

### 3.4.5 Special cases

#### a) References to communications

See in this chapter III.K.3.5. "Decisions according to the state of the file".

#### b) Reference to a board decision or case law

In T.1205/12 and T.1206/12, which are worded identically, the board held that a mere reference to jurisprudence of the boards of appeal did not, by itself, constitute or replace an argument in a first instance decision. If a deciding body, in a decision, wanted to rely on an argument put forward in a decision of the boards, be it part of its ratio decidendi or an obiter dictum, it was insufficient merely to refer to it or to cite it. The deciding body also had to make clear that it adopted the argument and explain why, in what respect and to what extent this argument applied to the case at hand.

In T.227/95 the contested decision contained no reasons on the merits of the case but merely stated: "for the reasons it is referred to the decision of the board of appeal dated 24.01.94" (meaning T.527/92). However, T.527/92 contained no such reasons, since the case was remitted to the opposition division for further prosecution. The requirements of R.68(2)EPC 1973 were not met.

#### c) Assessment of inventive step without assessing the prior art

In T.87/08 the board pointed out that Art.56 EPC required that the assessment of inventive step be made "having regard to the state of the art". Accordingly, a decision was not sufficiently reasoned if the chain of reasoning to justify the finding of lack of inventive step merely stated that a purported effect had not been achieved, i.e. this technical problem had not been solved, without reformulating the problem in a less ambitious way and without assessing the obviousness of the claimed solution to that reformulated problem in the light of the cited prior art.

In T.2375/10 the board found that since the requirement of inventive step under Art.56 EPC had to be assessed in the light of the prior art, the decision of the examining division to conclude that there was a lack of inventive step without referring to the prior art was insufficiently reasoned within the meaning of R.111(2)EPC. See also T.306/09.

#### d) Identical decision after remittal for further prosecution

In T.740/93 the case had been sent back to the department of first instance because of a procedural violation (incorrect composition of the opposition division). Because of the remittal with the order for further prosecution of the opposition, the first decision became nothing more than a communication and the first statement of grounds of appeal therefore had to be considered as a response to this communication. The new opposition division rendered a decision which was nearly identical to the first one. Although the decision under appeal contained a reasoning as to why the subject-matter of the patent in suit was considered to lack an inventive step and referred to points of dispute raised in the