

## **6.2. Point in time from which a new decision which deviates from existing practice becomes generally applicable**

In three decisions the Enlarged Board of Appeal reached the conclusion that these decisions overturning earlier rulings would not be applied up to the date on which they were made available to the public (G 5/88, OJ 1991, 137, concerning an administrative agreement; G 5/93, OJ 1994, 447, concerning the possibility for Euro-PCT applicants to have their rights re-established with regard to the time limit for paying the national fee provided for in R 104b EPC 1973; and G 9/93, OJ 1994, 891, holding that a European patent cannot be opposed by its own proprietor, thereby overturning G 1/84). These three decisions do not, however, form the basis of a general rule that new case law must never be applied "retrospectively" (J 8/00).

In T 716/91 the board came to the conclusion that G 4/93 (corresponding to G 9/92, OJ 1994, 875) had also to be applied to pending cases. The situation in the case in hand was not analogous to the situation in G 9/93, where the Enlarged Board of Appeal had held that it was inequitable to apply the law as interpreted in G 9/93 to pending cases. The board pointed out that G 4/93 did not contain any indication limiting the applicability of the law as interpreted therein to pending cases.

In T 739/05, the board saw no reason to suspend the further prosecution and the final decision of the case until a decision of the Enlarged Board of Appeal was issued on an important point of law which might have been of importance for the case under consideration. The board held that the decision of the Enlarged Board of Appeal could not affect the outcome of the case because of the principle of the protection of legitimate expectations relating to pending cases. Where existing long-standing practice laid down in publications of the EPO is overruled by a new decision, consistent case law (G 5/93, G 9/93, T 905/90, J 27/94, J 25/95) allows the applicants of pending cases a transitional period during which they may rely on the previous practice until the modifying decision is made available to the public.

Decision G 2/08 (OJ 2010, 456) stated that in order to ensure legal certainty and to protect legitimate interests of applicants, the interpretation of the law given by the Enlarged Board in this decision should have no retroactive effect, and an appropriate time limit of three months after publication of the present decision in the Official Journal of the EPO was set in order for future applications to comply with this new situation. On the same grounds, in G 3/19 (OJ 2020, A119 – see point XXIX of the Reasons) the Enlarged Board specified that the new interpretation of Art. 53(b) EPC given in the opinion had no retroactive effect on European patents containing the claims of the type at issue which were granted before 1 July 2017 (when R 28(2) EPC entered into force) or on pending European patent applications seeking protection for such claims which were filed before that date.

In G 2/07 and G 1/08 (OJ 2012, 130 and 206) the Enlarged Board of Appeal held that, in the past, it had granted a transitional period in cases in which its decision had brought about a change in relation to an established procedural practice, which change the parties could not be expected to foresee. By contrast, the existence of "legitimate expectations"