

## 7. Interlocutory decision on allowable auxiliary request – distinction between examination proceedings and opposition proceedings

In T 549/96 it was noted that Art. 113(2) EPC 1973 required the examining division to decide upon an application only in the text agreed by the applicant. Thus an applicant had to indicate clearly at the end of the proceedings which text he wished to be used. If an applicant failed to indicate his approval of the text of an allowable subsidiary request, e.g. by express disapproval or by maintaining one or more unallowable higher-preference requests over one considered allowable by the examining division, the examining division could refuse the application under Art. 97(1) EPC 1973. The board **contrasted opposition and grant proceedings**. In the case of an allowable auxiliary request in opposition proceedings an interlocutory decision was taken under Art. 106(3) EPC 1973 (Art. 106(2) EPC) to the effect that the European patent met the requirements of the EPC 1973, account being taken of the amendments made by the patent proprietor. This interlocutory decision then also had to include the reasons why the preceding requests did not meet the requirements of the EPC 1973. This saved the proprietor the further costs of fulfilling the formal requirements under R. 58(5) EPC 1973 (R. 82(2) EPC) before there was a final decision on the version in which the patent could be maintained. No comparable situation existed in grant proceedings. On the contrary, in ex parte appeal proceedings the principle of examination ex officio applied. Up to the grant stage it had to be ensured that the conditions for patentability were met. An interlocutory decision, stating that the application in a certain version met the requirements of the EPC 1973, would be in conflict with this purpose. The board drew attention to Legal Advice No. 15/98 (OJ 1998, 113).

In T 482/06, the board found that decision T 549/96 was compatible with the updated Legal Advice No. 15/05 (rev. 2) (OJ 2005, 357), as it stated that "an applicant must unambiguously indicate at the end of the proceedings, which text he proposes". Legal Advice No. 15/05 set out the mechanism to provide this indication. See also T 976/97, also before the entry into force of Legal Advice 15/05, where the situation was similar to that in T 549/96. In T 1220/05 the board (referring to T 839/95 and T 549/96) confirmed that interlocutory decisions finding an auxiliary request allowable were not in keeping with standard first-instance practice in examination proceedings, as opposed to opposition proceedings (see Legal Advice No. 15/05 (rev. 2), point 1.1), and in appeal jurisprudence were deemed undesirable owing to possible repercussions (binding effect, no reformatio in peius).

On the interlocutory decision in opposition proceedings (that the European patent as amended meets the requirements of the EPC), see chapter IV.C.8.2.2.

## 8. Opposition procedure

According to T 234/86 (OJ 1989, 79), the opposition division can – and in certain circumstances must – maintain the patent as per the patentee's subordinate auxiliary request if he pursues main and auxiliary requests which are not allowable although taking precedence over the allowable one. Rejection of the requests which take precedence must be reasoned.