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Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Case Number: R 0020/10

DECISION
of the Enlarged Board of Appeal
of 25 August 2011

Petitioner: Borealis Technology Oy
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Decision under review: **Decision of the Technical Board of Appeal
3.3.01 of the European Patent Office of
19 February 2010.**

Composition of the Board:

Chairman: P. Messerli
Members: B. Günzel
U. Oswald

Summary of Facts and Submissions

- I. The petition for review concerns decision T 1478/07 of Board of Appeal 3.3.01 of 19 February 2010, setting the decision under appeal aside and revoking the European patent No. 0 837 915.
- II. The petition was filed on 29 November 2010. The fee for the petition was paid on the same day. Petitioner is the patent proprietor, who was one of the appellants in the appeal proceedings. According to the petitioner a fundamental violation of Article 113 EPC occurred before the opposition division.
- III. The petitioner acknowledges that the facts of the case are correctly summarised in decision T 1478/07. The facts of the case are essentially as follows:
1. The oppositions filed against the patent were based on the grounds of lack of novelty and lack of inventive step. The petitioner filed several amended sets of claims. Shortly before the oral proceedings before the opposition division, the petitioner reverted to defending the patent as a main request in the version as granted. In the oral proceedings the opposition division raised the objection that one of the features of claim 1 in the version as granted, i.e. the MFR^{1}_2 value of the first ethylene polymer, was disclosed in the application as filed only in connection with two further additional features which were not contained in granted claim 1. This objection had previously been raised by one of the opponents against amended claims filed by the petitioner. The patent proprietor's main request was held unallowable under Article 123(2) EPC.

The patent was maintained in amended form on the basis of the first auxiliary request filed during the oral proceedings. The petitioner's auxiliary requests filed shortly before the oral proceedings were rejected as late filed.

2. In the course of the appeal proceedings the petitioner filed thirteen sets of amended claims. However, as regards the feature held unallowable by the opposition division, the main request and some of the auxiliary requests still contained that feature.

The board of appeal held the respective claims 1 of these requests to be unallowable under Article 123(2) EPC for the same reason as was given by the opposition division with respect to the main request before it. The remaining requests were rejected for lack of inventive step or lack of clarity and conciseness.

3. The objections raised under Article 100(c) EPC were discussed during the oral proceedings before the opposition division. They were also discussed in the proceedings before the board of appeal.

In the proceedings before the board of appeal the petitioner also objected to the opposition division's introduction of the new ground of opposition under Article 100(c) EPC, and in particular took issue with the fact that no prior discussion had taken place before the opposition division of the *prima facie* relevance of that ground. Furthermore, the petitioner had not been informed by the opposition division of the introduction of the new ground of opposition in a timely manner. The petitioner took the view that the

opposition division had thereby violated Article 113(1) EPC. In view of the procedural mistakes made by the opposition division a remittal of the case to a differently composed opposition division would be justified.

4. In the decision under review the board of appeal held in point 5.3 of the Reasons that it appeared from the minutes of the oral proceedings before the opposition division and the petitioner's own submissions that the legal framework of the admissibility of a new ground of opposition had been discussed (see points 6.1 and 6.2 of the minutes and the statement of grounds of appeal, page 5, second paragraph).

Furthermore, the board reasoned, it cannot be inferred either from the content of decision G 9/91 (or G 10/91) or from decision T 433/93 (cited by the petitioner) that in order to meet the requirements of Article 113(1) EPC, the opposition division must, before discussing the substantive reasons for the objection, give the parties the opportunity to express their views as to the *prima facie* relevance of the introduction of a new ground of opposition (point 5.4 of the Reasons).

The board of appeal may, however, assess whether the opposition division exercised its discretion to admit this new ground of opposition in an unreasonable way. The contested amendment has no explicit basis in the application as originally filed. The contested feature is only explicitly disclosed in the application as filed in connection with the two additional features

mentioned in the decision of the opposition division. This was sufficient to raise a *prima facie* relevant objection because there were clear reasons to believe that such a ground would be relevant (point 5.5 of the Reasons). The board of appeal concluded that the opposition division exercised its discretion in an appropriate manner.

IV. In the petition the petitioner argues essentially as follows:

A violation of Article 113(1) EPC occurred before the opposition division. The reasons justifying that conclusion were set out by the petitioner in great detail in the appeal proceedings. Consequently, the obligation (sic) of Rule 106 EPC is fulfilled.

The petitioner refers in detail, by reproducing *verbatim* large passages taken from decisions of boards of appeal, to case law purportedly having held that the essential legal and factual reasons for introducing new grounds of opposition must be set out in the invitation to the oral proceedings before the opposition division. Furthermore, before the opposition division, the patent proprietor must have a proper opportunity to present comments in reply to the new ground and its substantiation. If this requirement has not been observed, the case must be remitted back to the opposition division.

The present case compares in all material particulars to the facts underlying decision T 433/93, one of the cases referred to by the petitioner in the appeal proceedings. The board's finding under point 5.4 of the

Reasons that it cannot be inferred either from the content of decision G 9/91 (or G 10/91) or from decision T 433/93 that in order to meet the requirements of Article 113(1) EPC, the opposition division must, before discussing the substantive reasons for the objection, give the parties the opportunity to express their views on the *prima facie* relevance of the introduction of a new ground of opposition, is contrary to what was stated *expressis verbis* in G 9/91, point 16. of the Reasons. The Enlarged Board stipulates therein that an examination must be made in respect of the *prima facie* relevance of such a new ground of opposition before the ground is introduced into the proceedings. Therefore, first a discussion must take place on the question whether a new ground for opposition is to be introduced and the parties must be heard on this point. This is because where a new ground is introduced by the opposition division, it will automatically be in the appeal proceedings, even if eventually considered unfounded by the opposition division. By contrast, if the opposition division comes to the decision not to introduce the ground of opposition, this ground is not part of the appeal proceedings. The condition that there must be *prima facie* relevance sets a higher hurdle for the consideration of a new ground of opposition than if that ground was merely required to be relevant.

The decision of the board of appeal does not remedy the procedural mistake made and does not express any special reason for not remitting the case back to the opposition division. There is also a causal link between the procedural mistake and the decision of the board of appeal, since the procedural mistake according

to Article 113 EPC led to the opposition division's admission of the new ground of opposition under Article 100(c) EPC. Based on this new ground of opposition the board of appeal rejected the main request before it in the oral proceedings.

V. The petitioner requested that

- 1.1 the decision of the board of appeal dated 19 February 2010 be set aside and the proceedings be reopened before the board of appeal with members different from those who participated in taking the decision,
- 1.2 the board of appeal be ordered to remit the case back to the opposition division, which opposition division has to be differently composed.

Reasons for the Decision

1. The petition for review of the decision T 1478/07 of Technical Board of Appeal 3.3.01 of 19 February 2010 was filed on 29 November 2010 and thus within two months of the deemed notification of the decision of the board of appeal within the meaning of Article 112a(4), second sentence, EPC in conjunction with Rule 126(2) EPC. The fee for the petition was paid on the same day and, hence, also within the time limit.
2. According to Article 112a(4), first sentence, EPC the petition shall be filed in a reasoned statement. Furthermore, Rule 107(2) EPC stipulates that the petition shall indicate the reasons for setting aside

the decision of the board of appeal and the facts and evidence on which the petition is based. According to Rule 108(1) EPC the Enlarged Board of Appeal shall reject the petition as inadmissible if the petition does not comply with Article 112a, paragraph 1, 2 or 4, Rule 106 or Rule 107, paragraph 1(b) or 2, EPC.

- 2.1 The mandatory requirement set up in the above-cited provisions that the petition shall be reasoned is not a formality.

It is, to the contrary, a very important condition for a petition for review to be admissible. Its function is to ensure that the Enlarged Board only has to deal with the kinds of cases for which the right to petition the Enlarged Board of Appeal was instituted.

It is crystal clear from the preparatory documents relating to the EPC 2000 that the purpose of creating the possibility of judicial review of decisions of the boards of appeal was to provide for an extraordinary and limited legal remedy for cases in which the proceedings before a board of appeal suffer from an intolerable procedural defect as defined in the EPC, i.e. in Article 112a(2) EPC in conjunction with Rule 104 EPC. The function of the petition for review is not to further the development of EPO procedural practice, generally, or to ensure the uniform application of the law (see Synoptic presentation EPC 1973/2000 - Part I: The Articles, OJ EPO 2007, Special edition 4, 126).

It follows that procedural defects having occurred in first instance proceedings may not be the subject of a

petition for review. Decisions of the first instance are subject to judicial review by the boards of appeal. The examination of an appeal includes the examination of any procedural errors allegedly made by the first instance. Thereafter, a party's right to a judicial review of first instance proceedings is exhausted.

Furthermore, as the Enlarged Board of Appeal has held ever since its first decisions R 1/08 of 15 July 2008 (point 2.1 of the Reasons) and R 2/08 of 11 September 2008 (points 5. and 8.3 of the Reasons), the possible grounds for review are exhaustively listed in Article 112a(2) EPC in conjunction with Rule 104 EPC (see likewise e.g. R 10/09 of 22 June 2010, points 2.4 and 2.5 of the Reasons, R 1/11 of 27 June 2011, point 2.2 of the Reasons). This means that any other procedural defect in the proceedings before the board of appeal can only be considered to the extent that it at least allegedly results in one of the procedural defects listed in Article 112a(2) EPC in conjunction with Rule 104 EPC (R 2/08, Headnote 1 and point 8.4 of the Reasons).

2.2 As a consequence of the limited function and potential scope of petition for review proceedings, as defined above, the obligation to file a reasoned statement cannot be construed so narrowly as to mean that any kind of reasoning is sufficient to fulfil this requirement, so long it is only extensive enough. That the petitioner's submissions are extensive cannot be denied, since they extend over nineteen full pages. Those nineteen pages, it must also be said, however, consist largely in the *verbatim* reproduction of

extracts from decisions of boards of appeal, purportedly confirming the petitioner's position.

In order to justify the Enlarged Board examining the merits of a petitioner's case, the complaints made must provide at least a minimum context with a ground which could potentially constitute a ground for revision of a decision of a board of appeal within the terms of the EPC. This can also be inferred from the fact that Rule 106 EPC requires as a condition for the admissibility of the petition that an objection under Article 112a(2)a)-d) EPC is raised in the proceedings before the board of appeal.

- 2.3 A potential ground for review has not been raised in the petition.
- 2.4 The petitioner's complaint that the opposition division (as opposed to the board of appeal) violated its right to be heard falls completely outside the ambit of any of the possible grounds for review listed in the EPC. There is no more to be said on that.
- 2.5 Under the circumstances of the present case as set out below, the same applies to the petitioner's further argument that the board of appeal erred in its finding that the opposition division had exercised its discretion in an appropriate manner. Even assuming for the sake of argument that the petitioner was right in this respect, that would not mean that by (wrongly) deciding the legal question concerning the conduct of the proceedings by the opposition division, the board of appeal had thereby itself violated any of the provisions listed in Article 112a(2) EPC in conjunction

with Rule 104 EPC, such as in particular its right to be heard. The petitioner itself does not even submit that. On the contrary, according to the petitioner's own submissions, all the questions relating to the new ground of opposition raised by the opposition division, i.e. whether the opposition division should have heard the petitioner on the *prima facie* relevance of the objection before admitting it into the proceedings, whether the opposition division exercised its discretion correctly and whether the objections raised against the allowability of the amendment in question were well-founded, were discussed extensively in the proceedings before the board of appeal.

There is hence nothing in the petitioner's submissions that may be regarded as substantiating a ground within the meaning of Article 112a(2) EPC in conjunction with Rule 104 EPC, on which, at least potentially, a petition for review could be based, and the petitioner itself has not indicated any of these as forming a legal basis for its petition. On the contrary, the submissions of the petitioner all boil down to saying that the board of appeal should have decided the issue of the opposition division's admission of the new ground of opposition differently from how it did. In this respect, the Enlarged Board only notes that, the board having decided that the feature in question offended against Article 123(2) EPC, it is difficult to imagine how it could nevertheless justifiably have come to the conclusion that in admitting the new ground of opposition into the proceedings the opposition division exercised its discretion wrongly.

As has also been acknowledged in decision R 1/11 (point 2.2 of the Reasons, final sentence) a petition may not be used as a vehicle to review the merits of the decision of a board of appeal, even to the extent that that decision relates to procedural issues, as long as a wrong application of rules of procedure does not result in any of the defects listed in Article 112a(2)(a)-(d), in conjunction with Rule 104 EPC.

Since this has not been submitted in the petition, for this reason alone it has to be rejected as clearly inadmissible.

3. Furthermore, there is also nothing in the petition for review indicating that during the appeal proceedings the appellant raised the objection of a fundamental procedural violation falling within one of the grounds on which a petition for review can be based being committed by the board of appeal itself if the board was to decide or because it did decide that the opposition division had exercised its discretion correctly and that, therefore, it would not remit the case to the opposition division. Nor has the petitioner submitted that it only became aware from the reasons of the decision of the board of appeal that it decided this issue in the way it did. On the contrary, the board had already indicated in its provisional opinion that it was not inclined to follow the petitioner's interpretation of decisions G 9/91, G 10/91 and T 433/93, as regards the issue of what the opposition division must discuss with the parties before it may decide to introduce a new ground of opposition into the proceedings. In the oral proceedings before the board, the requests in question were undisputedly also

discussed with respect to their compliance with Article 123(2) EPC, which implies the board's position that the opposition division had exercised its discretion appropriately by admitting the ground of opposition into the proceedings. Hence, the requirements of Rule 106 EPC are not fulfilled either in the present case.

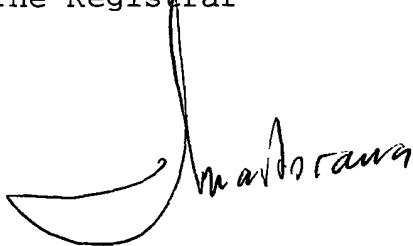
Accordingly, the petition must be rejected as clearly inadmissible, since pursuant to Rule 108(1) EPC a defect within the meaning of Article 112a(4) EPC and Rule 106 EPC cannot be remedied after the expiry of the period for filing the reasoned petition.

Order

For these reasons it is unanimously decided that:

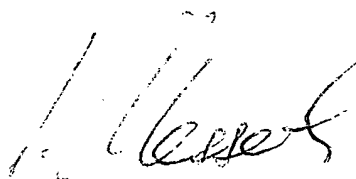
The petition for review is rejected as clearly inadmissible.

The Registrar



P. Martorana

The Chairman:



P. Messerli

