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**Datasheet for the decision  
of 26 February 2010**

**Case Number:** T 0349/09 - 3.3.08

**Application Number:** 92903304.1

**Publication Number:** 0568575

**IPC:** C12N 15/00

**Language of the proceedings:** EN

**Title of invention:**

Test and Model for Alzheimer's disease

**Patentee:**

ELAN PHARMACEUTICALS, INC.

**Opponent:**

ABBOTT GmbH & Co. KG

**Headword:**

Admissibility/ABBOTT

**Relevant legal provisions:**

EPC Art. 108, 112

EPC R. 99(2)

RPBA Art. 12(2), 13(1)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Admissibility of appeal - no link between statement of grounds of appeal and decision under appeal"

"Request to refer questions to Enlarged Board of Appeal - inadmissible"

**Decisions cited:**

G 0009/91, G 0010/91, T 0001/88, T 0432/88, T 0611/90,  
T 0574/91, T 0147/95, T 1007/95, T 0065/96, T 0644/97,  
T 0087/05, T 1239/06

**Catchword:**

The absence of any correlation of the ground of appeal to the decision under appeal is detrimental to admissibility of the appeal (see reasons).



Case Number: T 0349/09 - ^3.3.08

**D E C I S I O N**  
**of the Technical Board of Appeal ^3.3.08**  
**of 26 February 2010**

**Appellant:**  
(Opponent 02)

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**Respondent:**  
(Patent Proprietor)

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**Decision under appeal:**

Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
26 January 2009 concerning maintenance of the  
European patent No. 0568575 in amended form.

**Composition of the Board:**

**Chairman:** L. Galligani  
**Members:** P. Julià  
C. Rennie-Smith

## Summary of Facts and Submissions

- I. The appellant (opponent O2) has appealed against the interlocutory decision of the Opposition Division posted on 26 January 2009 to maintain European Patent No. 0 568 575 ("the patent") in amended form. The patent was based on European Patent Application No. 92903304.1, which in turn derived from the International Application WO92/13069, and was entitled "Test and model for Alzheimer's disease". The notice of opposition filed by the appellant on 12 October 2005 challenged in part the patent's claimed priority and sought revocation of the patent under Article 100(a), (b) and (c) EPC on the grounds of insufficient disclosure, of unallowable subject-matter under Article 53(a) EPC, of lack of inventive step, and of subject-matter which extended beyond the application as filed. Another opposition filed on 11 October 2005 and relying on substantially the same grounds was withdrawn by a letter dated 18 July 2008.
- II. The Opposition Division decided that the patent was to be maintained in amended form on the basis of the first auxiliary request (in two different versions for different Contracting States) filed by the respondent during the oral proceedings on 17 September 2008. In the decision under appeal the Opposition Division refused the respondent's main request (also in two versions) under Article 53(a) EPC in conjunction with Rule 28(d) EPC and following decision T 315/03 (OJ EPO 2006, 15), but found that the first auxiliary request met the requirements of Articles 52, 53, 54, 56, 83, 84, 87 to 89 and 123(2) and (3) and Rule 28(c) and (d) EPC.

III. The appellant filed a notice of appeal on 4 February 2009 and paid the appeal fee on the same date. Its written statement of grounds of appeal was filed by a letter both dated and faxed on 5 June 2009. The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety and, as auxiliary request, that oral proceedings be held.

IV. The statement of grounds of appeal opens with the following wording (on page 1 to the end of the first paragraph on page 2):

"This is further to the formal notice of appeal of February 3, 2009.

The detailed grounds for the appeal are provided herewith.

I. Requests

It is requested to set aside *the Interlocutory Decision* of the Opposition Division dated January 26, 2009 and to revoke the above-mentioned patent in its entirety.

As an auxiliary measure it is requested to set a term for oral proceedings.

II. Reasoning for the Appeal. Patentability and Sufficiency of Disclosure

1. Claims 1 to 4

Claim 1 of the opposed patent as mentioned with *the Interlocutory Decision* pertains

to an isolated polynucleotide comprising a nucleic acid sequence encoding a mutant human APP allele having an amino acid ("AA") substitution at the position encoded by codon 717 as defined in relation to APP 770."

From the words "an isolated polynucleotide" (see above) in the last line of page 1 to the end of the penultimate paragraph on page 22, the statement of grounds of appeal reproduces the notice of opposition from the appearance of those words in the first full paragraph on page 6 to the penultimate paragraph on page 28. Certain textual differences are noticeable including references to numbers of claims in the request allowed by the Opposition Division instead of the claims of the granted patent; references to documents not just by D number but by author and citation as well; a number of partial amendments and some omissions of text, making it shorter in length than the original; and a number of mis-spellings. An objection in the notice of opposition under Article 53a EPC re-appears in the statement of grounds of appeal even though it cannot apply to the claims as maintained at first instance.

On page 22 of the statement of grounds of appeal, after the text reproduced from the notice of opposition, the following final paragraph appears:

"The request to set aside *the interlocutory decision* and to revoke the patent in its entirety is thus deemed justified."

The only references in the statement of grounds of appeal to the decision under appeal are those shown in italics (added by the Board) in the passages quoted above.

- V. The respondent (patentee) filed its written reply by a letter both dated and faxed on 26 October 2009. The respondent's main request was to dismiss the appeal as inadmissible, its first auxiliary request was to dismiss the appeal and maintain the patent in the amended form maintained by the Opposition Division and, in any event other than dismissing the appeal, it also requested oral proceedings.
- VI. On 2 November 2009 the Board issued a summons to oral proceedings and a communication containing its provisional and non-binding opinion on the admissibility of the appeal.

The Board's provisional opinion was that the respondent's submissions appeared to be correct - the statement of grounds of appeal merely repeated the appellant's notice of opposition without supplying any substantive argument directed to the reasons for the decision under appeal and that accordingly the requirements of Article 108 and Rule 99(2) EPC and Article 12(2) RPBA had not been met. It seemed that the earlier document had been edited slightly to take account of differences between the claims as granted and as maintained and to remove or amend certain passages (as shown by mis-spellings in the later document, for example "liklyhood" on page 10 and "wildtyp" on page 13). However, the key problem as regards admissibility appeared to be the absence of any

argument or reasoning linking the matters set out in the statement of grounds with the reasons given by the opposition division in its decision.

Since it appeared that this issue could be decisive for the appeal proceedings, the Board considered it appropriate to deal with it immediately since time and cost might thereby be saved. Accordingly, since both parties had requested oral proceedings, these had been appointed and would be limited to the issue of admissibility.

The appellant replied to the communication by a letter dated and faxed on 26 January 2010.

VII. Oral proceedings before the Board took place on 26 February 2010, limited to the issue of admissibility of the appeal. Both the appellant and respondent were represented and presented further arguments in addition to those submitted in writing (see sections VIII and IX below). During the oral proceedings the appellant also filed the following request that the Board refer questions to the Enlarged Board of Appeal:

"In view of the decision T 147/95 it is requested to refer the following questions to the Enlarged Board of Appeal:

- 1 Does the statement of the grounds of appeal have to contain a link to the reasoning in the appealed decision in order to render the appeal admissible under Article 108 and Rule 99(2) EPC and Article 12(2) RPBA?



2 If the answer is yes, is a verbatim link to the reasoning in the appealed decision required?"

The parties also presented arguments on the admissibility of this request (see sections X and XI below).

The Board's decision was announced at the end of the oral proceedings.

VIII. The appellant's arguments, in its letter of 26 January 2010 and during the oral proceedings, as regards admissibility of the appeal were as follows:

The only issue is whether the grounds of appeal comply with the substantiation requirement. The appellant concurs with the Board's preliminary opinion that the requirements for admissibility are contained in Article 108 and Rule 99(2) EPC and Article 12(2) RPBA which provide the framework for admissibility. Article 12(2) RPBA is crucial. It merely requires that grounds of appeal "shall set out clearly and concisely the reasons why it is requested that the decision under appeal is set aside." This is intended to ensure that the grounds of appeal can be properly understood.

The Board expressed the provisional opinion that the key problem appeared to be the absence of any argument or reasoning linking the matter set out in the statement of grounds with the reasons in the decision under appeal. It is clear that there is no requirement for a verbatim or explicit linkage of the reasoning of

the grounds of appeal to the reasons given in the decision under appeal. The appellant's statement of grounds of appeal complies with this requirement in that it is clear and concise and focuses on specific objections against certain claims that were found allowable in the decision of the Opposition Division. Looking at the reasoning in the first instance decision and the patentee's reply, the respondent factually understood the grounds of appeal since, after its admissibility objection, it dealt with other substantive issues which were the major issues in the grounds of appeal.

There is ample case law on admissibility. G 10/91 (OJ EPO 1993, 420) provides the overall framework by requiring an appeal to stay within the same grounds as those raised in the opposition. Only new grounds not raised before are forbidden. This has been elaborated in subsequent cases which even allow new reasoning relating to a ground already raised.

Decision T 644/97 of 22 April 1999 (see Reasons, point 1) held that the fact "that the points made in the Statement of Grounds of Appeal did not go beyond those made before the Opposition Division, does not itself detract from the admissibility of the appeal." In the light of this decision it is not required to provide information going beyond the notice of opposition in order for an appeal to be admissible. T 644/97 more or less states an appeal is admissible if the appellant does not present anything not present in the opposition.

T 1/88 of 26 January 1989 held an appeal was admissible if it argued the Opposition Division's position was improper and the patent should be allowed on documents not considered. In T 574/91 of 3 August 1993 a statement of grounds was admissible even though it did not discuss any of the arguments in the contested decision and the sole argument put forward bore no connection with the decision. In T 611/90 (OJ EPO 1993, 50), although the statement of grounds developed an entirely fresh case and did not discuss the reasons upon which the contested decision was based, the board considered the appeal to be admissible because the fresh reasons presented were still within the same opposition ground. T 147/95 of 14 November 1995 held it was not necessary for an appeal to deal with arguments in the appealed decision but only that the grounds of appeal give the legal and factual grounds from which the incorrectness of the decision can be derived. This means the grounds of appeal must refute the decision and not necessarily the reasons leading to the decision. The case law cited by the respondent is not comparable to the present case.

The case law is very friendly to an appellant, once he brings his argument within the framework of the opposition proceedings. An appeal is always admissible if reasoned with the decision and it can be understood. Simply referring to submissions in the opposition is one of the rare cases where admissibility is not allowed. The presence in the grounds of appeal in this case of some "bogus" material (the redundant Article 53a EPC objection) does not lead to inadmissibility: T 65/96 of 18 March 1998 held that irrelevance and lack of cogency may lead to an

unsuccessful outcome of the appeal, but do not of themselves render it inadmissible.

The reasoning in the grounds of appeal addresses particular issues not properly reflected in the decision of the Opposition Division. In particular, paragraphs 11.1.1 and 11.1.2 are in reply to the Opposition Division's short statement (at point 3.6 of the reasons for the decision) that there were no objections to priority under Articles 87 to 89 EPC with regard to the subject matter of claims 1 to 7 of the first auxiliary request. That was incorrect - the appellant's entire arguments on priority presented in the notice of opposition and its submissions at the oral proceedings were just not considered by the Opposition Division. It followed from the incorrect decision on priority that the appellant's arguments on inventive step based on D1 were also not considered in the decision. There is certainly no reasonable way in which arguments in the grounds of appeal could have been linked to reasoning in the decision under appeal because there was no such reasoning. The direction of the appeal is clear from the grounds of appeal, which begin with the question of priority and the consequences of that for the prior art, and the Board and the respondent can clearly see what it is about. It clearly focuses on the statement (at point 3.6 that there was no objection to priority) without generally saying that. The statement of grounds of appeal is more or less an adaptation or condensation of the notice of opposition directed to an issue which was not decided.

In reply to the Board's observation at oral proceedings that the grounds of appeal make no mention of document

D22 although at first instance the parties agreed it was the closest prior art for inventive step, the appellant said the simple answer was priority: the arguments were in the notice of opposition, the decision under appeal ruled on priority in a certain way, that is contested in the grounds of appeal for various reasons, then the consequences for other issues are given. The Board can find from the grounds of appeal what part of the decision is challenged.

Similarly, the remaining passages of the grounds of appeal can be directly allocated to certain parts of the decision. Thus the Board and respondent are clearly in a position to assess which parts of the decision are addressed in the grounds of appeal. The appeal is thus admissible under Article 108 and Rule 99(2) EPC and Article 12(2) RPBA.

IX. The respondent's arguments, in its reply and during the oral proceedings, as regards admissibility of the appeal were as follows:

The respondent agrees that the requirements for admissibility are contained in Article 108 and Rule 99(2) EPC and Article 12(2) RPBA but considers that neither Article 12(2) RPBA nor the case law have been complied with.

The grounds of appeal simply repeat, almost verbatim, the notice of opposition and do not provide any substantive argument against the Opposition Division's reasoning set out in the decision under appeal. Indeed, the only reference to the decision at all is in the request to set it aside. Instead, the Appellant has

left it entirely to the Board and the respondent to decipher which of the objections contained in its notice of opposition of 12 October 2005 it is relying on. Where grounds of appeal are effectively a repeat of the notice of opposition, a link to the decision under appeal is necessary (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006 (hereafter referred to as "Case Law"), page 625, section 7.5.4 and T 1007/95 (OJ EPO 1999, 733), Reasons, point 1, also cited in "Case Law", page 624).

The case law establishes that a statement of grounds which merely refers generally to submissions made in the first instance proceedings is not considered sufficient (see for example T 1239/06 of 30 July 2008, Reasons, point 1.1.2). Although the Appellant has reproduced the arguments submitted in its notice of opposition rather than merely referring to the notice, the effect is the same. Copying and pasting the notice of opposition into the grounds of appeal is equivalent to a simple cross-reference to it.

The appellant has made no attempt to indicate which specific aspects of the decision it considers incorrect. No discussion of documents considered by the Opposition Division to be key to the conclusions reached is provided. Indeed, the appellant has provided no analysis of the reasoning set out in the decision at all. The decision under appeal said (see point 3.5) that, as regards sufficiency of description, decision T 1384/06 of 26 June 2007 had to be taken into account but there is no mention of this in the grounds of appeal. The decision also said (at point 3.7 on page 20) that document D17 was indicative of an

inventive step in the subject matter of claim 1, but that is not dealt with in the grounds of appeal. The Opposition Division held that Article 54 EPC was satisfied but there is no mention of that Article in the grounds of appeal. The appellant's position is unclear.

Furthermore, the duplication of the initial grounds of opposition has the absurd consequence that the appellant repeats its earlier objection under Article 53(a) EPC, which clearly no longer applies. During the opposition proceedings, the transgenic host claims were amended to state that, when the host is an animal, the host is a mouse, thereby overcoming the objection under Article 53(a) EPC. So its repetition, without any explanation of how it applies to the claims of the patent as amended, illustrates the fact that the appellant has not prepared any arguments specifically addressing the Opposition Division's reasoning set out in the decision.

Thus, the appellant's actions have resulted in a situation analogous to that in cases such as T 432/88 of 15 June 1989 (see Reasons, points 2 and 3) in which the appeal only made a general reference to the appellant's submissions in the opposition proceedings and thus amounted to no more than a mere assertion that the contested decision was incorrect so the board and the respondent were left to conjecture how the appellant might consider the decision under appeal to be defective. This is just what the requirement that grounds of appeal be filed is designed to prevent.

The appellant argued at the oral proceedings that the respondent could understand the grounds of appeal because its reply contained substantive submissions but the respondent had to guess what the grounds of appeal meant before replying and such guessing adds to the time, effort and expense involved. The respondent was forced to make such guesses in order to make its complete case.

The appellant also argued at the oral proceedings that the essential point was priority: if the appellant disagreed with what the Opposition Division decision said about priority, that should be in the grounds of appeal but it is not. On the contrary, the grounds of appeal show no relationship between priority and the other issues.

The statement of grounds of appeal may be an adaptation of the notice of opposition but only in form not substance. It does not meet the requirements of Article 108 and Rule 99(2) EPC and Article 12(2) RPBA. Since the time limit of four months from notification of the decision has expired and the appellant has not substantiated its appeal within this time limit, the appeal should be dismissed.

- X. As regards its request to refer questions to the Enlarged Board of Appeal, the appellant argued as follows:

If the Board should decide the appeal is inadmissible, there would be a conflict between this decision and that in T 147/95. As for the lateness of the request,



the appellant's representative only became aware of T 147/95 recently.

As to whether the Board needs the Enlarged Board's opinion on the appellants' proposed questions in order to decide the present case, a decision of inadmissibility in this case would be a total change of overall attitude to admissibility. The previous liberal approach has been to allow reasoning related to the decision under appeal. To require a verbatim link between that reasoning and the decision would be a tightening of the requirements for an admissible appeal, put more pressure on appellants and favour respondents. Appellants already have the pressure of having to produce their grounds of appeal within four months whereas respondents, who also have four months for their replies, have the chance of extensions of time.

XI. The respondent's arguments regarding the request to refer questions to the Enlarged Board of Appeal were as follows:

The request is very late filed. The appellant has known since the Board's communication of 2 November 2009 that admissibility was the only issue to be discussed at the oral proceedings and had ample time to prepare and give notice of any additional requests. It filed written submissions on 26 January 2010 and could have, but did not, make this request then. The respondent had no chance to consider the proposed questions until they were filed at the oral proceedings.

The Enlarged Board's opinion on the appellants' proposed questions is not necessary to decide the present case as a finding of inadmissibility would be in line with the case law.

- XII. The appellant requested that the decision under appeal be set aside and that the patent be revoked. The appellant also requested that the Board refer the questions it filed during the oral proceedings to the Enlarged Board of Appeal. The respondent's main request was to reject the appeal as inadmissible, and its first auxiliary request was to dismiss the appeal.

### **Reasons for the Decision**

#### *The issues between the parties*

1. This decision is concerned only with the admissibility of the appeal. The appellant complied with the time limits for filing the notice of appeal and written statement of grounds of appeal and paying the appeal fee (see Article 108 EPC). However, the respondent has challenged admissibility for lack of substantiation and based its arguments squarely on the absence in the statement of grounds of appeal of any link between the matters set out in the statement of grounds and the reasons given by the opposition division in its decision. It argues that the statement of grounds of appeal is no more than a "cut and paste" version of the notice of opposition from which the appellant's case on appeal cannot be clearly understood.

2. The appellant counters that by arguing variously that in this case such a link was not possible; that, while not set out expressly or verbatim, such a link was apparent from the statement of grounds of appeal; and that evidence of such a link appeared from the respondent's reply. The appellant also made a number of submissions based on individual case-law decisions.
  
3. Accordingly, the Board sees the issues to be considered as follows. First, whether the respondent's assertions about the statement of grounds of appeal are correct. Second, if they are correct, whether a link between the statement of grounds of appeal and the decision under appeal is or is not required. Third, if it is required, whether the appellant's argument that it was impossible to provide such a link in this case can succeed. And fourth, if that cannot succeed, whether the appellant's other arguments - that a link exists or by reference to case-law - can succeed.

*The nature of the statement of grounds of appeal*

4. The appellant conceded that the statement of grounds of appeal is "more or less an adaptation or condensation of the notice of opposition". There can be no doubt at all that the statement of grounds of appeal was prepared by simple editing of the earlier notice of opposition so as, for example, to refer to claims numbered as in the request allowed by the Opposition Division. Moreover, the editing was clearly done in great haste and/or with insufficient attention so that some obvious mis-spellings occurred and an objection in the notice of opposition (that under Article 53a EPC) was retained even though, as a result of the decision

under appeal, it had become redundant. The respondent almost correctly observed that the only reference to the decision under appeal was in the request to set it aside - in fact there were two such references, on each on the first and last pages of the statement of grounds of appeal, and a third mention of the decision also on the first page in the sentence beginning "Claim 1 of the opposed patent as mentioned with the Interlocutory Decision pertains to...". That third reference immediately precedes the use of some twenty-one pages of text, recycled with slight editing from the notice of opposition, which contain no other reference whatsoever to the decision under appeal, let alone any attempt to relate its content to that decision. The respondent was beyond doubt correct to say it was a "copy and paste" version of the notice of opposition. The appellant was beyond doubt correct to say that there is no verbatim or explicit link between the grounds of appeal and the decision.

*The requirement for a link between the statement of grounds of appeal and the decision under appeal*

5. Article 108, third sentence, EPC is the basic legal provision relating to statements of grounds of appeal. It requires that:

"Within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations."

The importance of this provision is that, by requiring a statement of grounds **of appeal**, it calls for something more than, and different from, submissions

made at first instance. As to what form that should take, one must turn to the Implementing Regulations.

6. The relevant provision of the Implementing Regulations is Rule 99(2) EPC which sets out in general terms the required contents of a statement of grounds of appeal. It reads:

"In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."

This makes quite clear that the statement of grounds of appeal must, first, supply the appellant's reasons for attacking the decision under appeal and, second, put forward the facts and evidence on which **the appeal** is based. Again, it is significant that Rule 99(2) EPC refers here to the appeal and not to the opposition. Of course, Rule 99 EPC governs appeals against other decisions than those of the Opposition Division. However, even within the limited ambit of opposition proceedings, the obligatory requirement is to substantiate **the appeal** and not just refer to or repeat the substantiation of the opposition. This distinction - namely, that oppositions attack patents, but appeals attack decisions - is crucial and the attack must be presented accordingly.

7. Additionally, Article 12(2) of the Rules of Procedure of the Boards of Appeal ("RPBA" - see Supplement to OJ EPO 1/2010, page 38) requires:

"The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on."

The similarity of Article 12(2) RPBA to Rule 99(2) EPC is clear. Again, there is the requirement to give reasons for attacking the decision under appeal and to put forward the facts, arguments and evidence relied on, which clearly means relied on in **the appeal**.

Additionally, the statement of grounds of appeal must contain an appellant's complete case (if only because later amendments are not necessarily allowable - see Article 13(1) RPBA) and the facts, arguments and evidence must be specified "expressly".

8. Similarly, the case-law of the Boards of Appeal has consistently considered it to be incumbent on an appellant to file, by the end of the four month time limit, a statement of grounds which (either in itself or together with the notice of appeal) presents the Board with the appellant's case why it considers the decision under appeal to be wrong. A detailed survey of the case-law in question is at pages 621 to 625 of "Case Law" in the section VII.D.7.5 entitled "Statement of grounds of appeal". It is sufficient to mention here the general principles established by early case-law, namely that

- (a) the statement of grounds of appeal should specify the legal or factual reasons on which the case for setting aside the decision is based, present clear

and concise arguments to enable the board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the arguments are based, without first having to make investigations of their own; and

(b) to be sufficient for admissibility, the grounds of appeal must be analysed in detail vis-à-vis the main reasons given for the contested decision.

9. Just as there is a noticeable similarity between Rule 99(2) EPC and Article 12(2) RPBA as already noted (see point 7 above), so there is also an equally noticeable similarity between Article 12(2) RPBA and the basic principles of the case law (see point 7 and (a) and (b) in point 8 above). This is not coincidental. As has been observed elsewhere (see T 87/05 of 4 September 2007), the RPBA are in part at least a codification of the case-law on procedural practice. It would indeed be surprising if the RPBA did not reflect the case-law. This means that compliance with the basic principles of the case-law on substantiation will often ensure compliance with Article 12(2) RPBA - and vice versa. It also means that recourse to the case-law is unlikely to avoid a finding of inadmissibility if Article 12(2) RPBA has not been complied with. Article 12(2) RPBA provides the essential test of substantiation which the case-law supplements but over which it does not take precedence. The appellant referred to Article 12(2) RPBA as "crucial" and the Board agrees.

10. To summarise, the legislation and the case-law are unanimous in the requirement that a statement of grounds of appeal must present a reasoned case against the decision under appeal. All of Article 108 and Rule 99(2) EPC and Article 12(2) RPBA require reasons to support the appeal and both Rule 99(2) EPC and Article 12(2) RPBA require those reasons to say why the decision under appeal is attacked. While clearly implicit in those legislative requirements, the case-law adds that the grounds of appeal must be analysed vis-à-vis the reasons in the decision under appeal and must enable the board and the respondent to understand immediately why the decision is alleged to be incorrect: what the Board in its communication called the need for "argument or reasoning linking the matters set out in the statement of grounds with the reasons given by the opposition division in its decision". The legislation does not say in more detail how that link is to be made but, by requiring a complete case setting out expressly the facts, arguments and evidence relied on, Article 12(2) RPBA indicates it should, to use the appellant's word, be verbatim. If not spelled out in terms, the link must be at the very least be apparent from the expressly-stated contents of the statement of grounds of appeal, since the board and the other party or parties must be able to understand the appellant's case from the statement without having to make investigations of their own (see point 8(a) above).

*The appellant's argument that it was impossible to provide a link*

11. The appellant alleged (but only in subsequent submissions and not in the grounds of appeal) that the



Opposition Division's decision misrepresented its arguments on priority. The decision said (in point 3.6 of the reasons) that there were no objections to priority when in fact the appellant (as opponent) did indeed have such objections. That, the appellant now submits, made it impossible to provide a link between arguments in the grounds of appeal and the decision under appeal. The Board cannot accept this. As the respondent submitted, if the appellant disagreed with what the Opposition Division decision said about priority, that disagreement should be expressed in the grounds of appeal but it is not. It would have been perfectly possible for the appellant to refer to its case on priority at first instance, to the Opposition Division's rejection (and, as the appellant now says, misrepresentation) of that case and, having shown the difference, set out the arguments why the decision was wrong. Far from being impossible, that would have been a very easy link to make.

12. The appellant takes the argument further however - since its other arguments rested on the issue of priority, they were not considered in the decision under appeal but, none the less, its statement of grounds of appeal begins with the question of priority and then proceeds to deal with other issues; thus it is apparent from the statement of grounds what parts of the decision are challenged. The most the Board can say of this line of argument is that the appellant now seeks belatedly to make the best of a bad job. Other than as appeared from the notice of opposition, the statement of grounds of appeal shows no relationship between priority and other issues although, as with the priority issue itself, that could have been done

without difficulty. As the respondent mentioned, there are several other issues - including sufficiency of description, document D17 as indicative of an inventive step, and whether Article 54 EPC is satisfied - on which the Opposition Division decision made specific findings but which are just not mentioned in the grounds of appeal, with the result that the appellant's position is unclear. There is no reason why the appellant could not have made submissions about those findings.

*The appellant's "implicit link" arguments*

13. The appellant argued that, while its statement of grounds of appeal did not contain a verbatim link, one was none the less apparent because the statement focused on specific objections against certain claims that were found allowable in the decision of the Opposition Division. (The appellant did not use the word "implicit", but such must be the case in the acknowledged absence of an explicit link.) This argument is correct only in that, in the editing of the notice of opposition to produce the statement of grounds of appeal, the references to claims have been renumbered to replace the numbers of the claims as granted with the numbers of the claims as maintained. However, the substance of the text, and thus the reasons why the claims are objected to, remains almost verbatim the same as in the notice of opposition. At the very least, to try to understand the statement of grounds of appeal, the reader would need to trace the appellant's objections from the original notice of opposition to the decision under appeal in order to see how and to what extent the opposition succeeded, then

read the grounds of appeal to see which of the original objections were still maintained, ignore those which although maintained clearly no longer apply, and then assume that, as regards the rest, the appellant intends to make exactly the same case as at first instance. Even assuming that laborious sequence of exercises would tell the reader what the appellant's case against the decision was, as the respondent observed such conjecture is exactly what the statement of grounds of appeal is designed to prevent. As the case-law demonstrates (see point 8(a) above), the Board and the respondent should be able to understand immediately why the decision is alleged to be incorrect, and on what facts the arguments are based, without first having to make investigations of their own. That is also the clear intention behind the requirement of Article 12(2) RPBA for a complete case which expressly sets out facts, arguments and evidence.

14. Turning to the appellant's second argument in support of an implicit link - that the respondent did actually understand the grounds of appeal since it dealt with substantive issues in its reply - the Board agrees with the respondent which argued that it had to guess what the grounds of appeal meant before replying but was forced to do so in order to make its complete case. The respondent could have filed a reply which challenged admissibility only; however, in doing so it would have taken the risk of not filing its own complete case (Article 12(2) RPBA applies to a reply as well as to a statement of grounds of appeal). The respondent could also have asked for an extension of time to file a reply on substantive issues but such extensions of time are only allowed exceptionally and at the Board's

discretion (see Article 12(5) RPBA), so again it would have taken a risk. Thus the only safe course open to the respondent was to file a reply both challenging admissibility and, albeit on the basis of guesswork, making submissions on substantive issues. The appellant's argument is self-serving - just because the respondent did its best in a difficult situation does not mean the situation was not difficult. A substantive reply does not in itself make an unsubstantiated appeal admissible.

*Case-law*

15. In the Board's view, the case-law referred to by the appellant does not assist it. It referred first to G 10/91 (OJ EPO 1993, 420), the reasons for which are to be found in G 9/91 (OJ EPO 1993, 408). The appellant correctly submitted that these decisions held that an appeal must be confined to the same grounds as the opposition while new reasoning relating to such a ground may be raised on appeal. However, this cannot affect the appellant whose grounds of appeal not only included no new reasons relating to the original grounds of opposition but also no reasons why the decision on those grounds was challenged.
  
16. The appellant then submitted that T 644/97 of 22 April 1999 "more or less" states that an appeal is admissible if the appellant does not present anything which was not present in the opposition. That is indeed only "more or less" correct: T 644/97 actually held the opposite - that a statement of grounds of appeal does not need to contain new material to be admissible (see "Case Law", page 622). That is no basis for the

proposition that the absence of new material ensures admissibility.

17. The appellant also referred to T 1/88 of 26 January 1989 in which an appeal was admissible which only argued that a particular document had not been properly evaluated by the Opposition Division. However, in that case the appeal, for all its substantiation was minimal, did attack the decision under appeal (see "Case Law", pages 622 to 623) which the appellant's statement of grounds of appeal does not.
  
18. The appellant also correctly submitted that in T 574/91 of 3 August 1993 a statement of grounds was held to be admissible even though it did not discuss any of the arguments in the contested decision and the sole argument put forward bore no connection with the decision. The appellant omitted however to add that the appeal was thereby limited to reviewing the grounds for revocation. By comparison, the present case concerns not one argument unrelated to a decision to revoke a patent but a multiplicity of arguments unrelated to a decision to maintain a patent in amended form (see "Case Law", page 623).
  
19. In relation to T 611/90 (OJ EPO 1993, 50), the appellant's submissions were again correct but the case is irrelevant as it concerned a statement of grounds of appeal containing an entirely fresh case: wholly unlike the present case in which the case presented in the statement of grounds could not be less fresh (see "Case Law", page 623 to 624). The appellant also argued that T 147/95 of 14 November 1995 held that it was not necessary for an appeal to deal with arguments in the

appealed decision but only that the grounds of appeal give the legal and factual grounds from which the incorrectness of the decision can be derived. It submitted that this means the grounds of appeal need only refute the decision and not necessarily the reasons leading to the decision. Again, the appellant is correct but, again, the earlier decision is irrelevant. In T 147/95, the only argument on appeal against rejection of an opposition was based on a new document which the board of appeal considered admissible and then remitted the case to the first instance accordingly. This was therefore another "entirely fresh case" decision like T 611/90 (see above) and, indeed, it cites and follows that decision to which, in terms of jurisprudence, it adds nothing. The present case could not be further removed from T 611/90 and T 147/95: far from the statement of grounds of appeal presenting an entirely fresh case, it presents an entirely stale case from which the incorrectness of the decision cannot be derived.

20. The final decision cited by the appellant was T 65/96 of 18 March 1998 as to which it submitted, with reference to the redundant Article 53a EPC objection, that irrelevance and lack of cogency may lead to an unsuccessful outcome of the appeal, but do not of themselves render it inadmissible. Yet again, the appellant is correct but, yet again, the decision is not in point. The mere redundant repetition of the irrelevant Article 53a EPC objection cannot make an otherwise inadmissible appeal admissible. Even a reason which is certain to fail must be linked to the decision under appeal which, in the case of this particular objection, was not only not done but, if done, would in

the circumstances have been absurd. The appellant has apparently missed the point of the respondent's argument which was, quite simply, that the repetition of the Article 53a EPC objection was an illustration of how the statement of grounds of appeal failed to address the reasoning of the decision under appeal.

21. The appellant's more general submissions with respect to the case-law were too vague to add anything to its case. To say the case-law is "very friendly" to an appellant once its arguments are within the framework of the opposition proceedings adds nothing to the appellant's submissions on G 10/91 (see point 16 above), "very friendly" as an assessment of such a large body of case-law being so general as to be meaningless. As regards the statement that an appeal is always admissible if it is reasoned with reference to the decision under appeal and if it can be understood, that is also far too general a summary of the case-law but, none the less, the appellant's own grounds of appeal fail to meet either of those criteria. The appellant was more correct in submitting that simply referring on appeal to submissions in the opposition is one of the rare cases where admissibility is not allowed - that was indeed the root cause of the appellant's difficulty. For the avoidance of any possible doubt, the Board adds that it can see no difference between the mere incorporation by reference in a statement of grounds of appeal of first instance submissions and, as in this case, the repetition of such submissions *in extenso*. In either case, the absence of any correlation of the grounds of appeal to the decision under appeal will be equally detrimental to admissibility.

*Request to refer questions to the Enlarged Board of Appeal*

22. The appellant's request to refer questions to the Enlarged Board of Appeal is inadmissible for several reasons. It was beyond doubt filed very late and gave the respondent no chance to consider the issues they raised. It would have been very easy for the appellant to have given earlier notice of the request, for example when it replied to the Board's communication on 26 January 2010. However, such lateness apart, there was quite manifestly no need for the Enlarged Board's opinion on such questions in order to dispose of this case as the appeal was clearly inadmissible by reference to both the relevant legislation and case-law.
23. Further, as the present decision shows (see points 4 to 10 above), the proposed questions could be answered by reference to well-established law and thus neither a need to ensure uniform application of the law nor an important point of law arises (see Article 112 EPC). The appellant's submission that this decision would conflict with T 147/95 is simply untenable. As indicated above (see point 20), decision T 147/95 concerned a quite different, indeed completely opposite, fact-situation (namely, an entirely fresh case) as to which there is already settled case-law, such as T 611/90 (OJ EPO 1993, 50) which was followed in T 147/95 itself. The present decision marks no change of attitude to admissibility, let alone a total change imposing tougher requirements as the appellant argued.



*Conclusion*

24. The Board concludes accordingly that none of the appellant's arguments succeed. While intended to show that the appeal was substantiated, the very fact that those arguments raised points (such as the treatment of the priority issue in the decision under appeal) wholly absent from the statement of grounds of appeal served only to underline the absence of substantiation. Not only did they fail to demonstrate the necessary link between the statement of grounds of appeal and the decision under appeal, they also showed that the grounds of appeal, contrary to Article 12(2) RPBA, neither contained the appellant's complete case nor set out expressly all the facts evidence and arguments on which it relied. In the circumstances, there was no alternative but to reject the appeal as inadmissible.

**Order**

**For these reasons it is decided that:**

1. The request to refer questions to the Enlarged Board of Appeal is rejected as inadmissible.
2. The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

A. Wolinski

L. Galligani