

Enlarged Board of Appeal EPO, 14 July 1994, BMW

PATENT LAW

Patent proprietor sole appellant interlocutory decision - no challenge of maintenance patent by non-appelling opponent or Board of Appeal

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

The first case involves a sole appeal by the patent proprietor against an interlocutory decision by the Opposition Division to maintain the patent in amended form. The amended text is not covered by the appellant's appeal request, that is its statement setting out the scope of the appeal (Art. 108, first sentence, and Rule 64(b) EPC). The aim of such an appeal is to replace the text of the patent as maintained by the Opposition Division, or, if this request is not allowed, that is if the appeal is rejected, that the patent be maintained in the form allowed by the Opposition Division. The scope of the appeal defined in an appellant's request is exceeded if the non-appelling opponent files a request for revocation of the patent. The opponent can thus no longer effectively file such a request once the time limit for appeal has expired.

Opponent sole appellant interlocutory decision – proprietor primarily restricted to patent as maintained by Opposition Division

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

The second case relates to a sole appeal by the opponent against an interlocutory decision issued by an Opposition Division maintaining a patent in amended form. The opponent filed an appeal aimed at amending the contested decision either so that the patent is revoked in full or so that the patent is maintained in a form which is more restricted, in the opponent's view, than the version in the interlocutory decision.

16. The patent proprietor, who has not filed an appeal and is therefore only a party to the proceedings under Article 107, second sentence, EPC, does not have the right to file a "cross-appeal" without limit of time. Unlike the rights he would have as appellant, his re-

quests are therefore subject to restrictions. By not filing an appeal, he has indicated that he will not contest the maintenance of the patent in the version accepted by the Opposition Division in its decision. He is therefore primarily limited to defending this version. Any amendments he proposes in the appeal proceedings may be rejected by the Board of Appeal if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal (Art. 101(2) EPC, Rules 58(2) and 66(1) EPC; T 406/86, OJ EPO 1989, 302; T 295/87, OJ EPO 1990, 470).

Source: epo.org, OJ EPO 1994, 875

Enlarged Board of Appeal EPO, 14 July 1994

(P. Gori, G. Gall, C. Andries, G. D. Paterson, C. Payraudeau, E. Persson, P. van den Berg)

Decision of the Enlarged Board of Appeal dated 14 July 1994

G 9/92*

(Translation)

Composition of the Board:

[...]

Patent proprietor/Respondent: Bayerische Motoren Werke Aktiengesellschaft

Opponent/Appellant: KUKA Schweißanlagen + Roboter GmbH

Headword: Non-appelling party / BMW

Summary of Facts and Submissions

I. Appeal cases T 60/91, T 96/92 (before Board of Appeal 3.2.1 and published in OJ EPO 1993, 551) and T 488/91 (before Board of Appeal 3.5.1 - not published in OJ EPO) each concern interlocutory decisions by the Opposition Division which established in each case that the grounds for opposition did not prejudice maintenance of the opposed patent in amended form, once the outstanding formal requirements had been completed. The interlocutory decisions allowed separate appeal under Article 106(3) EPC.

II. In case T 60/91, during the proceedings before the Opposition Division the patent proprietor did not request maintenance of the patent as granted, but proposed two amended versions as main and auxiliary requests. The set of claims according to the main request contained limiting features compared to the claims of the patent as granted, and the independent claims of the auxiliary request were further limited compared to the main request. The Opposition Division held that the set of claims according to the main request lacked inventive step, but that the patent should be maintained in accordance with the auxiliary request. The patent proprietor and sole appellant filed an appeal requesting maintenance of the patent in accordance with the main request submitted during the first instance proceedings. The opponent/respondent filed observations in reply, requesting complete revocation of the patent.

III. In case T 96/92 the patent proprietor submitted a main request before the first instance requesting that the opposition be rejected and an auxiliary request that the patent be maintained in amended form. The Oppo-

sition Division in its interlocutory decision maintained the patent in accordance with the auxiliary request. The opponent and sole appellant filed an appeal requesting revocation of the patent. The patent proprietor/ respondent filed observations in reply, requesting that the patent be maintained as granted; in the alternative it requested maintenance of the patent in amended form as accepted by the Opposition Division in its interlocutory decision.

IV. In case T 488/91 the opponent was again the sole appellant. The patent proprietor submitted two sets of amended claims as main and auxiliary requests before the Opposition Division. The Opposition Division in its interlocutory decision maintained the patent in accordance with the auxiliary request. The opponent and sole appellant requested that the decision be amended to revoke the patent. The patent proprietor/respondent first requested the dismissal of the appeal and the maintenance of the patent in the form accepted by the Opposition Division in its decision. During oral proceedings this request became an auxiliary request, following a main request that the patent be maintained in accordance with the main request which had been rejected by the Opposition Division.

V. Board of Appeal 3.2.1, which was responsible for cases T 60/91 and T 96/92, considered that the question to be decided in both cases was whether the Board of Appeal could put the sole appellant in a worse position than it was in under the contested decision, or whether there should be prohibition of reformation in peius. In both cases the respondent, without filing an appeal, had submitted requests which went beyond the requests of the appellant and were to the latter's disadvantage. The case law on the admissibility of such requests varies. In decision T 369/91 (OJ EPO 1993, 561) the patent proprietor, who had not appealed against the Opposition Division's interlocutory decision to maintain the patent in amended form in accordance with an auxiliary request, was not allowed to request maintenance of the patent as granted (rejection of the opposition). On the other hand, in decisions T 576/89 (OJ EPO 1993, 543) and T 123/85 (OJ EPO 1989, 336) in similar circumstances the patent proprietor was allowed to request maintenance of the patent as granted. In the latter case, this was made conditional on no abuse of procedural law being involved.

VI. Referring to this lack of uniformity in the case law, Board of Appeal 3.2.1 consolidated cases T 60/91 and T 96/92 for referral of the following question of law, in two parts, to the Enlarged Board of Appeal:

Can the Board of Appeal amend a contested decision to the appellant's disadvantage? If so, to what extent?

The referred decision in respect of T 60/91 and T 96/92 was published in OJ EPO 1993, 551, and has the reference number G 9/92.

VII. Quoting this referred decision, Board of Appeal 3.5.1 referred the same two-part point of law to the Enlarged Board of Appeal in T 488/91 (G 4/93). VIII. The Enlarged Board of Appeal decided to consider the referrals from Boards of Appeal 3.2.1 (G 9/92) and

3.5.1 (G 4/93) in consolidated proceedings in accordance with Article 8 of the Rules of Procedure (OJ EPO 1983, 3, in the version published in OJ EPO 1989, 362).

IX. Following this decision the patent proprietor/appellant in case T 96/92 withdrew its main request for rejection of the opposition and maintenance of the patent as granted. As the point of law which had been referred to the Enlarged Board of Appeal in this case no longer arose, proceedings before the Enlarged Board of Appeal relating to case T 96/92 were terminated.

X. The remaining parties before the Enlarged Board of Appeal were given the opportunity to submit observations. The parties who were sole appellants were against the admission of what were effectively independent "cross-appeals" by the respondents, and submitted that the decision of the first instance could only be reviewed within the limits of the appeal. In so far as the sole appellant was not adversely affected by the decision of the first instance, it could not be the subject-matter of an appeal. There was no legal basis in the EPC for a "cross-appeal" on the part of the respondent in response to a filed appeal. Without any time limit being fixed, this would moreover delay the proceedings considerably and afford the respondent unjustified advantages over the party which had filed its appeal within the specified time limit. The fact that a party adversely affected by a decision of the first instance files an appeal should not come as a surprise to the opposing party. A review of the decision within the limits of the appeal would be in accordance with fair procedural principles. The parties to the proceedings before the Enlarged Board of Appeal who had not filed appeals were in favour of the Boards of Appeal having full power to decide on the proper scope of the patent. In the event of a sole appeal by the patent proprietor, the Boards should not be prevented from establishing the lack of patentability of the text accepted by the Opposition Division in its interlocutory decision by the simple reason that the opponent did not appeal. Any restriction would be artificial and would force the Boards, in their examination of the main and auxiliary appeals, to carry out a "balancing act" when assessing patentability criteria. The appeal was a new and unexpected situation for the respondent, who should have the right to respond without restriction. If an opponent did not contest the decision of the first instance, this simply meant that it was prepared to accept the text of the patent as approved in the decision, should the decision become final. However, if the patent proprietor appealed against the decision, then it had to face the risk of a counter-attack and hence the possibility of the patent being revoked. Conversely, in the case of a sole appeal by the opponent, the opponent must expect that the patent proprietor could revert to earlier requests and request the maintenance of the patent as granted.

Reasons for the Decision

Procedural principles

1. The referred point of law relates to general principles of procedural law as embodied - albeit with different provisions - in the procedural law of the Contracting

States to the EPC. The question whether and to what extent a case before the Boards of Appeal is governed under the EPC by appellants' requests and submissions is the subject-matter of the points of law referred to the Enlarged Board of Appeal in cases T 60/91 and T 488/91. Proceedings under the EPC in respect of European patent applications and patents are, with some exceptions, initiated by a party. The initial "request" determines the extent of the proceedings. This is known as the principle of party disposition (*ne ultra petita*). The present case concerns the question whether the extent of the initial appeal, i.e. the statement in the notice of appeal, affects the extent of the subsequent proceedings, and this has to be examined systematically in conjunction with procedural law under the EPC.

2. Opposition proceedings are postgrant proceedings (Art. 99 EPC) to which Articles 99 to 105 EPC and the corresponding provisions of the Implementing Regulations are applicable. In such proceedings the European Patent Office must examine the facts of its own motion (Art. 114(1) EPC). Certain restrictions have however been placed upon this so-called principle of *ex officio* examination in order to make such proceedings more clear, to shorten and accelerate cases, and to limit the risks to the parties.

3. The nature of the main procedural principles for opposition proceedings and opposition appeal proceedings has already been the subject of a number of [decisions by the Enlarged Board of Appeal. Decision G 9/91 \(OJ EPO 1993, 408\)](#) addressed the issue of the power of an Opposition Division or Board of Appeal to decide upon the patentability of parts of a patent which had not been attacked in the notice of opposition. According to this Decision, opposition proceedings are only pending to the extent to which the European patent is attacked in the "statement of the extent for which the European patent is opposed" under Rule 55(c) EPC. There is no power to decide and hence no authority to "examine the facts" beyond this stated extent ([G 9/91](#), reasons, 10 and 11). The Opposition Division or Board of Appeal has the power to decide on the revocation or maintenance of a patent only to the extent to which the patent is opposed in the notice of opposition.

4. The principle of *ex officio* examination (Art. 114(1) EPC) also has a restricted application to the extent of examination of grounds for opposition. However, in this case such restricted application is not derived from the principle of party disposition; the proper extent of examination has to be determined by the application of other procedural principles ([G 10/91, OJ EPO 1993, 420, reasons, 12](#)). In first instance proceedings the Opposition Division should examine only those grounds for opposition which the opponents have submitted within the time limit for opposition and have properly supported with facts and evidence. Grounds extending beyond this may only be considered in exceptional cases to which special conditions apply ([G 10/91](#), reasons, 16).

5. In the case of opposition appeal proceedings, the Enlarged Board of Appeal gave reasons which further

restrict the application of the principle of *ex officio* examination. The main aim of the inter partes appeal procedure is to give the losing party the opportunity to contest the Opposition Division's decision. It is only possible to introduce new grounds for opposition during appeal proceedings in exceptional cases and with the agreement of the patent proprietor ([G 10/91](#), reasons, 18).

6. The extent of the power of the Boards of Appeal to decide upon the proper scope of the patent should be considered in conjunction with the effect of withdrawal of the appeal. Appeal proceedings are terminated when the, or each, appeal has been withdrawn. Once the, or each, appeal has been withdrawn, there is no power to continue the proceedings (decisions G 7/91, OJ EPO 1993, 356, and G 8/91, OJ EPO 1993, 346).

The appellant's request and its binding effect

7. The question of law referred to the Enlarged Board of Appeal asks whether and to what extent a Board of Appeal can depart from the request formulated in the notice of appeal when deciding opposition appeal proceedings, to the disadvantage of the appellant. The referred decision approached the problem primarily from the point of view of the prohibition of a possible worse outcome, i.e. *reformatio in peius*. In essence, however, the referred question of law is concerned with the possible binding effect of the appellant's statement in the notice of appeal of the "extent to which amendment or cancellation of the decision is requested" on the subsequent appeal proceedings. It can have a restrictive effect on any subsequent requests by appellants or respondents, as well as on *ex officio* examination. The EPC does not contain any provisions which stipulate that a decision terminating appeal proceedings must not place an appellant in a worse position than it was in as a result of the contested decision.

8. The Enlarged Board of Appeal's decision in G 2/91 (OJ EPO 1992, 206) had already raised the question as to the extent to which the nonappealing party can contradict the appellant's requests with its own, or whether it was restricted to defending the contested decision (reasons, 6.2). Only those parties that lodge an admissible appeal have the status of appellant, while parties that do not file an appeal have the status of parties to the appeal proceedings as of right in accordance with Article 107, second sentence, EPC (reasons, 6.1).

9. The aim of an appeal is to eliminate an "adverse effect" (Art. 107, first sentence, EPC). It is the duty of the Board of Appeal to examine whether the appeal is admissible and allowable (Art. 110(1) EPC). An examination as to the allowability of the appeal is followed by a decision "on the appeal" (Art. 111(1), first sentence, EPC). The Board of Appeal may make a decision on the case itself or may remit the case to the first instance for further prosecution (Art. 111(1), second sentence, EPC). However, the subject-matter of the appeal proceedings is always the appeal itself. The appeal may not be simply regarded as a means of commencing the proceedings.

10. According to the EPC, the filing of a notice of ap-

peal (including a statement of the extent to which amendment or cancellation of the decision is requested - the appeal request) is subject to a time limit. It would not be consistent with this time limit to allow non-appealing parties the unrestricted right to alter the extent of the proceedings by submitting their own requests without limitation of time. If a party does not appeal against a decision of the first instance within the time limit for appeal, that party cannot claim the right, without limit of time, to submit requests having the same scope as an appellant's request, and thus, in response to an appeal by the opposing party, effectively to assume the status of an appellant. The provision of Rule 65(1) EPC concerning the inadmissibility of an appeal when the statement is not submitted within the specified time limit clearly emphasises the importance of such time limit. Thus requests by nonappealing parties to the appeal proceedings which are filed after this time limit expires, and which go beyond the appellant's original appeal request pursuant to Rule 64(b) EPC, are not admissible. The EPC does not provide for the possibility of a cross-appeal by a respondent.

11. The argument that the appeal was a "new and unexpected situation" for the respondents has no weight in the above procedural context. Under the EPC, if opposing parties to first instance proceedings are adversely affected by the first instance decision, a right of appeal is equally available to such parties. If one opposing party does not win a case outright, the other opposing parties must be prepared for it to file an appeal. A non-appealing party as a respondent has the opportunity to make what it considers to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the first instance.

12. The idea that, irrespective of whether the opposing party appeals, an appellant might have to take the risk of its appeal endangering the result which it achieved before the first instance, is likewise not found in the EPC. Linked with this, the concept that it should be possible for a sole appellant to be compelled as a result of opposing requests to withdraw its appeal, is also absent.

13. The Enlarged Board of Appeal's conclusions relating to the case of a sole appeal by the patent proprietor on the one hand and a sole appeal by the opponent on the other are set out below.

Sole appeal by the patent proprietors (T 60/91)

14. The first case involves a sole appeal by the patent proprietor against an interlocutory decision by the Opposition Division to maintain the patent in amended form. The amended text is not covered by the appellant's appeal request, that is its statement setting out the scope of the appeal (Art. 108, first sentence, and Rule 64(b) EPC). The aim of such an appeal is to replace the text of the patent as maintained by the Opposition Division, or, if this request is not allowed, that is if the appeal is rejected, that the patent be maintained in the form allowed by the Opposition Division. The scope of the appeal defined in an appellant's request is exceeded if the non-appealing opponent files a request for revocation of the patent. The opponent can thus no longer

effectively file such a request once the time limit for appeal has expired.

Sole appeal by the opponent (T 488/91)

15. The second case relates to a sole appeal by the opponent against an interlocutory decision issued by an Opposition Division maintaining a patent in amended form. The opponent filed an appeal aimed at amending the contested decision either so that the patent is revoked in full or so that the patent is maintained in a form which is more restricted, in the opponent's view, than the version in the interlocutory decision.

16. The patent proprietor, who has not filed an appeal and is therefore only a party to the proceedings under Article 107, second sentence, EPC, does not have the right to file a "cross-appeal" without limit of time. Unlike the rights he would have as appellant, his requests are therefore subject to restrictions. By not filing an appeal, he has indicated that he will not contest the maintenance of the patent in the version accepted by the Opposition Division in its decision. He is therefore primarily limited to defending this version. Any amendments he proposes in the appeal proceedings may be rejected by the Board of Appeal if they are neither appropriate nor necessary, which is the case if the amendments do not arise from the appeal (Art. 101(2) EPC, Rules 58(2) and 66(1) EPC; T 406/86, OJ EPO 1989, 302; T 295/87, OJ EPO 1990, 470).

17. Minority opinion

In the opinion of a minority of the members of the Enlarged Board of Appeal, the principle of *ex officio* examination takes priority. *Reformatio in peius* would therefore be admissible. This opinion is based on the text of the provisions concerning *ex officio* examination, which has remained substantially unchanged since the First Preliminary Draft for a European Patent Law (see proposals of the chairman of the EEC Patents Working Party from 29 May 1961 to 9 April 1962, Article 96 of the Draft, Doc. IV/6514/61 dated 28 July 1961). This principle was confirmed in the comments on Article 96 of the draft, which included the following remarks: "Thus, if a patent proprietor appeals against the fact that his provisional European patent has been revoked in part, in the appeal proceedings the provisional European patent may be revoked in full on the basis of material which has already been cited or material not previously submitted". Although the first preliminary draft related to pre-grant opposition proceedings, subsequent reports of meetings indicated that the change to post-grant opposition should not affect the application of the principle of *ex officio* examination, as this had been decided on for a different reason (BR 87/71 dated 28 February 1971, page 5, point 9). According to the minority opinion there is thus no basis in the EPC for limiting the extent of the power of the Boards of Appeal to decide on a case in opposition appeal proceedings.

Order

For these reasons the two-part point of law referred to the Enlarged Board of Appeal is answered as follows:

1. If the patent proprietor is the sole appellant against an interlocutory decision maintaining a patent in

amended form, neither the Board of Appeal nor the non-appealing opponent as a party to the proceedings as of right under Article 107, second sentence, EPC, may challenge the maintenance of the patent as amended in accordance with the interlocutory decision.

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