



Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 2 April 2001

Case Number: G 0001/99

Application Number: 86308961.1

Publication Number: 0225103

IPC: G02B 5/128

Language of the proceedings: EN

Title of invention:

Encapsulated-lens retroreflective sheeting and method of making

Patentee:

MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

Nippon Carbide Industries Co., Ltd.

Headword:

Reformatio in peius / 3M

Relevant legal provisions:

EPC Art. 100, 101(1), 102(1), 102(2), 102(3), 106(1), 107, 108,
112(1)(a), 114(1), 123(2), 123(3), 125
EPC R. 57a, 58(2), 64(b), 66(1), 87

Keyword:

"Reformatio in peius - exception to the prohibition"

"Status of appellant/opponent"

"Status of appellant/patent proprietor"

Decisions cited:

G 0002/91, G 0008/91, G 0009/91, G 0010/91, G 0009/92,
G 0004/93, G 0001/95, T 0406/86, T 0295/87, T 0060/91,
T 0488/91, T 0096/92, T 0923/92, T 0752/93, T 0579/94,
T 1002/95, T 0315/97

Headnote:

In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision.

In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;

- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC.



Case Number: G 0001/99

D E C I S I O N
of the Enlarged Board of Appeal
of 2 April 2001

Appellant:
(Opponent)

Nippon Carbide Industries Co., Ltd.
New Tokyo Building
3-1, 3 chome, Marunouchi Chiyoda-ku
Tokyo (JP)

Representative:

Hansen, Bernd, Dr. Dipl.-Chem.
Hoffmann Eitle
Patent- und Rechtsanwälte
Arabellastraße 4
D-81925 München (DE)

Respondent:
(Proprietor of the patent)

MINNESOTA MINING AND MANUFACTURING COMPANY
3M Center
P.O. Box 33427
St. Paul
Minnesota 55133-3427 (US)

Representative:

Wilhelm, Stefan
3M Deutschland GmbH
Carl-Schurz-Straße 1
D-41453 Neuss (DE)

Referring decision:

Decision of the Technical Board of Appeal 3.4.2
of 17 December 1998 in the appeal proceedings
T 0315/97 - 3.4.2.

Composition of the Board:

Chairman: P. Messerli
Members: J.-C. Saisset
C. Andries
G. Davies
B. Jestaedt
A. Nuss
R. Teschemacher

Summary of Facts and Submissions

- I. The facts leading to the present referral are as follows. The respondent is proprietor of European patent No 0 225 103, which was granted on the basis of European patent application No 86 308 961.1. The sole opponent lodged an appeal as the sole appellant against the interlocutory decision of the Opposition Division maintaining the patent in amended form. The maintained claim 1 comprised a feature which has been added to claim 1 as granted. During the appeal proceedings, the respondent/proprietor filed a main request including this feature and a first auxiliary request deleting it.
- II. In the referring decision T 315/97 (OJ EPO 1999, 554), Technical Board of Appeal 3.4.2 stated that, although the added feature was based on a passage of the description, it was not able to envisage giving a positive decision on the basis of the main request. The referring Board considered that the deletion of this feature in the first auxiliary request would lead to an extension of the protection conferred by the patent as maintained. In consequence, the appellant would be put in a worse situation than if it had not appealed. The Board added that the requested deletion could be considered appropriate and necessary because it had been filed in order to meet an objection put forward during the appeal proceedings.
-
- III. Considering that legal uncertainty has been created by the fact that the case law of the Boards of Appeal has not been uniform as regards the principle of prohibition of *reformatio in peius* when applying or interpreting decision G 9/92 (OJ EPO 1994, 875),

Technical Board of Appeal 3.4.2 referred the following question to the Enlarged Board:

"Must an amended claim which would put the opponent and sole appellant in a worse situation than if he had not appealed - e.g. by deleting a limiting feature of the claim - be rejected?"

IV. In its first written statement in the present proceedings, the appellant/opponent considered that the Enlarged Board of Appeal should also prohibit *reformatio in peius* in cases where the opponent is the appellant and the patent proprietor is party to the appeal proceedings as of right. In its view, this would be in line with legislation and case law in many of the Contracting States of the EPC and with earlier case law of the Enlarged Board of Appeal. It was submitted that, because the patent proprietor had decided in opposition proceedings of its own volition no longer to defend its patent as granted but to resort to more limited claims, there were no special reasons to justify a deviation from the established legal principles.

V. In its response, the respondent/proprietor took the view that decision G 9/92 unambiguously reached "non-symmetrical" conclusions in points 14 and 15 of the reasons in stating that:

- in the case of a sole appeal by the patentee the claims as allowed by the opposition division form a lower limit and a request aimed at putting the patentee below such limit cannot be granted,

- in the case of a sole appeal by the opponent the claims as allowed by the opposition division do not form an upper limit which may not be crossed by the patentee when defending the patent.

- VI. In these statements, and in their subsequent submissions, the parties proposed diametrically opposed answers to the referred question.
- VII. The Enlarged Board sent with the summons to oral proceedings a Communication to the parties drawing attention to the topics which in its opinion needed to be discussed in depth for the purposes of the decision to be taken.
- VIII. In reply, the respondent/proprietor filed a legal opinion on the admissible extent of amendments to claims by a patentee, party to the appeal proceedings under Article 107, second sentence, EPC. In this opinion, it was argued that a request for amendment proposed by a non-appealing patent proprietor should be admissible. Such a request should only be rejected if it failed to comply with Articles 123(2) and 123(3) EPC, even if the requested amendment would put the opponent and sole appellant in a worse situation than if it had not appealed. Thus, the opinion concluded that the question referred to the Enlarged Board should be answered "no".
- IX. In its final written submissions, the appellant/opponent came to the conclusion that the referred question should be answered in the affirmative because in its view a negative answer would overturn the reasoning of G 9/92 in its entirety and the respondent/proprietor had not shown any convincing reason why the Enlarged Board of Appeal should do so.
- X. In the last written observations of the respondent/proprietor, it mainly argued that an unacceptable imbalance would arise if a non-appealing patentee's capacity to respond to an appeal were not

only limited by the freedom of the appellant/opponent to terminate the proceedings by withdrawing the appeal but also by being required to respect the version as maintained by the Opposition Division as an upper limit for amendments to meet attacks by the opponent.

XI. Oral proceedings were held on 19 January 2001. The parties developed their arguments, giving in particular their opinion on the followings questions raised orally by the Enlarged Board:

- what is the correct reading of decision G 9/92; in particular, does it contain a symmetrical application of the principle of the prohibition of *reformatio in peius* to cases where the sole appellant is the patent proprietor and to cases where the sole appellant is the opponent?

- if the answer is "no", does that mean that an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, should always be allowed into the procedure or only under specific circumstances?

- if the answer is "yes", are there reasons to depart from this symmetrical application in specific cases and in particular where an amended claim is filed by the patent proprietor in order to meet an objection put forward by the opponent and sole appellant and which consists of the deletion of a limiting feature introduced during the opposition proceedings?

At the conclusion of the oral proceedings, the Enlarged Board announced that the decision would be delivered in writing.

Reasons for the Decision

1. The referral fulfils the requirements of Article 112(1)(a) EPC, and is therefore admissible.
2. The referring decision raises the question whether or not the principle of the prohibition of *reformatio in peius* must be applied to a case where the opponent is the sole appellant.
 - 2.1 In the case law of the Boards of Appeal, a definition of that principle has already been quoted e.g. in decision T 60/91, OJ EPO 1993, 551, reasons, point 7: *"Soweit die Regeln eines Beschwerdeverfahrens ein Hinausgehen über die Anträge der beschwerdeführenden Partei zu deren Nachteil verbieten, spricht man, zumindest im deutsch-sprachigen Rechtskreis, vom sog. 'Verschlechterungsverbot' oder vom Verbot einer 'reformatio in peius'". ["Where the rules of court procedure governing appeals prevent a court of appeal from going beyond the requests of the appealing party and putting it in a worse position than it was in before it appealed, the legal term used in German-speaking countries is 'Verschlechterungsverbot', the prohibition of 'reformatio in peius'"]*. Thus, the principle of the prohibition of *reformatio in peius* is the principle that a decision may not be reached which would put an appellant in a worse position than it was in under the impugned decision. This corresponds to the definition generally recognised in the Contracting States.
 - 2.2 In the question raised by Technical Board of Appeal 3.4.2, the wording *"opponent and sole appellant"* corresponds to the procedural situation present in the referring case, namely to appeal proceedings where the

opponent is the sole appellant and where the patent proprietor is party to the appeal proceedings as of right within the meaning of Article 107, second sentence, EPC, i.e. where the patent proprietor is the respondent. However, the question of *reformatio in peius*, or of its prohibition, equally applies to cases where more than one opponent has individually and separately filed an appeal against the same decision. For the sake of completeness, the present decision also intends to cover such situations.

- 2.3 As regards putting the opponent/appellant in a worse situation, Board 3.4.2 only referred to the possible deletion of a limiting feature added during opposition proceedings. This corresponds to the procedural situation present in the referring case. Consequently, in the present decision, the Enlarged Board of Appeal only addresses the question whether and under what circumstances such a deletion is permissible.
3. Board 3.4.2 referred the question mainly because it considered that legal uncertainty had been created by the fact that the case law of the Boards of Appeal, when interpreting decisions G 9/92 and G 4/93 of the Enlarged Board of Appeal, is not uniform. (These two decisions are identical, see: OJ EPO 1994, 875 and footnote. However, as the official text of G 9/92 is German, only G 4/93 the official text of which is English will be quoted hereafter for the sake of clarity).
- 3.1 The question to be answered in G 4/93 was "*Can the Board of Appeal amend a contested decision to the appellant's disadvantage?*". Because it did not differentiate between appeals filed solely by the patent proprietor or by the opponent, this original question encompasses the present question raised by

Board 3.4.2. Thus, at the outset, it is necessary to analyse decision G 4/93 before answering the referred question.

3.2 Moreover, as stated in the referring decision, a divergent interpretation of the answer given in the order of G 4/93 to the question whether the prohibition of *reformatio in peius* is to be applied or not in cases where the patent proprietor is a party as of right had arisen in the decisions of the Boards of Appeal cited in the referring decision. In particular, the following decisions took the view that the prohibition of *reformatio in peius* did apply: T 923/92 (OJ EPO 1996, 564) and T 579/94 (unpublished in the OJ EPO). Decisions which found that *reformatio in peius* is possible include the following: T 752/93 (unpublished in the OJ EPO) and T 1002/95 (unpublished in the OJ EPO).

3.3 The reason for the diverging approaches in the case law lies mainly in the interpretation given by Boards of Appeal to paragraph 2 of the order of decision G 4/93, which reads as follows:

"If the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, the patent proprietor is primarily restricted during the 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."

3.4 In the referring decision, the Enlarged Board is now requested to clarify the balance of priorities of the criteria laid down in G 4/93, i.e. the balance of priorities between the worsening of the situation of the opponent/appellant vs. the appropriate and necessary character of the amendment.

4.1 It is undisputed that decision G 4/93 decided that the principle of the prohibition of *reformatio in peius* should be applied in cases where the patent proprietor is the sole appellant against an interlocutory decision maintaining the patent in amended form. This is clearly the wording of paragraph 1 of the order. A patent proprietor can therefore not be placed in a worse position than if it had not appealed. This means that the patent as maintained by the Opposition Division in its interlocutory decision cannot be objected to by the Board of Appeal, either at the request of the respondent/opponent or *ex officio*. This is balanced by the option open to the opponent to file a request for the revocation of the maintained patent at the national level.

4.2 Paragraph 2 of the order relates to proceedings where the opponent is the sole appellant against an interlocutory decision maintaining the patent in amended form or, as explained *supra* in point 2.2, to appeal proceedings where the patent proprietor is simply a party as of right to these proceedings. Whereas the question referred to the Enlarged Board of Appeal in G 4/93 related to appellants in general, the distinction made in the order without doubt implies that the Enlarged Board of Appeal intended also to specifically address this latter situation.

5. The interpretation of G 4/93 obviously requires consideration of the order of the decision in relation

to the reasons for the decision. Points 1 to 13 deal with procedural principles and the binding effect of the appellant's request. In these points, the Enlarged Board of Appeal defined the general concepts from which a specific conclusion was inferred for opposition appeal proceedings where the sole appellant is the patent proprietor (point 14) and for opposition appeal proceedings where the opponent is the sole appellant (points 15 and 16). Point 17 contains a dissenting opinion.

6. In points 1 to 13 of G 4/93, the Enlarged Board of Appeal noted that the EPC does not contain any provision which stipulates that a decision terminating appeal proceedings must not place an appellant in a worse situation than it was in as a result of the contested decision. However, it went on to draw attention to the following considerations.
 - 6.1 As regards the aim of the appeal proceedings, the Enlarged Board, referring to Opinion G 10/91 (OJ EPO 1993, 420), repeated in point 5 of the reasons of G 4/93 that *"The main aim of the inter partes appeal procedure is to give the losing party the opportunity to contest the Opposition Division's decision"*. This is in line in particular with Article 106(1) EPC which states that *"an appeal shall lie from decisions of...Opposition Divisions"* and with Article 107 EPC which states that *"any party to proceedings adversely affected by a decision may appeal"*. It results from these statements that the subject of an appeal is a decision issued by one of the instances listed in Article 106(1) EPC (see also: Paterson, "The European Patent System", London: Sweet & Maxwell, 1992, 57 and Singer/Stauder, "Europäisches Patentübereinkommen", 2nd edition, Köln: Heymanns, 2000, Art. 106, note 21).

Indeed, issues outside the subject-matter of the decision under appeal are not part of the appeal. From this, Opinion G 10/91 derived the principle that fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee. In appeal proceedings a fresh ground for opposition is by definition a ground for opposition which was neither raised and substantiated in the notice of opposition nor introduced into the proceedings by the Opposition Division (see G 1/95, OJ EPO 1996, 615, reasons, point 5.3).

6.2 Moreover, as regards the extent of the proceedings, as stated *supra*, the Enlarged Board of Appeal pointed out in point 1 of the reasons of G 4/93 that "*the initial request*" determines the extent of the proceedings. The appellant may file an appeal against the decision taken as a whole or in part (see: Rule 64(b) EPC). This is the principle of free party disposition.

6.3 However, another consideration is to be taken into account as regards the extent of appeal proceedings. As pointed out in point 9 of G 4/93, and in accordance with Article 107 EPC, the aim of appeal proceedings is to eliminate an "*adverse effect*" arising from the decision under appeal. An adverse effect can arise from the decision taken as a whole or only from a part thereof. Therefore, the appellant may not dispute either a decision or a part of a decision which does not adversely affect it.

6.4 Thus, within the limits of what in the subject-matter of the decision under appeal adversely affects it, it is the appellant who in the notice of appeal determines the extent to which amendment or cancellation of the decision under appeal is requested.

6.5 As regards the status of the parties to the appeal proceedings, it is stated in point 8 of the reasons for G 4/93 that "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 party to the appeal proceedings as of right". This results from Article 107, second sentence, EPC which stipulates that "any other parties to the proceedings shall be parties to the appeal proceedings as of right". This also relates to point 6.1 of the reasons for G 2/91 (OJ EPO 1992, 206) where the Enlarged Board stated: "Artikel 107, Satz 2 EPÜ verleiht den Beteiligten der ersten Instanz, die keine Beschwerde eingelegt haben, keine von der Beschwerde unabhängige Rechtsstellung, sondern garantiert lediglich, dass sie an einem anhängigen Beschwerdeverfahren beteiligt sind". ["Article 107, second sentence, EPC does not grant parties to first-instance proceedings who have not filed an appeal a legal status independent of the appeal, but merely guarantees that they are parties to the appeal proceedings being heard"]. In point 10 of the reasons for G 4/93, the Enlarged Board stated that "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". In point 11 it was added that "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".

6.6 Article 114(1) EPC lays down the principle of ex officio examination which, prima facie, may allow Boards of Appeal to broaden the extent of the appeal.

With regard to this principle, the Enlarged Board, referring to point 18 of the reasons for G 9/91 (OJ EPO 1993, 408) stated, in point 3 of the reasons for G 4/93, that the power of an Opposition Division or a Board of Appeal to decide on the revocation or maintenance of a European patent depends on the extent to which the patent is opposed in the notice of opposition. In these two decisions it was explained that Article 114(1) EPC, which already has a restricted application in the opposition proceedings, is to be applied in an even more restrictive manner in appeal proceedings. This was essentially because, in the Enlarged Board's view, the appeal procedure is to be considered as a judicial procedure (see point 8 of the reasons for G 9/91) proper to an administrative court (see point 7 of the reasons for G 8/91, OJ EPO 1993, 346). Furthermore, in point 6 of the reasons for G 4/93, the Enlarged Board specified that *"the extent of the power of the Board of Appeal to decide upon the proper scope of the patent should be considered in conjunction with the effect of withdrawal of the appeal"* and added that *"Once the, or each, appeal has been withdrawn, there is no power to continue the proceedings"*. This was done to emphasize how the appellant's request operates to restrict the extent to which Boards of Appeal may act *ex officio*.

7. The Enlarged Board of Appeal considers that it results from points 1 to 13 of the reasons for decision G 4/93 that the non-appealing party may not in principle file a request going beyond the extent of the appeal defined in the appellant's request.

8. Point 14 of the reasons for G 4/93 relates specifically to appeals where the patent proprietor is the sole appellant. Considering that, if the non-appealing opponent files a request for revocation of the patent,

the scope of the appeal is exceeded, point 14 leads to paragraph 1 of the order. As pointed out *supra* in point 4.1, this makes clear that a patent proprietor cannot be placed in a worse situation than if it had not appealed, i.e. that *reformatio in peius* is prohibited.

9. Points 15 and 16 of the reasons for G 4/93 relate specifically to appeals where the opponent is the sole appellant and lead to paragraph 2 of the order. In such cases, as regards the respondent/proprietor, it is stated in point 16 that: *"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"*.

- 9.1 In view of Article 107, first sentence, EPC this implies that the patent proprietor was entitled to file an appeal because it had been adversely affected by the decision of the Opposition Division. In the three referring decisions T 60/91, T 96/92 (consolidated cases, OJ EPO 1993, 551) and T 488/91 (not published in OJ EPO) leading to G 4/93, the patents were maintained in an amended form in accordance with one of the auxiliary requests of the patent proprietor, the main requests of which were refused. By contrast, in the present referred case the patent proprietor was not entitled to file an appeal because the claims maintained by the Opposition Division in its interlocutory decision correspond to the main and only request of the patent proprietor. Thus, the patent proprietor was not adversely affected by the decision and, therefore, was not entitled to file an appeal. However, this difference does not change the conclusion reached by the Enlarged Board in G 4/93 because, by requesting in a main and only request the maintenance of the patent in a restricted form, the patent proprietor also indicated that it would not contest the

maintenance of the patent as examined and found allowable by the Opposition Division. In such a situation, the patent proprietor is aware that, if the Opposition Division allows its main request, it will lose the right to file an appeal because that decision will not adversely affect it. As a consequence of the fact that the patent proprietor has indicated that it will not contest the maintenance of the patent in the version accepted by the Opposition Division, it was decided in the first sentence of paragraph 2 of the order of G 4/93, that the patent proprietor is primarily restricted during appeal proceedings to defending the patent as amended in accordance with the interlocutory decision. This means that, if the version of the patent held allowable by the Opposition Division is also held allowable by the Board, then, because the patent proprietor intentionally accepted this version either by making it the basis of its main request before the Opposition Division or by not filing an appeal, the proprietor/respondent may not in principle request another version of the patent during the appeal proceedings, unless this version is a restriction of the maintained version.

- 9.2 This is in line with the general concepts laid down in points 1 to 13 of the reasons for G 4/93 and, consequently, with the principle of the prohibition of *reformatio in peius*. This is also in line with the case law of the Enlarged Board of Appeal. Whether or not this prohibition is in line with the principles of procedural law generally recognised in the Contracting States is not relevant because the reasoning of G 4/93 is not based on Article 125 EPC. However, even if generally balanced by the fact that cross-appeals are allowed, which is not the case under the EPC, this prohibition is at least present in the procedural law of France, Germany, Italy, and Switzerland.

10. It has to be considered now whether or not it was envisaged in G 4/93 to apply this prohibition in an absolutely symmetrical way to appeals where the patent proprietor is the sole appellant and to appeals where the opponent is the sole appellant. When the Enlarged Board decided that *"Amendments proposed by the patent proprietor ... may be rejected as inadmissible ... if they are neither appropriate nor necessary"*, it simply added in the last sentence of point 16 the comment: *"which is the case if the amendments do not arise from the appeal (Article 101(2) EPC; Rules 58(2) and 66(1) EPC; T 406/86, OJ EPO 1989, 302; T 295/87, OJ EPO, 1990, 470)"*. However, relating to cases where it is established that amendments proposed by the patent proprietor arise from the appeal, no answer is to be found to the question of in which situation amendments which are appropriate and necessary may be allowed in the appeal proceedings or rejected as inadmissible, in particular as regards an eventual worsening of the position of the opponent/appellant.

10.1 As regards which amendments may be considered appropriate and necessary, point 16 of the reasons for G 4/93 refers to decisions T 406/86 and T 295/87. There it was decided that the law does not guarantee a patent proprietor the right to have proposed amendments admitted in opposition appeal proceedings. Whether to allow such amendments is left to the Board of Appeal, which must exercise due discretion in the matter.

However, T 406/86 decided that amendments are "appropriate" if they arise from the grounds for opposition and that amendments should be limited to what is "necessary" in the light of the grounds for opposition (points 3.1.3 and 3.1.4 of the reasons). Thus, if the grounds for opposition do not prejudice the maintenance of the patent as it stands, the Opposition Division rejects the opposition in

accordance with Article 102(2) EPC and in that case it would clearly be inappropriate and unnecessary to admit amendments. If on the other hand there are grounds for the opposition which prejudice the maintenance of the European patent (Article 102(1) EPC), it is normally appropriate to give the patent proprietor an opportunity of making amendments to enable the patent to be maintained within the meaning of Article 102(3) EPC (Point 3.1.6 of the reasons). Decision T 295/87, confirmed that, during opposition proceedings, amendments should only be considered appropriate and necessary if they can fairly be said to arise out of the grounds of opposition laid down in Article 100 EPC (point 3 of the reasons). Neither of these decisions considered *reformatio in peius* and the question whether or not appropriate and necessary amendments should be admitted into the proceedings even though the opponent/appellant is put in a worse situation. In T 1002/95 (cited by the patent proprietor), it was stated that amendments proposed by the patent proprietor in appeal proceedings are appropriate and necessary in the sense of G 4/93 if these amendments are intended to remove deficiencies in respect of requirements of the EPC which should be fulfilled. As pointed out *supra* in point 3.2, it was also stated in T 1002/95 that such amendments should be allowed even if they put the opponent/appellant in a worse situation than if it had not appealed.

- 10.2 In the present referral, the patent proprietor referred also to Rule 57a EPC to demonstrate that, in opposition appeal proceedings, this rule is a legal basis for a Board of Appeal to allow amendments which may worsen the situation of the opponent/appellant. However, the Enlarged Board of Appeal cannot follow this line of argument. Rule 57a EPC is contained in Part V of the

Implementing Regulations to the EPC which relate to opposition procedure and not in Part VI "Appeals procedure" or in Part VII "Common provisions". However, by virtue of Rule 66(1) EPC, Rule 57a EPC is applicable *mutatis mutandis* to appeal proceedings, but only "unless otherwise provided". Thus, Rule 57a EPC, as far as it is applicable in proceedings before the Boards of Appeal, does not as such restrict the application of principles specific to the appeal proceedings such as the prohibition of *reformatio in peius*.

10.3 Coming back to G 4/93, it is stated in point 10 of the reasons that it would not be consistent with the time limit of Article 108, first sentence, EPC "to allow non-appealing parties the *unrestricted* right to alter the extent of the proceedings by submitting their own request without limitation of time". This, in the Enlarged Board's opinion, implies that requests submitted by a non-appealing party might, in very specific circumstances and in a restricted manner, alter the extent of the proceedings. This has to be considered together with the sentence in the order "the patent proprietor is *primarily* restricted ... to defending the patent in the form in which it was maintained by the Opposition Division" which also gives an indication that there might be situations where the patent proprietor might be allowed to alter the extent of the proceedings to defend the patent in a form which might be different to that maintained by the Opposition Division.

11. Consequently, the Enlarged Board of Appeal takes the view that the absolutely symmetrical application argued for by the opponent/appellant was not foreseen in G 4/93. Its undifferentiated application is

inappropriate in cases where the patent proprietor is only party as of right to the appeal proceedings because it could lead, in certain specific circumstances, to inequitable consequences. Taking into consideration that in appeal proceedings before the EPO the application of the principle of prohibition of *reformatio in peius* derives from its own case law, the Enlarged Board of Appeal has also to weigh the consequences of this application, if it appears that they might be unsatisfactory.

12. It results from the case law of the Enlarged Board of Appeal (see *supra* point 6), that *reformatio in peius* should be prohibited because it is the principal task of the Boards of Appeal to review the decision under appeal, not to reexamine the case from scratch. This is not in contradiction with the fact that, with respect to the allowability of amendments made during the opposition procedure, the appeal proceedings are not restricted to the legal and factual background of the proceedings before the Opposition Division. Indeed, objections raised in the first instance may be supported by new facts and new objections may be raised in appeal proceedings with the consequence that the basis on which limitations have been made may still change and it would not be equitable to allow the opponent/appellant or the Board to present new attacks and to deprive the proprietor/respondent of a means of defence. As stated in G 4/93, the proprietor/respondent is primarily limited to defending the version of the patent held allowable by the Opposition Division. However, in particular if the patent cannot be maintained for reasons which were not raised at the first instance, the non-appealing proprietor deserves protection for reasons of equity.

13. As regards the principle of equity, for the purpose of the present referral the following aspects have to be taken into consideration.

13.1 When prohibition of *reformatio in peius* is applied to cases where the patentee is the sole appellant, if the opponent/respondent considers that the patent as finally maintained is not a valid one, there is a remedy because it has an opportunity to request the revocation of the patent at the national level.

13.2 The consequences of the application of the same principle to cases where the patent proprietor is party as of right in the appeal proceedings are completely different. Indeed, if the Board of Appeal comes to the conclusion that it is not possible to maintain a patent there is no remedy for the patent proprietor, neither at the level of the EPO nor at the national level since no appeal or action may be filed against that decision.

13.3 With regard to the present case, the referring Board already stated that it was not able to envisage giving a positive decision on the basis of the main request of the respondent/proprietor, i.e. on the version held allowable by the Opposition Division, which contains a limiting feature added during the opposition procedure. However, as regards the first auxiliary request in which this limiting feature was deleted, the referring Board stated that this deletion arises from the appeal and could be considered appropriate and necessary because it aims at meeting an objection put forward during the appeal proceedings. Thus, the referring Board would have to reject the main request of the proprietor/respondent because it does not meet the requirements of the EPC. Moreover, if the principle of prohibition of *reformatio in peius* were to be applied without considering the specific circumstances of the

case, it would also have to reject the first auxiliary request because it would put the opponent/appellant in a worse situation than if it had not appealed. Finally, it would then have to set aside the decision under appeal and revoke the patent. As stated *supra* in point 13.2, when a patent is revoked as a result of appeal proceedings, there is no remedy for the patent proprietor. This means that the patent proprietor will definitively lose any protection as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision, whereas the deletion of the added feature as such would have avoided the direct revocation of the patent.

14. In order to decide on the request of the appellant/opponent, the Board of Appeal has to decide whether or not the amended set of claims as maintained by the Opposition Division is patentable. This means in particular that the Board has to consider whether or not a limiting feature added during the opposition proceedings fulfils the requirements of the EPC. Thus, if during the appeal proceedings a request is filed by the patent proprietor/respondent in order to meet an objection raised by the opponent/appellant or by the Board to the effect that an amendment introduced in opposition proceedings and held allowable by the Opposition Division does not comply with the requirements of the EPC, and would have the direct consequence that the patent would have to be revoked, then for the reasons given *supra* in point 13, it would be inequitable for the patent proprietor not to be given a fair opportunity to mitigate the consequences of errors of judgement made by the Opposition Division. Therefore, the patent proprietor may be allowed to file requests in order to overcome this deficiency.

15. In line with point 10.1 *supra*, during the appeal proceedings the proprietor/respondent may request a restriction of the maintained version of the patent by introducing one or more originally disclosed limiting features. Such a restriction does not contravene the principle of the prohibition of the *reformatio in peius*. However, if such a limitation proves impossible, only an exception to the principle may allow to overcome the deficiency. Because the Boards of Appeal have to respect the principle of the prohibition of *reformatio in peius*, such an exception should only be construed narrowly. Consequently, in order to overcome the deficiency which is due to an amendment introduced into the version of the patent as maintained by the Opposition Division but which does not comply with the requirements of the EPC, the respondent/proprietor must attempt to resolve the problem by filing requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed limiting features, which would not put the opponent/appellant in a worse situation than it was in before it appealed; or

- if such a limitation proves impossible, for an amendment introducing one or more originally disclosed features, which extends the scope of the patent as maintained, but within the limits of Article 123(3) EPC; or

- if such an amendment proves impossible, for deletion of the inadmissible amendment maintained by the Opposition Division, but within the limits of Article 123(3) EPC, even if, as a result, the situation of the opponent/appellant is made worse.

Such requests for amendment shall be considered appropriate and necessary and, therefore, admissible.

Order

For these reasons, it is decided that the question of law referred to the Enlarged Board of Appeal by Technical Board of Appeal 3.4.2 in its decision T 315/97 is answered as follows:

In principle, an amended claim, which would put the opponent and sole appellant in a worse situation than if it had not appealed, must be rejected. However, an exception to this principle may be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision.

In such circumstances, in order to overcome the deficiency, the patent proprietor/respondent may be allowed to file requests, as follows:

- in the first place, for an amendment introducing one or more originally disclosed features which limit the scope of the patent as maintained;

- if such a limitation is not possible, for an amendment introducing one or more originally disclosed features which extend the scope of the patent as maintained, but within the limits of Article 123(3) EPC;

- finally, if such amendments are not possible, for deletion of the inadmissible amendment, but within the limits of Article 123(3) EPC.

The Registrar:



W. Roepstorff

The Chairman:



P. Messerli