

Decision of Technical Board of Appeal 3.2.06 dated 28 June 2007**T 263/05 - 3.2.06¹**

(Language of the proceedings)

Composition of the board:

Chairman: P. Alting Van Geusau

Members: M. Harrison

K. Garnett

Opponent/Appellant: Bayerische Motoren Werke Aktiengesellschaft

Opponent/Appellant: KUKA Schweissanlagen GmbH

Opponent/Appellant: TRUMPF Laser-und Systemtechnik GmbH

Patent proprietor/Appellant: HONDA GIKEN KOGYO KABUSHIKI KAISHA

Headword: Laser welding/HONDA GIKEN KOGYO K.K.

Article: 54(1), 56, 84, 111(1), 114(1) EPC 1973

Rule: 27(1)(b), 27(1)(c), 29(2), 57a, 61a, 76(1) EPC 1973

RPBA Art. 10a(1), 10a(2) and 10b(3)

Keyword: "Novelty and inventive step of one independent claim and its dependent claims (yes)" - "Amendments prohibited by Rules 57a or 29(2) EPC (no)" - "Amendments to description (allowed)" - "Amendment of a party's case to introduce a new line of argument in appeal proceedings after filing of reply (not allowed)" - "Extent of duty of board of appeal to examine claims *ex officio* (Article 114(1) EPC)" - "Extent of power of Board acting *ex officio* under Article 111(1) EPC to remit a case to the Opposition Division" - "Remittal of case to Opposition Division (no)" - "Requests to record matters in minutes (refused)"

Headnote

I. Rule 57a EPC does not prohibit an amendment to a granted patent containing a single independent claim whereby a plurality of independent claims are introduced if the amendment is a necessary and appropriate response to a ground of opposition. (Reasons 4.8)

II.1 Rule 29(2) EPC does not apply in opposition proceedings to prohibit an amendment to a granted patent if it would be unreasonable to demand of the amended claims that they comply with this rule. This condition is satisfied in a case where otherwise Rule 29(2) EPC would force the proprietor to abandon potentially valid subject-matter already contained in the granted claims. (Reasons 5.16)

II.2 No circumstances are envisaged in which Rule 29(2) EPC would be of any application in opposition proceedings. Once an amendment to the claims has been established to be necessary and appropriate having

¹ This is an abridged version of the decision. A copy of the full text in the language of proceedings may be obtained from the EPO Information Desk in Munich on payment of a photocopying fee of EUR 0.70 per page.

regard to grounds of opposition, it would be unreasonable to impose the additional requirement that the amendment complies with the purely administrative provisions of Rule 29(2) EPC. (Reasons 5.19)

III.1 Article 10a(2) of the Rules of Procedure of the Boards of Appeal requires that a party wishing to argue that a decision under appeal should be upheld for a reason additional to the reason(s) already relied on by the Opposition Division, must, in its reply to the appeal, set out its complete case in respect of this additional reason, together with all facts, arguments and evidence relied upon. Otherwise such additional reason will only be admitted and considered at the Board's discretion by way of an amendment to the party's case. (Reasons 7.10)

III.2 A Board of Appeal has an ex officio duty under Article 114(1) EPC to examine amended claims, but only for prima facie non-compliance with the EPC. (Reasons 7.15)

III.3 A Board of Appeal's power under Article 111(1) EPC, ex officio, to remit the case to the Opposition Division for further prosecution should only be exercised in a case such as the present one if, as a minimum, there are materials before it in the appeal proceedings which indicate that one or more of the claims under attack in the appeal proceedings are prima facie highly unlikely to be valid. (Reasons 7.16)

IV. The minutes of oral proceedings before the Boards of Appeal should record the requests of the parties on which a decision of the Board is required, such as the allowability or otherwise of the appeal, the form in which the proprietor seeks maintenance of the patent, requests for remittal of the case or relating to appeal fees or costs. The minutes should also record specific statements which have an impact on the definition of the subject-matter, such as statements of surrender or abandonment of subject-matter, where these are relevant to the decision to be taken. The arguments of the parties should not be recorded in the minutes, nor should statements or admissions made in oral proceedings which a party considers will be of use to it in any subsequent proceedings in national courts but which have no bearing on the decision which the Board is required to make, such statements or admissions constituting neither "essentials of the proceedings" nor "relevant statements" within the meaning of Rule 76(1) EPC. (Reasons 8.5 - 8.8)

Summary of facts and submissions

I. In its interlocutory decision of 20 January 2005, the Opposition Division found that European patent number 0 857 536, as amended in accordance with the proprietor's second auxiliary request, met the requirements of the European Patent Convention.

The Opposition Division rejected the proprietor's main request on the basis of Rule 57a EPC because of the use of two independent claims, compared to only one independent claim in the granted patent, and on the basis of Rule 29(2) EPC in combination with Article 84 EPC, because of the presence of two independent claims in the same category, where the subject-matter of the two independent claims did not fall under any of the exceptions listed in sub-paragraphs (a), (b) or (c) of Rule 29(2) EPC.

II. The proprietor filed an appeal, requesting maintenance of the patent in an amended form according to its main request or alternatively based on a series of auxiliary requests. The main request contained a set of fourteen claims including independent claims 1 and 8, claim 1 being a combination of granted claims 1 and 5, and claim 8 being a combination of granted claims 1 and 7. This main request was identical to the main request rejected by the Opposition Division.

III. Each of the Opponents I, II and III also filed an appeal against the Opposition Division's decision, requesting revocation of the patent.

IV. Only Opponents I and II filed a response to the proprietor's appeal. With regard to the proprietor's main request, neither opponent filed arguments against novelty or inventive step in respect of claim 8. Opponent III filed no response to the proprietor's appeal.

V. With its summons to oral proceedings, the Board *inter alia* noted that the matter of Rule 29(2) EPC would be taken up if the subject-matter of claim 1 were found to be novel and inventive. Concerning novelty, the Board noted that the opponents had provided no evidence that scan heads of the prior art were adjustable or rotatable. Further, the parties were invited to comment on the possibility of remittal to the first instance since the subject-matter of independent claim 8 had not been examined by the Opposition Division.

VI. During the oral proceedings of 28 June 2007, the proprietor filed a new main request, being to set aside the decision under appeal and maintain the patent based on amended claims and an adapted description.

The claims of the new main request differed from the claims of the previous main request only in that independent claims 1 and 8 were cast in a one-part form and dependent claim 12 was deleted with subsequent renumbering of claims 13 and 14.

VII. ...

VIII. In addition to their requests for revocation, the opponents made the following additional requests:

Opponent I requested that Rule 29(2) EPC be applied by the Board and that if the patent were not revoked the case be remitted to the Opposition Division for further prosecution.

Opponent II requested that if the patent were not revoked the case be remitted to the Opposition Division for further prosecution and that its written request filed during oral proceedings (see paragraph X, below) be met.

Opponent III requested that its written request filed during oral proceedings (see paragraph XI, below) be met.

IX. Claims 1 and 8 of the main request read as follows:

Claim 1:

"A laser beam welding apparatus comprising: a laser beam emitting device (22,76,78,96,108,110,128,130) for emitting a laser beam (L) to be applied to a location to be welded on a workpiece (W) in a welding station; a plurality of scan heads (26,28,84,86,88,90,100,102,116,118,120,136,138) for guiding the laser beam (L) to said location to be welded on the workpiece(W); and a beam path switcher (30,94,104,124,126) disposed in respective a laser beam transmission passage between said laser beam emitting device and said scan heads, for guiding the laser beam to a selected one of said scan heads; wherein each of said scan heads comprises a beam deflecting optical system (68,70) for guiding the laser beam to said location to be welded on the workpiece; and each of the scan heads comprises a beam converging optical system (60,62,64,66) for converging the laser beam onto said location to be welded on the workpiece, and said beam deflecting optical system comprises an angularly movable scanning mirror (68,70) disposed downstream from said converging optical system for deflecting said laser beam, said scanning mirror being angularly movable with respect to said converging optical system for deflecting said laser beam to a plurality of welding spots on the workpiece, and each of the scan heads comprises: a casing which houses said beam deflecting optical system and said beam converging optical system therein, and a turning mechanism (46, 52, 54) for turning said casing about an axis."

Claim 8:

"A laser beam welding apparatus comprising: a laser beam emitting device (22,76,78,96,108,110,128,130) for emitting a laser beam (L) to be applied to a location to be welded on a workpiece (W) in a welding station;

a plurality of scan heads (26,28,84,86,88,90,100, 102,116,118,120,136,138) for guiding the laser beam (L) to said location to be welded on the workpiece (W); and

a beam path switcher (30,94,104,124,126) disposed in respective a laser beam transmission passage between said laser beam emitting device and said scan heads, for guiding the laser beam to a selected one of said scan heads; wherein each of said scan heads comprises a beam deflecting optical system (68,70) for guiding the laser beam to said location to be welded on the workpiece; and each of the scan heads comprises a beam converging optical system (60,62,64,66) for

converging the laser beam onto said location to be welded on the workpiece, and said beam deflecting optical system comprises an angularly movable scanning mirror (68,70) disposed downstream from said converging optical system for deflecting said laser beam, said scanning mirror being angularly movable with respect to said converging optical system for deflecting said laser beam to a plurality of welding spots on the workpiece, and the laser beam welding apparatus further comprises a feed mechanism (14) for introducing the workpiece into the welding station, and a position measuring device (16A, 16B) disposed in said welding station, for measuring the position of the workpiece in the welding station, the arrangement being such that a position in which the workpiece is scanned by the laser beam guided by each of said scan heads is corrected out of a deviation based on a positional deviation of said workpiece which is measured by said position measuring device."

X. The written request of Opponent II filed during oral proceedings reads as follows:

"Die Einsprechende II beantragt, in das Protokoll zur mündlichen Verhandlung vom 28.6.2007 die Erklärung des Vertreters der Patentinhaberin aufzunehmen, dass Anspruch 1 des beschränkt aufrecht erhaltenen Patents sich nicht auf die Anordnung der scan heads an einen Roboter bezieht."

XI. The written request of Opponent III filed during oral proceedings reads as follows:

"Die Einsprechende OIII beantragt in der mündlichen Verhandlung, dass in der neu anzupassenden Beschreibung eine zu lösende Aufgabe zu formulieren ist, und dass in der Würdigung des Stands der Technik "John Macken, Optical Engineering, Inc. "Remote Laser welding" in der Beschreibung des europäischen Patents EP 0 857 536 B1 aufzunehmen ist, dass sich diese Vorrichtung nicht auf die Verwendung in Verbindung mit Robotern bezieht und auch dafür nicht geeignet ist."

Es wird weiterhin beantragt in das Protokoll aufzunehmen, dass der Vertreter des Patentinhabers vorgetragen hat, dass sich der geltende Patentanspruch 1 nicht auf Drehbewegungen in Verbindung mit Robotern bezieht."

XII. Opponent I argued essentially as follows:

Novelty

...

The subject-matter of claim 1 lacked novelty over:

D1 - "Remote Laser Welding", by John Macken, Proceedings of the International Body Engineering Conference, 1996.

...

Inventive step

The problem to be solved over D1 by the novel feature of claim 1 was merely to increase the working area of the welding device. This problem was solved by D7 ...

Rule 57a EPC

The reasons given by the Opposition Division for its decision on this issue were relied upon.

Rule 29(2) EPC

Again, the reasons given by the Opposition Division for its decision on this issue were relied upon. It was argued that Rule 61a EPC applies Rule 29 EPC to opposition proceedings and that this is confirmed by the decision of the Enlarged Board of Appeal in G 1/91 (OJ EPO 1992, 253). In decision T 991/02 (not reported in OJ EPO) the Board of Appeal did not question that Rule 29(2) EPC is applicable in opposition proceedings. Opposition is in effect a re-examination, therefore all requirements of the EPC must be fulfilled.

Claim 8 and remittal

A claim cannot be simply allowed if it has never been examined. In any event, arguments against this claim had been raised in opposition proceedings, so that its allowability was *prima facie* in doubt.

In any event, the Board had an obligation to examine the claim, and for the above reasons there was a *prima facie* case for why it was not allowable. The purpose of opposition and appeal proceedings cannot be to allow an entirely unexamined claim combination to provide protection.

Amendments to the description

The amendments made to the description during the oral proceedings to adapt it to the allowable claims were not sufficient. No "object of the invention" was mentioned in the description as regards claim 8. This was incorrect.

XIII. Opponent II argued essentially as follows:

Novelty

...

Inventive step

The problem to be solved over D1 ...

Rule 57a EPC

Opponent II relied on the grounds given by the Opposition Division for its decision on this issue. It was argued that the use of two independent claims was not occasioned by the grounds of opposition because:

(i) only one invention was disclosed (see paragraph [0033] of the granted patent);

(ii) there were not two embodiments of the invention, only one - this could be seen from paragraphs [0025] and [0026] of the granted patent;

(iii) although the Board had indicated that this was in reality an Article 123(2) EPC objection and thus could not be relied on, it was important to realise that there was no description of separate embodiments, so it was inappropriate to submit two independent claims in respect of these aspects which were present (albeit incorrectly) in the granted claims;

(iv) amendment of just one independent claim was all that was occasioned by the grounds of opposition. Either claim 1 and 5, or claim 1 and claim 7, each as granted, should have been combined as one single independent claim, with the other claim made dependent;

(v) merely drafting dependent claims in the form "according to any preceding claim", while perhaps providing a theoretical basis for an amendment having two independent claims, was not in practice sufficient unless there was also a substantive basis in the description for such claims;

(vi) it was evident that Rule 57a EPC could operate to prevent a request with simply "any number" of independent claims being used after grant;

(vii) decision T 223/97 (not reported in OJ EPO), referred to by the proprietor, did not show that it was permissible to select feature combinations arbitrarily so as to arrive at independent claims.

Rule 29(2) EPC

Opponent II agreed with and adopted the submissions of Opponent I.

Claim 8 and remittal

(i) There was no reason *not* to send the case back to first instance.

(ii) The decision under appeal did not deal with claim 8, so there had been no reason for the opponents to provide grounds attacking it in their replies to the proprietor's grounds of appeal.

(iii) The appeal procedure exists to examine the decision under appeal, and the validity of claim 8 was not part of that decision.

(iv) An attack on claim 8 was made in Opponent II's own grounds of appeal filed on 25 May 2005, where the opening paragraph referred to all matters brought forward in the first instance.

(v) A request to remit the case in the light of claim 8 was made with letter of 25 May 2007 in response to the Board's request for comments on this issue.

(vi) In any event, the Board had an obligation *ex officio* to examine claim 8. Where an amendment is made to a granted patent the Board has a duty to check for formal deficiencies and such matters as compliance with Article 84 EPC at least. In this case a problem existed under Article 84 EPC as already mentioned, because the combination of granted claims 1 and 7 was not one which clearly arose from the application, and thus lacked support.

Amendments to the description

The amendments made to the description to adapt it to the allowable claims were not adequate because:

(i) the description should state that the invention did not concern robot arms, as had been admitted to be the case by the patentee;

(ii) an object of the invention needed to be stated for independent claim 8. This was missing.

Written request

The minutes of the oral proceedings should record the declaration of the proprietor's representative about the extent of claim 1 of the patent as maintained.

XIV. Opponent III argued essentially as follows:

Inventive step

D1 disclosed ...

Rule 57a EPC

Opponent III did not file a reply to the proprietor's appeal and made no submissions on this issue during oral proceedings.

Rule 29(2) EPC

Opponent III agreed with and adopted the submissions of Opponent I.

Claim 8 and remittal

(i) The proprietor had brought no new arguments forward in relation to claim 8 and had not substantiated why it was either novel or inventive. Opponent III as a respondent had no case to meet.

(ii) Claim 8 had not been examined, and could contain all manner of errors and be open to many different objections.

In any event, the Board had an obligation *ex officio* to examine claim 8:

(i) If it did not examine the claim it meant that the Board was implicitly deciding that the claim was allowable;

(ii) The legal situation was that the Board was reviewing the first-instance decision. If it pronounced claim 8 and all the claims dependent on it allowable, it would be acting beyond a mere review of that decision, and thus outside its proper ambit.

(iii) Claim 8 was first put forward in the opposition proceedings and it was not examined because of other defects. As a matter of course it should now be sent back for further examination, just as a claim which was previously considered to lack novelty would be sent back for consideration of inventive step.

(iv) Formal administrative rules of procedure such as the RPBA could not outweigh the substantive requirement to examine a claim.

Amendments to the description

The amendments made to the description to adapt it to the allowable claims were not adequate, because there were many different problems stated in the description and it was unclear which problem related to claim 8. Not least in this regard, the requirements of Rule 27(1)(c) EPC were not fulfilled.

Written request

The newly adapted description should contain the matters referred to in the request filed during the oral proceedings. Also, the minutes should record what the representative of the proprietor had said about the extent of claim 1 of the main request.

XV. The proprietor argued essentially as follows:

Novelty

...

Inventive step

...

Rule 57a EPC

(i) The purpose of opposition proceedings was to enable an opponent to have protection removed from the patent to which the proprietor was not entitled (G 1/91, point 4.2). When the patent was granted, the proprietor became entitled to both claims 1 and 5, and claims 1 and 7. This protection should not be taken away merely because claim 1 as granted lacked novelty.

(ii) No possibility existed in opposition proceedings for the proprietor to file a divisional application.

(iii) Rule 57a EPC was merely a procedural provision and could not undermine the basic right of a proprietor to file amendments to maintain rights to which it was entitled.

(iv) Although decisions T 610/95, T 223/97 and T 181/02 (none reported in OJ EPO) were all relevant, they were not decisive for all opposition cases but merely provided examples of where more than one independent claim could be used.

(v) The amendment here was occasioned by the ground of opposition. A limitation was being made and nothing new was being protected as compared to the granted patent.

(vi) The Guidelines for Examination, C-IV, 5.3, do not state that a specific description of an embodiment is a requirement for such an amendment. The claims themselves disclose various embodiments and anyway there is an embodiment covered by the claims, which thus corresponds to the Guidelines.

(vii) The Opposition Division wrongly construed the Guidelines.

(viii) The Board in T 937/00 (not reported in OJ EPO) saw no objection in principle to using several independent claims. With reference to what was said in that case:

(a) the two independent claims here were not filed late in the proceedings, but as the first response to the oppositions;

- (b) there was not a large number of independent claims in the present case, only two;
- (c) the present proceedings had not been prolonged by the filing of these claims.

(ix) As regards claim 5 and claim 7 covering independent embodiments and resulting from claims which were not separately dependent on claim 1 in the filed application and, as alleged by the opponents, not being described separately, this was an objection under Article 100(c) EPC, which was not raised with the grounds of opposition nor at any occasion in the first instance proceedings. Since no consent had been given by the proprietor, it could not be raised now.

(x) In as far as the opponents were objecting under Article 84 EPC, then in accordance with T 367/96 (not reported in OJ EPO) this could not be raised now, since these were granted claims which were merely being combined. The subject-matter was unchanged.

Rule 29(2) EPC

(i) By its very wording Rule 29(2) EPC was not applicable to patents, only to applications.

(ii) According to the Opposition Division (see the minutes of oral proceedings, paragraph 2.2) it was Office practice to apply Rule 29(2) EPC in opposition proceedings. However, Part D of the Guidelines for Examination said nothing about Rule 29(2) EPC. How then could it be Office practice to do something if it was not in the Guidelines?

(iii) Apart from decision T 991/02 there was no case law touching on the application of Rule 29(2) EPC in opposition proceedings, and T 991/02 did not even decide whether it did or did not apply.

(iv) Rule 61a EPC did not mean that all the Rules of Part III of Chapter II of the Implementing Regulations applied to granted patents.

(v) The explanatory notes on the introduction of the amended version of Rule 29(2) EPC, published in the OJ EPO 2002, 112, refer only to the "applicant", not the proprietor. The rule is clearly meant only to apply in the case of applications.

(vi) The amended version of Rule 29(2) EPC states that it is without prejudice to Article 82 EPC. It would make no sense if the rule applied to patents because Article 82 EPC only applies in the case of applications.

(vii) It is not possible to file a divisional application during opposition proceedings. This would make it unfair to apply Rule 29(2) EPC during opposition proceedings.

(viii) G 1/91 explains that Rule 29 EPC is merely a procedural rule.

(ix) Rule 61a EPC refers to "documents" but Rule 29(2) EPC relates to claims, not documents.

(x) If the real problem was the introduction of too many claims, Article 84 EPC would be the ground of objection.

(xi) Although in G1/91, point 3.4, the Enlarged Board gave Rule 29 as an example of one of the rules applicable by virtue of Rule 61a, there were provisions of Rule 29 other than Rule 29(2) that could be of application in opposition proceedings.

Claim 8 and remittal

(i) The opponents had had four months to respond to the proprietor's appeal. The opponents who had filed a response, did not attack claim 8 in any way apart from by relying on Rules 57a and 29(2) EPC. The complete case in response to the proprietor's appeal (see Rules of Procedure of the Boards of Appeal, Article 10a(2)) did not include any substantive attacks on claim 8.

(ii) The proprietor was entitled to assume that substantive arguments against claim 8 were no longer being made.

(iii) It would be an abuse of proceedings to challenge claim 8 now, and thus open up the possibility of renewed searches and attacks even on claim 1. This would be entirely unfair to the proprietor.

(iv) The request for remittal from e.g. Opponent II in regard to claim 8 did not arrive in the four-month period required to state its full case. The opponents were silent about the point until the Board raised the issue. Opponent II first made its request for remittal on 25 May 2007, two years outside the date for stating its full case.

(v) No justification existed for asking for remittal at this late stage - this was a late-filed request without justification or *prima facie* case of non-allowability of the claim. The facts of the proprietor's case had not changed throughout the proceedings. The Rules of Procedure must be adhered to by the Board.

(vi) The proprietor did not need to file arguments in support of the substantive allowability of claims of its main request, which was in any event a request made in the first-instance proceedings.

As to whether the Board should examine claim 8 *ex officio*:

(i) This would prolong proceedings unnecessarily.

(ii) It would result possibly in a further appeal if the case was remitted following such examination, and thus a further delay. This did not serve the interests of the parties, the EPO or the public.

(iii) Claim 8 was not *prima facie* non-allowable under Articles 84 and 123 EPC, as it was a combination of granted claims. Examination of novelty and inventive step would require embarking on an entirely fresh case. This could not be considered as a *prima facie* case of non-allowability because the opponents had presented no arguments at all, not even in response to the Board's provisional opinion where the issue of remittal was mentioned.

(iv) The legal and factual framework of the appeal was limited by the grounds of appeal and the requests of the parties. This was clear from G 9/91 and G 10/91 (OJ EPO 1993, 408, 420), which decisions also required a *prima facie* case of non-allowability for such an examination. Opening a fresh case *ex officio* would be going beyond the judicial task of the Board to examine the first-instance decision.

Amendments to the description

As to the amendments made to the description to adapt it to the allowable claims:

(i) The requirements of Rule 27(1)(b) EPC were met, since it merely required disclosure of the background art in so far as it could be regarded as "useful" for understanding the invention. In regard to claim 8, this had many features of claim 1, so the reference to D1 also sufficed here.

(ii) The requirements of Rule 27(1)(c) EPC were met, since the invention was disclosed in such terms that the problem and its solution could be understood.

The written requests of Opponents II and III

There was no basis for fulfilling such requests. The proprietor denied having stated what was requested; the written requests of the opponents should simply be refused, as they were anyway not relevant to the decision.

Reasons for the decision

1. The appeals are admissible.

2. *Novelty*

...

Thus, the subject-matter of claim 1 is novel with respect to the cited prior art and consequently the requirements of Article 54(1) EPC are met.

3. *Inventive step*

3.1 D1 has been used by all the parties as the closest prior art starting point for assessing inventive step. The Board agrees with this view, as D1 discloses the same type of device used for the same purpose as in the patent.

In regard to the only novel feature of claim 1 in relation to D1 ...

3.6 In respect of the cited prior art and the evidence brought forward by the opponents, the Board concludes that the subject-matter of claim 1 involves an inventive step and that the requirements of Article 56 EPC are fulfilled.

4. *Rule 57a EPC*

4.1 The Opposition Division rejected the proprietor's main request, which for present purposes can be taken as the same as the main request on the proprietor's appeal, first, because the amended claims according to the request did not comply with Rule 57a EPC. This rule states:

"Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Article 100, even if the respective ground has not been invoked by the opponent."

4.2 The Opposition Division accepted that claim 1 of the main request (and its dependent claims 2 to 7), by virtue of the incorporation of the restricting features of granted claim 5, constituted a valid amendment in response to the lack of novelty objection to granted claim 1. It held, however, that independent claim 8 of the main request (and its dependent claims 9 to 14) did not constitute a valid amendment according to Rule 57a EPC. The Opposition

Division first posed the question whether the ground for opposition "required further amendments to the claims, in particular the submission of a new independent claim." The Opposition Division then noted that granted claim 1 did not cover multiple specific embodiments, because the description referred to only one embodiment. Since all the granted claims concerned only this single embodiment, the ground of opposition required only that the subject matter for which protection was sought be defined in more restrictive terms. The Opposition Division considered that amended claim 8 of the main request represented another definition of the invention, derived from the same single embodiment, and was therefore superfluous by way of a response to the ground of opposition. Reference was made to the Guidelines for Examination Part D, Chapter IV, paragraph 5.3, the section dealing with Rule 57a. The relevant passage states:

"The mere addition of new claims to the claims as granted is inadmissible because such amendments cannot be said to meet a ground of opposition. However, the replacement of one independent claim as granted by multiple, e.g. two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted is admissible if such a replacement is occasioned by grounds of opposition specified in Art. 100 (T 223/97, not published)."

4.3 The Opposition Division concluded that the statement in the second sentence of the Guidelines did not apply in the present case because granted claims 5 and 7 (whose features were incorporated into amended claims 1 and 8 respectively) were not directed to specific embodiments but merely represented different aspects of the one embodiment, these aspects being already covered by amended claim 7.

4.4 The Board cannot agree with the Opposition Division's conclusions or with the arguments of the opponents. It is helpful to spell out the scheme of the various claims, omitting dependent claims which are irrelevant for present purposes, and starting with the granted claims:

- Claim 1: an apparatus comprising certain features.
- Claim 5: an apparatus according to claim 1, containing the further feature X.
- Claim 7: an apparatus according to claim 1 or claim 5, containing the further feature Y.

Granted claim 7 therefore in fact defines two areas of subject-matter (which will be categorised here as claims 7(a) and (b)):

- Claim 7(a): an apparatus according to claim 1, containing the further feature Y, but not the feature X.
- Claim 7(b): an apparatus according to claim 1, containing both the further features X and Y.

The amended claims of the main request are then in the following form:

- Claim 1: an apparatus according to granted claim 1, containing the further feature X.
- Claim 8: an apparatus according to granted claim 1, containing the further feature Y.

4.5 The first point to note is that amended claim 8 cannot be regarded as wholly superfluous to amended claim 1, as suggested by the Opposition Division. This is because amended claim 1 does not define subject-matter containing the feature Y and therefore does not claim protection for subject-matter containing the feature Y but not X. It is true that there is a degree of superfluity or potential overlap between amended claims 1 and 8. However, this element of superfluity or overlap was already present in granted claims 5 and 7. The amendment therefore did not introduce this element of superfluity: it was already present.

4.6 Moreover, and more importantly, since the granted claims did define subject-matter which contained the feature Y (i.e., granted claim 7(a)), the effect of Rule 57a EPC, if the Opposition Division was correct about its application, would be to force the proprietor to abandon a potentially valid claim (i.e. granted claim 7). The actual result of the Opposition Division's decision also seems to turn on the fortuitous ordering of the claims: if the order of amended claims 1 and 8 had been reversed, what was claim 8 (now claim 1) would presumably have been accepted as a valid response to the novelty objection, but what was claim 1 (now claim 8) would have been rejected.

4.7 The thrust of the Opposition Division's objection to the form of the amended claims appears to have been directed at the fact that amended claim 8 is an additional independent claim, whereas the granted claims contained no such additional independent claim. In decision T 223/97, on which the passage from the Guidelines for Examination referred to above is based, it is said that where a claim covers two "specific" embodiments, the proprietor can restrict himself to independent claims to these two embodiments (see page 9, first main paragraph: "Si la revendication 1 couvre ... deux modes particuliers de réalisation, le titulaire du brevet peut, pour répondre au défaut de brevetabilité, se restreindre à ces deux modes de réalisation et, par suite, déposer deux revendications indépendantes protégeant chacune l'un de ceux deux modes de réalisation."). However, this does not mean that it is only in such a case that more than one independent claim can be used. In decision T 937/00, for example, the Board observed that there is no objection in principle to a patentee amending its claims so as to comprise several independent claims directed to different objects originally covered by a single generic claim, where this was done in response to a ground of opposition. This is because, as established by the Enlarged Board of Appeal in decision G 1/91 (op. cit.), unity of invention does not come under the requirements which a European patent must meet when the patent is maintained in amended form. In decision T 181/02, citing T 223/97, the Board observed it was only in "exceptional cases" that the replacement of a granted single independent claim by two or more independent claims would be occasioned by a ground for opposition, and gave the example of a case where a granted independent claim covers two specific embodiments. However, the Board then went on to observe (paragraph 3.2) that a situation in which the introduction of two independent claims would be appropriate might also arise:

"... if two granted dependent claims (e.g. claims 2 and 3) are linked in parallel to a single independent claim (e.g. claim 1). Then, of course, the filing of two independent claims (e.g. including the features of claims 1 and 2, and 1 and 3) may be possible."

That is almost precisely the position here.

4.8 The Board does not need to decide whether it is only in "exceptional cases" that the replacement of a granted single independent claim by two or more independent claims will be occasioned by a ground for opposition. What these cases do show, however, is that every case must turn on its own facts. What is important to consider in each case are the granted claims themselves and to ask whether the proposed amendments are an appropriate and necessary response to try and avoid revocation of the patent, in the sense that they can fairly be said to be occasioned by grounds for opposition: see decisions T 295/87, paragraph 3 (OJ EPO, 1990, 470) and T 610/95, paragraph 2.1 (not reported in OJ EPO). The Board considers that this is the case here. An amendment was necessary to deal with the lack of novelty attack on granted claim 1. The particular form of the amendments was appropriately framed as a response to this attack: the amendments derive from a combination of the claim under attack (claim 1) with other granted claims (claims 5 and 7), a form of amendment which is usually the most appropriate and the least likely to give rise to difficulties (see, e.g., decision T 610/95, point 2.1, final paragraph, and point 2.2(e), the paragraph bridging pages 19 and 20). Indeed, given that the proprietor is no longer able to file a divisional application, the Board considers that the proprietor could not have framed a set of amended, dependent claims without giving up protected subject-matter which was not the target of this particular lack of novelty attack. For example, if amended claim 8 had been framed to be dependent on amended claim 1, protection for subject matter which had feature Y but not feature X would have been abandoned. Effectively, the logical conclusion of the arguments of the Opposition Division and the opponents is that a blanketing limiting feature must be introduced into the claims, presumably taken from the description, on which granted claims 5 and 7 could each then be made dependent. However, no suggestion was made as to what this feature might be in the present case and the Board has not considered whether such a feature exists. In many cases, of course, it will not.

4.9 Opponent II also argued that the use of two independent claims was an unallowable extension of the content of the filed application, there being no disclosure of such independent solutions. However, this is an Article 123(2) EPC objection, and the proprietor did not agree to the introduction of this ground.

4.10 Opponent II further argued that technically different solutions were being claimed to different problems and that if this were followed to its limit, a set of claims with many independent claims could result. It is true that if the number of independent claims were increased to a large number, this might become objectionable under Article 84 EPC, both from the viewpoint of clarity and conciseness, and might also unduly complicate and delay the opposition procedure. In such a case, it would need to be carefully considered whether the amendment was a necessary and appropriate response to a ground of opposition. See decision T 937/00, point 2.2. However, this problem does not arise in the present case: only two independent claims have been introduced; the amendments were filed early on in the opposition proceedings, and the opponents had already filed documents and arguments as part of their objections to granted claims 1, 5 and 7.

4.11 The Board therefore concludes that the amendments contained in the proprietor's main request are a necessary and appropriate response to try and avoid revocation of the patent, in the sense that they can fairly be said to be occasioned by grounds for opposition, and that Rule 57a EPC does not prohibit these amendments.

5. Rule 29(2) and Article 84 EPC

5.1 The Opposition Division held that Rule 29(2) EPC applied in opposition proceedings and that amended claim 8 of the main request did not comply with this rule, so that for this reason also the patent could not be maintained on the basis of the main request. According to the minutes of the oral proceedings (see paragraph 2.2), it is "Office practice" to apply Rule 29(2) EPC in opposition proceedings. It is not disputed that if the amended form of Rule 29(2) EPC (see below) applies in this case, the amendments according to claim 8 of the main request are not allowable.

5.2 Rule 29(2) EPC, in its original form, provided as follows:

"(2) Subject to Article 82, a European patent application may contain two or more independent claims in the same category (product, process, apparatus or use) where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim."

Rule 29(2) EPC, in the form amended by the decision of the Administrative Council of 2 January 2002 (OJ EPO 2002, 2), provides as follows:

"(2) Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

- (a) a plurality of inter-related products;
- (b) different uses of a product or apparatus;
- (c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim."

5.3 The Opposition Division applied the amended form of the rule in its decision but, for reasons which are set out in paragraphs 5.16 to 5.18, it is not necessary to decide whether this was correct.

5.4 The Opposition Division referred to Rule 61a EPC, which provides that "Part III, Chapter II, of the Implementing Regulations shall apply *mutatis mutandis* to documents filed in opposition proceedings." Chapter II of Part III of the Implementing Regulations is headed "Provisions governing the application" and consists of Rules 26 to 36 EPC. The Opposition Division held that it was clear that all the requirements set out in Chapter II, including those of Rule 29(2), although formulated by reference to and directed to "applications", also applied to all documents filed in opposition proceedings. In opposition proceedings, the passage in Rule 29(2) stating that "... a European patent application may contain more than one independent claim in the same category (product, process, apparatus or

use) only if ..." should therefore be read "... the patent in amended form may contain more than one independent claim in the same category (product, process, apparatus or use) only if ...". In the view of the Opposition Division, the decision of the Enlarged Board of Appeal in G 1/91 (OJ EPO 1992, 253) did not alter this conclusion.

5.5 The Board cannot agree with this conclusion of the Opposition Division or the arguments of the opponents. The Board considers that Rule 29(2) EPC, whether in its original form or in the form amended on 2 January 2002, does not apply in the circumstances of this case.

5.6 Looking first at decisions of Boards of Appeal of which this Board is aware and which might help on this issue:

(i) In decision T 991/02 (not reported in OJ EPO), the Board of Appeal was concerned with an appeal from a decision of the Opposition Division by which the proprietor's main request had been rejected on the grounds that the amended claims did not comply with Rule 29(2) EPC in its amended form. The Board concluded that the Opposition Division had been wrong to apply the amended version of the rule since, by virtue of the relevant transitional provisions (see Decision of the Administrative Council of 13 December 2001, Article 2, EPO OJ 2002, 2), the amended version did not apply to those particular proceedings. The Board therefore held that the decision had no legal basis and remitted the case to the Opposition Division. The Board did not consider the threshold question of whether Rule 29(2) EPC in either form applied to the amended claims in question, and so the present Board cannot derive any assistance from the decision.

(ii) In decision T 1416/04, the present Board, in a different composition, decided that the provisions of the relevant version of the rule, assuming that Rule 29(2) did apply in opposition proceedings, would be met. The Board did not therefore need to decide the threshold question concerning the application of the rule in opposition proceedings.

Neither of these cases therefore helps the Board, one way or the other.

5.7 Turning to the arguments of the opponents and the reasons of the Opposition Division for its decision, Rule 29(2) is expressed to be concerned with claims which may be contained in a patent "application", whereas Rules 29(1) and 29(3) - (6) deal generally with what claims should contain (Rule 29(7) also expressly refers to a patent "application"). Although this might be taken as limiting the application of Rule 29(2) to proceedings before grant, the Board can nevertheless accept that this difference in wording does not necessarily mean that the rule does not apply in opposition proceedings. This follows having regard both to the history of the rule (discussed below - see especially paragraphs 5.12 and 5.13) and the use of words "mutatis mutandis" in Rule 61a EPC ("entsprechend" in the German version of the rule - the French version is silent on the point). Again, given the history of the rule, the Board cannot draw any definite conclusions about its applicability from the fact that it is prefaced by the words "Without prejudice to Article 82 ..."

5.8 The effect of Rule 61a EPC was considered by the Enlarged Board of Appeal in decision G 1/91 (op. cit.). The Enlarged Board was concerned with the question whether the requirement of unity of invention under Article 82 EPC was one of the requirements which a European patent and the invention to which it relates must meet when the patent is maintained in amended form during opposition proceedings. In particular, although lack of unity is not a ground of opposition, did Rule 61a EPC make Rules 27, 29 and 30 EPC applicable, such that the requirement of unity of invention demanded by Article 82 EPC came under the "requirements of this Convention" mentioned in Article 102(3) EPC which the patent maintained in amended form must meet?

5.9 The current Board extracts the following points from the Enlarged Board's decision in G 1/91 (op. cit.):

(i) Although Rule 61a EPC states that Part III, Chapter II of the Implementing Regulations (ie, Rules 26 - 36) is to apply *mutatis mutandis* to documents filed in opposition proceedings, the reference to Chapter II is only a general one and Rule 61a can only be taken to refer "to those requirements which it would still be reasonable to demand of the new documents relating to the amended patent" (paragraph 3.2).

(ii) Further, Rule 61a refers only to "documents", and so cannot be applicable to those rules within Chapter II that do not relate to documents. Rule 30, which relates specifically to the requirement of unity, is not such a rule. Therefore, despite the general reference in Rule 61a EPC to Chapter II, Rule 61a is clearly not intended to apply to Rule 30 and certain other rules (such as Rules 26, 31 and 33) but only to others (such as Rules 27, 29, 32 and 34). As the Enlarged Board pointed out, the committee responsible for framing Rule 61a EPC had considered it to be too complicated to single out individually the rules to which Rule 61a applied and had therefore drafted a general reference only.

(iii) Rule 61a EPC makes it "clear that the requirements laid down in Rules 26 to 36 EPC for patent applications *must* also apply *mutatis mutandis* to *documents* filed in opposition proceedings." (paragraph 3.5, emphasis added by the present Board).

(iv) So far as concerns the purpose of Article 82 EPC, it is merely an administrative regulation, whose purposes are fulfilled once the patent is granted. Lack of unity in the application does not by itself rule out the conferring of patent protection, since the requirements of Article 82 EPC can be overcome by the filing of a divisional application. In contrast, the purpose of opposition proceedings is to enable a party to oppose unjustified protective rights. There is no reason to give an opponent the opportunity to contest a patent on the grounds of lack of unity. It is therefore neither necessary nor appropriate to attach importance to lack of unity at the stage of opposition proceedings.

(v) For as long as unity under Article 82 EPC remains a requirement to be met there must also exist the possibility for the party concerned to establish that unity. Where this can no longer be done by means of a divisional application, lack of unity is of no further legal significance. The lack of the ability to file a divisional application during opposition proceedings therefore makes it clear that lack of unity no longer has any relevance at this stage.

5.10 Although the Enlarged Board gave Rule 29 EPC as an example of one of the rules to which Rule 61a EPC was intended to apply, the Enlarged Board did not consider Rule 29(2) EPC specifically, either in its original or its amended form, and the present Board considers that it cannot be regarded as part of the *ratio decidendi* of the Enlarged Board's decision that Rule 29(2) EPC always applies in opposition proceedings. Indeed, it is clear to the Board that for the reasons which are given below (paragraph 5.16) it cannot have been the intention of the Enlarged Board to lay down a principle that Rule 29(2) EPC applies in all circumstances in opposition proceedings. In the English translation of the decision, quoted above, it is true that the Enlarged Board said that Rule 61a EPC made it "clear that the requirements laid down in Rules 26 to 36 EPC for patent applications *must* also apply *mutatis mutandis* to *documents* filed in opposition proceedings" (paragraph 3.5, emphasis added by the present Board). In the German text, which was the language of the proceedings, the equivalent passage states: "Mit der nachträglich in die Ausführungsordnung eingefügten Regel 61a EPÜ wird also klargelegt, daß die in den Regeln 26 bis 36 EPÜ für Patentanmeldungen aufgestellten Erfordernisse auch auf die im Einspruchsverfahren eingereichten Unterlagen "entsprechend" ("mutatis mutandis") anzuwenden sind. Irgendeine Schlußfolgerung für die Beantwortung der hinsichtlich der Einheitlichkeit gestellten Rechtsfrage kann aber aus Regel 61a EPÜ nicht gewonnen werden." The present Board understands this passage to use the expressions "entsprechend" and "mutatis mutandis" in a rather broader sense than the English translation implies, suggesting that rules which cannot be adapted in a way which is appropriate for opposition proceedings, or which would lead to an inappropriate result in opposition proceedings, are not to be applied. This reading is more consistent with the earlier statement of the Enlarged Board at paragraph 3.2 that the reference in Rule 61a EPC was only a reference in general terms and the Rule could only be taken to refer "to those requirements which it would still be reasonable to demand of the new *documents* relating to the amended patent" (emphasis added by the Board). In any event, a decision of the Enlarged Board is only binding on the Board of Appeal in respect of the appeal in question (Article 112(3) EPC). Although the Board is bound under Article 16 RPBA to refer a question to the Enlarged Board if it considers it necessary to deviate from an interpretation or explanation of the Convention contained in an earlier opinion or decision of the Enlarged Board, the present Board

does not consider that this is the case here, since the Enlarged Board did not specifically consider Rule 29(2) EPC or its application in circumstances such as the present. Moreover, the Enlarged Board was not concerned with the text of the amended version of Rule 29(2) EPC, which only entered into force on 2 January 2002 and thus long after the Enlarged Board's decision. Finally, there are other provisions of Rule 29 EPC which may well apply in opposition proceedings (e.g., Rules 29(1), (3) - (7)), and to which the statement of the Enlarged Board may be applicable.

5.11 Turning to the question of the possible application of Rule 29(2) EPC in the present case, the Board, following G 1/91, considers that the question to be asked is whether, assuming but without deciding that the contents of an amended claim constitute a "document" within the meaning of Rule 61a EPC, it would still be reasonable to demand of the amended claims that they comply with Rule 29(2) EPC.

5.12 As to this question, it is first helpful to consider the purpose of Rule 29(2) EPC. It formed part of the original version of the Implementing Regulations. When these regulations first came into force, Rule 61a had not yet of course been introduced (only coming into force on 1 February 1978 (OJ EPO 1978, 12)), so that Rule 29(2) was therefore at first only of express application before grant, and not in opposition proceedings. The *travaux préparatoires* for the Implementing Regulations make it clear that:

(a) What became Rule 29(2) was originally seen as an adjunct to what became Article 82, and thus was seen as having a possible overlap with Article 82 EPC and thus with the issue of unity. Indeed this relationship can still be seen in the opening words of the Rule: "Without prejudice to Article 82 ...".

(ii) The Rule was introduced so as to place a limitation on the use of independent claims in the same category. (See the Minutes of the 4th Meeting of the Inter-Governmental Conference for the Setting up of a European System for the Grant of Patents, Luxembourg, 20 to 28 April 1971.)

5.13 This indicates that the original form of Rule 29(2) EPC was concerned only with a perceived procedural and practical need to limit the number of independent claims, not out of any regard for the substantive patentability of the claims themselves.

5.14 This underlying purpose of Rule 29(2) EPC was confirmed when it came to be amended in 2002 following a proposal from the President of the EPO (CA/128/01 Rev. 2). This proposal first noted that during examination and opposition proceedings, the amount of work required was highly dependent on the number of independent claims in the application or patent. A large number of such claims in the granted patent made it difficult for third parties and national judges to determine the scope of protection conferred by the patent. Further, so far as concerned applications, the proportion of applications with an excessive number of independent claims, in the sense that they did not comply with the requirements of the EPC regarding the drafting of claims (i.e., Articles 82 and 84 EPC), had been continuously increasing. Although the substantive examiner had the power to insist on a limitation of the number of independent claims in an application by a strict application of Articles 82 and 84 EPC, he was required to give detailed reasons demonstrating that the objections were a direct consequence of the presence of excessive independent definitions of the subject-matter for which protection was sought. A considerable increase of procedural efficiency could therefore be achieved if the examiner had at his disposal a requirement imposing a clear limitation on the number of independent claims. The proposed amendment to Rule 29(2), which was duly adopted by the decision of the Administrative Council of 13 December 2001 (OJ EPO 2002, 2 ff), was intended to achieve this effect.

5.15 The above confirms that Rule 29(2) EPC is a purely administrative provision, designed to help ensure that applications which contravene Articles 82 and 84 EPC can be refused with procedural economy. The framers of the amended rule do not appear to have considered that it had any role to play in opposition proceedings.

5.16 As to whether Rule 29(2) EPC in fact has any role to play in opposition proceedings, the Board considers, first, that the rule, certainly in its amended form, cannot apply across the board to all amendments in opposition proceedings. This is because, if it did so, it would not be permissible to make an amendment by which non-unitary claims were introduced, something that is not merely permissible in opposition proceedings but which can clearly be

appropriate given that the proprietor is no longer able to file a divisional application (G 1/91, and paragraph 5.8, above). Indeed, to conclude that Rule 29(2) applied across the board in opposition proceedings would drive a coach and horses through G 1/91. This can be seen by looking at what the position would be if the amended version of Rule 29(2) EPC did apply in opposition proceedings. Taking the example of apparatus claims, with which the Board is concerned in the present case, Rule 29(2) EPC would not permit an amendment whereby two independent apparatus claims were newly introduced unless the claims involved either: (i) a plurality of inter-related products, or (ii) alternative solutions to a particular problem, it not being appropriate to cover these alternatives by a single claim. Taking the case of a non-unitary amendment, i.e. one by which there was newly claimed more than one invention, or a group of inventions not linked so as to form a single general inventive concept (Article 82 EPC), such claims would clearly not necessarily involve either (i) a plurality of inter-related products or (ii) alternative solutions to a particular problem, such that it was appropriate to cover these alternatives by a single claim. It follows that Rule 29(2) EPC in its amended form, if it applied in opposition proceedings, would prevent at least some if not most amendments whereby non-unitary claims were introduced.

5.17 The position with regard to the original version of Rule 29(2) EPC and the introduction of non-unitary claims is inconclusive. If this version of the rule did apply in opposition proceedings, it would only prevent an amendment being made by which two independent claims in the same category were newly made where it would be appropriate, having regard to the subject-matter of the amended claims, to cover this subject-matter by a single claim, rather than two claims. In the case of newly introduced non-unitary claims by way of a necessary and appropriate amendment in response to grounds of opposition, it would seemingly never be appropriate to cover this subject-matter by a single claim. Thus the original version of Rule 29(2) EPC would not prevent such an amendment.

5.18 There are also other circumstances in which the Board considers it would not be reasonable to demand of amended claims that they comply with Rule 29(2) EPC, of which the present case is an example. Thus, whether or not the amended claims according to the main request in the present case are non-unitary within the meaning of Article 82 EPC, they nevertheless constitute a necessary and appropriate response to try and avoid revocation of the patent, as has already been decided by the Board in relation to the issue under Rule 57a EPC. Because the proprietor can no longer file a divisional application, the Board considers that it would not be reasonable to demand of these claims that they comply with the purely administrative provisions of Rule 29(2) EPC in its amended version, and thus force the proprietor to abandon claims which are potentially valid. So far as concerns the original version of Rule 29(2) EPC, again, the rule would not prevent the amendment in the present case.

5.19 Going beyond these two types of cases, the Board cannot at present envisage any circumstances in opposition proceedings in which Rule 29(2) EPC, in whichever version, would be of any application. This is because once an amendment to the claims has been established to be necessary and appropriate having regard to grounds of opposition, it seems to the Board that it would inevitably be unreasonable to impose the additional requirement that the amendment complies with the purely administrative provisions of Rule 29(2) EPC. There will also be no reason to impose Rule 29(2) as a further limitation on Rule 57a EPC. Thus, the requirements of Article 82 EPC, in respect of which Rule 29(2) EPC was partly intended to help examiners, are irrelevant in opposition proceedings. As to Article 84 EPC, if the amendment is not clear and/or concise it will in any event be rejected as contravening this article (see G 1/91, paragraph 5.2). There will be no need in such a case to fall back on Rule 29(2) for reasons of procedural economy, as in the case of an amended application: it will already have been decided that the amendment is necessary and appropriate. Again, if the amendment introduces large numbers of independent claims, the amendments are unlikely to be necessary or appropriate having regard to grounds of opposition (see T 937/00), although each case will depend on its own particular circumstances.

5.20 Summing up the present case, the Board has already decided that the amended claims according to the main request in the present case satisfy the requirements of Rule 57a EPC: they are a necessary and appropriate response to a ground of opposition. Not least because the proprietor can no longer file a divisional application, it would also not be reasonable to demand of these claims that they comply with the provisions of Rule 29(2) EPC, at least in its amended version, and so force the proprietor to abandon potentially valid claims. Further, the amendments are clear and concise and thus satisfy Article 84 EPC and in any event are derived from the granted claims. It follows that Rule 29(2) EPC is of no application in relation to the amendments.

6. Description amendments

6.1 Since a disclosure of D1 has now been included in the amended description, the background art useful for understanding the invention of claim 1 is present as required by Rule 27(1)(b) EPC. Due to the large number of similar features between claim 1 and claim 8, the mention of D1 also fulfils the requirements of Rule 27(1)(b) EPC in regard to the invention of claim 8.

6.2 With respect to the opponents' objections under Rule 27(1)(c) EPC that the amended description did not disclose the invention in such terms that the technical problem could be understood, the Board finds that for the invention of claim 1, paragraphs [0020], [0031] and [0032], together with the description of the relevant features in D1, allow the skilled person to understand that the problem being solved is the increase of weld head working volume. For claim 8, the technical problem being solved can be understood by the skilled person from paragraphs [0018], [0024] and [0025], together with the disclosure of D1, as being obtaining improved welding accuracy. The Board consequently finds that the requirements of Rule 27(1)(c) EPC are fulfilled.

6.3 Concerning Opponent II's objection that remarks (allegedly) made by the proprietor in the oral proceedings had not been included in the description, there is no provision in the EPC requiring the inclusion of such matters, and no such provision was cited by Opponent II. The inclusion of such remarks in the description is therefore not required.

7. Remittal

7.1 The background to this issue has already been briefly outlined. Claim 8 of the main request before the Board, which for present purposes can be taken to be in the same form as the main request before the Opposition Division, corresponds to claim 7 as granted. In the notices of opposition, the opponents had each stated as one of their grounds of opposition that claim 7 was not inventive. Following the proprietor's request to maintain the patent in amended form, which had been filed on 4 September 2003, Opponents I, II and III all filed further written arguments, on 4 December 2003, 20 January 2004 and 30 January 2004, respectively, in which the new claim 8 was attacked on substantive grounds. The Opposition Division did not consider the substantive grounds of opposition to the proprietor's main request in its decision, since it rejected the request on the grounds of Rules 57a and 29(2) EPC. The claims according to the proprietor's second auxiliary request, which was allowed, did not contain a claim equivalent to claim 8 of the main request. In its notice of appeal and also its grounds of appeal, the proprietor requested, as its main request, that the decision under appeal be set aside and that the patent be maintained in amended form based on the claims according to the main request before the Opposition Division.

7.2 Opponents I and II filed responses on 14 June and 12 October 2005, respectively, requesting that the proprietor's main request be refused, stating that reliance was placed on the same grounds as those on which the Opposition Division had based its decision, i.e. that independent claims 1 and 8 did not comply with Rules 57a and 29(2) EPC. Opponent I simply referred to the reasons given by the Opposition Division; Opponent II in addition set out its own detailed arguments on these points in response to those of the proprietor. Opponent III did not file any reply to the proprietor's grounds of appeal.

7.3 In its communication to the parties of 13 March 2007, sent after the invitation to oral proceedings, the Board indicated that if the decision under appeal were set aside, remittal of the case to the Opposition Division would need to be considered, since claim 8 of the main request had not been examined. The parties were invited to comment on the issue. Opponent I filed a response on 25 May 2007 dealing *inter alia* with issues raised by the Board in relation to Rule 29(2) EPC and merely concluding with the request that if the Board did not accept its arguments, and considered claim 1 of the main request to be new and inventive, the case be remitted. Opponent II filed a response on 25 May 2007 putting forward arguments on the substantive validity of claim 8 and requesting that the case therefore be remitted. Opponent III did not file a response and did not request remittal during the oral proceedings. In its own response filed on 25 May 2007, the proprietor requested *inter alia* that in the event of the main request being formally allowable and claim 1 or its subject-matter being found to be novel and involving an inventive step, the case should be remitted to the Opposition Division to determine the patentability of claim 8. This request was implicitly withdrawn during the oral proceedings.

7.4 The Board accepts the arguments of the proprietor advanced during oral proceedings that in these circumstances the Board should not, as a matter of discretion, remit the case. Article 10a(1) RPBA states that appeal proceedings are to be based on, *inter alia*, (a) the statement of grounds of appeal, (b) any written reply of the other party or parties (such reply to be filed within four months of the notification of the grounds of appeal), and (c) any communication sent by the Board and answer filed thereto. Further, Article 10a(2) requires that the statement of the grounds of appeal or the reply, as the case may be, contains a party's complete case. These documents are to set out clearly and concisely why the party requests that the decision under appeal be reversed, amended, or upheld, as the case may be. The documents are also to specify expressly all the facts, arguments and evidence relied on. It is these facts and requests which the Board is required to take into account when deciding the appeal (Article 10a(4)). Extension of these time limits may exceptionally be allowed in the Board's discretion where a reasoned request is made (Article 10a(5)) and, as referred to in more detail below, the Board also has a discretion to admit and consider amendments to a party's case. These rules are binding on the Boards of Appeal, provided that they do not lead to a situation which would be incompatible with the spirit and purpose of the EPC (Article 18 RPBA).

7.5 The relevant part of the present appeal proceedings (i.e., the proprietor's appeal against the decision of the Opposition Division refusing its main request) is therefore to be based upon the proprietor's grounds of appeal and the replies of the opponents filed within four months of notification of the proprietor's grounds of appeal. Opponents I and II made it clear in their respective replies that they opposed the proprietor's appeal and wished this part of the decision to be upheld. The reasons given by Opponents I and II for these requests were stated to be that the Opposition Division's reasoning on the Rule 57a and 29(2) EPC issues was correct. Arguments as to why this was so were provided to a greater or lesser degree. None of these opponents gave as a reason why the decision should be upheld the fact that claim 8 was not inventive, and no facts, arguments or evidence were specified which might have supported such a case. None of the opponents requested remittal of the case.

7.6 In its letter of 25 May 2007, Opponent II for the first time in the appeal proceedings provided facts and arguments against the substantive validity of claim 8, these essentially being the same as in its opposition grounds and subsequent written submissions, and, together with Opponent I, requested remittal. During the course of oral proceedings, Opponents I and II in effect applied to amend their case by introducing these facts and arguments in support of their request for remittal of the case.

7.7 A Board of Appeal may at its discretion admit an amendment to a party's case after it has filed its grounds of appeal or reply, such discretion to be exercised taking into account *inter alia* the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy (Article 10b(1) RPBA). Such amendments are not to be admitted if they are sought to be made after oral proceedings have been arranged and they raise issues which the Board or the other party or parties (here, in particular, the proprietor) cannot reasonably be expected to deal with without adjournment of the oral proceedings (Article 10b(3) RPBA).

7.8 The requests by Opponents I and II to introduce facts and arguments by way of amendments to their cases were not just made after oral proceedings had been arranged, but during the oral proceedings themselves, i.e., at the very last stage possible. In one sense, of course, the facts and arguments were not entirely new, since some of these matters had been raised in the opposition proceedings, as set out above. Again, it is the case that Opponent II had raised these matters in its letter filed on 25 May 2007, i.e. almost five weeks before the oral proceedings. This was only done, however, in response to the Board's invitation to the parties to comment on the question of possible remittal; the Board had not invited the parties to amend their cases in the appeal or to file new facts and arguments in relation to issues of substantive validity of the claims.

7.9 With regard to such an amendment and the above provisions of the Rules of Procedure of the Boards of Appeal:

(a) *Article 10b(1) RPBA*: (a) the new subject-matter which is sought to be introduced, i.e. the grounds for the attack on claim 8, is reasonably complex or, at least, not straightforward; (b) the amendment is sought to be made at the latest possible stage of the proceedings; (c) the need for procedural economy points to refusing the amendment.

(b) *Article 10b(3) RPBA*: The amendment raises reasonably complex issues which in the Board's opinion it was not reasonable to expect the proprietor or the Board to consider so late in the proceedings.

7.10 In the Board's view, Opponents II and III were wrong to suggest that since the decision under appeal did not deal with the substantial validity of claim 8 of the main request there was no need or reason for the opponents to provide grounds for attacking it in their replies to the proprietor's grounds of appeal. The function of a Board of Appeal is not to examine the whole of the decision under appeal in order to see whether or not it was correct. Rather, the extent of the appeal proceedings is determined by the admissible requests of the parties (see, e.g., decision G 9/92 (OJ EPO 1994, 875)), as substantiated in accordance with the Boards' Rules of Procedure. In the present case these include requiring the respondents to set out their complete case as to why the appellant's requests should be refused and the decision upheld (Article 10a(2) RPBA), including any reasons in addition to those relied on by the Opposition Division.

7.11 Nor was Opponent II correct to suggest that it had made a sufficient attack on claim 8 in its own grounds of appeal filed on 13 May 2005. First, this statement was made in the context of Opponent II's own appeal and not the proprietor's. Second, this was a completely general statement referring to all matters advanced before the Opposition Division. The Rules of Procedure of the Boards of Appeal require a party to set out *expressly* all facts, arguments and evidence relied on (see Article 10a(2), emphasis added).

7.12 Opponent III was also wrong to suggest that it was for the proprietor to advance reasons why claim 8 was novel and inventive, and that therefore the opponents had no case to meet. It was for the opponents to advance reasons why the claim was not allowable.

7.13 In the circumstances, and in the exercise of its discretion, the Board decided not to admit these amendments to the cases of Opponents I and II.

7.14 This case should serve as a warning to parties and their representatives of the importance of paying close heed to the requirements of the Rules of Procedure of the Boards of Appeal, and the need to bring forward all their lines of argument during the written stage of appeal proceedings in accordance with Article 10a of those rules. Section 2 of the Guidance for parties to appeal proceedings and their representatives, issued by the Office (OJ 2003, 419), underlines what is already clear from the Rules themselves, namely that the parties should develop their arguments in the written stage of the appeal proceedings and not reserve them for a possible oral hearing.

7.15 Notwithstanding this conclusion, the Board accepts, first, that under Article 114(1) EPC it has a duty *ex officio* to examine amended claims, but only for *prima facie* non-compliance with the EPC, e.g., lack of clarity and/or conciseness. Indeed, the Board in the present case raised objections of this kind of its own motion to the form of independent claims 1 and 8 and in respect of a subsequent dependent claim. As a result, the proprietor filed an amended set of claims in which claims 1 and 8 were now cast in a satisfactory one-part form and the dependent claim was deleted. However, such examination did not give rise to any other doubts in relation to claim 8. So far as concerns Opponent II's argument that support within the meaning of Article 84 EPC was lacking for the new claims, in particular claim 8, the subject-matter of claim 8 was the same as that of claim 7 as granted, and so no such *prima facie* case of non-compliance exists.

7.16 Second, the Board accepts that it still has power, *ex officio*, to remit the case to the Opposition Division for further prosecution under Article 111(1) EPC. However, applying the principles set out in decision T 1002/92, paragraph 3.4 (OJ EPO 1995, 605), the Board considers that it would only be appropriate to do this in a case such as this if, as a minimum, there were materials before it which indicated that one or more of the claims under attack in the appeal proceedings were *prima facie* highly unlikely to be valid. In the present case, however, there are no materials in the appeal proceedings which have caused the Board to reach such a *prima facie* conclusion.

7.17 Opponent III was wrong to suggest that if the Board did not examine the claim it was implicitly deciding that the claim was allowable and that it was the duty of the Board to review the first-instance decision. Nothing was cited by Opponent III in support of such a far-reaching submission. As already pointed out (see paragraph 7.10), the Board's obligation is to decide the appeal on the basis of the admissible requests of the parties and the case advanced by each party in accordance with the Rules of Procedure of the Boards of Appeal. An appeal is a judicial procedure and

the principle of party disposition applies to the proceedings (see G 9/92 and G 4/93 (both OJ EPO 1994, 875)). The Board's obligations beyond this are limited, as set out in paragraph 7.15 above.

7.18 In these circumstances, the requests of Opponents I and II to remit the case to the Opposition Division are refused.

8. *Requests of Opponents II and III filed during the oral proceedings*

8.1 As set out in paragraphs X and XI, above, Opponents II and III filed certain supplementary requests in the course of the oral proceedings.

8.2 *Opponent II.* The Board takes this request (see paragraph X, above) to be a request that there be recorded in the minutes of the oral proceedings of 28 June 2007 the alleged declaration of the proprietor's representative that claim 1 of the patent as maintained in restricted form does not relate to the arrangement of the scan heads on a robot.

8.3 Rule 76(1) EPC provides that "Minutes of oral proceedings ... shall be drawn up containing the *essentials* of the oral proceedings ..., [and] the *relevant* statements made by the parties..." (emphasis added by the Board). Rule 76 EPC is part of Part VII of the Implementing Regulations to the EPC, and Part VII of the EPC deals with common provisions governing procedure before the EPO. This rule therefore applies to oral proceedings both before the Boards of Appeal and before the Examining or Opposition Divisions.

8.4 The rule does not require that the minutes reflect the full arguments of the parties. The minute-writer has a discretion as to what are the "essentials" or what is "relevant", both in examination/opposition proceedings and in appeal proceedings (see T 212/97, not published in OJ EPO, point 2.2, referring to the Guidelines for Examination, E-III, 10, and T 966/99, not published in OJ EPO, point 7.2.2, respectively). Apart from this, the practice of the Boards of Appeal and the Examination/Opposition Divisions differs: the minutes of oral proceedings before the Examination/Opposition Divisions usually contain a summary of the submissions of the parties (whose correctness can be challenged - see T 212/97, point 2.2) whereas those of the Boards of Appeal do not. The reason for this is primarily that decisions of the Boards of Appeal are intended to be self-contained, that is, they are intended to be capable of being understood by the parties and the public without reference to other documents. The decision will therefore provide a summary of all the arguments of the parties, both during the written phase of the proceedings and during the oral proceedings themselves. In contrast, decisions of the Examination/Opposition Divisions will often contain references to the minutes or other documents on file, which need to be referred to in order to fully understand the decision.

8.5 So far as concerns minutes of oral proceedings of the Boards of Appeal, what constitutes "the *essentials* of the oral proceedings" or "the *relevant* statements made by the parties" has to be determined by reference to what the Board has to decide (T 966/99, point 7.2.2). As a first step, therefore, it is the common practice of the Boards of Appeal to record in the minutes the formal written requests of the parties on which the parties at the close of proceedings require a formal decision (T 459/01, not reported in OJ EPO, point 6.3). These will typically include requests such as the dismissal of the appeal, setting aside of the decision under appeal, revocation of the patent or maintenance of the patent in amended form, or other procedural requests such as the remittal of the case or requests relating to appeal fees or costs. Other forms of request are possible. For this reason, in the present case, the written requests of Opponents II and III filed during the oral proceedings were recorded in the minutes.

8.6 Beyond this, a party may make a specific statement which has an impact on the definition of the subject-matter, such as a statement of surrender or abandonment of subject-matter. Where such a statement is relevant to the decision to be taken, it should be recorded in the minutes (see T 212/97, T 928/98, not reported in OJ EPO).

8.7 On the other hand, since the arguments concerning patentability will be apparent from the facts and submissions set out in the written decision, such arguments should not be contained in the minutes. These matters are relevant to the decision, but it is unnecessary to repeat them in the minutes.

8.8 Furthermore, it is not the function of the minutes to record statements or admissions made in oral proceedings which a party considers will be of use to it in any subsequent proceedings in national courts, for example in infringement proceedings as to the extent of protection conferred by the patent in suit. This is because such statements are not "relevant" to the decision which the Board has to take, within the meaning of Rule 76(1) EPC. Such matters are within the exclusive jurisdiction of the national courts: see T 928/98, point 5.3 (not published in OJ EPO).

8.9 Turning now to Opponent II's request, the submissions made by the proprietor's representative as to the meaning of claim 1 formed part of his arguments on the patentability of the invention as claimed, which have been dealt with in this decision. Such statements did not relate to the surrender or abandonment of subject-matter of the patent and did not otherwise have an impact on the definition of the subject-matter of the patent for the purposes of the questions the Board had to decide in these proceedings. It follows that they are not the proper subject-matter of the minutes. The request is refused.

8.10 *Opponent III.* The Board takes the first supplementary request of Opponent III (see paragraph XI, above) to be requests that the newly adapted description (see paragraph 6) contain a formulation of the problem to be solved, that in the evaluation of the state of the art in the description there be a reference to "John Macken, Optical Engineering, Inc. Remote Laser Welding", and that it be stated that the claimed apparatus does not relate to use in connection with robots and is also not suitable for such use. Arguments about whether the description is suitably adapted to the amended claims are matters for submissions during oral proceedings. The parties made such submissions and they have been recorded and dealt with in this decision. Again, there is no need to record them in the minutes. The request is refused.

8.11 The Board takes the second supplementary request of Opponent III (see paragraph XI, above) to be a request that it be recorded in the minutes that the representative of the proprietor submitted that the current claim 1 (i.e., claim 1 according to the main request) does not relate to rotational movements in connection with robots. The remarks made by the Board in relation to the supplementary request of Opponent II also apply to this request, *mutatis mutandis*. The request is refused.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The written requests filed by Opponents II and III during the oral proceedings are refused.
3. The case is remitted back to the Opposition Division with the order to maintain the patent on the basis of:
 - (a) the description consisting of columns 1 to 4 as filed during the oral proceedings together with columns 5, 6 and 7 as granted,
 - (b) claims 1 to 13 as filed during the oral proceedings, and
 - (c) Figures 1 to 3 as granted.