

# Case Law for the EQE

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# Warning

- I am not exam committee
- I do not draft the papers
- **Do not make important life decisions based on this overview talk. 😊**

# Is this just for the legal paper?

- Not really!
- In all papers, you always have to do the right thing, taking the EPC (*and its interpretation*) into account
  - Draft right – not usually case law heavy but you never know.
  - Amend right – disclaimer, anyone?
  - Oppose right – partial priorities, same invention, divisional subject matter, ...
  - ...
- If there's a G decision relevant to the issue, cite it (it looks good)

# Which cases are really important?

- G decisions
  - the notorious ones, and
  - the more recent ones
- Case law cited in the GL
  - It's always better to cite G / T / J than the GL... (you will look cleverer)
- Notorious Ts and Js (these are in the GL)
- ("White Book" usually not needed)

# Good news for legal papers!

- PCT may be daunting but there's no case law!
  - (There's no possibility to appeal)
  - PCT is 'self-contained'
- Hands up who likes PCT tiny little bit more now. 😊

**G** decisions that feature  
“often” in papers

Oldies but goldies 😊

# G 1/15 “partial priorities”

- Typical scenario:
  - Priority application: range 3-7
  - Application as filed: range 1-10
  - Conclusion 1: effective date = PD for 3-7, = DoF for 1-2.99 & 7.01-10
- Prior art: effective date between PD and DoF, discloses 2, 4, 6, 8
- Conclusion 2: 3-7 survives, rest is 💀
- Claims with more than one effective date are popular

## G 3/14 “clarity in opposition”

- Clarity of amended claims never examined if:
  - Claims were granted like that, or
  - Amendment comes from dependent claims which were granted like that
- Therefore, clarity only relevant if amendment comes from description

# G 1/09 “application pending”

- (For filing divisionals)
- **Div of a div:** the 2nd is enough (the root doesn't have to be pending)
- **Grant:** up to the eve of publication of grant (a Tues)
- **Deemed withdrawn:** until the TL expires (if it's gone, you have to further-process it) – with **renewal**, last day of the “+6m” period
- **Withdrawn:** incl. the day of withdrawal (even if div filed later than withdrawal)
- **Refused:** end of the 2m for filing notice of appeal (even if appeal not filed)
- **Stay of proceedings** (“stolen invention”): no div filing possible (but then div is one of the rightful owner's options - Art. 61(1)(b))

# G 1/05 & G 1/06 “impeccable pedigree”

- **G 1/05:** the test for Art. 123(2) and for Art. 76(1) is the same (no undue leniency!)
  - **G 1/06:** consider:
    - EP0 (root) discloses ABC;
    - EP1 (1st gen div) discloses AB;
    - EP2 (2nd gen div) discloses C
- Then EP2 has a problem (Art. 76(1) “invalid divisional”) because C was not in the earlier application (EP1)
- Subject matter of a divisional has to be in all predecessors
  - (If EP2 is a div of EP0, that’s something else)

## G 2/98 “same invention”

- The test for the “same invention” for the purpose of Art. 87 [priority] is the same as for added subject matter in amendments
- So the test is strict!

# G 3/89 & G 11/91 “content of application as filed”

- The content of the priority documents is not part of application as filed
  - Also you can't use priority documents to clarify / prove obvious error
  - You can only use application as filed
  - Consider:
    - In the application, there's 7 mm
    - Applicant says this should be 7 cm and requests correction
    - 7 mm / 7 cm is not “immediately obvious” etc.
    - Applicant argues that priority doc discloses 7 cm so either it's obvious or they can amend.
- Applicant is wrong!

“New” G decisions

# G 1/22, G 2/22 “entitlement to priority”

- EPO can assess entitlement to priority
- EPO assumes that whoever claims priority is entitled, but this can be disproven
  - (Previously: prove your right to prio; now: prove they don't have it)
- This assumption applies also for ex-PCTs
- ...and if priority application is filed by a subset of applicants

## G 1/23 “enabling disclosure”

- Even non-reproducible features are disclosed if product is made available to the public
- Or, “once it is disclosed, it is disclosed and that’s it”
- Previously in Paper D: whatever was not visible / not possible to reverse-engineer didn’t count as state of the art

## G 1/24 “claim interpretation”

- “The description and any drawings are always referred to when interpreting the claims, and not just in the case of unclarity or ambiguity.”
- Practically, this decision seems to change very little  
(‘referred to’ is not necessarily the same as ‘followed’)

## G 2/24 “intervention in appeal”

- If there are
  - regular appellants and
  - opposition interveners *who only intervened in the appeal stage*, and if the regular appellants all withdraw their appeals, then the interveners cannot continue on their own.
- The intervening third party does not acquire an appellant status.
- (G 3/04 was right the whole time)

Top 3 case-law heavy topics

# Disclaimers

- Disclosed disclaimer (“not A” in the application as filed) – no pb
- Undisclosed disclaimer (neither “B” nor “not B” in the application as filed)
  - **G 1/03, G1/16** undisclosed disclaimer can only restore novelty in special cases
  - it can’t remedy anything else, or serve two purposes (one legit, one not)
- Disclaiming stuff disclosed positively (“C” disclosed in the application as filed but “not C” is not)
  - **G 2/10** the test is, is what remains directly and unambiguously disclosed
  - beware intermediate generalisation
- H-V, 4 has a neat summary of how to deal with each of these situations

# Oral proceedings

- **G 4/92** about new evidence taking absent party by surprise
  - **G 4/95** on accompanying persons speaking at OP
  - **G 1/21** “oral proceedings by videoconference”
  - ...and a bunch of Ts
- 
- See GL E-III, they cite all the important Ts there

# Oppositions

- Case law for oppositions is in GL part D
- Selection:
  - **G 1/84, G 9/93, G 3/97** “any person”
  - **G 4/88 & G 2/04** “transfer of opposition”
  - **G 3/99** “joint opponents”
  - **G 9/91 & G 10/91** “late filed”; **G 1/95 & G 7/95** “separate grounds”
  - **G 1/91** “unity”, **G 3/14** “clarity”
  - **G 4/91 & G 1/94** “intervention”
  - **G 1/13** “party status”
  - **G 1/10** “requests for correcting patent”
- + the OP case law as/if applicable (beware)

# Note about appeals

- Some of the list (*previous slide*) applicable to appeals
- In addition, e.g.:
  - **G 3/04 & G 2/24** “intervention in appeal”
  - **G 1/18** “deemed not filed”
  - **G 1/13** “identity of appellant”
- Appeals are not in GL (BoA not bound by GL)
  - Do read RPBA (OJ EPO 2024, A15)

(This could go on and on, so...)

All the best for the exams

(The End)

