PART II

Elements of the solution

Re (A): The EPC does not allow a patent proprietor to request an amendment (limitation) to his claims once a European patent has been granted. A limitation procedure as provided for in many national patent laws does not exist.

Mittlerer have the following options:

(a) to initiate national limitation procedures where possible;

(b) to file an opposition themselves to limit the patent to claim 2;

(c) if he waits for an opposition to be filed he is taking the serious risk that he will have no opportunity to restrict his patent.

Option (c) seems to be risky

Option (b) is preferable in view of Decision Gr 01/84 of the Enlarged Board of Appeal (OJ EPO 1985, 229). The opposition can be based on the applicant's own earlier European patent application - meanwhile abandoned - with a priority of 5 February 1985.

Under Article 54(3) and (4) EPC, however, the latter represents the state of the art only for AT, CH and FR.

The German priority application dated 5 February 1985 and published on 7 August 1986 is not prior art under Article 54(3) EPC.

If the opposition is based on this earlier European application, there is little risk that the patent will be

.../...

revoked, since neither the temperature (feature b) nor the refractive index (feature a) are features whose novelty has been prejudiced.

Under case law relating to Article 54(3) EPC the temperature claimed is not anticipated by general indications of temperature (T 17/85, OJ EPO 1986, 406; T 198/84, OJ EPO 1985, 209).

The refractive index must also be a new feature since equivalents do not belong to the "whole contents" (T 167/84, OJ EPO 1987, 369).

If the opposition is based on the UK patent, which represents the state of the art under Article 54(2) EPC, Mittlerer run little risk that the Opposition Division will find the limited claim obvious in view of that document.

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Re (B1): The opposition (I) is admissible because based on grounds under Article 100(a) EPC.

The brochure would have to be taken into account by the Opposition Division as being a prior publication under Article 114(1) EPC (T 156/84, OJ EPO 1988, 372).

The patent proprietor's objection that a non-prejudicial disclosure under Article 55(1)(a) EPC is involved does not hold good. It cannot be said that the sending of the brochure by Abel to opponents I constituted an evident abuse in relation to Mittlerer.

.../...

Such documents being intended precisely for public consumption, it cannot be excluded that Abel did not consider the brochure to fall under the tacit secrecy obligation and thus considered himself entitled to hand the brochure on to opponents I.

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Re (B2): The documents submitted by opponents (II) must be taken into account by the Opposition Division even after the opposition has been withdrawn (Article 114(1) EPC)

and are to be commented on even if there is a likelihood that grounds can easily be put forward in support of inventive step.

The Opposition Division must take account of objections under Article 84 EPC only if Mittlerer submit amended claims on their own initiative (T 23/86, OJ EPO 1987, 316) or if the Article 84 objections are such that they justify objections under Articles 54, 56 and/or 83 EPC.

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Re (C1): Appeal of opponents (I) clearly has to be rejected as inadmissible owing to lack of grounds. In the grounds for their appeal, opponents (I) claim non-patentability and fail to show that the opposition is admissible. Being

.../...

unsubstantiated, the appeal is therefore inadmissible (T 213/85, OJ EPO 1987, 482).

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Re (C2): The new document which opponents (II) only submitted in the appeal stage would have to be taken into account by the Board of Appeal under Article 114(1) EPC (T 142/84, OJ EPO 1987, 112).

The Board will not necessarily take account of significantly amended alternative claims not submitted until the oral proceedings, since the new document had already been filed with the grounds for appeal and Mittlerer had meanwhile had adequate time to amend the claims.

Moreover the claims have been amended significantly. Whether this alternative claim would be considered by the Board will depend on whether the claim is clearly allowable (T 153/85, OJ EPO 1988, 1).

In respect of the allowability of new alternative claims the patentee may argue that there was no reason for him to amend the claims before the Board allowed late filed documents to be introduced into the proceedings.

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EXAMINATION COMMITTEE III

Candidate's a... lo. .....

Report by exami...

PART II

PARTS	Category	Maximum possible		Individual marks awarded	Where grades awarded are not identical	
					Revision of marks/grade (if any)	Remarks*
A	PROCEEDINGS	wait ?	1.5			
		nationals ?	1.5			
		Opposition	5			
	PRIOR ART		5			
	CLAIMS	feature a	2			
		feature b	3			
		combined	4			
	ACTION		4			
B	OPPOSITION I		7			
	OPPOSITION II	A 114	4			
		A 84	3			
C	OPPOSITION I		5			
	OPPOSITION II		5			
TOTAL PART I		**50**				
TOTAL PART II		**50**				
TOTAL PARTS I + II		**100**				
CORRESPONDING GRADE						

Translation of marks into grades

%			Grade
0	-	35	7
35,5	-	45	6
45,5	-	55	5
55,5	-	65	4
65,5	-	75	3
75,5	-	85	2
85,5	-	100	1

* to be filled in if both the following requirements are fulfilled:
(a) the grades awarded by the two individual examiners before their discussion differ by two grades or more;
(b) the marks awarded by at least one of the two individual examiners have been changed during their discussion.
If remarks are to be filled in, they should briefly explain why the examiner has changed his marks.