

Amendments to Claims in Patent Invalidation Proceedings: PRB's Scope of Examination *ex officio*

Comments on Supreme People's Court's opinions on rejecting petition for *certiorari* with regard to *Shanghai Jahwa Pharm. Tech., Co. Ltd. v. PRB* (Case No. Zhixingzi 17/2011)

He Huaiwen

In October 2011, the Supreme People's Court (SPC) rejected the petition for *certiorari* with regard to *Patent Reexamination Board (PRB) v. Shanghai Jahwa Pharm. Tech Co., Ltd., et.al* (the "Jahwa case"). This decision has important legal impacts upon the rules governing amendments to claims made in patent invalidation proceedings. The SPC held that (1) an amendment to claims in patent invalidation proceedings must conform to the principles set forth in the Patent Examination Guidelines (the PEG), and must not go beyond the disclosure of the description and claims as filed; (2) the Implementing Regulations of the Chinese Patent Law (the IRCPL) and the PEG limit possible amendments to claims in invalidation proceedings primarily on the following two grounds: to safeguard stability of the scope of patent protection by upholding the public notice function of claims; and to prevent elements discovered later than the filing date from being given an unjust priority by forbidding a patentee from incorporating in claims, by virtue of later amendment, a technical solution that was absent, or, at least, not reflected in the description on the filing date; and (3) the PEG does not rule out "other manners of amendment", even though the PEG provides that amendments must not only comply with the relevant principles, but also be in one of the following ways in ordinary cases: deletion or combination of claims, and deletion of technical solution.

The above legal opinion naturally raises the following legal issue: with regard to amendments to claims in patent invalidation proceedings, especially "other manners of amendment" not specified in the PEG, what is mandate and

responsibility on the part of PRB to review them? To answer it, this paper will first present an overview of the legal context, then make a summary of the entire proceedings of the Jahwa case, the SPC's decision in particular, and finally examine the case in the light of the patent regime as a whole, by answering the following three questions: (1) the legal character of amendment to claims in patent invalidation proceedings; (2) the PRB's mandate to review such amendments; and (3) the PRB's responsibility to examine such amendments. By "mandate" is meant what PRB "may" do; by responsibility is meant what PRB "must" do.

I. Legal context

The Chinese Patent Law (the CPL) provides only that an applicant may amend patent application,¹ saying nothing about whether a patentee may amend the claims of a patent as issued. However, the IRCPL allows a patentee to do so in patent invalidation proceedings. Rule 68, paragraph one, of the IRCPL as of 2001 (or Rule 69, paragraph one, of the IRCPL as of 2010) provides that in patent invalidation proceedings, a patentee for an invention or utility model patent may amend the claims, but must not broaden the scope of protection for the original patent.

The PEG further provides for the principles and manners of amendments to claims in patent invalidation proceedings. Specifically, Sec.4.6, Chapter 3 of Part 4 the PEG provides that any amendment to the documents of a patent for invention or utility model shall be limited to the claims only, and

shall follow the following “principles” (hereinafter “principles of amendment”): (1) the title of the subject matter of a claim cannot be changed; (2) the scope of protection cannot be broadened as compared with that in the patent as issued or granted; (3) the amendment shall not go beyond the scope of disclosure contained in the initial description and claims; and (4) addition of technical features not expressed in the claims as granted is generally not allowed.² Furthermore, in addition to the above principles, the manners of amendment to the claims are generally limited to deletion or combination of claim(s), or deletion of technical solution(s) (hereinafter “manners of amendment”). The Jahwa case mainly involved deletion of technical solution, i.e., deleting one or more technical solutions of the two or more technical solutions standing in parallel in the same claim.³

II. Proceedings

Jahwa filed an application with the State Intellectual Property Office (SIPO) on 19 September 2003 to patent the invention of “amlodipine and irbesartan” (the patent in suit). The patent was granted and published on 23 August 2006, the grant publication number being 03150996.7. Claim 1 was in dispute, which went as follows: “1. A compound preparation, characterized in that the preparation is a pharmaceutical composition comprising active ingredients amlodipine or amlodipine physiologically acceptable salt, and irbesartan, in 1: 10-30 proportion by weight.”

Directed to the patent in suit, Li Ping requested in June 2009, the PRB to declare claims 1-4 invalid on the grounds, *inter alia*, that said patent was granted in violation of Article 26, paragraph four, of the CPL, which provides that “claims shall be supported by the description”.

In September 2009, the PRB held an oral hearing, at which Jahwa filed the text of the amended claims, with ratio “1:10-30” in the Claim 1 being changed into “1:30”. The PRB decided at the hearing that the amendment was not in compliance with the PEG, and refused to review the case on the basis of the claim as amended. The PRB relied on two grounds. First, the amendment violated the “principles of amendment” set forth in the PEG. The PRB found that the amended technical solution cannot be “unambiguously” derived from the original claims and description, thus going beyond the disclosure of the original claims and description. By the amendment, a specific ratio is chosen from a range of continuous ratio as claimed. The specific ratio relationship

was not recited in the original description and claims, and there was not teaching on it. While a combination of amlodipine 1mg/kg and irbesartan 30 mg/kg were disclosed in the description, it only indicated the composition of a specific dosage of the medicaments, not showing a ratio relationship in its entirety. Additionally, on page 10 of the original description, the specific dosage of the medicaments is clearly defined: “the dosage for the present invention is: amlodipine: irbesartan = 2-10mg: 50-300mg”. It is not certain that any composition with the ratio 1:30 could produce the same effect as the composition following the above dosage.

Second, the amendment was not made in one of the manners as specified in the PEG. “Deletion of technical solution(s)” under the PEG is “deletion of one or more technical solutions of the two or more technical solutions standing in parallel in the same claim”. For Claim 1 as granted, “1:10-30” was “one technical solution”, not “two or more technical solutions standing in parallel”. And thus changing it into “1: 30” was not a deletion of technical solution(s) within the meaning of the PEG. For these reasons, the PRB did not proceed with the review of changed Claim 1. Relying on the patent as granted, the PRB held that the relevant claim was not in conformity with Article 26, paragraph four, of the CPL, and declared the patent in suit invalid by the decision WX 14275.

Dissatisfied with the PRB’s decision, Jahwa brought an administrative suit. The Beijing No. 1 Intermediate People’s Court supported the PRB’s argument, and upheld the decision in suit.⁴

Jahwa appealed again to the Beijing Higher People’s Court. It argued that “according to the PRB’s practice, if a patentee has deleted a technical solution under the PEG, there is no need for PRB to examine whether the amendments comply with Article 33 of the CPL”, which provides that “an applicant may amend his patent application, provided that the amendment to the invention or utility model patent application does not exceed the scope specified in the original written descriptions and claims...”. The court supported Jahwa, finding that the amendment Jahwa made in the patent invalidation proceedings “does not broaden the extent of protection of the patent in suit, nor go beyond the disclosure of the original description and claims, nor add any technical feature that was absent in the claims as granted. The court held that the PRB “shall” accept the amendment, and review the invalidation request on the basis of the amended claim.⁵

This time, it is the PRB that was not satisfied with the final decision. The PRB then filed a petition with the SPC for *certiorari*. The PRB argued that the amendment Jahwa made was not in compliance with the “manners of amendment” specified in the PEG, and the PRB should not accept it for the purpose of proceeding with the invalidation request.

Upon examination, the SPC held that amendments to the claims made in patent invalidation proceedings must comply with the IRCPL and PEG, specifically the “principles of amendment” and “manners of amendment”. First amendments should satisfy the “principles of amendment” as provided in the PEG, in particular “amendment made to the claims in the invalidation proceedings should not go beyond the scope of the original description and claims”. However, the SPC found that the ratio 1:30 was disclosed in the description, and that said amendment did not go beyond the disclosure of the original description and claims. The reasons were: the description disclosed the combination of amlodipine 1mg and irbesartan 30 mg; took amlodipine 1mg/kg and irbesartan 30mg/kg as the optimal dosage ratio; and in the embodiment for making tablets, there were also compositions with the 1:30 ratio.⁶

Then, the SPC held that amendments to the claims made in the patent invalidation proceedings, while satisfying the “principles of amendment” as provided in the PEG, should also generally follow the “manners of amendment” as specified in the PEG, i.e., “deletion of claims, combination of claims, and deletion of technical solution(s)”, but the PEG does not preclude “other manners of amendment”. The IRCPL and the PEG limit possible amendments to claims in the invalidation proceedings primarily on the following two grounds: to safeguard stability of the scope of patent protection by upholding the public notice function of claims; and to prevent elements discovered later than the filing date from being given an unjust priority by forbidding a patentee from incorporating into claims by virtue of later amendment a technical solution that was absent, or, at least, not reflected in the description on the filing date. In the present case, while the original claim comprising the technical solution 1:10-30 was not a typical one where two or more technical solutions stand in parallel, the ratio 1:30 was explicitly presented in the description as the best dosage ratio. Said amendment neither went beyond the scope of the original description and claims, nor broadened the extent of protection of the original patent. Rather, the amendment rendered the extent of protection more clear and specific, and would not make it fuzzy

or confusing. In justice, the amendment should be permitted.

III. Analysis and comments

1. Legal character of amendments to claims made in patent invalidation proceedings

What kinds of amendments made to claims in the patent invalidation proceedings are allowable are closely related to their legal character. Under the current Chinese patent system, such amendments follow the domain of “disposal by the party concerned”. By an amendment to a claim in the patent invalidation proceedings, the patentee admits that the claim subject to the amendment has the defects pointed out by the requester and that the claim must be invalid *ab initio*. According to the PEG, “in the invalidation procedure, if, in response to the request for invalidation, the patentee narrowed the scope of protection of the patent right on his own initiative and the corresponding amendment was accepted by the Patent Reexamination Board, then it shall be deemed that the patentee admitted that a larger scope of protection is contrary to the relevant provisions of the Patent Law and its Implementing Regulations and acknowledged the request for invalidation concerning the claim, and thus the burden of proof on the petitioner for invalidation of the said claim is exempted.”⁷

As for the claim as amended, the PRB follows the same principle: the PRB does not make a comprehensive examination of its validity in the light of the CPL and IRCPL, absent any grounds raised by the requester. The PEG proceeded on the presumption that so long as an amendment complied with the “principles of amendment” and “manners of amendment”, the resulting amended claim must be valid under the CPL and IRCPL, and should be allowed.⁸ Only when the requester raises a new ground for invalidation should the amended claim be examined or reviewed accordingly. The PEG provides specifically that “in the invalidation procedure, the Patent Reexamination Board usually performs examination pursuant to the scope requested by the petitioner and only on the causes and evidence submitted by the parties concerned, and does not have the obligation to comprehensively examine the validity of the patent.”⁹ This rule applies to amended claims as well. If the requester makes it clear that he would not raise any new grounds with regard to the amended claims obtained from combination of claims, the PRB would not review the claims as amended any more.¹⁰ If the requester does raise new grounds in the above case

within the specified time limit, and makes corresponding arguments and produces relevant evidence,¹¹ the PRB will examine the validity of the claim as amended on the grounds both as originally filed and newly raised.

The parties may even reach a settlement on the amended claims. In practice, when the requester compromises with the patentee on the extent of protection on the basis of the amended claim, the PRB would maintain the amended patent as valid if the PRB, upon review, is satisfied that the amendments comply with “principles of amendment” and “manners of amendment” specified in the PEG. Due process requires limitation on the time when a patentee may file an amendment to claims in the patent invalidation proceedings. Deletion of a claim or a technical solution in response to an invalidation request is equal to a complete admission of the request, and the PEG allows the patentee to file such amendment at the oral hearing.¹² As for combination of claims, it is possible that the claim as amended may not satisfy statutory requirements for patenting; and thus the requester may need time to raise new grounds and collect relevant evidence. As a result, such amendment must be filed within a specified time limit under the PEG.¹³

2. PRB’s mandate to review claims as amended in patent invalidation proceedings

Should an amendment to a claim made in the patent invalidation proceedings be accepted so long as the PRB confirms that the patentee narrows down the extent of protection for the patent? When appealing to the Beijing Higher People’s Court, *Jahwa* argued for this position. In fact, Rule 68, paragraph one, of the IRCPL merely provides that an amendment to an invention or utility model patent during patent invalidation proceedings, “must not broaden the original extent of protection”, without mentioning any other conditions. According to this argument, issues such as whether the amendment goes beyond the original disclosure of the patent, whether the amended claim is supported by the description, fall outside the PRB’s mandate when the PRB considers whether to accept the amendment. The PRB should leave the issue to the parties as to whether the claim as amended should be protected by a patent or not, observing the principle of disposal by interested parties. Only when the requester challenges the validity of the amended claim on specific grounds should the PRB examine the claim accordingly.

The Beijing Higher People’s Court supported this argument in part. On the one hand, the court found that “the a-

ment” *Jahwa* made in the patent invalidation proceedings “does not broaden the extent of protection of the patent in suit, nor go beyond what was recited in the original description and claims, nor add any technical feature that was not present in the claims as granted”. The court ordered the PRB to accept the amendment, and to review the invalidation request on the basis of the amended claim.

On the other hand, the court did not hold that all amendments that do not broaden the extent of protection of the patent as granted in compliance with Rule 68, paragraph one, of the IRCPL, may serve as the basis of examination for the purpose of the patent invalidation proceedings. The court did not think that the “principles of amendment” and “manners of amendment” under the PEG are the sufficient and necessary conditions for the PRB to “accept” an amendment made to claims in the patent invalidation proceedings.¹⁴ To the condition of not broadening the extent of protection of the patent as granted, the court added two conditions: amendment should not go beyond what is recited in the original claims, and should not incorporate any technical feature that is not present in the claims of the patent as granted.

These two conditions are well grounded. The patent invalidation procedure is designed to rectify, rather than to replace, the patent prosecution procedure before the Patent Office. In other words, the PRB should not consider during the patent invalidation proceedings a technical solution that has not been considered by the Patent Office, a technical feature that is absent in the claims of the patent as granted. Otherwise, the arrangement for amendment to claims in the patent invalidation proceedings would be reduced into a backdoor for the patentee to secure patent through circumventing the stringent substantive examination procedure before the Patent Office. The court thus suggested that the principle for disposal by interested parties is not good with regard to amendments to claims made in patent invalidation proceedings.

The SPC does not support the Beijing Higher People’s Court’s opinions in full. The SPC held that the PRB “may” decide whether to accept a claim as amended by a patentee according to the “principles of amendment” and “manners of amendment” under the PEG. In *Jahwa*, the SPC, in fact, approached the dispute from these two aspects. In holding that there was no violation of the “principles of amendment”, the SPC suggested that where an amendment “is likely to cause adverse consequences, such as rendering the claim fuzzy or confusing”, PRB may reject the amended claim. By

so holding, the SPC effectively authorised PRB to review amended claims before accepting them under Article 26, paragraph four, of the CPL, which provides that “claims shall be clear..., concisely define the scope of protection sought”.¹⁵ This condition is not part of the “principles of amendment” and “manners of amendment” specified in the PEG. But it is unclear whether “the adverse consequences” meant by the SPC covering any non-compliance with the statutory conditions for granting patent. For example, whether the PRB may examine, *ex officio*, whether an amendment to be made to the claims in the patent invalidation proceedings (i.e. the ratio “1:30” for the present case) is supported by the description, and refuse to accept the claims as amended as the a basis for further proceedings?¹⁶

As for the “manners of amendment” under the PEG, which are more formalistic than the “principles of amendment”, the SPC held the PRB’s interpretation of “deletion of technical solution” too demanding. In the SPC’s view, the PEG only provides that manners of amendment are normally confined to deletion or combination of claim(s), or deletion of technical solution(s), without completely ruling out “other manners of amendment”. According to the SPC, whether an amendment to claims is acceptable or not should be reviewed in the light of the two major reasons for the IRCPL and the PEG to confine amendments to claims in patent invalidation proceedings,¹⁷ rather than in an over-formalistic fashion.

However, the SPC did not, in any way, inform the full scope for PRB’s mandate to review claims as amended in the patent invalidation proceedings. In Jiahwa, the SPC has left the concept of “other manners of amendment” undefined, without even offering any explanatory examples. The legal uncertainty is thus considerable. For instance, the three manners of amendment as now recognised in the PEG are conditioned upon satisfying the “principles of amendments”. For the “other manners of amendment”, a notable question is whether the PRB may require any prerequisites, other than the “principles of amendments”? Or the PRB only needs to consider whether “other manners of amendment” are in line with the “two major reasons” suggested by the SPC which underlies the IRCPL and the PEG for regulating amendments to claims in the patent invalidation proceedings? Besides, when should an amendment in any other manner be filed, so as to ensure a fair and equitable procedure for the parties?

Thus, the SPC in the Jiahwa case failed to answer the more fundamental question: what should the PRB’s mandate

be with respect to reviewing claims amended in the invalidation proceedings and to what extent the principle for disposal by interested parties should be limited?

3. PRB’s responsibility to review claims amended in patent invalidation proceedings

In Jiahwa, the SPC has left the following question unanswered: Is the PRB responsible for reviewing, or required to review, the claims as amended in patent invalidation proceedings in the light of the “principles of amendment” and in the “manners of amendment” under the PEG? Where the PRB fails to do so, may the requester bring a suit against PRB, requesting the court to order the PRB to fulfill this duty?

In theory, the PRB shall shoulder this duty. When a third party files an invalidation request, it is impossible for him to foresee whether and how the patentee would amend his claims, let alone raise corresponding grounds to challenge the claims not yet amended and collect the relevant evidence. More importantly, the “principles of amendment” and “manners of amendment” under the PEG are not “grounds for invalidation” specified in Article 65 of the IRCPL. In particular, a third party may not file a request with the PRB, asking the latter to declare a given claim invalid on the ground of a violation of Rule 69, paragraph one, of the IRCPL that the claim as amended has an extent of protection broader than the original one. It is no availing to resort to Article 33 of the CPL, either. This article applies only to “patent application”, not to a patent as granted. If the PRB has no duty to examine claims as amended, it is equal to saying that patentees may amend the claims in patent invalidation and preserve patent right subject only to the willingness of the requester.

Then, what is the scope of this duty? In the wake of Jiahwa case, this question became increasingly important. The SPC permitted “other manners of amendment”, so long as the claim as amended does not broaden the extent of protection of the patent as granted and does not go beyond the disclosure of the description and claims as filed. However, these two conditions fall far short of the statutory conditions for granting a patent, which are specified in the CPL and IRCPL. If the principle for disposal by interested party governs, apart from examination for the above two conditions, claims as amended may be allowed easily: for a utility model patent, the amended claims will give rise to exclusive rights upon another formal examination; for an invention patent, the claims as amended will only have to go through less substantive examination before giving rise to exclusive rights than other un-amended claims having undergone examination before

the Patent Office. But the patent invalidation procedure is not designed to lower the requirements for patenting, but to ensure that trade freedom is not interfered with by erroneous granted patents. Allowing patentees to amend claims in response to an invalidation request without requiring the PRB to examine in full the validity of the amended claims is liable to open backdoor to grant questionable patents.

In other words, where a patentee is allowed to amend claims in the invalidation proceedings in the light of the “principles of amendment”, the principle for disposal by interested parties should no longer govern, and the PRB should have the duty to comprehensively examine the validity of the claims as amended. Only those claims which have passed through full substantive examination are entitled to the presumed validity. This is the practices in the developed countries. As early as 1990, the EPO Technical Board of Appeal (TBA) pointed out in T472/88 that “where amendments are requested by a patentee in the course of opposition proceedings; Article 102 (3) of the EPC confers upon the Opposition Division as well as the Boards of Appeal jurisdiction, and thus the power, to consider the whole of the EPC.”¹⁸ This holding was affirmed by the Enlarged Board of Appeal (EBA),¹⁹ and now is a rule of law under the European Patent Convention (EPC).²⁰ As a result, the TBA has the power to examine the validity of claims as amended in opposition in the light of the whole EPC, but has only limited power to review claims as granted in the light of the specified grounds under Article 100 of the EPC.²¹ Furthermore, an opponent may request the TBA or EBA to order additional search for the amended claim in opposition in order to facilitate comprehensive examination of amended claims.²²

Some may counter the above position, arguing that in view of the backlog of patent invalidation cases, the PRB does not have the resources to do comprehensive examination of the validity of amended claims. And it is likely that patentees may abuse this procedure to prolong unjustly the invalidation proceedings. First of all, requiring the PRB to comprehensively examine amended claims does not mean requiring it itself to do so. The PRB may authorise the relevant departments of the Patent Office to make the substantive examination. Where he is not satisfied with the decision made upon such examination, the requester may be allowed to raise new grounds, among those specified in Rule 65 of the IRCPL for requesting invalidation. Second, patentees are not motivated to prolong invalidation proceedings. By amending a claim, the patentee admits that the claim is invalid

ab initio; the patentee may not enforce that claim any more. On the other hand, the claim as amended is pending examination, and may not be relied upon to bring an infringement lawsuit against any third parties. Therefore, it is not in the interests of the patentee to prolong the invalidation proceedings by amending claims. Where he makes an amendment, he must do so in order to obtain a fair protection for his invention.

In conclusion, when the SPC required in *Jahwa* the PRB to allow “other manners of amendment” to claims in patent invalidation proceedings, it should have also required the PRB to abandon the “principle for disposal by interested parties”, and to shoulder the responsibility for examining fully the validity of the claims as amended in the light of the whole patent law. ■

The author: IP law faculty member of the Guanghua Law School of Zhejiang University, PhD in laws graduated from Peking University Law School, email: zjuhwh@gmail.com

¹ Article 33 of the CPL as of 2008: An applicant may amend his or its application for a patent, but the amendment to the application for a patent for invention or utility model may not go beyond the scope of the disclosure contained in the initial description and claims, and the amendment to the application for a patent for design may not go beyond the scope of the disclosure as shown in the initial drawings or photographs.

² Section 4.6 Amendments Made to Claims in the Process of Invalidation, Chapter 3 of Part 4 of the PEG, P.385.

³ *Ibid*.

⁴ The Beijing No. 1 Intermediate People’s Court’s Administrative Judgment No. Yizhognzhixingchuzi 1364/2010.

⁵ The Beijing Higher People’s Court’s Administrative Judgment No. Gaoxingzhongzi 1022/2010.

⁶ Embodiments 1 and 2 for preparation of tablet on Pp.10-11 of the patent in suit respectively disclosed the combination of amlodipine 2.500mg and irbesartan 75.00mg and the combination of amlodipine 5.000mg and irbesartan 150.000mg.

⁷ The PEG 2010, P.375.

⁸ See the PRB’s Patent Invalidation Decision No. WX11742 (23 June 2008).

⁹ The PEG 2010, P.380.

¹⁰ See PRB’s Patent Invalidation Decision No. WX 13407 (18 may 2009).

¹¹ The PEG 2010, P.382.

¹² The PEG 2010, P. 386.

¹³ *Ibid* (The patentee may amend the claims by the way of combination

within the time limit for response only in one of the following circumstance: (1) in response to the request for invalidation; (2) in response to causes for invalidation or evidence added by the petitioner; (3) in response to causes for invalidation or evidence not mentioned by the petitioner, but introduced by the Patent Reexamination Board.)

¹⁴ In the Judgment, the SPC held: “it is not erroneous for the court below to hold that the amendment is compatible with the PEG”. But the Beijing Higher People’s Court did not consider—let alone accept—the “principles of amendment”. Otherwise, it would have clearly considered whether the amendment “1:30 ratio” went beyond the disclosure of the description and claims of the original patent.

¹⁵ The SPC suggested that the PRB may examine claims as amended in the light of “scope of *ex officio* examination” under the PEG. See the PEG 2010, P.380.

¹⁶ In the case, the SPC only pointed out in the Judgment: “whether all the technical solutions of said ratio relations can achieve the objective of the patented invention is related to whether the claims are supported by the description, i.e., an issue under Article 26, paragraph four, of the CPL. It is improper to find on that account that the amendment goes beyond the disclosure of the patent as filed.” the SPC did not make any comment on whether it is possible not to accept the amended claim on the ground of Article 26, paragraph 4, of the CPL.

¹⁷ The Supreme People’s Court’s Administrative Judgment (No. Zhixingzi 17/2011 (the “IRCPL and the PEG limit possible amendments to claims in invalidation proceedings primarily on the following two grounds: to safeguard stability of the scope of patent protection by up-

holding the public notice function of claims; and to prevent to elements discovered later than the filing date from being given an unjust priority by forbidding a patentee from incorporating into claims by virtue of later amendment a technical solution that was absent, or, at least, not reflected in the description on the filing date”).

¹⁸ See T472/88 (“where amendments are requested by a patentee in the course of opposition proceedings; Article 102(3) of the EPC confers upon the Opposition Division as well as the Boards of Appeal jurisdiction, and thus the power, to consider the whole of the EPC.”). Also see T 227/88; T 301/87; T 367/96; 853/02; T 648/96. Under Article 99 EPC 2000, within nine months from the publication of the mention of the grant of the European patent in the European Patent Cassette, any person may give notice to the European Patent Office of opposition to that patent pursuant to the Regulations for the EPC.

¹⁹ See G9/91 (“In order to avoid any misunderstanding, it should finally be confirmed that in case of amendments of the claims or other parts of a patent in the course of opposition or appeal proceedings, such amendments are to be fully examined as to their compatibility with the requirements of the EPC”).

²⁰ The EBA only consider and decide on important issues of law referred to it by the Board of Appeals and the Director of the EPO under Article 112, paragraph one (a) and (b), of the EPC. The EBA is equivalent to rules of law under the EPC.

²¹ See T227/88, OJ 1990, 292; G 9/91, OJ 1993, 408; T472/88; T922/94.

²² See the Guidelines for Examination in the European Patent Office (April 2010) Part D-Chapter VI.