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**Datasheet for the decision
of the Enlarged Board of Appeal
of 22 December 2009**

Case Number: R 0014/09
Appeal Number: T 1020/06 - 3.2.01
Application Number: 96942575.0
Publication Number: 0802341
IPC: F16D 3/20
Language of the proceedings: EN

Title of invention:
Constant velocity universal coupling

Patentee:
NTN Corporation

Opponents:
GKN Automotive GmbH
Volkswagen AG

Headword:
-

Relevant legal provisions:
EPC Art. 24(4), 112a, 113(1)
EPC R. 106, 117, 124(1)

Keyword:
"Petition for review - clearly unallowable"

Decisions cited:
R 0004/08

Catchword:
-



Case Number: R 0014/09

D E C I S I O N
of the Enlarged Board of Appeal
of 22 December 2009

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Decision under review:

**Decision of the Technical Board of Appeal
3.2.01 of the European Patent Office of
15 May 2009.**

Composition of the Board:

Chairman: P. Messerli
Members: R. Menapace
P. Alting van Geusau

Summary of Facts and Submissions

- I. The petition for review concerns decision T 1020/06 of Board of Appeal 3.2.01 remitting the case to the department of first instance with the order to maintain European patent No. 0802341 *inter alia* on the basis of claims 1-10 submitted during the oral proceedings before the Board.
- II. The proceedings leading to said decision can be summarised as follows:
- (i) The patent proprietor lodged an appeal against the decision of the opposition division revoking the above patent.
 - (ii) On 14 September 2007 the Board of Appeal issued summons to oral proceedings to take place on 10 January 2008, together with an annex pursuant to the then Article 11(1) RPBA.
 - (iii) Following objections under Article 24(3) EPC by the appellant (patent proprietor) received on 4 October 2007 the members of Board 3.2.01 were replaced pursuant to Article 24(4) EPC by their alternates and the oral proceedings were cancelled.
 - (iv) On 7 March 2008 the appellant (patent proprietor), "in response to the summons to oral proceedings of September 14, 2007" filed 16 sets of amended claims accompanied by detailed arguments in support of the admissibility and the patentability of each set of claims. The

explanations concerning the claims presented as "1st Auxiliary Request" explicitly refer, in order to demonstrate that the claimed range of parameter R1 is different from that conventionally chosen, to "Attachment A (comparative Figure)", which is a set of colored drawings with commentaries, all made up by the appellant (patent proprietor).

- (v) By interlocutory decision of 28 November 2008 the objections under Article 24(3) EPC against the original board members were rejected.
- (vi) On 17 February 2009 the Board of Appeal (in its original composition) summoned the parties to the oral proceedings scheduled to take place on 15 May 2009. In an annex pursuant to Article 15(1)) RPBA the parties were informed of the Board's preliminary view that the amended claims filed with the appellant's letter of 7 March 2008 should not be admitted and that *"the reasoning provided in support of inventive step of the new auxiliary request relating to parameter R1, which the respondents have not countered, would be relevant also in respect of the appellants previous main request"*.
- (vii) In a letter received 15 April 2009 the respondent (opponent 01) concurred with the Board's preliminary view on the inadmissibility of the claims. As a precaution extensive arguments against the patentability of the subject-matter of both the previous and the new claims were submitted which include a discussion of (the

alleged lack of) novelty and inventive step having particular regard to the critical parameter R1 and it was stated that during the oral proceedings the opponent 01 would, if necessary, expand on the arguments in respect of lack of clarity and patentability.

(viii) Again on 15 April 2009 the appellant (patent proprietor), in reaction to the preliminary comments of the Board of Appeal, submitted a new main request as well as five auxiliary requests and arguments why these new requests should be admitted into the proceedings and why their subject-matter was patentable.

(ix) During the oral proceedings on 15 May 2009 Attachment A (point II(iv), above) became the object of discussions, because the appellant's (patent proprietor's) representative used that document for explaining technical connections. The respondent's objections to the taking into account of said document were rejected for the reason that the respondent (opponent 01) had had more than one year's time to comment on the patent proprietor's submissions in his letter of 7 March 2008. At the end of the oral proceedings the decision now under review was announced.

III. Two days later a clean copy of the minutes of the oral proceedings was sent to each party by registered letter. The minutes are silent on the discussion of Attachment A and no objection against taking this document into account in the proceedings is recorded in them.

- IV. The reasons for the decision were notified to the parties by registered letter dated 26 June 2009 and received by the representative of the respondent (opponent 01) on 29 June 2009.
- V. On 26 August 2009 the respondent (opponent 01 - in the following referred to as "the Petitioner") filed a petition for review pursuant Article 112a EPC, based on Article 112a(2) EPC, in particular alleging that mistakes had occurred in the conduct of the proceedings by the Board of Appeal, which led to fundamental violations of Article 113 EPC and of Article 114 EPC in conjunction with Rule 116(1) and (2) EPC or, respectively, Rule 101 and 99(2) EPC. Oral proceedings were requested in the case that the petition would not be allowed in the written proceedings.
- VI. In support of his petition, as far it is based on a violation of Article 113 EPC, the Petitioner argued in essence as follows:
- (i) Attachment A had been filed at a time when the interlocutory proceedings pursuant to Article 24(4) EPC were pending and therefore, this document had never been validly introduced into the appeal proceedings.
 - (ii) Hence, the Petitioner did not attribute any significance to this document, which was not mentioned in the summons, and its discussion in the oral proceedings came as a surprise to him as he could not recognize that this document continued to be considered as a means of evidence

and it was not pointed out to him at all that this document was part of the appeal file. He actually did, during the oral proceedings, object that he had no opportunity to comment on Attachment A. However, that objection did not receive attention, rather it was rejected for the reason that the Petitioner had had more than one year time to comment on the patent proprietor's submissions in his letter of 7 March 2008.

- (iii) Only from the reasons for the decision under review the Petitioner learned that the Board of Appeal considered Attachment A to be so relevant that it lead even to a shift of the burden of proof which must have taken place during the partiality proceedings and to which the Petitioner had no possibility to react. This amounted to a further violation of Article 113 EPC.
- (iv) Generally, the Petitioner had no reason to thoroughly examine this document, as it had not been validly introduced into the appeal proceedings and the relevance attributed to it by the Board of Appeal became only apparent from the written reasons for the decision.

VII. On 1 September 2009 the Petitioner's representative filed a "Technical Opinion on the Submissions of the Patent Proprietor concerning the Parameters of EP 0 802 341 B1" (30 pages plus 60 pages of patent and non-patent literature) in order to demonstrate which convincing proof the Petitioner would have produced if sufficient opportunity to comment had been given to him.

It was requested that these substantiated and substantive submissions, which would have considerably influenced the decision of the Board of Appeal, be taken into account in the review of the impugned decision.

- VIII. Oral proceedings before the Enlarged Board, at the end of which the decision on the petition was announced, took place on 22 December 2009.

During the oral proceedings the Petitioner stressed his contention that he had had no opportunity at all to comment on Attachment A in that the potential relevance of the attachment was not easily ascertainable and he trusted that documents filed during the partiality proceedings would not be taken into account. The communication of the Board of Appeal in preparation of the oral proceedings on 15 May 2009 made no mention of Attachment A or means of evidence in general, and that document was not specifically discussed in the oral proceedings. So the Petitioner had neither a reason nor the opportunity to specifically object to the consideration of Attachment A. Under these procedural circumstances it constitutes a fundamental violation to tell a party that it had one year reaction time. It then came as an absolute surprise to him when in the reasons for the decision under review Attachment A was held so relevant that it even shifted the burden of proof to the Petitioner as opponent.

Furthermore, the Petitioner's representative submitted a written request for the admission of further evidence (see below) on the ground that under the EPC there is no parties' right to a correction of the minutes and to

appeal against the refusal of a correction. Thus the filing of a request for correction of the minutes in parallel to a petition under Article 112a EPC does not appear to be an appropriate course of action in order to obtain correct minutes on which the decision on the petition for review could be based.

IX. The Petitioner's final requests were

- that, beyond the minutes of the oral proceedings of 15 May 2009, further evidence be admitted, in particular the hearing of witnesses, in order to ascertain the actual course of the oral proceedings, these means of evidence having been already offered at the filing of the petition for review pursuant to Article 112a EPC.
- that the decision T 1020/06 be set aside and re-opening of the proceedings before a board of appeal be ordered.

Reasons for the decision:

Admissibility of the petition for review, formal requirements

1. In accordance with Article 112a(4) EPC, the petition was filed and the prescribed fee was duly paid on 26 August 2009, that is within two months of notification of the decision of the Board of Appeal of Appeal on 29 June 2009.
2. The requirements of Rule 107 EPC in respect of the contents of the petition for review have been fulfilled.

3. The requirement pursuant to Rule 106 EPC is fulfilled in so far as the Petitioner asserts a violation of Article 113(1) EPC on the ground that allegedly the relevance attributed to Attachment A by the Board of Appeal became only apparent from the written reasons of the decision under review.
4. However, the Board has serious doubts whether that is also true for the Petitioner's contention that during the oral proceedings before the Board of Appeal he had raised qualified objections (see decision R 4/08) to the consideration of Attachment A. No such objection has been recorded in the minutes of the oral proceedings of 15 May 2009, which, as prescribed by Rule 124(1) EPC, must contain the essentials of the oral proceedings and the parties' relevant statements - the latter certainly including any objection pursuant to Rule 106 EPC - and the Petitioner did not object to the content of the minutes as notified to him about three months before he filed the present petition. Furthermore, the raising of such an objection during the oral proceedings is incompatible with the second ground on which the Petitioner relies, namely that he had, allegedly, no opportunity to comment on Attachment A as it was not pointed out to him that this document was part of the appeal file and the relevance attributed to it by the Board became apparent only from the written reasons for the decision (see point VI(ii)-(iv), above): If it were true that he raised the required qualified objection during the oral proceedings, then he must have been (made) aware of the (potential) relevance of that document at that time already and cannot have learned about it only from the

reasons for the decision under review. In any event, this matter needs not to be pursued further, because of the Board's finding on the allowability of the Petition.

Allowability of the petition for review

5. The Petitioner argues in essence, that he had not been given a reasonable chance to realise in time, i.e. before the Board of Appeal took the decision under review, the relevance which the Board attributed to Attachment A, so that he was not able to comment on it as it is his right pursuant to Article 113(1) EPC. This contention is, however, not supported either by the facts or by the law:
6. True, when the Petitioner received that document more than 14 months before the oral proceedings, at the end of which the decision under review was taken, the members of the Board of Appeal had been replaced as required by Article 24(4) EPC. However, this *interim* composition of the Board did not and could not have any bearing on the decision on the substance of the case. What matters is rather the fact that the document in question is nothing else than a set of colored drawings with commentaries, all made up by the then appellant (patent proprietor) and submitted for an enhanced comprehensibility of his arguments in support of the patentability of the claims according to the "1st Auxiliary Request" and that the parties, about three months before the oral proceedings, were informed by the Board of Appeal in its second communication, that the reasoning provided in support of inventive step would be relevant also in respect of the appellant's main request. Under these circumstances the

Petitioner, even if he (wrongly) assumed that Attachment A was not formally in the proceedings, he could not reasonably have trusted that this document would not be considered at all by the Board of Appeal. The Petitioner did not allege and there are no indications whatsoever, that during the oral proceedings he had been hindered by the Board of Appeal to comment on that document or on the Petitioner's arguments referring to it before or after he had, according to his own account, unsuccessfully objected to the use of that document.

7. It follows that the Petitioner had actually been given the opportunity to present his comments within the meaning of Article 113(1) EPC also on Attachment A insofar as it is to be considered as grounds or evidence on which the decision under review is based.
8. It is then irrelevant for the purposes of Article 113(1) EPC, whether and when Attachment A became (legally) part of the file within the meaning of Rule 147(1) EPC, and it is immaterial that, as the Petitioner maintains, he became aware of the purported relevance of that document only when reading the reasons for the decision. That would certainly have been too late for a successful plea, but could not alter the fact that his right to be heard before the Board of Appeal decided against him was not infringed. It is pointed out in this context, that it is not the purpose of that right to provide - and the Articles 112a(2)(c) and 113(1) EPC may not be construed as providing - to any party to the proceedings a further opportunity to argue its case.

9. The Petitioner relies also on purported violations of Article 114 EPC in conjunction with Rule 116(1) and (2) EPC or, respectively, Rule 101 and 99(2) EPC. However, these provisions are not listed in Article 112a(2) or Rule 104 EPC as grounds on which a petition may be filed.

Technical opinion filed in support of the petition:

10. The "Technical Opinion on the Submissions of the Patent Proprietor concerning the Parameters of EP 0 802 341 B1" (point VII, above) was filed during the period provided in Article 112a(4) EPC, first alternative. However, the right to be heard or "the opportunity to present comments" (Article 113(1) EPC) is by definition not related to the content and/or the merits of the comments. Hence, there is no need that the party affected demonstrate that it would have produced convincing evidence (or arguments) if sufficient opportunity to comment had been given to it. It follows that the "Technical opinion" cannot be considered in the review of the impugned decision, irrespective of whether it contained "substantiated and substantive submissions, which would have considerably influenced the decision of the board of appeal".

Admission of further evidence

11. In view of the findings under point 6, above, that the parties could not reasonably trust that Attachment A would not be discussed and that the Petitioner was not prevented from presenting his comments on that document during the oral proceedings, it was not necessary within the meaning of Rule 117 EPC to take evidence, in particular the hearing of witnesses, in order to

ascertain the actual course of the oral proceedings
before the Board of Appeal.

Order

For these reasons it is decided that:

1. The request for admitting further means of evidence is rejected.
2. The petition for review is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli