



AIPPI FORUM 2005

23 - 25 September 2005

Session III B:

Recent Decisions of the EPO Boards of Appeal and the Enlarged Board of Appeal and their effects on European Patents

Recent Decisions of the Enlarged Board of Appeal
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- **Since 1978:** 75 decisions and opinions of the Enlarged Board of Appeal (EBA)
In the same period : Over 18'000 decisions by the Boards of Appeal

- **5 decisions of the EBA in 2004 and 2005**

Not treated in detail:

G 2 and 3/02 (OJ EPO 2004, 483): No priority based on first filing in a State member of the WTO/TRIPs but not member of the Paris Convention

G 3/03 (OJ EPO 2005, 344): Reimbursement of appeal fee in case of interlocutory revision (Article 109 EPC)

- **Currently pending cases:**

G 1/04: Diagnostic methods

G 1/05: Divisional applications

• **Disclaimers**

- Transfer of the Status of Opponent
- Intervention



Disclaimers (1)

- **G 1/03** (OJ EPO 2004, 413 - Disclaimers/PPG) and **G 2/03** (OJ EPO 2004, 448 - Disclaimers/GENETIC SYSTEMS). Two cases, same text of decision.
- Disclaimer: Amendment to a patent claim, resulting in the incorporation of a negative technical feature.



Disclaimers (2)

- Question of Article 123 EPC, if neither disclaimer nor its subject matter have no basis in the application as filed.
- T 323/97 (OJ EPO 2002, 476):
Disclaimers are amendments governed by Article 123.



Disclaimers (3)

- EBA allows disclaimers in three areas:
 - To establish novelty with respect to a prior application in the sense of Article 54(3) EPC
 - To establish novelty vis-à-vis an accidental anticipation (Article 54(2) EPC)
 - To remove subject-matter excluded from patentability



Disclaimers (4)

- A disclaimer may serve only one of these purposes. If its effect goes beyond this, the disclaimer is or becomes inadmissible.
- Drafting of the disclaimer.
 - Disclaimer should not remove more than necessary
 - Article 84 applies to claims containing disclaimers



Transfer of the Status of Opponent ⁽¹⁾

G 2/04 (decision of 25 May 2005, not yet published in OJ EPO; available at www.epo.org)

- G 4/88: Transfer of opponent status admissible as part of the opponent's business assets together with the assets in the interests of which the opposition was filed



Transfer of the Status of Opponent (2)

In the present case:

- Free transfer of the status as an opponent?

Answer of the EBA:

- No right to dispose over the status as a party (G 3/97)
- Equal treatment does not call for a free transfer
- Nor does the public interest in having invalid patents revoked

Therefore: No free transfer



Transfer of the Status of Opponent ⁽³⁾

- Transfer of opponent status to a subsidiary which is sold (Broadening of G 4/88)?

Answer of the EBA: no

- Situation different from the one in G 4/88, since subsidiary is legal entity which could have filed opposition from the outset
- Opposition can also be filed as common opposition of holding company and subsidiary, payment of one opposition fee only
- Risk of complications in the proceedings



Transfer of the Status of Opponent (4)

- Admissibility of an appeal with auxiliary request concerning the person entitled to appeal?

Answer of the EBA: Yes, if there is a justifiable legal uncertainty as to who the correct party is.

- Principle that procedural declarations have to be unconditional has exceptions
- Situations may arise where uncertainties as to the correct party exist (eg a merger not yet approved by the antitrust authorities within the appeal period)
- Not a case of conditional appeal
- Overly formalistic to require two appeals



Intervention (1)

G 3/04 (decision of 22 August 2005, not yet published in OJ EPO)

- Previous decisions of the EBA concerning intervention:
 - G 4/91: No intervention during appeal period, if no appeal filed
 - G 1/94: Intervention during appeal proceedings admissible; new grounds of opposition possible



Intervention (2)

In this case:

- Intervention during appeal proceedings: continuation of proceedings if sole appeal is withdrawn?

Answer of the EBA:

- Intervener has same rights and obligations as any other opponent (Article 105 EPC)
- in case of withdrawal of the sole or of all appeals, proceedings end, including for non-appealing opponent
- Intervener during appeal proceedings is not appellant. Therefore, in case of withdrawal of the sole or of all appeals, proceedings cannot be continued with the intervener.



**THANK YOU FOR
YOUR ATTENTION**