Latin in IP: *Reformatio in peius*

Following historical traditions in the legal field, a number of Latin expressions are commonly used in IP case law. Using a single Latin term avoids having to translate a legal concept differently into every language. This article explores one such concept, the *reformatio in peius*.

Reformatio in peius

One of the Latin phrases frequently used in decisions of the Boards of Appeal (BoA) at the European Patent Office (EPO) is the legal concept of the prohibition of reformatio in peius. The prohibition of *reformatio in peius* has become a well-established principle in appeal proceedings before the EPO.

Literally, *reformatio in peius* means »amendment for the worse«. This terminology refers to situations where the sole appellant would, as a result of its own appeal, be put in a worse position than if it had not appealed the underlying first instance decision.

Legal basis and rationale

A basic prerequisite for admissibility of an appeal is that the appellant must be adversely affected by the impugned decision, see Art. 107 EPC, first sentence. As a consequence, the prohibition of *reformatio in peius* is guided by the principle of law that the aim of appellant's appeal is to remove the »adverse effect« of the appealed decision for the appellant.

This principle of law applies to *inter partes* appeals (again, a Latin term!), where the sole appellant seeks to reverse an entirely, or at least partly, negative decision of the Opposition Division.

No *reformatio in peius* in *ex parte* appeal proceedings

In *ex parte* (Latin again!) cases at the EPO, at the end of examination the EPO invites the applicant to approve the text for grant. If the applicant approves, there is no adverse effect and, hence, no possibility of appeal. If the applicant does not approve the text, or the Examining Division considers that no allowable text exists, the only possible decision is refusal of the application in its entirety. Thus, the situation cannot get worse for the appellant before the Boards of Appeal.

As a consequence, the concept of prohibition of *reformatio in peius* cannot be applied to *ex parte* appeals. The Boards of Appeal are free to raise new objections or to consider new prior art *ex officio* (again, a Latin term!), even if this leads to a refusal of a request which the Examining Division prior to refusal of another request might have considered allowable.

***Reformatio in peius* in *inter partes* appeal proceedings**

The situation is different in inter partes proceedings, i.e., proceedings between multiple parties, such as opposition appeals.

Multiple appellants

If both sides file an appeal, a prohibition of *reformatio in peius* does not apply. By the requests and interests of both sides – Patentee and Opponent(s) – the first instance decision is normally at stake in its entirety. Applying the prohibition of *reformatio in peius* for one party would run counter to the aim of the appeal of the other party.

Sole appellant and party as of right

Specific situations for applying the prohibition of *reformatio in peius* in inter partes proceedings arise only where there is a sole appellant. According to Article 107 EPC, second sentence, the non-appealing party is then merely a party as of right, either because it was not adversely affected by the impugned decision or because it deliberately decided not to appeal.

A party as of right can make appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the first instance. However, it is the sole appellant's initial request that determines the extent of the proceedings. This follows from the principle of party disposition (»*ne ultra petita*«, again a Latin term; see G 4/93, Reasons 1 and 11).

Patentee as sole appellant

If the patent has been upheld in an interlocutory decision in amended form and the sole appellant is the patentee, neither the Board of Appeal nor the party/parties as of right can challenge the maintenance of the patent in the form underlying the first instance decision, in application of the prohibition of *reformatio in peius* (see Headnote I of G 4/93).

Consequently, if the patentee's appeal is dismissed, the first instance decision becomes final. The Board of Appeal is not allowed to reconsider the validity of the claims upheld by the Opposition Division in such a scenario. In the logic of the Enlarged Board of Appeal, this is balanced by the possibility of national revocation actions – now also before the Unified Patent Court (UPC) – that can be initiated by opponents, at their own volition, at any time (see G 1/99, Reasons 4.1).

Opponent as sole appellant

Conversely, if the opponent is the sole appellant to an interlocutory decision, the patentee as a party as of right is restricted to defending the patent in the form in which it was upheld in the interlocutory decision, or in a further limited form.

For a party as of right under Article 107 EPC, second sentence, there is no right to file a »cross appeal« without time limit (see G 4/93, Reasons 16). The patentee is not allowed to request a broader (or otherwise »better«) version of the patent than that underlying the appealed decision, as this would put the opponent as sole appellant in a worse situation than if it had not appealed (see G 1/99, Headnote).

The EPO case law thus reflects the long established principle of the prohibition of *reformatio in peius*. Like most legal rules, however, this Latin principle has its exceptions.

Exceptions under G 1/99

G 1/99 formulated narrow exceptions to the principle of prohibition of *reformatio in peius* for situations in which the patentee has not appealed, an inadmissible amendment was erroneously held allowable by the Opposition Division in its interlocutory decision, and the patent was maintained with this amendment.

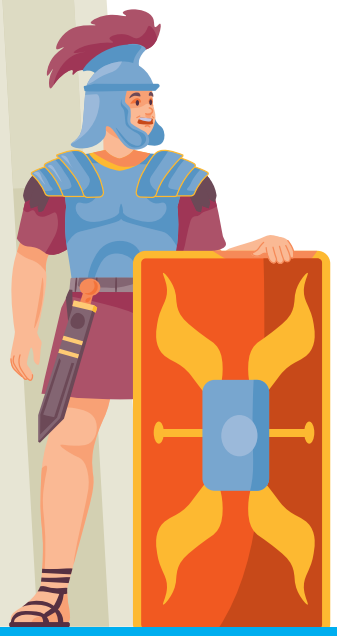
If, in such circumstances, the patent would have to be revoked because an objection (for example under Article 123(2) EPC) raised by the Board or by the Opponent as sole appellant could not be overcome without violating

the prohibition of *reformatio in peius*, certain options for alternative requests are available to the patentee, but only under strict conditions:

1. **Primary option – further limitation**
   The patentee must first attempt to amend the claims by introducing one or more originally disclosed features that limit the scope of the patent as maintained. This remains fully in line with the prohibition of *reformatio in peius*.
2. **Secondary option – controlled extension within Article 123(3) EPC**
   Only if this is not possible, the patentee may amend the claims by introducing one or more originally disclosed features (thus compliant with Article 123(2) EPC) that, however, **extend** the scope of the patent **as maintained**, provided that the amended claims still comply with Article 123(3) EPC, i.e., they must not be broader than the claims as granted.
3. **Tertiary option – deletion of the inadmissible amendment**
   Finally, if even this second option is not possible, the patentee may delete the inadmissible amendment altogether, again only within the limits of Article 123(3) EPC.

Whether any of these strict and narrowly construed exceptions is available at all depends heavily on the specific facts of the individual case.

These exceptions are designed to provide a fair balance for the patentee, who has no further options at a later stage (i.e., in national revocation proceedings or in UPC revocation proceedings) if the patent is revoked, in situations where the crucial mistake lies in the interlocutory decision of the Opposition Division – a decision on which the patentee relied when choosing not to file its own appeal.



Strategic recommendations for patentees

In view of the legal principles outlined above, patentees are generally well advised to:

- **Always consider filing an appeal** when the patent has been upheld in amended form, even if the upheld claims appear acceptable at first sight. Otherwise, one risks having no, or only very strictly limited, possibilities to revert to broader or different claim sets if required later (for example, if an unforeseen Article 123(2) EPC issue arises during appeal).
- **Avoid withdrawing an appeal** at least as long as an opponent's appeal is still pending and no preliminary opinion of the Boards of Appeal has been issued. Maintaining one's status as an appellant preserves one's full procedural rights and mitigates the risk of being constrained by the prohibition of *reformatio in peius*.

Strategic recommendations for opponents

For opponents, it may likewise be advisable to file their own appeal in order to preserve all procedural rights available to a full party to the appeal, including the ability to challenge the patent beyond the framework set by another party's appeal.

Conclusion: Latin still matters

The case law surrounding *reformatio in peius* illustrates how a seemingly archaic Latin expression continues to shape modern EPO appeal proceedings. Balancing the aim of avoiding a worsening of the sole appellant's position with the principle of party disposition (*ne ultra petita)* has led to a sophisticated body of jurisprudence.

Latin still matters – particularly when it encapsulates complex procedural principles in a single, concise expression.

Dr. Norbert Hansen
/ Partner
/ German Patent Attorney
/ European Patent Attorney
/ UPC Representative
/ Chemist