

Key to the European Patent Convention
Edition 2011

Part VI

PART VI - APPEALS PROCEDURE

Article 106ⁱ - Decisions subject to appeal

(1) An appeal shall lie from **decisions**¹ of the **Receiving Section**², Examining Divisions, **Opposition Divisions**³ and the Legal Division. It⁴ shall have **suspensive**⁵ effect.

(2) A decision which **does not terminate**⁶ proceedings as regards one of the parties can only be appealed **together**⁷ with the **final decision**⁸, unless the **decision**⁹ **allows**¹⁰ a separate **appeal**¹¹.

(3) The right to file an appeal against decisions relating to the apportionment or fixing of costs in opposition proceedings may be restricted in the Implementing Regulations.

Ref.: Art. 104 R. 63, 65, 68, 90

PCT: R. 82ter

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1. decisions [A106(1)]

G0005/91 [T0479/04]

Composition of the opposition division, partiality.

Under the EPC is no legal basis for separate appeal against 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 opposition division could however be challenged on such a ground in an appeal against its final decision or against a separately appealable interlocutory decision under article 106 (3) EPC.

D0015/95 [D0028/97, D0001/98, D0023/99, D0024/99, D0009/03, D0025/05]

Of the Disciplinary Committee.

Appealability of a Disciplinary Committee decision dismissing a complaint. A Disciplinary Committee decision dismissing a complaint is a decision in the legal sense only as regards the professional representative concerned and the Presidents of the epi and EPO, and only they can appeal against it. Thus the person who made the complaint has no right of appeal, and any appeal he does file is irreceivable.

J0017/04

Appellant's actual intentions and facts submitted.

Ambiguity of the waiver. Omission to issue the reminder pursuant to Rule 85a(1) EPC.

Admissibility of the appeal with regard to appellant's actual intentions and facts submitted by the appellant. Procedural violation caused by non-observance of the incompleteness of a form. Ambiguity of a pre-printed text in a form.

J0012/04

Refusal of a priority date. Fax transmission.

Refusal of a priority date for a European patent application. Fax transmission interruption.

J0016/03

Statement that the procedure is closed.

Withdrawal of the international application or a designation. Discretion of the EPO to treat the application as a pending European application.

Reasoned statement by the Receiving Section, that the application concerned will not be processed further and that the procedure is closed.

Error of law as to the scope of the discretionary power of the EPO.

ⁱ See opinions/decisions of the Enlarged Board of Appeal G 1/90, G 1/99, G 1/02, G 3/03.

J0014/00 [J0019/00, J0009/04, J0002/05]

Extension Agreement.

The extension of European patents to Slovenia is determined by the Extension Ordinance on the extension of European patents to Slovenia (EO) alone; the provisions of the EPC apply only where it is expressly mentioned in the EO.

J0038/97 [T1101/99]

No competence of DG2 director to decide on inspection of file. Inadmissible appeal.

Technical opinion not open to public inspection.

J0011/87 [T0252/91, T0691/91]

Also interlocutory revision.

J0012/85 [J0017/04, T0114/82, T0115/82]

Not a request for a correction based on rule 89 EPC.

The Boards of Appeal cannot examine a request for a correction, based on Rule 89 EPC, of the decision under appeal. A decision on this request must be first rendered by the Examining Division before the matter can be referred to the Board of Appeal.

J0008/81 [J0026/87, J0013/92, J0043/92, T0222/85]

Depends on the substance, not upon its form.

A decision of the European Patent Office may be, but ought not to be, given in a document which in form appears to be merely a communication. Whether a document constitutes a decision or a communication depends on the substance of its contents, not upon its form.

T1349/08

Correction of decision to grant after mention of grant. Third party, even when opponent indirectly affected in opposition proceedings, has no party status in examination proceedings.

T1178/04 [T0293/03]

Ruling on transfer of opponent status.

Purported new opponent is a "party to proceedings". Proprietor not adversely affected by decision, not prevented from presenting arguments relating to validity of transfer of opponent status. *Reformatio in peius*. The duty of the European Patent Office to examine, *ex officio*, the status of the opponent at all stages of the proceedings extends not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party.

The doctrine of no *reformatio in peius* is of no application in relation to the exercise of such duty.

T1012/03

Not: Only an isolated point of law.

Summons to oral proceedings in The Hague.

T1063/02 [T0977/02]

Decision relating to the correction of a decision, of the minutes.

Rejected request for correction of a decision and the minutes. Decision communicated per fax. One of the members of the opposition division responsible did not sign the decision.

An appeal directed against a decision relating to the correction of a decision made by the first instance can be admissible.

T1147/01

Not: Merely a number of grounds of opposition had been decided in favour of the patentee. The first instance must have refused some request of the party appealing.

T0981/01

Obiter dicta not part of the decision itself.

T0054/00

Not: Provisional opinions, obiter observations, informal comments, etc..

Not: Appellant adversely affected by grant of his main request.

Distinguishing the decision proper from provisional opinions, obiter observations, informal comments, etc..

T0009/00

Doubt over whether the decision was taken by the competent department. No original document bearing signatures.

The files do not include any original document bearing signatures of the persons charged with taking the decision. However, doubt over whether any such decision was taken and therefore actually exists does not rule out an appeal under Article 106 EPC. The issue of whether the decision was taken by the competent department must be examined in the context of the appeal's merits and has no impact on its admissibility.

T0231/99

Not: Correction to the minutes made ex officio.

Correction to the minutes; no request before the first instance.

The correction to the minutes of oral proceedings made by the Opposition Division of its own motion cannot be challenged directly with the appeal.

T0473/98 [T0915/98, T0725/05]

Not: Obiter dicta in the revocation decision.

I. 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 Article 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.

II. An opponent is not adversely affected by such findings favourable to the proprietor included in a revocation decision nor is the proprietor as sole appellant protected against a reformatio in peius in respect of such findings.

The mere fact that in the present case such findings were somewhat misleadingly referred to in the pronouncement as "further decisions" "included" in the decision proper did not, in the judgement of the board, constitute a substantial procedural violation.

T0142/96

Decision on rectification also.

Legal and factual issues considered to be well founded. Admissibility of appeal against a decision on rectification.

T0611/90 [T0736/01]

Not grounds of decisions

Under Article 106(1) EPC, appeals lie from decisions rather than from the grounds of such decisions. Apart from other deficiencies, an appeal raising a case entirely different from that on which the decision under appeal was based is still admissible if it is based on the same opposition ground.

T0073/88 [T0169/93]

Not against reasoning in the decision which was adverse to him.

If a patentee in opposition proceedings has had his request that the patent be maintained upheld by the Decision of the Opposition Division, he may not file an appeal against reasoning in the Decision which was adverse to him (here: his claim to priority), because he is not adversely affected by the Decision within the meaning of Article 107 EPC.

1.1. Decisions of the Boards of Appeal

G0001/97 [T0365/09]

Not: Revision of a final decision taken by a board of appeal.

T0315/97 [T0609/03, T0431/04]

New Article 112a EPC is not open to provisional application under Article 6 of the Revision Act. Conversion.

T0843/91 [T0304/92, T0296/93, T1895/06]

Not: Decisions of the Boards of Appeal.

The Boards of Appeal are the final instance and their decisions become final once they have been delivered, with the effect that the appeal proceedings are terminated.

Rejected retrial against a decision of the Board of Appeal in application of Article 125 EPC.

1.2. Notice, communication

J0024/01

Determine whether a document issued is a communication or a decision.

It is the contents which determine whether a document issued by the EPO is a communication or a decision.

A second appeal against a decision is devoid of any object and accordingly inadmissible.

J0015/01

Appeal against a communication is inadmissible.

J0024/94

Not a letter of the juridical department.

A letter of the juridical department whose aim is the information of the grantee concerning a final decision of a Board of Appeal is not an appealable decision.

J0002/93

Not a letter signed by a Vice-President of the EPO.

A letter bearing the letterhead of a Directorate-General and signed by a Vice-President of the EPO is not subject to appeal under Article 106 EPC when 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 instances listed in Article 21(1) EPC.

J0013/83

Rule 69(1) communication is not an decision subject to appeal.

T0165/07

Decision by communication of formalities officer. Ultra vires.

T1181/04 [T1255/04, T1474/05, T1226/07]

Communication under Rule 51(4) EPC. No opportunity to express disapproval.

I. The applicant's approval of the text proposed for grant by the Examining Division is an essential and crucial element in the grant procedure and its existence or non-existence needs to be formally ascertained.

II. The applicant must be given the opportunity to express his disapproval of the text proposed for grant by the Examining Division with a communication under Rule 51(4) EPC and to obtain an appealable decision refusing his requests. If he has been deprived of this possibility a substantial procedural violation has occurred in the proceedings.

T0263/00

Not: Communication of the opposition.

A decision of the opposition division "to end the ex-parte proceedings" is not foreseen in the EPC.

The communication of the opposition division inviting the respondent to rectify deficiencies of the notice of opposition as well as the respondent's reply to it had not been notified to the appellant. The procedural violation was remedied on request of the appellant by sending copies of the relevant documents.

T0934/91

Not every communication entitled a "decision".

1. Boards of Appeal have the power to apportion and also to fix costs: Articles 104(1) and (2) and 111(1) EPC, having due regard to Article 113(1) EPC.

2. Their decisions are res judicata and final.

3. A communication by the first instance despite being entitled a "decision", and having the sole effect of informing a party of the points listed above does not rank as a "decision" for the purposes of Article 106(1) EPC. An appeal against such an act is therefore inadmissible.

T0087/88

Not: The Search Division's communication in the case of a lack of unity

The Search Division's communication in the case of a lack of unity is not an appealable decision.

T0005/81

Not preparatory measures.

An appeal may relate only to a decision subject to appeal within the meaning of Article 106 (1) and not to the preparatory measures referred to in Article 96 (2) and Rule 51 (3).

2. Receiving Section [A106(1)]

J0010/04

Decision under Rule 82ter.1 PCT.

Receiving Section should have heard the witness personally in order to evaluate the credibility.

3. Opposition Divisions [A106(1)]

G0001/02

Formalities officers.

Entrustment to formalities officers of certain duties normally the responsibility of the Opposition Divisions of the EPO. Provisions of a higher level.

Points 4 and 6 of the Notice from the Vice-President Directorate-General 2 dated 28 April 1999 (OJ EPO 1999, 506) do not conflict with provisions of a higher level.

T1062/99

Rejecting as inadmissible. Formalities officer.

Rejecting the opposition as inadmissible. Formalities officer acting in the opposition procedure.

4. It [A106(1)]

T1382/08

Extent constitutes the limit of the devolutive effect.

The extent, defined according to Rule 99(2) EPC, to which the impugned decision is to be amended constitutes at the same time the limit of the devolutive effect of the appeal.

T0304/99

Conditional withdrawal of the appeal. Abolition of the suspensive effect.

Conditional withdrawal of the appeal. Abolition of the suspensive effect of the appeal by such a withdrawal. Authority of the Board after complete deletion of the sole contested patent claim.

W0053/91

Suspensive effect of protest, amended invitation against which the protest was lodged is null and void ab initio.

Protest cases are to be considered and treated as appeals within the framework of the provisions of the EPC on appeals and appeals procedure, provided that no conflict arises between the two treaties.

Given the analogy between protests under the PCT and appeals under the EPC, an invitation against which a protest has been lodged cannot validly be replaced by a second invitation.

5. suspensive [A106(1)]

J0001/05

Notification of a loss of rights under Rule 69(2) EPC.

J0028/03 [J0003/04, T1351/06, J0005/08]

Actions normally taking place after a decision are "frozen". Not: Cancellation of the decision.

Meaning of suspensive effect.

I. Suspensive effect means that the consequences following from an appealed decision do not immediately occur after the decision has been taken. Actions normally taking place after a decision are "frozen". Suspensive effect does not have the meaning of cancellation of the appealed decision. Even after an appeal the decision as such remains and can only be set aside or confirmed by the Board of Appeal.

II. The status of a divisional application filed while an appeal against the decision to grant a patent on the parent application is pending depends on the outcome of that appeal. Therefore, the department of first instance cannot decide on the question whether the divisional application has been validly filed until the decision of the Board of Appeal on the appeal is taken.

J0010/02

Suspension of proceedings.

Weighing up the interests. The entitlement proceedings only concern part of the invention. Duration of the suspension.

J0029/94

Also where only one designation is the subject of the appeal.

Deemed withdrawal of the application pursuant to Article 110(3) EPC applies in the case of a failure to reply to a communication pursuant to Article 110(2) EPC in ex parte appeal proceedings, even where the decision under appeal did not refuse the application, but only a particular request.

J0028/94 [J0033/95]

Mention of grant of a patent.

The suspensive effect of an appeal deprives the contested decision of all legal effect until the appeal is decided. Otherwise the appeal would be deprived of any purpose. Thus, in the event of appeal against a decision refusing to suspend publication of the mention of grant of a patent, publication must be deferred pending the outcome of the appeal.

If a suspension of publication proves impossible for practical reasons, the EPO must take appropriate steps to inform the public that the mention of grant was not valid.

T0135/98

Extension. Postponement of oral proceedings. Abuse of procedure.

Late-filed evidence not admissible: Appellant's silence for four months, knowing it would not be able to comply with a direction of the Board given in response to its own adjournment request.

Adjournment of the oral proceedings to conduct experiments.

Postponement of oral proceedings granted in favour of an appellant acts as an extension of the suspensive effect of an appeal.

T1229/97

Excluded from further opposition procedure.

T0001/92

Withdrawal of approval of text.

Withdrawal of approval of text of European patent not taken into account. Suspensive effect of appeal. Cancellation of mention of grant of European patent.

T0290/90

Opposition proceedings in parallel with the appeal proceedings.

In a multiple opposition, where an appeal has been filed concerning the existence or admissibility of one of the oppositions, the examination stage of the opposition proceedings should be prepared and processed in parallel with the appeal with the participation of all the opponents up to the point when it is ready to be decided: as soon as the appeal is decided, the opposition may also be decided.

6. does not terminate [A106(2)]

J0024/94

A letter of the juridical department.

A letter of the juridical department whose aim is the information of the grantee concerning a final decision of a Board of Appeal is not an appealable decision.

J0037/89

Extension of time limit rejected. Further processing. Reimbursement of the fee for further processing.

If a request for extension of a time limit filed in good time has been rejected under Rule 84, second sentence, EPC, and the applicant considers this unjust, the ensuing loss of rights can only be overcome by a request for further processing under Article 121 EPC. At the same time, he may request reimbursement of the fee for further processing. This secondary request will have to be decided on in connection with the final decision. Under Article 106(3) EPC, the decision on the secondary request can be appealed together with the final decision. The appeal may also be confined to contesting the decision on the secondary request.

J0013/83

Rule 69(1) communication is not a decision subject to appeal.

T0972/02 [T0101/03]

Interlocutory decision that the subject-matter was obvious.

T0263/00

Communication of the opposition.

A decision of the opposition division "to end the *ex parte* proceedings" is not foreseen in the EPC.

The communication of the opposition division inviting the respondent to rectify deficiencies of the notice of opposition as well as the respondent's reply to it had not been notified to the appellant. The procedural violation was remedied on request of the appellant by sending copies of the relevant documents.

T0087/88

The Search Division's communication in the case of a lack of unity

The Search Division's communication in the case of a lack of unity is not an appealable decision.

T0005/81

Preparatory measures.

An appeal may relate only to a decision subject to appeal within the meaning of Article 106 (1) and not to the preparatory measures referred to in Article 96 (2) and Rule 51 (3).

7. together [A106(2)]**J0037/89**

The appeal may also be confined to contesting the decision regarding the secondary request.

If a request for extension of a time limit filed in good time has been rejected under Rule 84, second sentence, EPC, and the applicant considers this unjust, the ensuing loss of rights can only be overcome by a request for further processing under Article 121 EPC. At the same time, he may request reimbursement of the fee for further processing. This secondary request will have to be decided on in connection with the final decision. Under Article 106(3) EPC, the decision on the secondary request can be appealed together with the final decision.

8. final decision [A106(2)]**T0857/06**

Second interlocutory decision.

A first interlocutory decision which does not allow a separate appeal can be appealed together with a second interlocutory decision which does not leave any substantive issues outstanding and which allows a separate appeal.

9. decision [A106(2)]**T0549/96**

Main and auxiliary requests before the Examining Division. No interlocutory decision.

No interlocutory decision, stating that the application in a certain version meets the requirements of the Convention.

T0247/85 [T0089/90]

Interlocutory decisions by which the patent was maintained in amended form.

W0024/01

Not: Refusal under Article 17(2) PCT to search the entire claimed subject-matter.

No judgement on refusal under Article 17(2) PCT to search the entire claimed subject-matter.

Article 17(2) PCT: Restricted to very exceptional cases, e.g. to cases of a clear abuse.

10. allows [A106(2)]**T0721/05**

Final decision maintaining the patent in amended form before the period for filing an appeal had expired. Ultra vires and null and void.

Filed translations according to the auxiliary request and payment of the fees. Not: Implicit withdrawal of the main request.

T0247/85 [T0089/90]

Interlocutory decisions by which the patent was maintained in amended form.

11. appeal [A106(2)]**T0376/90**

Not admitted.

Separate appeal is not admitted by the Opposition Division.

T0089/90 [T0055/90]

Appealable interlocutory decisions in the case of maintenance of the patent as amended.

The EPO's established practice of delivering appealable interlocutory decisions under Article 106(3) EPC

to maintain a patent as amended is both formally and substantively acceptable.

T0247/85

Late appeal against interlocutory decision.

Article 107¹ - Persons entitled to appeal¹ and to be parties to appeal proceedings

Any **party**² to proceedings **adversely affected**³ by a **decision**⁵ may appeal. **Any other**⁶ parties to the proceedings shall be parties to the appeal proceedings **as of right**⁷.

Ref.: R. 101, 111

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ⁱ See decisions of the Enlarged Board of Appeal G 1/88, G 2/91, G 4/91, G 9/92, G 1/99, G 3/99, G 3/03, G 2/04, G 3/04.

1. entitled to appeal [A107 Title]**G0003/99 [T0866/01]**

Joint opposition or joint appeal. Common representative. Withdrawal from the proceedings.

Admissibility of joint opposition or joint appeal. Duly signed, only one fee. Common representative. Withdrawal from the proceedings.

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

II. If the opposing party consists of a plurality of persons, an appeal must be filed by the common representative under Rule 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 Rule 100 EPC.

III. 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 common representative or by a new common representative determined under Rule 100(1) EPC in order for the withdrawal to take effect.

J0016/96

Change of party in ex parte appeal proceedings is allowable if serves useful function.

T1154/06 [G0003/99]

Several patentees.

Necessity of having a professional representative in the case of several patentees, when the first nominated does not have their residence in a Contracting State of the EPC.

T0552/02 [T0030/90, T0612/90, T1062/96, T1561/05]

General legal principle that all parties whose interests are related to the decision take part in the proceedings.

Participation of the opposing party in a procedure concerning re-establishment.

1) The granting of an application for re-establishment is of greatest importance for the respondent because it relates to the admissibility of the appeal itself and therefore the possibility of revising the decision of the

opposition division, i.e. the revocation of the contested patent.

2) The members of the board are not bound by any instructions and are only obliged to respect the provisions of the convention, which means that the board is not bound by the Guidelines for Examination.

T0543/99 [G0003/99]

Related companies.

Related companies filing opposition or appeal must each pay opposition or appeal fee.

T0590/98

Continued existence of the partnership, notwithstanding changes of both participating partners and of name.

T0353/95 [T0425/05, T0477/05, T0480/05]

Bankruptcy. Appellant lost capacity to be party to proceedings. Appeal terminated.

2. party [A107]**G0004/91**

Notice of intervention which is filed during the two-month period for appeal.

Proceedings before an Opposition Division are terminated upon issue of such a final decision, regardless of when such decision takes legal effect.

In a case where, after issue of a final decision by an Opposition Division, no appeal is filed by a party to the proceedings before the Opposition Division, a notice of intervention which is filed during the two-month period for appeal provided by Article 108 EPC has no legal effect.

J0028/94 [J0033/95]

Suspension of proceedings. Also the patent applicant.

The patent applicant is not heard in proceedings which lead to a decision regarding the suspension of the proceedings. He is party as of right to appeal proceedings initiated by the third party against rejection of his request.

J0001/92 [T0355/86, T0920/97]

Representative is not entitled to appeal in his own name.

T1349/08

Correction of decision to grant after mention of grant. Third party, even when opponent indirectly affected in opposition proceedings, has no party status in examination proceedings.

T0384/08

Transfer of opponent status refused by first instance, no res judicata. Prohibition of reformatio in peius not applicable.

T1178/04 [T0293/03, T1081/06]

Purported new opponent.

Proprietor not adversely affected by decision, not prevented from presenting arguments relating to validity of transfer of opponent status. Reformatio in peius. The duty of the European Patent Office to examine, ex officio, the status of the opponent at all stages of the proceedings extends not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party.

The doctrine of no reformatio in peius is of no application in relation to the exercise of such duty.

T0543/99 [G0003/99]

Related companies.

Related companies filing opposition or appeal must each pay opposition or appeal fee.

T0454/98

Appellant not identical with the opponent.

Appeal of a party not party to the opposition procedure.

T1229/97

Excluded from further opposition procedure.

T0019/97

Change of firm name in the course of the appeals procedure. Multiple legal assignment.

The change of firm name of the opponents in the course of the further appeals procedure is without legal importance for the admissibility of the appeal. Multiple legal assignment of the opposition's position. Contractual obligation to secrecy. Change of party not without formal knowledge of the Board and not with retroactive effect.

T0340/92 [T1150/02]

Not the parent company.

T0898/91

In the case of an inadmissible opposition until the decision on admissibility takes full legal effect.

In the case of inadmissible opposition the opponent is entitled to be a party to the opposition proceedings only until the decision on the admissibility of the

opposition takes full legal effect. If he has not filed an appeal against this decision, he is not entitled to be a party to opposition appeal proceedings of the patent proprietor.

2.1. Change of party

G0002/04

The status as an opponent cannot be freely transferred. Subsidiary.

Professional representative is deemed to be entitled to act.

I. (a) The status as an opponent cannot be freely transferred.

(b) A legal person who was a subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status as opponent if all its shares are assigned to another company.

II. If, when filing an appeal, there is a justifiable legal uncertainty as to how the law is to be interpreted in respect of the question of who the correct party to the proceedings is, it is legitimate that the appeal is filed in the name of the person whom the person acting considers, according to his interpretation, to be the correct party, and at the same time, as an auxiliary request, in the name of a different person who might, according to another possible interpretation, also be considered the correct party to the proceedings.

J0016/96

Change of party in ex parte appeal proceedings is allowable if serves useful function.

T0659/05 [T0426/06]

Doubt that the totality of the assets of a company had been transferred.

T0425/05

The original opponent company is dissolved without liquidation. Universal succession. Consecutive continuation of the mandate to represent and present the case.

The original opponent company could no longer claim legal existence for having been dissolved without liquidation.

Transfer of the party's quality by universal succession. Consecutive continuation of the mandate to represent and present the case.

T0293/03 [T1178/04, T1081/06]

Transfer of opponent status. Protection of legitimate expectations.

Transfer of opponent status was acknowledged by the opposition division.

T0413/02 [T0428/08]

Transfer. Date of receipt of the documentary evidence.

A new opponent does not obtain the status of opponent and party to the appeal proceedings until the moment when it submits evidence of the legal transfer justifying the transfer of the opponent status. Until the date of receipt of the documentary evidence of the transfer, the proceedings are conducted with the initial opponent and party to the proceedings. As long as evidence of the transfer is not produced, the initial party continues to have the same rights and obligations in the proceedings.

T0711/99 [T0503/03]

The opponent does not have the right to dispose freely of his status as a party.

I. The opponent does not have the right to dispose freely of his status as a party, following the general principle of law whereby legal actions are not transferable by way of singular succession - whether for a consideration or not - but only by way of universal succession. Once he has filed an opposition and met the requirements for an admissible opposition, he is an opponent and remains so until the end of the proceedings or of his involvement in them.

II. Opponent status may be transferred to a singular successor when a commercial department is sold, but this is an exception to the general principle in law whereby an opposition is not freely disposable.

III. This exception should be a narrowly interpreted and precludes an opponent parent company from being recognised, in the event of the sale of a subsidiary that has always been entitled itself to file oppositions, as having the right to transfer its opponent status, by analogy with an opponent who sells a commercial department that is an inseparable part of the opposition but is not itself entitled to file oppositions. The notion of legitimate interest in the proceedings, which is irrelevant for the admissibility of an opposition at the time of its filing, likewise has no bearing on the opponent's status at any subsequent stage.

T0656/98 [T0015/01, T0413/02]

Not: Transferee entitled to appeal before registration.

Not: Appeal validated by recordal outside appeal period.

Not: Correction under Rule 88 EPC.

Not: Rule 65(2) EPC applicable.

Effective date recited in the assignment document.

Legal fiction under which the transfer could be deemed filed in time.

For a transferee of a patent to be entitled to appeal, the necessary documents establishing the transfer, the transfer application and the transfer fee pursuant to

Rule 20 EPC must be filed before the expiry of the period for appeal under Article 108 EPC. Later recordal of the transfer does not retroactively validate the appeal.

The EPO cannot be deemed to take on the burden of spotting every possible action that a proprietor or unrecorded transferee should take in his own interest.

T0298/97

Transfer to two separate persons. Absence of evidence of a transfer of rights.

Party adversely affected not the party filing Grounds of Appeal. Commercial interest insufficient to remedy deficiency in admissibility.

I. If 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.

II. No provision having been made in the Implementing Regulations pursuant to Article 133(3), last sentence EPC, the EPC does not currently allow the representation of one legal person by the employee of another economically related legal person.

III. Save in the limited situation of a transfer of the right to oppose a European patent (or to appeal or continue an opposition appeal) together with the related business assets of the opponent's business, a commercial interest in revocation of such patent is not a requirement for being an opponent. Nor is possession of such a commercial interest sufficient to allow a successor in business to take over and conduct opposition or 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.

IV. (a) In the absence of such evidence, the transfer of an opponent's business assets to two separate persons cannot give either of them the right to take over and conduct opposition or opposition appeal proceedings.

(b) When such evidence is present, only the transferee established by such evidence can acquire such a right.

T0670/95

Mere declaration of a legal successor without submission of proof.

The transfer of opponent status had to be factually substantiated and proven; the firm named as successor could not acquire that status, and thus become party to appeal proceedings, simply by declaring it was the successor in title to the original opponent.

T0870/92

Change of party by succession in title without agreement of the other party.

Departments of a legal entity.

Change of party by succession in title without agreement of the other party.

Termination of the proceedings.

3. adversely affected [A107]

J0017/04

Appellant's actual intentions and facts submitted.

Ambiguity of the waiver. Omission to issue the reminder pursuant to Rule 85a(1) EPC.

Admissibility of the appeal with regard to appellant's actual intentions and facts submitted by the appellant.

Procedural violation caused by non-observance of the incompleteness of a form. Ambiguity of a pre-printed text in a form.

J0014/03

Not: Decision was quite simply the inevitable consequence of the appellant's own actions and inactions. Loss of priority.

No request, evidence or argument by appellant in first instance proceedings.

Decision was quite simply the inevitable consequence of the appellant's own actions and inactions, namely seeking a decision in the absence of any request while failing to make any case whatsoever.

Evidence available or obtainable prior to first instance decision but only filed on appeal.

J0007/00

Due to completion elsewhere only the reply to a question of law.

Owner's procedure for the return of his property. Date of suspension of proceedings to grant according to rule 13 EPC.

Admissibility of an appeal if, because of completion elsewhere, only the reply to a question of law can be made.

T1790/08

Clarify true identity of the opponent.

T0332/06

Not: Claims for DE identical with main request.

The appeal of the patent proprietor which was admissible at the time of filing the appeal became inadmissible on receipt of the statement of the grounds of appeal. In this statement the patent proprietor had contested only that part of the decision concerning the claims for the contracting state DE. The claims considered as allowable for DE by the opposition division in its interlocutory decision were however identical with the corresponding claims according to the main

request of the patent proprietor, which was only rejected in relation to the remaining contracting states. With reference to DE the patent proprietor was therefore not adversely affected.

T1474/05

Not: Appellant filed the requested translations and paid the printing and grant fees.

Legal fiction referred to in Rule 51(4) EPC.

T0721/05

Filed translations according to the auxiliary request and payment of the fees. Not: Implicit withdrawal of the main request.

Final decision maintaining the patent in amended form before the period for filing an appeal had expired. Ultra vires and null and void.

T0591/05

New prior art, filing of divisional application, and suspensive effect immaterial to the admissibility of appeal against decision to grant.

Not: Admissibility of appeal against decision to grant a patent.

New prior art document found after grant, filing of divisional application after grant, and suspensive effect of appeal immaterial to the admissibility of the appeal.

Not: Enlargement of the composition of the Board. No special circumstance or particular legal or factual issues.

T0537/05 [T0722/97]

No power to continue the examination of the opposition on further requests presented after the announcement of decision. Interlocutory decisions.

T0084/02 [J0017/04]

Not: Refusal to recognise the validity of the priority as such.

The refusal to recognise the validity of the priority as such, if it does not represent an obstacle to issuing a decision with respect to the requests of the appellant, cannot be placed in doubt on the basis of article 107 EPC.

The discussion on the right of priority right can be reopened before the national judge within the scope of a possible revocation action.

T1147/01

The first instance must have refused some request of the party appealing.

Not: Merely a number of grounds of opposition had been decided in favour of the patentee. The first instance must have refused some request of the party appealing.

T0824/00

Not: Withdrawal of all requests before the opposition division. Retraction of withdrawal on appeal.

Retraction of withdrawal on appeal by way of Rule 88 EPC correction not allowed.

I. A request under Rule 88 EPC for correction of a document filed at the EPO, the effect of which correction would be materially to breach principles representing the fundamental value of legal procedural certainty, should not normally be allowed. One such principle is that a competent first instance department of the EPO is empowered under Article 113(2) EPC to take a decision which terminates the first instance procedure on the basis of the ostensible final requests of the parties; a second such principle is that a party is not to be regarded as adversely affected within the meaning of Article 107 EPC by such a decision which grants his final request.

II. The statement in J0010/87 at point 12 of the reasons: "Legal certainty demands that the EPO can rely on statements of the parties in proceedings" pinpoints the precise procedural stage at which certainty prevails over intention and Rule 88 EPC reaches the limit of its applicability, viz. when a party statement is relied on in a formal juridical act.

T0054/00

Not: By grant of own main request. Distinguishing the decision proper from provisional opinions, obiter observations, informal comments, etc..

Improper pressure by opposition division to promote auxiliary request to main request.

Not: Appellant adversely affected by grant of his main request.

At least one request - the main request - which is clear, certain and unconditional.

Distinguishing the decision proper from provisional opinions, obiter observations, informal comments, etc..

T0613/97

Not: Withdrawal of the original main request.

Maintenance of the patent following an original auxiliary request, which after the withdrawal of the original main request became the final main request. Because the decision complies with requirements, the appeal does not conform to the requirements of the Article 107 EPC.

T0528/93 [T0506/91, T0168/99, T0386/04]

Not: Withdrawn version of an independent claim.

A version of an independent claim already withdrawn in the opposition procedure is not admitted in the opposition appeal procedure. Not adversely affected by the withdrawn version of an independent claim.

T0266/92 [G0009/92]

Withdrawal of the request for oral proceedings is not a implicit agreement with the expecting decision of the opposition.

T0073/88 [T0169/93]

Not simply reasoning in the decision which was adverse to him.

If a patentee in opposition proceedings has had his request that the patent be maintained upheld by the Decision of the Opposition Division, he may not file an appeal against reasoning in the Decision which was adverse to him (here: his claim to priority), because he is not adversely affected by the Decision within the meaning of Article 107 EPC. In the event of an appeal being filed by an opponent, however, if the patentee wishes to contend that such adverse reasoning was wrong, he should set out his grounds for so contending in his observations under Rule 57(1) EPC in reply to the statement of grounds of appeal, by way of cross-appeal.

T0244/85 [T0392/91]

Points in time of the issue of the decision and the filing of the appeal: Divergence between the decision and the (main-) request.

When at the points in time of the issue of the decision and the filing of the appeal a divergence exists between the decision and the (main-) request.

3.1. Opposition

T0961/00

Not: Withdrawn consent to the granted version.

A patent proprietor who has declared in opposition proceedings before the opposition division that he withdraws his consent to the granted version of his European patent and will not file an amended version (see also Legal Advice 11/82), is not adversely affected within the meaning of Article 107, first sentence, EPC by the decision of the opposition division revoking the European patent.

T0848/00

Not: Representative was not able to confer with his client.

Missing signature has no detrimental effect on the legal validity of the requests presented during the oral proceedings.

T0239/96

Keeping the granted claims as main request. Reformatio in peius.

Keeping the granted claims as main request. In the absence of a provision on cross-appeal, reformatio in peius cannot be ruled out altogether.

T0227/95

After remittal.

An opponent who did not appeal the first decision by the Opposition Division to reject the oppositions may still be considered adversely affected in accordance with Article 107 EPC by a second decision of that division (after remittal) maintaining the patent in amended form. Such an opponent is entitled to appeal said second decision, if he originally had requested the revocation of the patent in its entirety.

T0900/94 [T0373/96, T0065/97, T0564/98, T0168/99]

Not merely within the scope of the claims underlying the revocation.

Following revocation the patent proprietor is not adversely affected only to the extent of the claims on which the revocation was based. He may file broader claims with the notice of appeal.

T0273/90 [T0996/92, T0506/01]

Incomplete adaptation of the description.

Incomplete adaptation of the description to the claims amended in the course of the opposition proceedings.

T0457/89

Silence of a party concerning Article 101(2) and Rule 58(1) until (3).

Silence of a party on a communication pursuant to Article 101(2) and Rule 58(1) until (3) EPC does not lead to a loss of rights.

3.1.1. Opponents

G0001/88

Silence of the opponent on Rule 58(4).

The fact that an opponent has failed, within the time allowed, to make any observations on the text in which it is intended to maintain the European patent after being invited to do so under Rule 58(4) EPC does not render his appeal inadmissible.

T1147/01

Not: Merely a number of grounds of opposition had been decided in favour of the patentee.

The first instance must have refused some request of the party appealing.

T0833/90

Not clear and not ascertainable.

Not clear and not ascertainable, whether the opponent and appellant had agreed to maintenance of the patent.

T0156/90

Not: Formal consent of the opponent concerning the decision of the opposition, after that withdrawn.

T0299/89

In an opposition appeal only to the extent of the appellant's original request.

3.2. Formal Examination

J0005/79

Not: right of priority has been declared lost and has been restored before publication.

1. The applicant for a European patent whose right of priority has been declared lost for failure to file a copy of the priority document within the permitted 16-months period but whose right has been restored before publication of the European patent application is not thereafter adversely affected by the decision that the right had been lost.

2. Third party rights to continue use of an invention where an applicant's rights have been lost and restored cannot arise if the loss and restoration of the applicant's rights occur before publication of the European patent application.

T0549/93 [T0591/05]

Not: Opportunity for a divisional application lost.

Granting a patent is not only therefore adversely affecting because its a possible loss of rights with regard to the divisional application.

3.3. Auxiliary requests

T0054/00

Improper pressure by opposition division to promote auxiliary request to main request.

Not: Appellant adversely affected by grant of his main request.

T0506/91 [T0528/93, T0434/00]

Not in the case of withdrawal of the main requests.

Not in the case of withdrawal of the main requests and approval of the granted auxiliary request.

T0234/86 [T0392/91, T1105/96]

Auxiliary request allowed.

Rejection of requests preceding an auxiliary request, but the latter allowed.

3.4. Substantive examination

J0012/85 [J0017/04, T0114/82, T0115/82, T0953/96]

By a decision to grant only if such a decision is inconsistent with what he has specifically requested. Correction of errors in decisions of the first instance.

An applicant for a European patent may only be "adversely affected" within the meaning of Article 107 EPC by a decision to grant the patent if such a decision is inconsistent with what he has specifically requested.

J0012/83 [T1093/05, T0971/06]

Patent is granted in a text not approved by the applicant.

An applicant for a European patent may be "adversely affected" within the meaning of Article 107 EPC by a decision to grant the patent, if it is granted with a text not approved by the applicant in accordance with Article 97(2)(a) and Rule 51(4)EPC.

T0001/92

Withdrawal of approval; patent nevertheless granted.

Withdrawal of approval of text of European patent not taken into account

1. If, according to Rule 51(6) EPC, it cannot be established beyond doubt at the end of the time limit under Rule 51(4) EPC that the applicant approves the text in which the Examining Division intends to grant the European patent, the Examining Division cannot proceed to the grant of the patent and Rule 51(5) EPC applies.

2. The applicant is adversely affected in the sense of Article 107, first sentence, EPC if the patent is nevertheless granted.

T0793/91

Amendments in the sense of the examining division.

Amendments which are put forward by the examining division are only requested in the notice of appeal.

T0831/90 [G0007/93]

Not: Amendments of the claims filed after the Rule 51(6)-communication have not been taken into consideration.

Alleged telephone call to Examining Division cannot be considered as positive disapproval of the text in which Examining Division intends to grant the patent.

4. a [A107]

T1147/01

Not: Merely a number of grounds of opposition had been decided in favour of the patentee. The first instance must have refused some request of the party appealing.

5. decision [A107]

T0384/08

Transfer of opponent status refused by first instance, no res judicata. Prohibition of reformatio in peius not applicable.

T1178/04 [T0293/03]

Ruling on transfer of opponent status.

Purported new opponent is a "party to proceedings". Proprietor not adversely affected by decision, not prevented from presenting arguments relating to validity of transfer of opponent status. Reformatio in peius. The duty of the European Patent Office to examine, ex officio, the status of the opponent at all stages of the proceedings extends not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party.

The doctrine of no reformatio in peius is of no application in relation to the exercise of such duty.

T0981/01

Obiter dicta not part of the decision itself.

T0231/99

Not: Correction to the minutes made ex officio.

Correction to the minutes; no request before the first instance.

The correction to the minutes of oral proceedings made by the Opposition Division of its own motion cannot be challenged directly with the appeal.

T0473/98 [T0915/98, T0725/05]

Not: Obiter dicta in the revocation decision.

I. 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 Article 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.

II. An opponent is not adversely affected by such findings favourable to the proprietor included in a revocation decision nor is the proprietor as sole appellant protected against a *reformatio in peius* in respect of such findings.

The mere fact that in the present case such findings were somewhat misleadingly referred to in the pronouncement as "further decisions" "included" in the decision proper did not, in the judgement of the board, constitute a substantial procedural violation.

T0142/96 [J0032/95]

Decision on rectification.

Legal and factual issues considered to be well founded. Admissibility of appeal against a decision on rectification.

T0073/88

Not simply reasoning in the decision which was adverse to him.

If a patentee in opposition proceedings has had his request that the patent be maintained upheld by the Decision of the Opposition Division, he may not file an appeal against reasoning in the Decision which was adverse to him (here: his claim to priority), because he is not adversely affected by the Decision within the meaning of Article 107 EPC. In the event of an appeal being filed by an opponent, however, if the patentee wishes to contend that such adverse reasoning was wrong, he should set out his grounds for so contending in his observations under Rule 57(1) EPC in reply to the statement of grounds of appeal, by way of cross-appeal.

6. Any other [A107]

J0028/94 [J0033/95]

Suspension of proceedings. Also the patent applicant.

The patent applicant is not heard in proceedings which lead to a decision regarding the suspension of the proceedings. He is party as of right to appeal proceedings initiated by the third party against rejection of his request.

T1063/02 [T0977/02]

Decision relating to the correction of a decision, of the minutes.

Rejected request for correction of a decision and the minutes. Decision communicated per fax. One of the members of the opposition division responsible did not sign the decision.

An appeal directed against a decision relating to the correction of a decision made by the first instance can be admissible.

T1022/01

Grant of file inspection. Proprietor is a concerned party.

Correspondence in PCT-Chapter II proceedings not part of the European file.

Inspection of the file of the international preliminary examination at the EPO in its function as elected Office is not possible under Article 128(4) EPC in conjunction with Articles 36(4), 38(1) and Rule 94.3 PCT if the international application was filed before 1 July 1998.

The proprietor is a party concerned within the meaning of Article 113(1) EPC because he has a legitimate interest in keeping the contested documents confidential and the grant of file inspection would affect his rights.

T0009/00

Also patent proprietor in appeal against inadmissibility of the opposition.

T0643/91

Also party with inadmissible own appeal.

T0604/89

Several appellants.

When several parties to proceedings before the EPO have filed appeals, than they are all appellants.

T0396/89 [G0009/92, T0576/89]

No requirement for a cross-appeal.

T0073/88

An opponent who is adversely affected is party to the appeal proceedings even without filing an appeal.

7. as of right [A107]

T0384/08

Transfer of opponent status refused by first instance, no res judicata. Prohibition of reformatio in peius not applicable.

T1178/04 [T0293/03]

Purported new opponent. Proprietor not prevented from presenting arguments relating to validity of transfer of opponent status. Reformatio in peius.

The duty of the European Patent Office to examine, ex officio, the status of the opponent at all stages of the proceedings extends not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party.

The doctrine of no reformatio in peius is of no application in relation to the exercise of such duty.

T1112/04

No basis in the Convention for a party as of right being considered to have forfeited its right of presenting arguments in oral proceedings.

Respondent did not present any specific arguments regarding the grounds of appeal.

T0864/02 [T0233/93]

Opponents have exactly the same rights. Not: Non-appealing opponent can be prohibited from raising novelty objection.

T0406/00

Withdraw from the Appeal.

T0701/97

Non-appealing opponent in the case of rejection of multiple oppositions.

Procedural status of a non-appealing opponent in the case of rejection of multiple oppositions.

Where Article 100(c) EPC has been raised as a ground for opposition and has been considered in the appealed decision, it is the board's duty to assess correctly whether or not the respondent's requests comply with said Article. Hence, the board has to consider all arguments which are relevant, independently of

- the point in time at which they were introduced into the proceedings,
- the procedural status of the party who actually introduced them, and
- whether or not a given party, relying on these arguments, had based its initial opposition on this ground.

T0270/94 [T0154/95, T0774/05]

Commenting on an opposition ground duly submitted by another opponent.

Opponent not to be prevented from commenting on an opposition ground duly submitted by another opponent.

T0838/92

The Exclusion of a party is not possible.

T0753/92 [T0762/96, T0514/01]

Request for apportionment of costs merely as a party as of right.

A request for apportionment of costs in appeal proceedings by a party adversely affected solely by the decision on the apportionment of costs is inadmissible.

T0646/91

Change of the ground for opposition within Article 100(a) by the party as of rights is admissible.

T0811/90

Opponent not party to further proceedings before the EPO after termination of the opposition proceedings

T0073/88

Reasoning in the decision which was adverse to him.

If a patentee in opposition proceedings has had his request that the patent be maintained upheld by the Decision of the Opposition Division, he may not file an appeal against reasoning in the Decision which was adverse to him (here: his claim to priority), because he is not adversely affected by the Decision within the meaning of Article 107 EPC. In the event of an appeal being filed by an opponent, however, if the patentee wishes to contend that such adverse reasoning was wrong, he should set out his grounds for so contending in his observations under Rule 57(1) EPC in reply to the statement of grounds of appeal, by way of cross-appeal.

7.1. Patent proprietor**T0637/96**

Amendment made during the appeal proceedings which cancels the unnecessary amendment of the patent.

An amendment made during appeal proceedings which cancels the unnecessary amendment of the patent made during opposition proceedings is appropriate and necessary.

T1002/95

Amendments occasioned by an opposition ground, not arising from the opponent's appeal.

Having regard to Rule 57a EPC, a non-appealing patent proprietor is entitled to make amendments on its own volition in cases where these amendments - although occasioned by an opposition ground under Article 100 EPC - do not arise from the opponent's appeal.

7.2. Withdrawal**G0002/91**

No independent right to continue the proceedings.

A person who is entitled to appeal but does not do so and instead confines himself to being a party to the appeal proceedings under Article 107, second sentence, EPC, has no independent right to continue the proceedings if the appellant withdraws the appeal.

T0233/93

If the appellant II withdraws his appeal but not his opposition, he falls back into the role of a party.

If the appellant II withdraws his appeal but not his opposition, he falls back into the role of a party as of right in the sense of Article 107 EPC, second sentence and the scope of the appeal is defined by the request of appellant I, which the non-appealing party may not exceed. As appellant I only objected to those parts of the impugned decision which relate to product claims the Board is not authorised to question the patentability of the process claims.

T0789/89 [T0884/91, T0082/92, T0092/92, T0329/92]

Ceases to be a party to appeal proceedings as far as the substantive issues are concerned.

The respondent to an appeal and former opponent, who "withdraws his opposition" ceases to be a party to appeal proceedings as far as the substantive issues (existence and scope of the patent right) are concerned. However this leaves his party status unaffected insofar as the question of apportionment of costs under Article 104 EPC is at issue.

T0484/89

Also in the case of withdrawal of the opposition by the respondent in opposition appeal proceedings.

7.3. Reformatio in peius

G0001/99

Reformatio in peius; exception to the prohibition.

In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision.

In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;
- 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 Article 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC.

G0009/92 [G0004/93, T0369/91, T0488/91, T0266/92, T0321/93, T0752/93, T0828/93, T0815/94, T1002/95, T0637/96]

Reformatio in peius.

The opponent as a party as of right may not challenge the maintenance of the patent as amended in accordance with the interlocutory decision, nor may he request complete revocation of the patent.

The patent proprietor as a party as of right is primarily limited to defending the patent in the version in which it was maintained. He cannot primarily pursue a broader claim in his request.

1. If the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appealing opponent as a party to the proceedings as of right under Article 107, second sentence, EPC, may challenge the maintenance of the patent as amended in accordance with the interlocutory decision.

2. If the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the Opposition Division in its interlocutory decision. Amendments proposed by the patent proprietor as a party to the proceedings as of right under Article 107, second sentence, EPC, may be rejected as inadmissible by the Board of Appeal if they are neither appropriate nor necessary.

T0127/05

Withdrawing the appeal. Disadvantageous outcome.

The sole appellant has the possibility of withdrawing its appeal if it finds that the outcome would be disadvantageous to itself.

T0724/99

Alternative amendment not leading to reformatio in peius. Not requested.

Applicability of decision G0001/99 to amendments filed before.

Alternative amendment not leading to reformatio in peius is possible but no such amendment requested by the Respondent (Patentee).

T0239/96

In the absence of a provision on cross-appeal, reformatio in peius cannot be ruled out altogether.

Keeping the granted claims as main request.

T0169/93 [T0327/92, T1341/04, T1042/06]

A party who is not adversely affected may carry forward facts again.

A party who is not adversely affected may carry forward facts again to defend the result granted before the opposition division even if the latter did not follow this submission in the decision.

Article 108¹ - Time limit and form

Notice of appeal shall be **filed**¹, in accordance with the Implementing Regulations, at the European Patent Office **within**² two months **of**³ **notification**⁴ of the **decision**⁵. Notice of appeal shall not be deemed to have been **filed**⁶ until the **fee for appeal**⁷ has been **paid**⁸. **Within**⁹ **four months**¹⁰ of **notification**¹¹ of the **decision**¹², a statement setting out the **grounds**¹³ of **appeal**¹⁴ shall be filed in accordance with the Implementing Regulations.

Ref.: R. 3, 6, 99, 101, 111

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ⁱ See decisions of the Enlarged Board of Appeal G 1/86, G 2/97, G 1/99, G 3/03, G 2/04, G 3/04.

1. filed [A108]**J0016/94 [T0460/95]**

Not: As subsidiary request to the main request before the department of first instance.

For a notice of appeal to comply with Article 108, first sentence, and Rule 64(b) EPC, it must express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. subject to the main request not being allowed by the department of first instance, is therefore inadmissible.

T0783/08

Signature on the direct debit order as part of the notice of appeal is sufficient.

T0765/08 [T1090/08]

Technical means not approved. Appeal filed via epoline.

Documents purporting to be documents filed subsequently for the purposes of Rule 2(1) EPC must be deemed not to have been received if they are filed with technical means not approved by the President of the EPO.

T1130/06 [T0529/08]

Missing signature. Appeal fee must be reimbursed.

T1152/05

Notice of Appeal, Article 14(4) EPC not applicable. Not: correction by deleting the term "traduction".

T0514/05 [T0781/04, T0991/04]

Not: Via epoline®.

Legal effect of appeal filed via epoline®. Formal requirements of documents filed by other means of communication.

I. The use of "other means of communication" (Rule 24(1) and 36(5) EPC) must be expressly permitted by the President of the EPO, before parties may use those means of communication for filing documents with a department of the EPO, including the EPO Board of Appeal.

II. An appeal filed via epoline® cannot have any legal effect absent explicit permission of the President of the EPO.

T0517/97

Precise time of day of faxed withdrawal of appeal.

Faxed withdrawal of appeal by sole appellant, followed on same day by Intervener I's faxed declaration of intervention.

I. If the precise time of day at which the EPO receives notice of withdrawal of appeal can be established, then withdrawal is effective from that moment.

II. If the sole appellant's notice of withdrawal of appeal and a notice of intervention are filed by fax on the same day, the chronological order in which they arrive must be taken into account, because for a notice of intervention to be valid the appeal proceedings must be pending when it is filed.

2. within [A108]**T0210/89 [T0266/97, T0314/01]**

Not re-establishment for the opponent when the time limit for filing an appeal is missed. Period laid down pursuant to R 36 (5) EPC.

An opponent is not entitled to have his rights re-established when he misses the time limit for filing an appeal. The legal position of such an opponent/appellant differs from that of one whose appeal does exist, but whose statement of grounds of appeal is filed out of time. When the two-week period pursuant to Rule 36(5) EPC has not been observed, the appeal is deemed not to have been received.

T0389/86 [T0197/02]

Before notification of the decision duly substantiated in writing.

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.

3. after [A108]**J0016/94 [T0460/95]**

Not: As subsidiary request to the main request before the department of first instance.

For a notice of appeal to comply with Article 108, first sentence, and Rule 64(b) EPC, it must express the definite intention to contest an appealable decision. An appeal filed as a subsidiary request, i.e. subject to the main request not being allowed by the department of first instance, is therefore inadmissible.

4. notification [A108]**T0876/04**

Decision sent to all the parties except one. Protection of legitimate expectations.

T0703/92

Breach of the provision relating to notification. Notification only when received by the representative.

If the written decision and minutes of the oral proceedings are sent not to the authorised representative but to the opponent himself, the provision relating to notification has not been observed. The question as to whether notification has effectively taken place depends on whether and when the representative received the full decision.

5. decision [A108]

T1081/02 [T0466/03]

Decision dispatched as a result of a formal mistake and therefore irrelevant. Second decision issued on the same case.

Granted opportunity to speak not respected.

The principle of good faith may not be applied to such an extent that a formalities officer neither officially nor functionally competent in the matter could be entitled to cancel the formal decision of the opposition division. This is not compatible with due process of law, in particular in regard to legal certainty.

1) When the opposition division issues an interlocutory decision in a written procedure where a separate appeal following Article 106(3) is admitted, the procedure of the first instance is closed, and the opposition division, in the interest of legal certainty, is no longer entitled to reverse or modify its final decision itself, whether on the basis of new insight or at the request of a party. Rather, this is only possible via an appeal to the legally constituted second instance of the boards of appeal of the EPO.

2) The communication sent by the formalities officer of the opposition division within the time limit for appeal stating that the decision had been dispatched as a result of a formal mistake and was therefore to be regarded as irrelevant is not an appropriate way of creating confidence in the facts of the case, which bears legal significance and could mean that the legal outcome of the decision is called into question to such an extent that it would be considered null and void. However, the required maintenance of good faith prohibits holding the legal time limit for appeal set out in Article 108 EPC against the parties.

3) A second decision issued on the same case infringes the basic procedural principle also underlying the EPC that the instance which makes the decision is itself bound by it; for this reason alone the decision must be set aside.

T1176/00 [T0830/03, T0993/06, T0130/07]

Time limit for appeal post-dated by the purported withdrawal and reissue of the decision. Principle of legitimate expectations.

T0124/93 [T0212/88, T0116/90, T1176/00, T0972/05]

No further enclosure or new date of the decision by way of a correction.

T0601/91

Illegible page. Page later reissued.

Illegible page of the written draft of the decision.

T0313/86

Time limit for appeal and submission of grounds begins from the decision from which an appeal emerges.

6. filed [A108]

J0005/03

The Board does not have to examine whether the actual amount finally received of the appeal fee would or would not have led to a loss of rights.

J0021/80 [J0016/82, T0239/92]

Until after the expiry of the period of two months, appeal is inadmissible.

1. If the appeal fee has not been paid until after the expiry of the period of two months provided for in Article 108 EPC, the Registrar has good reason to consider that the appeal is inadmissible; he will therefore advise the appellant of the loss of a right, pursuant to Rule 69(1) EPC.

2. The appellant may apply for a decision of the Board of Appeal against the finding of the Registrar, pursuant to Rule 69(2) EPC.

3. If that finding is confirmed by the Board of Appeal, reimbursement of the appeal fee will be ordered.

T0781/04 [T0991/04, T1260/04, T0395/07]

Via epoline®. Principle of good faith. Restitutio in integrum.

Requirement of written form.

An appeal filed via electronic means - epoline® - does not comply with the requirement of Article 108 EPC that an appeal must be filed in writing. The appropriate sanction for non compliance is inadmissibility.

If the electronic filing took place well before the end of the appeal period (in the present case nearly one month) and the appeal, although inadmissible, is treated by the Boards as having been duly filed, then the principle of good faith may require that a request for restitutio in integrum be granted.

T0184/04

Appeal filed inadvertently. Reserve the right to continue with the appeal.

T0126/04

Translation not filed in time. Appeal inadmissible.

Rule 65(1) EPC prevails over the general provision in Article 14(5) EPC. Therefore no disagreement exists between the provisions of the convention (Article 14(4) and (5) EPC) and the provisions of the implementing regulations (Rule 65(1) and Rule 1 (1) EPC). If the required translation of the notice of appeal is not filed in time, then the appeal is inadmissible.

T0309/03

Notice of appeal filed before taking note of the applicant's adverse instruction.

The mere fact that a representative has filed a notice of appeal before taking note of the applicant's adverse instruction does not justify a correction to the effect that no appeal has been filed.

T0372/99

Appeal lodged inadvertently, partial reimbursement of the appeal fee refused.

Appeal was inadvertently lodged, appeal deemed to have been filed, withdrawal of the appeal, partial reimbursement of the appeal fee refused.

T0460/95 [T0275/86, T0445/98]

Payment, form for the payment and covering letter as valid filing. Inadmissible appeal.

A notice of appeal within the meaning of Rule 64 of the Implementing Regulations to the EPC is inadmissible if it does not contain an explicit and unequivocal statement expressing the definite intention to contest an appealable decision.

T0773/91 [T0265/93, T0120/98, T0142/04]

No reimbursement of the appeal fee in the case of withdrawal prior to the examination.

No reimbursement of the appeal fee in the case of withdrawal of the appeal after effective filing and prior to the substantive and formal examination.

T0323/87

Not if translation is not filed in due time.

The appeal fee, if paid, must be reimbursed if no appeal exists. In the case in question, the translation referred to in Article 14(5) EPC was not filed in due time and the appeal is deemed not to have been lodged.

6.1. Merely the fee for appeal**J0019/90 [T0275/86, T0445/98, T0637/04]**

Merely the fee for appeal is not sufficient.

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.

T1943/09

Not: "Substitution" of the notice of appeal by payment of the appeal fees in due time.

T0778/00

Debit order not sufficient.

I. Article 108, second sentence, EPC is not to be interpreted as meaning that merely sending the EPO a debit order for the appeal fee constitutes a valid means of filing the appeal (following J0019/90).

II. The absence of a reference to Rule 65 EPC in the annex to the communication of the possibility of appeal does not make the communication incomplete or misleading.

T0371/92 [T0266/97, T1100/97]

The appeal fee does not in itself constitute the valid filing. Decision definitively the force of res judicata.

Payment of the appeal fee does not in itself constitute the valid filing of the appeal. Consequently, where there is no appeal, it is not for the board of appeal to judge whether there has been a substantial procedural violation by the first instance, whose decision therefore definitively acquires the force of res judicata.

T0275/86 [T0445/98]

Considered to be admissible.

In relation to the missing notice of appeal it is observed that the completed "Abbuchungsauftrag" (EPO Form 4212 05.80), which was received within two months after the date of notification of the decision of the Opposition Division, contains essentially the same information that is required in a notice of appeal in the sense of Rule 64 EPC, i.e. name and address of the Appellant, the number of the patent to identify the decision which is impugned and that the purpose of the payment is to pay the fee for the appeal. Therefore, the appeal of Appellant OII is also considered to be admissible.

6.2. Withdrawal**J0030/94**

Implicit withdrawal.

The statement "We have lost interest in performing an appeal procedure and request to leave closed the file" constitutes a withdrawal of the appeal.

After withdrawal of an appeal a reimbursement of the appeal fee can exceptionally be ordered if the appeal was not remitted to the Board of Appeal within a reasonable time after the first instance decision not to allow it.

J0012/86 [T0021/82, T0041/82, T0773/91]

Withdrawal of the appeal before the expiry of the period for filing the statement of grounds of appeal.

An appeal fee cannot be reimbursed if after a notice of appeal has been duly filed and the appeal fee has been duly paid the appeal is withdrawn before the expiry of the period for filing the statement of grounds of appeal.

J0019/82

Withdrawal of a part of an appeal.

In general, an appeal pending before a Board of Appeal of the EPO can be withdrawn without the consent of the Board concerned. Part of an appeal can be withdrawn in a case in which the part in question relates to a specific issue which formed a distinct part of the decision under appeal.

T0752/05 [T0603/99]

Withdrawal within the 2-month time limit, no reimbursement.

Where an appeal has been filed in due time, a request for reimbursement of the appeal fee can be allowed only under the requirements of Rule 67 EPC. The withdrawal of the appeal, whenever it occurs (here: within the 2-month time limit provided in Article 108 EPC for filing the notice of appeal), does not allow a reimbursement.

T1142/04

Even if the appellant has added an obviously non-admissible request to his declaration of withdrawal.

If an appellant has clearly withdrawn his appeal, the appeal proceedings can be terminated without a written substantiated decision even if the appellant has added an obviously non-admissible request for reimbursement of the appeal fee to his declaration of withdrawal.

T0060/00

Statement "decided not to pursue the appeal" cannot be regarded as a withdrawal of the appeal.

Statement "decided not to pursue the appeal" cannot be regarded as a withdrawal of the appeal.

Contact by telephone.

On the day of the oral proceedings, the appellant sent a fax.

T0041/82 [T0089/84, T0603/99, T1142/04, T1216/04, T0752/05, T1004/05]

Appeal withdrawn.

Where an appeal has been withdrawn, the Board of Appeal concerned may consider applications made to it in matters arising out of or in connection with the former proceedings, in the exercise of its inherent original jurisdiction.

7. fee for appeal [A108]

G0002/97

Inadvertently missed time limit for payment of the fee. No indication, neither in the notice of appeal nor in any other document

The principle of good faith does not impose any obligation on the boards of appeal to notify an appellant that an appeal fee is missing when the notice of appeal is filed so early that the appellant could react and pay the fee in time, if there is 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.

T0859/08

"Fee for appeal". EQE.

T0343/02

Underpayment of less than two percent due to the unexpected deduction of bank charges.

Payment of appeal fee by cheque into EPO's Euro-account in London. Small amount lacking due to deduction of bank charges.

1. Overlooking an underpayment of the appeal fee of less than two percent is justified pursuant to Article 9(1), last sentence, Rules Relating to Fees if this underpayment is due to the unexpected deduction of bank charges from the correct amount paid by cheque into the Euro account of the EPO in a country not having adopted the Euro system.

2. The notice of appeal referring to details of payment of the appeal fee and the fact of paying more than 98 percent of the appeal fee in time give clear indications within the meaning of G0002/97 that payment of the appeal fee was intended so that the principle of good faith obliges the EPO to notify the appellants if there is sufficient time to react before expiry of the period for payment.

T0079/01

Less than half of the appeal fee paid. Appeal inadmissible.

The EPO cannot debit a different, much higher amount for the payment. Principle of impartiality or equal treatment of parties to the proceedings. Appeal inadmissible.

T0109/86

Erroneous underpayment; formerly correct appeal fee paid. Less than 10%.

T0130/82 [T0109/86, T0277/90]

The amount unpaid fairly considered to be small.

A notice of appeal can be considered as having been filed within the time limit prescribed by Article 108 EPC, not with standing that the full amount of the appeal fee has not been paid within that period, if the amount unpaid can fairly be considered to be small, within the meaning of Article 9(1) Rules relating to Fees, and if the circumstances justify overlooking the amount lacking.

8. paid [A108]**J0021/80 [J0016/82, T0239/92]**

Until after the expiry of the period of two months, appeal is inadmissible.

1. If the appeal fee has not been paid until after the expiry of the period of two months provided for in Article 108 EPC, the Registrar has good reason to consider that the appeal is inadmissible; he will therefore advise the appellant of the loss of a right, pursuant to Rule 69(1) EPC.

2. The appellant may apply for a decision of the Board of Appeal against the finding of the Registrar, pursuant to Rule 69(2) EPC.

3. If that finding is confirmed by the Board of Appeal, reimbursement of the appeal fee will be ordered.

T0046/07

Paid after expiry, fee must be refunded even without a respective request.

If the fee for re-establishment of rights is paid after expiry of the two-month period laid down in Article 122(2) EPC, the application for re-establishment of rights does not come into existence and therefore the fee must be refunded even without a respective request.

T1147/03 [J0027/90]

The EPC does not require parties to proceedings to pay the relevant fees themselves.

T1029/00

Not: In DPMA by payment in cash.

Receipt of the fee for appeal in DPMA by payment in cash is ineffective vis-à-vis EPO.

T0270/00

Debit order "unconditionally revoked" following the debit.

T1130/98

Not: Transfer of the appeal fee by mistake to an account of the German patent office.

Failure to pay the appeal fee within the time limit because of transfer by mistake to an account of the German patent office.

T0296/96

Appeal deemed to have been filed. Protection of legitimate expectations.

The Formalities Officer invited the Appellant to pay the remainder of the appeal fee and accepted its subsequent payment without comment.

T0045/94

Remittance to the German Patent Office.

Neither the date on which a transfer to the German Patent Office is entered nor the date on which an order to transfer an amount to the German Patent Office may be taken into account when establishing whether a fee due to the EPO has been paid in due time.

T0415/88

Ineffective payment by fees vouchers of the German Patent Office.

9. Within [A108]**G0001/86 [T0210/89]**

Failed to observe the time limit for filing the statement of grounds of appeal; re-establishment of the opponent.

Article 122 EPC is not to be interpreted as being applicable only to the applicant and patent proprietor. An appellant as opponent may according to Article 122 EPC have his rights re-established if he has failed to observe the time limit for filing the statement of grounds of appeal.

T0632/95

The fact that the Statement of Grounds of appeal was received in time could not be proven. Burden of proof lies with the party submitting the document.

10. four months [A108]

T0881/98

Not: Standard request for extension of time limit, statement of grounds of appeal, re-establishment.

T0248/91 [T0516/91, T0460/95]

No request for any additional time.

T0869/90 [T0111/92]

Miscalculation of time limit; a little too late; re-establishment.

11. notification [A108]

T0703/92

Breach of the provision relating to notification. Notification only when received by the representative.

If the written decision and minutes of the oral proceedings are sent not to the authorised representative but to the opponent himself, the provision relating to notification has not been observed. The question as to whether notification has effectively taken place depends on whether and when the representative received the full decision.

12. decision [A108]

T1081/02 [T0466/03]

Decision dispatched as a result of a formal mistake and therefore irrelevant. Second decision issued on the same case.

Granted opportunity to speak not respected.

The principle of good faith may not be applied to such an extent that a formalities officer neither officially nor functionally competent in the matter could be entitled to cancel the formal decision of the opposition division. This is not compatible with due process of law, in particular in regard to legal certainty.

1) When the opposition division issues an interlocutory decision in a written procedure where a separate appeal following Article 106(3) is admitted, the procedure of the first instance is closed, and the opposition division, in the interest of legal certainty, is no longer entitled to reverse or modify its final decision itself, whether on the basis of new insight or at the request of a party. Rather, this is only possible via an appeal to the legally constituted second instance of the boards of appeal of the EPO.

2) The communication sent by the formalities officer of the opposition division within the time limit for appeal stating that the decision had been dispatched as a result of a formal mistake and was therefore to be regarded as irrelevant is not an appropriate way of creating confidence in the facts of the case, which bears legal significance and could mean that the legal

outcome of the decision is called into question to such an extent that it would be considered null and void. However, the required maintenance of good faith prohibits holding the legal time limit for appeal set out in Article 108 EPC against the parties.

3) A second decision issued on the same case infringes the basic procedural principle also underlying the EPC that the instance which makes the decision is itself bound by it; for this reason alone the decision must be set aside.

T1176/00 [T0830/03, T0993/06, T0130/07]

Time limit for appeal post-dated by the purported withdrawal and reissue of the decision. Principle of legitimate expectations.

T0124/93 [T0212/88, T0116/90, T1176/00, T0972/05]

No further enclosure or new date of the decision by way of a correction.

T0601/91

Illegible page of the written draft of the decision. Page later reissued.

T0313/86

Time limit for appeal and submission of grounds begins from the decision from which an appeal emerges.

13. grounds [A108]

T0934/02 [T0407/02]

Not: In support of a version of a claim that the appellant (patent proprietor) no longer defends.

I. An appeal of the patent proprietor is to be considered sufficiently substantiated within the meaning of Article 108, third sentence EPC by filing amended claims which deprive the contested decision of its basis, even though it does not state any specific reasons why the contested decision is wrong. It is therefore not necessary and would also be pointless for the purposes of adequately substantiating an appeal, to file grounds in support of a version of a claim that the appellant (patent proprietor) no longer defends in the appeal proceedings.

II. Where a patent proprietor appeals against an interlocutory decision, maintaining a patent in amended form in accordance with an auxiliary request the main request rejected by the opposition division is to be considered as a formulation attempt which does not prevent the patent proprietor from submitting in the appeal proceedings a new main request having a claim 1 broader in scope than that of the rejected main request but narrower than that of the granted version.

T0733/98

Main and auxiliary requests in grant procedure. Neither approval nor amendments. Only new claims filed together with the statement.

I. If an application is refused under Article 97 and Rule 51(5) EPC, on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to Rule 51(4) EPC nor proposed amendments within the meaning of Rule 51(5) EPC within this period, a statement setting out the grounds of appeal which deals only with the issues of admissibility and allowability of new claims filed together with the statement does not meet the requirement of Article 108 EPC, third sentence.

II. The requirement of "all due care required by the circumstances" within the meaning of Article 122(1) EPC is not met if an applicant and his professional representative fail to realize that the procedural way in handling main and auxiliary requests as set out in Legal Advice 15/84, points 2.4 and 2.5, is no longer relevant after the amended Rule 51 EPC had entered into force on 1 September 1987.

T0543/95

Substantiation does not extend to collected evidence.

T0145/88

Depends on its substance and not upon its heading or form.

A Statement of Grounds of Appeal should state the legal and factual reasons why the decision under appeal should be set aside and the appeal allowed. Whether a document complies with Article 108 EPC, third sentence, is considered to depend on its substance and not upon its heading or form.

T0013/82 [T0950/99, T0012/00]

Anything that can be regarded as a statement of grounds.

I. If the notice of appeal does not contain anything that can be regarded as a statement of grounds, the appeal is inadmissible unless a written statement of grounds is received by the EPO within the time limit set in Article 108, third sentence.

II. Re-establishment of rights may be justified under the conditions set out in decision J0005/80 dated 7 July 1981 in the event of a wrongful act or omission on the part of an assistant. However, first of all a conclusive case must be made, setting out and substantiating the facts, for the probability that such a wrongful act or omission was instrumental in the failure to meet the time limit.

III. If an appeal is to be rejected as inadmissible solely because the statement of grounds was not filed in due time the fee for appeal is not refundable.

13.1. Submitting new facts**J0902/87**

Invalidation of the contested decision.

An appeal is to be considered sufficiently well-founded, if it refers to a new circumstance which, if confirmed, will invalidate the contested decision.

J0002/87 [T0195/90]

Former communication of the EPO now fulfilled.

The minimal requirements of Art. 108 EPC are satisfied when the notice of appeal can be interpreted as containing a request for rectification of the decision concerned on the grounds that due to the fact that the conditions set forth in a former Communication of the EPO were now fulfilled, the decision was no longer justified.

J0022/86

Exceptionally, the requirement may be regarded as satisfied.

The written statement setting out grounds of appeal should set out fully the reasons why the appeal should be allowed and the decision under appeal should be set aside. Exceptionally, where the written statement does not contain such full reasons, the requirement for admissibility may be regarded as satisfied if it is immediately apparent upon reading the decision under appeal and the written statement that the decision should be set aside.

T0387/88

It can be sufficient to state that the act omitted has been completed.

13.2. Alternative claims**T0051/08**

Principle of res iudicata applied in the divisional application.

Subject matter on which a final decision has been taken by a board of appeal in the parent application becomes res iudicata and cannot be pursued in the divisional application.

If the statement setting out the grounds of appeal in a case does not go beyond submitting and arguing for a set of claims which constitutes such subject matter, the appeal is not sufficiently substantiated.

T0078/05

Filing the appeal based on amended claims without further comment on the objections means that arguments rebutting them are not part of the appellant's case.

T0039/05

Why it had not been possible to make these requests at first instance.

T0295/04

Not: Global reference to reply and new claims filed during first instance proceedings.

T0257/03

Not only that the opposition procedure should be begun afresh.

The content of the statement of the grounds of appeal indicates that the opposition procedure should be begun afresh but does not indicate the reasons why the opposition decision should be set aside according to the appellant.

T0132/03

New main claim does not contain any additional features.

The new main claim contains no additional features compared with the rejected claims 1 to 4.

The references, though brief, are sufficient since the issue here is simply features additionally disclosed in the closest prior art.

T0023/03

Not: The factual basis of the contested decision remains unchanged but no arguments presented.

T1045/02

Not: dealt with only one of several grounds for rejection.

The minimum requirements for a statement of grounds of appeal are not fulfilled if they deal with only one of several grounds for rejection.

T0064/02

Single request in accordance with an auxiliary request rejected by the Opposition Division on the grounds of being filed late.

If the only request of the appellant is directed to maintaining the patent in accordance with an auxiliary request which was rejected by the Opposition Division on the grounds of being filed late, then the appeal can be rejected without examining of the allowability of

this request if the Board is of the opinion that the non-admission of the auxiliary request was justified.

T0717/01 [T0934/02, T1197/03, T0642/05]

Maintenance on the basis of new patent claims.

The grounds provided by the patentee appellant following Article 108 sentence 3 EPC can be regarded as sufficient, in the case of the absence of discussion concerning the grounds for the contested decision, if

- the subject underlying the decision has been amended by the submission of new patent claims together with the statement of grounds, and
- it is stated in detail why the raised grounds are not obstacle to the maintenance of the patent on the basis of these new patent claims.

T0717/99

Statement as a formal waiver or estoppel. Abandonment of subject-matter by estoppel.

T0733/98

Main and auxiliary requests in grant procedure. Neither approval nor amendments. Only new claims filed together with the statement.

I. If an application is refused under Article 97 and Rule 51(5) EPC, on the grounds that the applicant neither communicated his approval of the text proposed for grant within the period according to Rule 51(4) EPC nor proposed amendments within the meaning of Rule 51(5) EPC within this period, a statement setting out the grounds of appeal which deals only with the issues of admissibility and allowability of new claims filed together with the statement does not meet the requirement of Article 108 EPC, third sentence.

II. The requirement of "all due care required by the circumstances" within the meaning of Article 122(1) EPC is not met if an applicant and his professional representative fail to realize that the procedural way in handling main and auxiliary requests as set out in Legal Advice 15/84, points 2.4 and 2.5, is no longer relevant after the amended Rule 51 EPC had entered into force on 1 September 1987.

T0169/98 [T0650/03, T0778/06]

The examination is continued on the basis of amendments proposed by the examining division but without making use of interlocutory revision.

T0445/97

New claims filed for removing the grounds for revocation. Partial reinstatement of the scope of the claims restricted during the opposition proceedings.

T0162/97

Amended claim as statement of grounds for maintaining in full the patent in suit.

T0898/96

Notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Use not made of interlocutory revision.

The notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Failure to rectify by way of interlocutory revision is a substantial procedural violation but inequitable to refund the appeal fee.

T0729/90 [T0105/87, T0563/91, T1158/98]

Auxiliary requests even without further statement of grounds to the main request.

Auxiliary requests which overcome the objections of the first instance even without further statement of grounds to the main request.

T0105/87 [T0563/91]

Newly introduced facts, arguments and claims are admissible grounds; original requests withdrawn.

Newly introduced facts, arguments and claims which destroy the basis for the decision are admissible grounds even if the earlier decision is accepted and the original requests are withdrawn.

T0153/85

Alternative sets of claims.

If an appellant desires that the allowability of alternative sets of claims should be considered in an appeal, such alternative claims should normally be filed with the statement of grounds of appeal or as soon as possible thereafter.

When deciding an appeal during oral proceedings, a Board of Appeal may refuse to consider alternative claims which have been filed at a late stage, e.g. during the oral proceedings, if such claims are not clearly allowable.

13.3. Making use of the suspensive effect**T0591/05**

New prior art, filing of divisional application, and suspensive effect immaterial to the admissibility of appeal against decision to grant.

Not: Admissibility of appeal against decision to grant a patent.

New prior art document found after grant, filing of divisional application after grant, and suspensive

effect of appeal immaterial to the admissibility of the appeal.

T0549/93 [T0591/05]

Not simply that the possibility for divisional application is affected.

The grant of a patent is not simply adversely affecting because it affects the possibility for divisional application.

T0022/88

Not only announcing that the act will be completed.

A written statement setting out the grounds of appeal within the meaning of Article 108, third sentence, EPC, must contain reasons why the decision under appeal should be set aside. A written statement announcing only that the appellant will complete an omitted act, in this case the filing of the translations of the revised claims, within the four-month period allowed for submitting the grounds of appeal, does not comprise such reasons and therefore does not constitute a valid statement of the grounds of appeal.

13.4. Opposition appeal**T0349/09**

No link between statement of grounds of appeal and decision under appeal. Not: "cut and paste" version of the notice of opposition. Article 12(2) RPBA.

T1276/05

Returning to the abandoned form of the patent.

T0263/05

Reason additional to the reason(s) already relied on by the Opposition Division.

T0039/05

Why it had not been possible to make these requests at first instance.

T0257/03

Not only that the opposition procedure should be begun afresh.

The content of the statement of the grounds of appeal indicates that the opposition procedure should be begun afresh but does not indicate the reasons why the opposition decision should be set aside according to the appellant.

T0717/01 [T0934/02, T1197/03, T0642/05]

Maintenance on the basis of new patent claims.

The grounds provided by the patentee appellant following Article 108 sentence 3 EPC can be regarded as

sufficient, in the case of the absence of discussion concerning the grounds for the contested decision, if

- the subject underlying the decision has been amended by the submission of new patent claims together with the statement of grounds, and
- it is stated in detail why the raised grounds are not obstacle to the maintenance of the patent on the basis of these new patent claims.

T0445/97

New claims filed for removing the grounds for revocation. Partial reinstatement of the scope of the claims restricted during the opposition proceedings.

T0162/97

Amended claim as statement of grounds for maintaining in full the patent in suit.

T0154/95 [T0270/94, T0774/05]

Citing of a prior use which was invoked by an other opponent whose opposition was judged inadmissible.

Admissibility of a prior use invoked after expiry of the opposition period by a second opponent.

In opposition or appeal proceedings it is basically irrelevant how an opponent comes across documents or other evidence made available to the public. So there is nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition is inadmissible.

T0003/95

Problem-solution approach. Problem neither disclosed nor solved.

T0455/94

State of the art under Article 54(3) must be interpreted as an objection of lack of novelty.

The mere fact that an earlier European application has been referred to in the notice of opposition as being comprised in the state of the art under Article 54(3), (4) EPC, must be interpreted as an objection of lack of novelty, even if this ground for opposition was not mentioned as such expressis verbis in the notice of opposition.

T0574/91 [T0644/97]

Only a review.

Only a review of the grounds for revocation in the absence of specific objections to the decision to revoke in the statement of grounds of appeal.

13.4.1. Patent proprietor's request for revocation

T0018/92 [T0481/96]

Only patent proprietor's request for revocation in his statement of grounds of appeal.

T0459/88 [T0961/93]

Based on the patent proprietor's request for revocation.

An opponent's appeal is admissible when the written statement of grounds is based solely on the fact that the patent proprietor himself filed the request for revocation of the patent after the appeal was filed. If the patent proprietor requests that his patent be revoked, it is to be revoked on the basis of this request. It is not in the public interest to maintain a patent against the patent proprietor's will.

13.4.2. Concerning admissibility

T0505/93

Admissibility of the opposition does not depend on the accuracy of the produced facts.

T0925/91

Grounds which are not adequately defined due to an erroneous action. Concerning admissibility if appeal against rejecting as inadmissible.

Insufficient substantiation as a result of misleading conduct on the part of the opposition division does not render the appeal inadmissible. Remarks on substantive matters of an inadmissible opposition.

If a notice of opposition is rejected as inadmissible by the first instance, the opposition proceedings are legally terminated without a decision as to the substance of the opposition being issued. It is inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider its merits. Remarks on substantive matters in a decision rejecting the opposition as inadmissible have no legal effect. Even if misleading, they do not represent a substantial procedural violation justifying the reimbursement of the appeal fee.

T0213/85 [T0169/89, T0534/89]

Elaboration on the admissibility of the opposition.

If an opposition has been dismissed on the grounds of insufficient substantiation and the grounds for appeal merely dispute patentability without elaborating on the admissibility of the opposition, the appeal is inadmissible for lack of adequate substantiation.

13.5. New facts for opposition appeal**G0010/91 [T0443/93, T0018/93]**

Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

1. An Opposition Division or a Board of Appeal is not obliged to consider all the grounds for opposition referred to in Article 100 EPC, going beyond the grounds covered by the statement under Rule 55(c) EPC.

2. In principle, the Opposition Division shall examine only such grounds for opposition which have been properly submitted and substantiated in accordance with Article 99(1) in conjunction with Rule 55(c) EPC. Exceptionally, the Opposition Division may in application of Article 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.

3. Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

T0395/00

New attack represents a new argument.

T0701/97

Rejection of multiple oppositions. Additional arguments not raised before.

Procedural status of a non-appealing opponent in the case of rejection of multiple oppositions.

Where Article 100(c) EPC has been raised as a ground for opposition and has been considered in the appealed decision, it is the board's duty to assess correctly whether or not the respondent's requests comply with said Article. Hence, the board has to consider all arguments which are relevant, independently of

- the point in time at which they were introduced into the proceedings,
- the procedural status of the party who actually introduced them, and

- whether or not a given party, relying on these arguments, had based its initial opposition on this ground.

Once the board has become aware, during the prosecution of the case, of additional arguments not raised by one of the parties, and which are of decisive importance in the correct assessment of the case within the given framework of Article 100(c) EPC, it has the power and the duty to bring them into consideration in the course of the proceedings.

T0470/97

Abuse of procedure: Further impediments to patentability raised for the first time in the oral proceedings.

1. Where the opposing appellant bases an objection on a single reason only (here: lack of disclosure, Article 83 EPC) before expiry of the period for the statement of grounds of appeal, without disputing the decision pronounced by the first instance with regard to other impediments to patentability, then the appeal procedure is limited on principle to this reason. This follows from an analogous application of the decision G0009/91, where an opponent is on principle limited to the reasons he has indicated before expiry of the opposition period, unless the other party agrees that further reasons are considered. The introduction of further reasons in the appeal procedure, such as lack of novelty and inventive step of the claim subject-matter is within the discretion of the Board of Appeal, if necessary with the agreement of the other party.

2. A request made for the first time in the oral proceedings before the Board of Appeal, even to consider lack of inventive step of the claim subject-matter, always represents an abuse of procedure if the appellant fails to reply to a communication of the Board of Appeal, in which the parties were informed more than half a year prior to the proceedings that the said proceedings would limit themselves to the lack of disclosure (Article 83 EPC). Such a request will not be admitted by the Board of Appeal.

T0100/97

Evidence submitted late. Oral disclosures.

T1007/95

Not: Only a new document and a new ground for opposition. No connection with the reasons given in the appealed decision.

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 G0009/91 and G0010/91, 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.

T0389/95 [T0191/96, T1082/05, T1557/05, T1029/05]

Evidence making an entirely fresh factual case on appeal.

Evidence making an entirely fresh factual case on appeal is disregarded pursuant to Article 114(2) EPC. The appeal based on this evidence is, however, admissible.

T0252/95

Further prior use. Relevance and convincing reasons given.

Further public prior use not raised until filing the statement of grounds of appeal.

T0105/94

Grounds of appeal of the opponent which were not substantiated in the notice of opposition are not admissible at appeal stage.

T0219/92

Rejected opposition supported with new material from the search report.

Consideration on account of its relevance. Decision without remittal in favour of the late filing opponent.

T0003/92

Completely different facts but new reasons were in the same article 100a) category.

T0611/90 [T0847/93, T0229/92, T0938/91, T0708/95, T0736/01, T1557/05]

Case entirely different but the same opposition ground.

An appeal raising a case entirely different from that on which the decision under appeal was based is still admissible if it is based on the same opposition ground.

13.5.1. Grounds for opposition

G0007/95 [T0018/93]

No switching from Article 56 to Article 54 for grounds in opposition appeal proceedings.

In a case where a patent has been opposed under Article 100(a) EPC on the ground that the claims lack an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Articles 52(1) and 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.

G0001/95 [T0588/90]

No switching from Articles 54/56 to Article 52(2) for grounds in opposition appeal proceedings.

In a case where a patent has been opposed on the grounds set out in Article 100(a) EPC, but the opposition has only been substantiated on the grounds of lack of novelty and lack of inventive step, the ground of unpatentable subject-matter based upon Articles 52(1) and (2) EPC is a fresh ground for opposition and

accordingly may not be introduced into the appeal proceedings without the agreement of the patentee.

T0986/04

Further appeal proceedings following remittal. Fresh ground.

T0894/02

Ground of opposition abandoned during the opposition proceedings, not admitted in appeal proceedings.

T0520/01 [T0376/04]

Re-introduction constitutes a fresh ground. Not: Party which raised the ground does not appear at the opposition oral proceedings.

1. Where a ground of opposition, here insufficiency, was expressly not maintained in opposition oral proceedings by the only party which had relied on the ground and the Opposition Division did not deal with the ground in their decision the re-introduction of the ground in appeal proceedings constitutes a fresh ground which, following Opinion G0010/91 by analogy, requires the permission of the proprietor.

2. Where a ground, here novelty, was substantiated within the opposition period and the party which raised the ground neither appears at the opposition oral proceedings nor withdraws the ground the Opposition Division has to deal with the ground in their decision. The ground may then be taken up by other appellants in subsequent appeal proceedings.

T0135/01

Confirmation of novelty by opposition division is not implying introduction of lack of novelty as a ground for opposition.

T0131/01 [T0807/98, T0281/03]

Lack of inventive step in respect of alleged novelty destroying prior art.

Ground of lack of inventive step in respect of alleged novelty destroying prior art raised in the notice of opposition but not specifically substantiated.

New relevant arguments in respect of previously submitted facts presented after the time indicated in the summons must be taken into account.

In a case where a patent has been opposed under Article 100(a) EPC on the grounds of lack of novelty and inventive step having regard to a prior art document, and the ground of lack of novelty has been substantiated pursuant to Rule 55(c), a specific substantiation of the ground of lack of inventive step is neither necessary - given that novelty is a prerequisite for determining whether an invention involves an inventive step and such prerequisite is allegedly not satisfied - nor

generally possible without contradicting the reasoning presented in support of lack of novelty.

In such a case, the objection of lack of inventive step is not a fresh ground for opposition and can consequently be examined in the appeal proceedings without the agreement of the patentee.

T0012/00

Not novel and, by way of inevitable consequence, not inventive.

Subject-matter is not novel and, by way of inevitable consequence, does not involve an inventive step.

T0693/98 [T0300/04]

Objection under Article 123(2) EPC at the appeal stage results from an amendment made before grant.

The fact that amendments have been made to a claim in the course of the opposition proceedings does not allow an opponent to raise an admissible objection under Article 123(2) EPC at the appeal stage in the absence of the patentee's agreement, if such objection results from an amendment made before grant and has not been originally raised as a ground for opposition under Article 100(c) EPC pursuant to Rule 55(c) EPC.

T0274/95 [T0151/99, T0877/01]

A ground of opposition which is sought to be re-introduced is not a "fresh ground of opposition".

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the Opposition Division proceedings (here: a statement to that effect is made by the opponent during oral proceedings), the Opposition Division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent.

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the Opposition Division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of Opinion G0010/91, and may 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.

T0928/93 [T1226/01, T0448/03]

No switching from Article 54 to Article 56 EPC for an opposition appeal.

T0309/92 [T0931/91, T1070/96]

The Board of Appeal has the right to decide upon a ground for opposition which the Opposition Division has examined of its own motion.

13.6. Completeness and accuracy

T0760/08

An appeal, with a very short statement of grounds anyhow, which due to contradictions and approximations leaves the Board the task of finding in it a meaning, is in principle inadmissible. Mere filing of a new set of claims without comment.

T0613/07

Lack of reference to the ground of insufficiency. General reference made "to all intents and purposes" to the arguments presented to the opposition division.

Lack of reference to the ground of insufficiency of the description, which led to the rejection of the main request, cannot be compensated for by the general reference made "to all intents and purposes" to the arguments presented to the opposition division by the patent proprietor.

T0601/05

Not: Deal with all the reasons made in the context of lower-ranking requests. Not: Later inadmissible by subsequent submissions, including changes or replacements of requests.

T1377/04

Integrate the statement of grounds for lost or missing parts also after the time for appeal has expired, subject to the permission of the board.

T0624/04

Not: Duty to attach copies of papers referred to.

1. The duty to attach copies of papers referred to in the statement of grounds of appeal, as imposed by the original version of Article 10a(2), third sentence, RPBA, does not constitute a requirement for the admissibility of an appeal.

2. From the entry into force of the amended version of that provision, i.e. from 1 January 2005, copies of such papers are deemed to have been filed.

T0300/04

The brevity of the grounds of appeal corresponds to that of the reason of the impugned decision.

T1248/03 [T0300/04, T1059/04, T0597/05, T0922/05, T0809/06]

Present a complete case with the submissions of the Statement of Grounds of Appeal. Article 10(a)(2) and (b)(1) RPBA.

T1045/02

Not: dealt with only one of several grounds for rejection.

The minimum requirements for a statement of grounds of appeal are not fulfilled if they deal with only one of several grounds for rejection.

T0808/01

One of several argumentation lines sufficient.

T0165/00

Not: Merely refer to submissions in the previous instance. Minimum requirements in the particular context of the case.

The question as to whether a statement of grounds in a particular case meets the minimum requirements of Article 108 EPC can only be decided in the particular context of the case.

A statement which merely refers to submissions of the appellant in the previous instance is, in general, considered as being insufficient.

T0950/99 [T0012/00]

With respect to at least one ground.

T1156/98

Statement that the appellant is prepared to amend the claims.

T0065/96

Irrelevancy and lack of cogency of the submitted arguments do not render the appeal inadmissible.

T0505/93

Admissibility of the opposition does not depend on the accuracy of the produced facts.

T0045/92

Not: Limiting the criticism to one of the reasons.

Where a statement of grounds of appeal limits its criticism to the fact that the decision of the first instance had drawn upon a feature not mentioned in the claim to support the existence of inventive step, it does not meet the requirement to file the grounds of appeal specified in Article 108 (3) EPC.

T0869/91

Only global reference to cited documents.

T0250/89

Document necessary to develop the case but held by a third party.

Whilst Board of Appeal practice allows the grounds for appeal to be presented in a notice of appeal which has been produced in due time, the grounds presented must still include the legal or factual reasons why the appeal should be allowed and the decision under appeal set aside. When trying to establish that he was not in a position to observe the time limit laid down in Article 108, third sentence, EPC, an appellant may not invoke the late production of a document necessary to enable him to develop his case but held by a third party, where it emerges from his correspondence that despite not having said document in his possession he had sufficient information available within the time limit to file a statement setting out the grounds of appeal in accordance with the requirements of the EPC.

T0220/83 [T0001/88, T0013/82, T0145/88, T0250/89, T0102/91, T0706/91, T0493/95, T0283/97, T0500/97]

Not only assert the incorrectness.

Grounds for appeal may not be confined to an assertion that the contested decision is incorrect but should state the legal or factual reasons why the decision should be set aside. It is not sufficient for the appellants merely to refer in general terms to passages from the literature showing the state of the art and to the guidelines without making their inferences adequately clear.

13.6.1. Reference to other submissions

T0100/04

Reference to a letter submitted earlier, even though the letter was referred to with the wrong date.

T0349/00 [T0295/04]

Referring to the first instance cannot as a rule replace the explicit indication.

Referring to one's own statement in the first instance cannot as a rule replace the explicit indication of the legal and real reasons for the appeal.

T0725/89

References to presented comments filed after the oral proceedings of the opposition.

T0432/88 [T0254/88, T0090/90, T0154/90, T0253/90, T0287/90, T0188/92, T0563/92, T0646/92, T0283/97, T0500/97]

Not globally refer to previous statement.

T0140/88 [T0725/89]

Reference to a statement filed earlier before the Opposition Division interpreted as a new filing.

T0355/86

General back-reference admissible.

14. appeal [A108]

T0848/08

Request for correction of application number in grounds of Appeal.

T0846/01

At least one of the grounds must relate to a point which could at least arguably have been decided in the appellant's favour. Res judicata.

For an appeal to be admissible, at least one of the grounds in the written statement of grounds of appeal must relate to a point which could at least arguably have been decided in the appellant's favour by the instance appealed from but which point had not been so decided, and such favourable decision on this point would have produced a different outcome.

T0715/01 [T1147/03]

Correction of the wrongly-named appellant.

Correction of the wrongly-named appellant in the statement of grounds of appeal allowed under Rule 65(2) EPC (applying the rationale of T0097/98).

T0298/97 [T1071/00, T0085/03]

Not: Party adversely affected not the party filing Grounds of Appeal.

Commercial interest insufficient to remedy deficiency in admissibility.

I. If 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.

II. No provision having been made in the Implementing Regulations pursuant to Article 133(3), last sentence EPC, the EPC does not currently allow the representation of one legal person by the employee of another economically related legal person.

III. Save in the limited situation of a transfer of the right to oppose a European patent (or to appeal or continue an opposition appeal) together with the related business assets of the opponent's business, a commercial interest in revocation of such patent is not a requirement for being an opponent. Nor is possession of such a commercial interest sufficient to allow a successor in business to take over and conduct opposition or 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.

IV. (a) In the absence of such evidence, the transfer of an opponent's business assets to two separate persons cannot give either of them the right to take over and conduct opposition or opposition appeal proceedings.

(b) When such evidence is present, only the transferee established by such evidence can acquire such a right.

Article 109ⁱ - Interlocutory revision

(1) If the **department**¹ whose **decision**² is contested **considers**³ the **appeal**⁴ to be **admissible**⁵ and **well founded**⁶, it shall **rectify**⁷ its **decision**⁸. This shall not apply where the appellant is **opposed**⁹ by another party to the proceedings.

(2) If the **appeal**¹⁰ is **not**¹¹ **allowed**¹² **within**¹³ three **months**¹⁴ **of**¹⁵ receipt of the statement of grounds, **it**¹⁶ shall be remitted to the Board of Appeal **without delay**¹⁷, and **without**¹⁸ **comment**¹⁹ as to its merit.

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ⁱ See decision of the Enlarged Board of Appeal G 3/03.

1. department [A109(1)]**T1234/03**

Formalities officer not entitled to decide that no rectification had been ordered.

Procedural violation occurred only after the appeal had been filed.

2. decision [A109(1)]**T0615/95 [T0001/06]**

Supplementary conditions for interlocutory revision as an annex.

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. Supplementary conditions for interlocutory revision as an annex to the reasons for the decision.

T0835/90

Revocation only according to Article 123(3).

3. considers [A109(1)]**T0704/05**

Not: Exercise of discretion. Precluded from giving reasons.

Decision pursuant to Article 109 EPC not an exercise of discretion. Precluded from giving its reasons for not granting interlocutory revision.

T1222/04

Second refusal decision may result. Not: Unconditional reimbursement.

Preliminary opinion may have been overoptimistic and/or outvoted within the Examining Division.

T0603/04

Refusal decision following interlocutory revision and reimbursement of the appeal fee.

Refusal decision following re-opening and continuation of proceedings after interlocutory revision of a previous refusal decision tainted by a substantial procedural violation and reimbursement of the appeal fee. Decision raising essentially the same substantive issues as the previous decision: Not ultra vires.

T0685/98 [T0861/03]

Manifest violation of a fundamental procedural right. Interlocutory revision irrespective of the substantive merits of the case.

Procedural request no reply for the purposes of Art. 96(3) EPC.

Refusal ultra vires.

Where a fundamental procedural right has manifestly been violated in a refusal pursuant to Article 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 since such a right must be safeguarded irrespective of the substantive merits of the case.

T0169/98 [T0650/03, T0778/06]

Amendments as proposed by the examining division but without making use of interlocutory revision.

The examination is continued on the basis of amendments proposed by the examining division but without making use of interlocutory revision.

T0919/95

No interlocutory revision simply to grant a patent according to an auxiliary request although main request is maintained.

Purpose of the interlocutory revision. Speeding up the procedure. "Reformatory" or "cassatory" interlocutory revision.

T0183/95

No automatic obligation to grant interlocutory revision. Refusal to grant interlocutory revision despite the insertion of a feature considered to be unobvious.

Where the claims were amended, together with filing the statement of grounds of appeal, by inserting a feature which was considered in the reasons for the decision to be unobvious, the refusal to grant interlocutory revision does not simply constitute a clear case of a substantial procedural violation. The insertion does not automatically lead to an obligation to grant interlocutory revision.

T0536/92

Circumstances giving rise to interlocutory revision.

T0047/90

In the case of amendments the appeal may be considered as well founded.

An appeal may be considered as well founded if an appellant no longer seeks grant of the patent with text as refused by the Examining Division, but proposes substantial amendments to the text which are clearly intended to overcome the objections raised in the decision under appeal.

3.1. *Obligation*

T0898/96

Notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Use not made of interlocutory revision.

The notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Failure to rectify by way of interlocutory revision is a substantial procedural violation but inequitable to refund the appeal fee.

T0180/95 [T0826/08]

Claims substantially amended to meet the ground for refusing the application.

Claims substantially amended to meet the grounds for refusing the application. Obligation of the examining division to grant interlocutory revision if only objections exist which were not subject of the contested decision.

T0648/94

Appeal removes the ground of the refusal. Obligation to grant interlocutory revision.

T0647/93 [T0808/94]

Interlocutory revision in the case of infringement of the right to be heard.

The provision of Article 113(2) EPC, that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation. In any case, such violation occurs when, as in the present case, the examining division does not make use of the possibility of granting interlocutory revision under Article 109 EPC, after the mistake has been pointed out in the grounds of appeal.

T0139/87 [T0219/93, T0648/94, T0794/95, T1113/06]

Obligation to rectify the decision, if the objections are met. Other irregularities do not preclude rectification of the decision.

1. An appeal by an applicant for a European patent is to be considered well founded if simultaneously amendments to the application are submitted which clearly meet the objections on which the contested decision relies.

2. In this case, the department that issued the contested decision must rectify that decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision.

4. *appeal* [A109(1)]

G0003/03

Request for reimbursement of the appeal fee.

Department of the first instance not competent to refuse the request for reasons of equity.

I. In the event of interlocutory revision under Article 109(1) EPC, the department of the first instance whose decision has been appealed is not competent to refuse a request of the appellant for reimbursement of the appeal fee.

II. The board of appeal which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted is competent to decide on the request.

J0032/95

Request for reimbursement of the appeal fee.

I. Under Rule 67 EPC, in the event of interlocutory revision, the department whose decision has been impugned does not have the power to refuse a requested reimbursement of the appeal fee.

II. Such power lies with the board of appeal.

III. If the department whose decision is contested considers the requirements of Article 109 EPC for interlocutory revision to be fulfilled, but not the requirements of Rule 67 EPC for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision.

T0647/99

Request for reimbursement of the appeal fees remitted to the Board of Appeal for decision.

T0939/95 [T0778/06]

Separate decision on rectification if there are further issues, such as the reimbursement of the appeal fee.

Under Article 109(2) EPC a file 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 for the appeal. Therefore, if further separate issues - such as reimbursement of the appeal fee - arise out of the appeal, the instance in charge of the case is obliged under Article 109(2) EPC to take a separate decision on rectification before the end of the one-month time period, as soon as it realises that a

decision on any further issue cannot be taken within that period.

5. admissible [A109(1)]

T0808/03

Decision by DG2 formalities officer granting restitutio in integrum for a late-filed notice of appeal, ultra vires, null and void.

T0473/91 [T0949/94, T0303/05]

On the basis of the appeal submissions themselves. Not: Restitutio in integrum into a time limit relating to the appeal itself.

The admissibility question under Article 109 EPC only falls under the jurisdiction of the department of first instance when this question can be decided immediately on the basis of the appeal submissions themselves (notice of appeal and statement of grounds, date of payment of the appeal fee). Consequently, the appellate instance has exclusive jurisdiction over a request for restitutio in integrum into a time limit relating to the appeal itself (Art. 108 EPC). The same instance then decides the admissibility issue accordingly (Art. 110(1) EPC in conjunction with Rule 65(1) EPC).

6. well founded [A109(1)]

T1222/04

Second refusal decision may result. Not: Unconditional reimbursement.

Preliminary opinion may have been overoptimistic and/or outvoted within the Examining Division.

T0603/04

Refusal decision following interlocutory revision and reimbursement of the appeal fee.

Refusal decision following re-opening and continuation of proceedings after interlocutory revision of a previous refusal decision tainted by a substantial procedural violation and reimbursement of the appeal fee. Decision raising essentially the same substantive issues as the previous decision: Not ultra vires.

T0685/98 [T0861/03]

Manifest violation of a fundamental procedural right.

Procedural request no reply for the purposes of Art. 96(3) EPC.

Refusal ultra vires.

Where a fundamental procedural right has manifestly been violated in a refusal pursuant to Article 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 since such a right must be safeguarded irrespective of the substantive merits of the case.

T0898/96

Notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Use not made of interlocutory revision.

The notice of appeal requests grant of patent with text as previously specified in communication under Rule 51(4). Failure to rectify by way of interlocutory revision is a substantial procedural violation but inequitable to refund the appeal fee.

T0142/96

Legal and factual issues.

Legal and factual issues considered to be well founded. Admissibility of appeal against a decision on rectification.

T0648/94

Appeal removes the ground of the refusal. Obligation to grant interlocutory revision.

T0647/93 [T0808/94]

Infringement of the right to be heard pointed in the grounds of appeal.

The provision of Article 113(2) EPC, that the European Patent Office shall consider and decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant for or proprietor of the patent, is a fundamental procedural principle, being part of the right to be heard, and is of such prime importance that any infringement of it, even as the result of a mistaken interpretation of a request, must, in principle, be considered to be a substantial procedural violation.

In any case, such violation occurs when, as in the present case, the examining division does not make use of the possibility of granting interlocutory revision under Article 109 EPC, after the mistake has been pointed out in the grounds of appeal.

T0219/93

Interlocutory revision by disposing of all objections raised without considering any other possible objections.

T0252/91

Interlocutory revision of an unfounded appeal.

Interlocutory revision of an unfounded appeal constitutes a substantial procedural violation.

6.1. Amendments

T0183/95

Insertion of a feature considered to be unobvious.

Where the claims were amended, together with filing the statement of grounds of appeal, by inserting a feature which was considered in the reasons for the decision to be unobvious, the refusal to grant interlocutory revision does not simply constitute a clear case of a substantial procedural violation. The insertion does not automatically lead to an obligation to grant interlocutory revision.

T0180/95 [T0826/08]

Claims substantially amended to meet the ground for refusing the application.

Claims substantially amended to meet the grounds for refusing the application. Obligation of the examining division to grant interlocutory revision if only objections exist which were not subject of the contested decision.

T0047/90

Amendments which are clearly intended to overcome the objections.

An appeal may be considered as well founded if an appellant no longer seeks grant of the patent with text as refused by the Examining Division, but proposes substantial amendments to the text which are clearly intended to overcome the objections raised in the decision under appeal.

T0139/87 [T0690/90, T0536/92, T1042/92, T1097/92, T0096/93, T0311/94, T0794/95, T0863/01, T1113/06]

Amendments meet objections.

1. An appeal by an applicant for a European patent is to be considered well founded if simultaneously amendments to the application are submitted which clearly meet the objections on which the contested decision relies.
2. In this case, the department that issued the contested decision must rectify that decision. Irregularities other than those that gave rise to the contested decision do not preclude rectification of the decision.

7. rectify [A109(1)]

G0003/03

Not: Competent to refuse the request for reimbursement.

Department of the first instance not competent to refuse the request for reasons of equity.

I. In the event of interlocutory revision under Article 109(1) EPC, the department of the first instance whose decision has been appealed is not competent to refuse a request of the appellant for reimbursement of the appeal fee.

II. The board of appeal which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted is competent to decide on the request.

J0032/95

Refusal of the request for reimbursement of the appeal fee only by the boards of appeal.

I. Under Rule 67 EPC, in the event of interlocutory revision, the department whose decision has been impugned does not have the power to refuse a requested reimbursement of the appeal fee.

II. Such power lies with the board of appeal.

III. If the department whose decision is contested considers the requirements of Article 109 EPC for interlocutory revision to be fulfilled, but not the requirements of Rule 67 EPC for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision.

T0303/05

Cannot be set aside by the Examining Division, let alone by a Formalities Officer.

A decision to grant interlocutory revision, once validly taken and irrespective of whether the department of first instance was correct in considering the appeal to be admissible and well founded, cannot be set aside by the Examining Division, let alone by a Formalities Officer. The grant of interlocutory revision communicated to the applicant (appellant) is not invalidated by the mere fact that there is no record on the file that the interlocutory revision had been ordered by all three members of the Examining Division. *Venire contra factum proprium*.

T1222/04

Second refusal decision may result. Not: Unconditional reimbursement.

Preliminary opinion may have been overoptimistic and/or outvoted within the Examining Division.

T0603/04

Refusal decision following interlocutory revision and reimbursement of the appeal fee.

Refusal decision following re-opening and continuation of proceedings after interlocutory revision of a previous refusal decision tainted by a substantial

procedural violation and reimbursement of the appeal fee. Decision raising essentially the same substantive issues as the previous decision: Not ultra vires.

T0843/03 [T0935/03, T0303/05]

Doubts as to the true intention.

T0647/99

Request for reimbursement of the appeal fees remitted to the Board of Appeal for decision.

T0939/95 [T0778/06]

Separate decision on rectification if there are further issues, such as the reimbursement of the appeal fee.

Under Article 109(2) EPC a file 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 for the appeal. Therefore, if further separate issues - such as reimbursement of the appeal fee - arise out of the appeal, the instance in charge of the case is obliged under Article 109(2) EPC to take a separate decision on rectification before the end of the one-month time period, as soon as it realises that a decision on any further issue cannot be taken within that period.

T0919/95

Speeding up the procedure. "Reformatory" or "casatory" interlocutory revision.

Purpose of the interlocutory revision. No interlocutory revision simply to grant a patent according to an auxiliary request although main request is maintained.

T0691/91

Not: Maintain the decision in amended form.

T0252/91

Not: Repeat or maintain the decision without amendment.

Interlocutory revision of an unfounded appeal constitutes a substantial procedural violation.

8. decision [A109(1)]

T0021/02 [T0242/05]

Not: Request for reimbursement submitted only after the contested decision had been rectified.

Where a request for reimbursement of the appeal fee pursuant to Rule 67 EPC was submitted only after the contested decision had been rectified under Article 109(1) EPC, the procedural situation differs from that underlying decisions G0003/03 and J0032/95 and, failing a decision of the department of first instance,

no legal basis exists for the Board of Appeal to decide on that request.

9. opposed [A109(1)]

T0168/03

Not: Parties other than the proprietor of the patent are not involved.

Correction of errors made by the office. Interlocutory revision in opposition procedures possible in special cases.

Legitimate interest of parties other than the proprietor of the patent are not involved.

T0835/90

Interlocutory revision in opposition proceedings.

10. appeal [A109(2)]

G0003/03

Request for reimbursement of the appeal fee.

Department of the first instance not competent to refuse the request for reasons of equity.

I. In the event of interlocutory revision under Article 109(1) EPC, the department of the first instance whose decision has been appealed is not competent to refuse a request of the appellant for reimbursement of the appeal fee.

II. The board of appeal which would have been competent under Article 21 EPC to deal with the substantive issues of the appeal if no interlocutory revision had been granted is competent to decide on the request.

J0032/95

Request for reimbursement of the appeal fee.

I. Under Rule 67 EPC, in the event of interlocutory revision, the department whose decision has been impugned does not have the power to refuse a requested reimbursement of the appeal fee.

II. Such power lies with the board of appeal.

III. If the department whose decision is contested considers the requirements of Article 109 EPC for interlocutory revision to be fulfilled, but not the requirements of Rule 67 EPC for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision.

T0647/99

Request for reimbursement of the appeal fees remitted to the Board of Appeal for decision.

11. not [A109(2)]

T1234/03

Formalities officer not entitled.

Formalities officer not entitled to decide that no rectification had been ordered.

Procedural violation occurred only after the appeal had been filed.

T0843/03 [T0935/03, T0303/05]

Doubts as to the true intention.

12. allowed [A109(2)]

T1222/04

Notifying Form 2710.

It may be questionable whether interlocutory revision should have been granted (by notifying Form 2710) at a point in time when the Examining Division had already communicated reasons for refusing the amended claims. In fact, the Examining Division was acting ultra vires when it communicated such reasons before notifying the rectification of its decision.

13. within [A109(2)]

T0778/06 [T1222/04]

Not: Late interlocutory revision. Competence ends with expiry of the three month time limit.

Late interlocutory revision.

The competence of the first instance, whose decision is contested with the appeal, ends with expiry of the three month time limit in accordance with Article 109 (2) EPC. After that interlocutory revision is no longer possible.

T1222/04

Notifying Form 2710.

It may be questionable whether interlocutory revision should have been granted (by notifying Form 2710) at a point in time when the Examining Division had already communicated reasons for refusing the amended claims. In fact, the Examining Division was acting ultra vires when it communicated such reasons before notifying the rectification of its decision.

14. months [A109(2)]

T1222/04

Examining Division was acting ultra vires when it communicated reasons before notifying Form 2710.

It may be questionable whether interlocutory revision should have been granted (by notifying Form 2710) at a point in time when the Examining Division had

already communicated reasons for refusing the amended claims. In fact, the Examining Division was acting ultra vires when it communicated such reasons before notifying the rectification of its decision.

T0180/04

Interlocutory revision of the appeal not submitted to the examining division in time.

T1097/92 [T1042/92]

The one-month term has to be strictly adhered to.

In certain situations, a telephone contact with the Appellant during the term available for any interlocutory revision may be appropriate and indeed helpful. If such a telephone contact is held, however it should not be recorded in writing in such a way as to constitute a comment on the merits of the appeal.

15. of [A109(2)]

T1891/07

Wait until the filing of the full content of the statement of grounds.

T0041/97

Not: Before.

Appeal not to be remitted to the board of appeal before receipt of the statement of grounds of appeal. Interlocutory revision.

16. it [A109(2)]

T0021/02 [T0242/05]

Not: Request for reimbursement submitted only after the contested decision had been rectified.

Where a request for reimbursement of the appeal fee pursuant to Rule 67 EPC was submitted only after the contested decision had been rectified under Article 109(1) EPC, the procedural situation differs from that underlying decisions G0003/03 and J0032/95 and, failing a decision of the department of first instance, no legal basis exists for the Board of Appeal to decide on that request.

17. without delay [A109(2)]

J0030/94

Delay in remitting.

After withdrawal of an appeal a reimbursement of the appeal fee can exceptionally be ordered if the appeal was not remitted to the Board of Appeal within a reasonable time after the first instance decision not to allow it.

T0939/95 [T0778/06]

Separate decision on rectification if there are further issues, such as the reimbursement of the appeal fee.

Under Article 109(2) EPC a file 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 for the appeal. Therefore, if further separate issues - such as reimbursement of the appeal fee - arise out of the appeal, the instance in charge of the case is obliged under Article 109(2) EPC to take a separate decision on rectification before the end of the one-month time period, as soon as it realises that a decision on any further issue cannot be taken within that period.

18. without [A109(2)]**T0704/05**

Not: Exercise of discretion. Precluded from giving reasons.

Decision pursuant to Article 109 EPC not an exercise of discretion. Precluded from giving its reasons for not granting interlocutory revision.

19. comment [A109(2)]**T1222/04**

Examining Division was acting ultra vires when it communicated reasons before notifying Form 2710.

It may be questionable whether interlocutory revision should have been granted (by notifying Form 2710) at a point in time when the Examining Division had already communicated reasons for refusing the amended claims. In fact, the Examining Division was acting ultra vires when it communicated such reasons before notifying the rectification of its decision.

T1097/92

Telephone contact should not be recorded as to constitute a comment on the merits.

The one-month term stipulated by Article 109(2) has to be strictly adhered to. In certain situations, a telephone contact with the Appellant during the term available for any interlocutory revision may be appropriate and indeed helpful. If such a telephone contact is held, however it should not be recorded in writing in such a way as to constitute a comment on the merits of the appeal.

Article 110¹ - Examination of appeals

If the appeal is **admissible**¹, the Board of Appeal shall **examine**² whether the **appeal**³ is **allowable**⁴. The examination of the appeal shall be conducted in accordance with the Implementing Regulations.

Ref.: R. 100-102, 111-113

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ⁱ See decisions/opinions of the Enlarged Board of Appeal G 9/91, G 10/91, G 10/93, G 3/99.

1. admissible [A110]**G0008/91**

Withdrawal of the appeal of the sole appellant.

In so far as the substantive issues settled by the contested decision at first instance are concerned, appeal proceedings are terminated, in ex parte and inter partes proceedings alike, when the sole appellant withdraws the appeal.

J0015/08

Only request (1) is directed to the request for re-establishment of rights desired in the case by the appellant and which was rejected by the Examining Division in the contested decision.

J0014/03

Not: Decision was quite simply the inevitable consequence of the appellant's own actions and inactions. Loss of priority.

No request, evidence or argument by appellant in first instance proceedings.

Decision was quite simply the inevitable consequence of the appellant's own actions and inactions, namely seeking a decision in the absence of any request while failing to make any case whatsoever.

Evidence available or obtainable prior to first instance decision but only filed on appeal.

J0024/01

A second appeal against a decision is devoid of any object and accordingly inadmissible.

J0007/00

Due to completion elsewhere only the reply to a question of law.

Owner's procedure for the return of his property. Date of suspension of proceedings to grant according to rule 13 EPC.

Admissibility of an appeal if, because of completion elsewhere, only the reply to a question of law can be made.

T1790/08

Clarify true identity of the opponent.

T1425/05

Application of the principle of prohibition of reformatio in peius is a matter of allowability, not a matter of admissibility.

T0152/82 [T0109/86]

Binding ruling given in an interlocutory decision.

The admissibility of an appeal may be established in an interlocutory decision.

2. examine [A110]**G0008/91**

Withdrawal of the appeal of the sole appellant.

In so far as the substantive issues settled by the contested decision at first instance are concerned, appeal proceedings are terminated, in ex parte and inter partes proceedings alike, when the sole appellant withdraws the appeal.

T0501/92

Absence of a request from the respondent.

The absence of a request from the Proprietor for maintenance of the patent, during opposition appeal proceedings, is not in itself a ground for allowing the appeal and revoking the patent.

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 Articles 110 and 111 EPC.

3. appeal [A110]**T0981/01**

Obiter dicta not part of the decision itself.

T0473/98 [T0915/98, T0725/05]

Obiter dicta in the revocation decision. Reformatio in peius.

I. 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 Article 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.

II. An opponent is not adversely affected by such findings favourable to the proprietor included in a revocation decision nor is the proprietor as sole appellant protected against a reformatio in peius in respect of such findings.

The mere fact that in the present case such findings were somewhat misleadingly referred to in the pronouncement as "further decisions" "included" in the decision proper did not, in the judgement of the board, constitute a substantial procedural violation.

T0154/95 [T0270/94, T0774/05]

Citing of a prior use which was invoked by an other opponent whose opposition was judged inadmissible.

Admissibility of a prior use invoked after expiry of the opposition period by a second opponent.

In opposition or appeal proceedings it is basically irrelevant how an opponent comes across documents or other evidence made available to the public. So there is nothing to stop an opponent from citing a prior use invoked in the same case by another opponent whose opposition is inadmissible.

T0003/95

Problem-solution approach. Problem neither disclosed nor solved.

T0455/94

State of the art under Article 54(3) must be interpreted as an objection of lack of novelty.

The mere fact that an earlier European application has been referred to in the notice of opposition as being comprised in the state of the art under Article 54(3), (4) EPC, must be interpreted as an objection of lack of novelty, even if this ground for opposition was not mentioned as such expressis verbis in the notice of opposition.

Novelty of a kit with completely separate elements of which one is known.

3.1. Power to examine

G0010/93

Inclusion of further patenting requirements in ex-parte proceedings.

In an appeal from a decision of an examining division in which a European patent application was refused the board of appeal has the power to examine whether the application or the invention to which it relates meets the requirements of the EPC. The same is true for requirements which the examining division did not take into consideration in the examination proceedings or which it regarded as having been met. If there is reason to believe that such a requirement has not been met, the board shall include this ground in the proceedings.

T0051/08

Principle of res iudicata applied in the divisional application.

Subject matter on which a final decision has been taken by a board of appeal in the parent application becomes res iudicata and cannot be pursued in the divisional application.

If the statement setting out the grounds of appeal in a case does not go beyond submitting and arguing for a set of claims which constitutes such subject matter, the appeal is not sufficiently substantiated.

T1355/04

Not: Limited to only considering passages in documents indicated and facts submitted by the parties.

T1254/06

Res judicata. Pursuing of requests in a parent application after rejection by the first instance of identical requests in the divisional application.

T1180/04

Refused auxiliary request for which the examining division proposed the grant of a patent.

T1134/04

Claim of divisional application is a restricted version of claim granted in parent application pursuant to a previous decision of the Board in a different composition. No reason to depart from its earlier reasoning.

T0272/04 [T1016/96, T0938/98]

Ex-parte. Introduction of a new highly relevant document ex officio. Procedural economy.

The introduction of a new document ex officio in ex-parte appeal proceedings is admissible if this document is highly relevant for the examination of the patentability.

The remittal to the previous instance is at the discretion of the Board. This Board exercises its discretion among other things by considering general procedural economy.

T0064/02

Single request in accordance with an auxiliary request rejected by the Opposition Division on the grounds of being filed late.

Not: Procedural violation by non-admission of a further auxiliary request filed just before the oral proceedings.

If the only request of the appellant is directed to maintaining the patent in accordance with an auxiliary request which was rejected by the Opposition Division on the grounds of being filed late, then the appeal can be rejected without examining of the allowability of this request if the Board is of the opinion that the non-admission of the auxiliary request was justified.

T0385/97 [T1124/02]

Highly relevant matter which is clearly available in the file. Competence of the board.

If first instance departments and/or parties have failed to take account of highly relevant matter which is clearly available in the file and which relates to a ground of opposition, the Board's competence extends to rectifying the position by consideration of that matter provided the parties' procedural rights to fair and equal treatment are respected.

T0715/94

Document cited in the search report invoked by the board.

Document cited in the search report and in the notice of appeal only in relation to dependent claims invoked by the board as novelty-destroying for the independent claim.

T0442/91 [T0740/96, T0223/05]

Not: Determination of the scope of protection.

If the legal requirements have been met in the case of an amendment to a claim, the determination of the scope of protection is not a matter for the appeal proceedings.

It is not the responsibility of the EPO, but that of the national courts, to determine the future scope of protection of a European patent.

T0026/88

Essential function is to determine whether the decision issued by the first instance department was correct on its merits.

3.1.1. Opposition appeal

G0009/91

Extent pursuant to Rule 55(c) in an opposition appeal.

The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC. However, subject-matters of claims depending on an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is *prima facie* in doubt on the basis of already available information.

T0079/07

Rule 140 EPC. No competence for verifying conformity of examining division's correction decision.

Neither the opposition division nor the board of appeal in opposition appeal proceedings has any competence to verify whether the examining division's decision to

correct its grant decision complies with the requirements of Rule 89 EPC 1973.

T0911/06

Maintenance of the patent as granted as an auxiliary request.

When, as in the present case, it is clear from the statement of grounds of appeal that the appellant proprietor contests a decision that the patent cannot be maintained as granted, and when the appellant proprietor finally requests the maintenance of the patent as granted as an auxiliary request which is subordinate to a main or auxiliary request for maintenance of the patent in a new amended form that was filed during the appeal, the correctness of the decision refusing the maintenance of the patent as granted has to be examined first, before examining the new amended claims. Since in the present case it is clear from the statement of grounds of appeal that the appellant opponent contests a decision maintaining the patent in a particular amended form, and since, in the appellant proprietor's final requests, the maintenance of the patent in that particular amended form is the subject of an auxiliary request that is subordinate to one or more requests for maintenance of the patent in some other amended form, the Board decides, after examining the correctness of the decision refusing the maintenance of the patent as granted, to examine the correctness of the decision maintaining the patent in the particular amended form that was the subject of the appealed decision before examining, and deciding upon, the patent in any other amended form finally requested.

T0913/05

Amendment based on a granted dependent claim created a fresh case.

By deleting all claims as granted of one category, restricting the defence of the patent to the subject-matter of a combination of granted claims of another category and relying on an alleged combinatory effect of the features of the thereby formed independent claim, the amendments made to the patent as granted have in substance created a fresh case which justifies examination as to whether the amended patent meets the requirements of the EPC.

T0864/02 [T0233/93]

Opponents have exactly the same rights. Not: Non-appealing opponent can be prohibited from raising novelty objection.

T0653/02 [T0198/05]

No competence of the Board to examine a combination with a sub-claim not being opposed.

Extent to which patent is opposed - transcended by amendment.

No competence of the Board to examine a claim derived by combination of granted claim 1 with a sub-claim not being within the extent to which the patent had been opposed.

T0646/02

Board has no power to examine when the claims are limited to a subject-matter which does not form part of the opposition.

T0268/02

Indirect competence of the opposition division and of the Board of appeal to verify whether the examining division has taken into account the provisions of Rule 89 EPC.

T1161/01

Appellant does not approve the version. Rejection of the appeal without substantive examination.

The appeal against the revocation of a patent must be rejected without substantive examination if the patent proprietor as appellant no longer approves the granted version of the patent and does not submit an other version of the patent.

T1098/01

The respondents agree expressly with the amendments.

Opening statement regarding the scope limited by withdrawal of the former main request.

If the patent proprietor as single appellant makes amendments in opposition appeal proceedings to the version of the patent in accordance with the interlocutory decision, the Board has the competence and obligation to examine these amendments of its own accord in respect of formal and substantive matters even than if the respondents agree expressly with these amendments.

T1126/00

Appellant and Respondent filed the same request. Principle of party disposition.

If both the Patentee and the Opponent who is the sole Appellant request the maintenance of the patent in amended form according to a new set of claims, the power of the Board of Appeal to examine the subject-matter of these claims in substance is limited due to the principle of party disposition.

T0701/97 [T0036/02, T1124/02]

Arguments not raised by one of the parties, which are of decisive importance in the correct assessment.

Procedural status of a non-appealing opponent in the case of rejection of multiple oppositions.

Where Article 100(c) EPC has been raised as a ground for opposition and has been considered in the appealed decision, it is the board's duty to assess correctly whether or not the respondent's requests comply with said Article. Hence, the board has to consider all arguments which are relevant, independently of

- the point in time at which they were introduced into the proceedings,

- the procedural status of the party who actually introduced them, and

- whether or not a given party, relying on these arguments, had based its initial opposition on this ground.

Once the board has become aware, during the prosecution of the case, of additional arguments not raised by one of the parties, and which are of decisive importance in the correct assessment of the case within the given framework of Article 100(c) EPC, it has the power and the duty to bring them into consideration in the course of the proceedings.

T0470/97

Abuse of procedure: Further impediments to patentability raised for the first time in the oral proceedings.

1. Where the opposing appellant bases an objection on a single reason only (here: lack of disclosure, Article 83 EPC) before expiry of the period for the statement of grounds of appeal, without disputing the decision pronounced by the first instance with regard to other impediments to patentability, then the appeal procedure is limited on principle to this reason. This follows from an analogous application of the decision G0009/91, where an opponent is on principle limited to the reasons he has indicated before expiry of the opposition period, unless the other party agrees that further reasons are considered. The introduction of further reasons in the appeal procedure, such as lack of novelty and inventive step of the claim subject-matter is within the discretion of the Board of Appeal, if necessary with the agreement of the other party.

2. A request made for the first time in the oral proceedings before the Board of Appeal, even to consider lack of inventive step of the claim subject-matter, always represents an abuse of procedure if the appellant fails to reply to a communication of the Board of Appeal, in which the parties were informed more than half a year prior to the proceedings that the said proceedings would limit themselves to the lack of disclosure (Article 83 EPC). Such a request will not be admitted by the Board of Appeal.

T0525/96

Power of the board to examine a product-by-process claim not explicitly opposed.

The relationship between a product-by-process claim and the original process claim for the assessment of patentability is even stronger than that between independent and dependent claims, since the invalidity of the product-by-process claim follows directly from the invalidity of the process claim.

T0443/96 [T0300/04]

In opposition appeal proceedings the board has no right to examine amendments from the examination procedure without approval of the patentee or submission of the opponent.

In opposition appeal proceedings the board has no right to examine amendments from the examination procedure concerning admissibility according to Article 123(2) EPC without approval of the patentee or submission of the opponent, if the patentee's arguments are convincing that, prima facie, these amendments of the application as filed are correctly based on the application as filed.

T0481/95

In opposition appeal proceedings clarity only in connection with amendments.

In opposition appeal proceedings the examination of the clarity of claims and description is carried out only in connection with amendments of the granted documents.

T0968/92

Claims whose content remained unchanged after the removal of the references in dependent claims.

Claims whose content remains 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.

T0856/92 [T0223/05, T0887/08]

No examination of claims not under appeal.

T0327/92 [T0169/93, T1341/04]

Opposition grounds on appeal when the patent was revoked.

Jurisdiction of Board of Appeal to consider opposition grounds on appeal where patent revoked by first instance

Where a patent has been revoked by the Opposition Division, then on appeal the Board of Appeal is entitled to consider all material in the opposition on all grounds originally alleged, even where the opponent no longer opposes the grant of a patent and the conclu-

sion of the Board on a particular ground differs from that of Opposition Division.

3.1.2. Reformatio in peius

G0001/99

Reformatio in peius; exception to the prohibition.

In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision.

In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;
- 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 Article 123(3) EPC;
- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC.

G0009/92 [G0004/93, T0369/91, T0488/91, T0266/92, T0321/93, T0752/93, T0828/93, T0815/94, T1002/95, T0637/96]

Reformatio in peius. Binding effect for the Board of Appeal.

1. If the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in amended form, neither the Board of Appeal nor the non-appealing opponent as a party to the proceedings as of right under Article 107, second sentence, EPC, may challenge the maintenance of the patent as amended in accordance with the interlocutory decision.

2. If the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily restricted during the appeal proceedings to defending the patent in the form in which it was maintained by the Opposition Division in its interlocutory decision. Amendments proposed by the patent proprietor as a party to the proceedings as of right under Article 107, second sentence, EPC, may be rejected as inadmissible by the Board of Appeal if they are neither appropriate nor necessary.

T0384/08

Transfer of opponent status refused by first instance, no res judicata. Prohibition of reformatio in peius not applicable.

T0659/07

Patentee is sole appellant; patent as maintained cannot be objected to by the Board. Article 123(2) EPC.

If the patentee is the sole appellant, the patent as maintained by the opposition division in its interlocutory decision cannot be objected to by the Board of Appeal either at the request of the respondent/opponent or ex officio, even if the patent as maintained would otherwise have to be revoked on the ground that a feature present in both claim 1 as granted and as maintained amended introduces added subject-matter contrary to Article 123(2) EPC.

T0817/05

Disclaimer deleted.

T0127/05

Withdrawing the appeal. Disadvantageous outcome.

The sole appellant has the possibility of withdrawing its appeal if it finds that the outcome would be disadvantageous to itself.

T0149/02

Not: Reasoning leading to the impugned decision.

The doctrine of prohibition of reformatio in peius, cannot be construed to apply separately to each point or issue decided, or the reasoning leading to the impugned decision.

T0092/01

Maintained in modified version for a part of the designated States. Board is authorised to examine and decide for the other States.

Prohibition of "reformatio in peius".

The Board is authorised in the case of a single appeal by the patent proprietor against a decision according to which the patent was maintained only in a modified version for a part of the designated States, to examine and decide for the other States whether the version of the patent maintained by the opposition division is new and inventive. The rejection of the appeal in the negative case would not infringe the prohibition of the reformatio in peius.

T0724/99

Alternative amendment not leading to reformatio in peius. Not requested.

Applicability of decision G0001/99 to amendments filed before.

Alternative amendment not leading to reformatio in peius is possible but no such amendment requested by the Respondent (Patentee).

T0893/96 [T0915/95]

Too broad a disclaimer not deemed unallowable until opposition appeal proceedings. Reformatio in peius.

T0239/96

In the absence of a provision on cross-appeal, reformatio in peius cannot be ruled out altogether.

Keeping the granted claims as main request.

T0401/95 [T0583/95, T0542/96, T0149/02]

Board not bound by decision of first instance on each separate issue.

Jurisdiction of Board of Appeal on issues arising from a request rejected by the first instance.

The board is not bound by the decision of the first instance on each separate issue.

3.1.3. Withdrawal

T0304/99

Conditional withdrawal of the appeal. Complete deletion of the sole contested patent claim.

Conditional withdrawal of the appeal. Abolition of the suspensive effect of the appeal by such a withdrawal. Authority of the Board after complete deletion of the sole contested patent claim.

T0233/93

If the appellant II withdraws his appeal but not his opposition, he falls back into the role of a party. As appellant I only objected to those parts of the impugned decision which relate to product claims the Board is not authorised to question the patentability of the process claims.

If the appellant II withdraws his appeal but not his opposition, he falls back into the role of a party as of right in the sense of Article 107 EPC, second sentence and the scope of the appeal is defined by the request of appellant I, which the non-appealing party may not exceed. As appellant I only objected to those parts of the impugned decision which relate to product claims the Board is not authorised to question the patentability of the process claims.

T0006/92

Partial withdrawal of an opposition appeal following an allowable limitation of the patent's subject-matter.

The partial withdrawal of an opposition appeal by the sole appellant following an allowable limitation of the patent's subject-matter under Art. 123 EPC deprived the board of its discretionary power to examine the substantive merits of the remaining, limited subject-matter.

3.2. New grounds for opposition

G0010/91 [G0007/95, G0001/95, T0018/93, T0443/93, T0928/93, T1007/95, T0190/05]

Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

1. An Opposition Division or a Board of Appeal is not obliged to consider all the grounds for opposition referred to in Article 100 EPC, going beyond the grounds covered by the statement under Rule 55(c) EPC.

2. In principle, the Opposition Division shall examine only such grounds for opposition which have been properly submitted and substantiated in accordance with Article 99(1) in conjunction with Rule 55(c) EPC. Exceptionally, the Opposition Division may in application of Article 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.

T1300/06

In the context of the amended request. Remittal.

T0913/05

Not: Amendment based on a granted dependent claim created a fresh case.

By deleting all claims as granted of one category, restricting the defence of the patent to the subject-matter of a combination of granted claims of another category and relying on an alleged combinatory effect of the features of the thereby formed independent claim, the amendments made to the patent as granted have in substance created a fresh case which justifies examination as to whether the amended patent meets the requirements of the EPC.

T0395/00

Not: New attack represents a new argument.

T0693/98 [T0300/04]

Objection under Article 123(2) EPC at the appeal stage results from an amendment made before grant.

The fact that amendments have been made to a claim in the course of the opposition proceedings does not allow an opponent to raise an admissible objection under Article 123(2) EPC at the appeal stage in the

absence of the patentee's agreement, if such objection results from an amendment made before grant and has not been originally raised as a ground for opposition under Article 100(c) EPC pursuant to Rule 55(c) EPC.

T0128/98 [T0101/00, T0736/05]

Mere reference to Article 100(c) EPC.

Objections based upon a fresh ground for opposition. The mere reference to Article 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 does not deal in a substantial way with this ground for opposition.

T0027/95

New opposition grounds against claims amended in appeal proceedings.

T0105/94

Grounds of appeal of the opponent which were not substantiated in the notice of opposition are not admissible at appeal stage.

3.2.1. From opposition proceedings

T0986/04

Further appeal proceedings following remittal. Fresh ground.

T0894/02

Ground of opposition abandoned during the opposition proceedings, not admitted in appeal proceedings.

T0520/01 [T0376/04]

Re-introduction constitutes a fresh ground. Not: Party which raised the ground does not appear at the opposition oral proceedings.

1. Where a ground of opposition, here insufficiency, was expressly not maintained in opposition oral proceedings by the only party which had relied on the ground and the Opposition Division did not deal with the ground in their decision the re-introduction of the ground in appeal proceedings constitutes a fresh ground which, following Opinion G0010/91 by analogy, requires the permission of the proprietor.

2. Where a ground, here novelty, was substantiated within the opposition period and the party which raised the ground neither appears at the opposition oral proceedings nor withdraws the ground the Opposition Division has to deal with the ground in their decision. The ground may then be taken up by other appellants in subsequent appeal proceedings.

T0135/01

Confirmation of novelty by opposition division is not implying introduction of lack of novelty as a ground for opposition.

T0274/95 [T0151/99, T0877/01]

A ground of opposition which shall be re-introduced is not a "fresh ground of opposition".

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the Opposition Division proceedings (here: a statement to that effect is made by the opponent during oral proceedings), the Opposition Division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent.

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the Opposition Division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of Opinion G0010/91, and may 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.

T0309/92 [T0931/91, T1070/96]

The Board of Appeal has the right to decide upon a ground for opposition which the Opposition Division has examined of its own motion.

T0931/91 [T0309/92]

New ground for opposition examined ex officio in opposition proceedings.

The Board of Appeal is empowered to examine and rule upon a new ground for opposition examined ex officio in opposition proceedings.

4. allowable [A110]

T0433/93

Following a substantial procedural violation in connection with a decision, at the request of a party, the decision has to be set aside.

Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside. If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division.

Article 111¹ - Decision in respect of appeals

(1) **Following**¹ the examination as to the allowability of the **appeal**², the Board of Appeal shall **decide**³ on the **appeal**⁴. The Board of Appeal may either **exercise**⁵ any power **within**⁶ the competence of the department which was responsible for the decision appealed or **remit**⁸ the **case**⁹ to **that**¹⁰ department for **further**¹¹ prosecution.

(2) If the Board of Appeal remits the **case**¹² for **further**¹³ prosecution to the **department**¹⁴ whose decision was appealed, that **department**¹⁵ shall be **bound**¹⁶ by the **ratio decidendi**¹⁷ of the **Board of Appeal**¹⁸, **in so far as**¹⁹ the **facts**²⁰ are **the same**²¹. If the decision under appeal was taken by the Receiving Section, the Examining Division shall also be **bound**²² by the **ratio decidendi**²³ of the Board of Appeal.

Ref.: Art. 112a, R. 100-103, 111, 140

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ⁱ See decisions of the Enlarged Board of Appeal G 9/92, G 10/93, G 3/03.

1. Following [A111(1)]**T1033/04**

Withdrawal of appeal made by the (sole) appellant after the final decision had been announced at oral proceedings.

A statement of withdrawal of appeal made by the (sole) appellant after the final decision of the Board had been announced at oral proceedings does not relieve the Board of its duty to issue and to notify to the appellant the decision in writing setting out the reasons for the decision in order to conclude the decision-taking procedure triggered by the announcement of the final decision at the oral proceedings.

T0544/02

Decision requested on the file as it stands.

Finally the appellant did not counter the grounds but requested a decision on the file as it stood.

T0716/01

Withdrawal of requests thereafter can have no effect on the proceedings.

Since the decision ends the dispute between the parties, the withdrawal of requests thereafter can have no effect on the proceedings.

T0515/94 [T0609/03]

Termination of the appeal procedure in oral proceedings.

When a final decision is given orally at the end of oral proceedings the appeal procedure is thereby terminated. Accordingly all submissions made after the closure of said procedure may not be considered by the Board.

T0296/93

Documents submitted following announcement of the decision are not taken into consideration.

T0843/91 [T0304/92, T0296/93, T1895/06]

Desirability of ending of legal disputes, vexatious proceedings.

2. appeal [A111(1)]**T0986/04**

Further appeal proceedings following remittal. Fresh ground.

T0894/02

Ground of opposition abandoned during the opposition proceedings, not admitted in appeal proceedings.

T1098/01

The respondents agree expressly with the amendments.

Opening statement regarding the scope limited by withdrawal of the former main request.

If the patent proprietor as single appellant makes amendments in opposition appeal proceedings to the version of the patent in accordance with the interlocutory decision, the Board has the competence and obligation to examine these amendments of its own accord in respect of formal and substantive matters even than if the respondents agree expressly with these amendments.

T0520/01 [T0376/04]

Re-introduction constitutes a fresh ground. Not: Party which raised the ground does not appear at the opposition oral proceedings.

1. Where a ground of opposition, here insufficiency, was expressly not maintained in opposition oral proceedings by the only party which had relied on the ground and the Opposition Division did not deal with the ground in their decision the re-introduction of the ground in appeal proceedings constitutes a fresh ground which, following Opinion G0010/91 by analogy, requires the permission of the proprietor.

2. Where a ground, here novelty, was substantiated within the opposition period and the party which raised the ground neither appears at the opposition oral proceedings nor withdraws the ground the Opposition Division has to deal with the ground in their decision. The ground may then be taken up by other appellants in subsequent appeal proceedings.

T1126/00

Appellant and Respondent filed the same request. Principle of party disposition.

If both the Patentee and the Opponent who is the sole Appellant request the maintenance of the patent in amended form according to a new set of claims, the power of the Board of Appeal to examine the subject-matter of these claims in substance is limited due to the principle of party disposition.

T0304/99

Conditional withdrawal of the appeal. Complete deletion of the sole contested patent claim.

Abolition of the suspensive effect of the appeal by such a withdrawal. Authority of the Board after complete deletion of the sole contested patent claim.

T0128/98 [T0101/00, T0736/05]

Mere reference to Article 100(c) EPC.

Objections based upon a fresh ground for opposition.

The mere reference to Article 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 does not deal in a substantial way with this ground for opposition.

T0481/95

In opposition appeal proceedings clarity only in connection with amendments.

In opposition appeal proceedings the examination of the clarity of claims and description is carried out only in connection with amendments of the granted documents.

T0274/95 [T0151/99, T0877/01]

A ground of opposition which is sought to be re-introduced is not a "fresh ground of opposition".

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the Opposition Division proceedings (here: a statement to that effect is made by the opponent during oral proceedings), the Opposition Division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent.

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the Opposition Division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of opinion G0010/91, and may 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.

T0006/92

Partial withdrawal of the appeal following limitation of the patent's subject-matter.

The partial withdrawal of an appeal by the sole appellant following an allowable limitation of the patent's subject-matter under Art. 123 EPC deprived the board of appeal of its discretionary power to examine the substantive merits of the remaining, limited subject-matter.

T0784/91 [T1058/97, T1069/97, T0230/99]

As the file stands if the appellant does not wish to comment on the case.

If in ex parte proceedings the appellant indicates that he does not wish to comment on the case, this can be construed as signifying agreement to a decision being taken on the case as the file stands.

3. decide [A111(1)]

G0001/97 [T0365/09]

Request with a view to revision.

T1747/06

Decision not to remit the case to the department of first instance can be changed by the Board.

T1033/04

Withdrawal of appeal made by the (sole) appellant after the final decision had been announced at oral proceedings.

A statement of withdrawal of appeal made by the (sole) appellant after the final decision of the Board had been announced at oral proceedings does not relieve the Board of its duty to issue and to notify to the appellant the decision in writing setting out the reasons for the decision in order to conclude the decision-taking procedure triggered by the announcement of the final decision at the oral proceedings.

T0716/01

Withdrawal of requests thereafter can have no effect on the proceedings.

Since the decision ends the dispute between the parties, the withdrawal of requests thereafter can have no effect on the proceedings.

T0515/94 [T0609/03]

Termination of the appeal procedure in oral proceedings.

When a final decision is given orally at the end of oral proceedings the appeal procedure is thereby terminated. Accordingly all submissions made after the closure of said procedure may not be considered by the Board.

T0433/93

Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside.

If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division.

T0296/93 [T0843/91, T0304/92, T0598/92]

Documents submitted following announcement of the decision are not taken into consideration.

T0843/91 [T0304/92, T0296/93, T1895/06]

The Boards of Appeal are the final instance; their decisions become final once they have been delivered, with the effect that the appeal proceedings are terminated.

After the decision has been taken a Board is no longer empowered or competent to take any further action apart from drafting the written decision (apart also Rule 88 EPC). Any further action which in the light of the decision becomes necessary, is the responsibility of the internal administration.

4. appeal [A111(1)]**G0010/93**

Inclusion of further patenting requirements in ex-parte proceedings.

In an appeal from a decision of an examining division in which a European patent application was refused the board of appeal has the power to examine whether the application or the invention to which it relates meets the requirements of the EPC. The same is true for requirements which the examining division did not take into consideration in the examination proceedings or which it regarded as having been met. If there is reason to believe that such a requirement has not been met, the board shall include this ground in the proceedings.

T0384/08

Transfer of opponent status refused by first instance, no res judicata. Prohibition of reformatio in peius not applicable.

T0817/05

Disclaimer deleted.

T1180/04

Refused auxiliary request for which the examining division proposed the grant of a patent.

T0986/04

Further appeal proceedings following remittal. Fresh ground.

T0894/02

Ground of opposition abandoned during the opposition proceedings, not admitted in appeal proceedings.

T1098/01

The respondents agree expressly with the amendments.

Opening statement regarding the scope limited by withdrawal of the former main request.

If the patent proprietor as single appellant makes amendments in opposition appeal proceedings to the version of the patent in accordance with the interlocutory decision, the Board has the competence and obligation to examine these amendments of its own accord in respect of formal and substantive matters even than if the respondents agree expressly with these amendments.

T0520/01 [T0376/04]

Re-introduction constitutes a fresh ground. Not: Party which raised the ground does not appear at the opposition oral proceedings.

1. Where a ground of opposition, here insufficiency, was expressly not maintained in opposition oral proceedings by the only party which had relied on the ground and the Opposition Division did not deal with the ground in their decision the re-introduction of the ground in appeal proceedings constitutes a fresh ground which, following Opinion G0010/91 by analogy, requires the permission of the proprietor.

2. Where a ground, here novelty, was substantiated within the opposition period and the party which raised the ground neither appears at the opposition oral proceedings nor withdraws the ground the Opposition Division has to deal with the ground in their decision. The ground may then be taken up by other appellants in subsequent appeal proceedings.

T1126/00

Appellant and Respondent filed the same request. Principle of party disposition.

If both the Patentee and the Opponent who is the sole Appellant request the maintenance of the patent in amended form according to a new set of claims, the power of the Board of Appeal to examine the subject-matter of these claims in substance is limited due to the principle of party disposition.

T0309/99

Termination by agreement.

Balance procedural and substantive fairness.

Auxiliary request containing amended claims prima facie inadmissible for late-filing but capable of maintaining patent revoked at first instance. Right of other party to be heard. Interest of third parties in certainty. Suspensive effect of appeal. Admissibility of request conditional as patentee's undertaking not to bring infringement proceedings until board's decision issued. Termination by agreement. Parties had agreed a sum.

T0304/99

Conditional withdrawal of the appeal. Complete deletion of the sole contested patent claim.

Abolition of the suspensive effect of the appeal by such a withdrawal. Authority of the Board after complete deletion of the sole contested patent claim.

T0119/99

Different proprietors for different states. Opposition appeal.

Unity of European patent not affected although different proprietors for different designated states.

T0128/98 [T0101/00, T0736/05]

Mere reference to Article 100(c) EPC.

Objections based upon a fresh ground for opposition. The mere reference to Article 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 does not deal in a substantial way with this ground for opposition.

T1129/97

Not: Allowability of the wording of claims in other patent applications.

This board is competent to rule only on the present appeal proceedings, relating to the examining division's decision to refuse the patent application in suit; it does not have the power to pronounce, in general terms going beyond its remit, on the allowability of the wording of claims in other patent applications. That would entail setting an authoritative precedent and would therefore be *ultra petita*.

T0893/96 [T0915/95]

Too broad a disclaimer not deemed unallowable until opposition appeal proceedings. Reformatio in peius.

T0239/96

In the absence of a provision on cross-appeal, reformatio in peius cannot be ruled out altogether.

Keeping the granted claims as main request.

T0401/95 [T0583/95, T0542/96, T0149/02]

Board not bound by decision of first instance on each separate issue.

Jurisdiction of Board of Appeal on issues arising from a request rejected by the first instance.

T0274/95 [T0151/99, T0877/01]

A ground of opposition which is sought to be re-introduced is not a "fresh ground of opposition".

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the Opposition Division proceedings

(here: a statement to that effect is made by the opponent during oral proceedings), the Opposition Division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent.

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the Opposition Division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of Opinion G0010/91, and may 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.

T0006/92

Partial withdrawal of an appeal following an allowable limitation of the patent's subject-matter.

The partial withdrawal of an appeal by the sole appellant following an allowable limitation of the patent's subject-matter under Article 123 EPC deprived the board of appeal of its discretionary power to examine the substantive merits of the remaining, limited subject-matter.

4.1. Interlocutory decision

T0152/95

Partial decision and separate decision.

Interlocutory decision concerning the admissibility of the opposition and the request to submit this matter to the Enlarged Board of Appeal; partial decision concerning the main request and separate decision on the auxiliary requests in the written proceedings.

T0315/87

Interlocutory decision on the re-establishment of rights in respect of the time limits for appeal.

T0152/82 [T0109/86]

The admissibility of an appeal may be established in an interlocutory decision.

5. exercise [A111(1)]

T0515/05

Opposition division itself introduced new ground for opposition. Proceedings are to be conducted in a fair manner.

T0265/05

Parties' wishes.

T0263/05

Claims prima facie highly unlikely to be valid.

T0151/05

Balance the public interest to know about the eventual outcome with the entitlement of the parties to fair proceedings.

T0869/04 [T0416/06]

Not: Interest of the public that the patent that may be granted has been correctly searched and examined outweighs that of the appellant.

Feature not contained in claims as filed; remittal for consideration of further search.

Absence of knowledge of what the Search Division considered could be possible amendments.

T0272/04 [T1016/96, T0938/98]

Ex-parte. Introduction of a new highly relevant document ex officio. Procedural economy.

The introduction of a new document ex officio in ex-parte appeal proceedings is admissible if this document is highly relevant for the examination of the patentability.

The remittal to the previous instance is at the discretion of the Board. This Board exercises its discretion among other things by considering general procedural economy.

T0047/04

Not: Long history of the case.

Right to submit observations not respected by examining division, Rule 51(6) EPC.

T0461/03

Due to a fundamental deficiency, the application cannot proceed to grant.

T0900/02

Not: Procedural deficiencies so grave that the case must be remitted. Delay, further proceedings will be accelerated.

Delay between the oral proceedings and the issue of the written decisions.

Several shortcomings which require an Opposition Division of totally different composition and that the further proceedings will be accelerated.

If delay were the only deficiency, the extreme length of that delay (three years and seven months between oral proceedings and issue of a written decision) and the consequent need to avoid further delay is a special reason why the case should not be remitted to the first instance under Article 10 RPBA.

If procedural deficiencies in first instance proceedings were so grave that the decision under appeal must be held invalid, that decision is thereby quashed and

regarded as a nullity. In that event the case must be remitted to the first instance under Article 10 RPBA to ensure a procedurally proper first instance decision.

T0004/00 [J0013/02]

Procedural violation is not substantial.

Refusal of request for correction of the minutes of oral proceedings is not within the competence of the formalities officer.

No reason for remittal.

T0165/99

Admission of a late ground of opposition on appeal. Wrong discretion exercised by opposition division. Revocation.

T0117/99

No suitable basis for further prosecution.

Remittance for formal reasons is inappropriate, in particular with regard to the duration of the examining procedure, the advanced stage of the examination/appeal procedure, and the fact that the claims underlying the decision under appeal did not appear to form a suitable basis for further prosecution.

Neither the Examining Division nor the Board are obliged to indicate which of the claims might possibly be allowable.

T0018/99

Further unresolved problems giving rise to objections under Articles 83 and 84 EPC.

T0914/98

Infringement proceedings before the German courts.

T0541/98

Stricter interpretation of a prior art.

Stricter interpretation by the Board of Appeal of a prior art mentioned in the opposed patent, but without remittal.

T0473/98 [T0915/98]

No finding as to inventive step.

I. 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 Article 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.

II. An opponent is not adversely affected by such findings favourable to the proprietor included in a revocation decision nor is the proprietor as sole appel-

lant protected against a reformatio in peius in respect of such findings.

The mere fact that in the present case such findings were somewhat misleadingly referred to in the pronouncement as "further decisions" "included" in the decision proper did not, in the judgement of the board, constitute a substantial procedural violation.

The decision under appeal does not include a finding as to whether the subject-matter of the claim is to be considered as involving an inventive step.

T0111/98

Amendment in response to a new document.

Amendment of the claims in response to the citation of a new document during appeal proceedings is not as such a sufficient reason to remit the case to the department of first instance.

Giving rules for exercising discretion in any possible situation which might arise is not comprised by the tasks of the Enlarged Board of Appeal set out in Article 112 EPC.

T0679/97

Instructions of the Board of Appeal ignored after remittal. Nonetheless not remitted again.

T0577/97

As the first and only instance. Public in uncertainty.

There is no basis in the EPC to refuse auxiliary requests at oral proceedings because of the circumstance that the new claims are apparently "not clearly allowable". In contrast to the situation in examining proceedings, where Rule 86(3) EPC requires that amendments after expiration of the time limit set in the first communication of the EPO are subject to the consent of the EPO, Rule 57a EPC does not contain such a requirement. The discretion not to admit auxiliary requests should in principle be limited to exceptional cases in which the filing of the auxiliary request can be said to amount to an abuse of procedural rights.

Article 111 EPC also confers the power upon a Board of Appeal to act inter alia as the first and only instance in deciding upon a case taking into account a document which was only filed in appeal proceedings, without the possibility of further appellate review. Remittal of a case results in a substantial delay of the procedure which keeps the public in uncertainty about the fate of the patent for several more years.

T0083/97 [T1070/96, T0887/98]

Not: Absolute right to two instances every time a fresh case has been raised.

T1060/96 [T0379/96]

Revocation for the first time. New citation.

New citation not introduced until opposition appeal proceedings.

T0379/96

Revocation for the first time without recourse to a further review. TRIPS.

(Auxiliary) Request on the basis of Article 125 EPC or Article 32 TRIPS to refer a question of law to the Enlarged Board of Appeal or to the European Court of Justice.

Revocation for the first time by a Board of Appeal without recourse to a further review by a higher instance.

T0977/94

In a position oneself to check the amendment of the description.

For reasons of procedural economy and although Art. 111(1)EPC permitted it, remittal to the first instance to bring the description into line with amended claims should be avoided if at all possible. The board of appeal which finds the invention defined in the claims to be patentable is a priori better placed than the opposition division to check the amendment of the description in order to disclose the same invention.

T0249/93 [T1709/06]

Late stage of the proceedings.

T0202/92

Restricted claims filed during oral proceedings in the absence of the opponent.

Remittal is not always necessary where restricted claims are filed during oral proceedings in the absence of the opponent.

T0048/91 [T0385/91]

Case should be ready for decision at the conclusions of oral proceedings. Late filed claims inadmissible.

Late filed claims at oral proceedings are inadmissible. Not remitted to the Opposition Division.

T0097/90 [T0852/90, T0874/03]

Principle of fairness.

1. The wording of Article 114(1) EPC does not mean that the Boards of Appeal have to conduct rehearings of the first instance proceedings, with unfettered right, and indeed obligation, to look at all fresh matter regardless of how late it was submitted. Article 114(2) as well as Article 111(1) EPC set a clear limit to the scope of any new matter that may be introduced into an appeal by the parties so that cases on appeal must

be, and remain, identical or closely similar to those on which first instance decisions have been rendered.

2. Where fresh evidence, arguments or other matter filed late in the appeal raise a case substantially different from that decided by a first instance, that case should be referred back to the first instance where this is demanded by fairness to the parties - with an award of costs against the party responsible for the tardy introduction into the appeal proceedings.

3. Cases where a new ground of objection is raised late in the appeal should only be referred back to the first instance where the admittance of the new ground would result in the revocation of the patent. Where the maintenance of the patent would not be put at risk the Board can either refuse to admit the fresh ground of objection, or admit it into the appeal proceedings, and decide it against the opponent. The latter can be preferable, leading, as it does, to detailed written reasons being made available for possible further use in litigation before national courts.

T0005/89 [T0392/89]

To maintain claims in accordance with an auxiliary request. Procedural economy.

Where claims are maintained in accordance with an auxiliary request and the Opposition Division has already ruled in favour of these claims, there is no need for a remittal.

T0274/88

Waiver of the right to two instances by the appellant. Correction of all deficiencies drawn attention to by the first instance.

5.1. Late submissions

T0908/07

Late filed claim admitted by the Board.

A late filed claim admitted in the exercise of the Board's discretion mainly because the Board and the opponent can be clearly expected to deal with the issues raised without adjournment of the oral proceedings, should not normally be remitted to the first instance for examination in regard of the grounds for opposition on which the first instance decision is based.

T0152/03

Notice of intervention. Tardy and piecemeal filing of evidence.

Prima facie assumption that any person involved in a medical process is obliged to confidentiality.

Evidence of prior use which is in the possession of an opponent should be submitted as soon as it is recognised as being highly relevant, particularly in cases

where the evidence is likely to be contested, such as for deciding the question of confidentiality of the prior use.

T0045/98

Apportionment of costs without remittal.

T0219/92

In favour of the late filing opponent.

Rejected opposition supported with new material from the search report. Consideration on account of its relevance. Decision without remittal in favour of the late filing opponent.

T0049/89 [T0253/85, T0565/89, T0137/90]

In the case of new documents without relevance.

Remittal in the case of new documents without relevance and need for further inquiry into the facts for a decision is an unreasonable procedural delay.

T0416/87 [T0626/88, T0881/91, T0210/92, T0457/92, T0527/93]

Loss of an instance to the disadvantage of the opponent who had introduced documents late.

In a case where a prior document is cited by an opponent for the first time during the appeal stage of an opposition and is considered by the Board to be the closest prior art and therefore admissible but not such as to prejudice maintenance of the patent, the Board may itself examine and decide the matter under Article 111(1) EPC rather than remit the matter to the first instance. In such a case an apportionment of costs may be made against the opponent in respect of the submission of evidence in reply by the patentee, following decision T0117/86.

6. within [A111(1)]

T0640/91 [G0007/93, T0182/88, T0986/93, T0237/96, T1119/05]

Way in which the first instance has exercised its discretion.

A Board of Appeal should only overrule the way in which a first instance department has exercised its discretion in a decision in a particular case if the Board comes to the conclusion that the first instance department in its decision has exercised its discretion according to the wrong principles, or without taking into account the right principles, or in an unreasonable way.

7. or [A111(1)]

T0622/02

Not: Take position on Article 83 EPC and then remit for the same question to be reconsidered.

The board cannot decide on the main request, thereby taking a position on Article 83 EPC, and then remit the case for the same question to be reconsidered.

8. remit [A111(1)]

T1414/06

Opinion about a matter if there is a possibility the matter will be disputed on appeal. Avoiding procedural ping-pong between instances.

T1356/05 [T0265/03, T0583/04, T1182/05, T1309/05, T1360/05, T1709/06]

A request for a decision on the state of the file is not to be construed as a waiver of the right to a fully reasoned first instance decision.

T0838/02

Composition contrary to Article 19(2) EPC. Parties should be given the opportunity to comment.

If the composition of the Opposition Division is contrary to Article 19(2) EPC, the parties should be given the opportunity to comment, before the Board decides on the remittal of the case.

Appointment of the members of a Division is an administrative function which is the primary competence of the responsible director.

T0818/01

Withdrawal of the rejected main requests and auxiliary requests.

Remittal based on the version intended for grant.

T0914/98

Infringement proceedings before the German courts.

T0869/98

Despite request for final decision.

Remittal, despite request for final decision.

T0169/98 [T0650/03, T0778/06]

The examination is continued on the basis of amendments proposed by the examining division but without making use of interlocutory revision.

T0065/97

Not: Remittal to keep the case alive.

T0977/94

To be avoided for reasons of procedural economy. Amendment of the description.

For reasons of procedural economy and although Article 111(1)EPC permitted it, remittal to the first instance to bring the description into line with amended claims should be avoided if at all possible. The board of appeal which finds the invention defined in the claims to be patentable is a priori better placed than the opposition division to check the amendment of the description in order to disclose the same invention.

T0557/94 [T1070/96]

Not simply in order to guarantee a judicial review in case of revocation.

T0433/93 [T0071/99]

Reasonable grounds for partiality in the same composition.

Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside. If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division.

8.1. New facts

J0014/03

Not: No request, evidence or argument by appellant in first instance proceedings.

Loss of priority.

Decision was quite simply the inevitable consequence of the appellant's own actions and inactions, namely seeking a decision in the absence of any request while failing to make any case whatsoever.

Evidence available or obtainable prior to first instance decision but only filed on appeal.

J0902/87

Incapacity not invoked until the appeal.

In accordance with Rule 90 EPC, which the Office 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 time limit referred to in Article 122(2) EPC. Thus, if such incapacity is invoked where a decision based on such a time limit is appealed, that decision must be cancelled and the matter referred back to the first

instance for a fresh decision that takes account of the new circumstance.

Rule 90(4) EPC has to be interpreted as deferring the payment date for renewal fees falling due during the period of incapacity of the applicant or his representative until the date proceedings are resumed.

T0893/07

Not: Document newly introduced in appeal proceedings is a family member of a document cited in parallel proceedings. Not: The position of the examining division can be reasonably estimated.

T0711/06

Not: Request not admissible under Article 123(2) EPC.

T0152/03

Notice of intervention. Not: Tardy and piecemeal filing of evidence.

Prima facie assumption that any person involved in a medical process is obliged to confidentiality.

Evidence of prior use which is in the possession of an opponent should be submitted as soon as it is recognised as being highly relevant, particularly in cases where the evidence is likely to be contested, such as for deciding the question of confidentiality of the prior use.

T0758/99 [T1182/01]

Decision on apportionment of costs will be taken at a later stage.

Remittal for further prosecution.

T0083/97 [T1070/96, T0887/98]

Not: Absolute right to two instances every time a fresh case has been raised.

T0929/94

Third party observations introduced into the appeal proceedings and case remitted.

T0169/92

Intervention during appeal proceedings.

If, in the course of an intervention during appeal proceedings, an intervener files new grounds for opposition, the case should be remitted.

T0611/90 [T0462/94, T0125/94]

Entirely different case.

If there is such an entirely different case, it may, subject to the other circumstances of the case, be inappropriate for an Appeal Board to deal itself with its al-

lowability. 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.

T0215/88

Late filed submission of a totally fresh line of argument.

8.1.1. New documents

T0919/03

Already acknowledged Japanese document was not taken into consideration by the examining division.

T0402/01

Not: Automatic right of remittal after the citation of a new document.

A patent proprietor has no automatic right of remittal after the citation of a new document with the grounds of appeal, even if there is a change in factual framework, at least in cases where the document is filed in reaction to amendment of the claim, providing that both parties' right to a fair hearing (Article 113(1) EPC) is not jeopardised.

The right to a fair hearing comprises the right to be heard, explicitly required by Article 113(1) EPC, and the general principle of equal treatment of parties, implied by Article 113(1) EPC in combination with Article 125 EPC.

T0336/00 [T0335/00]

Admission in the appeal of a document cited in the patent.

T0736/99

Intervening prior art submitted more than two years after statement of grounds of appeal.

Document representing prior art intervening between priority date and filing date, submitted in response to a first instance decision approving an amended patent with loss of priority, more than two years after expiry of term for filing statement of grounds of appeal.

T0385/97

Failure to take account of highly relevant matter which is clearly available in the file.

If first instance departments and/or parties have failed to take account of highly relevant matter which is clearly available in the file and which relates to a ground of opposition, the Board's competence extends to rectifying the position by consideration of that matter provided the parties' procedural rights to fair and equal treatment are respected.

T0223/95

Evidence of common general knowledge in the art introduced on appeal too relevant to be disregarded.

T0622/89 [T0864/97, T0611/00]

Direct remittal owing to relevant new document. Apportionment of costs.

T0588/89

It is possible to remit in the case of documents introduced by the EPO of its own motion.

T0326/87 [T0638/89, T0847/93, T0286/94]

Late filed material puts the maintenance of the patent at risk.

If the evidential weight of late filed documents in relation to those already in the case ("their relevance") warrants their admission into the proceedings, the case should normally be remitted to the first instance (Article 111(1) EPC), particularly if the late filed material puts the maintenance of the patent at risk.

In such a case, costs between the parties should be apportioned under Article 104 and Rule 63(1) EPC, in such a way that the late filing party should normally 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.

T0273/84 [T0147/84, T0170/86, T0621/90, T0166/91, T0223/95]

New documents to be examined at two levels of jurisdiction. Forestall tactical abuse.

Documents introduced for the first time in appeal proceedings following opposition must be taken into consideration when the principle of examination by the EPO of its own motion so requires. Where this is the case it may be appropriate to refer the matter back to the Opposition Division so as to make it possible for the new documents to be examined at two levels of jurisdiction and to avoid one of these being by-passed. Forestall tactical abuse.

T0258/84 [T0028/81, T0273/84, T0621/90, T0166/91, T1071/93]

In case of late submitted documents. Not in the absence of any comment by the patent proprietor.

Documents cited for the first time by the opponent in his statement of grounds for appeal despite the fact that he ought to have known them to exist are documents submitted late which the Board is not bound to consider (Article 114(2) EPC), even though it is of the opinion that it should do so, pursuant to Article 114(1) EPC, where it reckons them to be particularly relevant.

In this case the matter should, as a rule, be referred to the first instance so as not unfairly to deprive the patent proprietor (respondent) of a hearing before a judicial body unless, in the absence of any comment whatsoever by the respondent, such referral appears unjustified.

8.1.2. New support for the claims

T0561/94

Submission of comparative tests in support of alleged improvement queried for the first time in oral proceedings.

T0125/93

Introduction of new facts by the patentee.

The legal consequences of the introduction of new facts - here a relevant prior art document - into an appeal, resulting in a shift in the factual framework of the appeal, apply also when the party responsible for the shift is the Patentee.

8.1.3. Amendments to the claims

T0908/07

Late filed claim admitted by the Board.

A late filed claim admitted in the exercise of the Board's discretion mainly because the Board and the opponent can be clearly expected to deal with the issues raised without adjournment of the oral proceedings, should not normally be remitted to the first instance for examination in regard of the grounds for opposition on which the first instance decision is based.

T0449/01

Document forming basis of decision no longer closest prior art. Auxiliary request remitted to first instance.

T1201/00

Auxiliary request presented just before the end of the oral proceedings. No significant delay.

If the case is likely to be remitted to the Opposition Division for examination of the unaddressed question of inventive step, an auxiliary request presented for the first time in the oral proceedings before the Board to reply to a raised objection of lack of novelty vis-à-vis a citation may, as an exception, be admitted and the auxiliary request even be remitted to the Opposition Division for examination of novelty vis-à-vis the citation.

The necessity for the first instance to address the question of inventive step vis-à-vis the entire state of the art cited means that the examination of novelty vis-

à-vis a citation does not lead to a significant delay in the opposition procedure.

T0047/94

Substantial amendments to the claims in opposition appeal proceedings.

T0063/86 [T0347/86, T0381/87, T0098/88, T0423/88, T0531/88, T0300/89, T0317/89, T0047/90, T0184/91, T0746/91, T0919/91, T0933/91, T0001/92, T0241/92, T0599/92, T1032/92, T1067/92, T0186/93, T0462/94]

In the case of substantial amendments to the claims.

1. The amendment of claims during an appeal from a decision to refuse a European patent application is a matter of discretion under Rule 86(3) EPC, final sentence.

2. 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, so that such examination should be carried out, if at all, by the Examining Division after the latter has exercised its discretion under Rule 86(3) EPC, final sentence.

3. The fact that the Examining Division did not exercise its power to rectify its decision under Article 109 EPC is irrelevant to the exercise of discretion under Rule 86(3) EPC, final sentence.

8.2. Incomplete reasoning in the decision

T1747/06

Decision not reasoned. Composition of the board changed.

T0763/04 [T0852/07, T0246/08]

Disregarding facts and arguments which may speak against the decision taken.

Final communication is the first communication to contain a reasoned statement.

The right to be heard in accordance with Article 113(1) EPC is contravened if the decision of the first instance fails to mention and to take into consideration important facts and arguments which may speak against the decision in question.

T0897/03 [T0276/04]

Formal written decision requested. Decision according to the state of the file.

T0552/97 [T0740/00, T0654/04]

Position before the announcement of the decision unclear. No decision of the opposition division regarding the supposedly withdrawn main request of the patent proprietor.

T0135/96 [T0567/06, T0567/06]

Non-consideration of presented documents and arguments in a decision.

Non-consideration of documents and arguments presented in support of lack of inventive step, in a decision rejecting the opposition. Remittal of the case to the first instance without comment as to its merits.

T0740/94

An objection raised by the opponent was not taken into account in the decision.

The decision to maintain the patent in amended form did not take into account an objection raised by the opponent against one of the amended claims on the basis of the grounds for opposition under Article 100b) EPC.

T0698/94

De facto absence of a reasoning in respect of some grounds vitiates entire decision.

8.3. Incomplete examination

T0919/03

Already acknowledged Japanese document was not taken into consideration by the examining division.

T0659/03

Rule 29(2) EPC.

Number of independent claims.

T0314/03 [T0473/98, T0915/98]

Approach taken by the Opposition division is contrary to the general interest of procedural expediency.

T0853/02 [T1028/02]

Disclosed disclaimer erroneously not taken into account in assessing inventive step. Remittal for further prosecution.

T0394/02

Not: Remittal would only prolong the proceedings unduly.

T0992/01 [T0959/00]

Remittal for hearing of witnesses.

T0254/01 [T1107/02]

The provisions of Article 84 and Rules 29(1), 29(7) and 27(1) (b) EPC not complied with. Description pages missing in the EPO file.

T0336/00 [T0335/00]

Admission in the appeal of a document cited in the patent.

T0485/99

Lack of discussion of the main issue concerning the novelty of the therapy.

T0275/99

Systematic approach required.

Remittal, examination of Article 56 EPC requires systematic approach.

T0915/98 [T0473/98]

Splitting up the proceedings, unnecessary costs.

The invention has not yet been examined for novelty and inventive step. The discussions in the oral proceedings before the Opposition Division were limited to issues relating to Articles 123 and 84 EPC. Although this opinion may be correct from a formal point of view the Board disagrees with it with regard to overall efficiency. Splitting up the proceedings in this way only prolongs the procedure and may cause unnecessary costs both for the parties and the EPO.

T0632/97

Evidence not taken into account during examination proceedings.

T0385/97

Failure to take account of highly relevant matter which is clearly available in the file.

If first instance departments and/or parties have failed to take account of highly relevant matter which is clearly available in the file and which relates to a ground of opposition, the Board's competence extends to rectifying the position by consideration of that matter provided the parties' procedural rights to fair and equal treatment are respected.

T0648/96

No thorough examination of the amendments made.

No thorough examination of the amendments made during opposition proceedings to the claims and the patent description with regard to the requirements of the EPC, especially Articles 84, 123(2) and (3) EPC.

T0142/95

Missing examination of an opposition ground. Remittal.

T0953/94

For examination of and decision on further grounds for opposition invoked.

T0307/86 [T0423/88, T0924/91, T1071/93, T1116/97]

In the case of incomplete examination.

It is possible to remit in the case of an incomplete examination of the application documents and a failure to consider late filed documents.

8.4. Incomplete search

T1873/06

Minor obscurities in the claims. No search.

If an application for which no search has been carried out, inter alia for lack of clarity of the claims, has been refused for the same reason, a board of appeal need only examine whether the claims fail to comply with the clarity requirement of Article 84 EPC to such an extent that it is not possible to carry out a meaningful search.

T0869/04 [T0416/06]

Feature not contained in claims as filed; remittal for consideration of further search.

Absence of knowledge of what the Search Division considered could be possible amendments.

Interest of the public that the patent that may be granted has been correctly searched and examined outweighs that of the appellant in the present case.

T0144/04 [T0828/08]

Remittal for search and examination.

Remittal for further prosecution (search and examination).

T0101/04

Owing to an abundance of over 6000 multimetallic oxides a complete search was probably not made. Additional search.

T0089/03

Further prosecution of claims directed to hitherto unsearched and unexamined subject-matter. Super-toroidal conductor.

T0492/02

For topping-up search. Document came to the Board's attention during the examination of the appeal.

T0702/01 [T0911/01]

Features only in the description. Additional search.

Features were taken which had only been disclosed in the description and therefore not searched. The first instance must carry out an additional search.

8.5. Procedural violation

T1178/04 [T0293/03]

Ruling on transfer of opponent status.

Purported new opponent is a "party to proceedings". Proprietor not adversely affected by decision, not prevented from presenting arguments relating to validity of transfer of opponent status. Reformatio in peius. The duty of the European Patent Office to examine, ex officio, the status of the opponent at all stages of the proceedings extends not only to the admissibility of the original opposition but also to the validity of any purported transfer of the status of opponent to a new party.

The doctrine of no reformatio in peius is of no application in relation to the exercise of such duty.

T0047/04

Not: Long history of the case.

Right to submit observations not respected by examining division, Rule 51(6) EPC.

T0830/03

The opposition division acted ultra vires after the notification of the first written decision by replacing it by a second written decision.

T1153/02 [T0107/05]

Not: Possible violation of the right to be heard in respect to secondary statements in the decision.

Possible violation of the right to be heard in respect to secondary statements in the decision under appeal is not a substantial procedural violation which would justify to declare the decision under appeal void and to remit the case back to the first instance.

T0587/02 [T1870/07]

International Preliminary Examination Report not sufficiently reasoned.

If the only communication preceding the decision to refuse an application merely draws attention to an International Preliminary Examination Report (IPER), the requirements of Article 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by Rule 51(3) EPC, using language corresponding to that of the EPC; in the case of an inventive step objection this will require a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant.

In order to guarantee a fair conduct of the further proceedings a different composition of the examining division should be considered by the first instance.

T0611/01

Misleading impression as to treatment of application. Someone may have caused the Examining Division to treat a case in a different manner than an applicant expected.

Applicants given misleading impression as to treatment of application.

Cause for concern if someone other than the particular members should have caused the Examining Division to treat a case in a different manner than an applicant expected.

To be conducted by differently composed Examining Division.

T0318/01

Unclear legal and factual framework.

Series of fundamental procedural deficiencies resulting in unclear legal and factual framework of the case on appeal.

T0959/00

File history. No particular interest in a speedy procedure.

Alleged prior use. Witness offered but not heard by opposition division.

The file history does not show a particular interest of the respondent in a speedy procedure.

T0594/00 [T0165/99, T0343/01, T1494/05, T1077/06]

Right to be heard. Repaired only by remitting.

Right to be heard has been violated by the authority of the first instance. This violation cannot be repaired by hearing the Appellants before an authority of the second instance, but only by remitting the case to the first instance.

T0048/00 [T0343/01]

Delay is an insufficient reason not to order remittal.

Inadmissibility of late filed request in oral proceedings at the opposition stage immediately followed by revocation of the patent. Unsatisfactory wording before final decision. The Appellant's conduct of the case has been less than exemplary.

Apportionment of costs; more appropriate for decision in resumed first instance proceedings.

T1065/99 [T1982/07]

Serious denial of justice. Opportunity to have the case examined de novo.

Adoption of International Preliminary Examination Report as only reasons for refusal of application under the EPC.

Re-examination by differently composed examining division.

1. When an International Preliminary Examination Report drawn up by the EPO under the PCT is relied on by the Examining Division, such reliance should not be presented to applicants in such a manner as to suggest that the Examining Division has not given objective consideration to the patentability requirements of the EPC. An Examining Division has discretionary powers under the EPC which it should not surrender, or appear to surrender, by mere adoption of such a Report. The standard form used by the EPO for such Reports suggests they are confined to three patentability considerations under the PCT (novelty, inventive step and industrial applicability). Other objections raised under the patentability requirements of the EPC should be particularly drawn to the applicant's attention.

2. When an appellant has suffered such a serious denial of justice that it would be unsafe to allow the decision under appeal to stand, setting that decision aside and remitting the case to the first instance gives the appellant the opportunity to have its case examined de novo and according to proper procedural standards as if the decision under appeal and the proceedings which led up to it had never taken place.

3. When remitting a case to the first instance after finding procedural violations have occurred, the number and/or seriousness of those violations may make it appropriate, notwithstanding the absence of possible bias, for the further prosecution of the case to be conducted by a differently composed first instance in order to ensure so far as possible there are no further grounds for dissatisfaction on the part of a party.

T0117/99

Not: No suitable basis for further prosecution.

Remittance for formal reasons is inappropriate, in particular with regard to the duration of the examining procedure, the advanced stage of the examination/appeal procedure, and the fact that the claims underlying the decision under appeal did not appear to form a suitable basis for further prosecution.

T1056/98

Opponent unaware of the grounds for inadmissibility.

The Opposition Division violates the right of the opponent to be heard if it rejects the opposition as inadmissible without the opponent having been aware of the grounds for inadmissibility before the decision was issued.

T0425/97 [T0666/90, T0740/00]

Decision notified different to the decision given orally.

Decision notified in writing different to the decision given orally at the oral proceedings. Different texts of the claim.

Request for correction according to Rule 89 EPC and revised form of the minutes.

T0041/97

Appeal to be remitted to the board of appeal before receipt of the statement of grounds of appeal. Interlocutory revision.

T0225/96 [T0837/01]

Issuing of a decision not yet finalised.

Missing approval and signatures of the chairman, second examiner and legal member of the opposition division.

T0510/95

Consider a recently issued decision if it relates to a procedural question.

Room for discretion provided for under Rule 86(3) not exercised. Remittal appropriate because the recently issued decision G0007/93 must be considered as it relates to a procedural question.

T0181/95

Communication must observe the basic grammar rules of the adopted official language.

The text of every communication addressed to the applicant must be composed in such a way that it observes the basic grammar rules of the adopted official language. The non-observation of these conditions in the first and only communication containing objections, which is followed by the refusal of the application, constitutes an infringement of Article 113(1) EPC, since it may lead to ambiguities or difficulties of comprehension and put the applicant in an unclear position regarding which measures must be taken into account to overcome these deficiencies.

8.5.1. Interlocutory revision

T0180/04

Interlocutory revision of the appeal not submitted to the examining division in time.

T0041/97

Appeal to be remitted to the board of appeal before receipt of the statement of grounds of appeal. Interlocutory revision.

T0180/95 [T0826/08, T1281/08]

Obligation to grant interlocutory revision.

Claims substantially amended to meet the grounds for refusing the application. Obligation of the examining division to grant interlocutory revision if only objections exist which were not subject of the contested decision.

T0219/93

In the case where interlocutory revision is clearly necessary but not made use of. Remittal.

8.5.2. Oral proceedings**T1359/04 [T1494/05]**

Purpose of the minutes to document the proper course. Suspected serious procedural violation.

The filing of new documents by the Examining Division for the first time in the oral proceedings represents an extraordinary event. Utmost care to guarantee the right to be heard.

The purpose of the minutes is to represent and thereby document the proper course of these events.

T0862/03

Provisional request for oral proceedings unambiguously restricted.

Later requests made without any request for oral proceedings. Clearly no valid request pending on date of decision of opposition division.

T1103/96

The minutes, as edited, do not refer to the question of inventive step.

Right to be heard: The Opposition Division rejected the possibility of discussing inventive step during oral proceedings. No reason at all to doubt the allegation of the appellant. The minutes, as edited, do not refer to the question of inventive step.

T0808/94

Request of the applicant for oral proceedings disregarded.

T0731/93

Disregard of an opponent's request for a second oral proceedings in spite of new evidence.

If an opponent's request for further oral proceedings is disregarded, although fresh evidence was presented, it is possible to remit the opposition of all opponents.

T0125/91

Disregard of an opponent's request for oral proceedings.

If an opponent's request for oral proceedings is disregarded, the opposition of all opponents may be remitted.

9. case [A111(1)]**T1747/06**

Not: Order that a decision with the same tenor as the decision under appeal be issued, in which the decision is reasoned.

T0064/03

Not: Request that Opposition Division be ordered to restrict considerations to facts and evidence already on file.

The Board is not empowered to deviate from, or order a different instance to deviate from, the EPC.

T0500/01

Not: Limit in advance the right to file a new set of claims.

There is no provision in the EPC under which a board upon remittal can limit in advance the patentee's right to file a new set of claims.

The manner of proceeding lies within the competence and is at the discretion of the instance which has to decide on the case before it.

T0710/00

Opportunity given to submit evidence.

General knowledge. An opponent cannot rely on the description in the contested patent.

T0636/97

Instruction concerning the adaptation of the description is missing.

10. that [A111(1)]**T0095/04**

View that the application does not contain any patentable subject-matter. Partiality. Examining Division in a different composition.

T0900/02

Several shortcomings which require a totally different composition.

Delay between the oral proceedings and the issue of the written decisions.

Several shortcomings which require an Opposition Division of totally different composition and that the further proceedings will be accelerated.

1. A suspicion of partiality must inevitably arise if a member of an Opposition Division, or any other first instance body, first solicits and then accepts employment with a firm in which a partner or other employee is conducting a case pending before that member. The fact that this only occurred after the oral proceedings were held, and the decision if not the reasons known, makes no difference - to be above all suspicion of partiality, every member must avoid any such situation at any time during the proceedings. No-one can be seen as independent of both parties while in the employ of one of them.

2. That adaptation of a description is connected to the claims as maintained appears clear from the very term "adaptation" and it is inconceivable that the parties could or would expect anyone other than the same members of the Opposition Division who conducted the oral proceedings and made a decision on the claims to deal with the necessarily inter-related and dependent question of adapting the description. If for any reason (even quite acceptable and understandable reasons such as illness or retirement) the same three members are not available to deal with the description, then it must follow that the parties are to be offered new oral proceedings and that, without such an offer, both the use of a different composition to decide the description and the issue of two separate decisions signed by differently composed Opposition Divisions amount to fundamental deficiencies.

3. If delay were the only deficiency, the extreme length of that delay (three years and seven months between oral proceedings and issue of a written decision) and the consequent need to avoid further delay is a special reason why the case should not be remitted to the first instance under Article 10 RPBA.

4. If procedural deficiencies in first instance proceedings were so grave that the decision under appeal must be held invalid, that decision is thereby quashed and regarded as a nullity. In that event the case must be remitted to the first instance under Article 10 RPBA to ensure a procedurally proper first instance decision.

T0838/02

Composition contrary to Article 19(2) EPC. Parties should be given the opportunity to comment.

If the composition of the Opposition Division is contrary to Article 19(2) EPC, the parties should be given the opportunity to comment, before the Board decides on the remittal of the case.

Appointment of the members of a Division is an administrative function which is the primary competence of the responsible director.

T0587/02 [T1870/07]

Different composition of the examining division should be considered by the first instance.

International Preliminary Examination Report not sufficiently reasoned.

If the only communication preceding the decision to refuse an application merely draws attention to an International Preliminary Examination Report (IPER), the requirements of Article 113(1) EPC are met provided the IPER constitutes a reasoned statement as required by Rule 51(3) EPC, using language corresponding to that of the EPC; in the case of an inventive step objection this will require a logical chain of reasoning which can be understood and, if appropriate, answered by the applicant.

In order to guarantee a fair conduct of the further proceedings a different composition of the examining division should be considered by the first instance.

T0611/01 [T0628/95]

Differently composed Examining Division. Misleading impression as to treatment of application. Someone may have caused the Examining Division to treat a case in a different manner than an applicant expected.

Applicants given misleading impression as to treatment of application.

Cause for concern if someone other than the particular members should have caused the Examining Division to treat a case in a different manner than an applicant expected.

To be conducted by differently composed Examining Division.

T0740/00

Composition. Leaving it to the Appellant.

Serious doubt as to whether the Appellant's rights can be guaranteed when the present case is dealt with by the Opposition Division in its present composition. Appropriate to leave it to the Appellant to decide whether it shares this doubt to a degree necessitating a request for a change in the composition of the Opposition Division.

T1065/99 [T1982/07]

Serious denial of justice. Re-examination by differently composed examining division.

Adoption of International Preliminary Examination Report as only reasons for refusal of application under the EPC.

Re-examination by differently composed examining division.

1. When an International Preliminary Examination Report drawn up by the EPO under the PCT is relied on by the Examining Division, such reliance should

not be presented to applicants in such a manner as to suggest that the Examining Division has not given objective consideration to the patentability requirements of the EPC. An Examining Division has discretionary powers under the EPC which it should not surrender, or appear to surrender, by mere adoption of such a Report. The standard form used by the EPO for such Reports suggests they are confined to three patentability considerations under the PCT (novelty, inventive step and industrial applicability). Other objections raised under the patentability requirements of the EPC should be particularly drawn to the applicant's attention.

2. When an appellant has suffered such a serious denial of justice that it would be unsafe to allow the decision under appeal to stand, setting that decision aside and remitting the case to the first instance gives the appellant the opportunity to have its case examined de novo and according to proper procedural standards as if the decision under appeal and the proceedings which led up to it had never taken place.

3. When remitting a case to the first instance after finding procedural violations have occurred, the number and/or seriousness of those violations may make it appropriate, notwithstanding the absence of possible bias, for the further prosecution of the case to be conducted by a differently composed first instance in order to ensure so far as possible there are no further grounds for dissatisfaction on the part of a party.

T0071/99

Modification of the composition must be examined by the responsible authority.

Modification of the composition of the opposition division must be examined by the authority responsible for the composition of the opposition division.

T0111/95 [T0772/03]

Different composition of the examining division for the oral proceedings.

The date set for oral proceedings should be provably and unconditionally accepted. Remittal to the examining division under a different composition.

T0433/93 [T0071/99]

On request a different composition of the opposition division in the case of partiality.

Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside. If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should

be reheard before a different composition of opposition division.

11. further [A111(1)]

T0679/97

Instructions of the Board of Appeal ignored after remittal. Nonetheless not remitted again.

T0227/95

Disregard of the communicated order.

I. An opponent who did not appeal the first decision by the Opposition Division to reject the oppositions may still be considered adversely affected in accordance with Article 107 EPC by a second decision of that division (after remittal) maintaining the patent in amended form. Such an opponent is entitled to appeal said second decision, if he originally had requested the revocation of the patent in its entirety.

II. For a decision to be properly reasoned as required under Rule 68(2) EPC, the reasons must clarify the standpoints of the body responsible for the decision and be adequately connected to the resulting order. Where a remittal has taken place with the order to prosecute the case further, it is incumbent upon the first instance to examine all the patentability issues arising from this order, and give adequate reasons on each such issue.

12. case [A111(2)]

T0264/99

Prior use. Need to hear witnesses.

13. further [A111(2)]

T0148/06

The expression "further prosecution" does not extend the extent of the Boards' decisions but allows the first instance to reach a final decision.

T0922/02 [T1425/05, T1494/05]

Notification and invitation is to be made after the remittal. Right to be heard after remittal.

T0796/02 [T1029/99]

Abuse of procedure: Re-introducing broader claims before the opposition division, having obtained remittal on the basis of much more limited claims.

It amounts to an abuse of procedure to withdraw a request with broader claims in proceedings before the board of appeal, in order to avoid that a negative decision be taken on it by the board, but then to re-introduce those broader claims before the opposition division, having obtained remittal of the case for

further prosecution on the basis of much more limited claims.

T0139/02

Dependent claims with respect to Article 123(2) EPC.

Remittal to the first instance to examine the dependent claims of the auxiliary request with respect to Article 123(2) EPC.

T0120/96 [T0769/91, T0832/92, T0892/92, T0742/04]

Termination of opposition proceedings after remittal.

Termination of opposition proceedings after remittal without previous notification and without taking into account the parties' request for oral proceedings constitutes an essential procedural violation.

T0609/94 [T1630/08]

Continuation of the procedure on the basis of claims. Claims which differ from the first ones.

Binding effect of an appeal decision. Ratio decidendi. When, by decision of a Board of Appeal, the case is remitted to the first instance with the order to continue the procedure on the basis of a first set of claims, the first instance is not entitled to reject new claims merely by reference to said decision, when said new claims, while differing from said first claims, do not contravene the ratio decidendi of said decision.

14. department [A111(2)]

T0740/00

Composition. Leaving it to the Appellant.

Serious doubt as to whether the Appellant's rights can be guaranteed when the present case is dealt with by the Opposition Division in its present composition. Appropriate to leave it to the Appellant to decide whether it shares this doubt to a degree necessitating a request for a change in the composition of the Opposition Division.

T0433/93

On request a different composition of the opposition division in the case of partiality.

Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside. If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division.

15. department [A111(2)]

T0365/09

Res judicata under EPC 2000.

T1827/06

Estoppel by rem judicatam. Not: Departments of the EPO bound by precedents.

T0694/01

Nature of the proceedings.

Scope of appeal limited to adaptation of description. An intervention is dependent on the extent to which opposition/appeal proceedings are still pending. Where a board has decided that a patent is to be maintained on the basis of a given set of claims and a description to be adapted thereto, a party intervening during subsequent appeal proceedings confined to the issue of the adaptation of the description cannot challenge the res judicata effect of the previous board of appeal decision regardless of whether a new ground for opposition is introduced. The binding effect of a final decision applies only to the extent determined by the nature of the proceedings.

T0546/98 [T0846/01]

Opposition Division or Board in later appeal proceedings.

Inadmissibility of the Opposition Division, or a Board in subsequent appeal proceedings, reconsidering the patentability of the claims after remittal to the first instance for adapting the description.

T0436/95

The changed composition of the Board in the two appeal proceedings is of no consequence for the binding effect of the earlier decision.

Earlier decision of a board in the same case. Ratio decidendi.

T0167/93 [T0026/93, T1099/06]

Not the Opposition Division or the Board of Appeal after remittal to the Examining Division.

A decision of a Board of Appeal on appeal from an Examining Division has no binding effect in subsequent opposition proceedings or on appeal therefrom, having regard both to the EPC and 'res judicata' principle(s).

T0079/89 [G0001/97, T0021/89, T0055/90, T0690/91, T0757/91, T0843/91, T0113/92, T0255/92, T1063/92, T0153/93]

Also the Board of Appeal in any subsequent appeal proceedings.

1. If a Board of Appeal has issued a decision rejecting certain claimed subject-matter as not allowable and has remitted the case for further prosecution in accordance with an auxiliary request, the legal effect of Article 111 EPC is that examination of the allowability of the rejected claimed subject-matter cannot thereafter 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.

2. After a Board of Appeal has issued a decision in respect of certain issues, it has no power under Article 112(1)(a) EPC in the same proceedings to refer a question of law to the Enlarged Board of Appeal which arose in connection with issues which it has already decided, even though other issues are still pending before the Board of Appeal in proceedings on the same case.

16. bound [A111(2)]

J0027/94 [T0021/89, T0288/92, T0026/93]

Only for the individual case.

The binding effect according to Article 111(2) EPC applies only to the case decided upon.

T0051/08

Principle of res iudicata applied in the divisional application.

Subject matter on which a final decision has been taken by a board of appeal in the parent application becomes res iudicata and cannot be pursued in the divisional application.

If the statement setting out the grounds of appeal in a case does not go beyond submitting and arguing for a set of claims which constitutes such subject matter, the appeal is not sufficiently substantiated.

T1895/06

Not: Remittal proceedings to afford the parties a further opportunity to attack the finally decided and therefore binding parts of the remitting decision by introducing new facts. Res iudicata.

T1827/06

Estoppel by rem iudicatam. Not: Departments of the EPO bound by precedents.

T1254/06

Res iudicata. Pursuing of requests in a parent application after rejection by the first instance of identical requests in the divisional application.

T1134/04

Claim of divisional application is a restricted version of claim granted in parent application pursuant to a previous decision of the Board in a different composition. No reason to depart from its earlier reasoning.

T1170/03

Request aimed at revision of ratio decidendi of decision of remitting board rejected as inadmissible.

T0940/03 [T0622/02]

Divisional, Res iudicata not decided.

T0653/00

Not: Earlier decision of the Board relating to similar subject-matter.

T0740/98

Not: Guidelines or established jurisprudence treated as binding.

The legal system established under the EPC does not treat either the Guidelines or established jurisprudence as binding.

Any principle of protection of legitimate expectations cannot be based on earlier Guidelines or jurisprudence.

In G0001/03 the Enlarged Board clarified the law which had been uncertain.

T0679/97

Instructions of the Board of Appeal ignored after remittal. Nonetheless not remitted again.

T0227/95

Disregard of the communicated order.

I. An opponent who did not appeal the first decision by the Opposition Division to reject the oppositions may still be considered adversely affected in accordance with Article 107 EPC by a second decision of that division (after remittal) maintaining the patent in amended form. Such an opponent is entitled to appeal said second decision, if he originally had requested the revocation of the patent in its entirety.

II. For a decision to be properly reasoned as required under Rule 68(2) EPC, the reasons must clarify the standpoints of the body responsible for the decision and be adequately connected to the resulting order. Where a remittal has taken place with the order to prosecute the case further, it is incumbent upon the first instance to examine all the patentability issues arising from this order, and give adequate reasons on each such issue.

T0027/94

Remitted to the previous instance for further substantive examination of a claim considered to be formally admissible.

If, through a decision of a Board of Appeal, a matter is referred back to the previous instance for further substantive examination (here: with regard to inventive step) of the subject-matter of a claim considered formally admissible neither this instance, nor the subsequently engaged Board of Appeal are bound to the content of this patent claim.

17. ratio decidendi [A111(2)]

T0120/03

No implicit decision in a previous appeal on formal requirements, no limitation of extent of proceedings.

T0500/01 [T0742/04]

The manner of proceeding lies within the competence and is at the discretion of the instance which has to decide on the case before it.

There is no provision in the EPC under which a board upon remittal can limit in advance the patentee's right to file a new set of claims.

T0135/96 [T0567/06, T0567/06]

Remittal of the case to the first instance without comment as to its merits.

Non-consideration of documents and arguments presented in support of lack of inventive step, in a decision rejecting the opposition.

18. Board of Appeal [A111(2)]

T0752/94

On remittal the first instance is bound by the ratio decidendi of its own decision.

W0003/02

Decision in respect of a protest.

The findings of the board of appeal in respect of the non-unity of the subject-matters of the application within the scope of a protest decision are part of the EPO's function as an International authority under the PCT and do not, in the further processing of the patent application before the EPO in the regional phase, bind either the examining division or the board of appeal in an eventual subsequent procedure.

19. in so far as [A111(2)]

T0546/98

Not: Reconsidering the patentability of the claims after remittal for adapting the description.

Inadmissibility of the Opposition Division, or a Board in subsequent appeal proceedings, reconsidering the patentability of the claims after remittal to the first instance for adapting the description.

T0313/97

Concerning clarity.

No possibility of defining a feature which is not important for the invention. Interpretation in the light of the description.

First instance is bound by the legal judgement of the Board concerning clarity of the claims. No review before the opposition division.

T0027/94

Remitted to the previous instance for further substantive examination of a claim considered to be formally admissible.

If, through a decision of a Board of Appeal, a matter is referred back to the previous instance for further substantive examination (here: with regard to inventive step) of the subject-matter of a claim considered formally admissible neither this instance, nor the subsequently engaged Board of Appeal are bound to the content of this patent claim.

T1063/92 [T0026/93, T0720/93]

Claims specified in the auxiliary request satisfy the requirements of the Convention.

If the Board of Appeal remits a case to the first instance with the instruction to maintain the patent in the amended form "on the basis of the respondent's auxiliary request", it thereby finally decides on the patentability of the invention; it states *res judicata*, that the European patent and the invention upon which it is based in the version of the claims specified in the auxiliary request, satisfy the requirements of the Convention (see Article 102(3) EPC).

Even in so far as the decision of the Board of Appeal passes the task of adapting the description to the claims to the first instance, new documents, which are probably relevant for the state of the art, can no longer be taken into consideration in further proceedings (*res judicata*).

T0113/92 [T0757/91]

Remittal for adaptation of the description.

Adaptations of the description should be carried out in an economic fashion. They should be limited to the absolutely necessary. Therefore, as a rule, complete re-writes of descriptions should not be filed.

The adaptation of the description passed to the first instance by the board does not open the way for calling into question anew the previously legally established validity of the patent claims.

T0934/91 [T0323/89, T1137/97]

Decision regarding the fixing of costs is res judicata.

1. Boards of Appeal have the power to apportion and also to fix costs: Articles 104(1) and (2) and 111(1) EPC, having due regard to Article 113(1) EPC.

2. Their decisions are res judicata and final.

3. A communication by the first instance despite being entitled a "decision", and having the sole effect of informing a party of the points listed above does not rank as a "decision" for the purposes of Article 106(1) EPC. An appeal against such an act is therefore inadmissible.

T0843/91 [T0255/92, T0366/92, T0153/93, T1895/06]

Content and text of the patent claims, as well as the finding of fact upon which the decision rests, are res judicata.

The Boards of Appeal are the final instance and their decisions become final once they have been delivered, with the effect that the appeal proceedings are terminated.

A decision remitting a case to the Opposition Division with the order to maintain a patent on the basis of amended claims is binding in the sense that neither the wording nor the patentability of these claims may be further challenged in subsequent proceedings before the EPO. A finding of fact upon which this decision rests, i.e. a finding which is *conditio sine qua non* for the decision, is equally binding. Such a finding of fact is therefore not open to reconsideration pursuant to Article 111(2) EPC.

When the first board of appeal delivered its decision, the content and text of the patent claims became res judicata and could no longer be amended in proceedings before the EPO.

20. facts [A111(2)]

T0194/05

The prior examination of the formal admissibility of the introduced amendments in an opposed patent is not a necessary requirement for being able to decide on the sufficiency of the disclosure of the subject matter of the claims of the patent. Res judicata.

T0120/03 [T1895/06]

Not: Board empowered to decide on admissibility of a previous appeal before another Board.

T0436/95

The changed composition of the Board in the two appeal proceedings is of no consequence for the binding effect of the earlier decision.

Earlier decision of a board in the same case. Ratio decidendi.

21. the same [A111(2)]

T0201/04

Request for resuming discussion of an issue already decided by the Board of Appeal in an earlier decision. Article 10(b)(1) RPBA.

T0796/02 [T1029/99]

Abuse of procedure: Re-introducing broader claims before the opposition division, having obtained remittal on the basis of much more limited claims.

It amounts to an abuse of procedure to withdraw a request with broader claims in proceedings before the board of appeal, in order to avoid that a negative decision be taken on it by the board, but then to re-introduce those broader claims before the opposition division, having obtained remittal of the case for further prosecution on the basis of much more limited claims.

T0609/94 [T1630/08]

Continuation of the procedure on the basis of claims. Claims which differ from the first ones.

Binding effect of an appeal decision. Ratio decidendi. When, by decision of a Board of Appeal, the case is remitted to the first instance with the order to continue the procedure on the basis of a first set of claims, the first instance is not entitled to reject new claims merely by reference to said decision, when said new claims, while differing from said first claims, do not contravene the ratio decidendi of said decision.

22. bound [A111(2)]

J0027/94 [T0021/89, T0288/92]

Only for the individual case.

The binding effect according to Article 111(2) EPC applies only to the case decided upon.

23. ratio decidendi [A111(2)]

T0120/03

No implicit decision in a previous appeal on formal requirements, no limitation of extent of proceedings.

T0500/01 [T0742/04]

The manner of proceeding lies within the competence and is at the discretion of the instance which has to decide on the case before it.

There is no provision in the EPC under which a board upon remittal can limit in advance the patentee's right to file a new set of claims.

T0135/96 [T0567/06, T0567/06]

Remittal of the case to the first instance without comment as to its merits.

Non-consideration of documents and arguments presented in support of lack of inventive step, in a decision rejecting the opposition.

Article 112¹ - Decision or opinion¹ of the Enlarged Board of Appeal

(1) In order to **ensure² uniform³** application of the law, or if a **point of law⁴ of fundamental importance⁵ arises⁶**:

(a) the **Board of Appeal⁷** shall, **during⁸** proceedings on a case and either of its own motion or following a **request⁹** from a party to the appeal, refer any question to the **Enlarged Board of Appeal¹⁰** if it considers that a decision is **required¹¹** for the above purposes. If the Board of Appeal rejects the request, it shall give the **reasons¹²** in its final decision;

(b) the President of the European Patent Office may refer a point of law to the Enlarged Board of Appeal **where¹³ two¹⁴** Boards of Appeal have given **different¹⁵ decisions¹⁶** on that question.

(2) In the cases referred to in paragraph 1(a) the parties to the appeal proceedings shall be parties to the proceedings before the Enlarged Board of Appeal.

(3) The decision of the Enlarged Board of Appeal referred to in paragraph 1(a) shall be **binding¹⁷** on the Board of Appeal in respect of the appeal **in question¹⁸**.

Ref.: Art. 22, R. 111, 140

1. opinion [A112 Title]

T0952/92

The translation is legally irrelevant to the interpretation of the official text.

The wording of a translation published in the Official Journal of the EPO of the official text of an opinion issued by the Enlarged Board of Appeal pursuant to Article 22(1)(b) EPC is legally irrelevant to the interpretation of such official text.

2. ensure [A112(1)]

G0003/06 [G0001/05, G0001/06, T1040/04]

Related referral still pending.

Amendment of a patent granted on a divisional application. Related referral still pending.

The following question is referred to the Enlarged Board of Appeal:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?

T0739/05

No suspension, principle of the protection of legitimate expectations.

In a case where the principle of the protection of legitimate expectations in pending cases is applicable with regard to an established practice of the European Patent Office as published in the Guidelines for Examination in the European Patent Office and where there is no corresponding request by a party, there is no reason to suspend the further prosecution until a decision in a case pending before the Enlarged Board of Appeal is issued, even though the important point of law raised by the underlying T-case (referral) may concern the case under consideration.

This ensues from the above principle according to which in pending cases where existing long-standing practice laid down in publications of the European Patent Office might be overruled by a new decision of the Enlarged Board of Appeal the parties may rely on the previous practice until the new decision is made available to the public - and this is in line with consistent case law of the Boards of Appeal.

T0590/98

No reason to suspend the proceedings.

ⁱ See decisions/opinions of the Enlarged Board of Appeal G 1/86, G 2/88, G 4/88, G 5/88, G 6/88, G 7/88, G 8/88, G 1/90, G 1/92, G 3/95, G 6/95, G 2/97, G 2/98, G 3/98, G 4/98, G 1/99, G 2/99, G 3/99, G 1/02, G 1/03, G 2/03, G 3/03, G 1/04, G 2/04, G 3/04, G 1/05.

Continued existence of the partnership, notwithstanding changes of both participating partners and of name.

No reason to suspend the proceedings until the decision of the Enlarged Board of Appeal has been issued.

T0166/84 [T1283/05]

Suspension of examination for similar cases.

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 according to Article 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.

W0006/91

Disregard of a decision of the Enlarged Board of Appeal.

3. uniform [A112(1)]

G0005/88 [G0007/88, G0008/88]

Protection of legitimate expectations in the case of deviation from previous case law or practice.

J0008/00 [T1108/02]

Application of an Enlarged Board's decision to cases pending at the time of the decision.

No change in the law but an interpretation of the law one could rely on in place of the previous uncertainty on which one could not rely.

T0724/99

Applicability of decision G0001/99 to amendments filed before.

Alternative amendment not leading to reformatio in peius is possible but no such amendment requested by the Respondent (Patentee).

T0117/99

Not: Japanese or US-authorities.

The requirement of unity of invention has to be met, irrespective of whether or not the same or a similar set of claims had been found allowable by other authorities, in particular, Japanese or US-authorities. Euro-PCT.

T0111/98

Rules for exercising discretion.

Giving rules for exercising discretion in any possible situation which might arise is not comprised by the

tasks of the Enlarged Board of Appeal set out in Article 112 EPC.

T0143/91 [J0017/00, T0257/03]

There is no indication of contradictory case law where a different application of a legal provision is justified by different circumstances

T0603/89

A supposed contradiction between the Guidelines and an intended decision of a Board of Appeal is no ground for referring a question to the Enlarged Board of Appeal.

T0373/87

A single decision departing from the case law.

There is no contradictory case law where a single, unconfirmed decision departs from the case law established by several decisions.

4. point of law [A112(1)]

T0500/91

Not evaluation of evidence.

T0118/89 [T0373/87, T0939/92]

Not only a question of fact.

T0181/82 [T0219/83, T0583/89, T0972/91, T0082/93]

Not technical questions.

The request for the question to be remitted to the Enlarged Board of Appeal as to whether a person skilled in the art would readily understand a certain document was rejected. Likewise the question regarding the basis for interpreting a claim.

5. fundamental importance [A112(1)]

J0006/05

Not: Requirements in question will cease to exist. EPC 2000.

Requirements in question will cease to exist when the Revised EPC 2000 will enter into force.

Until the Revised EPC 2000 enters into force, an application filed in an official language of a Contracting State other than English, French or German, e.g. in the Finnish language, does not produce the result provided for in Article 80 EPC, i.e. no date of filing is attributed, if the other conditions provided for in Article 14(2) EPC, namely the applicant having its residence or principal place of business within the territory or being a national of that (same) Contracting State (here: Finland), are not fulfilled.

J0014/90

Invitation to the President to comment.

An invitation to the President of the EPO under Article 12a of the Rules of Procedure of the Boards of Appeal to comment on "questions of general interest" which arise in the course of proceedings is made to him direct. It is not necessary for such questions to be specifically defined or formulated.

T0601/92

Not special case.

There is no general interest in clarifying points of a special case. Such points are consequently not important.

T0184/91

Not the entire pending case.

T0835/90

Not a purely theoretical interest in responding a question.

T0118/89 [T0322/87, T0373/87]

Not only a question of fact. Not hypothetical question.

T0026/88

Not in the case of a changed legal situation.

There is no important point of law to be clarified where the legal situation on which the question was based has changed in the interim and the question is therefore unlikely to arise again very often.

6. arises [A112(1)]

G0009/92

The referred point of law no longer arises. The proceedings have therefore to be terminated.

7. Board of Appeal [A112(1)(a)]

D0019/99

Not: Disciplinary Board of Appeal.

The reporter of the disciplinary board is in no way an investigation authority, unlike one of the disciplinary council.

It is beyond the disciplinary Board of Appeal's power to refer to the Enlarged Board of Appeal.

Actions of the professional representatives with regard to their entitlement to represent, in particular concerning the granting of a European patent.

D0003/89 [D0009/03]

Referral by the Disciplinary Board.

The admissibility of the Disciplinary Board of Appeal's referring a matter to the Enlarged Board of Appeal seems doubtful. Such action is unnecessary if the Disciplinary Board's decision is consistent with its case law.

8. during [A112(1)(a)]

G0008/92

Allowability of appeal.

A Board of Appeal is only entitled to refer a point of law to the Enlarged Board of Appeal where an appeal is admissible, unless the submission relates to a point of law concerning allowability.

T0894/02

Not: Points of law having the force of res judicata.

Points of law having the force of res judicata, cannot be referred to the Enlarged Board of Appeal.

T0079/89

Not as far as it is bound by an earlier decision.

After a Board of Appeal has issued a decision in respect of certain issues, it has no power under Article 112(1)(a) EPC in the same proceedings to refer a question of law to the Enlarged Board of Appeal which arose in connection with issues which it has already decided, even though other issues are still pending before the Board of Appeal in proceedings on the same case.

9. request [A112(1)(a)]

T0379/96

On the basis of TRIPS.

(Auxiliary) Request on the basis of Article 125 EPC or Article 32 TRIPS to refer a question of law to the Enlarged Board of Appeal or to the European Court of Justice.

Revocation for the first time by a Board of Appeal without recourse to a further review by a higher instance.

10. Enlarged Board of Appeal [A112(1)(a)]

T0276/99

Not: European Court of Justice.

Replacement of parts of the description by a reference to the A-publication.

The provisions of the EPC, and the purpose of these, forbidding such replacement are clear, and no serious arguments based on the EC Treaty or the TRIPS Agreement exist which throw doubt on the matter or which raise anything that can be regarded as an important point of law that should be referred to the

Enlarged Board of Appeal, let alone the Court of Justice of the European Communities. A reference to the latter would in any case appear to have no basis under the EPC or the EC Treaty Article 234 (ex 177). Practice of Contracting States also members of the EU in exercising their rights under Article 65 EPC.

11. required [A112(1)(a)]

G0003/06 [G0001/05, G0001/06, T1040/04]

Related referral still pending.

Amendment of a patent granted on a divisional application. Related referral still pending.

The following question is referred to the Enlarged Board of Appeal:

Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual date of filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?

J0007/90 [J0016/90, J0014/91, T0072/89, T0583/89, T0676/90, T0297/91, T0485/91, T0860/91]

Not if irrelevant.

A question involving an important point of law does not need to be referred to the Enlarged Board of Appeal if the question is not important for the decision of this concrete case.

J0005/81 [T0162/82, T0198/88, T0579/88, T0708/90]

Not if the answer can be deduced beyond doubt.

A question involving an important point of law does not need to be referred to the Enlarged Board of Appeal if the Board of Appeal hearing the case considers itself able to answer it beyond doubt by reference to the Convention.

T0966/02

Of considerable importance in concrete case. Not: Academic interpretation of the Convention.

Double filing of an opposition by the same legal person.

It is not the duty of the Enlarged Board of Appeal to draw up binding legal opinions, nor to go into academic interpretation of the Convention, but to decide on legal issues which are of considerable importance in a concrete case.

T0520/01

Not: Decision can be reached on the basis of other grounds.

A request for a referral under Article 112 EPC to the Enlarged Board of Appeal must be refused if a decision can be reached on the basis of grounds other than those grounds to which the proposed question was related.

T0998/99

Not: Non-existence of Case Law in itself.

The non-existence of case law is not reason enough in itself to put a case and a related question to the Enlarged Board of Appeal.

T0525/99

Not: Established jurisprudence is giving a clear answer.

I. Disclaimers based solely on an Article 54(3) EPC prior art document are not objectionable under the terms of Article 123(2) EPC.

II. Established jurisprudence on this matter giving a clear answer, no reference to the Enlarged Board of Appeal is necessary.

T0972/91

Not if no general answer is possible.

T0727/89 [T0082/90, T0162/90, T0921/91, T1059/98]

Not if the premises on which the question is based are not applicable in the proceedings in question.

T0461/88 [T0301/87, T0648/88, T0180/92, T0469/92]

Referral is not necessary if a decision is made in favour of the requesting party.

T0297/88 [J0015/90, T0208/88, T0184/91, T0082/93, T0803/93, T1108/02]

Renewed submission is possible in certain cases only.

T0170/83 [J0047/92, T0162/85, T0058/87, T0373/87, T0005/89, T0315/89, T0037/90, T0323/90, T0688/90, T0506/91, T0473/92, T0952/92, T0702/93]

Not if there is no contradiction between decisions.

12. reasons [A112(1)(a)]

T0390/90

Procedural economy.

Possible decision of the Boards not to refer to the Enlarged Board on grounds of procedural economy.

13. where [A112(1)(b)]

T0688/05 [T0897/09, T0950/09]

Appellants' suggestions concerning an intervention of the president of the Office.

14. two [A112(1)(b)]

G0004/98 [G0001/04, G0003/08]

*Conflicting decisions of the Legal Board of Appeal.
Not: Discrepancy between office practice and the case law in itself.*

A discrepancy between office practice of the EPO and the case law of the Boards of Appeal is not in itself sufficient to justify a referral by the President of the EPO to the Enlarged Board of Appeal, if the practice of the EPO is not warranted by the case law.

Conflicting decisions of the Legal Board of Appeal which sits in a number of different compositions, at least if taken in different compositions.

15. different [A112(1)(b)]

G0003/95 [G0003/08]

Conflicting decisions.

1. In decision T0356/93 it was held that a claim defining genetically modified plants having a distinct, stable, herbicide-resistance genetic characteristic was not allowable under Article 53(b) EPC because the claimed genetic modification itself made the modified or transformed plant a "plant variety" within the meaning of Article 53(b)EPC.

2. This finding is not in conflict with the findings in either of decisions T0049/83 or T0019/90.

3. Consequently, the referral of the question: "Does a claim which relates to plants or animals but wherein specific plant or animal varieties are not individually claimed contravene the prohibition on patenting in Article 53(b) EPC if it embraces plant or animal varieties?" to the Enlarged Board of Appeal by the President of the EPO is inadmissible under Article 112(1)(b) EPC.

16. decisions [A112(1)(b)]

G0003/93

Also obiter dictum.

17. binding [A112(3)]

T0740/98

Not: Guidelines or established jurisprudence treated as binding.

The legal system established under the EPC does not treat either the Guidelines or established jurisprudence as binding.

Any principle of protection of legitimate expectations cannot be based on earlier Guidelines or jurisprudence.

In G0001/03 the Enlarged Board clarified the law which had been uncertain.

T0556/95

No power to limit the application of Article 116 (1) EPC.

The Enlarged Board has no power to limit the application of Article 116(1) EPC by means of any guidance it may lay down as to how an Examining Division should exercise its discretion under Rule 86(3) EPC.

T0297/88 [J0015/90, T0208/88, T0184/91, T0082/93, T0803/93]

Renewed submission of the same question is possible in certain cases.

18. in question [A112(3)]

J0008/00

Application of an Enlarged Board's decision to cases pending at the time of the decision.

Failure to pay designation fees.

Application of an Enlarged Board's decision to cases pending at the time of the decision.

No change in the law but an interpretation of the law one could rely on in place of the previous uncertainty on which one could not rely.

T0724/99

Applicability of decision G0001/99 to amendments filed before. Reformatio in peius.

T0590/98

No reason to suspend the proceedings.

Continued existence of the partnership, notwithstanding changes of both participating partners and of name.

No reason to suspend the proceedings until the decision of the Enlarged Board of Appeal has been issued.

T0166/84 [T1283/05]

Suspension of examination for similar cases.

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 according to Article 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.

Article 112a - Petition for review¹ by the Enlarged Board of Appeal

(1) Any **party**² to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal.

(2) The petition may **only**³ be filed on the grounds that:

(a) a member of the Board of Appeal took part in the decision in breach of Article 24, paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4;

(b) the Board of Appeal included a **person**⁴ not appointed as a member of the Boards of Appeal;

(c) a **fundamental**⁵ **violation**⁶ of **Article 113**⁷ occurred;

(d) any other fundamental procedural defect **defined**⁸ in the Implementing Regulations occurred in the appeal proceedings; or

(e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.

(3) The petition for review shall not have suspensive effect.

(4) The petition for review shall be filed in a reasoned statement, in accordance with the Implementing Regulations. If based on paragraph 2(a) to (d), the petition shall be filed within two months of notification of the decision of the Board of Appeal. If based on paragraph 2(e), the petition shall be filed within two months of the date on which the criminal act has been established and in any event no later than five years from notification of the decision of the Board of Appeal. The petition shall not be deemed to have been filed until after the prescribed fee has been **paid**⁹.

(5) The Enlarged Board of Appeal shall examine the petition for review in accordance with the Implementing Regulations. If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision and shall re-open proceedings before the Boards of Appeal in accordance with the Implementing Regulations.

(6) Any person who, in a designated Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the **period**¹⁰ between the decision of the Board of Appeal and publication in the European Patent Bulletin of the mention of the decision of the Enlarged Board of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.

Ref.: Art. 22, 24, 106, 111, 113, R. 104-111, 140

1. review [A112a Title]

G0001/97 [T0365/09]

Request with a view to revision.

T0315/97 [T0609/03, T0431/04]

New Article 112a EPC is not open to provisional application under Article 6 of the Revision Act. Conversion.

Request for conversion into national patent applications.

2. party [A112a(1)]

R0018/09

Joint petitioners.

3. only [A112a(2)]

R0002/08 [R0016/09, R0018/09, R0021/09]

Not: To examine in a general manner whether the board has correctly observed the rules applicable to the proceedings.

1. In the context of the examination of a petition for review it is obvious that the Enlarged Board of Appeal can examine the alleged violation of a procedural rule in order to know if this has caused a fundamental violation of the Article 113 EPC in the sense of Article 112a, paragraph 2, letter c) EPC.

2. In the absence of any substantiation in the notice of opposition, an opposition ground should not be considered as having been validly introduced in the proceedings by the mere fact of having crossed the corresponding box in the opposition form. This applies independently of the opposition ground concerned.

3. The submission of a new document in order to justify an alleged lack of novelty for the first time in the course of the appeal proceedings constitutes a new opposition ground in the sense of the opinion G0010/91 and the decision G0007/95.

4. The party which requires a decision in its favour from a Board of Appeal must take part actively in the procedure.

4. person [A112a(2)(b)]

T0857/06

Presence of assistant at deliberations. Article 19(1) RPBA.

The discretion under Article 19(1), second sentence, RPBA may be exercised to allow the board's assistant to attend and to take part in the deliberations.

5. fundamental [A112a(2)(c)]**R0011/08 [R0001/08, R0019/09, R0021/09]***Causal link between denial and final decision.***6. violation [A112a(2)(c)]****R0009/10 [R0012/09]***Not: No remittal to the first instance.***R0007/09***Statement setting out the grounds of appeal never notified to respondent/patent proprietor. No duty to monitor the proceedings themselves by regularly inspecting the electronic file.***R0009/08***Document had never been introduced.***R0004/08***Not: Reason corresponds to argument put forward by Proprietor.***R0002/08***Objections not raised by the Board itself.**Compliance with the right to be heard does not require that the objections filed against the assertions of a party and on which the decision is based are raised by the Board itself.***R0001/08 [R0010/09, R0012/09, R0014/09, R0018/09]***All foreseeable arguments in advance.**No provision of the EPC requires that a Board of Appeal must provide a party with all foreseeable arguments in favour or against a request in advance.***7. Article 113 [A112a(2)(c)]****R0003/09 [R0010/08, R0008/09, R0013/09]***No distinction between paragraphs 1 and 2. Differing interpretation of claims.***8. defined [A112a(2)(d)]****R0018/09 [R0010/09]***Not: Contravention of Article 6 ECHR.***R0010/09 [R0016/09]***Not: Exercise of discretion.***9. paid [A112a(4)]****R0002/09***Not: By compensation with claims for damages against the Office.***10. period [A112a(6)]****R0018/09***Acceleration.*