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**Datasheet for the decision
of the Enlarged Board of Appeal
of 22 June 2010**

Case Number: R 0010/09
Appeal Number: T 1515/06 - 3.2.02
Application Number: 95916308.0
Publication Number: 0827417
IPC: A61M 37/00
Language of the proceedings: EN

Title of invention:
Apparatus for conditioning gas

Patentee:
Lexion Medical, LLC

Opponent:
OII - Trudell Medical International

Headword:
-

Relevant legal provisions:
EPC Art. 112a, 113(1), 114(2), 111(1)
EPC R. 104, 106, 109(2)(a)
RPBA Art. 12(2)(a), 12(4), 13(1)

Keyword:
"Petition for review - clearly unallowable"

Decisions cited:
-

Catchword:
Exercise of discretion - not subject to review



Case Number: R 0010/09

D E C I S I O N
of the Enlarged Board of Appeal
of 22 June 2010

Petitioner:
(Patent Proprietor)

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St. Paul
MN 55112-2750 (US)

Representative:

Schäfer, Horst
Schweiger & Partner
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Other Party:
(Opponent II)

Trudell Medical International
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Representative:

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Decision under review:

Decision of the Technical Board of Appeal
3.2.02 of the European Patent Office of
4 March 2009, and remitted to the post for
notification on 20 April 2009.

Composition of the Board:

Chairman: P. Messerli
Members: J.-P. Seitz
P. Ranguis

Summary of Facts and Submissions

- I. European patent No. 0827417 relating to an apparatus for conditioning gas was granted to Lexion Medical, LLC. Mention of this grant was published in the European Patent Bulletin on 10 March 2004.

Two notices of opposition were filed on 10 December 2004 respectively by

OI: Pall Corporation (USA) having G. Wössner as authorised representative.

OII: Trudell Medical International (Canada) having T. Albrecht as authorised representative.

The patent was opposed under the respective grounds of opposition of Articles 100(a) and (b) EPC.

With its interlocutory decision posted on 16 August 2006 the opposition division maintained the patent in amended form.

- II. With letter dated 27 September 2006 Dr T. Albrecht acting as professional representative filed an appeal against this decision. Said letter mentioned the names of both opponents, and further identified the patent in suit, its proprietor, and the appealed decision. This letter also contained the requests of the appellant. With letter dated 22 December 2006 Dr T. Albrecht filed the statement of grounds of appeal.

With letter dated 7 July 2008 Dr G. Wössner as professional representative withdrew the opposition in the name of Pall Corporation, i.e. OI.

III. In its reply of 9 July 2007 to the notice of appeal the patent proprietor/respondent requested:

- that the appeal be considered inadmissible since it failed to comply with the requirements of Article 108 and Rule 64 EPC;
- that documents E25 to E27 filed together with the statement of grounds of appeal not be admitted into the proceedings due to their late filing;
- that in case they be admitted the case be remitted to the first instance and the costs accordingly apportioned.

IV. In a communication dated 21 October 2008 annexed to the summons to oral proceedings the Board of Appeal set out its provisional non-binding opinion that:

- the appeal appeared admissible since the corresponding notice allowed the appellant to be identified,
- documents E25 to E27 filed with the statement of grounds of appeal were to be considered as a direct reaction to the adverse decision of the opposition division and should therefore be introduced into the proceedings,

and that in this respect a remittal to the first instance would be inappropriate.

- V. In response to said communication the patent proprietor/respondent by letter of 4 February 2009 maintained its objections and filed observations in respect of the corresponding preliminary opinion of the Board concerning the admissibility of the appeal and of the newly filed documents E25 to E27.

Further the proprietor/respondent disagreed with the preliminary opinion of the Board relating to inventive step, and filed in this respect an auxiliary request, with the sole comment that "Claim 1 has been amended to include the features of Claims 5 and 6".

- VI. Oral proceedings took place on 4 March 2009, at the issue of which the respondent/patentee requested that:
- the appeal be rejected as inadmissible;
 - if the appeal is admissible, that it be dismissed and the patent be maintained as in the contested decision (main request) or with the auxiliary request filed on 4 February 2009;
 - furthermore that the late-filed documents not be admitted into the proceedings:
 - if the late filed documents are admitted, that the case be remitted to the first instance:
 - if the case is remitted, that an apportionment of cost be ordered.

The debate was then closed and after deliberation the Board pronounced its decision that:

- the decision under appeal is set aside and
- the patent is revoked.

No procedural objection under Rule 106 EPC was raised during the oral proceedings held before the Board.

The decision in writing was notified to the parties by letter posted 20 April 2009, and deemed received on 30 April 2009.

VII. On 16 June 2009 the patentee (hereafter the petitioner) filed a petition for review with the Enlarged Board of Appeal pursuant to Article 112a EPC. It paid the corresponding fee on the same day.

As a main request the petitioner requested that the decision T 1515/06 of Board of Appeal 3.2.02 be set aside, proceedings be reopened before the Board of Appeal and the patent be granted as upheld in amended form by the opposition division.

As an auxiliary request the petitioner requested oral proceedings.

The petitioner based its requests on two provisions of law, namely:

- Article 112a(2)(c) EPC on the ground that a fundamental violation of Article 113 EPC occurred, and
- Article 112a(2)(d) EPC together with Rule 106 EPC on the ground that a fundamental procedural defect occurred in the appeal proceedings.

The facts on which the petition for review relied in writing were:

1. The refusal by the Board to admit the single auxiliary request into the proceedings;
 2. the decision by the Board to admit documents E25 and E26 into the proceedings;
 3. the refusal by the Board to remit the case to the first instance while admitting late-filed documents into the proceedings;
 4. the decision by the EPO to reopen appeal proceedings it had already declared closed;
 5. the decision by the Board to admit the appeal.
- VIII. In a communication dated 5 May 2010 pursuant to Article 14(2) of the RPEBA in order to prepare the oral proceedings due to take place on 22 June 2010 the petitioner was informed of the provisional non-binding opinion of the Enlarged Board of Appeal on each point it made in support of its petition for review.

IX. Oral proceedings were held on 22 June 2010. The petitioner presented its case and before closure of the debate it made the following requests:

- as main request,
 - that the decision T 1515/06 of the Board of Appeal 3.2.02 notified with letter dated 20 April 2009, deemed received on 30 April 2009, be set aside,
 - that the proceedings be re-opened before the Board of Appeal and,
 - that the patent be granted as upheld in amended form by the Opposition Division.

- as auxiliary request filed during the oral proceedings,
 - that the decision for which review is sought be set aside, proceedings be re-opened before the Board of Appeal and the case be remitted to the Opposition Division.

Reasons for the Decision

1. *Admissibility of the petition for review*
 - 1.1 The formal requirements for the petition for review according to Article 112a(4) and Rule 107 EPC are met.
 - 1.2 Rule 106 EPC additionally requires as a prerequisite of admissibility of the petition for review that an objection in respect of the procedural defect be raised during the appeal proceedings and dismissed by the

Board of Appeal except where such objection could not be raised during the appeal proceedings.

- 1.3 The Enlarged Board of Appeal accepts that no objection could have been raised before the decision not to allow the petitioner's requests had been notified in writing, since at the time the debate was closed it ignored which would be their fate.
2. The first alleged ground for review consists in the refusal by the Board of Appeal to admit the auxiliary request into the appeal proceedings.

The petitioner although originally relying on the provisions of Rule 106 EPC admitted that they could not constitute a proper legal basis for its petition and relied rather during the oral proceedings on those of Rule 104 EPC which it alleged not to be exhaustive.

- 2.1 According to the petitioner, the decision not to admit an auxiliary request that had been filed within the time limit set by the Board of Appeal itself was a total surprise for it since it was given no opportunity at all to comment on the merits of a request which indeed represented a mere limitation of the granted patent by way of incorporation of dependent claims into claim 1. Further being the respondent in the appeal proceedings it saw no need when filing the auxiliary request in writing to explain why the newly defined subject-matter would be inventive, all the more in a case like this where the patent had been maintained unamended by the Opposition Division.

2.2 That notwithstanding, the decision to admit or not to admit a request into the appeal proceedings is at the discretion of the Board of Appeal. Therefore the way in which this judicial body has exercised its discretion on a procedural matter falls outside the jurisdiction of the Enlarged Board of Appeal since this would need a review of all facts and circumstances of the case, which necessarily would mean entering on the merits of the substantive issue.

Moreover the petitioner, who recognises that admission of new requests is at the discretion of the Board of Appeal, cannot claim that its right to be heard has been infringed in this respect since the issue of admissibility of the auxiliary request has been the object of debate during the oral proceedings held before the Board of Appeal. This is confirmed in the petition itself (page 3, paragraph 2) and also in the decision of which review is sought (page 5, point VIII last paragraph).

Finally the mere fact that a time limit for filing new submissions set by the Board of Appeal in a communication prior to oral proceedings, has been respected by a party does not necessarily mean that any timely submission becomes for that reason alone admissible.

2.3 The discretionary power contained in Article 114(2) EPC, as well as in Article 13(1) RPBA, is as such not subject to review by the Enlarged Board of Appeal, unless under Article 112a(2)c) EPC a fundamental violation of Article 113 EPC occurred while exercising this discretionary power.

Precisely this cannot be the case here since the issue of the admission of the auxiliary request was, as admitted by the petitioner, the object of debate during the oral proceedings held before the Board of Appeal.

- 2.4 That having been said and concerning Article 112a(2)(d) EPC, the Enlarged Board notes that the alleged violation is not included in the list of fundamental procedural defects of Rule 104 EPC. This rule implements Article 112a(2)(d) EPC which provides: "any other fundamental procedural defect as defined in the Implementing Regulations".

The wording of Article 112a(2)(d) EPC is quite clear:

- a petition for review can only be filed on the grounds it specifies
- it leaves it to the Implementing Regulations to define further procedural defects which may justify a petition for review. This implies that what is not defined by the Implementing Regulations does not qualify as a procedural defect in the sense of Article 112a(2)(d) EPC.

Rule 104 EPC is the implementing rule providing two additional fundamental procedural defects to wit, (a) the Board did not hold oral proceedings despite a request to this end; or (b) it omitted to decide upon a request.

- 2.5 Since the list of grounds for review mentioned in Rule 104 EPC is exhaustive and since the Board decided

on the admission of an auxiliary request Rule 104 EPC is of no relevance here.

3. The decision to accept late-filed documents E25 and E26 into the appeal proceedings, but to refuse the request for remittal to the first instance and further to revoke the patent on the basis of one of these documents also constitutes in the view of the petitioner a violation of Article 113 EPC pursuant to Article 112a(2)c) EPC as a second instance was denied the patent proprietor whereas given to the opponent. The petitioner added in this respect that the purpose and function of Article 113 EPC were *inter alia* to ensure that the parties be fairly and equally treated in the proceedings before the EPO. It referred to the principles set out in the Vienna Convention on the Law of Treaties, the European Convention on Human Rights and Fundamental Freedoms, and the Treaty on Trade Related Aspects of Intellectual Property Rights, more particularly to Article 65 of the latter. In its view it was fundamental that judicial decisions remain predictable, and that in *inter partes* proceedings, both parties be guaranteed due process of law, which required equality of treatment.

- 3.1 The Enlarged Board of Appeal considers that there is no need in the present case to decide whether the provisions of the European Convention on Human Rights and Fundamental Freedoms of 4 November 1950 directly apply to the proceedings before the EPO which is not a party to said treaty. Nor can a mere imprecise reference to such other Treaties be decisive in the case in suit.

Indeed the guarantee of due process of law requires primarily that the relevant provisions of law be applied to the facts under consideration; i.e. in the case in suit Article 114(2) EPC together with Article 12(2) and (4) RPBA, as well as Article 111(1) EPC last sentence respectively.

- 3.2 On the one hand it is standing case law under Article 114(2) EPC and 12(4) RPBA that the admission of new requests in appeal proceedings, the purpose of which is mainly to review the decision of the department of first instance, is a matter for the board's discretion and not a right of any party.

On the other hand similarly, under Article 111(1) EPC last sentence the Boards of Appeal have the power either to decide on the appeal themselves or to remit the case to the department of first instance for further prosecution. The Boards of Appeal have developed a body of case law regarding the criteria for exercising this discretion. In particular, when applying Article 12(2)(a) RPBA, boards usually consider that documents filed together with the statement of grounds of appeal by the appealing party adversely affected by the decision of the first instance are presumed admissible if the introduction of these documents does constitute a legitimate reaction to the reasoning underlying the appealed decision.

- 3.3 Moreover both issues have been the subject-matter of debate before the Board of Appeal, and were also addressed by the petitioner in its submissions in writing. Therefore for this very reason the petitioner

cannot now claim that its right to be heard was violated in this respect.

In any case the Enlarged Board of Appeal is not empowered under the provisions of Article 112a EPC to decide on the merits of a case, which also necessarily implies that it has no power to control the normal exercise a board makes of its discretion in respect of admission of late-filed documents or remittal of the case under consideration to the first instance.

4. After former Opponent I withdrew its opposition the registrar erroneously notified the remaining parties that the case was to be considered closed. This error was corrected later on. The registrar has no judicial function to decide an appeal, so no particular rights can be derived from this error. Moreover an administrative action cannot exhaust the rights of an appellant (here OII) to have its case decided by the competent board of appeal. Relying on this error as a ground is therefore manifestly void of merit, even leaving aside the fact that it does not appear in the exhaustive list of grounds of review contained in Article 112a(2)(a) to (e) together with Rule 104 (a) and (b) EPC, respectively.

5. The issue of the admissibility of the appeal was discussed at large in writing (see replies by the respondent petitioner) as well as, on the petitioner's own admission, during the oral proceedings held before the Board of Appeal.

This body decided that point on the merits, and the Enlarged Board of Appeal cannot identify anything in

that respect that could constitute a procedural defect falling under the list of grounds of Article 112a(2) and Rule 104 EPC, which, as has been mentioned above (points 2.4 and 2.5), contains an exhaustive list.

6. To summarise, none of the grounds relied on by the petitioner has been made out and the Enlarged Board of Appeal sitting in its composition under Rule 109(2)(a) EPC rejects the petition for review as clearly unallowable.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Cremona

P. Messerli