

Case Number G 10/91

O P I N I O N  
of the Enlarged Board of Appeal  
of 31 March 1993

Headword: Examination of oppositions/appeals

EPC Articles 99-102, 110, 114; Rules 55, 56, 66

Keyword: "Extent of obligaton and power to examine grounds for opposition"

Headnote

1. An Opposition Division or a Board of Appeal 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.
2. In principle, the Opposition Division shall examine only such grounds for opposition, which have been properly submitted and substantiated in accordance with Article 99(1) in conjunction with Rule 55(c) EPC. Exceptionally, the Opposition Division may in application of Article 114(1) EPC consider other grounds for opposition, which, prima facie, in whole or in part would seem to prejudice the maintenance of the European patent.
3. Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

## Summary of Facts and Submissions

- I. European patent number 76 691, concerning certain anhydride polymers and imide polymers and processes for preparing them, was granted to Rohm and Haas Company in 1986. Within the period of nine months laid down in Article 99(1) EPC, notice of opposition to the patent was filed by BASF AG. In the statement pursuant to Rule 55(c) EPC the opponent requested that the patent be revoked to the extent it concerned polymers containing anhydride units on the ground that this subject-matter was not patentable within the terms of Articles 52 - 57 EPC (i.e. the ground referred to in Article 100(a) EPC). The subject-matter relating to polymers containing imide units was not attacked by the opponent in the course of the opposition proceedings. By an interlocutory decision of 28 August 1989, the Opposition Division maintained the patent in amended form on the basis of a set of 11 claims, of which Claims 1-8 were directed to a polymer with imide groups and the preparation thereof and Claims 9-11 were related to a polymer with anhydride units and the preparation thereof.
- II. The opponent appealed against the decision of the Opposition Division; the appeal (T 580/89) was allocated to the Board of Appeal 3.3.3. The opponent requested that the appealed decision be set aside and the (entire) patent be revoked, arguing, for the first time, that not only the subject-matters relating to anhydride polymers but also those relating to imide polymers (including the respective preparation thereof) were not patentable.
- III. Furthermore, in the course of the appeal proceedings a third party presented observations under Article 115 EPC, submitting that the subject-matters relating to both of the above types of polymers were not patentable due to lack of novelty and inventive step (in fact, such

observations had been filed even during the proceedings before the Opposition Division but had not reached the file until after the decision of the Opposition Division was given and were therefore not considered by the Opposition Division).

- IV. The patentee then offered to dispose of the appeal by deleting Claims 9-11 relating to anhydride polymers arguing that the Board should not express any opinion as to the alleged invalidity of unopposed Claims 1-8 relating to imide polymers (cf. paragraph I above); to do so would entail an examination contrary to Article 114(1) EPC as interpreted by the Board of Appeal 3.3.1 in case T 9/87 (OJ EPO 1989, 438).
- V. In response to this, the above third party submitted further observations, wherein the obligation of the EPO vis-à-vis the public to examine the facts of its own motion pursuant to Article 114(1) EPC was emphasised; reference was in this context made in particular to the decision of the Board of Appeal 3.4.1 in case T 156/84 (OJ EPO 1988, 372). The patentee, in maintaining his position, submitted that Article 99(1) EPC carries a mandatory time limit which would be rendered meaningless if Article 114 EPC were applicable in the present circumstances as suggested by the opponent.
- VI. The Board of Appeal 3.3.3, considering that the above issue concerned an important point of law within the meaning of Article 112(1)(a) EPC, decided on 29 August 1991 to refer the following questions to the Enlarged Board of Appeal (reference number G 9/91):
1. Is the power of an Opposition Division or, by reason of Rule 66(1) EPC, of a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC dependent upon the

extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC?

2. If the answer to the first question should be affirmative, are there any exceptions to such dependence?

VII. On 4 October 1991, the President of the EPO, making use of his power under Article 112(1)(b) EPC, referred the following question to the Enlarged Board of Appeal (reference number G 10/91):

Is the Opposition Division in the examination of the opposition obliged to consider all the grounds for opposition referred to in Article 100 EPC or is this examination restricted to the grounds referred to by the opponent in his statement of grounds of opposition?

VIII. In the reasons for his referral, the President referred in particular to conflicting decisions on the above point of law given by the Board of Appeal 3.3.1 in cases T 320/88 (unpublished) and T 182/89 (OJ EPO 1991, 391) on the one hand, and the Board of Appeal 3.4.1 in case T 493/88 (OJ EPO 1991, 380) on the other. In the President's view, this divergency had created a considerable legal uncertainty as how to carry out the opposition procedure under the EPC. He further submitted that neither a general obligation to consider all grounds for opposition referred to in Article 100 EPC, nor a general restriction to consider only such grounds relied upon by the opponent would provide an appropriate solution. One should rather try to find a way of combining the purpose of the opposition procedure, which is to enable the EPO to decide on the validity of European patents on a broader basis than during the procedure up to grant, with a practicable

possibility for the Opposition Division to achieve this purpose.

- IX. In his referral, the President also drew attention to the close relationship between the point of law, which he was referring to the Enlarged Board of Appeal and the one which is the subject of case G 9/91 (cf. paragraph VI above), by pointing out that the total basis for the opposition according to Rule 55(c) EPC is determined by the extent to which the European patent is opposed as well as by the grounds on which the opposition is based.
- X. On 15 April 1992, the Enlarged Board, considering that the points of law which had been referred to the Board in case G 9/91 and case G 10/91 concerned similar subject-matters, decided to consider these points of law in consolidated proceedings in accordance with Article 8 of the Rules of Procedure of the Enlarged Board of Appeal.
- XI. In a communication dated 27 April 1992, the parties to the proceedings in case G 9/91 (T 580/89) were informed about the referral of the President of the EPO in case G 10/91 and invited to file any observations they might wish to make on the matters before the Enlarged Board. The opponent (appellant) in case G 9/91 filed such observations by letter dated 25 August 1992, while the patentee (respondent) declared that he did not intend to file any observations.
- XII. On 30 November 1992, oral proceedings took place before the Enlarged Board in the presence of representatives of the opponent (appellant) in case G 9/91 and a representative of the President of the EPO in case G 10/91; the patentee (respondent) in case G 9/91 had informed the Board that he did not wish to attend the hearing.

## Reasons for the Decision

1. The questions referred to the Enlarged Board in the present cases concern some fundamental aspects of opposition and appeals procedure under the EPC.
  
2. As to the general scope of opposition under the EPC, it is of importance that it takes place only after grant of the European patent, i.e. at a point in time when its proprietor is enjoying in each designated Contracting State the same rights as would be conferred by a national patent granted in that State (Articles 64 and 99 EPC). Thus, the relief sought by the opponent is not, as in traditional pre-grant opposition, refusal of the patent application but revocation of the patent as granted (in its entirety or in part) with effect ex tunc in all designated Contracting States (Article 68 EPC). Furthermore, the grounds for opposition (Article 100 EPC) being limited to and essentially the same as the grounds for revocation under national law (Article 138 EPC), it appears that the concept of post-grant opposition under the EPC differs considerably from that of classical pre-grant opposition and in fact has several important features more in common with the concept of traditional revocation procedure (cf. Haertel in GRUR INT, April 1970, p. 9: "Das nachträgliche Einspruchsverfahren kommt in seiner Wirkung einer europäischen Nichtigkeitsverfahren nahe"). This characteristic was further emphasised by the addition at a late stage in the preparation of the EPC of the possibility to oppose a European patent even if it has been surrendered or has lapsed for all Contracting States (Article 99(3) EPC; cf. the report by Braendli in the minutes of the Munich Diplomatic Conference published by the Government of the Federal Republic of Germany, p. 186: "... this amendment has raised the opposition proceedings another step towards the level of actual revocation

proceedings"). In these circumstances, it may be questioned whether the statement made by the Enlarged Board of Appeal in case G 1/84 (OJ EPO 1985, 299, point 4 of the reasons) that "it would be wrong to regard such (opposition) proceedings (under the EPC) as essentially contentious proceedings between warring parties, where the deciding body takes a neutral position, as would be the case in revocation proceedings before a national Court" is quite accurate, at least as a generalisation. This statement, sometimes referred to in the discussion on the issues at stake in the present cases in support of a wide investigative approach to be taken by the EPO, has to be seen in the special context of case G 1/84. In any case, it seems to the Enlarged Board in its present composition that post-grant opposition proceedings under the EPC are in principle to be considered as contentious proceedings between parties normally representing opposite interests, who should be given equally fair treatment.

3. It is inherent in any post-grant opposition procedure that the patent office cannot take any action in respect of a granted patent, however clear it may have become after grant that the patent is invalid, unless initiated by an admissible opposition. If no opposition is filed, the patent can only be attacked in revocation proceedings before a national court. In other words: the competence of the patent office to deal with the patent depends on the action taken by the opponent.
4. A post-grant opposition system may be constructed in different ways. It would, for example, be possible to allow the opponent to confine his action to making a simple request for a general re-examination of the patent application as filed on the basis of some general observations. The post-grant opposition procedure under the EPC, however, is not constructed in this way. As appears from Article 99 in conjunction with Rule 55(c)

EPC, the notice of opposition must, inter alia, contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds. The importance of this requirement is underlined by the fact that the non-observance of it within the period of nine months prescribed by Article 99(1) EPC renders the opposition inadmissible according to Rule 56(1) EPC, with the result that the EPO loses competence to deal with the patent altogether.

5. The core of the matter in the present cases before the Enlarged Board is, therefore, whether or not - or to what extent - an Opposition Division or a Board of Appeal in its examination of an opposition or an appeal is bound by the statement of the opponent under Rule 55(c) EPC of the extent to which the patent is opposed and of the grounds for opposition. In other words: does that statement limit the power and the obligation of the EPO in its examination of the case or may or even should such examination go beyond the opposition as filed and be extended to other parts of the patent and to other grounds for opposition than those covered by such statement? A further question to be considered in this context is whether or not the same principles are to be applied to proceedings before an Opposition Division and to appeal proceedings, having regard to the different legal character of such proceedings.
  
6. According to Article 101(2) EPC, the examination of the opposition shall be conducted in accordance with the provisions of the Implementing Regulations (i.e. the Rules). Read in conjunction only with Rule 56(1) EPC, Rule 55(c) EPC may give the impression that the content of the statement of Rule 55(c) EPC only implies a formal requirement for admissibility of the opposition without



any further legal effect on the examination of the opposition. This would seem to be the position of the opponent (appellant) in case G 9/91. In the Enlarged Board's opinion, this is a too narrow view on the function of Rule 55(c) EPC. This provision must be considered in the context of the EPC as a whole, having regard to the particular character of its post-grant opposition system as outlined above. Being so considered, Rule 55(c) EPC only makes sense interpreted as having the double function of governing (together with other provisions) the admissibility of the opposition and of establishing at the same time the legal and factual framework, within which the substantive examination of the opposition in principle shall be conducted. The latter function is of particular importance in that it gives the patentee a fair chance to consider his position at an early stage of the proceedings.

7. This having been said, the question arises whether the above principal framework for the substantive examination of the opposition is subject to any exceptions. In the Board's view, a distinction has here to be made between the two main requirements of the statement under Rule 55(c) EPC, i.e. the indication of the extent to which the European patent is opposed and the grounds for opposition, respectively.
8. As to the former requirement, which is the subject of the referral in case G 9/91, it has to be noted that in practice it is rather unusual that the opposition is limited to only a certain part (subject-matter) of the patent. Normally, the whole of the patent is opposed. Sometimes, this is not explicitly explained in the notice of opposition but it appears by implication that the opposition is directed to the whole of the patent. There may be cases when the notice of opposition has to be interpreted in this respect, in particular when only

certain claims are explicitly dealt with in the notice (cf. the decision of 20 July 1989 in case T 192/88). However, the Enlarged Board sees no reason in the present context to go further into this problem, but will confine its considerations mainly to the situation, where it is clear from the statement under Rule 55(c) EPC that the patent is opposed only to a certain extent, as illustrated e.g. by the case before the referring Board of Appeal 3.3.3 (see paragraph I above; cf. also paragraph 11 below).

9. It has also to be noted that the jurisprudence of the Boards of Appeal on this issue so far is very limited. In fact, there would seem to be only one decision analysing in some depth the legal implication of the statement under Rule 55(c) EPC containing a limitation of the extent to which the European patent is opposed, namely the decision in case T 9/87 referred to in paragraph IV above. In this decision it was held that the examination of an opposition under Article 101 EPC is limited by the statement in the notice of opposition of the extent to which the patent is opposed. Article 114(1) EPC should be interpreted as subject to Article 101 EPC in this respect. It was further stated in the decision that neither the Opposition Division nor a Board of Appeal has the obligation or the power to examine and decide on the maintenance of a European patent except to the extent to which it is opposed. It appears from the decision that it is mainly based on the consideration that opposition proceedings constitute an exception to the general rule under the EPC, that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of patents within the jurisdiction of the designated Contracting States. In his submissions before the Enlarged Board, the opponent (appellant) in case G 9/91 has challenged this decision, in particular for not taking duly into account the overriding importance of Article 114 EPC.

10. The conclusion of the Enlarged Board on this matter comes close to that of the above decision in case T 9/87. The requirement of Rule 55(c) EPC to specify the extent to which the patent is opposed within the time limit prescribed by Article 99(1) EPC would obviously be pointless, if later on other parts of the patent than those so opposed could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC as outlined above. By limiting the extent to which the patent is opposed to only certain subject-matters, the opponent deliberately refrains from making use of his right under the EPC to oppose remaining subject-matters covered by the patent. Such subject-matters are therefore, strictly speaking, not subject to any "opposition" in the sense of Articles 101 and 102 EPC, nor are there any "proceedings" in the sense of Articles 114 and 115 EPC in existence concerning such non-opposed subject-matters. Consequently, the EPO has no competence to deal with them at all.
  
11. It follows that the answer to the first question put to the Enlarged Board in case G 9/91 has to be affirmative. However, even if the opposition is explicitly directed only to the subject-matter of an independent claim of a European patent, subject-matters covered by claims which are depending on such an independent claim may also be examined as to patentability, if the independent claim falls in opposition or appeal proceedings, provided their validity is prima facie in doubt on the basis of already available information (cf. T 293/88, OJ EPO 1992, 220). Such dependent subject-matters have to be considered as being implicitly covered by the statement under Rule 55(c) EPC (cf. paragraph 8 above).
  
12. Turning to the second main requirement of the statement under Rule 55(c) EPC, i.e. the indication of the grounds on which the opposition is based, which is the subject of

the referral in case G 10/91, the problems involved differ from those related to the first main requirement as dealt with above in the following sense: While in the case of the extent to which the patent is opposed, it is a matter of the formal competence of an Opposition Division or a Board of Appeal to deal with a timely non-opposed part of a European patent, the problems connected with the grounds for opposition rather concern the procedural principles to be applied in opposition proceedings where the European patent (or a part of it) has been correctly opposed in accordance with Rule 55(c) EPC on at least one of the grounds listed in Article 100 EPC. The patent (or the relevant part of it) is, so to speak, already under fire in the latter case.

13. As submitted by the President of the EPO, very conflicting views have been taken on this point of law in the jurisprudence of the Boards of Appeal. In particular, the decisions in the cases T 493/88 and T 182/89 represent quite irreconcilable approaches. In case T 493/88 it was held that Articles 101(1) and 102(2) EPC clearly refer to all the grounds for opposition set out in Article 100(a)-(c) EPC and do not limit the scope of the examination to be carried out by the Opposition Division merely to the grounds for opposition mentioned by the opponent in the notice of opposition pursuant to Rule 55(c) EPC; an opposite view on this would also be in conflict with the principle of examination by the EPO of its own motion as laid down in Article 114(1) EPC. In other words: the Opposition Division has not only the right but even the duty to examine all grounds for opposition set out in Article 100 EPC, irrespective of whether the opponent in the statement pursuant to Rule 55(c) EPC has based the opposition only on one or two of these three grounds. In contrast to this, in case T 182/89 it was held that in principle Article 114(1) EPC should not be interpreted as

requiring the Opposition Division or a Board of Appeal to investigate whether support exists for grounds for opposition which have not been properly supported by the opponent, but should be interpreted as enabling the EPO to investigate fully the grounds for opposition which have been both alleged and properly supported as required by Rule 55(c) EPC. In his submissions before the Enlarged Board, the opponent (appellant) in case G 9/91 strongly supported the approach taken in case T 493/88; the other approach would entail the risk of the maintenance of invalid European patents, thereby rendering the EPC less attractive.

14. Obviously, the approach taken in case T 493/88 is not compatible with the principle established by the Enlarged Board in paragraph 6 above, based on the concept of post-grant opposition under the EPC. Furthermore, the fact that in Articles 101(1) and 102(2) EPC references are made to "the grounds" for opposition laid down in Article 100 EPC, i.e. all such grounds, cannot be considered as implying that all such grounds always have to be examined irrespective of the opponent's submissions. A corresponding purely literal interpretation of Article 102(1) EPC would e.g. make it impossible to revoke a patent, if not all the grounds for opposition mentioned in Article 100 EPC prejudiced the maintenance of the patent, which would be clearly absurd. The plural form "grounds" has to be considered only as a legal-technical means of covering the total possible framework of the examination. It also goes without saying that the approach taken in case T 493/88 is contrary to the general interest of procedural expediency.
  
15. The approach taken in case T 182/89 is clearly more in line with the concept of post-grant opposition under the EPC as outlined above. The Enlarged Board agrees that Article 114(1) EPC is no legal basis for an obligatory

review of grounds for opposition not covered by the statement pursuant to Rule 55(c) EPC. The crucial point is, however, whether Article 114(1) EPC empowers the Opposition Division or a Board of Appeal to investigate such grounds at all.

16. Although the wording of Article 114 EPC is not formally covering the concept of grounds for opposition, there would seem to be support in the travaux préparatoires to the EPC for the opinion that the principle of examination by the EPO of its own motion as laid down in Article 114 EPC was intended to be applied even to that concept at least in proceedings before the Opposition Division (cf. BR/87/71, point 9). This has also been accepted in the practice of the EPO (cf. Guidelines for substantive examination of opposition, Part D, Chapter V). The Enlarged Board does not consider that there is sufficient justification for changing this practice insofar as it concerns the proceedings before the Opposition Division. It is obviously aimed at avoiding the maintenance of European patents which are invalid. Thus, an Opposition Division may, in application of Article 114(1) EPC, of its own motion raise a ground for opposition not covered by the statement pursuant to Rule 55(c) EPC or consider such a ground raised by the opponent (or referred to by a third party under Article 115 EPC) after the expiry of the time limit laid down in Article 99(1) EPC. At the same time, the Enlarged Board would like to emphasise that the consideration of grounds not properly covered by the statement pursuant to Rule 55(c) EPC, as an exception to the principle established by the Board in paragraph 6 above, should only take place before the Opposition Division in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent. The possibility of disregarding facts and evidence in support of fresh grounds not submitted in due

time under Article 114(2) EPC should of course also be kept in mind.

17. Although the question put to the Enlarged Board in case G 10/91 is formally restricted to the proceedings before the Opposition Division, it is appropriate in this context to clarify the situation also in respect of the appeal procedure (cf. Rule 66(1) EPC).
  
18. The purpose of the appeal procedure inter partes is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits. It is not in conformity with this purpose to consider grounds for opposition on which the decision of the Opposition Division have not been based. Furthermore, in contrast to the merely administrative character of the opposition procedure, the appeal procedure is to be considered as a judicial procedure, as explained by the Enlarged Board in its recently issued decisions in the cases G 7/91 and G 8/91 (see point 7 of the reasons). Such procedure is by its very nature less investigative than an administrative procedure. Although Article 114(1) EPC formally covers also the appeal procedure, it is therefore justified to apply this provision generally in a more restrictive manner in such procedure than in opposition procedure. In particular with regard to fresh grounds for opposition, for the above reasons the Enlarged Board considers that such grounds may in principle not be introduced at the appeal stage. This approach also reduces the procedural uncertainty for patentees having otherwise to face unforeseeable complications at a very late stage of the proceedings, putting at risk the revocation of the patent, which means an irrevocable loss of rights. Opponents are in this respect in a better position, having always the possibility to initiate revocation proceedings before national courts, if they do not succeed before the EPO. 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 fit injuria. It may in some cases be in his own interest that such a ground is not excluded from consideration in the centralised procedure before the EPO. However, it goes without saying that such a ground should only be raised by a Board of Appeal or, if raised by an opponent, be admitted into the proceedings, if it is considered by the Board to be already prima facie highly relevant. If a fresh ground is admitted, the case should, having regard to the purpose of the appeal procedure as stated above, be remitted to the first instance for further prosecution, unless special reasons present themselves for doing otherwise. It may be added that if the patentee does not agree to the introduction of a fresh ground for opposition, such a ground may not be dealt with in substance in the decision of the Board of Appeal at all. Only the fact, that the question has been raised may be mentioned.

19. In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC (e.g. with regard to the provisions of Article 123(2) and (3) EPC).



Opinion

For these reasons, it is decided that:

The question of law referred to the Enlarged Board by the President of the EPO is to be answered as follows:

1. An Opposition Division or a Board of Appeal 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.
2. In principle, the Opposition Division shall examine only such grounds for opposition, which have been properly submitted and substantiated in accordance with Article 99(1) in conjunction with Rule 55(c) EPC. Exceptionally, the Opposition Division may in application of Article 114(1) EPC consider other grounds for opposition, which, prima facie, in whole or in part would seem to prejudice the maintenance of the European patent.
3. Fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

The Registrar:

The Chairman:

  
J. Rückerl

  
P. Gori