

## G decisions for the EQE

### Art.14 Languages

**G 4/08:** Language of proceedings

1) Language of proceedings cannot be changed

When an international patent application has been filed and published in an official language of the EPO, it is not possible to switch the language of proceedings and file a translation into another official EPO language upon entry into the European phase

2) EPO can only use the language of proceedings in written proceedings

In written proceedings on a European patent application or an international application in the regional phase, EPO departments cannot use an EPO official language other than the language of proceedings used for the application under Article 14(3) EPC.

**G 6/91:** Entitlement to fee reduction under Rule 6(3) EPC

In order to be entitled to fee reduction under Rule 6(3) EPC, the essential item must be filed in an admissible non-EPO language (an official language of the State concerned other than English, French or German), and supply the necessary translation no earlier than simultaneously.

### Art.53, Art.54

(G 1/03, G 2/03: Undisclosed disclaimers, G 1/16: Allowability of undisclosed disclaimers

→ see under Art.123, amendments)

### Art.55 Non-prejudicial disclosures

**G 3/98** and **G 2/99**: For the calculation of the six-month period referred to in Article 55(1) EPC, the relevant date is the actual filing date of the European patent application (and not the priority date). (*The language of proceedings in G 3/98 was English, in G 2/99 German. The text of both decision is otherwise identical.*)

### Art.61 Person with better right

**G 3/92:** Original application does not need to be pending

When it has been adjudged by a final decision of a national court that a person other than the applicant is entitled to the grant of a European patent, and that person, in compliance with the requirements of Art.61(1) EPC, files a new European patent application in respect of the same invention under Art. 61(1)(b) EPC, it is not a pre-condition that the earlier original application is still pending before the EPO at the time the new application is filed.

r.5.8: If original application not pending, only new application can be filed under Art.61(1)(b) EPC.

### Art.71, R.85 Transfer

**G 4/88:** It is not permitted to transfer an opposition before the EPO to another party unless the opposition is transferred or assigned as part of the opponent's business assets.

**G 2/04:** The status of an opponent cannot be freely transferred.

### Art.76, R.36 Divisional application

**G 1/05:** Amendment to conform with Art. 76(1) EPC (deleting added subject-matter) is allowable later, even if at time of amendment earlier application is no longer pending.

**G 1/06:** Content of a member of a sequence of divisional applications must be disclosed in each of the preceding applications in the sequence as filed.

**G 1/09:** When is a parent application pending

r.3.2.4: A 'pending (earlier) European patent application' is a patent application in a status in which substantive rights deriving therefrom under the EPC are (still) in existence.

r.4.2.4: In the case where no appeal is filed, a European Patent application which has been refused by a decision of the Examining Division is thereafter still pending within the meaning of Rule 25 EPC 1973 (Rule 36(1) EPC) until the expiry of the time limit for filing a notice of appeal.

G 4/98: Deemed withdrawal takes effect upon expiry of the time limit for payment of designation fees and not upon expiry of the grace period. (*So, in case of non-payment of the designation fee, the application is considered pending until it lapses on expiry of the normal period under R. 39(1) EPC.*)

### **Art.82 Unity**

**G 1/91:** Unity in opposition - legally irrelevant

The requirement for unity of invention under Art. 82 EPC does not apply to granted European patents. It is consequently irrelevant in opposition proceedings that the European patent as granted or amended does not meet the requirement of unity.

**G 2/92:** An applicant who fails to pay the further search fees for a non-unitary application (when requested to do so by the Search Division under Rule 46(1) EPC) cannot pursue that application for the subject-matter in respect of which no search fees have been paid. The non-searched subject-matter can only be protected in a divisional application.

### **Art.84 Clarity**

**G 2/88:** Change of claim category allowed if no extension of protection,

Amendment of "compound" to "use of compound" claim is allowed

r.2.2: There are basically two different types of claim, namely a claim to a physical entity (e.g. product, apparatus) and a claim to a physical activity (e.g. method, process, use).

Headnote 2: An amendment of granted claims directed to "a compound" and to "a composition including such compound", so that the amended claims are directed to "the use of that compound in a composition" for a particular purpose, is not open to objection under Article 123(3) EPC.

(G 3/14: Clarity of amended claims in opposition → see under Art.101, examination of opposition)

### **Art.87 Priority**

**G 1/15:** Partial priority is allowable

Entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR" claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document.

The broader claim (generic "OR" claim) is de facto conceptually divided into two parts: the first part corresponds to the invention as disclosed in the priority document, while the second part is the remaining part of the subsequent broader claim. The first part enjoys the priority of the first application, whereas the second part does not enjoy this priority, but itself gives rise to a right to priority as laid down in Article 88(3) EPC.

**G 2/98:**

- Interpretation of the concept of "the same invention" referred to in Article 87(1) EPC

The priority of a previous application in respect of a claim in a European patent application is to

be acknowledged only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.

- Partial priority:

r.6.6: No multiple effective dates for an "AND" claim.

Where a first priority document discloses a feature A, and a second priority document discloses a feature B for use together with feature A, then a claim directed to A+B cannot enjoy a partial priority from the first priority date, because the invention A+B was disclosed only at the date of the second priority document.

r.6.7: Multiple effective dates are possible for an "OR" claim.

Where a first priority document discloses a feature A, and a second priority document discloses a feature B for use as an alternative to feature A, then a claim directed to A or B can enjoy the first priority for part A of the claim and the second priority for part B of the claim.

## **Art.97 Grant**

### **G 7/93**: Late amendments

An approval of a notified text submitted by an applicant pursuant to Rule 51(4) EPC 1973 (now R.71(3) EPC) does not become binding once a communication in accordance with Rule 51(6) EPC 1973 has been issued. Following issue of such a communication under Rule 51(6) EPC 1973 and until issue of a decision to grant the patent, the Examining Division has a discretion under Rule 86(3) EPC 1973 second sentence (now R.137 (3) EPC), whether or not to allow amendment of the application.

### **G 4/19**: Double patenting

A European patent application can be refused under Articles 97(2) and 125 EPC if it claims the same subject-matter as a European patent which has been granted to the same applicant and does not form part of the state of the art pursuant to Article 54(2) and (3) EPC.

2. The application can be refused on that legal basis, irrespective of whether it

a) was filed on the same date as, or

b) is an earlier application or a divisional application (Article 76(1) EPC) in respect of, or

c) claims the same priority (Article 88 EPC) as the European patent application leading to the European patent already granted.

## **Art.99 Opposition**

**G 9/93**: Self opposition is not allowed (overturns ruling in G 1/84)

**G 3/97** (identical to G 4/97): Strawman in opposition proceedings

Headnote 1(a), r.3.2: An opposition is not inadmissible purely because the person named as opponent is acting on behalf of a third party.

Headnote 1(c), r.4.1: The action of the opponent on behalf of the patent proprietor renders the opposition inadmissible.

Headnote 1(c), r.4.2.1: However, if a person not entitled to act as a professional representative before the EPO files an opposition in his own name on behalf of a client, the opposition is inadmissible.

Headnote 1(d), r.4.2.2: A professional representative is allowed to file an opposition in his own name on behalf of a client.

**G 3/99**: Joint opposition

Headnote 1: An opposition filed by jointly two or more persons is admissible if only one fee has been paid.

Headnote 2: 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.

(G 4/88, G 2/04: Transfer of opponent → see under Art.71, transfer)

### **Art.100 Grounds for opposition, Art.101 Examination of opposition**

(G 1/91: Unity in opposition → see under Art.82, unity)

#### **G 9/91: Extent of opposition**

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.

*If an independent claim is not indicated in the notice of opposition, that claim (and all its dependent claims) is not part of the opposition and also not of a subsequent opposition appeal.*

#### **G 10/91: Examination of grounds for opposition**

In principle, the Opposition Division shall examine only such grounds for opposition, which have been properly submitted and substantiated.

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

#### **G 1/95: Fresh ground for opposition, separate grounds**

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), (2) EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee.

#### **G 7/95: Fresh ground for opposition, separate grounds**

Inventive step and novelty are separate grounds. Lack of inventive step allows assessment of novelty in view of closest prior art.

#### **G 3/14: Examination of amended claims on clarity**

In considering whether, for the purposes of Article 101(3) EPC, a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Article 84 EPC only when, and then only to the extent that the amendment introduces non-compliance with Article 84 EPC.

*Guidelines D-V 5: "According to G 3/14, the amendment of one claim or part of a patent cannot lead to a re-examination of other parts of the patent which have not been amended. Thus the deletion of an independent claim with its dependent claims or the deletion of a dependent claim leaving the independent claims and other dependent claims intact does not permit examination of the remaining claims for compliance with Art. 84.*

*A claim amended during opposition proceedings is not subject to examination for compliance with Art. 84 if it results from*

*(i) inserting a complete dependent claim as granted into an independent claim;*

- (ii) combining one of several alternative embodiments of the dependent claim as granted with the independent claim as granted;*
- (iii) deleting wording from a granted claim (whether independent or dependent), whereby its scope is narrowed but a pre-existing lack of compliance with Art. 84 is left intact (as exemplified by T 301/87); or*
- (iv) deleting optional features from a granted claim (whether independent or dependent). However, an amended claim is to be examined for compliance with Art. 84:*
- (v) if features are taken from the description and inserted into a granted claim by way of amendment; or*
- (vi) if a feature from a dependent claim as granted is introduced into an independent claim as granted and this feature was previously connected with other features of that dependent claim and an alleged lack of compliance with Art. 84 is introduced by the amendment."*

### **Art.105 Intervention of the assumed infringer**

**G 1/94:** Intervention of the assumed infringer under Article 105 EPC is admissible during pending appeal proceedings and may be based on any ground for opposition under Article 100 EPC.

**G 4/91:** In order for there to be a possibility of intervention, opposition proceedings must be in progress when the notice of intervention is filed.

A notice of intervention cannot be filed in the two-month period for filing an appeal, unless one of the parties to the opposition proceedings files an appeal.

### **G 3/04:**

- Status of intervener

A valid intervener only acquires the status of an opponent, irrespective of whether the intervention occurs during the proceedings before the opposition division or at the appeal stage see under Art.108. This means that an intervener in proceedings before the opposition division, where all the opponents have withdrawn their oppositions, can continue the proceedings alone and, if need be, file an appeal, since he has the same status as an opponent under Article 99 EPC. For the same reason, if an appeal is filed by someone other than him, he is a party as of right.

- Continuation of proceedings after withdrawal of sole appeal

After withdrawal of the sole appeal, the appeal proceedings may not be continued with a third party who intervened during the appeal proceedings.

### **Art.106, 108 Appeal**

**G 2/91:** Reimbursement of appeal fee

1. 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.

2. Appeal fees cannot be reimbursed simply because several parties to proceedings before the EPO have validly filed an appeal against the same decision.

**G 5/91:** It is not possible to file an appeal based on suspected partiality only

1. Although Article 24 EPC applies only to members of the Boards of Appeal and of the Enlarged Board of Appeal, the requirement of impartiality applies in principle also to employees of the departments of the first instance of the EPO taking part in decision-making activities affecting the rights of any party.

2. There is no legal basis under the EPC for any separate appeal against an order of a director of a department of the first instance such as an Opposition Division rejecting an objection to a

member of the division on the ground of suspected partiality. However, the composition of the Opposition Division may be challenged on such a ground on appeal against the final decision of the division or against any interlocutory decision under Article 106(3) EPC allowing separate appeal.

**G 7/91** and **G 8/93**: Appeal terminated if sole appellant/opponent withdraws opposition

**G 8/91**: Withdrawal of appeal

Appeal proceedings are terminated, in ex parte and inter partes proceedings alike, when the sole appellant withdraws the appeal.

**G 9/92**: Reformatio in peius - Non-appealing party

1. If the patent proprietor is the sole appellant, the Board of Appeal and the non-appealing opponent may not challenge the maintenance of the patent as amended.
2. If the opponent is the sole appellant, the patent proprietor may only defend patent as maintained amended.

**G10/93**: Scope of examination in ex parte appeal

Inclusion of new grounds or re-consideration of met grounds is allowed in an appeal from a decision of an examining division in which a European patent application was refused, i.e. in ex parte proceedings.

r.2 and r.3: Although the consideration of new grounds for opposition in appeal proceedings is restricted - G 9/91 and 10/91 -, these principles cannot be applied to ex parte proceedings. In ex parte proceedings, therefore, the boards of appeal are NOT restricted to examination of the grounds for the contested decision or to the facts and evidence on which the decision is based, and can include new grounds in the proceedings.

**G 1/99**: Reformatio in peius - exception

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.

**G1/12**: Notice of appeal filed in name of person not entitled to appeal - incorrect identification

When a notice of appeal, in compliance with Rule 99(1)(a) EPC, contains the name and the address of the appellant as provided in Rule 41(2)(c) EPC and it is alleged that the identification is wrong due to an error, the true intention having been to file on behalf of the legal person which should have filed the appeal, it is possible to correct this error under Rule 101(2) EPC by a request

for substitution by the name of the true appellant, provided the requirements of Rule 101(1) EPC have been met.

In cases of an error in the appellant's name, the general procedure for correcting errors under Rule 139, first sentence, EPC is also available under the conditions established by the case law of the boards of appeal.

**G 1/18:** Appeal filed/not filed, fee reimbursed

1. An appeal is deemed not to have been filed in the following cases:

(a) where notice of appeal was filed within the two-month time limit prescribed in Article 108, first sentence, EPC AND the appeal fee was paid after expiry of that two-month time limit;

(b) where notice of appeal was filed after expiry of the two-month time limit prescribed in Article 108, first sentence, EPC AND the appeal fee was paid after expiry of that two-month time limit;

(c) where the appeal fee was paid within the two-month time limit prescribed in Article 108, first sentence, EPC for filing notice of appeal AND notice of appeal was filed after expiry of that two-month time limit.

2. In the cases referred to in answers 1(a) to (c), reimbursement of the appeal fee is to be ordered ex officio.

3. Where the appeal fee was paid within or after the two-month time limit prescribed in Article 108, first sentence, EPC for filing notice of appeal AND no notice of appeal was filed at all, the appeal fee is to be reimbursed.

**Art.109 Interlocutory revision**

**G 3/03:** Reimbursement of the appeal fee

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.

**Art.114(2) EPO may disregard facts/evidence not submitted in time**

**G 12/91:** Final decision

The decision-making process in written proceedings is considered to be complete when the decision to be notified is handed over to the postal service of the EPO.

r.2: Decision in oral proceedings enters into force and can no longer be amended once it has been pronounced.

(r.9.1: decision handed over to EPO postal service: three days prior to the date stamped)

**Art. 115 Observations by third parties**

**G 2/19:** Right to be heard and correct venue for oral proceedings

1. A third party within the meaning of Article 115 EPC who has filed an appeal against a decision to grant a European patent has no right to have its request for an order that examination proceedings in respect of the European patent be reopened for the purpose of removing allegedly unclear claims (Article 84 EPC) heard at oral proceedings before a board of appeal of the European Patent Office.

An appeal filed in such a way has no suspensive effect.

2. Oral proceedings before the boards of appeal at their site in Haar do not infringe Articles 113(1) and 116(1) EPC

**Art.116 Oral proceedings**

**G 4/92:** Basis of decisions

1. A decision against a party who has been duly summoned but who fails to appear at oral

proceedings may not be based on facts put forward for the first time during those oral proceedings.

2. Similarly, new evidence may not be considered unless it has been previously notified and it merely supports the assertions of the party who submits it, whereas new arguments may in principle be used to support the reasons for the decision.

**G 2/94:** Accompanying person may be allowed to speak in ex-parte oral proceedings

A board of appeal should normally refuse permission for a former member of the boards of appeal to make oral submissions during oral proceedings before it, until at least three years have elapsed following termination of the former member's appointment to the boards of appeal.

**G 4/95:** Accompanying person may be allowed to speak in inter-partes oral proceedings

During oral proceedings under Article 116 EPC in the context of opposition or opposition appeal proceedings, a person accompanying the professional representative of a party may be allowed to make oral submissions on specific legal or technical issues on behalf of that party, otherwise than under Article 117 EPC, in addition to the complete presentation of the party's case by the professional representative.

Such oral submissions cannot be made as a matter of right, but only with the permission of and under the discretion of the EPO.

*(The criteria is in the decision and in Guidelines E-III 8.5.)*

*Regarding G 2/94 and G 4/95: A person who accompanies a professional representative and who is not entitled either under Article 134(1) EPC or under Article 134(7) EPC to represent parties to proceedings before the EPO, is referred to as an "accompanying person".*

**G1/21:** Oral proceedings by videoconference

During a general emergency impairing the parties' possibilities to attend in-person oral proceedings at the EPO premises, the conduct of oral proceedings before the boards of appeal in the form of a videoconference is compatible with the EPC even if not all of the parties to the proceedings have given their consent to the conduct of oral proceedings in the form of a videoconference.

**Art.122 Re-establishment of rights**

**G 1/86:** Re-establishment of rights of opponent

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

**Art.123 / R.139 Amendments**

**G 3/89:** Correction of errors

Under Rule 139 EPC, the description, claims and drawings may only be corrected within the limits of what the skilled person would derive, directly and unambiguously, using common general knowledge viewed objectively at the date of filing, from the totality of these documents as filed. So, a correction under R. 139 EPC may not infringe Art.123(2) EPC.

**G 11/91:** Correction of errors

Correction under R.139 (R.88 EPC 1973), second sentence, should be within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the documents as filed.



**G 1/93:** Limiting feature

A feature which has not been disclosed in the application as filed but which has been added to the application during examination and which, without providing a technical contribution to the subject-matter of the claimed invention, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, is not to be considered as subject-matter which extends beyond the content of the application as filed in the sense of Article 123(2) EPC.

**G 2/95:** Replacement of application documents

The complete documents forming a European patent application, that is the description, claims and drawings, cannot be replaced by way of a correction.

**G 1/03** and **G 2/03:** Undisclosed disclaimers (**G 1/16:** Allowability of undisclosed disclaimers)

A disclaimer may be allowable in order to:

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and
- disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.

A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC.

A claim containing a disclaimer must meet the requirements of clarity and conciseness of Article 84 EPC.

**G 2/10:** Disclosed disclaimers

An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.

(G 1/12: Notice of appeal filed in name of person not entitled to appeal - incorrect identification -> see under Art.108 Appeal)

**Art.133 Representation**

(**G 2/94** and **G 4/95:** Discretion to allow an accompanying person, who is not entitled under Article 134(1) or (7) EPC to represent parties to proceedings before the EPO, to make submissions during oral proceedings -> see under Art.116, oral proceedings)