPC and in the absence of exceptional circumstances, the examining division could refuse to allow the filing of a divisional application in the exercise of its discretion under R. 25(1)(a) EPC (old version) and also refuse its consent to further amendments pursuant to R. 86(3) EPC.

(b) Opposition proceedings

(aa) Reinstating broader claims before the opposition division

In **T 64/85** during opposition proceedings the patent proprietor had first amended his claim 1 and then asked as his main request that the patent be maintained as granted. The opponent was of the opinion that the patent proprietor had, by his amendments, abandoned certain subject-matter. Since both the opponent and the public ought to be entitled to trust that this subject-matter was no longer protected, such abandonment should not be reversible. The board took the view that decision **J 15/85** was not applicable in this case since the amendments here did not affect any embodiment in the description or the drawings, with the result that they did not unambiguously limit the protection originally sought but rather clarified features which were already implicitly comprised in the description. The board also held that an amendment made before the opposition division had commented on patentability could not be definitive (see also **T 168/99**).

In **T 123/85** (OJ 1989, 336) the board stated that during the opposition proceedings the patent proprietor was entitled to amend a request already made; in particular he could reinstate the patent in the form in which it was granted, provided this did not constitute an abuse of procedural law. In requesting that their patent be maintained in a limited form the patent proprietors were merely trying to delimit their patent to meet objections expressed by the EPO or the opponents. However, the patent proprietors did not, by virtue of such limitation, irrevocably abandon subject-matter covered by the patent as granted but not by the request as thus limited (likewise **T 155/88, T 225/88, T 715/92**).

The view taken in **T 123/85** that this also applied to the subsequent appeal proceedings now only applies to the extent laid down in **G 9/92** and **G 4/93** (OJ 1994, 875) (see below and under "Appeal").

(bb) Reinstating broader claims in opposition appeal proceedings

According to **G 9/92** and **G 4/93** (OJ 1994, 875), in opposition appeal proceedings the extent to which the patent proprietor is entitled to make amendments depends on the result of the first-instance proceedings and on whether the patent proprietor himself filed an admissible appeal or is merely the respondent. The view taken in decisions such as **T 576/89** (OJ 1993, 543) **T 770/89** and **T 217/90** is no longer applicable.

(1) Where the patent proprietor is appealing against the **revocation** of his patent, he is entitled to revert to a more broadly worded version of the patent, and in particular the one as granted, even if he had filed a restricted version at the commencement of appeal proceedings

(**T 89/85; T 296/87**, OJ 1990, 195; **T 373/96**; **T 65/97** and **T 564/98**). Should opposition appeal proceedings reveal that the claims as amended during opposition proceedings are in breach of Art. 123(3) EPC, the patent proprietor and appellant must be allowed to abandon this version (**T 828/93**). The right in principle to reactivate earlier claims is refused if it appears to constitute an abuse of procedure, as was the case in **T 331/89**.

(2) Where the **opposition was rejected** and the patent maintained as granted, the respondent/patent proprietor can revert to the version as granted, provided he has first proposed restrictions during the appeal proceedings (**T 705/91**).

(3) Where the patent was **maintained as amended** the **patent proprietor** who did **not** himself file **an admissible appeal** may, according to **G 9/92, G 4/93** (OJ 1994, 875), in principle only defend the patent in the form it which it was maintained by the opposition division in its decision. He may not revert to the version of the patent as granted (see also **T 369/91**, OJ 1993, 561). Any amendments he proposes in the appeal proceedings may be rejected by the board if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal (see, for example, **T 266/92** of 17.10.1994). According to **T 752/93** of 16.7.1996, however, an amendment made in the course of appeal proceedings to the version as amended by the opposition division which is appropriate and necessary may not merely restrict this version, it may also extend it - even in cases where the patent proprietor has not filed an appeal. For the limits set on the patentee/respondent to make amendments see **G 1/99**, OJ 2001, 381 and chapter "Appeal procedure".

If however, where the patent is maintained in amended form, the **patent proprietor** is himself the **appellant**, he may in appeal proceedings pursue claims which are broader than those held to be allowable by the opposition division.

It was however decided that in appeal proceedings the patent proprietor may only pursue claims which were the subject of the first-instance decision. In **T 528/93** the board took the view that a request containing an independent claim filed earlier in virtually identical form, then withdrawn during proceedings before the opposition division and hence not the subject of the contested decision, was not the subject of the appeal, because the appellant was not adversely affected by such a decision with respect to that request. Exercising its discretion, the board did not therefore admit this request into the appeal proceedings (see also **T 506/91**).

3.1.3 Non-payment of further search fees in the case of lack of unity

According to **T 178/84** (OJ 1989, 157) it is clearly the intention of R. 46(1) EPC to regard subject-matter as abandoned in a particular patent application if, in response to an invitation according to this rule, the further search fee is not paid for this subject-matter within the time limit set by that rule. Since a different view was taken in **T 87/88** (OJ 1993, 430), the President of the EPO referred the matter to the Enlarged Board of Appeal which, in **G 2/92** (OJ 1993, 591), held that an applicant who failed to pay the further search fees for a non-unitary application could not pursue that application for the subject-matter in respect of which no search fees had been paid. He would have to file a divisional application in respect of such subject-matter. However, non-payment was not to be equated with the abandonment of parts of the application.

3.1.4 Non-payment of claims fees

If an applicant fails to pay claims fees, he is considered under R. 31(2) EPC to have abandoned the claims. Apart from resolving the specific question whether certain parts of the application were part of the description or were claims, decision **J 15/88** (OJ 1990, 445) made clear that such abandonment of certain claims could only cause a substantive loss of subject-matter if the subject-matter involved was contained only in the claims and not also in the description or drawings. The board held that an applicant who declined to pay claims fees when they were demanded ran the risk that features of a claim deemed to have been abandoned pursuant to R. 31(2) EPC, which were not otherwise to be found in the description or drawings, could not subsequently be reintroduced into the application and, in particular, into the claims. The idea that there could be forced abandonment of subject-matter, in reliance on R. 31(2) EPC, appeared rather to be in conflict with the principles of higher law to be deduced from Art. 52(1) EPC in conjunction with Art. 123(2) EPC. An applicant normally had the right to derive subject-matter from any part of the description, claims or drawings as originally filed (see reasons 6 and 7). This view has since been confirmed in other ex parte proceedings, namely **T 490/90**.

J. Law of evidence

1. Introduction

Before an administrative authority or a court takes a decision, it is required to establish the existence of the material facts, ie the facts from which, under the relevant legal provision, the legal effect ensues. The facts are established by taking evidence. However, facts need not be proved if they have already been established or if the authority or court has to assume their existence.

Where the onus is on the parties to present their case, they are required to furnish proof of the facts they allege, in so far as such facts are disputed. Where the investigative principle applies, the evidence relating to the facts to be proved must be obtained by the body which has to take the decision, although the lengths to which it must go are left to it in the proper exercise of its discretion. The body in question is not bound by mutually corroborating statements made by parties on opposing sides; it has wide discretion to decide what evidence to accept and the weight it attaches to it (the principle of unfettered consideration of the evidence).

Art. 117 EPC and R. 72 to 76 EPC contain provisions governing means of giving or obtaining evidence, the procedure for taking evidence and the conservation of evidence. The boards of appeal have considered other questions arising in connection with the law of evidence.

1.1 Terminology

The boards have interpreted the term "taking of evidence" broadly, applying it not only to the procedures listed in R. 72 EPC but also to the production of documents of any kind, unsworn declarations and the giving and obtaining of evidence, whatever its form (see **T 117/86** (OJ 1989, 401), **T 416/87** (OJ 1990, 415), **T 323/89** (OJ 1992, 169), **T 314/90**).

The term "documents" in Art. 117(1)(c) EPC, which is not elucidated in the EPC, was defined in **T 314/90** as meaning essentially all written documents in which thoughts are expressed by means of characters or drawings, including published documents.

In **T 795/93** the board was of the opinion that a document as a means of disclosing the state of the art was a means of proof with a variety of functions. It was intended first to prove what had been made available to the public in the written description it contained, ie what contribution in the form of information, knowledge, teaching, etc. it made to the state of the art, and also served to prove when such information had been made available.

In **T 543/95** the board drew a distinction between the terms "evidence" and "substantiation". The time at which something could be said to have been made available to the public was substantiated by indication of a date or of a restricted period and by indication of the means by which the time claimed was established. The purpose of the evidence was to verify whether the assertion made was in fact correct. Substantiation did not extend to evidence, even if it was possible for both to coincide when using written documentation as a means of proof.

In **T 558/95** the board stated that a statutory declaration ("eidesstattliche Erklärung") was evidence within the meaning of Art. 117(1) EPC and as such subject to the free evaluation of evidence. It took the place of the sworn statements in writing referred to in Art. 117 EPC which did not exist as evidence under German law.

In **T 301/94**, the board confirmed the practice of the boards of appeal stating that the EPC did not contain any restrictions with regard to the kind of evidence which could be produced in proceedings before the EPO. A "déclaration sur l'honneur" certified by a "notaire" is therefore admissible as means of proof.

2. Admissibility of evidence

The question has often arisen as to whether a particular submission may be admitted as evidence. This question has to be kept separate from that of the actual consideration of the evidence. Art. 117 EPC does not contain an exhaustive list of admissible evidence. Nor does the EPC provide that certain points of fact may be established only by certain means of evidence. The boards have therefore assumed that any kind of evidence is admissible for any facts that have to be proved.

In **G 11/91** (OJ 1993, 125) the Enlarged Board of Appeal stated that evidence of what was common general knowledge on the date of filing of a patent application may be furnished in connection with an admissible request for correction under R. 88 EPC, second sentence, in any suitable form allowed by the EPC - and Art. 117(1) EPC in particular - as a means of giving or obtaining evidence. It may thus be based upon means of evidence in other than document form (see also **G 3/89**, OJ 1993, 117).

The Legal Board of Appeal decided along the same lines in **J 11/88** (OJ 1989, 433), according to which questions of fact must be settled on the basis of any credible information available. In **T 838/92** too, the board established that any kind of evidence is admissible. In this case, the appellant argued that the witness's testimony should not be admitted as evidence; his impartiality was suspect because he was being sued for infringing the corresponding French patent.

In **T 482/89** (OJ 1992, 646) the board took the view that an employee of one of the parties to the proceedings could be heard as a witness (see also **T 443/93** and **T 937/93**). In **T 124/88** and **T 830/90** (OJ 1994, 713) employees of the opponent were heard without the admissibility of such oral evidence being called into question. In **T 575/94** the board held that hearing the employees of an opponent or of a company whose involvement was as a client of the opponent was not precluded. It was also pointed out in **T 838/92** and **T 443/93** that the fact that a witness might be biased did not make his oral evidence inadmissible but was a matter to be taken into account when the EPO considered the evidence.

In **T 558/95** the board held that the fact that the statutory declarations provided by the opponent were to some extent identical in wording and drawn up by employees of the opponent did not rule them out as admissible evidence. It was rather a question of evaluation to see whether the evidence provided was sufficient.

Art. 117(1)(g) EPC allows sworn statements in writing as a means of giving or obtaining evidence.

In **T 674/91** the board noted that it was board of appeal practice to regard affidavits or statutory declarations in original or copy form as admissible means of providing evidence, to avoid having to call the person who had made the declaration as a witness. In **T 770/91** the board pointed out that although statutory declarations were not covered by Art. 117(1)(g) EPC, they were taken into account in accordance with the principle of the unfettered consideration of evidence. In **T 970/93** the board pointed out that there was no express provision for the acceptance by the EPO of unsworn declarations in the catalogue given under Art. 117(1) EPC. However the EPO accepted unsworn solemn declarations, in the same way as it accepted other unsworn statements.

In **T 327/91** it was ruled that any kind of document, regardless of its nature, was admissible in proceedings before the EPO. The fact that an affidavit was submitted by the appellant's general manager did not make it inadmissible. Assessment of the affidavit was a question to be dealt with in accordance with the principle of the unfettered consideration of evidence.

In **T 231/90** it was made clear that evidence supplied in the form of testimony by witnesses or statutory declarations was not admissible if such means of evidence were offered in place of delivery notes which could no longer be produced because such a long time had been allowed to elapse that they had been destroyed during routine shredding.

In **T 395/91** it was not considered appropriate for an expert to be heard since the questions to be answered by the expert had already been answered by the inventor as a person skilled in the art. The board was further of the opinion that assessment of the patent law aspects, on the basis of comprehensible technical facts, was a matter for the members of the board and not a technical expert.

In **T 543/95** the opponent/appellant had asserted in the grounds for opposition that a brochure illustrating the apparatus had been made available to the public at a specified time. As proof he had cited the date printed on the brochure, and also offered to provide a witness. Regarding prior use of the apparatus, he had offered only witness corroboration. The opposition division had refused to hear the witness, commenting that he would serve only to confirm the facts presented. It regretted that the opponent had not produced further documents showing when the brochure was made public.

The board pointed out that the purpose of all evidence, whatever its nature, was to confirm a party's assertions. Parties were free in their choice of evidence. The kinds listed in Art. 117(1) EPC were merely examples. It was not for opposition divisions to criticise the absence of other types of evidence.

3. Procedure

It was made clear in **J 20/85** (OJ 1987, 102) that the Receiving Section too had the power to take evidence, although this EPO body was not listed in Art. 117 EPC. The board also laid down the principle whereby, in any case of disagreement, evidence relating to it should be taken as soon as it arose. Evidence could also be taken from parties without the presence of their patent attorneys if the latter had been informed of the hearing (see **T 451/89** and **T 883/90**).

In **T 953/90** the board held that when a party sought to prove potentially relevant facts by means of the statement of a witness, it was particularly important that this statement be furnished early in the opposition phase so as to enable the witness to give oral evidence in accordance with Art. 117 EPC, if the statement was disputed by a party on the other side or if the EPO considered it necessary.

T 760/89 (OJ 1994, 797) dealt with the possibility of returning documents which had been filed as evidence and were subject to an obligation to maintain secrecy. The ruling was that documents filed as evidence during opposition proceedings and submissions referring to them in principle remained in the file until the end of the proceedings and for at least five more years (see R. 95a EPC). Documents filed as evidence could only exceptionally and on a substantiated request remain unconsidered and be returned. Such an exception existed if the interests of the filing party in having them returned unconsidered clearly prevailed over the interests of any other party and the public interest. This might be the case if the documents were filed in breach of a confidentiality agreement and if they did not belong to the state of the art but were third party statements filed as part of the response to the opposition, and if the other parties involved agreed with the request. The same applied to submissions referring to such documents.

In **T 39/93** the board held that it had to decide an appeal on the basis of the evidence and arguments adduced in the current proceedings. It would be wholly wrong for it to take cognisance of any matter that was not actually in this particular case. If an original photomicrograph was a piece of evidence that had been introduced in another case and only a photocopy of this had been introduced in the case in question, the board was limited to a consideration of the photocopy filed in the present appeal.

In **T 232/89** the opponent/respondent had produced two affidavits which had not been contested by the patent proprietor/appellant, but had not tendered any witnesses. The opponent's request that the authors of the affidavits also be heard as witnesses was rejected, as the affidavits were quite sufficient in the circumstances.

In **T 674/91** it was stated that according to the practice of the boards of appeal, affidavits or statutory declarations, whether originals or copies, were acceptable as evidence. As one of the purposes of this form of evidence was to avoid having to call the signatory as a witness, it seemed superfluous to have them confirmed in this way. Since these statements were usually drawn up on the basis of answers to questions formulated by lawyers, it was not surprising to find the same stereotyped formulations in different declarations. The board was not required to check the signatures of the persons concerned, unless evidence disputing their validity was produced.

In **T 804/92** (OJ 1994, 862) the opposition division had, in a communication to the parties, suggested in detail the content of a statement under oath. Such a practice was firmly rejected by the board because it involved the risk of leading witnesses and could seriously undermine the probative value of such statements. This applied to departments at any instance in proceedings before the EPO.

In **T 798/93** the board emphasised that sworn statements in writing, which were one of the means of giving or obtaining evidence listed in Art. 117(1) EPC, were not automatically ordered simply at the request of one of the parties. All means of giving or obtaining evidence listed in Art. 117 EPC were subject to the discretion of the department concerned, which ordered them only when it considered this necessary.

In **T 142/97** (OJ 2000, 358) the board decided that EPO departments must ascertain the relevance of evidence submitted to them before deciding to admit or reject it. Only in exceptional circumstances need they not do so.

In the case in point, however, the opposition division based its refusal of the offers to present evidence on mere conjecture as to its content, and failed even to take cognisance of the evidence tendered and its connection with the circumstances of the prior use, although there were no circumstances which would have made examination as to relevance dispensable. An opposition division's refusal to consider evidence filed in due time (eg witness testimony or inspection) thus infringes a party's fundamental rights to free choice of evidence and to be heard (Art. 117(1) EPC and Art. 113(1) EPC).

4. Evaluation of evidence

The EPC says nothing about how the outcome of taking evidence should be assessed. The principle of unfettered consideration of evidence applies. The body required to take the decision therefore decides - on the basis of the whole of the evidence taken and the proceedings, and in the light of its conviction arrived at freely without reference to any legislative provisions on the evaluation of evidence - whether an alleged fact has occurred or not (see **T 482/89** (OJ 1992, 646), **T 327/91**, **T 838/92**, **T 575/94**). Nor, consequently, have any general rules for the evaluation of evidence been laid down, but it has been decided in individual cases when a particular means of evidence was sufficient.

If a party fails to submit available evidence when asked by the board to do so, this may be taken as an indication that possibly the evidence does not support his arguments (**T 428/98**, Reasons 3.6).

For examples of the appraisal of evidence, the following decisions may be cited.

In **T 473/93** the board decided that the appellant's surmise that he had been in error in making his statutory declaration was not sufficient to allow orally presented facts which deviated from the declaration to appear more credible. The fact alleged orally therefore had to be regarded as not proven.

In **T 332/87** a dated internal paper, marked as being confidential and not signed, was - together with an undated leaflet - not considered sufficient evidence. In **T 595/89** the board decided that the opponent's in-house documents relating to the installation of a device in an aeroplane and to the sale thereof were not sufficient to prove public prior use. In **T 204/88** a letter of tender was not sufficient to prove public prior use because it was not discernible when and to whom the device was to be delivered and because the device was described in terms too general for anyone to identify whether it corresponded to the invention. In **T 725/89** too, a dated tender was not regarded as sufficient evidence, as it was not proven when the tender had actually been presented, and the date of the tender was only one week prior to the priority date. In **T 482/89** (OJ 1992, 646) the board took the view that an unsigned delivery note, together with other documents, could constitute sufficient evidence of delivery.

In **T 162/87** and **T 627/88** it was decided that the statement made by an employee of the party alleging prior use could be sufficient. The statements of employees of one of the parties were also used in the above-mentioned decisions **T 124/88**, **T 482/89** (OJ 1992, 646), **T 830/90** (OJ 1994, 713), **T 838/92** and **T 327/91**, without any grounds for their credibility being given. The credibility of witnesses could not be impugned merely because they were related to one another and had a business relationship with one of the parties (**T 363/90**). In **T 937/93** it was stated that the probative value of the declarations of a witness depended on the circumstances of the particular case.

In **T 1191/97** the board thought the fact that the events at issue had taken place a long time ago could readily explain certain imprecisions in the witness's testimony. That applied in particular to the date of delivery of the prior-use item - which however was precisely established by other documentary evidence. The board saw no indication that the witness had been in breach of his obligation to testify to the best of his recollection.

In **T 970/93** the claims referred to a continuous multi-stand mill plant for producing steel plates. Two prior uses, a mill plant in China and a mill plant in Germany, were put forward by the opponents/appellants. A discussion developed on the subject whether the skilled person would have been able to recognise the relevant feature, ie the rolling speed ratio of the mill plant in China, because such ratio could not be derived from a single rolling event. Furthermore, the respondent took the view that both the builders and the owners of the plant would impose confidentiality in order not to reveal the actual capacity of the mill, thus putting competitiveness at risk.

Following the principle of the balance of probabilities it was in the board's view very unlikely that in a period of almost seven years between the start of operations at the plant and the priority date of the patent in question, the mill drive motor speed ratio of the mill would not have become publicly available taking account of the following evidence and circumstances: it was common practice in China to promote and demonstrate newly-installed industrial plants as a means of instruction to young engineers. Considering that one of the main performance parameters of a mill was its "speed cone", such a skilled person would enquire about this parameter or work out the speed ratio of the stand himself by comparing the minimum and maximum speed of the mill rolls. In view of the instructional aspects it was not at all likely that secrecy would bar this information path for competitive reasons as supposed by the respondent. In the absence of any evidence as to confidentiality the principle also applied that the company that purchased the mill could be considered a member of the public which through the purchase of the mill and subsequent use thereof took possession of all the relevant information with respect to the rolling speed ratio.

In **T 905/94** the patent proprietor had exhibited a blind at an exhibition. After having considered the evidence regarding the exhibition the board looked at the question of whether use of the same trade name for different models could constitute evidence of the fact that the patent proprietor had marketed or described the blinds according to the patent at issue before the date of priority. In the board's opinion, such use could not constitute sufficient evidence since it was common practice in industry for the same name to be used and retained for a product, the technical characteristics of which changed over time as improvements were made. The board also emphasised that the fact that one witness had made his declaration three years earlier than other witnesses was not sufficient reason to make his testimony more credible.

To prove the alleged public prior use, in **T 212/97**, the appellants (opponents) had cited facts based on hearsay. The appellants' attention had been drawn several times to the inadequacy of the evidence for the alleged prior uses. They failed to cite any witnesses. However, where public prior use was alleged, opponents had to do everything they could to provide satisfactory evidence.

In **T 687/93** the board had to decide on the basis of some documents indicating the product number and its commercial name whether a resin composition had been made available to the public. The board was of the opinion that a manufacturer would at least change the code number identifying a product if this was modified in any way so that products bearing an unchanged code number, possibly in association with a trade name, could be assumed to be the same.

In **T 48/96** the board stated that, in order to prove the allegation that a particular apparatus described in a catalogue had been available to the public before the priority date, it was not sufficient to show that the catalogue had been published on time, because a mere indication in a catalogue did not constitute absolute proof that the described product had in fact been available to anybody; for example, there could have been a delay. It therefore decided not to accept copies of pages from a catalogue bearing a date as sufficient proof of availability to the public.

In **T 970/93** the respondent had disputed the validity of all the evidence brought forward but mainly based its objection on the assumption that the evidence could have been falsified. The board held that such an allegation based solely on suspicion could not reasonably be expected to form a valid ground for casting doubt on the credibility of the evidence. It accepted them as valid evidence.

In **T 301/94,** the board confirmed that the principle of unfettered consideration of evidence applied to any kind of evidence submitted in these proceedings. Furthermore, the board stated that the probative value of a "déclaration sur l'honneur", the signature of which had been certified by a "notaire", depended on the particular circumstances of the case.

In **T 750/94** (OJ 1998, 32) the board held that in accordance with the principle of unfettered consideration of evidence items of evidence relevant to a matter at issue had to be given an appropriate weight in order to establish reliably what was likely to have occurred. An unsigned statement by an unknown and unnamed person should in principle be given minimal weight.

In national proceedings before the Dutch District Court and Court of Appeal, several witnesses were heard, and written statements were introduced from both parties. The Dutch Court of Appeal could not establish an uninterrupted chain of proof that the alleged public prior uses had indeed taken place before the priority date of the contested patent. After evaluating the Dutch Appeal Court's findings, the board's judgment in **T 665/95** was that no further investigations were necessary and that the conclusion of the Dutch Appeal Court could be followed, with the consequence that the subject-matter of the granted claim 1, contrary to the impugned decision of the opposition division, was considered to be novel.

5. Standard of proof

The facts on which the decision is based must have been established to the satisfaction of the deciding body. The question arises as to what degree of satisfaction is necessary. A substantial number of board of appeal decisions deal with this problem.

The boards of appeal generally apply the standard of the "balance of probabilities", ie they are satisfied on the basis that one set of facts is more likely to be true than the other. This applies particularly in opposition appeal proceedings, see inter alia **T 182/89**, OJ 1991, 391; **T 270/90**, OJ 1993, 725; **T 859/90**, **T 109/91**, **T 409/91**, OJ 1994, 653; **T 1054/92** of 20.6.1996, **T 296/93**, OJ 1995, 627, point 5.2 of the reasons; **T 326/93, T 343/95**. However, this standard is also applied in the decisions issued in ex parte proceedings, **T 381/87**, OJ 1990, 213; **T 69/86, T 128/87**, OJ 1989, 406; **T 939/92**, OJ 1996, 309.

In other cases (eg **T 100/97**) the board decided on the basis of circumstances of which it was sufficiently certain.

In **T 1103/96** the board ruled that even if it was not possible to reconstruct exactly what had happened during oral proceedings before the first-instance department, so that the board had only circumstantial evidence on which to base its decision, the facts apparent from the file nonetheless suggested with a sufficient degree of certainty that the appellant's arguments regarding violation of the right to be heard were well founded.

A much stricter standard of proof is applied in some cases.

According to decision **T 750/94** (OJ 1998, 32), when an issue of fact is being examined and decided by the EPO on the balance of probabilities, the more serious the issue the more convincing must the evidence be to support it. If a decision on such an issue might result in refusal or revocation of a European patent, for example in a case concerning alleged prior publication or prior use, the available evidence in relation to that issue had to be very critically and strictly examined. A European patent should not be refused or revoked unless the grounds for refusal or revocation (that is, the legal and factual reasons) were fully and properly proved.

(a) Content of a disclosure

In **T 793/93** the relevant prior art document had failed to disclose explicitly something falling within a claim. The board held that availability within the meaning of Art. 54 EPC could still be established if the inevitable outcome of what was literally or explicitly disclosed fell within the ambit of that claim. In the board's view, a standard of proof much stricter than the balance of probability, to wit "beyond all reasonable doubt", needed to be applied. It followed that if any reasonable doubt existed as to what might or might not be the result of carrying out the literal disclosure and instructions of a prior art document, in other words if there remained a "grey area", then the case of anticipation based on such a document had to fail (see also **T 464/94**).

In **T 348/94**, the board held that it had not been proven beyond reasonable doubt that the technical contents of the oral presentation at the conference corresponded **in all details** to the relevant article published 10 months later in the conference proceedings. Unless there was proof to the contrary, a written publication, supposedly based on a paper previously read at a public meeting held some time earlier, could not be assumed to be identical to what was disclosed orally but might contain additional information (see also **T 890/96**).

In **T 838/97**, the board emphasised that there must be no doubt that the prior disclosure, as read by the skilled person, unambiguously corresponded in all its technical features to the subject-matter as claimed.

(b) Prior use

In **T 782/92**, the board took the view that public prior use had to be proved beyond any reasonable doubt. **T 472/92** (OJ 1998, 161) reaffirmed the approach of the balance of probabilities in normal cases, but made a distinction for cases of public prior use where practically all the evidence in support of an alleged public prior use lay within the power and knowledge of the opponent. In such cases, the patentee seldom had any ready, or indeed any access to it at all. All he could, in practice, do was to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any gaps in the chain of commercial transactions that needed to be established by the opponent in order to succeed on this ground. The board stated that in such cases an opponent had to prove his case up to the hilt, for little if any evidence would be available to the patentee to establish the contradictory proposition that no public prior use had taken place (confirmed in **T 97/94** (OJ 1998, 467, reasons, 5.1) and **T 848/94**).

(c) Art. 123(2) EPC or R. 88 EPC, second sentence

The boards only allowed amendments or corrections if it was certain beyond any reasonable doubt that the subject-matter of the application had not been extended beyond that of the application as filed (**T 383/88**, **T 581/91**). When examining Art. 123(3) EPC the board laid down the principle in **T 113/86** that voluntary amendments requested by the patentee which were not necessitated by any of the grounds for opposition raised by the opponent or by the board should, in principle, not be allowed if there was the slightest doubt that the unamended patent could be construed differently to the patent as amended.

(d) Re-establishment of rights

In cases of re-establishment of rights it is usually ruled that, on the basis of the evidence furnished, the board is or is not satisfied that the facts adduced to substantiate the application for re-establishment of rights are true. In **T 243/86** and **T 13/82** (OJ 1983, 411), a request was made for "Glaubhaftmachung" (ie that the facts on which the application relies be set out) in accordance with Art. 122(3) EPC, first sentence. Whether this term signifies - as in German, Austrian or Swiss law - that a lower degree of probability is sufficient has not yet been decided.

(e) Disciplinary matters

In **D 5/86** (OJ 1989, 210), the board held that an infringement of the rules of professional conduct had to be established to the satisfaction of the disciplinary body before it could impose a disciplinary measure. Absolute certainty was not required, but a degree of probability which in human experience verged on certainty. A disciplinary measure could not be imposed if there was reasonable doubt as to whether the infringement had occurred.

(f) Opposition on behalf of a third party

In **G 3/97** (OJ 1999, 245) and **G 4/97** (OJ 1999, 270) the Enlarged Board of Appeal held that if the person named as opponent according to R. 55(a) EPC is acting on behalf of a third party, such an opposition is inadmissible only if the involvement of the opponent is to be regarded as circumventing the law by abuse of process. The deciding body had to be satisfied on the basis of clear and convincing evidence that the law had been circumvented by abuse of process.

6. Burden of proof

6.1 Unprovable facts

If a material fact is not or cannot be proven, a decision is taken on the basis of who carries the relevant burden of proof: the fact that the real position cannot be established operates to the detriment of the party which carries the burden of proof for this fact. The EPC contains no explicit provisions in this respect. However, a few principles can be inferred from board of appeal practice.

According to **T 200/94** (following established case law), if a board's investigations did not enable it to verify beyond reasonable doubt the facts alleged, this went to the detriment of the party needing to prove them, ie the party who relies on these facts.

In **ex parte proceedings** the applicant bears the burden of proof for the facts in his favour, eg the fact that a document cited by the examining division does not form part of the state of the art (**T 160/92**, OJ 1995, 35), the fact that the conditions laid down in Art. 123 EPC have been met (**T 383/88**) or the fact that a limitation of the claims is admissible (**T 2/81**, OJ 1982, 394).

In **T 32/95** the board found that once the applicant showed sound reasons for doubting whether a cited document belonged to the state of the art, the examiner should act as recommended in the Guidelines C-IV, 5.2, ie when any further investigation did not produce evidence sufficient to remove that doubt, not pursue the matter further.

With regard to **opposition proceedings**, the principle was laid down in **T 219/83** (OJ 1986, 211, Corr. OJ 1986, 328) that the patent proprietor is given the benefit of the doubt if the parties make contrary assertions regarding facts barring patentability which they cannot substantiate and, furthermore, the EPO is unable to establish the facts of its own motion (see also **T 293/87**, **T 459/87**). In appeal proceedings, the party's status as opponent makes no difference when it comes to assigning the burden of proof (this follows eg from **T 740/90** and **T 270/90**, OJ 1993, 725; **T 381/87**, OJ 1990, 213). If the opponent disputes eg the existence of an inventive step, he bears the burden of proof in this respect at first and second instance (see **T 382/93**).

These principles were confirmed with regard to non-reproducibility of the invention inter alia in **T 16/87** (OJ 1992, 212) and **T 182/89** (OJ 1991, 391).

In **T 1003/96**, the board confirmed that in case of uncertainty about a prior-art disclosure, the patentee should be given the benefit of the doubt (see decisions **T 230/92**, **T 345/86**, **T 601/91**, Reasons 5.2.6, and **T 968/91**).

In **T 547/88** inventive step was contested. Although the board had asked the parties to issue a joint protocol stating what tests had to be done and under what conditions, each party in fact conducted his own experiments and obtained contradictory results. It was therefore not possible for the board, on the basis of these tests, to conclude definitively that no inventive step was involved. The board held that in such a case the patent proprietor should be given the benefit of the doubt with regard to the relevance of the claimed features to the problem to be solved. Moreover, since the prior art did not suggest the subject-matter of the contested claims, that subject-matter implied an inventive step. The patent was therefore maintained.

In **T 254/98**, the appellant (patentee) provided no proof for the contention that it was not within its power to obtain counter-evidence from the firm in question. The board pointed out that a party could not relieve itself of the burden of providing counter-evidence for facts it alleged by simply referring to **T 472/92** (OJ 1998, 161) and stating that all the evidence was within the power of its adversary, without bringing proof that not he but only the Respondent was able to collect the evidence in support of the respective contention.

Questions relating to the allocation of the burden of proof can also arise in connection with **procedural questions**.

In **J 10/91** the board held that if a letter, and attached cheque in payment of a fee, had been lost without further evidence or high probability that it had been lost in the EPO, the risk was then borne by the sender.

In **T 632/95** the board confirmed that the burden of proving that a document had been received lay with the party submitting the document just as, vice versa, the EPO bore the burden of proving receipt of the documents it issued.

In **J 8/93**, the board confirmed that even conclusive evidence that something had been posted could not be treated as sufficient to prove that a document had been received by the EPO. If the post failed to deliver a document, the applicant would suffer the consequences for failing to file that document.

If a party relied on the fact that there was a general legal maxim along the lines of Art. 125 EPC, according to which his appeal would have to be allowed (in the case in question: the principle whereby decisions of a court of final jurisdiction could be set aside in the event of serious procedural errors), he would have to produce evidence that such a procedural principle existed in most EPC contracting states (**T 843/91**, OJ 1994, 832).

In **T 833/94** the board held that, when the evidence offered does not directly indicate the truth or falsity of the fact in issue, but requires knowledge of the national law and patent practice, such law and practice has to be proved as does any other fact on which a party bases its arguments.

According to the German version of R. 78(2) EPC, second sentence, (formerly R. 78(3) EPC), the EPO must in a case of doubt, "im Zweifel", establish the date on which the letter was delivered to the addressee. In **T 247/98** the board decided that, when establishing the meaning of the term "im Zweifel" in the German version of R. 78(2) EPC, account should be taken of the French and English versions, which assumed that there was a dispute ("en cas de contestation", "in the event of any dispute").

From the general principles concerning the burden of presentation which fell on the parties, it followed that a party seeking the application of a legal provision favourable to its interests had to set out the facts justifying such application, even if it did not ultimately bear the burden of proof for those facts. Although, in the event of a dispute within the meaning of R. 78(2) EPC, the burden of proof for the date of delivery fell on the European Patent Office, this could not be taken to mean that a party wishing to rely on the late delivery of a letter from the Office had no obligation to contribute to the clarification of circumstances within its own sphere of activity but could sit back, as it were, and wait to see whether the Office succeeded in ascertaining when the letter had been delivered to the party. A dispute ("Zweifel" in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting.

Having regard to the above, in the case in point the mere absence from the file of the advice of delivery and of the receipt from the appellants' then representative did not constitute a sufficient basis for a dispute ("Zweifel" or "contestation") under R. 78(2) EPC over whether the decision had been delivered to the appellants' then representative within ten days of despatch. It was generally known that advice of delivery notes, and receipt notes, were not always sent back to the Office; therefore, the fact that they were missing from the file did not necessarily mean that a delivery error had occurred. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ("Zweifel") within the meaning of this Rule.

At all events, in proceedings before the EPO, facts which related to a party's own actions or were the subject of a party's own perceptions could not be denied on the ground of "ignorance" by that party if the presentation of the facts in question was essentially the party's responsibility.

6.2 Shifting of the burden of proof

In the case law of the boards of appeal the term "burden of proof" is also used in another sense: if a party has achieved a favourable decision at first instance or has already produced convincing proof of the facts alleged by it, then the burden of proof shifts to the other party i.e. the party must now disprove or at least negate this evidence in order to achieve a decision in its favour.

In **T 270/90** (OJ 1993, 725) it was pointed out that each party carried the burden of proof for the facts it alleged. If one party furnished convincing proof of the fact it had alleged, the burden of proof for the other party's contrary assertion shifted to the latter. In **T 109/91** the board held that the burden of proof might shift constantly as a function of the weight of the evidence. This was confirmed in many decisions (see eg **T 525/90, T 239/92**, **T 838/92**).

In **T 954/93** the appellant/opponent had put forward objections to the patent on the basis of lack of novelty, which would have had to be demonstrated by means of experiments. He had not however carried out any tests on the ground that they would have been very expensive. The board considered the allegation unproven and refused to reverse the burden of proof. The fact that experiments would have been very expensive did not shift the burden of proof onto the patent proprietor.

In **T 743/89** the board applied the principle of prima facie evidence. Here, it had been proved that a leaflet disclosing the invention had been printed seven months before the date of priority, but it was uncertain when the leaflet had been distributed. The board took the view that, although the date of distribution could no longer be ascertained, it was reasonable in any event to assume that distribution had occurred within the seven-month period. The respondents contended that this was not the case, but the board considered this assertion to be so lacking in plausibility that it placed the onus of proof on the respondents.

In **T 585/92** (OJ 1996, 129) the board held that in opposition proceedings the burden of proving that the objections raised under Art. 100 EPC have been substantiated lay with the opponent. However, once the opposition division had decided to revoke the patent, the burden shifted to the proprietor of the patent, who had to demonstrate on appeal that the reasons for revoking the patent were not sound, ie that the opposition division's decision was wrong as to the merits.

Questions relating to the shifting of the burden of proof can also arise in connection with procedural questions.

According to **T 128/87** (OJ 1989, 406) a party presenting a cheque to the EPO bears the burden of proof for its receipt by the EPO. If the EPO denies receiving a document, but the party furnishes proof that it was filed, according to **T 770/91** and **J 20/85** (OJ 1987, 102) the EPO carries the burden of proof for its allegation that it did not receive the document.

K. Representation

1. The list of professional representatives under Article 134(1) EPC

Art. 134(1) EPC stipulates that professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. The requirements for such entry are laid down in Art. 134(2) EPC.

Persons whose name appears on the list of professional representatives (Art. 134(1) EPC) and who have passed the European qualifying examination (Art. 134(2)(c) EPC) possess scientific or technical knowledge, because under Art. 10(1) REE 1994 (OJ 1994, 7) evidence of such knowledge is a condition for admission to the examination. Practically all persons entered on the list under the special provisions of Art. 163 EPC may also be assumed to possess such knowledge. The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters (**D 14/93**, OJ 1997, 561).

In **J 1/78** (OJ 1979, 285) the appellant was entered on the list of professional representatives before the EPO under the letter "V" as "von F., A.". The object of his appeal was to obtain a ruling which would enable him to be entered under the letter "F" as, for example, in the telephone directory. The decision found that the entry was made in accordance with the principles laid down by the President of the EPO whereby the full surname must be entered in alphabetical order. Under German law, former titles of nobility ("von") form part of the surname. The board noted that the purpose of entry on the list was to confer upon the person whose name was entered the right to appear in the European patent grant procedure. A distinction had to be made between entry for the purposes of conferring a right and publication of the list, which latter was not prescribed in the EPC. The EPO issues a directory from time to time for the purposes of meeting public demand for information. In this directory, the person entered on the list could be allowed an additional entry under another letter should he so desire.

2. Representation before the EPO of applicants not having residence or place of business within a contracting state

Art. 133(2) EPC stipulates that natural or legal persons not having either a contracting state residence or their principal place of business within the territory of one of the contracting states must be represented by a professional representative and act through him in all proceedings established by this Convention, other than in filing the European patent application (see **T 451/89** and **T 883/90**); the Implementing Regulations may permit other exceptions.

In **T 213/89** the Japanese inventor replied directly to the EPO with a set of revised application documents, and accompanied by a letter to his representative indicating that the revised documents had also been sent to the representative. The board noted that no confirmation by the representative was received that any of the submissions directly received from the inventor should be regarded as an official reply to the Office action. Since persons not having a residence or their principal place of business within the territory of one of the contracting states must act through their representative in the proceedings, the said submissions received direct could not be taken into account.

3. Professional representatives during the transitional period under Article 163(6) EPC

One of the conditions for including a professional representative on the EPO list is that he has passed the European qualifying examination (EQE). During a transitional period after the EPC first entered into force, this requirement could be waived under the conditions laid down in Art. 163 EPC (see **J 19/89** (OJ 1991, 425), **J 10/81**). For all states belonging to the EPC since the beginning, this period ended on 7.10.1981 (decision of the Administrative Council dated 6.7.1978, OJ 1978, 327). After that date, under Art. 163(6) EPC, a person with his place of business or employment in a state newly acceding to the EPC may, during a period of one year as from that state's accession, be added to the list under the conditions laid down in Art. 163(1) to (5) EPC, ie without having to pass the EQE.

The reunification of Germany posed its own problems, in **J 18/92, J 30/92, J 31/92, J 32/92** and **J 33/92**, regarding the admission of professional representatives. The appellants argued that the provisions of Art. 163(6) EPC should be applied to patent attorneys, even where they had qualified in West Germany and not the former GDR. In the board's view, Art. 163(6) EPC could only be applied by analogy to those finding themselves in a similar situation to the patent agents of a country acceding to the EPC. This requirement was fulfilled only by patent agents from the former GDR and not by their colleagues who had already been admitted in the West. The board held that it would be strange if those who were admitted as patent agents in a contracting state were able to become authorised representatives without having to pass the examination merely by way of analogy with people working in a country which had just become a member. The appeals were accordingly dismissed.

4. Legal practitioners entitled to act as professional representative under Article 134(7) EPC

4.1 Introduction

Under Art. 134(1) EPC, professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on the above list. However, Art. 134(7) EPC provides that professional representation in such proceedings may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the contracting states and having his place of business within such state, to the extent that he is entitled, within the said state, to act as a professional representative in patent matters. The arrangements for legal practitioners set out in Art. 134(7) EPC constituted therefore an exception.

In **J 19/89** (OJ 1991, 425) it was observed that despite all the differences in the designations and career backgrounds of the persons included in the ranks of legal practitioners, the profession had developed on an essentially equal footing in the contracting states as a result of Europe's common legal history and shared legal culture. The board noted that the last clause of Art. 134(7) EPC, first sentence, was necessary, because under national law even an actual legal practitioner might be precluded to some degree from acting as a professional representative in patent matters. That clause prevented a "Rechtsanwalt", "legal practitioner" or "avocat" from having more extensive powers of representation before the EPO than he was entitled to before his national patent office. Art. 134(7) EPC was therefore a special rule limited in scope to the corpus of legal practitioners, which existed under various designations in all the contracting states. Members of the profession of Rechtsanwalt and comparable professions in the contracting states were entitled under Art. 134(7) EPC to act as professional representatives before the EPO, not by virtue of their status as individual Rechtsanwälte but by virtue of the institution of the profession of Rechtsanwalt as such.

4.2 Register of legal practitioners

The register of legal practitioners must be clearly distinguished from the **list of professional representatives** established in accordance with Art. 134(1) to (4) EPC. Whereas according to Art. 134(4) EPC, the entry of a person's name in the list of professional representatives entitles them to act in **all** proceedings established by the EPC, the EPC does not contain any corresponding provision for legal practitioners. Their competence to undertake representation before the EPO is not general, but depends directly on their complying with the provisions of Art. 134(7) EPC (**J 27/95**).

The objective of the list of professional representatives is to provide a survey of particularly qualified representatives in patent matters; it would be jeopardised if legal practitioners without such qualifications were included on the list. Accordingly, the conditions for entry on the list of professional representatives under Art. 134(2) EPC also applied to legal practitioners (**D 14/93,** OJ 1997, 561).

According to the practice of the EPO, legal practitioners who indicate their intention to undertake representation in proceedings before the EPO and present an authorisation are entered in a register of legal practitioners, provided that they comply with the requirements of Art. 134(7) EPC. The Legal Division is responsible for checking these requirements and for the registration of names in, or deletion from, the register of legal practitioners (see decision of the President dated 10.3.1989 concerning the responsibilities of the Legal Division, point 1.1(c), OJ 1989, 177) (**J 27/95**).

4.3 Precise meaning of Article 134(7) EPC

In **J 19/89** (OJ 1991, 425), the Legal Board of Appeal considered whether a patent attorney under national law should, in view of his legal qualifications and entitlement to act as a professional representative in national patent matters, be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC and hence be authorised to act before the EPO. The board decided that irrespective of his specialist qualifications and powers of representation in national patent matters, a **patent attorney** under national law could not be regarded as a "legal practitioner" within the meaning of Art. 134(7) EPC, and therefore was not entitled to act as a professional representative before the EPO (see also **D 14/93** (OJ 1997, 561)).

In **J 27/95** the appellant, a Spanish citizen, requested to be recognised as a legal practitioner within the meaning of Art. 134(7) EPC and to be allowed to undertake professional representation in proceedings established by the EPC. According to the decision of the Legal Division, Art. 134(7) EPC only applied to legal practitioners entitled to act as representatives before their national patent offices by virtue of the exercise of the profession of legal practitioner "as such". However, according to the Legal Division, in Spain legal practitioners were not as such entitled to act as representatives in patent matters. In the statement of grounds filed by the appellant, it was contended inter alia that the wording of Art. 134(7) EPC did not contain any limitation to legal practitioner "as such". In Spain the registration as "Agente de la Propiedad Industrial" was a pure formality completed within one afternoon on production of evidence of the requisite university degree.

The Legal Board of Appeal first made it clear that the competence of legal practitioners to undertake representation before the EPO depended directly on their complying with the provisions of Art. 134(7) EPC. Thus, each time a legal practitioner made a request to act as a professional representative in proceedings before the EPO, the Legal Division had the right to examine whether he or she satisfied the conditions under Art. 134(7) EPC. If such a request was refused, it could be refiled and reconsidered on the basis of new facts at any time.

In its decision the board pointed out that according to Art. 134(7) EPC a legal practitioner qualified in a contracting state had to have "his place of business in such State". The board noted that in all three languages of the EPC the expression "his place of business" (in contrast to "a place of business") was used. The board stated that this formulation made it clear that the place of business within the meaning of Art. 134(7) EPC was the place (if any) at which a person practised his or her profession as legal practitioner. However, the only evidence before the board was the registration of an address in Spain which could not be accepted as proof of a place of business within the meaning of Art. 134(7) EPC. Therefore, in the absence of any evidence that the appellant had a place of business in Spain within the meaning of Art. 134(7) EPC, the board had to reject the appeal. In these circumstances it was neither necessary nor appropriate for the board to consider the further issues on which the decision of the department of first instance was based.

4.4 Limits to the entitlement of legal practitioners

In **D 14/93** (OJ 1997, 561) the Disciplinary Board of Appeal noted that persons whose name appeared on the list of professional representatives (Art 134(1) EPC) and had passed the European qualifying examination possessed scientific or technical knowledge, because under Art. 7(1)(a) REE 1991 (now Art. 10(1) REE 1994) evidence of such knowledge was a condition for admission to the examination. Legal practitioners on the other hand did not normally possess the scientific or technical knowledge required with a view to activities pertaining to European patent applications and patents. The board held that a legal practitioner did not have the same entitlement as a professional representative to train candidates under Art. 7(1)(b)(i) REE (now Art. 10(2)(a)(i) REE 1994). The training of candidates under Art. 7(1)(b) REE 1991 (now Art. 10(2) REE 1994) did not constitute "proceedings established by the EPC" within the meaning of Art. 134(7) EPC. The training period pursuant to Art. 7(1)(b) REE 1991 for enrolment for the European qualifying examination could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said legal practitioner was also a patent attorney under national law.

5. Procedural steps performed by a person other than the representative in charge

In **J 28/86** (OJ 1988, 85) the Legal Board of Appeal held that a request for examination filed by a person who was not entitled to act as a representative in accordance with Art. 134 EPC was invalid. The board noted that the situation did not change because the representative had later been entered on the list of professional representatives. In this capacity he had neither approved nor resubmitted the invalid request he had made earlier.

In **J 32/86** the board held that the mere appointment of a professional representative to meet the requirement of Art. 133(2) EPC (the appellant had his residence in the USA) did not automatically have the legal effect of validating acts previously performed by an applicant himself. The EPO was however obliged to give the representative a fair chance to remedy any deficiency of this kind that might have occurred before his appointment and which could still lawfully be remedied by him.

In decision **T 665/89** the board addressed the question of the admissibility of an opposition by an opponent whose residence was in a contracting state, where the notice of opposition was signed by a person who was neither a professional representative (Art. 134(1) EPC or Art. 134(7) EPC) nor an employee of the opponent (Art. 133(3) EPC). The board of appeal concluded that the actions of the unauthorised person ought to be judged as if the signature were missing, and thus assumed that the **deficiency** was remediable. The opponent made up for the missing correct signature at the EPO's invitation within the time limit laid down. The document thus retained the original date of receipt in accordance with R. 36(3) EPC, third sentence.

6. Authorisations for appointment of a representative

6.1 Filing of the authorisation

R. 101(4) EPC stipulates that if the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken (see **T 355/86**).

R. 101(4) EPC attaches particular importance to formal clarification of the legal relationship between the entitled person and the representative, especially as regards the applicant/representative situation. In **T 10/82** (OJ 1983, 407) the person who gave his name as opponent was a professional representative within the meaning of Art. 134 EPC. The board held that a professional representative, within the meaning of Art. 134 EPC, was not entitled to give his own name as opponent when acting for a client. Thus, the opposition was inadmissible.

In **J 12/88** it turned out that the former representative of the appellant had acted before the EPO on behalf of the appellant without being instructed to do so and using a forged authorisation. The board considered all these proceedings to be null and void. There had never been a valid European patent application before the EPO. All fees paid to the EPO on behalf of the appellant were never due and had to be reimbursed.

In **T 850/96** the appellant had alleged that the opposition was not admissible because the signatories of the notice of opposition did not file an authorization. According to him an employee must declare with the notice of opposition that he acts as a professional representative. Otherwise he must file an authorization.

In the case under consideration both signatories of the notice of opposition were professional representatives. The board held that Art.1(1) of the decision of the President of the EPO of 19 July 1991 (OJ 1991, 489) stipulates that a professional representative whose name appears on the list maintained by the European Patent Office **and who identifies himself as such** shall be required to file a signed authorization only in the circumstances set out in paragraph (2) and (3) of Art.1 of this decision of the President. In the present case, the deficiency had not been the lack of a signed authorisation, but the failure of the signatories of the notice of opposition to identify themselves as professional representatives.

In the case in point, the signatories of the notice of the opposition referred to their being professional representatives when the opposition division invited them to file an authorisation. The opposition division was satisfied with this reply. Contrary to the appellant's allegations no time limit was prescribed as to when such identification as professional representative must take place. Therefore, it could be done after the filing of the notice of opposition. Therefore, contrary to the appellant's allegations R. 101(4) EPC prescribing that if the authorization was not filed in due time the procedural steps taken by the representative be deemed not to have been taken, did not apply in the present case, with the consequence that the notice of opposition had to be considered duly filed.

6.2 Appointment of a common professional representative

In **J 35/92** the first-named of two individual joint applicants had transferred his rights in the application to a company, which had appointed another representative who had then purportedly withdrawn the application. The second applicant did not agree with the withdrawal. The department of first instance held that the company was entitled unilaterally to withdraw the application by virtue of R. 100(1) EPC, according to which the first-named applicant could be regarded as the representative of both, but the board of appeal disagreed. R. 100 EPC applied only where no joint professional representative had been appointed, whereas in the case in question the original applicants had appointed a representative, who continued to act for the second applicant. The board therefore concluded that the purported withdrawal of the application by the first-named applicant was invalid. The parties were given two months to appoint a joint professional representative, failing which one would be appointed by the EPO.

In **J 10/96** the Legal Board of Appeal ruled that where several applicants were represented jointly by a professional representative, who during the course of proceedings ceased to represent his clients, the correct procedure to be followed was that contained in R. 100(2) EPC, second sentence, according to which the applicants were to be requested by the EPO to appoint a common representative within two months. If this request was not complied with, the EPO was empowered to appoint the common representative.

6.3 General authorisations

In **J 11/93** under R. 69(2) EPC the applicant formally applied for a decision on the finding that his application was deemed to be withdrawn. He submitted in his statement of grounds of appeal that the official communication under R. 85a(1) EPC should have been sent to the authorised European representative since he had been duly empowered to act on behalf of the applicant by a general authorisation filed with the EPO in respect of another European patent application. Instead of this the communication was sent directly to the applicant, a US company.

The board observed that the usual form recommended for general powers had not been used and nothing in the document filed with the co-pending application allowed the Receiving Section to infer that the applicant intended said document to be regarded as a general power rather than a specific one. The board confirmed that the authorisation in suit had never been registered by the EPO as being a general one, and that even if it had been so registered it would then have been incumbent on the applicant to communicate the number allotted to the general authorisation so that the Receiving Section could take it into consideration before sending the communication pursuant to R. 85a(1) EPC to the applicant at its last known address, rather than to the representative. Under these circumstances the board considered that when the letter pursuant to R. 85a(1) EPC sent directly to the applicant was issued no European professional representative had yet been appointed by the applicant. Hence the provisions of R. 81 EPC, according to which - if a representative (ie a European one) had been appointed - notifications were to be addressed to him, could not apply but consequently only those of R. 78(2) EPC (version as in force up to 31.12.1998) relating to notifications in respect of addressees not having either a residence or place of business in one of the contracting states and who had not appointed an authorised representative.

In **J 17/98** the Legal Board of Appeal needed to rule on whether communications concerning the deemed withdrawal of applications had been correctly notified to the applicants, who were residents of a non-EPC contracting state, even though general authorisations were held by the EPO on their behalf. The applicants argued that the communications relating to deemed withdrawal should in fact have been notified to the representatives appearing in the general authorisations on file with the EPO. The Board held that the filing of a general authorisation to act on behalf of a specific applicant and the notification of the appointment of a representative in an individual application were two separate procedural acts. By definition, general authorisations did not refer to specific cases and did not allow the EPO to assume, without further information from the applicant, that a specific representative had been appointed in a particular case. From the Convention it was clear that the filing of a general authorisation did not imply the appointment of a professional representative in a specific case. In such clear cases directly following from the provisions of the Convention the principle of the protection of legitimate expectations did not require the EPO to issue comprehensive legal advice extending beyond the form in question, provided it was in itself clear and unambiguous.

6.4 Sub-authorisations

In **T 227/92** it was held that a sub-authorisation from a professional representative to a person who was not a professional representative within the meaning of Art. 134 EPC was invalid. The latter person's role was therefore limited to that of technical adviser to the professional representative.

6.5 Authorisation of an association of representatives

In **J 16/96** (OJ 1998, 347) the EPO Legal Division had informed a company X that its patents department could not be registered as an association of representatives. Such an association meant one consisting solely of professional representatives in private practice. This was clear from the "Communication on matters concerning representation before the EPO" (OJ 1979, 92). Since the members of a company's patent department were not in private practice, they could not be registered as an association. In its decision, the Legal Division explained that the interpretation of the term "association of representatives " was based on a 1978 decision by the Administrative Council of the EPO regarding the interpretation of R. 101(9) EPC.

The board examined whether such Council decisions were binding on the boards of appeal. It pointed out that under Art. 23(3) EPC board members were not bound by instructions and were required to comply only with the EPC. Neither in formal nor in practical terms, therefore, could a Council decision on the interpretation of an EPC rule be binding on them. For the purpose of interpreting R. 101(9) EPC, the Council's decision had to be set alongside the general rule of interpretation laid down in Art. 31(1) of the Vienna Convention on the Law of Treaties.

The board concluded that there was no basis in the EPC for the Office's practice of restricting R. 101(9) EPC to professional representatives "in private practice". An association within the meaning of that provision could therefore also be formed by professional representatives not in private practice. This interpretation of R. 101(9) EPC was consistent with the EPC's general aim, as stated in its preamble, of providing protection for inventions in the contracting states by a single procedure for the grant of patents. As noted when it was first introduced, R. 101(9) EPC was to be applicable in various countries, with differing national legal provisions and traditions, where representatives had often pooled their resources by forming some kind of association, such as a firm. This was why it had been reworded, and the original terms "partnership" and "Sozietät" replaced with more general ones: "association of representatives" and "Zusammenschluss von Vertretern". The French term "groupement de mandataires" had remained unchanged (see CI/GT VI/166d/77 of 20.4.1977). In view of this, there was no reason to interpret the term "association of representatives" in a way which limited its meaning.

7. Oral submissions by an accompanying person

7.1 General

In **J 11/94** (OJ 1995, 596), the Legal Board of Appeal referred the question to the Enlarged Board of Appeal of whether a board of appeal could exercise discretion in deciding whether or not a person not entitled under Art. 134(1) and (7) EPC to represent parties to proceedings before the EPO could make submissions during oral proceedings in addition to the pleadings by the professional representative, and if such discretion existed which criteria the board had to observe when exercising it.

The Enlarged Board of Appeal also had to decide on a question referred to in decision **T 803/93** (OJ 1996, 204). This question was whether, and if so in what circumstances, a person other than the professional representative (that is, an accompanying person) may make oral submissions on behalf of that party concerning either legal or technical issues, during oral proceedings under Art. 116 EPC before an opposition division or a board of appeal. This question went beyond the circumstances of **J 11/94**, which concerned ex parte proceedings involving only legal issues.

The Enlarged Board gave its answer in two decisions, **G 2/94** (OJ 1996, 401) referring to **J 11/94,** and **G 4/94** (OJ 1996, 412) occasioned by **T 803/93**.

In **G 4/95** (OJ 1996, 412) the Enlarged Board noted that the appointment of a professional representative by a party involved the authorisation and identification of the professionally qualified person who was responsible for the presentation to the EPO of all submissions made by the party. Such presentation of a party's case was the essential core of the function of a professional representative under Art. 133 EPC. During oral proceedings, a professional representative was expected to present the entire case of the party that he or she represented.

The Enlarged Board considered separately the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand.

As to the presentation of facts or evidence by an accompanying person, the Enlarged Board held that such oral submissions during oral proceedings - in addition to the complete presentation of the party's case by the professional representative - are not excluded under the EPC. They may be allowed under the overall discretionary control which the EPC gives to the EPO with respect to the filing of facts and evidence.

As to the question whether an accompanying person may make oral submissions during oral proceedings by way of argument, the Enlarged Board pointed out that Art. 133 EPC made no distinction between written and oral proceedings in connection with the requirements for representation. Thus a professional representative was responsible for all written and oral submissions made on behalf of the party who had appointed him. However, in the context of the **written procedure** provided under the EPC for oppositions and opposition appeals an appointed professional representative could submit additional documents signed by a third person (for example a professor of law or science). Provided that they were submitted under the responsibility and control of the professional representative, they did not have to be excluded from consideration in the proceedings in which they were filed. Similarly, during **oral proceedings** under Art. 116 EPC in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party was not excluded from making oral submissions in relation to either legal or technical issues on behalf of that party to the proceedings under the control of the professional representative, and in addition to the complete presentation of the party's case by the professional representative.

The Enlarged Board further held that such oral submissions could not be made as a matter of right, but only with the permission of and at the discretion of the EPO. It decided that, if during oral proceedings before either an opposition division or a board of appeal a party wished that, in addition to the complete presentation of its case by its professional representative, oral submissions should be made on its behalf by an accompanying person, the admissibility of such additional oral submissions was a matter for the discretion of the EPO, bearing in mind in particular the nature and timing of each individual request for the making of such additional oral submissions, and the intended subject-matter of such oral submissions. The following **criteria** should be considered by the EPO when exercising its discretion:

(i) the professional representative should request **permission** for such oral submissions to be made. The request should state the name and qualifications of the accompanying person and should specify the subject-matter of the proposed oral submissions.

(ii) The request should be made sufficiently in advance of the oral proceedings so that all opposing parties were able properly to prepare themselves in relation to the proposed oral submissions.

(iii) A request which was made shortly before or at the oral proceedings should, in the absence of exceptional circumstances, be refused unless each opposing party agreed to the making of the oral submissions requested.

(iv) The EPO should be satisfied that oral submissions by an accompanying person were made under the continuing responsibility and control of the professional representative.

In **G 2/94** (OJ 1996, 401) the Enlarged Board made clear that there was no difference as a matter of principle between the admissibility of such oral submissions in ex parte proceedings and in inter partes (opposition) proceedings, and that this matter had been fully considered in the context of opposition proceedings in decision **G 4/95** (OJ 1996, 412). The Enlarged Board noted that it was important that the board should control the proceedings. The board should exercise its discretion in accordance with the circumstances of each individual case. The main criterion to be considered was that the board should be fully informed of all relevant matters before deciding the case. The board should be satisfied that the oral submissions were made by the accompanying person under the continuing responsibility and control of the professional representative.

In **T 334/94** the board emphasised that for a legal or technical expert to be allowed to make submissions at oral proceedings on behalf of a party and under the control of that party's representative, certain criteria relating to Art. 113(1) EPC had to be fulfilled. **G 4/95** had ruled that the party wanting such submissions to be made had to ask permission sufficiently in advance of the oral proceedings to give the other parties time to prepare. Only in exceptional circumstances should the EPO allow such a request if made just before the date of the hearing, unless all the other parties agreed. The board noted that the Enlarged Board had not defined what "sufficiently in advance" meant, or laid down a deadline for making such requests. In its view, the **deadline of one month** before the proceedings for filing submissions or new sets of claims was a minimum. On that basis, nominating an accompanying expert one week before the proceedings was not acceptable.

In **T 621/98** the board was faced with the question during oral proceedings of whether the patent proprietor, who was professionally represented, needed to announce in advance his intention to make submissions during the proceedings, pursuant to **G 4/95** (OJ 1996, 412). The board ruled that the patent proprietor was a party to the proceedings and as such was not to be treated as an accompanying person. As a party to the proceedings he had a right to take part in them.

7.2 Oral submissions by former members of the boards of appeal

In **J 11/94** (OJ 1995, 596) the authorised representative was accompanied during oral proceedings by a former chairman of the Legal Board of Appeal who had retired about a year and a half previously. The professional representative requested permission for the former board member to make submissions in addition to his own arguments. The case referred to the Enlarged Board therefore encompassed the question whether special criteria applied to the exercise of a board's discretion in relation to a request for the making of additional oral submissions by a former board of appeal member.

The Enlarged Board noted in **G 2/94** (OJ 1996, 401) that there was a potential conflict between what might be seen as a right of former board of appeal members to seek subsequent employment on the basis of their special knowledge by making oral submissions during proceedings before the EPO, and the need for proceedings before the EPO to be conducted free from any suspicion of partiality. The existence of such a potential conflict was well recognised in the context of national judicial systems where it was clear that persons accepting appointments as judges were subject to restrictions if they wished to work in private legal practice after having served as judges. The existence of such restrictions reflected the generally recognised principle of law that parties to legal proceedings were entitled to a fair hearing before judges who could not reasonably be suspected of partiality. It concluded that the above potential conflict had to be resolved in the direction of avoiding any suspicion of partiality during the conduct of proceedings before the EPO. The public interest in the proper conduct of proceedings before the EPO had to prevail over the personal interests of former board of appeal members who wished to make oral submissions on behalf of parties to the proceedings.

It was therefore necessary to place **restrictions** on the admissibility of such oral submissions, at least for a reasonable period of time following termination of a person's appointment as a member of the board of appeal. In the absence of specific legislation, the point in time following termination of his or her appointment after which a former member of the boards of appeal might make oral submissions in proceedings before the board of appeal, was **a matter within the judicial discretion** of the boards of appeal. The Enlarged Board found that during either ex parte or inter partes proceedings, a board of appeal should refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, unless it was completely satisfied that **a sufficient period of time** had elapsed following termination of such former member's appointment to the boards of appeal, so that the board of appeal could not reasonably be suspected of partiality in deciding the case if it allowed such oral submissions to be made.

The board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least **three years** have elapsed following termination of the former member's appointment to the boards of appeal. After three years have elapsed, permission should be granted except in very special circumstances. Before the expiry of three years, there would normally be too great a risk that the public would consider the making of such submissions in oral proceedings to give an unfair advantage to the party on whose behalf a former member appeared.

7.3 Oral submissions by qualified patent lawyers of non-EPC contracting states

Another question of law decided in **G 4/95** above was whether, having regard in particular to the provisions of Art. 133 EPC and Art. 134 EPC, a person who was not qualified in accordance with Art. 134 EPC but was a qualified patent lawyer in a country which was not an EPC contracting state might present some or all of a party's case as if he were qualified under Art. 134 EPC. The Enlarged Board decided that no special criteria applied to the making of oral submissions by qualified patent lawyers of countries which were not contracting states to the EPC. The criteria set out above were equally applicable to such patent lawyers.

8. Distinction between presentation of facts and evidence and presentation of arguments

In **G 4/95** the Enlarged Board noted that the distinction between the presentation of facts and evidence, on the one hand, and the presentation of arguments, on the other hand, was of basic importance under the EPC. It noted, as discussed in decision **T 843/91** (OJ 1994, 818), a practice developed in the boards of appeal "to allow contributions by experts under the control of the authorised representative when it considers it would be useful for the good understanding of the case", thus mirroring the practice within the opposition division. In decision **T 843/91** it was suggested that the legal basis for admitting such oral submissions by "experts" was Art. 117 EPC. In this connection, the Enlarged Board did not accept that Art. 117 EPC provided a legal basis for hearing oral submissions by an accompanying person involving the presentation of facts and evidence, as was suggested in decision **T 843/91** for example. Art. 117 EPC and its Implementing Rules, R. 72 to 76 EPC, are solely concerned with setting out the procedure relevant to formal "taking of evidence". Such procedure necessarily involved as a precondition for its use the making of a decision to take evidence in the sense of Art. 117 EPC, and such decision had to set out all the matters prescribed in R. 72(1) EPC, as the first stage in the procedure.

L. Decisions of EPO departments

1. Right to a decision

Pursuant to R. 69(1) EPC, the EPO, if it notes that the loss of any rights results from the EPC, must communicate this to the party concerned. If the party disagrees with the finding of the EPO it may apply for a decision on the matter by the EPO (R. 69(2) EPC) or it may request further processing or re-establishment of rights, as the case may be (**J 14/94**, OJ 1995, 824).

The right to a decision after notification of loss of rights is a substantial procedural right which cannot be ignored by the EPO. A party who applies for a decision under R. 69(2) EPC is entitled to receive one. If the correctness of a notification of loss of rights under R. 69(1) EPC is challenged, the EPO has a duty to reply within a **reasonable period of time** having regard to the subject-matter of the communication (see **J 29/86,** OJ 1988, 84; **J 34/92**).

In **J 7/92** the board stated that although it would be preferable for the EPO to issue a communication under R. 69(1) EPC quickly, it could not be blamed for having done so in the present case over seven months after expiry of the period of grace. The EPC did not provide that the EPO should note the loss of rights mentioned in R. 69(1) EPC within a certain period. Nor did it provide any period of time for the ensuing communication. The EPO could not be required to keep a permanent and close eye on every file so as always to act as quickly as possible in order to preserve all the applicant's rights. However, when the EPO had to handle incoming requests or documents containing clear deficiencies which were obviously easy to correct and could be expected to be remedied within the time limit to avoid a loss of rights, then the question might arise whether - depending on the case - the principles of good faith governing the relations between the parties and the EPO did not demand that the EPO should not fail to draw attention to such deficiencies (see chapter on "The principle of the protection of legitimate expectations", p. 251).

In **J 43/92** the board noted that a decision pursuant to R. 69(2) EPC could only validly be applied for in the circumstances defined in R. 69(1) EPC. Thus, it was a necessary condition for such an application that the EPO previously noted the loss of a right resulting from the EPC without any decision and communicated this to the party concerned. Otherwise, there was no basis for the EPO to give a decision pursuant to R. 69(2) EPC. The Board further noted that R. 69(1) EPC did not prescribe any particular form for the communications provided therein distinguishing them from other communications or notifications under the EPC. Even if, according to the Legal Advice No. 16/85, OJ 1985, 141, communications in which the EPO noted the loss of any right normally contained a reference to the time limit for an application for a decision on the matter under R. 69(2) EPC, such reference did not appear to be necessarily decisive as to the true nature of the communication. Whether a document constituted a communication pursuant to R. 69(1) EPC should be derived from its substantive content and its context (as to the form for such communications, see below under "Form of decisions").

2. Composition of examining divisions

In **T 714/92** the board could not find any indication in the part of the file open to public inspection that the primary examiner had already signed the impugned decision before the date on which he left the examining division. The board held that to take a decision on a date on which the examining division no longer existed in its stated composition, without the examining division ensuring that it be apparent from the part of the file open to public inspection that the member who left the examining division had agreed the text of the decision before leaving, had to be considered as a substantial procedural violation. Thus the impugned decision was set aside as void ab initio and without legal effect.

3. Composition of opposition divisions

Art. 19(2) EPC stipulates that an opposition division must consist of three technical examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates.

In **T 390/86** (OJ 1989, 30) oral proceedings had taken place in the presence of three examiners appointed to form the opposition division. The Chairman had announced its decision during the oral proceedings in the presence of the other two examiners. Although the decision had subsequently been duly reasoned in writing, it had been signed by three members other than those before whom the oral proceedings had taken place. The board considered whether the decision of the opposition division was valid having regard to the circumstances. The board held that it was quite clear from Art. 19(1)(2) EPC that an opposition in respect of a European patent was in all cases to be conducted and decided by three technical examiners appointed on a personal basis in respect of a particular opposition (in some cases an additional legal examiner might also be appointed), and that oral proceedings had to be before the three technical examiners personally appointed to form the opposition division. Further, the reference to voting in the final sentence of Art. 19(2) EPC made it clear that an opposition should be decided on the basis of the personal votes of the individual examiners appointed to constitute a particular opposition division. It was thus clear from Art. 19 EPC that the power to examine and decide an opposition pursuant to Art. 101 EPC and Art. 102 EPC had at all times to be exercised personally by the examiners appointed to do so. In accordance with the well-known principle "delegatus non potest delegare", the power of a department of the EPO such as an opposition division to issue a decision had not only to be exercised personally but also to be seen, both by the parties and by the public, to be exercised personally. Similarly, where a decision was issued in writing setting out reasons for an oral decision, the parties and the public should be able to see from the written decision that it had been taken by the examiners appointed to the particular opposition division responsible for that oral decision. It was of course possible that not all the appointed members were able to sign a written decision (for example through illness). However, in the board's view, if the decision of a particular division was to be legally valid, it had to have been written on behalf of and represent the views of the members who were appointed to that division to decide the issue or issues which were the subject of the decision, and it had to bear signatures which indicated this. As a result, the written reasons for a decision delivered during oral proceedings could only be signed by the members of the deciding body who took part in the oral proceedings. The board therefore held that if, in a case where a final substantive decision had been given orally by an opposition division during oral proceedings, the subsequent written decision giving the reasons for that oral substantive decision was signed by persons who did not constitute the opposition division during the oral proceedings, the decision was null and void.

It was further held that since the oral proceedings had taken place more than two years before and the (invalid) written decision had been given more than one year before (almost one year after the oral decision), the requirements of R. 68(1) EPC could no longer be properly complied with, and the substantive decision was therefore incurably void. The opposition had therefore to be re-examined.

In its decision **T 243/87** the board of appeal developed further the principles established in decision **T 390/86** (see above). The board held that even though only one member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the reasoned decision signed subsequently accurately reflected the point of view of all three members who had taken part in the oral proceedings, or even of the majority of the opposition division. In the board's view, the exceptional situation in which one of the appointed members was incapacitated (for example through illness) was quite different. In such cases it was right to accept that, although the reasoned written decision should be signed only by the members of the division who actually took part in the oral proceedings, one of them could sign on behalf of the member unable to do so. It was of course advisable to check that the reasoned written decision represented the point of view of all the members who took part in the oral proceedings.

In **T 251/88** the composition of an opposition division was held to be contrary to Art. 19(2) EPC, because two of the three members had taken part in the proceedings for grant of the patent to which the opposition related. The board of appeal ordered that the decision of the opposition division be set aside and the case be remitted for fresh examination by an opposition division with a different composition (see also **T 382/92**).

In **T 939/91** the chairman of the opposition division had participated as second examiner in the decision to grant the patent in suit, as was clear from EPO Form 2035.4. The board of appeal decided that the opposition division had therefore violated the provisions of Art. 19(2) EPC and that the decision delivered had to be annulled on the grounds that the department delivering it had not been competent to do so. The board felt it fair to order reimbursement of the appeal fee, given that violation of the provisions of Art. 19(2) EPC had to be considered as a substantial procedural violation.

In **T 476/95** the chairman of the opposition division had, at an earlier stage of the grant proceedings, written and signed a negative communication which preceded the decision of the examining division to refuse the application. In the board's opinion, Art. 19(2) EPC, first and second sentences, referred to the participation of members of the opposition division at every stage of the grant proceedings, not only to their involvement in the final decision. The primary examiner in the opposition proceedings had also been a signatory to the decision refusing the application after examination. A breach of Art. 19(2) EPC was considered to have occurred if both the primary examiner and the chairman of the opposition division had taken part in the grant proceedings.

In **T 960/94** the board held that to comply with R. 68(1) EPC, second sentence and R. 68(2) EPC a written reasoned decision confirming the orally announced decision was required. Such a written reasoned decision must be issued on behalf of the very same members of the opposition division who were present at the oral proceedings, as the task of giving a written reasoned decision is personal to those members of the opposition division present at the oral proceedings and cannot be delegated to a differently composed opposition division, even if two of the members remain the same (following **T 390/86**, OJ 1989, 30). As no confirmatory written decision had been issued in the names of the members present at the oral proceedings, the decision given orally was void and had to be set aside.

4. Suspected partiality

In **G 5/91** (OJ 1992, 617), the Enlarged Board of Appeal commented on the suspected partiality of a member of an opposition division. In the case which had led to the referral, **T 261/88** (OJ 1992, 627), the primary examiner was a former employee of the opponent and had represented that company many times in examination and opposition proceedings before the EPO. The Enlarged Board observed that although the questions referred to it were directly related only to proceedings before an opposition division, the problems involved were of a general character and also had a bearing on the activities of the other EPO departments of first instance charged with the procedure, eg the examining divisions (see Art. 15 EPC).

The Enlarged Board stated that it must be considered as a general principle of law that **nobody should decide** a case in respect of which a party may have good reasons to assume partiality. The basic requirement of impartiality therefore also applied to employees of the EPO departments of first instance engaged in decision-making activities affecting the rights of any party. Although the provisions of Art. 24 EPC on exclusion and objection only applied to members of the boards of appeal and the Enlarged Board of Appeal and not to employees of the EPO departments of first instance, including opposition divisions, this did not justify the conclusion that such employees were exempt from the requirement of impartiality. Furthermore, although Art. 24 EPC was only applicable to appeal proceedings, it seemed justified to apply the principles underlying the provisions of Art. 24(3) EPC, second and third sentences, to an objection on the ground of suspected partiality before a department of first instance. Such an objection could thus be disregarded if it was not raised immediately **after** the party concerned became aware of the reason for the objection or if it was based on nationality. Finally, the Enlarged Board found that the question whether or not an objection to a member of an opposition division on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case. Such considerations involved factual questions of degree rather than points of law and were therefore not a matter for the Enlarged Board of Appeal to decide.

In **T 433/93** (OJ 1997, 509) following a substantial procedural violation in connection with a decision issued by a first-instance department, the decision was set aside at the request of a party, and the case was remitted to the department of first instance for re-hearing. Following such remittal, the board found it necessary for the case to be examined and decided by a different composition of opposition division (that is, by a composition of three new members), in relation to the grounds of opposition raised and introduced into the proceedings. The board considered that if the case was to be heard further and re-decided by the same composition of opposition division, the members of the opposition division would have to attempt to put out of their minds the result of their previous decision before re-hearing and re-deciding the case.

The board held that the important point was not whether the file record showed any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see **T 261/88**, 16.2.1993), or whether the present members of the opposition division would in fact be unprejudiced or impartial if they re-heard the case, but **whether a party would have reasonable ground** to suspect that they would not receive a fair hearing if the case was re-heard before the same composition of opposition division (whether because of possible prejudice as to how the case should be decided, or because of possible partiality, or otherwise).

In **T 261/88** of 16.2.1993 the board held that disqualifying partiality presumed a preconceived attitude on the part of a deciding person (in this case the first examiner) towards a party (in this case the patentee) of the case. The fact that the views held on the issues of the case by the examiner differed from those held by the party was itself not disqualifying. The board noted that disqualifying partiality was limited to situations where the opinion of a person responsible for taking decisions affecting the right of parties (eg a judge) was swayed by his attitude towards a party. The board examined whether the reasoning underlying the decision under appeal showed such major deficiencies that there was reason to believe that the primary examiner was, either deliberately or inadvertently, trying to "bend" the facts of the case, and that this was done because of a preconceived attitude towards one of the parties. The board could not find anything basically or conspicuously wrong with the analysis of the technical questions. The content of the file did not go beyond the framework of a normal discussion between the EPO and an applicant, and there was nothing manifestly unreasonable to be found in the reasoning, so that disqualifying partiality could not be concluded.

In **T 843/91** (OJ 1994, 818), a newly appointed board had to consider whether the three members of the board of appeal originally appointed could be suspected of partiality. The board agreed with the view held in decision **T 261/88** (see above) that disqualifying partiality presumed a preconceived attitude towards a party on the part of a person in a decision-making capacity. More precisely, partiality would be knowingly to favour one party by granting it rights to which it was not entitled, or by intentionally disregarding the rights of the other party. The board referred to **G 5/91** (OJ 1992, 617) which stated that the question whether or not an objection to members on the ground of suspected partiality was to be considered justified could only be decided in the light of the particular circumstances of each individual case.

In **T 143/91** the board held that a member of an opposition division was biased if it could be shown that he had a personal **interest** within the meaning of Art. 24(1) EPC. The mere fact that the member was previously employed by a company dependent on a party to the opposition proceedings was not, however, sufficient proof of such an interest.

In **T 951/91** (OJ 1995, 202, edited version, Reasons Nr. 14 not published) objections under Art. 24 EPC and Art. 19(2) EPC were raised by the appellant in the statement of grounds of appeal suggesting that the opposition division had been biased in its attitude to the parties. In reaching its decision on this point, the board observed that nothing in the minutes of the oral proceedings, which the appellant had not criticised, led to the conclusion that the arguments had not been duly considered by the opposition division or that the latter was suspected of bias during those proceedings. The board examined the reasons set out in the appealed decision and observed that the decision itself did not reveal any bias.

In **T 241/98** dated 22.3.1999 a party to the appeal proceedings raised an objection under Art. 24(3) EPC to a member of the board on the basis of suspected partiality. As the objection was formally admissible the board held oral proceedings on the substantive issue of partiality, excluding the member objected to and including his alternate. As the board was unable to establish any objective basis for a suspicion of partiality, the exclusion of the original member was lifted and the appeal was continued before the board in its original composition. The appellant had relied on decision **T 253/95** in which the board had held that alerting a party to an argument against him in advance of oral proceedings amounted to a clear violation of the principle of impartiality. Such a statement, taken out of its context, namely an overriding need for a board to act impartially, contravened the established practice of the boards of appeal under Art. 110(2) EPC and Art. 12 RPBA, according to which a preliminary appreciation of substantive or legal matters could always be communicated, if expedient, in a non-binding form to the parties.

In **T 1028/96** dated 15.9.1999 the board had to consider the correct procedure where an objection of partiality was raised against board members. The board ruled that a preliminary examination for admissibility under Art. 24(3) EPC was incumbent on the original board, following which the procedure under Art. 24(4) EPC might need to be followed if the objection was admissible. An objection by a party that a member of the board had previously "participated in the decision under appeal" (Art. 24 (1) EPC) only covered decisions of the examining and opposition divisions and not decisions of the boards of appeal arising from those decisions. An objection under Art. 24(3) EPC based on "suspected partiality" could give rise to exclusion of board members originally appointed in circumstances where substantially the same crucial facts were at issue in opposition appeal proceedings as had previously been at issue in grant appeal proceedings "in the light of the particular circumstances of each individual case".

According to **T 954/98** of 9.12.1999, the rules for exclusion from a board for partiality should be interpreted not only in the light of the principle of judicial impartiality, but also the principle of "gesetzlicher Richter" (ie according to the principle of "the duly designated judge"); such that firstly a member whose impartiality was suspect should not handle a case, but secondly that parties should not be able to change the composition of boards at will for no objective reason.

Purely subjective impressions or vague suspicions were not enough to disqualify a member. The member's behaviour or situation had to provide objective justification for a party's fears. The mere fact of taking discretionary procedural steps which might disadvantage a particular party was not enough to justify exclusion, not even if the party concerned interpreted those steps as expressing bias against it.

5. Date of decision

5.1 Entry into force of decisions

The Enlarged Board of Appeal has held that it is necessary to distinguish between decisions taken after the closure of the debate in oral proceedings and decisions taken following written proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of that point in time in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it. A decision may only be revoked by the department that issued it by way of an interlocutory revision under Art. 109 EPC if one of the parties has filed an admissible and well-founded appeal (**G 12/91**, OJ 1994, 285).

5.2 Completion of the internal decision-making process

In **T 586/88** (OJ 1993, 313) the board referred the following point of law to the Enlarged Board of Appeal: "If the decision of an examining or opposition division is pronounced not at the end of oral proceedings but following written proceedings or proceedings continued in writing after oral proceedings, at what point is the internal decision-making process within that department of the EPO completed?".

In **G 12/91** (OJ 1994, 285) the Enlarged Board of Appeal stated that the point of law referred was of vital importance to the general question of determining the final point at which a first-instance department of the EPO could still take account of further submissions by the parties. The Enlarged Board noted that the point in time at which a decision entered into force, ie the moment it was pronounced or notified, was not the last moment at which parties could still submit observations. This had to be done **at an earlier point** in the proceedings to allow the decision-making department time to deliberate and then issue its decision based on the parties' submissions.

As far as oral proceedings were concerned, established board of appeal case law had this point in time as the time of closure of the debate, which was fixed by the decision-making department - having first heard the parties' submissions - to allow itself time to consider its decision. Once the debate had been closed, further submissions by the parties had to be disregarded unless the decision-making department allowed the parties to present comments within a fixed time limit or decided to reopen oral proceedings for further substantive debate on the issues.

In the case of decisions taken following written proceedings, the final moment at which fresh matter submitted by the parties could still be taken into account had to correspond to the time of closure of the debate during oral proceedings. The need to ensure legal certainty required that this moment be as clearly fixed as the moment when the debate was closed during oral proceedings. Neither the EPC nor its Implementing Regulations contained any provision fixing that moment.

The Enlarged Board pointed out that the date on which the three members of an examining or opposition division signed a decision was extremely important, as the date indicated was the date on which the division decided whether a patent application had to be refused, an opposition rejected or a patent granted or revoked. However, it was also a decision taken "in camera", because at the moment it was taken it did not have any immediate effect on the parties involved and was **not** therefore **binding** on the decision-making department that issued it. If, after it had signed it, the department discovered that it had failed to take account of a key point, it could amend its decision, despite having already signed it, because it had not yet left its custody.

Having weighed up the various arguments, the Enlarged Board of Appeal reached the conclusion that the point in time at which the internal decision-making process was completed was the date on which the formalities section handed over the date-stamped, post-dated decision to the EPO postal service. This was a date the parties could ascertain very easily, because, as the President of the EPO had explained, it was always three days prior to the date stamped. Internal EPO instructions made clear that a period of three days always elapsed between the date-stamping of a decision and its despatch. If, for whatever reason, the EPO postal service was unable to despatch the decision on the date stamped, it returned the decision to the formalities section where it was given a new date, which again pre-dated the date of actual despatch by three days. This practice ensured that the date of despatch was always stamped on the decision three days before it was actually despatched. This date was therefore very easy to ascertain, both for the EPO and the parties. It thus fulfilled the need for strict legal certainty which the handing down of a decision had to ensure.

When a decision is handed over by the formalities section to the EPO postal service for notification, it is taken from the file and is therefore removed from the power of the department that issued it. This moment marks the completion of proceedings before the decision-making department. Once proceedings have been completed the decision-making department can no longer amend its decision. It must disregard any fresh matter the parties may submit to the EPO thereafter. Seeing that it is important for the parties to know at which point in time the decision-making process following written proceedings is completed, this point in time should be clearly indicated in the decision. The formalities section should also keep a register of the dates on which decisions are handed over to the EPO postal service to enable those dates to be ascertained at any time (see also **T 631/94**, OJ 1996, 67).

In **T 798/95** the decision to grant a European patent was handed over to the EPO postal service for notification on 25.8.1995 during the official working time of the EPO. On 25.8.1995, at 6.47 pm, the appellant filed a request by telefax for amendment of the application under R. 86(3) EPC. The board held that a request for amendment filed after the completion of the proceedings up to grant before an examining division was to be disregarded even if the filing of the request and the completion of the proceedings occurred on the same date. The board noted that the proceedings before the examining division were completed not later than at the end of the official working time on that date. Thereafter, the examining division could no longer amend its decision, as it was not competent to consider the request. The appellant's submissions that the examining division had been responsible for the application all day on Friday, 25.8.1995 and that it was possible to amend the application until issue of the decision were therefore not correct.

6. Form of decisions

6.1 General issues

In **T 390/86** (OJ 1989, 30) the board stated that when a substantive decision is given orally during oral proceedings it must be formally notified to the parties in writing (R. 68(1) EPC) and formally completed by giving reasons for the decision in writing (R. 68(2) EPC). In the board's judgment, it was clear from R. 68 EPC and Art. 108 EPC that until a substantive oral decision was formally completed in writing and notified to the parties, the two-month period within which a notice of appeal had to be filed did not begin.

In **J 8/81** (OJ 1982, 10) the board stated that in accordance with the normal practice of the EPO, the contents of the communication ought to have been identified as a decision, so as to preserve the clear distinction made in the Convention and Implementing Regulations between decisions and communications; see eg R. 68 EPC and Art. 70 EPC. The letter ought also to have drawn attention to the possibility of appeal and the provisions of Art. 106 EPC to Art. 108 EPC, in conformity with R. 68(2) EPC. The fact that the requirements of R. 68(2) EPC were not fully complied with did not, however, mean that the letter was merely a communication. Whether a document issued by the EPO constituted a decision or a communication depended on the substance of its **contents**, not on its **form** (**J 43/92, T 222/85,** OJ 1988, 128).

In **T 42/84** (OJ 1988, 251) the board held that the alleged failure of the EPO to enclose the text of Art. 106 EPC to Art. 108 EPC with the decision neither invalidated the decision nor did it constitute a substantive procedural violation. R. 68 EPC stated that the written communication of the possibility of appeal had to draw the attention of the parties to the provisions laid down in Art. 106 EPC to Art. 108 EPC, the text of which should be attached. However, it also stated that the parties could not invoke the omission of that communication. This had, in the board's view, to be read as applying also to the omission of the text of the articles alone.

In **T 222/85** (OJ 1988, 128) the board noted that the contents of a "communication" never constituted a "decision". This distinction was important, because only a "decision" could be the subject of an appeal - see Art. 106(1) EPC. In the case at issue the communication only represented a preliminary view, on an ex parte basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" were always final and binding in relation to the department of the EPO which issued it, and could only be challenged by way of appeal.

In **J 20/99** the board noted in its decision that all EPO departments should, if quoting a decision of the boards of appeal or any other legal authority, identify that authority and place the cited passage(s) in quotation marks. It found that the examining division had raised in its communication some objections having in mind the reasons of a decision of a board of appeal that were repeated verbatim without any quotation marks or attribution. The board had observed that the situation then was completely different from that which the examining division had in mind.

6.2 Inconsistency between oral and written decisions

In **T 666/90** the opposition division had indicated during oral proceedings that it would maintain the European patent as amended if new documents conforming to the version of the claims it had said it would allow were submitted. Although such a set of claims had not yet been formally submitted in writing by the applicants' representative during oral proceedings, the representative had given an undertaking to do so later and had done so by the deadline set. The written decision had revoked the patent however. The board held that this inconsistency between the oral and written decisions was in breach of R. 68(1) EPC and was hence a substantial procedural violation.

In **T 425/97** an appellant submitted as unique ground of appeal the inconsistency existing between the written decision and the form of the patent held as patentable by the opposition division at the oral proceedings. The board held that, any substantive deviation, as in the present case, of the decision notified in writing from the decision taken at the oral proceedings and given orally amounts to a procedural violation.

6.3 Reasons for the decision

6.3.1 Reason for main and auxiliary requests

Under R. 68(2) EPC, decisions of the EPO which are open to appeal must be reasoned. According to the established jurisprudence of the boards of appeal, a reasoned decision must be given **for each** of the different requests (main and auxiliary requests). Although in exceptional circumstances a reference in the reasons for a decision to grounds given in preceding communications may be allowed, it must be quite clear from those grounds which considerations played a crucial role for the division responsible when it took its decision (**T 234/86**, OJ 1989, 79). It must be ensured that, before issuing a decision revoking the patent solely on the basis of the patent proprietor's main request, the proprietor has expressly withdrawn all subordinate requests (see **T 81/93**, **T 5/89**, OJ 1992, 348, section 2.2). If the patentee files one or more auxiliary requests in addition to a main request and does not withdraw any of them, an opposition division is obliged in its decision to give reasons why each successive request is either not admissible (in the exercise of its discretion under R. 57(1) EPC and R. 58(2) EPC) (**T 155/88**; **T 406/86**, OJ 1989, 302; **T 951/97**, OJ 1998, 440) or not allowable on substantive grounds. If an opposition division allows an auxiliary request without giving reasons in its decision as to why the main request or preceding auxiliary requests are not allowable, that decision should be set aside as void and without legal effect, and the appeal fee refunded on the basis of a substantial procedural violation (see **T 484/88**).

6.3.2 Compliance with the requirements of Rule 68(2) EPC

In **T 856/91**, the contested decision referred to the knowledge of prominent skilled persons and cited "a statement by a well-known expert" but contained no information enabling the reader to infer who these persons were or exactly what they had said. The board took the view that this incomplete information did not constitute a breach of R. 68(2) EPC, since it was sufficient for a decision to be reasoned in some way, even if the reasoning was incomplete and deficient.

In **T 647/93** (OJ 1995, 132) the appellants had lodged an appeal against the decision of the examining division to refuse the application and claimed that the latter had committed substantial procedural violations in that, inter alia, it had not followed the procedure set out in the Guidelines, or provided a written reasoned decision as required by R. 68(2) EPC. The board observed that the reasons for the refusal were somewhat enigmatic, and that there was no basis for them in the EPC. However, the board held that even if the reasons for the decision were not well founded, this did not mean that the decision was not reasoned at all within the meaning of R. 68(2) EPC.

6.3.3 Non-compliance with the requirements of Rule 68(2) EPC

In **T 493/88** (OJ 1991, 380) the board held that a decision of an opposition division rejecting an opposition had not been correctly reasoned within the meaning of R. 68(2) EPC, first sentence, if, after giving the reasons why the opposition division, unlike the opponent, considered the subject-matter of the patent to be new, it failed to state the reasons why it considered that the subject-matter also involved an inventive step.

In **T 292/90** regarding inventive step, the examining division had merely said that the claimed process amounted to an obvious juxtaposition of the teachings of documents 2, 3 and 4. There was no explanation of how the examining division had arrived at this conclusion. The board considered this form of reasoning to be insufficient. The reasoning given in a decision open to appeal had to enable the appellants and the board of appeal to examine whether the decision was justified or not. A decision on inventive step therefore had to contain the logical chain of reasoning which had led to the relevant conclusion (see also **T 52/90**).

In **T 153/89** the examining division had given no reasons for finding in its decision that the subject-matter of the dependent claims was not inventive. The board of appeal took the view that the perfunctory statement in the contested decision did not permit the board to judge whether this issue had been sufficiently investigated, or investigated at all. The examining division's decision on such grounds did not amount to a reasoned decision.

In **T 740/93** the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division), with the order for further prosecution by a correctly composed opposition division. The new opposition division rendered a decision which was nearly identical to the first one. The board held that, in accordance with R. 68(2) EPC, decisions of the EPO which were open to appeal had to be reasoned. In this respect the board accepted that reasoning did not mean that all the arguments submitted should be dealt with in detail, but it was a general principle of good faith and fair proceedings that reasoned decisions should contain, in addition to the logical chain of facts and reasons on which every decision was based, at least some motivation on crucial points of dispute in this line of argumentation, in so far as this was not immediately apparent from the reasons given, in order to give the party concerned a fair idea of why his submissions were not considered convincing. Although the decision under appeal contained a reasoning as to why the subject-matter of the patent in suit was considered to lack an inventive step and indeed contained references to points of dispute raised in the proceedings up to the first decision, it did not contain any direct reference to the important issues of dispute raised by the appellant in its appeal against the first decision. Since the second decision was nearly identical to the first one, it did not meet the requirements of R. 68(2) EPC, in that it was not sufficiently reasoned, which failure amounted to a substantial procedural violation.

In **T 227/95** the appellants submitted that the decision of the opposition division to maintain the patent in amended form was not reasoned within the meaning of R. 68(2) EPC. In its decision, the board agreed with this view. The decision contained no reasons on the merits of the case. Instead, it merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (**T 527/92**). However, decision **T 527/92** contained no such reasons, since the case was remitted to the opposition division for further prosecution. The board in that case decided only that the patent could not be maintained in accordance with the patentees' (then) main request. The examination of the auxiliary request was left entirely to the department of first instance.

In **T 698/94** the board noted that neither the minutes of the oral proceedings before the opposition division nor the "Summary of Facts and Submissions" of the appealed decision itself contained the slightest hint at the arguments brought forward by the parties. It was impossible for the parties to the proceedings to see how the opposition division had arrived at its conclusion of lack of novelty. As a result, the losing party was deprived of its legitimate right to challenge the reasoning on which the decision was based, which was the very purpose of proceedings before the boards of appeal (see the decision of the Enlarged Board in **G 9/91**, OJ 1993, 408, paragraph 18). The board explained that the requirement of R. 68(2) EPC for decisions to be "reasoned" meant that the decision had expressly to set out the logical chain of argument upon which the conclusion and therefore the final verdict were based, in respect of each and every ground that had been pleaded and substantiated. The de facto absence of reasoning in the decision under appeal represented a substantial procedural violation.

In **T 135/96** the opposition division had completely ignored two documents as well as some lines of argument developed by the appellants/opponents in support of their allegation that the claimed subject-matter lacked an inventive step. The board held that the failure to consider these documents and arguments, which were relevant to the ground of lack of inventive step on which the decision under appeal was based, constituted a violation of the right to be heard and thus a substantial procedural violation as well as a fundamental deficiency in the first-instance proceedings. Moreover, the decision under appeal was not in conformity with R. 68(2) EPC, since it gave no reason why the subject-matter of the independent claims was considered to involve an inventive step in respect also of the two additional lines of argument developed by the opponents.

In **T 652/97** the board held that the principle enshrined in R. 68(2) EPC ensured a fair procedure between the EPO and parties to proceedings, and the EPO could only properly issue a decision against a party if the grounds on which it was based had been adequately reasoned. The decision had not provided the opponent with any reasoning concerning its main argument, which conflicted with the requirements of R. 68(2) EPC and constituted a substantial procedural violation.

In **T 615/95** in an annex to its decision, the examining division considered that an interlocutory revision could only be possible on condition that several objections were overcome. These objections were unrelated to the grounds of refusal and had clearly no link at all to the decision under appeal. The board held that an examining division's decision should not be supplemented normally by annexes dealing with issues having no relation to the issues dealt with in the reasons for this decision.

In **T 473/98** (OJ 2001, 231) the board held that it is entirely appropriate and desirable in the interests of overall procedural efficiency and effectiveness that an opposition division should include in the reasons for a revocation decision pursuant to Art. 102(1) EPC employing the standard decision formula, by way of obiter dicta, findings which could obviate remittal in the event of the revocation being reversed on appeal.

See Chapter on Reimbursement of appeal fees (Appeal Procedure) on inadequate reasons given in the decision at first instance, and the circumstances in which reimbursement of the appeal fee is justified.

6.4 Signatures on a decision

In **T 390/86** (OJ 1989, 30) the board noted that although R. 70 EPC states that "any communication from the EPO is to be signed by and to state the name of the employee responsible", there was nothing in R. 68 EPC or elsewhere in the EPC which specifically required the decision of a first-instance department of the EPO (ie a decision which was open to appeal) to be signed by the employee or employees responsible. The board, however, having regard to the principles which were applicable, came to the conclusion that if the decision of a particular division was to be legally valid it had to bear the signatures of the members who had been appointed to that division to decide the issue or issues which were the subject of the decision.

In **T 243/87** the decision was substantiated and issued in writing after oral proceedings. The decision was signed by two members who had taken part in the oral proceedings and by one who had not. The board ruled that the latter signature rendered the decision null and void. It ordered remittal to the department of first instance, and a refund of the appeal fee because a substantial procedural violation had occurred.

In **T 777/97** the appellant had requested correction of the description before the opposition division. The first examiner had signed the correction decision also on behalf of the division's absent chairman. The board ruled that the decision was valid.

In **T 999/93** the board held that if a decision of a particular division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that division to decide the issues forming the subject of the decision, and it must bear signatures which indicates this.

In **D 8/82** (OJ 1983, 378) the board had to decide whether a signature was valid, where the surname appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. The board held that the signature was valid since in several Contracting States of the EPO there is no requirement that a signature be legible or recognisably composed of letters. It is enough that it serves to identify the signatory.

In **T 225/96**, the file showed that the contested decision had been signed by only the first examiner on the opposition division, and not by its chairman, second examiner and legal member. The board sent the case back for regularisation. The division however replied that the three non-signing members were not at this stage of the proceedings prepared to put their names to a text issued without their knowledge or approval.

The board decided that this response meant the division had not yet finalised a reasoned decision; the document sent to the parties was merely a draft from the first examiner. But to issue the parties with a draft decision not approved by all division members present at the oral proceedings was a substantial procedural violation. The board added that if, as it had first imagined, the signatures had merely been missing, this could have been corrected under R. 89 EPC which allows correction of linguistic errors, errors of transcription and obvious mistakes in EPO decisions. It also noted that decisions' accompanying forms are never signed, because they are computer-generated and therefore, under R. 70(2) EPC, 1st sentence, a seal may replace the signature. In general, the decision as notified to the parties is presumed to be authentic.

7. Correction of errors in decisions

7.1 General issues

In decisions of the EPO, only linguistic errors, errors of transcription and obvious mistakes may be corrected (R. 89 EPC).

In **T 212/88** (OJ 1992, 28) the board held that the absence of a chairman's or minute-writer's signature at the end of an opposition division's decision was a rectifiable, obvious error within the meaning of R. 89 EPC. In the case in question a second examiner had been referred to in the minutes as a member of the opposition division, although in fact he was not a member and did not take part in the oral proceedings. The board held that correction of the two errors had to be by means of a decision under R. 89 EPC with retrospective effect from the date of the original decision. The same board emphasised the retrospective effect of corrections under R. 89 EPC in **T 116/90** but stated that it was unnecessary to redate the decision as from the date of correction.

In **T 850/95** (OJ 1997, 152) the decision to grant under R. 51(6) EPC had been despatched when the applicant filed two additional pages of the description, which had been omitted due to a clerical error when the applicant filed a complete set of replacement pages for the text of the application, and requested their inclusion in the patent specification. He was informed that the technical preparations for the publication of the patent specification had been completed. The applicant requested that the patent be re-published incorporating the missing pages. The request for correction was refused by the examining division on the ground that "the corrections specified did not relate to passages in the patent specification where the Division wished to base its decision on a different text (Guidelines, Part E-X, 10)".

The board found that, according to the practice of the EPO, the decision to grant issued by the examining division (an electronically generated form) referred to the documents approved by the applicant under R. 51(4) EPC, so that they became an integral part of the decision to grant. It followed from this that errors in the specification might also be corrected under R. 89 EPC. The board held that, in a decision to grant, if the text given for grant was not and obviously could not be the text corresponding to the real intention of the examining division, there was an obvious mistake within the meaning of R. 89 EPC, and the text erroneously indicated could be replaced by the text on which the examining division actually wanted to base its decision. The board noted that the filing of replacement pages for the whole specification should be avoided unless the extent of the amendments made it absolutely necessary.

In **T 425/97** in a note from the opposition division concerning a consultation by telephone it was stated that appellant II (patentee) had drawn the opposition division's attention to an obvious error in the minutes and in the decision. This consultation was followed by the dispatch by telefax of a revised version of the "Facts and submissions" and the "Reasons" of the decision and a revised form of the minutes. A new term for appeal was not set. In a short accompanying communication, the opposition division informed the parties that the correction was made according to R. 89 EPC, and had "become necessary because auxiliary request 7 and 8 obviously had been confounded". No trace of said auxiliary request 8 was however to be found in the foregoing history of the case. In the corrected form of the decision, a completely fresh text of the valid claim was enclosed. The minutes were corrected accordingly.

The board referred to **G 8/95** which dealt with the scope of R. 89 EPC, stating that the difference between an appeal against a decision and a request for correction of a decision may be seen in the fact that in the first case the remedy is directed against the substance of the decision and in the latter case against the form in which the decision was expressed. This means that it could be within the scope of R. 89 EPC to correct the text of the patent if it is not and cannot be in the form corresponding to the intention of the deciding instance (**T 850/95**, OJ 1997, 152). The board found however that, in the case at issue, the intention of the opposition division apparently had changed between the oral proceedings and the issuance of the written decision in its original version. The claim on which the revised version of the decision was based was substantially different from the non-revised one. Moreover, the text of the minutes of the oral proceedings attached to the decision was not the original one, but was also modified to bring it into agreement with the decision. For these reasons, the original decision could not be revised under R. 89 EPC since the modifications introduced would change not only the form but its very substance.

In **T 212/97** the board pointed out that R. 89 EPC permitted the opposition division to correct an obvious mistake in the copy of the decision notified to the parties. In the case at issue, a fourth person had been named as a member of the opposition division although no such person had been mentioned in the original document.

In **T 965/98** the board issued a decision orally on the basis of claims submitted during oral proceedings. However, during preparation of the written reasons, the appellant requested correction of an obvious error in the claims. The board agreed to the correction under R. 88 EPC and amended its original decision to take account of the correction under R. 89 EPC.

In **T 867/96** the patentee had requested the correction under R. 89 EPC of a sentence, in the reasons for a board of appeal decision, stating that all the parties had agreed that a certain document represented the closest prior art. The board pointed out that the case was closed, as res judicata, and therefore no longer before it. Citing in particular **G 8/95** (Reasons 3.4) and **G 1/97**, the board held that only the board which had taken a decision could decide whether it required correction. Furthermore, establishing whether correction was necessary involved studying the facts, implying in general and up to a certain point that such requests were admissible. The present board thus ruled that the request for correction was admissible. However, it also held that this particular request did not fulfil the requirements of R. 89 EPC, was unfounded and should therefore be refused.

7.2 Errors in the printed version of the European patent specification

In **T 150/89** some printing errors in the published patent specification were found which were not present in the version accepted by the Office. The board found that such omissions should normally be corrected as a matter of routine. The decision to grant was legally binding as regards existence and scope of the patent (Art. 97 EPC). The specification reproduced that decision (Art. 98 EPC). It was an official document published by a public authority for general information, and as such had legal force before the courts. It was therefore subject to the same correction criteria as the grant decision itself under R. 89 EPC. That provision did not cover matters of fact or substance ; only obvious errors could be corrected. The Office could make such corrections **on request or of its own motion** . Thus the specification was to be brought into line with the decision to grant, and whether this took the form of a reprint or a corrigendum (which was a matter for the department of first instance, or possibly its formalities officer, to decide) should clearly indicate the correction made.

7.3 Competence to correct a decision under Rule 89 EPC

In **G 8/95** (OJ 1996, 481) a question of law was referred to the Enlarged Board of Appeal to decide which board of appeal (either the technical board or the Legal Board) was competent to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC for correction of the decision to grant. In the view of the Enlarged Board, the **basis** of such a request for correction was not that the party was not granted what it had requested.

Rather, such a request was based on the allegation that there was a linguistic error, error of transcription or similar obvious mistake.

The Enlarged Board noted that the competence to correct errors in a decision under R. 89 EPC lay with the body which had given the decision. Hence, in the examination procedure the examining division had to decide on a request to correct errors in the decision to grant. If the request for correction of the decision to grant concerned the grant of the patent, then the decision on the correction had also to concern the grant of the patent, since it was the request of the party which defined the subject of the dispute. The Enlarged Board also agreed with the statement made in **J 30/94** (OJ 1992, 516) that it was the decision to refuse the request for correction which was under appeal. According to the Enlarged Board, this did not alter the subject of the dispute in the second instance. The decisive criterion in Art. 21(3)(a) EPC was not that the decision under appeal was the decision to grant itself. It was sufficient for the decision to "concern" the grant, and this was necessarily the case if the subject of the decision was the text in which the patent was to be or had been granted, since this was the result of the substantive examination and defined the rights conferred by the patent. The Enlarged Board came to the conclusion that the decision refusing a request for correction of the decision to grant concerned the grant of the patent. It was, therefore the technical boards as defined in Art. 21(3)(a)(b) EPC which had to decide on appeals from a decision of an examining division refusing a request under R. 89 EPC for correction of the decision to grant.

In **J 12/85** (OJ 1986, 155) the board noted that the existence of inconsistencies in the decision to grant a patent might be a ground for filing a request for correction based on R. 89 EPC. However, a board of appeal could only examine appeals from decisions of other-instance departments of the EPO (Art. 21(1) EPC). Thus it could not examine a request for a correction of the decision under appeal based on R. 89 EPC. A decision on such a request had first to be taken by the department of first instance before the matter could be referred to a board of appeal. The board further noted that inconsistencies did not affect the validity of the decision to grant the patent nor imply that the appellant was "adversely affected" by this decision.

8. Principles for the exercise of discretion

In **J 4/87** the appellant submitted that there was nothing in the EPC which prevented the EPO from exercising discretion in cases of exceptional delay in the post. The board, however, held that as a matter of law the EPO had no general discretion as suggested by the appellant. The EPO could only exercise discretion if the power to do so could be derived from the EPC.

In **J 20/87** (OJ 1989, 67) the Receiving Section had rejected a request for a partial refund of the European search fee. In the reasons for its decision it was stated, inter alia, that the criteria for the refund of the European search fee were defined in Art. 10 RFees and these did not leave room for any discretion in favour of the applicant. In the case in question, these criteria had not been fulfilled. The board confirmed the finding of the Receiving Section and found that there was nowhere any support for the idea that the EPO was entitled to exercise any general discretion based on equity in respect of refunding the fee for the European search report. In fact, the existence of such a discretionary power could lead to serious difficulties in practice, bearing in mind the very large number of applications before the EPO and the great variety of possible borderline cases to be considered individually on such a general basis.

In **T 182/88** (OJ 1990, 287) the board clarified its case law concerning the exercise of discretion given to EPO departments. The board held that when exercising discretion, whether for or against a particular party, the reasons for the exercise of that discretion should be given. In any case where the EPC gave discretion to a department of the EPO in relation to an issue in proceedings before it, general principles of law required such discretion to be exercised having regard to the factors which were relevant to that issue. Those factors were in turn determined by considering the purpose of the exercise of the discretion in its context, and in the context of the EPC as a whole (see **T 183/89**). The board stressed that discretion had always to be exercised on a case-by-case basis, having regard to the particular circumstances. Discretion had always to be exercised judicially, by taking into account those factors which were legally relevant to the issue in question and ignoring those which were not. Showing consideration to parties before the EPO should not be confused with the proper exercise of discretion according to law.

The board made clear that where the EPC had given discretion to a department of the EPO in relation to proceedings at first instance before it, such discretion was normally best exercised by the department of first instance, because it had control over the proceedings and should be aware of all the factors which were relevant to the exercise of its discretion. Furthermore, once a department of first instance had exercised its discretion, in any appeal against a decision involving the exercise of that discretion a board of appeal was normally reluctant to interfere with such a decision, unless the reasoning in the decision had clearly been based on wrong principles. In the case in point, the board found that the reasoning of the examining division's decision did not provide an adequate basis for deciding on the exercise of discretion. According to the board, the examining division's function was not merely to consider whether the facts of the case before it were exactly the same as a previous case in which a board of appeal had decided in favour of an applicant. Its function was to decide on the applicant's request having regard to the factors which were relevant. In the circumstances, the board observed that this was a case in which it should set aside the decision of the examining division and itself decide the question of discretion (pursuant to the board's powers under Art. 111(1) EPC).

In **G 7/93** (OJ 1994, 775) the Enlarged Board stated that if an examining division had exercised its discretion under R. 86(3) EPC against an applicant in a particular case and the applicant filed an appeal against the way in which discretion had been exercised, it was not the function of a board of appeal to review all the facts and circumstances of the case as if it were in the place of the department of first instance, in order to decide whether or not it would have exercised its discretion in the same way as the department of first instance. If a department of first instance was required under the EPC to exercise its discretion in certain circumstances, it should have a certain degree of freedom when doing so, without interference from the boards of appeal. In the circumstances of a case such as that before the referring board, a board of appeal should only overrule the way in which a first-instance department had exercised its discretion if it came to the conclusion either that the department had not exercised its discretion in accordance with the proper principles as set out above, or that it had done so in an unreasonable way, and had thus exceeded the proper limits of its discretion (see also **T 640/91**, OJ 1994, 918).

9. Legal status of the Guidelines for Examination in the EPO

In **T 162/82** (OJ 1987, 533) and **T 42/84** (OJ 1988, 251), two boards of appeal ruled on the discretionary power of examining divisions to depart from the EPO Guidelines. According to these two decisions, the Guidelines were only general instructions intended to cover normal occurrences. Thus, an examining division could depart from them provided it acted in accordance with the EPC. In reviewing the decision of an examining division, a board of appeal would wish to ensure uniform application of the law and judge whether the division had acted in accordance with the EPC, not whether it had acted in accordance with the Guidelines.

In **T 647/93** (OJ 1995, 132) the board stated that it was normally desirable for examining divisions to act in accordance with the Guidelines, but pointed out that these were not rules of law, so failure to follow a procedure set out in them was not in itself a substantial procedural violation (**T 51/94, T 937/97**)

10. Duties not entrusted to formalities officers

In **T 161/96** (OJ 1999, 331) the appellant requested that the opposition fee be considered to have been paid in due time and that the notice of opposition I be deemed to have been filed validly within the opposition period. He applied for a decision by the EPO under R. 69(2) EPC. The appellant was informed within the meaning of R. 69(2) EPC, second sentence, by a formalities officer of the opposition division. Later on, the opposition division rejected opposition I as inadmissible.

The board held that the **act of informing** an opponent within the meaning of R. 69(2) EPC, second sentence, does not belong to the duties entrusted to formalities officers of the opposition divisions by virtue of the powers transferred to the Vice-President of Directorate-General 2 of the EPO by order of the President of the EPO of 6 March 1979, under R. 9(3) EPC (cf. Notice dated 15 June 1984 as revised and supplemented on 1 February 1989 [OJ 1984, 319; 1989, 178], point 4). The appellant was not therefore entitled to rely on the formalities officers's communication that no loss of rights had occurred.

11. Jurisdiction

In **J 42/92** the board had to decide whether a request under R. 88 EPC, second sentence, could be made after grant. It came to the conclusion that a request under R. 88 EPC for amendments to the description or claims could only be filed during the pendency of application or opposition proceedings. Under Art. 97(4) EPC, the decision to grant a European patent took effect on the date on which the European Patent Bulletin mentioned the grant. After that date, R. 88 EPC could only be applied while opposition proceedings were pending.

The board also pointed out that there was no reason why, once no application or opposition proceedings were pending before the EPO, decisions on the question of corrections (bearing in mind the requirement of obviousness to a skilled person) should not fall within the sole jurisdiction of the national courts or other authorities responsible for proceedings in which this question might arise (see also **T 777/97**).

M. Other procedural questions

1. Language privilege

Natural or legal persons having their residence or principal place of business within the territory of a contracting state having a language other than English, French or German as an official language, and nationals of that state who are resident abroad, may file documents which have to be submitted within a given time limit in an official language of the contracting state concerned (Art. 14(2) EPC and Art. 14(4) EPC). These persons thereby become entitled to a fee reduction under R. 6(3) EPC.

The leading decision in this area is **G 6/91** (OJ 1992, 491) following a referral by **T 367/90** of 2.7.91 (OJ 1992, 529). The Enlarged Board of Appeal ruled that the persons concerned were only entitled to the fee reduction under R. 6(3) EPC if they filed the **essential item** of the **first** act in filing, examination, opposition or appeal proceedings in an official language of the state concerned other than English, French or German, and supplied the necessary translation no earlier than simultaneously with the original. To be able to claim the fee reduction it was sufficient for the **notice of appeal** to be filed as the essential item of the first act in appeal proceedings in an official language of a contracting state and be translated into one of the official languages of the EPO. Subsequent items, such as the statement of grounds of appeal, could then also be filed in an EPO official language.

These principles have since been applied in a number of decisions, for example in **T 367/90** of 3.6.92, **T 385/90** and **T 297/92**.

As far as opposition proceedings are concerned, the board decided in **T 290/90** (OJ 1992, 368) that to be granted a 20% reduction in the opposition fee under R. 6(3) EPC, that part of a **notice of opposition** which is governed by R. 55(c) EPC should always be filed in a non-official authorised language.

Neither a request for a fee reduction, nor a notification that only a reduced fee has been paid, is an essential part of the first act of the relevant proceedings. This is in contrast to the **notice of appeal**, which, although linguistically insensitive, is clearly essential to appeal proceedings (**T 905/90** (OJ 1994, 306; Corr. OJ 1994, 556), applying **G 6/91**; see also **J 4/88** (OJ 1989, 483)).

Where a patent application was filed in one of the languages referred to in Art. 14 EPC, a date of filing was to be attributed under Art. 80 EPC, irrespective of the fact that the applicant had neither its residence nor principal place of business in a Contracting State nor was a national of a Contracting State, provided that all the other requirements of Art. 80 EPC were satisfied (**J 15/98,** OJ 2001, 183). However, it is inadmissible for a German opponent to file an opposition in the Dutch language even if represented by a Dutch patent attorney (**T 149/85**

(OJ 1986, 103)).

In **J 21/98** (OJ 2000, 406) the board found that the Guidelines A-XI, 9.2.3 were both misleading, being based on a misunderstanding of **G 6/91** (OJ 1992, 491), and also in contravention of the EPC. As a result, the appellant/applicant, who had filed a request for examination in Italian within the time limit provided for under Art. 94(2) EPC, and a simultaneous English translation, had been refused the 20% reduction in the examination fee pursuant to Art. 14 EPC. According to the Receiving Section, the written request for examination in the Italian language should either have been entered in the pre-printed box contained in EPO Form 1001, or have been sent to the EPO with that form.

According to the board, Art. 94(2) EPC, in connection with Art. 75 EPC, Art. 92 EPC and Art. 94(1) EPC, were to be interpreted such that, within the grant procedure, the request for examination constituted an autonomous step quite separate from the (previous) step of filing the patent application, enabling the applicant to consider whether to continue the grant procedure in the light of the search report. Since the EPC gave the applicant the right to file the request for examination after the publication of the search report, it followed that the same right must be owed to the applicant who wanted to avail himself of the option provided for in Art. 14(2) EPC and Art. 14(4) EPC.

Nor was this finding in conflict with **G 6/91**, which stated that the persons referred to in Art. 14(2) EPC are entitled to the fee reduction if they file the essential item of the first act in filing, examination or appeal proceedings in accordance with the provisions. Nowhere did the decision suggest that the time limit for filing the request for examination should be changed. (See also **J 22/98**, **J 6/99**, **J 14/99** and **J 15/99**).

However, under Art. 14(4) EPC, those entitled to file in an official language of a contracting state under Art. 14(2) EPC must supply a translation in English, French or German within the time limit prescribed in the Implementing Regulations, failing which either the application is deemed withdrawn under Art. 90(3) EPC or the original document is deemed not to have been received under Art. 14(5) EPC (see **T 323/87** (OJ 1989, 343) and **T 193/87** (OJ 1993, 207)).

2. Inspection of files

Under Art. 128 EPC, the confidential treatment of patent applications ceases on publication of the application, not on expiry of the 18-month period mentioned in Art. 93 EPC (**J 5/81**, OJ 1982, 155).

Any person who can prove that the applicant for a European patent has invoked the rights under the application against him may obtain inspection of the files prior to the publication of the application and without the consent of the applicant under Art. 128(2) EPC. According to **J 14/91** (OJ 1993, 479) these rights can be said to have been invoked where the invocation of rights is formulated in relation to the first filing in a contracting state but the subsequent European application is mentioned at the same time. Any dispute between the applicant and a third party concerning the latter's right to inspect the files pursuant to Art. 128(2) EPC is best decided in oral proceedings convened at short notice.

R. 93 EPC indicates those parts of the file which shall be excluded from inspection pursuant to Art. 128(4) EPC. In **T 811/90** (OJ 1993, 728) the board held that filed documents which, following a substantial procedural violation, were to be withdrawn from the part of the file available for public inspection and which did not fall under the exclusions listed in R. 93 EPC had to be returned to the filing party if it so requested. Thus, even those documents marked as "confidential" in **T 516/89** (OJ 1992, 436) were returned to the party concerned - without note being taken of their contents - since they did not belong to the classes of documents to be excluded from file inspection under R. 93 EPC.

Where a priority document reached the EPO in time, but was actually filed by a third party in connection with another application, the board held that the priority claim was lost. One reason given was that R. 38(3) EPC and R. 104b(3) EPC (now R. 111(2) EPC) ensure that a certified copy of the previous application is available to third parties requesting inspection of the file. This would clearly not be the case where a document is included only in a completely unrelated file (**J 11/95**).

3. Register of Patents

3.1 General

No entries can be made in the Register of Patents prior to publication of the European patent application (Art. 127 EPC). Even in the case of published applications, R. 92(1)(u) EPC provides that the date of re-establishment of rights is to be entered only if loss of the application (R. 92(1)(n) EPC) or the revocation of the patent (R. 92(1)(r) EPC) has been entered in the Register (**J 5/79** (OJ 1980, 71)).

3.2 Registration of licences

As to the recording in the Register of European Patents of an exclusive licence under a patent **already granted**, the Legal Board of Appeal ruled in its decisions **J 17/91** (OJ 1994, 225) and **J 19/91** that registration was no longer possible once the patent had been granted because the EPO had renounced jurisdiction in favour of the national offices of the contracting states designated in the request for grant.

3.3 Transfer

Art. 72 EPC provides that an assignment of a European patent application must be made in writing and requires the signatures of the parties to the contract. Under R. 20(1) EPC, a transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that the transfer has taken place. This is in line with the PCT system (R. 92bis. 1 PCT).

In **J 38/92** and **J 39/92** the Legal Board of Appeal ruled that a transfer could only be recorded in the Register of European Patents on the basis of an official document in accordance with (an earlier version of) R. 20(1) EPC if that document **directly** verified the transfer. It did not suffice if a judgment was submitted which mentioned another document from which it was possible to verify the transfer.

Assessing whether there are documents satisfying the EPO that a transfer has taken place in accordance with R. 20(1) EPC and R. 20(3) EPC and making the entry in the register is the responsibility of the relevant department of first instance. Accordingly, in appeal proceedings, substitution of another party for the original applicant, is possible only once the relevant department of first instance has made the entry or where there is clear-cut evidence of a transfer (**J 26/95** (OJ 1999, 668)).

Under Art. 20 EPC the Legal Division is responsible for decisions in respect of entries in the Register of European Patents and their deletion. An appeal lies to the Legal Board of Appeal, not to a technical board (Art. 106(1) EPC and Art. 21(2) EPC). The entitlement of the patent proprietor entered in the Register of Patents may not therefore be questioned in opposition and subsequent appeal proceedings (**T 553/90**, OJ 1993, 666).

A transfer can be recorded in the Register of European Patents even after deemed withdrawal of a patent application, if it is still possible that restitutio is available and the successor in title has taken, together with his request for registering the transfer, procedural steps suitable for restoring the application (**J 10/93**, OJ 1997, 91).

4. Suspension of proceedings

Under R. 13(1) EPC the EPO must stay the proceedings for grant ex officio if a third party provides it with proof that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent (see **J 28/94** (OJ 1997, 400)), unless the third party consents to the continuation of such proceedings. The patentee will not be heard but may file a request with the Legal Division not to suspend proceedings. An appeal may be filed against the Legal Division's decision adversely affecting the applicant, proprietor or third party respectively.

A decision of the examining division to grant a European patent (Art. 97(2) EPC) does not take effect on the date the decision-making process following written proceedings before that division is completed, but on the date on which the European Patent Bulletin mentions the grant (Art. 97(4) EPC). In the interim period, proceedings for grant are still pending before the EPO and a request for suspension of proceedings under R.13 EPC is admissible (**J 7/96** OJ 1999, 443)). This decision was followed in **J 36/97**. The respondents raised the issue of the jurisdiction of the Landgericht München I arguing that the appellants' action constituted an abuse of law. The board disagreed, however, pointing out that pursuant to Art. 7 of the Protocol on Recognition, the courts in the Contracting States before which entitlement proceedings were brought were of their own motion to decide whether or not they had jurisdiction pursuant to Art. 2 to 6 of the Protocol. Moreover, according to Art. 9(2) of the Protocol, neither the jurisdiction of the national court whose decision is to be recognised nor the validity of such decision may be reviewed. In connection with R. 13 EPC, it was sufficient for the board to ascertain that the party requesting suspension of the proceedings had opened proceedings against the applicants in a Contracting State for the purpose of seeking a judgement that it was entitled to the grant of the European patent. See also **J 8/96**.

Suspension must be ordered if satisfactory proof of the opening of relevant proceedings before a national court is given to the EPO by a third party, provided that the European patent application has not been withdrawn or is not deemed to have been withdrawn. If, in accordance with R. 13(3) EPC, the EPO sets a date on which it intends to continue the proceedings for the grant of the European patent, the date may be varied or the order staying the proceedings may be discharged at the subsequent request of the applicant or of the third party who applied for the order (**T 146/82** (OJ 1985, 267)).

Suspension of the proceedings for grant means that the legal status quo existing at the time they were suspended is maintained, ie neither the EPO nor the parties may validly perform any legal acts while the proceedings are suspended (**J 38/92** and **J 39/92**).

5. Notifications

If a representative has been appointed, notifications are addressed to him in accordance with R. 81(1) EPC.

In **J 19/92** the Legal Board of Appeal held that notifications to an applicant's representative are duly made if they were despatched before the representative relinquished his brief. The notification to the applicant does not therefore have to be repeated after the brief has been relinquished. On the contrary, it is the representative who is obliged to inform his client of the notification.

However, in **T 703/92** the written decision and minutes of the oral proceedings were sent not to the authorised representative but to the opponents. The board found that, as the provision relating to notification had not been observed, the question whether a notification had effectively taken place depended (in accordance with R. 82 EPC) on whether and when the representative had received the full decision.

In **J 9/96** the Legal Board of Appeal held that notification of a communication posted as an ordinary letter in accordance with R. 78(2) EPC is deemed to have been made when despatch has taken place. However, if the communication does not reach the addressee and is not returned to the EPO, the legal fiction of deemed notification cannot be applied, unless the EPO can establish that it duly despatched the communication. See also **J 27/97** and **J 32/97**. R. 78(2) EPC has since been amended with effect from 1.1.1999, such that notifications to addressees, who have not appointed a representative and have neither their residence nor a place of business within the territory of one of the Contracting States, are effected by registered letter (OJ 1999, 301, 304). Facsimile transmissions of notifications do not satisfy the requirements of R. 77(1) EPC and cannot therefore be considered as regular notification within the meaning of Art.119 EPC and R. 77 EPC (**J 27/97**).

When establishing the meaning of the term "im Zweifel" in the German version of R. 78(3) EPC (now R. 78(2) EPC), account should be taken of the French and English versions, which assume that there is a dispute ('en cas de contestation', 'in the event of any dispute'). A dispute ('Zweifel', literally 'doubt' in the German version) within the meaning of this rule could only arise if it was maintained that a letter had in fact been received more than ten days following its posting. The mere absence of the advice of delivery or the receipt from the file was not in itself sufficient to give rise to a dispute ('Zweifel') within the meaning of this rule (**T 247/98**).

A communication under R. 85b EPC was handed not to the appellant or his spouse (regulation dated 19.12.1995 to protect customers of the postal service in Germany (RPCPS, BGBl I, page 2 016)) but to a third party not authorised by the appellant to accept it. The said party was in the addressee's business premises, but not an employee. In the board's view, that meant that notification under Section 12(1) and (2) RPCPS had not occurred. Nor did the party qualify under any of the categories of "substitute addressee" defined in Section 13 RPCPS. There was also no evidence that the appellant had ever seen the communication. The board therefore found the EPO had not shown notification to have been properly effected (**J 35/97**).

6. Unity of the European patent application

A patent was owned in one designated state (UK) by one company (A) and in other designated states by another related company (B). Only company B filed an appeal against revocation of the patent. The respondents raised the question whether the revocation decision had become final as regards the UK, where only A had a patent, since the appeal filed by B and the subsequent decision of the board of appeal on it could not affect the decision under appeal with regard to the UK but only with regard to the designated states for which B was the patent proprietor

The board held that the principle of unitary procedure leading up to the grant of one European patent must be taken into account. This principle derived from Art. 118 EPC, which explicitly stated that applicants for different contracting states should, for the purpose of proceedings before the EPO, be regarded as joint applicants or proprietors. Thus the decisions of both first and second instance took effect for all the designated states (**T 119/99**).

N. Interpretation of the EPC

The Vienna Convention on the Law of Treaties applies only to agreements which postdate its entry into force, and therefore not for interpreting the EPC. In **J 8/82** (OJ 1984, 155) the board noted however that it was well recognised that what the Vienna Convention said in its Art. 31 and 32 about the interpretation of treaties merely codified existing public international law. In its first decision (**G 1/83**, OJ 1985, 60), the Enlarged Board of Appeal endorsed this, pointing out that the International Court of Justice, the European Court of Human Rights, the Federal German Constitutional Court and the House of Lords had also applied the principles of interpretation in Arts. 31 and 32 of the Vienna Convention to treaties to which strictly they did not apply. It concluded that the European Patent Office should do the same. Art. 31 of the Vienna Convention says that a treaty must be interpreted in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose. **T 128/82** (OJ 1984, 164) adds that under Art. 32 of the Vienna Convention recourse may also be had to supplementary means of interpretation, such as the international treaty's legislative history (eg the preparatory work and the circumstances in which the treaty was concluded), in order to confirm the meaning arrived at by applying Art. 31 or to determine the meaning when applying Art. 31 leaves the meaning ambiguous or obscure, or produces a meaning which is obviously nonsensical or unreasonable. In **J 4/91** (OJ 1992, 402), for example, the Legal Board of Appeal drew on historical material relating to the EPC to support its view, arrived at from a teleological and systematic interpretation of the relevant provisions, regarding the additional period for paying renewal fees. **G 1/98** (OJ 2000, 111) discussed the purpose of Art. 53(b) EPC, its relationship to other international treaties and legal texts, and its legislative history. In **G 3/98** and **G 2/99** (OJ 2001, 62 and 83), the Enlarged Board reached its conclusions on Art. 55(1) EPC after interpreting the wording and considering also the legislator's intention and the aspects of systematic, historical and dynamic interpretation.

In **J 8/95** it was held that **Art. 177(1) EPC** was based on the assumption that the authors of the EPC had one intention, which was to be determined using the three versions of the Convention. Even if one language version of a provision were found to differ from the other two versions, no legal consequences could be derived from that version other than could be derived from the other two versions - regardless of the language of the proceedings. A difference in the wording in one language would have to be considered only in so far as it could form one element of the interpretation. In the case at issue, however, the provision under consideration, even in the allegedly different version, could readily be understood in context in the same way as the other two official languages, with the result that all three versions of the provision corresponded as far as content was concerned.

In **J 16/96** (OJ 1998, 347) the issue was whether an association of representatives within the meaning of R. 101(9) EPC could also be formed by professional representatives who did not work in private practice. The Administrative Council of the European Patent Organisation had decided at its 4th meeting in 1978 that an association within the meaning of this rule could only be an association consisting of professional representatives in private practice. The Legal Board of Appeal pointed out that in their decisions the boards of appeal were not bound by any instructions and complied only with the provisions of the EPC (Art. 23(3) EPC). The boards of appeal could not be formally bound to a **decision of the Administrative Council concerning a question of interpretation**, nor could such a decision be deemed to be an instruction for their decisions. However, such a decision was a relevant element in interpretation.

According to the Vienna Convention on the Law of Treaties, the EPC had to be interpreted "in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose" (Art. 31(1) Vienna Convention). According to Art. 31(3)(a) Vienna Convention, "any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions" had also to be taken into account. Interpreting the case in accordance with Art. 31(1) of the Vienna Convention, the board concluded that an association within the meaning of R. 101(9) EPC could also be an association of representatives not engaged in private practice. The intended aim of the Council's decision, which was to eliminate ambiguities in the application of R. 101(9) EPC, had, in the light of recent developments in the profession, not been achieved, and as such the decision was less important in relation to the other factors involved in interpretation.

In **T 557/94** the board discussed the **TRIPS** requirement for the judicial review of decisions revoking a patent. While recognising that the EPO was not a party to TRIPS the board investigated whether the basic principle of judicial review under Art. 32 TRIPS was satisfied by the EPC. It found that in any case, under Art. 111(1) EPC, second sentence, the board of appeal was empowered either to decide on the merits of the case **or** to remit the case; it was not restricted to the latter alternative if the opposition division maintained the patent and the board was considering revoking the patent for the first time. Reading Art. 32 TRIPS in the context of the usual structure of judicial review in the EPC contracting states and the EPC itself, this provision guaranteed an instance for judicial review in revocation proceedings, but did not oblige the reviewing instance to remit the case to the department of first instance for continuation of proceedings when revocation was being considered by the judicial instance for the first time.

The right of the parties to fair proceedings if a relevant document was introduced only at the appeal stage was a quite different matter. According to the case law of the boards such a procedural situation called for careful consideration.

In **T 1173/97** (OJ 1999, 609, Reasons 2) the board however thought that, although TRIPs could not be applied directly to the EPC, it was appropriate to take it into consideration in connection with the patentability of computer program products. For TRIPs was aimed at setting common standards and principles concerning the availability, scope and use of trade-related intellectual property rights. It thus gave a clear indication of current trends. The appellant's reference to current practice at the US and Japanese patent offices caused the board to emphasise that the legal position in the USA and Japan differed greatly from that under the EPC: only the EPC contained an exclusion such as that in Art. 52(2) and (3) EPC. These developments nevertheless represented a useful indication of modern trends and, in the board's view, could contribute to the further highly desirable (worldwide) harmonisation of patent law.

In **T 452/91** the board took the view that in proceedings before the instances of the EPO, questions of patentability were to be decided solely in accordance with the EPC. No **national decision** should be cited as if it were binding on the EPO, and claims should not be refused by the EPO on the ground that their "patentability cannot be upheld under the jurisdiction of one member state". It could be that the law in most or all other contracting states was different. The reasoning that led the national instance to its conclusion might well lead an EPO instance to a similar conclusion under the EPC, but this would first need a careful assessment of the EPC, and of relevant EPO board of appeal case law, a comparison with the legislation and jurisprudence on which the national instance reached its conclusion, and a study of the position in other contracting states.

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 accordance 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 accordance of a filing date was not dependent on any text matter in the drawings being in a language in accordance with Art. 14(1) or (2) EPC. The accordance 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 und 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 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 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 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 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 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 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 ot 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** und **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 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 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 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 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, accotding 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** (ABl. 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 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 imcomplete 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)).

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

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 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 examing 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.I.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 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**).

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, 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 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 disussions 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 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 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 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.

VIII. DISCIPLINARY BOARD OF APPEAL

1. Introduction

Professional representation of natural or legal persons in proceedings established by the EPC may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO (Art. 134(1) EPC). Any natural person may be entered on the list, provided that he has passed the European qualifying examination (Art. 134(2)(c) EPC). Under Art. 134(7) EPC, legal practitioners from the contracting states are also entitled to act as representatives, subject to the conditions specified therein.

All persons on the list of professional representatives are members of the *epi* (Art. 5 of the Regulation on the establishment of an institute of professional representatives; latest version: OJ 1997, 350) and subject to the Regulation on discipline for professional representatives (RDR; OJ 1978, 91) adopted by the Administrative Council of the European Patent Organisation and the Code of Professional Conduct (latest version: OJ 1999, 537) adopted by the *epi*. The bodies which rule on infringements of the rules of professional conduct are: the *epi* Disciplinary Committee, the EPO Disciplinary Board, and the Disciplinary Board of Appeal (DBA) (see Art. 5 RDR). Under Art. 8 RDR, the DBA hears appeals against decisions of the *epi* Disciplinary Committee and the EPO Disciplinary Board.

The European qualifying examination (EQE) is governed in particular by the Regulation on the EQE (REE 1994, OJ 1994, 7), as amended by Administrative Council decision of 8.6.2000 (OJ 2000, 320), and the Regulation's implementing provisions (OJ 1998, 364). Under Art. 27 REE, the DBA hears appeals against decisions of the EQE Examination Board and Secretariat. The Regulation on the EQE has been frequently amended. The version which entered into force on 1.5.1991 (REE 1991, published in OJ 1991, 79) made comprehensive reference to the previous amendments made. The current version (REE 1994, OJ 1994, 7) entered into force on 1.5.1994. However, Art. 14, 15, 24(2) and 28(1) have been applied since 10.12.1993. By decision of 8.6.2000, the Administrative Council amended Art. 27(2) and (3) REE (regarding appeals in connection with the EQE) (OJ 2000, 320). For such cases, the DBA now comprises two legally qualified members of the EPO and a professional representative. The new provisions implementing the REE 1994 took effect on 1.7.1998 (OJ 1998, 364), replacing those previously in force (OJ 1994, 595; OJ 1995, 652). Despite these changes, DBA case law on the reviewability of Examination Board decisions continues to apply.

2. European qualifying examination

2.1 Drawing up the examination procedure

In **D 3/89** (OJ 1991, 257) it was stated that the validity of the examination procedure drawn up by the Administrative Council or by the Examination Board on its behalf could be scrutinised by the DBA only to a very limited extent, since the relevant bodies had discretionary powers in drawing up such procedures. As long as the legislative organ and subsidiary bodies had not misused their discretionary powers, the DBA could apply the provisions concerning examinations only to the case in point. (see also **D 1/81,** OJ 1982, 250, **D 5/89**, OJ 1991, 210, **D 11/99** of 17.11.1999).

2.2 Conditions for enrolment

The requirements of Art. 7(1) REE 1991 are now contained in Art. 10(2) REE 1994. The substance has not changed, so the case law on Art. 7 REE 1991 remains authoritative.

According to **D 4/86** (OJ 1988, 26), for the condition stipulated in Art. 7(1)(b)(i) REE 1991 to be met, the trainee must have completed his training period under conditions likely to ensure that he has actually assisted a professional representative by constantly taking part in activities pertaining to patent application procedures of which the representative is in fact in charge.

According to **D 3/89** (OJ 1991, 257) equivalent scientific or technical knowledge within the meaning of Art. 7 (1) (a) REE 1991, second alternative, may be demonstrated not only by an additional period of three years spent working in a range of activities pertaining to patent matters but also by relevant experience in another appropriate field (e.g. research).

D 14/93 (OJ 1997, 561) ruled that the training period required for EQE enrolment pursuant to Art. 7(1)(b) REE 1991 could not be served with a legal practitioner whose name did not appear on the list of professional representatives, even if the said practitioner was a patent attorney under national law (see Art. 134(7) EPC). The appellant argued that for Art. 7 REE 1991 not to allow the training period to be served under a legal practitioner's supervision infringed the principle enshrined in Art. 134(7) EPC of equal treatment of legal practitioners and professional representatives (Art. 134(1) EPC). The board took a different view: the activities referred to in Art. 7(1)(b) REE presupposed the scientific or technical knowledge required with a view to activities pertaining to European patent applications and patents; persons training EQE candidates needed to possess such knowledge, and legal practitioners did not normally do so.

D 25/96 (OJ 1998, 45) ruled that the period of professional activity required for EQE enrolment pursuant to Art. 10(2)(a) REE 1994 could not be served with a self-employed German patent agent who was not on the list of professional representatives.

2.3 Power of review in examination matters

Under Art. 27(1) REE 1994, an appeal lies from decisions of the Examination Board only on grounds of infringement of the Regulation or of any provision relating to its application.

In **D 1/92** (OJ 1993, 357) the appellant claimed that the examiners' assessment of his work was defective. The DBA pointed out that its review of Examination Board decisions was in principle limited to establishing whether they infringed the REE, its implementing provisions or higher-ranking law.

The DBA therefore concluded that its functions did **not** include reconsidering the examination procedure **on its merits**. It could only consider serious and obvious mistakes by an examiner marking a candidate's papers where the contested decision of the Examination Board was based on such a mistake. Furthermore, the alleged mistake had to be so obvious that it could be established without re-opening the entire marking procedure. Any further claims regarding alleged defects in the assessment of candidates' work fell outside the DBA's jurisdiction, since value judgments were not subject to judicial review (see also **D 6/92** (OJ 1993, 361)).

In **D 6/98**, the DBA added that these conditions are in line with those for correcting errors under R. 89 EPC, ie particularly in the case of errors of transcription or calculation in the marking. Under Art. 27(1) REE, the DBA is not empowered to reopen the assessment procedure (**D 15/97**). The DBA is not intended to be a department of second instance empowered to examine whether the marks awarded for a candidate's examination are justified on their merits or correct, and thus to superimpose its own value judgment on that of the Examination Board (**D 20/96**).

2.4 Examination conditions

In **D 2/95** the DBA found against an appellant alleging discrimination; the fact that certain other candidates had been allowed to use normal as opposed to copy paper for the examination was not in breach of the provisions governing its conduct. Some candidates might find copy paper more awkward, but others might well prefer it. Nor did other arguments along similar lines - eg that too little time was allowed for the papers, or that candidates whose mother tongue was not an EPO official language were at a disadvantage and should therefore be given more time than the others - convince the DBA that the relevant provisions had been infringed (**D 11/00**).

In **D 1/94** (OJ 1996, 468) it did however rule that a translation error might constitute a violation of Art. 11(3) REE 1991 [= Art. 15(3) REE 1994] since this provision assumed that the translation from the language selected by the candidate into one of the EPO official languages was totally correct. In its decision, the Examination Board therefore had to give reasons why the translation errors were not found to be serious.

In **D 14/95** the appellant's arguments centred on an alleged infringement of the principle of equal treatment. It had been infringed because he, as a specialist in biochemistry, had been placed at a disadvantage in Paper C (taken from mechanical engineering) compared with a specialist in that field. This explained the marking "slightly inadequate" awarded him for Paper C. The board found against any breach of equal treatment: the appellant's position was no different from that of any other candidate whose specialist field did not happen to be used in the paper as set. True, the examination procedure did in effect involve a certain "inequality". The Examination Board set a limited number of papers, and therefore had to make a choice amongst the different technical fields. So there would always be candidates who happened to be more specialised than others in the particular field selected. This however was inherent in any general examination, and thus did not constitute arbitrary unequal treatment. Furthermore, Paper C was less concerned with testing specialist technical knowledge than the ability to draft a notice of opposition to a European patent.

In **D 9/96** a candidate again alleged unequal treatment, this time in connection with the language rules under Art. 15 REE 1994. The board conceded that not all candidates were treated equally since not all of them received examination papers in their mother tongue. However, it had to be taken into account in this context that the differentiation referred to above was a direct consequence of the linguistic regime of the EPC itself. According to Art. 14(1) EPC the official languages of the EPO were English, French and German. Each professional representative was inevitably confronted with documents and notifications in one of the three official languages of the EPO. Thus, any professional representative had to be expected, in the public interest and the interest of his clients, to understand at least one of the official languages of the EPO and to be able to work on documents and notifications drafted in this language.

The background to several appeals (**D 10/97, D 15/97, D 17/97** and **D 5/97**) against Examination Board decisions failing candidates in Paper D of the 1996 EQE was that some (but not all) of the copies of the paper given to candidates did not contain Question 11. The Examination Board therefore automatically gave all candidates full marks for Question 11. On this point, the DBA reaffirmed **D 14/95**, ie that equal treatment did not have to be absolute, provided the nature and extent of any unequal treatment was justifiable in the circumstances. It would be wrong in law, however, if the examination conditions put certain candidates at a disadvantage for no good reason. The Examination Board had compensated the affected candidates in a way which appeared entirely appropriate given the circumstances. This necessarily involved a certain unequal treatment, which however was limited in its extent and acceptable in this special situation. In particular, it ensured that no candidate was worse off than if his answer had been marked objectively. So, in the DBA's view, the way in which the Examination Board had corrected the error was appropriate to the circumstances and did not constitute unlawfully unequal treatment.

In several decisions the DBA has pointed out that under point 7 of the Instructions to candidates concerning the conduct of the examination (OJ 1995, 145) and point 7 of the Instructions to invigilators (OJ 1995, 153), complaints filed in due time and form are heard by the Examination Board. In such cases, the Examination Board is in principle obliged to inform the complainant of its provisional opinion and give him an opportunity to comment. Failure to do so is an infringement of generally recognised principles of procedural law (Art. 125 EPC), notably the right to be heard (Art. 113(1)EPC) (**D 17/96, D 2/97, D 2/99, D 3/99**).

2.5 Substantiation of EQE decisions

At issue in **D 12/97** (OJ 1999, 566) was whether EQE Examination Board decisions informing candidates that they have failed the examination have to be reasoned. The DBA pointed out that the Regulation on the European qualifying examination (REE) did not require such decisions to be reasoned. R. 9(2) of the implementing provisions to the REE stipulated only that unsuccessful candidates be sent their answers and the marking sheets.

The board also found the appellant's constitutional arguments - that substantiation of such decisions was a generally recognised principle of procedural law within the meaning of Art. 125 EPC - to be unfounded. For this to be so, it had to be shown that substantiation of such decisions was required in the EPC contracting states.

2.6 Borderline cases

Borderline case assessments of candidates' fitness to practise as professional representatives before the European Patent Office are not possible under the 1994 Regulation on the European Qualifying Examination, REE 1994, and its implementing provisions (IP). Art. 17(1) REE 1994 is exhaustive. In accordance with this a candidate must pass each examination paper in order to pass the European qualifying examination as a whole. The only exception was laid down in R. 10 IP 1994, which by virtue of Art. 17(1) REE 1994 was also exhaustive and applicable only to candidates sitting the examination for the first time (**D 8/96** (OJ 1998, 302).

Appellants who have failed the EQE frequently cite the principle laid down in **D 1/93** (OJ 1995, 227), namely that in borderline cases where a resitting candidate has failed one of the papers the Examination Board has to analyse the results obtained in all the papers, taking into account not only the grades obtained but also their arithmetical sum, the nature of the papers, and the results obtained in each part of the papers. In several decisions (**D 2/96, D 4/96, D 2/97, D 3/97, D 18/97, D 8/98**) the DBA confirmed, citing **D 8/96**, that the introduction of Art. 17(1) REE 1994 did away with the right to any such overall analysis. The position now is that candidates resitting part of the examination have to pass each paper, so the principles of **D 1/93** can no longer apply.

3. Disciplinary matters

3.1 Disciplinary measures

According to **D 5/86** (OJ 1989, 210), an infringement of the rules of professional conduct must be established to the satisfaction of the disciplinary body before it can impose a disciplinary measure. Absolute certainty is not required, but a degree of probability which in human experience verges on certainty. A disciplinary measure cannot be imposed if there is reasonable doubt as to whether the infringement has occurred.

In **D 11/91** of 14.9.1994 (OJ 1995, 721) the EPO Disciplinary Board had ordered the deletion of the appellant from the list of professional representatives for an indefinite period. In his appeal, the appellant contested the disciplinary measure and held that the procedure before the DBA did not comply with the provisions of the European Convention for the Protection of Human Rights, in particular because the DBA had been established not by national law but by the Administrative Council of the EPO, the disciplinary bodies did not constitute an independent court, the DBA was not a national authority, and its decisions could not be referred to a higher court of appeal.

The DBA decided that the European Convention for the Protection of Human Rights contained provisions which expressed general principles of law common to the member states of the EPO. As such these provisions should be considered part of the legal system of this Organisation and should be observed by all its departments. This therefore applied to Art. 13, which guaranteed the protection by the judiciary of the rights of the individual. The "national authority" mentioned in this article was clearly meant to be understood as a competent authority in accordance with the law of the state concerned. However, in ratifying the Munich Convention, the contracting states accepted a transfer of prerogatives whereby professional representatives before the EPO became subject to the same set of professional regulations, controlled by a central body whose decisions are open to effective remedy before a body of second instance whose independence is guaranteed by the rules governing its composition. The drafting of these regulations and the establishment of these bodies was thus consistent with general principles of law, in particular those expressed in the European Convention for the Protection of Human Rights.

As far as the disciplinary measure was concerned, the board took the view that in order to ensure that the penalty was proportionate to the seriousness of the charges and that the maxim according to which penalties should not be arbitrary but fixed or predetermined was respected, Art. 4(1)(e) RDR (Regulation on discipline for professional representatives) should be understood as meaning "for a period not defined by the text", that is for a discretionary period to be decided by the competent disciplinary body which, in its decision, should fix the said period and give reasons for its choice.

In **D 20/99** (OJ 2002, 19) it was stated that national anmesty laws were inapplicable in disciplinary proceedings before international authorities.

In the case in point the misuse of corporate assets constituted unfair distortion of competition among colleagues and hence a breach of the code of conduct of professional representatives before the EPO.

3.2 Appealability of decisions in disciplinary matters

In **D 15/95** (OJ 1998, 297) the board ruled that a Discipinary Committee decision dismissing a complaint was a decision in the legal sense only as regards the persons referred to in Art. 8(2) RDR, and only they could appeal against it. Thus the person who made the complaint had no right of appeal. Review on appeal was limited to safeguarding the rights of the "accused", ie the "professional representative concerned" within the meaning of the RDR (see also **D 1/98**). In **D 28/97** and **D 24/99** the DBA added that the purpose of disciplinary proceedings was not for individuals to pursue their interests vis-à-vis others (although these might be affected in individual cases) but rather to serve the public interest in orderly and proper exercise of professional representation before the EPO. Any claims by individuals arising from a representative's infringement of the rules of professional conduct are exclusively a matter for the competent (civil) courts.

4. Code of Professional Conduct

The general principles for this are laid down in the Code of Professional Conduct (new version published in OJ 1999, 537). Point 1 of the Code refers in turn, as regards the general requirements for *epi* members, to the RDR (OJ 1978, 91).

4.1 General professional obligations

In **D 16/95** the board ruled that although drafting and filing translations and paying fees in the national phase in a contracting state were not directly related to grant, opposition or appeal proceedings, such activities were still covered by Art. 1 RDR. They were, after all, activities in connection with a European patent (see Art. 65 EPC and Art. 141 EPC) and as such part of a professional representative's job. Regarding them as covered by Art. 1 RDR was also justified by the fact that it was difficult for outsiders (eg persons commissioned to translate patent specifications) to distinguish between those of a representative's activities which were directly related to grant, opposition or appeal proceedings and those which were not. Since national-phase-related activities were thus covered by Art. 1 RDR, reprehensible conduct in connection with them constituted a breach of a representative's general professional obligations under that provision.

4.2 Professional secrecy

In **D 11/91** of 18.5.1993 (OJ 1994, 401), the appellant had requested the removal of various documents placed on file by the complainant. The appellant argued that his request was justified because, inter alia, their inclusion contravened the rule of confidentiality to which professional representatives were subject. The documents were items of correspondence between the complainant and the disciplinary bodies and correspondence pertaining to an opposition case.

The board decided that the professional secrecy referred to in Art. 2 RDR set limits to the disciplinary bodies' powers of investigation and to the obligation under Art. 18 RDR that a professional representative before the EPO supply all relevant information. However, the mere obligation of confidentiality deriving from the principle enshrined in Part I RDR could not be invoked to resist a request under Art. 18 RDR.

4.3 Advertising

In the new Code of Conduct for professional representatives (OJ 1999, 537), the ban on advertising in point 2 of the old Code was replaced by a new rule (point 2(a)) whereby advertising is generally permitted provided it is true and objective. **D 12/88** (OJ 1991, 591), in which the DBA ruled on the ban on advertising the services of a patent agency, is thus superseded.

IX. THE EPO ACTING AS A PCT AUTHORITY

A. Introduction

1. New structure of the EPC provisions relating to international applications under the PCT

By decision of the Administrative Council of 13.10.1999 which entered into force on 1.03.2000 (OJ 1999, 660 ff and 696 ff), the EPC Implementing Regulations relating to PCT-applications have been amended. A new Part IX has been inserted in the Implementing Regulations which encompasses former R. 104 to 104c EPC plus a number of new provisions. A much clearer system of consecutive numbers (R. 104 to 112 EPC) has also been adopted. Former R. 105 to 106a EPC were deleted because the respective regulations for a transitional period were no longer relevant.

2. New time limits for the European phase entry of an international application - (Rule 107(1) EPC)

Under Art. 22(3) PCT or Art. 39(1)(b) PCT, the EPC may lay down longer time limits for European phase entry than the standard PCT ones of 20 and 30 months. For the European phase entry of an international application, R. 107(1) EPC in its version in force up to 1.1.2002 prescribed two different time limits, running from the date of filing or priority: 31 months for the EPO as elected Office (PCT Chapter II) and 21 months for the EPO as designated Office (PCT Chapter I).

By decision of the Administrative Council of the European Patent Organisation dated 28 June 2001 the EPO has now harmonised both the time limits under R. 107(1) EPC at 31 months.The amendment entered into force on 2 January 2002 and applies to all international applications for which, on that date, the acts prescribed under R. 107(1) EPC have not yet been validly performed and where the time limit for doing so under R. 107(1) EPC in its former form had not yet expired (OJ 2001, 373).

B. Competence of the boards of appeal in proceedings under the PCT

Under Art. 154(3) EPC and Art. 155(3) EPC, the function, or competence, conferred by R. 40.2(c) PCT and R. 68.3(c) PCT has been devolved to the EPO's boards of appeal. This function relates solely to the examination of protests against an invitation to pay an additional fee owing to lack of unity.

In **J 20/89** (OJ 1991, 375) the board had to decide whether, during the international phase of a PCT application, it had jurisdiction to examine decisions taken by the EPO acting in its capacity as an International Preliminary Examining Authority (IPEA) within the meaning of Chapter II of the Patent Cooperation Treaty (see Art. 150 EPC and Art. 155 EPC). It noted that the PCT did not contain any provisions for appeal or petition during the international phase. Save as was provided in R. 40.2(c) PCT and R. 68.3(c) PCT, there was nothing in that Treaty, or in the Regulations under it, providing for appeal during the international phase in proceedings before the Authority acting as ISA or as IPEA. Applicants are not, however, entirely deprived of legal safeguards during the international phase. All PCT Authorities in fact accept and duly consider any request for reconsideration of an earlier decision taken during the international phase, although this is not expressly provided for in the PCT. Furthermore, a designated or elected Office can, during the national phase, review a decision taken during the international phase by an ISA or an IPEA.

The board observed that under Art. 150(3) EPC an international application for which the EPO acts as designated Office or elected Office is deemed to be a European patent application. Consequently, there was no obstacle to making use of appeal procedures provided for under the EPC to supplement the provisions of the PCT in such cases (see Art. 150(2) EPC). However, if the EPO was neither receiving Office nor designated Office nor elected Office, but was acting solely **as ISA or IPEA**, the application of Art. 150(2) EPC should be limited, as far as the appeal procedure is concerned, to supplementing the express provisions of PCT R. 40.2(c) PCT and R. 68.3(c) PCT, which relate only to the examination by boards or other special instances of ISAs or IPEAs of protests against the charging of additional fees. Thus the board came to the conclusion that during the international phase of a PCT application, the boards of appeal of the EPO have no jurisdiction to examine appeals against decisions taken by the EPO acting **solely** in the capacity of IPEA within the meaning of Chapter II of the PCT.

In **J 15/91** (OJ 1994, 296) the applicant filed an international patent application with the EPO and paid the international preliminary examination fee but failed to submit a demand for international preliminary examination within the time limit, laid down in Art. 39(1)(a) PCT, of 19 months from the date of priority. The EPO, acting as IPEA, notified the applicant that fee payment could not be accepted as a substitute for observing the prescribed time limit. This being so, the applicant was not entitled to benefit from the provisions for postponing entry into the regional phase until 30 months from the date of priority.

The aim of the requests made by the applicant in his appeal against this notification was to obtain a decision to the effect that he had filed his demand for international preliminary examination in due time. The appellant argued that the board of appeal did have jurisdiction in the case, because, unlike in case **J 20/89** (above), where it was acting solely as an IPEA, the EPO had also previously acted as receiving Office. The decision of the Legal Board of Appeal was based on the principle that the EPO was bound solely by the provisions of the PCT, the Regulations under the PCT and the relevant agreement between WIPO and the European Patent Organisation (OJ 1987, 515), where the EPO was acting, **in the international phase** of the PCT procedure, in the capacity of an international authority under the PCT. This followed, with regard to proceedings before the IPEA, from Art. 34(1) PCT. To this extent, therefore, the EPC did not apply. Apart from allowing for protests against an invitation by the ISA (or by the IPEA) to pay additional search fees in cases where the requirements for unity of invention had not been met, the PCT made no provision for appeal during the international phase. Furthermore, the board took the view that even if, as in the present case, the EPO had acted as receiving Office, there were no grounds for supposing that its boards of appeal had any jurisdiction. International preliminary examination by the

IPEA was a separate procedure which had to be distinguished from proceedings before the receiving Office and the ISA. Under Art. 31(3) PCT, the demand for international preliminary examination had to be made separately from the international application, and Art. 31(6)(a) PCT stipulated that the demand had to be submitted to the competent IPEA, not the receiving Office. Although the EPO might well perform all the various functions involved in the international phase of the PCT proceedings, the distinction between the procedures still applied. Thus, it was decided that EPO appeal boards had no jurisdiction to examine appeals against the EPO acting in its capacity as an IPEA. The Legal Board of Appeal thereby upheld its previous decision **J 20/89**.

In **J 14/98** the applicant had contended that the EPC Contracting States had been elected under Art. 39 PCT and that, therefore, the thirty-one (instead of the twenty-one) month period under R. 104b(1) EPC applied in the case at issue. In fact, a demand for international preliminary examination (PCT chapter II demand) was filed in due time but, owing to a series of errors including a wrong application number in the demand, it went astray in the US Patent Office (USPTO) acting as International Preliminary Examination Authority (IPEA) under the PCT.

The board noted that under the provisions of the PCT it was the Office acting as IPEA (here the USPTO) which was responsible for deciding on the question of whether a PCT chapter II demand complies with the formal requirements laid down in the PCT (see Art. 34 PCT in combination with R. 60.1 PCT, in particular R. 60.1 (c) PCT). Thu, the board made it clear that neither the EPO (if not acting as IPEA) nor the boards of appeal had jurisdiction concerning PCT chapter II demands (**J 20/89**, OJ 1991, 375). The question of whether or not the effects of Art. 39(1)(a) PCT applied in the proceedings before the EPO was therefore to be decided on the basis of the conclusions of the IPEA responsible for the application. The same was true if the IPEA (here the USPTO) acted under the orders of a final decision of a court (here the CAFC) binding on it. In any case the Legal Board could not question the jurisdiction of the CAFC in the those circumstances. Nor could the board review the decision of the CAFC as to the merits.

The board held that the finding in the CAFC decision that the PCT chapter II demand which had been validly filed in due time constituted the factual basis for the further proceedings before the EPO in its capacity as designated or elected Office. The board noted that as far as decisions of the EPO in connection with the entry of PCT applications into the regional phase were concerned, the jurisdiction of the boards of appeal clearly derived from Art. 150(3) EPC in combination with R. 104b EPC and R. 104c EPC (versions prior to the revision of 1998). Thus, in these circumstances, the Legal Board of Appeal had jurisdiction to examine the decision of the Receiving Section of the EPO.

C. The EPO acting as ISA

1. PCT search guidelines binding on the ISA

In decisions **G 1/89** and **G 2/89** (OJ 1991, 155 and 166) the Enlarged Board of Appeal decided that the EPO in its function as an ISA may, pursuant to Art. 17(3)(a) PCT, request a further search fee where the international application is considered to lack unity of invention a posteriori.

According to Art. 2 of the Agreement between the European Patent Organisation and WIPO (latest version dated 1.10.1997 (OJ 1998, 85) the EPO must, in carrying out international searches, be guided by the PCT Search Guidelines. This Agreement is based on Art. 154 EPC and Art. 16 PCT and is therefore binding on the EPO, including the boards of appeal when exercising their special functions under the PCT in accordance with Art. 154(3) EPC. The PCT Search Guidelines contain a direct reference to the consideration of unity of invention by the ISA on an a posteriori basis, ie after an assessment of the claims with regard to novelty and inventive step in relation to the prior art. Only in the case of a conflict between the guidelines and the PCT itself does the latter prevail as higher-ranking law. The Enlarged Board, however, could not see such a divergence and therefore concluded that the PCT Search Guidelines should be applied as a matter of principle when examining for non-unity of an application a posteriori.

2. Protest procedure

If the international application does not comply with the requirement of unity of invention, the ISA must invite the applicant to pay additional search fees within a time limit fixed by the ISA (Art. 17(3)(a) PCT, R. 40.3 PCT). The applicant may pay the additional fee under protest and thereby initiate a review of the justification for the invitation (R. 40.2(c) PCT).

2.1 Substantiation of invitation

Under R. 40.1 PCT, the ISA must specify the **reasons** for which the application is not considered as complying with the requirement of unity of invention. According to established case law the specification of reasons in an invitation to pay additional fees is an **essential requirement** and an invitation is not legally effective unless reasons are given to substantiate lack of unity (**W 4/85** and **W 7/86** (OJ 1987, 63 and 67), **W 9/86** (OJ 1987, 459), **W 7/85** (OJ 1988, 211)).

Decision **W 4/85** (OJ 1987, 63) stated the minimum requirement for adequate substantiation. According to that decision, the basic considerations behind the finding that the invention lacked unity must be set out in a **logical sequence** to enable the applicant and the appeal body to check this finding (see also **W 2/93**, **W 2/95**); only in **straightforward cases** might it be sufficient just to list the relevant subject-matters, provided the list made it perfectly clear that the application did not relate to a single general inventive concept (as, for example, in **W 7/92**). Also, in **W 7/86** (OJ 1987, 67), **W 33/90, W 50/90,W 16/91, W 32/91, W 43/91** and **W 9/92**, it was pointed out that listing the inventions which in the ISA's view the application contained was sufficient reasoning only in exceptional cases.

In **G 1/89** and **G 2/89** the Enlarged Board of Appeal noted that the consideration by an ISA of the requirement of unity of invention should, of course, always be made with a view to giving the applicant fair treatment and that the charging of additional fees under Art. 17(3)(a) PCT should be made only in **clear cases**. In particular, in view of the fact that such consideration under the PCT was being made without the applicant having had an opportunity to comment, the ISA should exercise restraint in the assessment of novelty and inventive step and in borderline cases preferably refrain from considering an application as not complying with the requirement of unity of invention on the ground of lack of novelty or inventive step (see **W 34/89, W 23/92**).

In **W 26/91** the board concluded that the ISA had contravened the principles laid down by the Enlarged Board of Appeal in **G 1/89** and **G 2/89**. The mere citation of three documents without any analysis of what was disclosed and the undifferentiated allegation that with regard to these documents there was no novelty or inventive step could not be considered as fair treatment (see also **W 3/92**, **W 3/96**). If a lack of inventive step is not immediately apparent, in case of doubt unity should be assumed (see **W 23/89** and **W 51/90**).

In **W 3/93** (OJ 1994, 931) the ISA did not base its objection of lack of unity on the prior art referred to in the application or established during the search. It was therefore an "a priori" objection within the meaning of Chapter VII, 9 of the PCT Search Guidelines. In the board's view the grounds for this objection as stated in the invitation to pay contained virtually nothing more than a repetition of the substance of R. 13.1 PCT in different words. However, as the applicant in the present case was nevertheless able to make a substantive response, the board could accept the reasoned statement as sufficient on this occasion (confirmed in **W 4/94** (OJ 1996, 73)). Thus, the only issue to be examined was whether, considering the reasons stated by the ISA and the submissions made in support of the protest, retaining the additional fees was justified. The board found that it could not investigate **ex officio** whether an objection of lack of unity would have been justified for reasons other than those given, for example after taking into consideration the documents found during the search or addressing in depth the objectively resolved technical problem. Accordingly, the objection of lack of unity could be raised again on different grounds in the event of subsequent proceedings under PCT Chapter II (confirmed in **W 8/93** and **W 11/94**) (see also **W 4/94** below).

In **W 14/92** the board ruled that it had to be clear to the applicant whether the lack of unity objection was a priori or a posteriori.

In **W 11/89** (OJ 1993, 225) and **W 10/92**, the boards came to the conclusion that an invitation to pay additional search fees had also to contain an exposition of the problem solved by the invention, unless it was perfectly clear that the technical facts listed in the invitation could not reasonably be subsumed under an overall problem; if that exposition was lacking, the invitation was not legally effective and any additional search fees paid should be reimbursed (see also **W 8/94**). The determination of the technical problem underlying the invention was a mandatory precondition for the assessment of unity of invention, that is to say, whether or not the subject-matter claimed as the solution to such a problem represented a single general inventive concept. The disregarding of this principle was considered to be in itself sufficient justification for reimbursement of the additional search fees (see also **W 14/89**, **W 6/91** and **W 3/92**). **W 50/91**, **W 52/91** and **W 22/92** held that where the lack of unity objection was a priori, the technical problem was to be defined only on the basis of the description, not the prior art. According to **W 59/90** and **W 14/91**, in a posteriori cases, details of the technical problem were required to be given both before and after a document which caused lack of novelty and gave rise to lack of unity was found.

In **W 18/92** the board found as regards inventive step that there was no indication in the invitation from the ISA as to which document represented the closest prior art, what the problem to be solved was in the light of the closest prior art, and whether all five documents had been combined together to arrive at the finding of lack of inventive step, or only some of them.

In **W 31/88** (OJ 1990, 134) the board held that consideration of the clarity and conciseness of claims by the ISA was limited to whether they could be sufficiently understood to permit a meaningful search to be carried out (Art. 17(2)(a)(ii) PCT). Under the PCT the ISA was not competent to consider whether the requirements of Art. 6 PCT (in particular clarity and conciseness of claims) had been met. According to Art. 17 PCT, clarity of claims for the purposes of a meaningful search was a separate question from that of unity of invention. An alleged lack of clarity in a claim could not be used as a reason for an objection based on lack of unity.

In **W 3/94** (OJ 1995, 775) the board pointed out that Annex B, Part 1(f) of the Administrative Instructions under the PCT (PCT Gazette No. 15/1992, in force since 1.7.1992) contained specific criteria for assessing the unity of "Markush" claims. These guidelines pointed out that the question of unity of invention must be reconsidered if at least one "Markush" alternative was not novel, but that reconsideration did not necessarily imply that an objection of lack of unity would be raised (see Annex B, Part 1(f), (v)). The requirement of R. 40.1 PCT, whereby the invitation had to be reasoned, would thus be met only if it indicated why the criteria mentioned in Annex B, Part 1(f)(i), (B)(2) of the Administrative Instructions under the PCT had not been fulfilled. This was particularly the case where the unity of alternatives "of a similar nature" in a Markush claim was contested on the basis that they did not share a significant structural element. In the present case there were no facts from which a lack of unity was so manifestly clear that more detailed reasons could be dispensed with.

In **W 7/99** the board said the purpose of the protest procedure under R. 40.2(c) PCT was to review whether the invitation to pay was substantively justified, so the sole issue was whether, given the grounds set out by the ISA and the arguments submitted in the protest, additional search fees should be retained. So the board could not consider, of its own motion, whether a lack-of-unity objection might be justified for other reasons than those given, eg after considering the documents found in the search or looking in detail at the technical problem objectively solved. The board noted in this connection that "further relevant material" in the form of WPIL abstracts annexed to the ISA's reasoned request for additional fees. The board said that merely naming or listing possibly relevant additional literature, or simply referring to prior art mentioned in the application's description, without in any way analysing the implications of that literature or prior art for unity purposes, could not be considered an implicit a posteriori objection.

In **W 11/99** (OJ 2000, 186) the board observed that in Guidelines C-III-7.6 is stated that, although lack of unity should be raised in clear cases, it should not be raised on the basis of a narrow, literal or academic interpretation of the relevant provisions. This follows the

Guidelines for Examination in the EPO with regard to the requirement of Art. 82 EPC (see Guidelines C-III, 7.7). In the opinion of the board, the narrow interpretation of the relevant provisions on which the request for payment was obviously based is incompatible with this guideline too, as it results in subject-matters which contribute to the solution of one and the same technical problem and therefore belong together (see also **W 11/89**, OJ 1993, 225, Reasons, 4.1) being deemed to lack unity.

2.2 Substantiation of protest

R. 40.2(c) PCT enables the applicant to pay the additional fee under protest, "that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention ...". If the applicant decides to pay the additional fee under protest, therefore, it must be accompanied by a statement setting out the reasons for the protest. Since under Art. 17(3)(a) PCT and R. 40.3 PCT this fee has to be paid within a specified time limit it follows that the statement must also be submitted within the same time limit.

In **W 4/87** (OJ 1988, 425) the board held that fees for additional inventions (see Art. 17(3)(a) PCT) paid within the prescribed time limit (obliging the EPO as International Searching Authority to draw up the international Search Report on those parts of the international application concerned with the said inventions) could not be refunded if the statement of grounds supporting the protest under R. 40.2(c) PCT was submitted late.

In **W 8/89**, **W 60/90**, **W 57/91** and **W 16/92** the board emphasised that an applicant who wished to pay the additional search fee under protest must submit a reasoned statement. A protest without sufficient reasoning would be rejected as inadmissible - without substantive examination by the board as to whether the invitation of the ISA had been properly reasoned. The reasoning must contain verifiable grounds indicating why the applicant considered unity of invention to be present. A mere statement to the effect that the international application met the unity requirement did not constitute a reasoned statement within the meaning of R. 40.2(c) PCT. Very brief statements of grounds would suffice only in exceptional cases (see **W 48/90**).

In **W 41/91** the board found that it was clear from the applicant's submissions that he disagreed with the ISA on one concrete point. To this extent, the applicant's response sufficed to meet the requirement of a reasoned statement under R. 40.2(c) PCT. The board stated that according to the established jurisprudence of the boards of appeal of the EPO, the substance and not the form of a submission was to be considered (see **J 24/82**, OJ 1984, 467).

In **W 16/99**, the board said the ISA's reasoning in its request for additional fees (Form PCT/ISA/206) indicated that citation (1) in the international search report suggested a lack of novelty or inventive step in Claim 1 of the international application. The applicant had not disputed this, but merely referred to statements in the description about advantages of the invention which did not take the cited prior art into account. He had said nothing about the identical or corresponding special technical features in which the contribution of the various solutions should be seen, especially with regard to citation (1). The board saw no reason to doubt the ISA's position on the disclosure in citation (1), and so concluded that the request for payment of four additional fees was in line with Art. 17(3)(a) PCT and R. 40.1 PCT.

2.3 Review of protests by a review panel

Where additional fees have been paid under protest, an EPO review panel will review whether the invitation to pay these fees was justified. The review panel consists of the head of the directorate from which the invitation was issued, an examiner with special expertise in unity of invention and, normally, the examiner who issued the invitation.

If the review panel finds that the invitation was justified, it will inform the applicant accordingly and invite him to pay a fee for the examination of the protest by the board of appeal ("protest fee") if he wishes the protest to be referred to the board of appeal for decision. The protest fee must be paid within a time limit of one month from the date of notification of the result of the review. If the protest fee is not paid in due time, the protest will be considered withdrawn. If the board of appeal finds that the protest was justified, the additional fee(s) and the protest fee will be refunded.

For details see the Decision of the President of the EPO dated 25.8.1992 and the Notice from the EPO dated 26.8.1992 (OJ 1992, 547).

2.4 Review of protest by a board

2.4.1 Additional reasons given by the review panel

In **W 11/93** the EPO, acting as ISA, had issued an invitation to pay three additional search fees, which the applicants paid under protest. The board found that the ISA's invitation under R. 40.1 PCT was invalid owing to lack of (sufficient) reasons. Under the new R. 40.2(e) PCT in conjunction with R. 104a(3) EPC (now R. 105(3) EPC), the ISA must carry out a review of the protest. The board also considered whether the reasons accompanying the "result of the review" might not be considered as making good the lack of reasons in the case of the invitation. In its decision, the board thoroughly scrutinised the **purpose and structure** of the new R. 40.2(e) PCT and considered whether, when notifying the results of the review in the event of the invitation's being upheld, there was any need at all to supply further reasons. It pointed out that prior review of the protest by the ISA was comparable to interlocutory revision under Art. 109 EPC in the case of an appeal (see also **W 4/94**, OJ 1996, 73). Furthermore, R. 40 PCT had been revised for reasons of general procedural economy. It would run counter to that object were the ISA to give **additional reasons** in the event of the invitation to pay's being upheld. With this decision, the board confirmed the case law developed in **W 4/93** (OJ 1994, 939).

In **W 5/94** the board held that in its examination of the protest against the invitation to pay an additional search fee, the board must not take into consideration any new reasons brought forward in the ISA's review of the justification for the invitation (R. 40.2 (c)(d)(e) PCT), particularly because any such new reasons could not have been considered by the applicant in his protest against the invitation and because the board's task, by letter of the law (R. 40.2(c) PCT, second sentence), was limited to the examination of "the protest" (see also **W 12/93**).

In **W 3/96** the board noted that, according to the case law concerning the analogous procedure for international preliminary examination (R. 68.3(e) PCT), new reasons may not be added when the result of the review is communicated (**W 4/93**, OJ 1994, 939). In this case, too, the subsequently presented reasons were not to be taken into account when assessing whether the invitation under R. 40.1 PCT was sufficiently substantiated and whether the protest was justified. The crucial issue was not whether the invitation could have been clearly substantiated, but whether clear reasons had in fact been given in the invitation under R. 40.1 PCT. The absence of such reasons meant that the invitation to pay failed to meet the requirements of R. 40.1 PCT and therefore offered no basis for refusing to reimburse the additional search fees which had been paid under protest.

2.4.2 Amendment of claims

In **W 3/91** the board held that the request for amendment of the claims could not be considered in the proceedings before it, because according to Art. 19(1) PCT any amendments of the claims after receipt of the International Search Report could only be filed with the International Bureau within a prescribed time limit. This left no room for the ISA or the board to accept amendments. However, the board believed that the request for amendment, ie that six certain probes should be deleted from claim 3, could be understood as a declaration that no search for these particular probes should be carried out by the ISA. The board considered this request to be in an auxiliary relationship to the request for a full refund of the fees.

In **W 3/94** (OJ 1995, 775) it was pointed out, with regard to the applicants' new claim 1 that the board had no power to examine unity on the basis of this new claim. The board's powers derived from Art. 154(3) EPC in conjunction with R. 40.2(c) PCT, which provided for the board to examine the protest. This, of course, it could only do on the basis of the documents available when the ISA issued its invitation to pay the additional search fees, as there was no provision for amendments during proceedings before the ISA. The replacement sheet could at best be regarded as indicating that the ISA should no longer search certain subject-matter. This was confirmed in **W 6/94**, where the board found that the invitation by the ISA to pay additional fees as well as the examination of the protest by the board under R. 40.2(c) PCT had to be based on the claims as originally filed. There was no opportunity for the applicant to amend the claim in the international phase until he had received the complete international search report (Art. 19(1) PCT).

2.4.3 Devolutive effect of protests

In **W 53/91** the EPO as ISA - applying the former protest procedure - invited the applicant to pay an additional search fee on 30.5.1991, followed on 1.10.1991 by a second invitation intended to replace the first one - against which the applicant had meanwhile (on 20.6.1991) filed a protest. He duly filed a protest against the second invitation too, and this the board was now hearing. The board's first ruling was that the provisions and principles of the EPC applied mutatis mutandis in protest proceedings, which therefore also had a suspensive and devolutive effect. The department of first instance had no power to amend, replace or cancel its own decision once that decision had been appealed. Noting this, the board also ordered that the search fee paid under protest be reimbursed.

In **W 1/97** (OJ 1999, 33) the board held that successive invitations to pay additional search fees could have the consequence that the question of unity of invention became pending at several instances at the same time. This would be in conflict with basic principles of procedural law which also applied in protest cases. Once a protest was filed, the EPO acting as ISA remained competent only for the prior review of the justification of the invitation already issued (R. 40.1(e) PCT). It was not entitled to raise the question of non-unity a second or even further times in the same search procedure. The board observed that this would be detrimental to the right of a party to have one and the same case decided in one set of proceedings, as well as his right not to be forced to seek legal redress in respect of the same case in several proceedings. It would also disregard the fact that the position to be taken by the board of appeal in its decision on the protest might become prejudicial for any further finding of non-unity.

2.5 Missed time limit for filing the protest

Art. 48(2) PCT requires every PCT contracting state to excuse, as far as that state is concerned, for reasons admitted under its national law, any delay in meeting any time limit, and allows such a state, so far as it is concerned, to excuse such delays for other reasons.

In **W 3/93** (OJ 1994, 931), the protest was first rejected as inadmissible by the board on the ground that it was filed too late, whereupon the applicant applied for re-establishment of rights. The board found that by analogy with the principles developed by the Enlarged Board of Appeal in decision **G 1/83** (OJ 1985, 60, reasons, 5 and 6) for interpreting the EPC, Art. 48(2) PCT should be construed to mean that in the event of a delay in meeting the time limit laid down in R. 40.3 PCT the same legal remedies are available as in the case of failure to observe other comparable time limits under the PCT or EPC (see also **W 4/87** (OJ 1988, 425, reasons, 7)). Thus, the provisions of Art. 122 EPC were applicable. As the communication notifying the appellant that the application did not meet the requirements of unity required an answer within thirty days of its date, but was not itself posted until one month **after** that date, it was clearly not possible for the appellant to comply with the time limit. The application for re-establishment was therefore granted. The board found that re-establishment of rights restores the legal situation to that existing prior to the decision which declared the protest inadmissible, ie it destroys the legal validity of the decision, which accordingly need not be set aside or amended.

D. The EPO acting as IPEA

1. Protest procedure

The requirement of unity of invention under the PCT applies equally to the procedure before the ISA and to the procedure before the IPEA according to Art. 17(3)(a) PCT and

Art. 34(3)(a) PCT, which is in conformity with the procedural separation of search and examination. Thus, the requirement of unity of invention under the PCT must in principle be judged by the same objective criteria by both the ISA and the IPEA (**G 1/89** and **G 2/89,** OJ 1991, 155 and 166). Under Art. 155(3) EPC the boards of appeal are responsible for deciding on a protest made by an applicant against an additional fee charged by the EPO, acting as IPEA, under the provisions of Art. 34(3)(a) PCT.

1.1 General issues

In **W 6/99** (OJ 2001, 196) the board ruled that the EPO, under the binding guidelines for international preliminary examination, could issue an invitation under R. 68.2 PCT only if the applicant failed to overcome the a posteriori non-unity objection raised by the IPEA in the first communication from the examining division. A desire to expedite proceedings by issuing the first such communication together with the invitation under R. 68.2 PCT could not justify departing from the procedure laid down in applicants' interests or make up for the lack of at least one first written opinion under R. 66.2 PCT prior to the invitation under Art. 34(3)(a) PCT in conjunction with R. 68.2 PCT (see also **W 13/99**).

1.2 Substantiation of invitation

In **W 2/93** the board noted that the invitation of the IPEA could not be considered as containing an acceptable reasoned statement setting out the grounds for the invitation. The reasons relied on were still those that the ISA had put forward in the invitation to pay additional fees issued pursuant to Art. 17(3)(a) PCT and R. 40.1 PCT. The applicant, in the light of the international search report, had submitted to the International Bureau of WIPO an amendment and the statement under Art. 19(1) PCT, and filed two replacement sheets as required by R. 46.5(a) PCT. It was clear that claim 1 before the IPEA was different from the one considered by the ISA. The board stated that, in these circumstances, an invitation relying on the same reasons as those which had been put forward by the ISA in its invitation could not be considered to fulfil the obligation to specify reasons laid down in R. 68.2 PCT.

In **W 4/94** (OJ 1996, 73) the board felt compelled, given the paucity of the IPEA's remarks, to comment on the issue of the obligation to specify reasons, even though the applicants had not expressly referred to this in their protest. The IPEA had established lack of unity with reference to three documents, ie a posteriori, and had maintained its finding unamended after review. Although the relevant remarks were not fully in accord with the PCT Preliminary Examination Guidelines, Chapter VI, 5.5 and 5.7 with reference to Chapter III, 7, the fact that in their protest the applicants had commented on an objection as to the novelty of the subject-matter of the invention according to claim 1 implied that the IPEA's remarks were understandable and not just mere assertion, and as a result the minimum criterion of the obligation under R. 68.2 PCT to provide justification could be seen as fulfilled. The board did not consider the obligation to be infringed if the determinative reason for the decision was identifiable, even though the reasons could be seen as insufficient or incorrect. In the board's opinion, EPO board of appeal case law adhered to this principle. A comparable approach could also be seen in decisions on protests, such as in **W 3/93** (OJ 1994, 931, reasons, 2.1).

In **W 12/94** the board noted that the reasoning given by the IPEA did no more than identify the content of the two sets of claims. However, the board stated that in a case as simple as the one in question, any further useful amplification of the reasoning was hardly possible. The board found the reasoning given by the IPEA sufficient.

1.3 Substantiation of protest

In **W 9/94** the EPO, acting as IPEA, informed the applicant that the application did not comply with the requirement of unity of invention for the reasons indicated. The sole argument in the statement accompanying the protest was to the effect that the contents of the claims were already contained in the original claims and therefore the set of claims had already been searched. The board observed that the appellant did not address the point at issue, and since the fact that the claims in question were searched cannot, on its own, constitute a reason for contesting a finding of lack of unity of invention by the IPEA, it followed that a protest statement which relied solely on pointing out this fact could not qualify as a reasoned statement for the purposes of R. 68.3(c) PCT. The same held true for the argument, which might be implicit in the protest statement, that the unitary character of the claims in question could be inferred from the fact that the ISA did not request an additional search fee. The board held that the decision of the ISA was not binding on the IPEA (see **G 2/89**, OJ 1991, 166, reasons, 8.1 to 8.2), and noted that in the matter of a finding of lack of unity of invention, both the ISA and the IPEA exercised discretion in borderline cases on whether or not to issue an invitation under Art. 17(3)(a) PCT or Art. 34(3)(a) PCT respectively. Because of the difference between the tasks of search and examination, it might in appropriate cases be proper for this discretion to be exercised differently by the respective authorities in relation to a given group of inventions. Thus a group of inventions might sometimes be searchable in full within the bounds of a normal case, while the examination of novelty, inventive step, industrial applicability, excluded subject-matter and clarity for each of the inventions might involve a cumulative effort well beyond such bounds.

In **W 4/93** (OJ 1994, 939) the board took the view that the applicant's right to communicate orally with the IPEA (Art. 34(2)(a) PCT) did not include the right to formal oral proceedings. The board added that an informal interview under R. 66.6 PCT usually served no purpose in protest proceedings under R. 68.3(c) PCT.

In **W 12/94** the board noted that the protest did not contain any reasoning but had to be read in the context of a letter in which the applicant's representative had set out its reasoning on the issue of unity, namely that as the search could be conducted without the effort justifying an additional fee, there was inherent unity. The board decided that in these circumstances the reasoning in the earlier letter had to be regarded as implicitly contained in the second, which dealt with exactly the same issue. It found that though the reasoning was totally unconvincing, it was nonetheless sufficient to qualify as "a reasoned statement" within the meaning of R. 68.3(c) PCT. The protest was therefore admissible.

In **W 2/00** the board found that the applicant had not given proper reasons for his protest, as required by R. 68.3 PCT. Under R. 68.3(c) PCT, the protest had to be accompanied by a reasoned statement to the effect that the application complied with the requirement of unity or that the amount of the required additional fee was excessive. According to the boards' case law, this meant that an applicant who believed that his application did not lack unity had to give specific reasons showing why he took that view (**W 16/92**, OJ 1994, 237). The appellant's letter contained no such reasons. It merely indicated his belief that the application did not lack unity. The board took the view that even if the words "we maintain our opinion" were taken to refer implicitly to some reason(s) given earlier, they did not amount to a reasoned statement within the meaning of R. 68.3(c) PCT.

1.4 Composition of a review panel

In **W 4/95** the applicants, in accordance with the PCT Preliminary Examination Guidelines (March 1993), Chapter VI, 5.7, filed a "reasoned statement" under R. 68.3(c) PCT after receiving the result of the preliminary examination. In particular, the applicants objected to the composition of the board responsible for examining the protest under the latter rule, on the grounds that one of its members was the examiner who had issued the opinion which was the subject of the original protest; under R. 68.3(d) PCT, this was not permissible. The board explained that R. 68.3(d) PCT referred to the examination of the protest itself and not to the "prior review" procedure mentioned in R. 68.3(e) PCT. Paragraph (d) specifically referred to the three-member board mentioned in paragraph (c). Under Art. 155(3) EPC in conjunction with Art. 34(3)(a) PCT, this body was the board of appeal for the EPO acting as IPEA. Neither the PCT nor its Implementing Regulations contained any provision as to who should carry out the prior review mentioned in paragraph (e). However, Chapter VI, 5.7, of the PCT Preliminary Examination Guidelines indicated that the review was not to be entrusted solely to the examiner responsible for the preliminary examination, although that examiner was allowed to sit on the three-member board.

1.5 Review of protests

W 4/93 (OJ 1994, 939) dealt for the first time with the new procedure for reviewing protests against invitations to pay additional fees for the international preliminary examination in the case of lack of unity of the invention. The board decided that the examination stipulated in R. 68.3(e) PCT of the justification for charging an additional fee should only be carried out on the basis of grounds stated in the invitation to pay the additional fee and that the facts and arguments submitted by the applicant in his grounds of protest should also be included. This **precluded the subsequent inclusion** of new grounds and evidence when communicating the result of this review. The board had to confine itself in its decision to examining the protest and the invitation to pay (confirmed in **W 11/93**).

In **W 4/94** (OJ 1996, 73), regarding the extent of the notification of the result of the review under R. 68.3(e) PCT, the board noted that the wording of the rule, in contrast to the "invitation to restrict or pay" in R. 68.2 PCT, first sentence, stipulated only that a result be notified and did not expressly mention any obligation to give reasons. The corresponding PCT Preliminary Examination Guidelines on implementing this rule in Chapter VI, 5.7, also stipulated a technical reasoned statement only where the review produced a negative result, ie where the facts in the invitation under R. 68.2 PCT were not confirmed. The board therefore took the view that, where the review body reached the conclusion that the arguments put forward in the protest did not necessitate any further discussion on the technical and/or patent law issues involved, ie did not lead to any new assessment of the facts, the phrase "... doit indiquer les raisons techniques de ce résultat ..." or "... will give a technical reasoning of that result" did not mean that it is automatically incorrect merely to refer back to the reasons given in form PCT/IPEA/405. The review under R. 68.3(e) PCT could also be compared with interlocutory revision in accordance with Art. 109 EPC, which did not stipulate any separate obligation to provide justification.

1.6 Additional fees - partial reimbursement

In **W 4/95** the EPO, acting as IPEA, had issued an invitation under Art. 34(3)(a) PCT and R. 68.2 PCT. The applicants had filed a protest, claiming that the amount of the requested additional fee was too high. Under R. 68.3(c) PCT, second sentence, the "total or partial reimbursement of the additional fee" could be ordered if the protest was found to be justified (see also the German wording and the French version, which deviates from the English by referring to "des taxes additionnelles"). In the applicants' view, this constituted a basis for paying back only a fraction of a single fee.

The board explained that Art. 34(3)(a) PCT and R. 68.2 PCT referred to several fees. The reason for this was that an application failing to comply with the requirement for unity of invention could cover more than one additional invention (see PCT Preliminary Examination Guidelines, Chapter VI, 5.5). Moreover, R. 68 PCT referred to Art. 34(3)(a) PCT; since both passages were clearly concerned with the same fees, R. 68.3 PCT had to be brought into accord with Art. 34 PCT and R. 68.2 PCT. In the board's view, therefore, a "partial reimbursement" should be taken to mean a reimbursement of some additional fees (but not all of them). A "partial reimbursement" could only be made if at least two additional fees had been paid. The reimbursement of a fraction of a single fee was not provided for under the PCT.

E. The EPO as designated or elected Office

The EPO may be a "designated Office" or an "elected Office" for an international application made under the Patent Cooperation Treaty (PCT). The application is then deemed to be a European application (Euro-PCT application) for the purposes of the EPC. In the case of Euro-PCT applications the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, the provisions of the PCT prevail.

In **J 26/87** (OJ 1989, 329) the international application had been published by the International Bureau without mentioning Italy as designated state. The question to be decided by the board was whether or not Italy was designated in the international application, i.e. whether or not the appellant had informed the receiving Office (the Australian Patent Office) in the international application that he wished to obtain a European Patent for (inter alia) Italy. The board noted that the answer to this question depended entirely upon the proper interpretation of the "request for grant" form (Form PCT/RO/101). The Receiving Section had held that Italy was not requested as a designated State in this form. The board came to the conclusion that if, on the proper interpretation of the request for grant of an international application, an applicant has designated an EPO contracting state for which the PCT is in force, the EPO is bound by the provisions of Art. 153 EPC to act as the designated Office for that contracting state, even if the international application has been published by the International Bureau without mentioning that contracting state as a designated state.

In **J 7/93** the International Bureau did not inform the EPO of its election as an IPEA within the 21-month time limit under R. 104b(1) EPC. At the end of this period the EPO therefore issued a communication pursuant to R. 85a EPC requesting payment of the fees to be paid under R. 104b EPC, unaware that the extended time limit of 31 months under Chapter II PCT was applicable. However, the fees were not paid within the 31-month time limit and a request for re-establishment of rights was filed. In the meantime, the EPO had issued a notification pursuant to R. 69(1) EPC indicating that the application was deemed to be withdrawn. This notification again referred to the 21-month time limit, the EPO still being unaware of its election. The Receiving Section went on to reject the request for re-establishment on the ground that re-establishment was excluded under Art. 122(5) EPC in respect of the time limits for paying fees pursuant to R. 104b(1)(b)(c) EPC (following **G 3/91** (OJ 1993, 8)). The board held that the communication pursuant to R. 85a EPC and the notification pursuant to R. 69(1) EPC were legally non-existent because they could not be based on any provision in the EPC or the PCT. Thus, the reasons for which the party refrained from acting upon them were irrelevant as the communications could have no legal effect to the party's detriment. Further, according to R. 85a EPC, the fees could still be paid with a surcharge within a period of grace of one month of notification of the failure to observe the time limit. As no such communication had been sent and the party had paid the fees and the surcharge, the proceedings for re-establishment were not necessary. The fact that the EPO continued the proceedings for, and finally refused, re-establishment of rights without taking into account the fact that these proceedings were unnecessary from the very beginning amounted to a substantial procedural violation.

A decision of an **examining division** of 5 June 1984 (OJ 1984, 565) pursuant to Art. 153(2) EPC in conjunction with Art. 25 PCT and Art. 24(2) PCT concerned the authority of a designated Office under Art. 24(2) PCT to maintain the effect of an international application. The applicant had missed the time limit for filing the authorisation for the representative set by the Japanese Patent Office acting as receiving Office.

The EPO, acting as designated Office, excused the non-observance of time limits which had been set by the receiving Office for the correction of formal deficiencies in accordance with Art. 14(1)(b) PCT in conjunction with R. 26.2 PCT (Art. 24(2) PCT and Art. 48(2)(a) PCT). The examining division found that the time limit under R. 26.2 PCT was to be compared with time limits set by the EPO under Art. 121 EPC and granted re-establishment of rights according to Art. 122 EPC in respect of the time limit under Art. 121(2) EPC.

In **J 3/94** the applicant **designated** in an international application under the heading "Regional Patent" the European patent and under the heading "National Patent" five contracting states to the PCT, including the EPC contracting states Germany and the

United Kingdom. However, in the demand for international preliminary examination, which was filed with the EPO in its capacity as IPEA, only the five PCT member states were **elected**; under the heading "Regional Patent" there was no cross indicating the European patent. The applicant subsequently submitted that the failure to elect the EPO resulted from a mistake when the demand for international preliminary examination was filed. He argued, however, that the time limit under R. 104b EPC had actually been observed because the election of contracting states to the EPC under the heading "National Patent" (GB and DE) also had the consequence that the EPO became an elected Office even if no cross was placed in the box for indicating the European patent. The applicant submitted that his actions were sufficient to cause the EPO to be deemed an elected Office by operation of law.

The board pointed out that Art. 31(4)(a) PCT, last sentence, stipulated that an election could relate only to contracting states already designated under Art. 4 PCT. With regard to a state providing for national and regional patents, this meant that an election concerning the national grant procedure was only possible if there was a designation indicating that the applicant wished to obtain a national patent. Likewise, an election concerning the regional grant procedure was only possible if there was a designation indicating that the applicant wished to obtain a regional patent. Since each type of election had effects on different grant proceedings, it appeared that the declaration to use the results of the international preliminary examination in national grant proceedings was different from the declaration to use them in European grant proceedings. The board found that the correspondence of designations and elections, as laid down in Art. 31(4)(a) PCT, last sentence, applied two principles: first, an election could not cover a designation which was not made when the application was filed and, second, it was up to the applicant for which office he intended to use the results of the international preliminary examination. The validity of the election had to be decided by the authorities concerned during the international phase in order to give effect to the election and had to be assessed on a uniform basis by the authorities concerned. This was apparently in agreement with the consistent practice under the PCT. The EPO as elected or designated Office is fully competent to interpret applications appointing it to act in these capacities. Accordingly, the Office is not bound by the interpretation of the receiving Office or of the International Bureau (**J 26/87** (OJ 1989, 329), **J 19/93**).

In **J 4/94** the board had to consider whether the EPO was competent to interpret the applicant's demand for international preliminary examination differently from the United Kingdom Patent Office acting as IPEA. The board conceded that the demand was addressed to the IPEA, which was the competent body for dealing with it. However, the board referred to **J 26/87** (OJ 1989, 329), in which it was decided that the interpretation of the request for grant form by the receiving Office and International Bureau was not binding on the EPO in its function as designated Office. The valid designation put the matter within the competence of the EPO as designated Office (Art. 2(xiii) PCT and Art. 153(1) EPC). In deciding on the present case, the board deviated from the interpretation by the IPEA. It found that there was a defect in the demand, which the applicant should have been invited under R. 60 PCT to correct. It held that a clear deviation by the IPEA from the intention expressed in the demand was not binding on the EPO. It was, therefore, possible for the EPO to regard itself as a validly elected Office. The consequence of this was that under R. 104b(1) EPC the time limit of 31 months applied.

In **J 19/93** the board held that the designation of states in the PCT request form for the purpose of obtaining a European patent could only be corrected if expressly requested, and if it was proved that an error had been made by the applicant.

In **J 17/99** the EP designation in an international application had not been confirmed within fifteen months as from the priority date as required by R. 4.9(c) PCT. It was therefore to be deemed withdrawn by the applicant at the end of that period (R. 4.9(b)(ii) PCT and Art. 24(1)(i) PCT). Consequently, the international application's effects under Art. 11(3) PCT - ie those of a European filing - ended on that date.

The board pointed out that the designated Office was not bound by the views or actions of the authorities involved in the application's international phase. On the contrary, in exercising that discretion in the present case the EPO had to apply the same rules and principles as for identical or comparable situations arising with direct European applications. This non-discriminatory approach was not only a fundamental principle of the PCT itself (see, for example, Art. 26 PCT and Art. 48(2)(a) PCT) but also a direct consequence of Art. 150(3) EPC. It followed from this that the fairly strict approach taken by the Legal Board of Appeal to correcting designations also applied to Euro-PCT applications - see also **J 3/81** (OJ 1982, 100) with its ruling that Euro-PCT applicants could not claim, under Art. 26 PCT, broader rights than those available under the EPC to EP applicants. **J 3/81** laid down that if a mistake was made in designating states in a European or Euro-PCT application, then a request to correct it by adding a further designation must generally be refused, in the public interest, if made too late for a notice about it to be added to the application as published. This general rule applied to a Euro-PCT application even if its publication by the International Bureau necessarily preceded the date on which the applicant could ask the EPO to correct it. It followed that the request for correction under Art. 24(2) PCT in conjunction with R. 88 EPC could not be allowed.

X. INSTITUTIONAL MATTERS

The Presidents of the German Patent Office (GPO) and the EPO entered into an Administrative Agreement on 29.6.1981 concerning the filing of documents and payments (OJ 1981, 381). According to Art. 1 of this Agreement, documents and payments filed with the GPO, but addressed to or intended for the EPO, are treated as if they had been received by the EPO on the day of actual receipt by the GPO.

In **G 5/88, G 7/88** and **G 8/88** (OJ 1991, 137) the Enlarged Board of Appeal considered the validity of this Administrative Agreement. The board reached the conclusion that the power of the President of the EPO to enter into such agreements could not be derived from Art. 5(3) EPC, which states that he represents the European Patent Organisation; the President's capacity to represent the European Patent Organisation was merely one of his functions. The extent of the President's power to enter into agreements was rather to be derived from other provisions of the EPC, in this case Art. 10(2)(a) EPC, according to which the President must take all necessary steps to ensure the functioning of the EPO.

It was held that an agreement concerning the treatment of misdirected documents involved a necessary step to ensure the functioning of the EPO for the following reason: the misdirection of papers led to the risk of loss of rights, as a result of failure to meet a time limit, caused by the late receipt of documents. The Administrative Agreement between the EPO and GPO was therefore found to be valid to the extent that the possibility of confusion regarding the filing offices of both Offices actually existed; this potential for confusion existed in Munich.

However, as far as the EPO sub-office in Berlin was concerned, there was no basis for such a regulation until 1.7.1989. Before this date the sub-office in Berlin was not a filing office, nor was a letter-box installed. As far as documents and payments which reached the EPO via the GPO's office in Berlin were concerned the Administrative Agreement was invalid. However, the Enlarged Board of Appeal applied the principle of good faith in favour of the opponent, who had filed a notice of opposition against a European patent via the Berlin office of the GPO, relying on the Agreement published in the Official Journal.

The same danger of confusion has existed in Berlin as in Munich since the opening of the EPO's Berlin filing office on 1.7.1989. On 13.10.1989, the Administrative Agreement between the Presidents of the two Patent Offices was adapted to the new situation (see OJ 1991, 187).

In **T 485/89** (OJ 1993, 214), the board held that a notice of opposition filed by fax at the GPO in Munich on the last day of the opposition period and forwarded to the EPO the next day was admissible; the opposition fee had already been paid some days earlier. Oppositions filed within the prescribed time by fax at the GPO in Munich while intended for the EPO were covered by the Administrative Agreement of 29.6.1981 and should be treated by the EPO as if it had received them directly, irrespective of whether or not they had been wrongly delivered.

In 1994, in accordance with Art. 33(1)(b) EPC, the Administrative Council amended R. 71 EPC by adding further provisions to R. 71a EPC, inter alia to the effect that a communication must be issued by the EPO at the same time as a summons to oral proceedings is issued (OJ 1995, 409). In contrast to this requirement of R. 71a(1) EPC, Art. 11(2) RPBA leaves it to the discretion of the boards of appeal whether or not to send a communication with such a summons. In **G 6/95** (OJ 1996, 649) the Enlarged Board held that R. 71a(1) EPC did not apply to the boards of appeal. This interpretation of R. 71a(1) EPC with regard to the boards was based on the consideration that Art. 23(4) EPC and Art. 33(1)(b) EPC provided two distinct and separate sources of legislative competence or power.

The Enlarged Board pointed out that Art. 23(4) EPC states that the RPBA "shall be adopted in accordance with the provisions of the Implementing Regulations". In the view of the Enlarged Board this was clearly directed to the mechanism set out in R. 11 EPC, which states that the authority referred to in R. 10(2) EPC (the "Praesidium") "shall adopt" the RPBA. The Enlarged Board concluded that the power under Art. 23(4) EPC to amend the RPBA belonged to the Praesidium of the boards of appeal, subject to the approval of the Administrative Council. Considered in the light of the principle of judicial independence, which Art. 23(3) EPC embodied, the mechanism for adopting the RPBA through the Praesidium of the Boards of Appeal pursuant to Art. 23(4) EPC acquired its full value and showed that the above principle extended to the procedure which was either preparatory to or otherwise related to the making of such decisions.

The Enlarged Board further stated that, according to Art. 33(1)(b) EPC, the Administrative Council was competent to amend the Implementing Regulations. There were obviously limits to the exercise of its powers, however. The Administrative Council was not entitled to amend the Implementing Regulations in such a way that the effect of an amended rule would be in conflict with the EPC itself (Art. 164(2) EPC). The Enlarged Board held that according to the proper interpretation of R. 71a(1) EPC, its mandatory procedural requirements were applicable to the first-instance departments of the EPO, but were not applicable to the boards of appeal. If R. 71a(1) EPC were to be interpreted as applying to all departments of the EPO, including the boards of appeal, its effect would be directly contradictory to and in conflict with the effect of Art. 11(2) RPBA which was adopted pursuant to Art. 23(4) EPC as the emanation of the independence of the boards of appeal. However, the Administrative Council must be presumed to know the limits of its own power. It was therefore reasonable to assume that the Administrative Council did not intend to amend R. 71 EPC so as to provide a conflict with a Rule of Procedure of the Boards of Appeal which it had itself previously approved.

Table of cases

Decisions of the technical boards of appeal

Index of cited provisions

1. European Patent Convention

2. Implementing Regulations to the EPC

3. Rules relating to Fees (RFees)

4. Patent Cooperation Treaty (articles and rules)

PCT Articles

PCT Regel

5. Regulation on the European qualifying examination for professional representatives

6. Regulation on discipline for professional representatives

7. Rules of Procedure of the boards of appeal

General Index