

Admissibility of Submission of fresh Reasons for Opposition after the End of the Opposition Term with the German and European Patent Office, especially during Appeal

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I. Introduction

A decision by the (German) federal supreme court (X ZB 11/92 of 10.01.1995; Aluminium-Trihydroxid, IUPAC nomenclature: aluminium trihydroxide)¹⁾ rendered in connection with the European patent harmonisation as well as a just rendered decision of the enlarged board of appeal of the EPO^{2,3,4)} regarding the application of grounds for opposition which have been submitted after the opposition term (in the following referred to as lately filed or fresh grounds) introduced into the opposition proceedings by the opposer or the patent or opposition division, respectively / the (German) federal patent court or the board of appeal, respectively, will be used as an opportunity to show a comparison between the confused case law of the EPO on the one hand and the corresponding use of similar provisions by the German patent office and the case law of the instance courts in the German opposition proceedings on the other hand.

II. Lately filed grounds for opposition in German opposition proceedings

In accordance with Sections 21 (1), 59 (1) No 3 patent act a German patent can generally be revoked by third parties, if

1. the subject matter of the patent is not patentable within the terms of Sections 1 to 5; e.g. because there is no invention with respect to Section 1 (2), the claimed subject matter is excluded from patentability in accordance with Section 2, for anticipation, lack of inventive step or lack of industrial applicability;
2. the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
3. the essential elements of an application have been taken from the descriptions, drawings, models, appliances or equipment of another person or from a process used by another person without his consent (unlawful usurpation);
4. the subject matter of the patent extends beyond the content of the application as originally filed with the competent authorities; the same applies if the patent was granted on a divisional application or on a new application filed in accordance with Section 7 (2) and the subject matter of the patent extends beyond the content of the earlier application as originally filed with the competent authorities.

Moreover, and even after the lapse of the opposition term, an alleged patent infringer may become a party of the opposition proceedings / appeal proceedings in accordance with Section 59 (2) patent act⁵⁾ and in accordance with the view of the

literature during the proceedings, and he may substantiate all reasons for opposition.⁶⁾

1. First instance proceedings before the German patent office

Generally, Sections 59 (3), 46 (1), patent act, prescribes that in a case of an admissible opposition the patent division has to consider all reasons for opposition in accordance with the *ex officio* principle and may also introduce fresh reasons for opposition.⁷⁾ In accordance with Section 61 (1), No 2, the proceedings shall also be continued if the opposer has withdrawn its opposition. However, a border-line is reached in those cases when the opposition is, only based on a prior public use and the first instance (patent division) is unable to examine the facts on its own motion without opposer's help.⁸⁾

This has been confirmed by the Federal supreme Court¹⁾ that states:

In opposition proceedings the German patent office must principally examine all those reasons for opposition that have been put forward by the parties. It can also examine and introduce further grounds for opposition in accordance with Section 21 (1) Patent Act and use these grounds as a basis for its revocation according to the examination of its own motion instead of these grounds or in addition to these grounds.

2. Appeal in opposition proceedings before the federal patent court

a) Federal supreme court decision "aluminium trihydroxide"

There it is stated that although Section 87 (1) patent act prescribes that the patent court shall investigate the facts of the case *ex officio* and that it shall not be bound by the facts or statements and the offers of proof by the parties. Under this aspect it may get knowledge on all those facts being relevant for the decision in using either all possibilities itself or in using the help of government administration or judicial help to get knowledge on all those facts being relevant for the decision. The investigation *ex officio* does not give evidence whether disposal of the proceedings is given to the court or to the parties. Above all, this principle does not authorize the federal patent court to base the appeal proceedings on another ground for revocation which has not been duly introduced into the opposition proceedings by the parties or the German patent office and to base the decision in the appeal on the said ground. Thus, the federal patent court has to judge only within the requests of the parties

concerned using the subject matter submitted by the parties in accordance with Section 99 patent act, Sections 308, 536, 559 of the code of civil procedure.⁹⁾

b) Literary criticism

In his summary on the second half-year of 1995, Bartenbach cited the essential content of the aluminium trihydroxide decision and highlights that the federal patent court has no right of disposal on the appeal proceedings. Especially, the function of the federal patent court as a court of ordinary jurisdiction will be against the right of disposal to introduce new grounds of appeal *ex officio* in accordance with Section 21 (1) patent act. He added that the federal supreme court, however, left it open whether a fresh ground for opposition may be introduced in the appeal proceedings with the consent of the patent proprietor as an exception.¹⁰⁾

In its paper "opposition appeal proceedings - quo vadis" the president of the federal patent court agrees with the federal supreme court insofar that in the course of the appeal proceedings the case has to be examined only within the scope of the first instance subject matter at issue.¹¹⁾ Provided the appeal in opposition is regarded as a true legal remedy, it follows from the devolutive effect, whereupon the complete subject matter which is at issue in the first instance has to be handed over to the court of the legal remedy. However, this devolutive effect according to the fundamentals of the German law of legal remedy comprises the complete subject-matter at issue without a restriction on those individual aspects which have been *de facto* dealt with in the first instance, because the federal patent court shall deal with the case at issue again as well. Restrictions in this respect would be not foreseen by the patent act and could not be deduced from the origin of the federal patent court either. For that reason, the subject-matter at issue that is handed over to the federal patent court in view of the devolutive effect which generally comprises all grounds for revocation, even if these grounds are not explicitly dealt with in the first instance.

The opinion in the aforementioned decision that the said devolutive effect could only be dealt with within the requests filed during the remedy is disapproved of by Sedemund-Treiber. In accordance with the actual case law, such a restriction, has always to be regarded as quantitative, e.g. with respect to a partial revocation, but not qualitative with respect to the binding on specific grounds for revocation.¹²⁾ Such a qualitative restriction of the grounds for revocation of the first instance could neither be derived from the notice of oppositions to be filed within the opposition term nor from the lack of right on disposal, nor by an analogy to the nullity proceedings, nor to the rescission suit, nor by a continuation of the opposition proceedings.

c) Own opinion

The aforementioned line of arguments provided by Sedemund-Treiber and the differentiating of the subject-matter in suit in the appeal proceedings, which in accordance with the aforementioned classification may, in general, either be quantitative-objectively (revocation in the range of specific claims, of a claim category) or qualitative objectively (only specific grounds for revocation being indicated and substantiated within the opposition term) may be restricted only by the requests of appellee, is not too persuasive.

With respect to the lack of the right of disposal of the federal patent court in appeal proceedings dealt with by the federal supreme court, Sedemund-Treiber holds the view, that this right does only comprise the right of the parties to open, to end or to restrict the proceedings on certain subject-matter as much as this is possible in the specific case. The disposition's principle does not define as such, whether the restriction of the subject-matter in suit of the first instance will be performed by filing narrower requests in the remedy and under what legal circumstances the court in charge will de facto examine the subject-matter in suit within the scope of the disposition principle.

In contrast thereto the commentary on the patent Act by Benkard states that the examination of the facts has to be performed within the range of the requests, that the right to act is on behalf of appellee, thus, a decision rendered in the appeal instance has only be rendered in accordance with the requests, i.e. no decision may be rendered at the disadvantage of the appellee (*reformatio in peius*) and no decision can be rendered which grants him more than he has requested (*ne ultra petita*).¹³⁾ There no explicit hint can be found that the re-examination by the Federal patent court should also comprise new **reasons for opposition**. On the contrary, it is only stated that new **facts** could be introduced. From the two aforementioned principles of the disposal principle follows that the federal patent court , as done in the appeal instance of aluminium trihydroxide, introduce a fresh ground for opposition *ex officio*, does not behave like a *deus ex machina*, and, thus, although still judging within the request of appellee to revoke the patent, but in the remaining aspect of the decision who is willing to to plead for lack of patentability, will be amazed if not surprised by this outcome of the consequences of his request. Certainly, this may not be desirable and is obviously not within the scope of the disposal principle of appellee, to help him to a successful appeal, but in any way, regiment him.

3. Proceedings before the patent division after reversal

This somewhat seldom case, in which the federal patent court reversed the case with the patent department in accordance with Section 79 (3) No. 1, occurs if

1. the patent office has not yet decided the case on its merits;
2. the proceedings before the Patent Office suffer from a substantial defect;
3. fresh facts or evidence have become known which are essential for the decision.
4. Further, and in case of a substantiated appeal, the federal patent court can reverse the case in accordance with Section 99 patent act, Section 575 of the code of civil procedure, in order to make necessary orders.

a) Examination of the case on its merits not yet being decided on

According to the first possibility, the federal patent court may order a reversal if the first instance decision has been issued for formal reasons, e.g. by a new matter rejection that has been dealt with on appeal or which has been stated to be not present on appeal.¹⁴⁾

b) Substantial defect

According to the case law the predominant substantial defect in the first instance proceedings is a violation of the right to be heard¹⁵⁾ or a violation of to duty to substantiate a decision.

c) Fresh facts or evidences

This case takes place, if in the appeal proceedings amended claims are submitted or new relevant evidences, e.g. documents or experiments, have been introduced into the proceedings.¹⁶⁾

d) Enactement of necessary orders

This happens in each case where the federal patent court will not achieve an end of the proceedings without the help of the patent division. The patent division, however, is, just as in cases 1) to 3) above, bound to the judicial judgements of the federal patent court (*res judicata*) and is allowed to decide within the scope of the left opened points at issue only.¹⁷⁾

III. Lately filed reasons for opposition with the EPO

In accordance with EPC Article 99 (1), 100 (1), the revocation of a patent may be requested by an opposer, but not by the patentee himself,¹⁸⁾ if

1. the subject matter of the European patent is not patentable within the terms of Article 52 to 57 e.g. because there is no invention with respect to Article 52 (2), the claimed subject matter is excluded from patentability in accordance with Article 53, for anticipation, lack of inventive step or lack of industrial applicability;
2. the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
3. the subject matter of the European patent extends beyond the content of the application as originally filed or if the patent was granted on a divisional application or on a new application filed in accordance with Article 61 or, beyond the content of the earlier application as originally filed.

Moreover, and even after the lapse of the opposition term an assumed infringer may become a party of the opposition proceedings / appeal proceedings in accordance with Article 105 EPC and may substantiate this with all reasons for opposition.¹⁹⁾

1. First instance proceedings before the EPO

Generally, EPC Article 114 (1) prescribes that in the case of an admissible opposition the opposition division in accordance with the ex officio principle as first instance body is entitled to regard lately filed reasons for opposition and can also introduce fresh grounds for opposition into the proceedings²⁰⁾, but it can also disregard and reject the said reasons for appeal in accordance with EPC Article 114 (2), e.g. at a non-sufficient substantiation of an insufficient disclosure.²¹⁾ In the decision G 09/91²²⁾ and the parallel opinion G 10/91²³⁾ the enlarged board of appeal has stated with respect to the power i.a. of the opposition divisions for the examination of grounds for opposition not being put forward and substantiated within the opposition term:

An opposition division 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. In principle, the opposition division shall examine only such grounds that have been properly submitted and substantiated in accordance with Article 99(1) EPC in conjunction with Rule 55 (c) EPC. Exceptionally, the opposition division may in application of Article 114 (1) EPC consider other grounds for opposition that, *prima facie*, in whole or in part would seem to prejudice the maintenance of the European patent.

In accordance with EPC Article 101 (1), Rule 60 (2) No 2 the proceedings shall be continued even in those cases where the opposer has withdrawn his opposition.²⁴⁾ A border-line is, however, reached in those cases when the opposition is e.g. only based on a prior public use and the opposition division is unable to examine the facts on its own motion without opposer's help.²⁵⁾ A further border-line is reached in this case if patentee is taken by surprise by a fresh ground for opposition including a fresh objection during the oral proceedings and therefore his right to be heard is violated. This does not only cause a reversal to the first instance decision but also causes a repayment of the appeal fee.²⁶⁾

2. Appeal proceedings before the board of appeal

a) Leading decisions G 9/91 and G 10/91

In the decision G 09/91²²⁾ and the parallel opinion G 10/91²³⁾ the enlarged board of appeal generally states with respect to the power of the boards of appeal to consider other grounds for opposition not properly submitted and substantiated within the opposition term:

Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee (headnote III of G 10/91).

Further, it is stated in the reasons for the decision that the purpose of the appeal proceedings *inter partes* mainly is to give the losing party the possibility of challenging the decision of the opposition division on its merits. In particular, no fresh grounds for opposition, may be introduced in the appeal stage for the above reasons. However, an exception to the above principle is justified in case the patentee agrees that a fresh ground for opposition may be considered: *volenti non fiat injuria*. Such a fresh ground for opposition should only be raised by a board of appeal or, if risen by an opponent, being admitted into the proceedings if it is considered by the board to be *prima facie* apparently highly relevant.

b) Literary Comments

Although only published in 1995 with reprint 1996, EPC commentary by Singer/Lunzer does not deal with these decisions under Article 114, but under No 114.06 under the heading "**Material introduced late in oppositions and appeals**" it provides a collection of new decisions updating the original Singer collection. However, this collection is obviously out-of-date with respect to lately filed grounds

introduced into the appeal in accordance with the enlarged board decisions G 9/91 and G 10/91. Even under Article 101.24 and in a 3-page discussion of these decisions, only a bashful hint can be found: "Finally, attention was drawn to the possibility of taking into account other grounds, if patentee so wishes for the sake of giving greater certainty to the validity of the patent.²²⁾ "

In T 758/90-3.3.2²⁷⁾ the board of appeal judged that it was not possible to deduce with complete certainty from G 9/91 and G 10/91 whether grounds for opposition which had been considered by the opposition division but submitted by one opponent only and then taken up by a different opponent as the sole appellant could be examined by the board with the patentee's consent only. However, the board did not need to resolve this question, as the grounds in question were not material to its decision.

When discussing the aluminium trihydroxide decision, Bartenbach²⁸⁾ also made a short summary of the two decisions of the enlarged board of appeal. In this connection he highlights that the enlarged board of appeal emerged that a „justified exemption“ (of the said restriction) considering the original reasons for opposition is only applicable, if the patent proprietor gives his consent to consider the said fresh ground for appeal.

According to the 1996 Issue of "Guidance for parties to appeal proceedings and their representatives"²⁹⁾, the heading examination of the appeal in *inter partes* proceedings, to in Article 100 EPC, which have not been properly submitted during opposition proceedings in accordance with Article 99 (1) in conjunction with Rule 55 (c) EPC, grounds for opposition are not as a rule to be considered in opposition appeal proceedings. However, the position is somewhat different if the patent proprietor agrees to this and the ground in question is considered to be *prima facie* highly relevant by the board.

In the latest version of Case law of the boards of appeal of the European patent office 1987 - 1995³⁰⁾ it is stated with respect to fresh grounds for opposition, „that only those grounds for opposition already cited in the opposition stage could be considered on appeal. New ones could be introduced only with the consent of patentee, whose power of veto exists regardless of the relevance of said fresh grounds. Broad application of Article 114 (1), *i.e.* examination also for unquoted grounds for opposition, is restricted to the department of first instance.“

c) Fresh ground for opposition in G 1/95

Under the file-number G 1/95 the following question of law was posted to the enlarged board of appeal in the intermediate decision T 937/91³⁾:

In a case where a patent has been opposed on the basis of Article 100 (a) EPC, but the opposition has been only substantiated on the grounds of lack of novelty and inventive step pursuant to Article 54 and 56 EPC, can a board of appeal introduce the ground that the subject matter of the claims does not meet the conditions of Article 52 (2) EPC of its own motion into the proceedings?

Under the file-number G 7/95 now being handled with file-number G 1/95 the following question of law was posed to the enlarged board of appeal in the intermediate decision T 514/92²⁾:

In a case where a patent has been opposed on the basis of Article 100 (a) EPC, that the claims lack an inventive step in view of the documents cited in the opposition statement and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal exclude the new allegation because it introduces a new ground of opposition?

These references were substantiated in that, according to the decision G 10/91, in appeal proceedings generally no fresh „grounds for opposition“ have to be considered. This term is not equivocal, since a „wide“ interpretation of the reasons for opposition under Article 100 (a) would encompass inventive step and novelty³¹⁻³³⁾, a „narrow“ interpretation would result, however, in a limitation of the obligation in the appeal proceedings the inventiveness could be only be examined without having decided first whether there is novelty or not.

After these similar questions have been consolidated into one proceeding in cases G 1/95 and G 7/95, and after oral proceedings were judged on April 15, 1996 the Enlarged Board of Appeal answered the said question by its decision dated July 19, 1996:⁴⁾ as follows:

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 patentee.

This has been substantiated referring to the aforementioned Article 100 EPC, the enlarged board of appeal decision G 10/91²³⁾ and by an analysis of the use of the

term “grounds“ or „grounds of appeal“ in Article 108 EPC, and of the “legal reasons for revocation“ in accordance with Article 138 EPC as follows:

In Article 108 EPC, the term „grounds“ in „grounds of appeal“ is to be interpreted as including both the legal reasons, i.e. the legal basis, and the factual reasons, i.e. the facts, arguments and evidence relied upon to give to the Board all the elements needed to decide whether or not the appealed decision has to be set aside (see T 220/83, OJ EPO, 1986, 249 and T 550/88).

Article 138 (1) EPC, in contrast, lists all the possible legal reasons for a revocation action under the law of a contracting state. These legal reasons are the „legal basis“ for such an action and it is clear that, in the different contracting states, the revocation of a patent may be obtained on any single „legal basis“ for revocation, e.g. lack of novelty, or lack of inventive step or because the invention is not susceptible of industrial application, etc. The function of Article 138 EPC is to provide, within the contracting states, a restricted number of legal bases, i.e. a restricted number of grounds, on which a revocation may be obtained.

The wording of Article 100 (a) EPC is the same as the wording of Article 138 (1) (a) EPC. The same interpretation for the term „ground“, i.e. „a legal basis“, applies also for each of the grounds mentioned in Article 100 (a) EPC.

The function of Article 100 EPC is to provide, within the framework of the EPC, a limited number of legal bases i.e. a limited number of objections on which an opposition can be based. All „grounds for opposition“ mentioned in Article 100 EPC have their counterparts in other Articles of the EPC which have to be met during the procedure up to grant.

Whereas the grounds for opposition in Articles 100 (b) EPC and 100 (c) EPC each relate to a single, separate and clearly delimited legal basis on which an opposition can be based, i.e. insufficient disclosure and unallowable amendment before grant respectively, the same does not apply to Article 100 (a) EPC.

Indeed, Article 100 (a) EPC simply refers, apart from the general definition of patentable inventions according to Article 52 (1) EPC, and the exceptions to patentability according to Article 53 EPC, to a number of definitions according to Article 52 (2) to (4) and 54 to 57 EPC, which specify „invention“, „novelty“, „inventive step“ and „industrial application“ which, when used together with Article 52 (1) EPC,

define specific requirements and therefore form separate grounds for opposition in the sense of separate legal objections or bases for opposition.

The totality of these Articles (namely Articles 52 to 57 EPC) within the meaning of Article 100 (a) EPC do not therefore constitute a single objection to the maintenance of the patent, but a collection of different objections, some of which are completely independent from each other (e.g. Article 53 and Articles 52 (1), 54 EPC), and some of which may be more closely related to each other (e.g. Articles 52 (1), 54 and Articles 52 (1), 56 EPC). For an opposition to be admissible within the framework of Article 100 (a) EPC. It must necessarily be based on at least one of the legal bases for an opposition, i.e. on at least one of the grounds for opposition set out in Articles 52 to 57 EPC.

One function of Rules 55 and 56 EPC is to establish what the notice of opposition shall contain in order to be admissible in that respect. Rule 55 EPC specifies in paragraph (c) that the notice of opposition shall contain a statement of the extent to which the European patent is opposed and of the grounds (i.e. the legal reasons mentioned above) on which the opposition is based **as well as** an indication of the facts, evidence and arguments presented in support of these grounds, i.e. the substantiation. The wording of paragraph (c) shows clearly the distinction made between the grounds, meaning as in Article 100 (a) EPC the legal reasons or legal bases, and the substantiation.

Accordingly, in the context of Articles 99 and 100 EPC and of Rule 55 (c) EPC, a „ground for opposition“ must be interpreted in the sense of an individual legal basis for objection to the maintenance of a patent. It follows in particular that Article 100 (a) EPC contains a collection of different legal objections (i.e. legal bases), or different grounds for opposition and does not apply to a single ground for opposition.

It follows from the aforementioned substantiation that in principle the ground for opposition of lack of inventive step is a different ground for opposition but related to anticipation. There are no new arguments not already mentioned in the leading decisions ^{22,23)} concerning the power of the board to consider. These grounds in the appeal stage, i.e. are only possible with the approval of patentee. However, under item 7.2 of the reasons for the decision it is somewhat pragmatically stated:

Nevertheless, in a case such as that under consideration in the decision of referral in case G 7/95, if the closest prior art document destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an

inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results in such subject-matter being unallowable on the ground of lack of inventive step.

d) Own comment on decision G 1/95

The said decision under the aforementioned items 3.1 - 4.6 of the reasons for the decision, correctly states that in reality, the ground for opposition in accordance with Article 100 (a) EPC has to be regarded as a bundle of grounds and not as a single ground for opposition, being partially very different and partially closely related to each other, such as anticipation and obviousness are.

Somewhat too pragmatic and only **obvious at first sight** seems the relationship in the case of the fresh ground for opposition of lack of novelty with respect to the original sole ground of obviousness. Lack of novelty, *in praxi*, relates to a single claim, a claim category, but only seldom to an anticipation of the invention as a whole with all features. Normally, such a partial anticipation of a claim, a claim category, can be avoided by a delimitation using a disclaimer³⁴⁾, provided this prior art is not the closed prior art. Such a delimited claim or a claim delimited by a novel feature from a dependent claim will then be ready for the examination on the inventive step using the known could-would-test.

3. Proceedings before the opposition division after reversal

This more frequent case with respect to the corresponding German opposition proceedings on appeals being reverted to the EPO in accordance with EPC Article 111 (1) No 2 , Article 111 (2), No. 1, takes place in case of a not sufficiently procedure ending decision, e.g.

1. new facts or evidence have become known which are essential for the decision;
2. considerably amended claims have been submitted during appeal;
3. the Patent Office has not yet decided the case on its merits;
4. formal aspects have to be dealt with by the EPO (article 10 of the IR of the Board of appeal of the EPO);
5. the proceedings before the Patent Office suffer from a substantial defect;

a) New facts or evidence

This case occurs if fresh relevant facts and evidences e.g. prior art, experiments have been introduced in the appeal proceedings which have not been considered by the first instance, thus giving the appellee the opportunity to have the case examined by two instances.³⁵⁾

b) Extensive amendments to the claims

The board of appeal uses this possibility if the amendments in the claims are so extensive that a new examination, eventually on the basis of a new search report, becomes necessary.³⁶⁾

c) Examination of the case on its merits not yet being decided on

This possibility occurs if the first instance decision only comprises a statement on a part of the grounds for opposition and if the essential ground for opposition, e.g. lack of novelty, has been avoided by a misinterpretation of the claims or by an amendment made in the claims during the appeal stage, but a consideration of the remaining ground for opposition has still to be done.³⁷⁾

d) Execution of formal aspects by the European patent office

This aspect takes place if the specification of a patent maintained in amended form has to be adapted to this set of claims, if translations of the modified claims into the two other languages of the proceedings have to be filed and if the printing fee has to be paid.³⁸⁾ In this case the first instance is bound to the reasons of the decision such as *i.a.* the language of the claims being worded by the board of appeal (*res judicata*).

e) Serious irregularity

According to the case law the predominant serious irregularity in the first instance proceedings is a violation of the right to be heard²⁶⁾ or the posting of a misleading official action. A wrong interpretation of a prior art will in accordance with the case law of the boards of appeal not be regarded as a serious irregularity.³⁹⁾

IV. Outlook

The aforementioned comparison shows that a harmonisation in case law of the German patent law onto the case law of the Boards of appeal of the EPO has been

achieved even with respect to the term of the lately filed „reasons for opposition“ and hopefully will be achieved even with respect to the reasons for opposition in accordance with Section 21(1) No 1 patent act. Even the patent department of the German patent office will be eager to learn. To some extent, however, even an excess of harmonisation is made. In this respect the writer has been rejected by decision of the patent division ⁴⁰⁾ for the reason that he has submitted a merely illustrating note after the expiration of the opposition term regarding **a common general knowledge** on the definition of a mirror, as a subject matter could obviously be no bar to patentability, i.e **as a lately filed evidence**. This has been substantiated by a case law of the federal supreme court that has been decided under the old patent law of 1968 dealing, however, with a lately filed **reference**. It must be left in abeyance whether the examiner in charge has informed himself too much about the provisions and the case law of the EPO regarding Article 114 (2) EPC or whether the draft of the decision has simply been made by a patent attorney trainee just preparing himself for the European exam which has uncritically become the language of the decision.

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- 1) BGH, GRUR 1995, 333 = Mitt. 1995, 243 = BI PMZ 1995, 438.
- 2) Referral decision T 514/92 OJ EPO 1996, 270 et seqq., 272 et seq.
- 3) Referral decision T 937/91 OJ EPO 1996, 25 et seqq., 29 et seq.
- 4) G001/95 of 19.7.1996; Head note OJ EPO 1996, issue 9, XI.
- 5) BPatG, GRUR 1988, 903 et seqq.; BGH, GRUR 1993, 892 et seqq.
- 6) (a) Benkard/Schäfers, PatG, Gebrauchsmustergesetz, 9. Ed., 1993, § 59 Rdn. 40, 8 et seqq.; (b) Bernhardt/Kraßer, Lehrbuch des Patentrechts, 4. Ed., 1986, § 26 II a 4, (c) Schulte, PatG mit EPC 1994, § 59 Rdn. 160.
- 7) BPatG, GRUR 1991, 40 et seqq. = BPatGE 31, 148; BPatG, GRUR 1994, 605 et seq. = BPatGE 34, 149; Schulte, § 59 Rdn. 40, 60.
- 8) BPatG, GRUR 1981, 651 et seqq. = BPatGE 24, 1.
- 9) Benkard/Schäfers, Ref. 6 (a), § 79, Rdn. 9; Bernhardt/Kraßer, Ref. 6 (b) § 23 II c 3; Schulte, Ref. 6 (c), § 73, Rdn. 11.
- 10) Bartenbach, Aktuelle Probleme des Gewerblichen Rechtsschutzes, 1995, Band 2, 175 et seqq., 180.
- 11) Sedemund-Treiber, GRUR int. 1996, 390 et seqq., 395 et seq.
- 12) Sedemund-Treiber, Ref. 11, 395.
- 13) Benkard/Schäfers, Ref. 6 (a), § 79, 7, 9.
- 14) Benkard/Schäfers, Ref. 6 (a), § 79, 27; Bernhardt/Kraßer, Ref. 6 (b), § 23 II a 10; Schulte, Ref. 6 (c), § 79, Rdn. 9.
- 15) Benkard/Schäfers, Ref. 6 (a), § 79, 28 - 29; Bernhardt/Kraßer, Ref. 6 (b), § 23 II a 10; Schulte, Ref. 6 (c), § 79 Rdn. 10.
- 16) Benkard/Schäfers, Ref. 6 (a), § 79, Rdn 30; Bernhardt/Kraßer, Ref. 6 (b), § 23 II a 10; Schulte, Ref. 6 (c), § 79 Rdn. 12.

- 17) Benkard/Schäfers § 79, Rdn. 23, 24; Bernhardt/Kraßer, § 23 II a 10; Schulte § 79 Rdn. 5.
- 18) (a) G 09/93, OJ EPO 1994, 891 et seqq. (Overturning of the earlier ruling in decision G 01/84, OJ EPO 1985, 299), (b) Singer, Europäisches Patentübereinkommen, 1989, Article 99, Rdnr. 2 (overturned); (c) Singer/Lunzer, The European Patent Convention, 1995, Article 99, 99.02 (d) EPO: Case law of the boards of appeal of the European patent office, 1996, 290.
- 19) G 07/93, OJ EPO 1994, 779 et seqq., 794 et seq.
- 20) T 493/88, OJ EPO 1991, 380 et seqq., headnote 1; Case law, Ref. 18d, 297.
- 21) T 122/84, OJ EPO 1987, 177 et seqq.; Singer, Ref. 18b, Article 114, Rdn. 6; Singer/Lunzer, Ref. 18c, 114.06; Case law, Ref. 18d, 222, 247.
- 22) G 09/91, OJ EPO 1993, 408 et seqq. 418; Singer/Lunzer, Ref. 18c, 101.24; Case law, Ref. 18d, 223 et seq., 296 et seq.
- 23) G 10/91, OJ EPO 1993, 420; reasons for the decision 16; Singer/Lunzer, Ref. 18c, 101.24; Case law, Ref. 18d, 233 et seq., 296 et seqq.
- 24) T 228/86-3.3.2, 27.9.1988; T 156/84, OJ EPO 1995, 202; Singer/Lunzer, Ref. 18c, 101.22.
- 25) T 129/88-3.3.3, OJ EPO 1993, 598; T 1002/92-3.4.2, OJ EPO, 1995, 605; Singer/Lunzer, Ref. 18c, 101.24.
- 26) T 817/93-3.4.2, 30.11.1994, EPOR, 1995, 557 et seqq. ; Case law, Ref. 18d, 358 et seqq.
- 27) T 758/90-3.3.2, 14.7.92, reasons for the decision 5.2, Case law, Ref. 18d, 325.
- 28) Bartenbach, Ref. 10, 180.
- 29) OJ EPO 1996, 342 et seqq., 352.
- 30) Case law, Ref. 18d, 286 et seq.
- 31) T 796/90 - 3.3.3, 13.9.1993, reasons for the decision 2.1.
- 32) T 018/93 - 3.3.1, 7.11.1994, reasons for the decision 3.2; Singer/Lunzer, Ref. 18c, 101.24.
- 33) T 649/93, 3.5.2, 4.5.1995, reasons for the decision 3.
- 34) Sieckmann, GRUR 1996, 236; Singer/Lunzer Ref. 18c, 54.15-54.15a.
- 35) T 228/89-3.2.1, 25.11.1991; T 161/82-3.5.1, OJ EPO 1984, 551; T 273/84-3.3.1, OJ EPO 1986, 346, Singer, Ref. 18b, Article 111, Rdn. 3; Case law, Ref. 18d, 342 et seq, 353 et seq.
- 36) T 063/86-3.2.1, OJ EPO 1988, 224; T 047/90-3.3.1, OJ EPO 1991, 486; T 200/86-3.3.2, 5.2.1987; T 296/86-3.3.2, 8.7.1986; T 098/88-3.2.1, 15.1.1990; T 423/88-3.2.1, 20.11.1990; T 501/88-3.2.2, 30.11.1989; Singer, Ref. 18b, Article 111, Rdn. 3; Case law, Ref. 18d, 353 et seqq.
- 37) T 378/88-3.5.1, 22.3.1990; Singer, Ref. 18b, Article 111, RdNr. 3; Singer/Lunzer, Ref. 18c, 111.03.
- 38) T 757/91-3.2.3, 10.3.1992; T 1063/92-3.4.2, 15.10.1993, reasons for the decision; Singer, Ref. 18b, Article 111, No. 3; Case law, Ref. 18d, 387 et seq.
- 39) T 162/82, OJ EPO 1987, 533; Singer, Ref. 18b, Article 111, Rdn. 3; Case law, Ref. 18d, 358.
- 40) DPA, Decision of 18.3.1996 regarding DE-P 3526511.6-32 (Diehl GmbH & Co v. Sharp K. K.), reasons for the decision II, No. 4.