

TABLE OF CONTENTS

FOREWORD TO THE FIFTH EDITION I

READER'S GUIDE XXXI

- | | | |
|----|---------------|-------|
| 1. | Abbreviations | XXXI |
| 2. | Citations | XXXII |
| 3. | Case numbers | XXXII |

REFERRALS TO THE ENLARGED BOARD OF APPEAL XXXIII

- | | | |
|-----------|---|----------|
| I. | PATENTABILITY | 1 |
| A. | Patentable inventions | 1 |
| 1. | Technical nature of an invention | 1 |
| 1.1. | Computer-implemented inventions | 3 |
| 1.2. | Word-processing | 9 |
| 1.3. | Presentations of information | 11 |
| 1.4. | Schemes, rules and methods for performing mental acts,
playing games or doing business | 14 |
| 1.4.1 | Methods for doing business | 15 |
| 1.4.2 | Methods for performing mental acts | 18 |
| 1.5. | Aesthetic creations | 19 |
| 2. | Medical methods | 20 |
| 2.1. | Introduction | 20 |
| 2.2. | Allowability of claims under Article 52(4) EPC | 21 |
| 2.2.1 | General remarks | 21 |
| 2.2.2 | Nature of the method claim | 21 |
| 2.2.3 | Features for curative purposes | 23 |
| 2.2.4 | Medical character of the excluded methods | 25 |
| 2.2.5 | The exclusion of industrial applicability under Article
52(4) EPC | 26 |
| 2.3. | Therapeutic methods | 27 |
| 2.3.1 | Meaning of "therapy" | 27 |
| 2.3.2 | Methods with both therapeutic and non-therapeutic
indications | 29 |
| 2.4. | Surgical methods | 32 |
| 2.5. | Diagnostic methods | 34 |
| 2.5.1 | Interpreting the notion of "diagnostic methods" | 34 |

2.5.2	Opinion G 1/04 of the Enlarged Board of Appeal	35
2.6.	Products for use in medical methods	37
B.	Exceptions to patentability	37
1.	Introduction	37
2.	Inventions contrary to "ordre public"	39
3.	Patentability of plants and plant varieties	42
4.	Patentability of animals and animal varieties	43
5.	Essentially biological processes	44
6.	Microbiological processes and the products thereof	45
C.	Novelty	46
1.	Defining the state of the art	47
1.1.	Relevant point in time	47
1.2.	European prior rights	47
1.3.	PCT applications as state of the art	48
1.4.	In-house knowledge not published before the priority date	48
1.5.	Definition of "common general knowledge"	48
1.6.	Excluded national prior rights	50
1.7.	Article 55 EPC	50
1.8.	Availability to the public	51
1.8.1	Publication	51
1.8.2	Lecture	54
1.8.3	Abstracts of documents	54
1.8.4	Repetition of oral disclosures	55
1.8.5	Prior use	55
1.8.6	Biological material	56
1.8.7	The concept of "the public"	56
1.8.8	Obligation to maintain secrecy	58
1.9.	Issues of proof	64
1.9.1	Nature of the evidence	64
1.9.2	Burden of proof	64
1.9.3	Standard of proof	65
1.9.4	Obligation of the EPO to examine of its own motion	67
2.	Determining the content of the relevant prior art	67
2.1.	General rules of interpretation	67
2.2.	Combinations within a prior art document	70
2.3.	Taking implicit features into account	71
2.4.	Taking intrinsic features into account	73
2.5.	Taking equivalents into account	73
2.6.	Taking drawings into account	74

2.7.	Taking examples into account	74
2.8.	Assessment of prior uses	75
2.9.	Broad claims	78
2.10.	Deficiencies and mistakes in a disclosure	79
2.11.	Accidental disclosure	80
2.12.	Reproducibility of the content of the disclosure	80
3.	Ascertaining differences	82
3.1.	Comparing each individual item from the prior art	82
3.2.	Distinguishing features	83
3.2.1	Difference in wording	84
3.2.2	Differences in values	84
3.2.3	Difference in composition	85
3.2.4	Inevitably obtained products	86
3.2.5	Functional features	86
3.2.6	Generic disclosure	87
3.2.7	Product claim with process features	87
4.	Chemical inventions and selection inventions	87
4.1.	Novelty of chemical compounds and groups of compounds	88
4.1.1	Anticipation of certain compounds	89
4.1.2	Novelty of groups of substances	92
4.1.3	Novelty of enantiomers	93
4.1.4	Achieving a higher degree of purity	94
4.2.	Selection of parameter ranges	96
4.2.1	Selection from a broad range	96
4.2.2	Overlapping ranges	97
4.2.3	Multiple selection	99
4.3.	Subject-matter group	101
5.	Novelty of use	101
5.1.	First medical use	101
5.1.1	Introduction	101
5.1.2	Scope of a purpose-related product claim	102
5.1.3	Protection of a preparation in the form of a "kit-of-parts"	103
5.1.4	Further technical information as compared with the state of the art	104
5.2.	Second (or further) medical use	104
5.2.1	Formulation of claims	104
5.2.2	Novelty of the therapeutic application	107
5.3.	Second (or further) non-medical use	113
5.3.1	Novelty criteria for use claims and process claims containing a purpose feature	113
5.3.2	Statement of purpose in non-medical use claims in view of Article 52(4) EPC	119

5.3.3	Novelty criteria for product claims with purpose characteristics	119
D.	Inventive step	120
1.	Introduction	120
2.	Problem and solution approach	120
3.	Closest prior art	121
3.1.	Determination of closest prior art in general	121
3.2.	Same purpose or effect	122
3.3.	Similarity of the technical problem	122
3.4.	Most promising springboard	123
3.5.	Selection of most promising starting point	124
3.6.	Improvement of a production process for a known product	125
3.7.	Old prior art documents as closest prior art	125
4.	Technical problem	126
4.1.	Determination of the technical problem	126
4.2.	Alleged advantages	127
4.3.	Formulation of the technical problem	128
4.3.1	No pointers to the solution	128
4.3.2	Problem formulated in the patent application as starting point	128
4.3.3	Formulation of partial problems - lack of unity	129
4.4.	Reformulation of the technical problem	129
4.5.	Alternative solution to a known problem	131
5.	"Could-would approach" and ex post facto analysis	131
6.	Expectation of success, especially in the field of genetic engineering and biotechnology	132
7.	Skilled person	135
7.1.	Definition of the skilled person	135
7.1.1	Definition	135
7.1.2	Competent skilled person - group of people as "skilled person"	136
7.1.3	Definition of the person skilled in the art in the field of biotechnology	136
7.1.4	Identification of the skilled person in the case of computer-implemented inventions	138
7.2.	Neighbouring field	138
7.3.	Skilled person - level of knowledge	139
7.4.	Everyday items from a different technical field	140
8.	Assessment of inventive step	141
8.1.	Treatment of technical and non-technical features	141

8.1.1	Technical character of the invention	141
8.1.2	Problem and solution approach	142
8.1.3	Identifying technical features	143
8.1.4	Assessment of technical effect	144
8.1.5	Formulation of the technical problem	146
8.2.	Combination invention	147
8.2.1	Existence of a combination invention	147
8.2.2	Partial problems	148
8.3.	Technical disclosure in a prior art document	149
8.4.	Features not contributing to the solution of the problem	149
8.5.	Foreseeable disadvantageous or technically non-functional modifications	149
8.6.	Substitution of materials - analogous use	150
8.7.	Combination of documents	151
8.8.	Chemical inventions	151
8.8.1	Structural similarity	151
8.8.2	Broad claims	152
8.8.3	Intermediate products	153
8.9.	Equivalents	154
8.10.	Problem inventions	154
8.11.	New use of a known measure	155
8.12.	Obvious new use	156
8.13.	Need to improve properties	156
8.14.	Disclaimer	157
8.15.	Optimisation of parameters	157
8.16.	Small improvement in commercially used process	158
8.17.	Evidence of inventive step in the field of medicine	158
8.18.	Analogy process - envisageable product	158
8.19.	Examples on the denial of inventive step	159
8.19.1	Reversal of procedural steps	159
8.19.2	Purposive selection	159
8.19.3	Automation	160
8.19.4	Routine experiments	160
8.19.5	Simplification of complicated technology	160
8.19.6	Choice of one of several obvious solutions	160
8.19.7	Several obvious steps	161
9.	Secondary indicia in the assessment of inventive step	161
9.1.	General issues	161
9.2.	Technical prejudice	161
9.3.	Age of documents - time factor	163
9.4.	Satisfaction of a long-felt need	163
9.5.	Commercial success	164
9.6.	Simple solution	165

9.7. Surprising effect - bonus effect	166
9.8. Comparative tests	167
E. The requirement of industrial applicability under Article 57 EPC	168
1. Notion of "industrial application"	168
2. Indicia in determining industrial applicability	171
2.1. Methods applied in the private and personal sphere	171
2.2. Possibility of services offered by an enterprise	172
2.3. Other criteria - formulation of claims	172
II. CONDITIONS TO BE MET BY AN APPLICATION	173
A. Sufficiency of disclosure	173
1. Parts of the application relevant for assessing sufficiency of disclosure	173
2. Knowledge of skilled person relevant for assessing sufficiency of disclosure	173
3. Clarity and completeness of disclosure	175
4. Reproducibility without undue burden	177
5. The requirement of sufficiency of disclosure in the biotechnology field	178
5.1. Clarity and completeness of disclosure	178
5.1.1 The extent to which the invention must be reproducible	178
5.1.2 Reproducibility without undue burden	179
5.2. Deposit of living material	181
5.2.1 Substantive law questions	181
5.2.2 Procedural law questions	182
6. The relationship between Article 83 and Article 84 EPC	183
6.1. Article 83 EPC and support from the description	183
6.2. Article 83 EPC and clarity of claims	184
7. Evidence	185
B. Claims	185
1. Clarity	186
1.1. Principles governing the text of claims	186
1.1.1 General	186
1.1.2 Reference to the description or drawings	188
1.1.3 Indication of all essential features	189
1.1.4 Clarity of broad claims	191

1.1.5	Principles in connection with categories of claim	192
1.2.	Exceptions to the principles	193
1.2.1	Disclaimers	193
1.2.2	Functional features	196
1.2.3	Unspecified features and relative qualities	198
2.	Conciseness	199
2.1.	General	199
2.2.	Rule 29(2) EPC	200
3.	Form of the claims	201
3.1.	One-part or two-part claim	202
3.2.	Particular issues in connection with two-part claims	202
4.	Claims supported by the description	203
5.	Interpretation of claims	205
5.1.	General	205
5.2.	Meaning of terms	206
5.3.	Using description and drawings to interpret the claims	206
5.3.1	Use in the examination of the conditions for patentability	207
5.3.2	Use in the examination relating to the requirements of Article 123 EPC	208
5.3.3	Use in the examination relating to the clarity requirement pursuant to Article 84 EPC	208
5.3.4	Scope of protection not defined with regard to infringement	210
6.	Product-by-process claims	211
6.1.	Introduction	211
6.2.	Requirement that the claimed product must be patentable	211
6.3.	Requirement that the claimed product cannot be described in any other way	213
6.4.	Combination of product and process features	213
6.5.	Extension of protection conferred by product-by-process claims	213
7.	Claims fees	214
C.	Unity of invention	215
1.	Introduction	215
2.	Unity in the context of different types of claims	215
2.1.	Plurality of independent claims	215
2.2.	Dependent claims	217
2.3.	Intermediate products	217
3.	Assessing lack of unity of invention	218

3.1.	General approach - content of claims	218
3.2.	Assessment of lack of unity by the International Searching Authority (ISA)	219
3.3.	Assessment of lack of unity in examination proceedings	220
3.3.1	Lack of unity raised at different stages of the procedure	221
3.3.2	Assessment of requests for refund of further search fees (Rule 46(2) EPC)	221
3.4.	No assessment of lack of unity in opposition proceedings	222
4.	Criteria for determining lack of unity	223
4.1.	Determination of the technical problem	223
4.2.	Examination as to novelty and inventive step	223
5.	The single general inventive concept	225
5.1.	General	225
5.2.	Inventive character of the single general concept	227
5.3.	Unity of single claims defining alternatives ("Markush claims")	229
6.	Plurality of inventions and further search fees	231
6.1.	Consequences of non-payment of a further search fee	231
6.2.	Dispensing with further search fee	233
6.3.	Further invitations to pay additional search fees	233
III.	AMENDMENTS - DIVISIONAL APPLICATIONS	235
A.	Article 123(2) EPC	235
1.	Content of the application as originally filed	235
1.1.	General issues	235
1.2.	Technical contribution - addition or deletion of a feature	242
1.3.	Disclosure in drawings	246
1.4.	Cross-references	248
1.5.	Errors in the disclosure	249
1.5.1	Calculation errors	249
1.5.2	Incorrect structural formula	249
1.5.3	Amendment based on errors	249
1.5.4	Elimination of contradictions	250
1.6.	Subsequent addition of details	251
1.6.1	Amendments in the description of the prior art	251
1.6.2	Subsequent addition of effects	252
1.6.3	Disclaimers	252
2.	"Tests" for the assessing allowability of an amendment	259
2.1.	Deducibility of amendments from the application as filed directly and unambiguously	259
2.2.	The "is it essential" test	263

2.3. The "novelty test"	265
B. Article 123(3) EPC	266
1. General issues	266
2. Generalisation of a feature	269
3. Transposition of features	270
4. Change of claim category	270
C. Relationship between Article 123(2) and Article 123(3) EPC	274
1. Cases of conflict	274
2. Decision G 1/93 of the Enlarged Board of Appeal	275
3. Resolving the conflict in exceptional cases	276
D. Rule 88, second sentence, EPC	277
1. Relation to Article 123(2) EPC	277
2. Obviousness of the error and the correction	278
E. Standard of proof for allowing amendments and corrections	280
F. Divisional applications	281
1. Subject-matter of a divisional application	281
1.1. General principles	281
1.2. Validity of divisional applications	282
1.3. Amendments to divisional applications	283
1.4. Individual cases	284
2. Division of a divisional application	285
3. Double patenting	287
IV. PRIORITY	289
A. Applications giving rise to a right of priority	289
1. Application filed in or for a state party to the Paris Convention	289
2. Priority right of the applicant or his successor in title	289
3. National deposit of industrial design	290
4. Postdating of the previous application	290
5. Multiple exercise of the right of priority for one contracting state	290

B. Identity of invention	291
1. Disclosure in the earlier application of the invention claimed in the subsequent application	292
1.1. Basic considerations in the interpretation of "the same invention"	292
1.2. Amendments and disclaimers	293
1.3. Disclosure in the previous application as a whole	293
1.4. Reference to common general knowledge	294
1.5. Explicit or implicit disclosure of the "essential" features in the priority document	295
1.5.1 General	295
1.5.2 Cases of non-disclosure of an essential feature	295
1.5.3 Example of disclosure of essential features of an invention	296
1.6. Solution of the same problem	297
1.7. Error margins and definitions of limits	297
1.8. Selection from generic disclosure	298
2. Claiming the invention disclosed in the earlier application in the subsequent application	299
2.1. Implicit features of the technical teaching of the subsequent application	299
2.2. Features missing with respect to the earlier application	300
2.2.1 Omission of non-essential features	300
2.2.2 Omission of indispensable features	300
3. Enabling disclosure in the priority document	301
C. First application in a Paris Convention country	303
D. Partial and multiple priorities	305
1. Publications during the priority interval	305
2. Different priorities for different parts of a European patent application	305
3. Multiple priorities for one claim	306
V. RIGHT TO A EUROPEAN PATENT	309

VI. RULES COMMON TO ALL PROCEEDINGS BEFORE THE EPO	311
A. The principle of the protection of legitimate expectations	311
1. General issues	311
1.1. Sources of legitimate expectations	311
1.2. Examples of the legitimate expectations principle	312
1.3. Limits of the legitimate expectations principle	313
1.4. The requirement of proof	314
2. Obligation to draw attention to easily remediable deficiencies	315
2.1. Examples of the obligation to draw attention to easily remediable deficiencies	315
2.2. Electronic filing of documents	317
2.3. Limits of the obligation to draw attention to easily remediable deficiencies	317
3. Courtesy services performed by the EPO	318
4. Principle of legitimate expectations where the previous case law is departed from	319
4.1. General	319
4.2. Point in time from which a new decision which deviates from existing practice becomes generally applicable	320
B. Right to be heard	322
1. The general principle	322
1.1. The definition of "grounds or evidence"	322
1.2. Some examples of the principle	323
1.3. Limits of the principle	323
1.4. Right to be heard and the timing of decisions	324
2. Right to be heard in oral proceedings	325
2.1. Right to oral proceedings	325
2.2. Introduction of a new claim, relevant document or new argument	326
2.2.1 Cases where new claims or relevant documents were introduced	326
2.2.2 Cases where no new claims, relevant documents or new arguments were introduced	327
2.3. Changes after oral proceedings	328
3. Non-appearance at oral proceedings and the right to be heard	328
3.1. Non-appearance at oral proceedings - case law concerning G 4/92	328

3.2.	Non-appearance at oral hearings before the boards of appeal	331
4.	Article 113(2) EPC	331
4.1.	The requirement of a text agreed by the applicant	332
4.2.	Cases where the EPO is uncertain or mistaken about the approval of the text	332
C.	Oral proceedings	333
1.	Right to oral proceedings	333
1.1.	The general principle	333
1.2.	Oral proceedings before the Receiving Section	334
1.3.	Examples of the principle	334
2.	Request for oral proceedings	335
2.1.	Wording of request	335
2.1.1	Wording constituting a request	335
2.1.2	Wording not constituting a request	336
2.2.	Withdrawal of request	336
2.3.	Further oral proceedings before the same department	337
2.4.	Auxiliary request for oral proceedings	338
2.5.	Request for oral proceedings in further prosecution proceedings	339
3.	Non-appearance at oral proceedings	339
3.1.	Right to present comments and non-attendance of a party by choice	339
3.2.	Obligation to give notice if not attending oral proceedings	339
4.	Preparation and conduct of oral proceedings	340
4.1.	Fixing or postponing the date for oral proceedings	340
4.1.1	Unavailability of a party, representative or expert	341
4.1.2	New evidence	342
4.1.3	Proceedings before a national court	342
4.2.	Curtailement of notice in the summons	342
4.3.	Communication under Article 11(1) RPBA	343
4.4.	Interpretation and application of Rule 71a EPC	343
4.4.1	Examination and opposition proceedings	344
4.4.2	Appeal proceedings	345
4.5.	Computer-generated presentations	346
4.6.	Taking of minutes	346
4.7.	Costs	347
4.7.1	Apportionment of costs	347
4.7.2	Interpreting costs during oral proceedings	347

D. Time limits, further processing and interruption of proceedings	348
1. Calculation of time limits	348
1.1. Calculation of time limits under Rule 83 EPC	348
1.2. Extension of time limits ipso jure on account of public holidays or technical failures	349
1.2.1 Public holiday in one of the filing locations under Rule 85(1) EPC	349
1.2.2 Interruption in the delivery of mail	349
1.3. Statutory periods of grace and the fiction of observance of a time limit for fee payments	350
1.3.1 Additional period for renewal fees under Article 86(2) EPC	350
1.3.2 Period of grace for payment of fees under Rule 85a EPC	350
1.3.3 Fiction of fee payment in due time pursuant to Article 8(3) and (4) RRF	351
2. Extension of time limits on request and further processing	352
2.1. Relevant criteria when time limits are extended	352
2.2. Further processing under Art. 121 EPC	352
3. Interruption of proceedings (Rule 90 EPC)	353
3.1. Application of Rule 90 EPC by the EPO of its own motion	353
3.2. Concept of legal incapacity (Rule 90(1)(a) and (c) EPC)	353
3.3. Determining legal incapacity of the applicant or patent proprietor for the purpose of Rule 90(1)(a) EPC	354
3.4. Determining legal incapacity of the representative for the purpose of Rule 90(1)(c) EPC	354
3.5. Legal incapacity of a representative from outside the contracting states	355
3.6. Interruption of proceedings because of insolvency (Rule 90(1)(b) EPC)	356
3.7. Consequences of interruption of proceedings (Rule 90(4) EPC)	357
E. Re-establishment of rights	357
1. Applicability of re-establishment of rights (Article 122(1) EPC)	357
1.1. The meaning of "time limit"	357
1.2. Loss of rights as a direct consequence by virtue of the EPC	358
1.3. Omission of acts by applicant	359
2. Admissibility of applications for re-establishment of rights	360
2.1. Department competent to decide upon the application	360

2.1.1	When the fee for grant and the printing fee have not been paid or the translation has not been filed	360
2.1.2	When no reply has been received to a communication under Article 96(2) EPC	360
2.1.3	When a renewal fee has not been paid	361
2.1.4	When a notice of appeal or statement of grounds of appeal has not been filed	361
2.1.5	When a protest under Rule 40.2 PCT has not been filed	362
2.2.	Time limits for filing an application for re-establishment (Article 122(2) EPC)	362
2.2.1	Two-month time limit from the removal of the cause of non-compliance	362
2.2.2	One-year time limit following the expiry of the unobserved time limit	365
2.3.	Making good the omitted act	366
2.4.	Filing and substantiation of the application (Article 122(2) and (3) EPC)	366
2.5.	Correction of deficiencies in the application for re-establishment	368
3.	Time limits excluded from re-establishment under Article 122(5) EPC	368
3.1.	General issues	368
3.2.	PCT time limits excluded under Article 122(5) EPC	369
4.	Article 48(2)(a) PCT	371
5.	Parties to proceedings	372
6.	Merit of applications for re-establishment of rights	372
6.1.	Inability to observe a time limit	372
6.1.1	Financial difficulties	372
6.1.2	Tactical considerations	373
6.2.	General comments on due care	374
6.2.1	Exceptional circumstances	374
6.2.2	Isolated mistake within a satisfactory system for monitoring time limits	375
6.3.	Persons required to exercise due care; requirements regarding due care	378
6.3.1	Due care on the part of the applicant	378
6.3.2	Due care on the part of the professional representative	379
6.3.3	Due care on the part of a non-authorized representative	382
6.3.4	Due care in dealing with assistants	383
6.3.5	Due care in using mail delivery services	386
7.	Rights of use under Article 122(6) EPC	387
8.	Restitutio in integrum - Interruption of proceedings	387

9.	Interrelation between Article 122 EPC and Rule 85(2) EPC	388
10.	Principle of proportionality	388
F.	Late submission	388
1.	The meaning of "late" - delaying the proceedings	389
2.	Consideration of late submissions	390
3.	Exercising discretion over admitting late submissions	392
3.1.	Examination as to relevance	392
3.1.1	General	392
3.1.2	Examination as to relevance with regard to G 9/91 and G 10/91	393
3.1.3	Examination as to relevance and abuse of procedure	394
3.1.4	Procedural abuse in the case of public prior use	396
3.1.5	Examination as to relevance and justified late submission	399
4.	Late submission and the right to be heard	400
5.	Late-filed arguments	401
6.	Documents cited in the patent or the search report	402
7.	Remittal to the department of first instance	403
7.1.	General	403
7.2.	Patent in jeopardy	404
7.3.	New facts	405
8.	Apportionment of costs	405
G.	Divisional applications	406
1.	Procedural questions	406
1.1.	Introduction	406
1.2.	Rule 25(1) EPC	407
1.2.1	General	407
1.2.2	Filing period	407
1.3.	Designation of contracting states in a divisional application	409
1.4.	Right to file a divisional application	410
1.5.	Correction of errors	410
H.	Rules relating to Fees	411
1.	Payment of fee	411
1.1.	Incorrect debit orders	411
1.2.	Designation fees	411
1.3.	Indication of purpose of payment	412

1.4. Methods of paying	412
2. Date of payment	412
3. Small amount lacking	413
I. Procedural steps	414
1. General principles	414
2. Signatures	415
3. Main and auxiliary requests	415
3.1. Admissibility	415
3.2. Examination procedure	415
3.3. Opposition procedure	416
4. Maintenance in the case of prior European rights	416
J. Withdrawal of application and surrender of patent	417
1. Withdrawal of patent application as a whole	417
2. Surrender of patent as a whole	418
3. Abandonment of parts of an application or patent	419
3.1. Abandonment with substantive effect	419
3.2. Abandonment without substantive effect	420
3.2.1 Examination proceedings	420
3.2.2 Opposition proceedings	420
3.3. Non-payment of further search fees in the case of lack of unity	422
3.4. Non-payment of claims fees	422
K. Law of evidence	423
1. Introduction and definitions	423
2. Admissibility of evidence	424
2.1. No definitive itemisation of admissible evidence	424
2.2. Hearing parties, witnesses and experts	424
2.3. Unsworn witness declarations (affidavits)	426
2.4. Other evidence	427
3. Procedure for the taking of evidence	427
3.1. Competent departments	427
3.2. Time frame	427
3.3. Taking of evidence - scope	427
3.4. Keeping of evidence	428
4. Evaluation of evidence	428
4.1. Principle of unfettered consideration of evidence	428
4.2. Probative value of evidence - individual cases	429

4.2.1	Evidence sufficient	429
4.2.2	Evidence insufficient	430
4.3.	"Balance of probabilities" and standard of proof - case groups	433
4.3.1	Prior use	433
4.3.2	Content of a disclosure	434
4.3.3	Amendments	435
4.3.4	Claiming a valid priority	435
4.3.5	Abusive conduct	435
4.3.6	Procedural issues	436
4.3.7	Disciplinary matters	437
5.	Burden of proof	437
5.1.	Apportioning the burden of proof	437
5.1.1	General	437
5.1.2	Individual cases	438
5.2.	Shifting of the burden of proof	440
L.	Representation	441
1.	Professional representatives	441
1.1.	List of professional representatives (Article 134(1) EPC)	441
1.2.	Duty of persons without residence nor place of business within a contracting state to be represented by a professional representative	442
1.3.	Professional representatives during the transitional period	442
1.4.	Procedural steps performed by a person other than the professional representative	443
2.	Legal practitioners entitled to act as professional representative	443
2.1.	Introduction	443
2.2.	Register of legal practitioners	444
2.3.	Qualifying conditions according to Article 134(7) EPC	445
3.	Appointment of a common professional representative (Rule 100 EPC)	446
4.	Authorisations for appointment of a representative	447
4.1.	Filing of the authorisation	447
4.2.	General authorisations	448
4.3.	Sub-authorisations	449
4.4.	Authorisation of an association of representatives	449
5.	Oral submissions by an accompanying person	450
5.1.	General	450
5.2.	Oral submissions by former members of the boards of appeal	453
5.3.	Oral submissions by qualified patent lawyers of non-EPC contracting states	454

6.	Distinction between presentation of facts and evidence and presentation of arguments	454
M.	Decisions of EPO departments	455
1.	Right to a decision	455
2.	Composition of the competent departments of first instance	456
2.1.	Examining division	456
2.2.	Opposition division	456
3.	Suspected partiality	458
3.1.	General principles	458
3.2.	Individual cases	459
3.2.1	Members of the examining and opposition divisions	459
3.2.2	Members of the boards of appeal	461
4.	Date of decision	463
4.1.	Entry into force of decisions	463
4.2.	Completion of the internal decision-making process	463
5.	Form of decisions	464
5.1.	General issues	464
5.2.	Inconsistency between oral and written decisions	466
5.3.	Reasons for the decision	466
5.3.1	Reason for main and auxiliary requests	466
5.3.2	Compliance with the requirements of Rule 68(2) EPC	467
5.3.3	Non-compliance with the requirements of Rule 68(2) EPC	467
5.4.	Signatures on a decision	470
6.	Correction of errors in decisions	471
6.1.	General issues	471
6.2.	Errors in the printed version of the European patent specification	473
6.3.	Competence to correct a decision under Rule 89 EPC	474
7.	Principles for the exercise of discretion	475
8.	Legal status of the Guidelines for Examination in the EPO	476
9.	Duties not entrusted to formalities officers	477
10.	Jurisdiction	478
N.	Other procedural questions	478
1.	Language privilege	478
2.	Inspection of files	480
3.	Register of Patents	481

3.1. General	481
3.2. Registration of licences	481
3.3. Transfer	481
4. Suspension of proceedings under Rule 13(1) EPC	482
4.1. Rule 13(1) EPC	482
4.1.1 General	482
4.1.2 Opening of proceedings before a national court	483
4.2. Rule 13(3) EPC	484
5. Notifications	484
6. Unity of the European patent application	486
O. Interpretation of the EPC	486
1. The Vienna Convention on the Law of Treaties	486
2. Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS)	487
2.1. The requirement for the judicial review of decisions	487
2.2. Interpretation of Article 87 EPC in the light of TRIPS	488
3. Interpretation of the various language texts of the EPC (Article 177 EPC)	488
4. Interpretation of the EPC by the boards of appeal	489
4.1. Decisions of the Administrative Council concerning a question of interpretation	489
4.2. Taking national decisions into account	489
4.3. Implementing Regulations	490
5. Allocation of responsibilities in the EPC	490
VII. PROCEEDINGS BEFORE THE EPO	491
A. Preliminary and formalities examination	491
1. Accordance of a date of filing - language of the filed documents	491
2. Application documents	492
2.1. Filing of application documents	492
2.2. Subsequent filing of drawings	493
2.3. Replacing the invention	493
2.4. Extent of competence of the Receiving Section	494
3. Identity of the applicant	495
4. Designation of states	496
4.1. Article 79(2) EPC (old version)	496
4.2. Article 79(2) EPC (current version)	496

4.3.	Effect of non-payment of designation fees	497
4.4.	Correction of designation of states in Euro-PCT applications	498
5.	Correction of priority declarations	499
6.	Filing of priority documents	502
7.	Applicability of Article 110(3) EPC	502
8.	Publication of the application	502
B.	Examination procedure	503
1.	Request for examination	503
2.	Procedure stage prior to substantive examination	504
2.1.	Communication under Article 96(1) EPC and Rule 51(1) EPC	504
2.2.	Amendments after receipt of the European search report (Rule 86(2) EPC)	504
2.3.	Failure to reply to the communication pursuant to Article 96(1) EPC (Article 96(3) EPC)	505
3.	Substantive examination of the application	505
3.1.	First and further communications pursuant to Article 96(2) EPC and Rule 51(2) EPC	505
3.2.	Contents of a communication according to Article 96(2) EPC and Rule 51(3) EPC	507
3.3.	Amendments after receipt of the first communication (Rule 86(3) EPC)	508
3.4.	Admissibility of amendments after reply to the first communication	508
3.5.	Amendments relating to unsearched subject-matter	509
3.6.	Issuance of a further communication under Article 113(1) EPC	512
3.7.	Informal communications	516
3.7.1	Telephone conversations	516
3.7.2	Interviews	516
3.8.	Failure to reply to the communication pursuant to Article 96(2) EPC	518
3.9.	Refusal of a European patent application (Article 97(1) EPC)	518
3.10.	Amendments filed before the boards of appeal	519
4.	Examination proceedings after issue of the Rule 51(4) EPC communication	520
4.1.	Introduction	520
4.2.	Approval of the text by the applicant	520
4.2.1	Clear and unambiguous approval according to R. 51(4) EPC (earlier version)	520
4.2.2	Rule 51(4) EPC communication refusing main and first auxiliary requests (2002 version)	521

4.3.	Article 113(2) EPC	522
4.4.	Amendments filed in reply to a communication under Rule 51(4) EPC	523
4.5.	Re-opening examination after approval of the text for grant	525
4.6.	Examination after remittal for further prosecution	525
4.7.	Late amendments under new Rule 51(6) EPC communication	526
4.8.	Amendment after completion of the examination procedure	528
5.	Consolidation of proceedings	528
6.	Entry into force of a decision to grant a European patent	529
7.	Errors in the Patent Bulletin	530
8.	Metric or SI units	531
C.	Opposition procedure	531
1.	Legal nature of opposition proceedings	531
1.1.	Introduction	531
1.2.	Independent procedure	531
1.3.	Contentious proceedings	531
1.4.	Principle of ex officio examination	532
1.5.	Principle of impartiality	533
2.	Right to be heard in opposition proceedings	533
2.1.	Opportunity to make comments and principle of equal rights	533
2.2.	Invitation to file observations under Article 101(2) EPC	534
2.2.1	"As often as necessary"	534
2.2.2	Limitation of the parties' observations to the "necessary and expedient"	535
2.3.	Communication and invitation to file observations under Rule 58(4) EPC	536
2.4.	EPO communications to "take note" and sufficient time to submit a response	536
2.5.	Opportunity to comment - case groups	538
2.5.1	Opportunity to comment on new grounds of opposition	538
2.5.2	Opportunity to comment on uncontested claims	539
2.5.3	Opportunity to comment on provisional opinions of the opposition division	539
2.5.4	Opportunity to comment where the opposition is rejected as inadmissible	540
2.5.5	Opportunity to comment after remittal to the department of first instance	540
3.	Special features of the opposition procedure	541
3.1.	Transfer of opponent status	541
3.2.	Impact of withdrawal of opposition on proceedings before the EPO	543

3.2.1	Withdrawal of opposition during opposition proceedings	543
3.2.2	Withdrawal of opposition during appeal proceedings	544
3.3.	Continuation of opposition proceedings in the event of surrender or lapse of a European patent	545
3.4.	Acceleration of proceedings in the case of pending infringement proceedings	546
3.5.	Intervention of an alleged infringer	546
4.	Examination of admissibility of opposition	548
4.1.	Examination of admissibility by the EPO of its own motion	548
4.2.	Competence to decide on inadmissibility	549
4.3.	Formal requirements for opposition and filing in due time	549
4.3.1	Fundamentals	549
4.3.2	Designating the opponent	550
4.3.3	Title of the invention	550
4.3.4	Payment of the opposition fee	551
4.3.5	Other requirements	551
4.4.	Entitlement to file an opposition	551
4.4.1	General conditions	551
4.4.2	No personal interest of the opponent - double filing of opposition by the same person	552
4.4.3	Opposition by the patent proprietor	553
4.4.4	Opposition on behalf of a third party - straw man	553
4.4.5	Admissibility of a joint opposition - multiple opponents	554
4.5.	Substantiation of the opposition	556
4.5.1	Required content of the notice of opposition	556
4.5.2	Case groups	558
4.5.3	Opposition based on public prior use	561
5.	Substantive examination of the opposition	562
5.1.	Introduction	562
5.2.	Examination of the legal framework of the opposition	563
5.2.1	Extent to which the European patent is opposed	563
5.2.2	Grounds on which the opposition is based	565
5.3.	Examination of the factual framework of the opposition	568
6.	Amendments in opposition proceedings	569
6.1.	Admissibility of amendments	569
6.1.1	General	569
6.1.2	Filing date of amendments	570
6.1.3	Filing additional dependent and independent claims	571
6.1.4	Amendments intended to remedy a lack of clarity	573
6.2.	Substantive examination in case of amendments	575
6.3.	Additional search	576
7.	Decisions of the opposition division	576
7.1.	Revocation of a European patent by way of a decision	576

7.2.	Interlocutory decisions	577
7.2.1	General	577
7.2.2	Maintenance of the European patent as amended	577
8.	Apportionment of costs	578
8.1.	Principle that each party must bear its own costs	578
8.2.	Equity of a different apportionment of costs – case groups	579
8.2.1	Late submission of documents and/or requests	579
8.2.2	Request for oral proceedings withdrawn or postponement requested	584
8.2.3	Appeal or opposition withdrawn	585
8.2.4	Failure of a party to appear at the oral proceedings	585
8.2.5	Cases of alleged abuse of procedure or abuse of oral proceedings	588
8.3.	Apportionable costs	590
8.4.	Fixing of costs	591
8.5.	Procedural aspects	592
8.5.1	Filing a request for apportionment of costs	592
8.5.2	Competence issues	592
8.5.3	Appeal solely against the decision on costs inadmissible	593
D.	Appeal procedure	593
1.	Legal character of appeal procedure	593
2.	Suspensive effect of the appeal	594
3.	Devolutive effect of the appeal	595
4.	Language of the proceedings	595
5.	Procedural status of the parties	596
5.1.	Parties to appeal proceedings	596
5.2.	Transfer of party status	597
5.2.1	Opponent	597
5.2.2	Patent proprietor	597
5.3.	Rights of parties under Article 107 EPC	598
5.4.	Intervention	599
5.4.1	Admissibility of intervention	599
5.4.2	Intervener's rights	600
5.5.	Observations by third parties	600
6.	Extent of scrutiny	601
6.1.	Binding effect of requests - no reformatio in peius	601
6.2.	Subject-matter under examination	604
6.3.	Patentability requirements under examination	606
6.3.1	In opposition appeal proceedings	606
6.3.2	Ex parte proceedings	609

6.4.	Facts under examination - applying Article 114 EPC in appeal proceedings	610
6.5.	Arguments under examination	611
6.6.	Review of first-instance discretionary decisions	611
7.	Filing and admissibility of the appeal	611
7.1.	Appealable decisions	612
7.1.1	Departments	612
7.1.2	Decisions	612
7.1.3	Interlocutory decisions	613
7.1.4	Appeals against decisions of the boards of appeal	613
7.2.	Board competent to hear a case	614
7.3.	Entitlement to appeal	614
7.3.1	Formal aspects	614
7.3.2	Party adversely affected	615
7.4.	Form and time limit of appeal	618
7.4.1	Form and content of notice of appeal	619
7.4.2	Appeal filed within the time limit	620
7.4.3	Payment of appeal fee	621
7.5.	Statement of grounds of appeal	621
7.5.1	General principles	621
7.5.2	Exceptions to these principles	622
7.5.3	Change of circumstances after delivery of the decision	624
7.5.4	Reference to an earlier submission	625
7.5.5	References to other documents	625
8.	Conclusion of the decision-making process	626
8.1.	Closure of the substantive debate	626
8.2.	Decision taken as the file stands	626
8.3.	Proceedings after delivery of the decision	626
8.4.	Interlocutory decisions of a board	627
9.	Remittal to the department of first instance	627
10.	Binding effect	629
10.1.	General principles	629
10.2.	Type of remittal	631
10.2.1	Remittal only for adaptation of the description	631
10.2.2	Remittal for the continuation of proceedings	631
11.	Termination of appeal proceedings	632
11.1.	Withdrawal of the appeal	632
11.2.	Withdrawal of the opposition during appeal proceedings	634
11.3.	Request for revocation of a patent	634
11.4.	Patent expired in all designated states	635
12.	Interlocutory revision	635
12.1.	General	636

12.2. Reimbursement of appeal fee	636
12.3. Substantial procedural violation	637
13. Referral to the Enlarged Board of Appeal	637
13.1. Ensuring uniform application of the law	638
13.2. Important points of law	638
13.3. Suspension of first-instance proceedings following referral to Enlarged Board	639
14. Filing of amended claims in appeal proceedings	640
14.1. Admissibility of filing amended claims in appeal proceedings	640
14.2. Criteria for taking amendments to claims into consideration	641
14.2.1 Time of filing	643
14.2.2 Difficulty of examination	645
14.2.3 Reasons for late filing	646
14.3. Amended claims not admitted with divisional applications pending	649
14.4. Remittal to the department of first instance because of substantial amendments to claims	649
15. Reimbursement of appeal fees	650
15.1. General issues	650
15.2. Allowability of the appeal	651
15.3. Fairness	651
15.3.1 Reimbursement held to be equitable	652
15.3.2 Reimbursement held not to be equitable	652
15.4. Substantial procedural violation	653
15.4.1 Definition	654
15.4.2 Request for oral proceedings	654
15.4.3 Right to be heard	655
15.4.4 Inadequate reasons given in the decision at first instance	657
15.4.5 Error of judgment by a department of first instance	659
15.4.6 Miscellaneous other cases	660
15.5. Interlocutory revision	662

VIII. PROCEEDINGS BEFORE THE DISCIPLINARY BOARD OF APPEAL **665**

1. Introduction	665
2. European qualifying examination	666
2.1. Conditions for enrolment	666
2.2. Examination conditions	668
2.3. Marking the answer papers	669
2.4. Borderline cases	670

2.5.	Substantiation of EQE decisions	670
2.6.	Appeals against decisions of the Examination Board and the Examination Secretariat	671
2.6.1	Competence of the board of appeal	671
2.6.2	Objective review of the marks awarded	671
2.6.3	Legitimate interest	672
2.6.4	Duties of the Examination Board	673
3.	Disciplinary matters	673
3.1.	Disciplinary measures	673
3.2.	Appealability of decisions in disciplinary matters	674
4.	Code of Professional Conduct	674
4.1.	General professional obligations	674
4.2.	Professional secrecy	675
4.3.	Advertising	675
IX.	THE EPO ACTING AS A PCT AUTHORITY	677
A.	Introduction	677
1.	Structure of the EPC provisions relating to international applications under the PCT since 1 March 2000	677
2.	Time limits for the European phase entry of an international application (Rule 107(1) EPC)	677
B.	Competence of the boards of appeal in proceedings under the PCT	677
1.	The changing role of the boards of appeal	677
2.	The role of the boards of appeal prior to the introduction of EPC 2000	677
C.	The EPO acting as ISA and IPEA	679
1.	PCT guidelines binding on the ISA and IPEA	679
2.	Protest procedure: the new provisions	680
3.	Protest procedure: the EPO acting as ISA	681
3.1.	Substantiation of invitation	681
3.2.	Substantiation of protest	683
3.3.	Review of protests	684
3.3.1	The review of protests by a review panel	684
3.3.2	Review of protest by a board	685
3.4.	Missed time limit for filing the protest	687

4.	Protest procedure: the EPO acting as IPEA	687
4.1.	General issues	687
4.2.	Substantiation of invitation	688
4.3.	Substantiation of protest	689
4.4.	Composition of a review panel	690
4.5.	Review of protests	691
4.6.	Additional fees - partial reimbursement	692
D.	The EPO as designated or elected Office	692
X.	INSTITUTIONAL MATTERS	697
1.	Administrative Agreement with the German Patent Office	697
2.	Power under Article 23(4) EPC to amend the RPBA	698
3.	Extension Ordinances on the extension of European patents	698
4.	Referrals to the Court of Justice of the European Communities under the EC Treaty - legal status of the EPO boards of appeal	700
	TABLE OF CASES	701
	Decisions of the Disciplinary Board	701
	Decisions and opinions of the Enlarged Board of Appeal	701
	Decisions of the Legal Board of Appeal	702
	Decisions of the technical boards of appeal	705
	PCT Protests	728
	INDEX OF CITED PROVISIONS	729
1.	European Patent Convention	729
2.	Implementing Regulations to the EPC	731
3.	Rules relating to Fees	733
4.	Patent Cooperation Treaty (articles and rules)	733
	PCT Articles	733
	PCT Rules	733
5.	Regulation on the European qualifying examination for professional representatives	734
6.	Regulation on discipline for professional representatives	734
7.	Rules of Procedure of the Boards of Appeal	734

CROSS-REFERENCE LIST EPC 1973 - EPC 2000	735
GENERAL INDEX	743