

Kluwer Patent Blog

T 1843/09: the EPO clarifies the scope of the prohibition of reformatio in peius

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Under the principle of the prohibition of reformatio in peius, the Boards of Appeal of the European Patent Office are forbidden from taking a decision which puts a sole appellant in opposition appeal proceedings in a worse position than if it had not filed an appeal against a decision of the Opposition Division to maintain a patent in amended form. The consequence of this is that the non-appealing party cannot make requests which improve its position vis-à-vis the decision of the Opposition Division. This principle was laid down in decision G 9/92 of the Enlarged Board of Appeal.

The later Enlarged Board decision G 1/99 established that an exception to the prohibition of reformatio in peius may be made in order to prevent revocation of a patent as a direct consequence of an inadmissible amendment allowed during the first instance proceedings due to an error of judgement on the part of the Opposition Division. In such circumstances, the Proprietor may exceptionally be allowed to broaden the scope of protection beyond that of the claims maintained by the Opposition Division, provided that the deficiency cannot be cured by further restricting the scope of the claims.

The recent decision T 1843/09 clarifies that the exception set out in G 1/99 in order to overcome an objection under Article 123(2) EPC is not the only exception to the prohibition of reformatio in peius. According to the Technical Board of Appeal, exceptions to this principle are a matter of equity in order to protect a non-appealing Proprietor against procedural discrimination in circumstances where the prohibition of reformatio in peius would impair the legitimate defence of its patent. Whether and to what extent an exception may be granted should be decided on a case-by-case basis in view of this overriding objective. The Board took the view that G 1/99 provides a guideline rather than a restrictive rule regarding the exercise of the discretionary power of the Boards of Appeal to allow the filing of broadened claims.

The facts of T 1843/09 are that the Opposition Division maintained the opposed patent on the basis of an amended claim 1 which included a feature that had the effect of invalidating the earliest priority claim of the patent. The Opponent appealed the Opposition Division's decision, but no appeal was filed by the Proprietor. The Opponent contested the Opposition Division's decision not to admit a late-filed document into the proceedings. The Board of Appeal accepted the Opponent's arguments and admitted the late-filed document. The Board then remitted the case to the Opposition Division for further prosecution. During the continued opposition proceedings, the Proprietor deleted the priority-invalidating feature from claim 1 in order to avoid the newly-

admitted document. The Opposition Division maintained the patent on the basis of the broadened claim 1. Unsurprisingly, the Opposition Division's decision was once again appealed by the Opponent, but not by the Proprietor.

The Board in T 1843/09, which had a different composition to the Board in the first appeal, acknowledged that, in general, an Opponent and sole Appellant should not be adversely affected by its appeal. However, the Board held that exceptions to the prohibition of reformatio in peius are not restricted to cases in which there has been an error of judgement by the Opposition Division which causes a contravention of Article 123(2) EPC. Equity prevails, such that the prohibition of reformatio in peius may be circumvented when there has been a change of the factual or legal basis upon which limiting amendments were made by the Proprietor. In this case, the admittance of the late-filed prior art document into the proceedings during the first appeal altered the factual and legal basis upon which the limiting amendment was made by the Proprietor. The Proprietor was permitted to undo this amendment in order to restore priority.

T 1843/09 provides welcome clarification regarding the scope of the prohibition of reformatio in peius. However, in practice, it is likely that exceptions to this principle will seldom be granted. In order to safeguard the right to broaden the scope of the claims, it is advisable for Proprietors to appeal decisions of Opposition Divisions which maintain their patents in an amended form.

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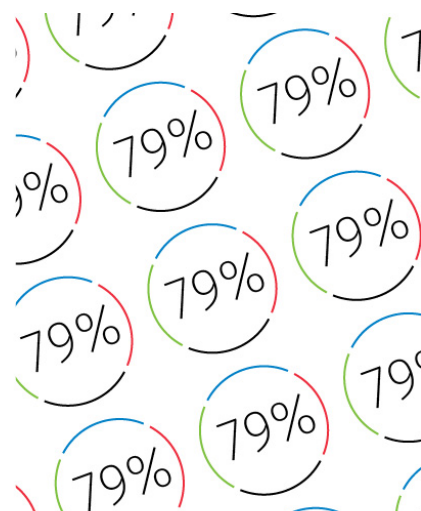
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This entry was posted on Friday, June 6th, 2014 at 11:11 am and is filed under [Art. 123\(2\) of the European Patent Convention \(EPC\)](#), a European patent (application) may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Adding subject-matter which is not disclosed would give an applicant an unwarranted advantage and could be damaging to the legal security of third parties. ([G 1/93](#), OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that “any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed” (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Added matter, [G 1/93](#), OJ 1994, 541) *The ‘gold standard’ of the European Patent Office’s Board of Appeal is that any amendment can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (G 3/89, OJ 1993,117; G 11/91, OJ 1993, 125).*“>Amendments, [EPC](#), [EPO Decision](#), [Priority right](#), [Procedure](#)

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