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**Datasheet for the decision
of the Enlarged Board of Appeal
of 27 September 2010**

Case Number: R 0018/09
Appeal Number: T 0128/08 - 3.3.05
Application Number: 99902690.9
Publication Number: 1054722
IPC: B01D 53/94
Language of the proceedings: EN

Title of invention:

System for NO_x reduction in exhaust gases

Patentee:

Johnson Matthey plc
Daimler AG
HJS Fahrzeugtechnik GmbH & Co. KG

Opponent:

Umicore AG & Co. KG

Headword:

Fundamental violation of Article 113 EPC/JOHNSON

Relevant legal provisions:

EPC Art. 112a, 113, 125
EPC R. 104, 106, 107(1)(2), 151(1)
ECHR Art. 6

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of petition for review filed by one of joint proprietors (yes)"

"The list of grounds for petition for review in Article 112a(2) and Rule 104 EPC is exhaustive"

"Allowability of petition for review (no)"

"Partial apportionment of costs of review proceedings (no)"

"Acceleration requests in review proceedings unnecessary"

Decisions cited:

G 0003/99, R 0001/08, R 0002/08, R 0004/08, R 0010/09,
R 0012/09, R 0016/09, T 1154/06

Catchword:

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Case Number: R 0018/09

DECISION
of the Enlarged Board of Appeal
of 27 September 2010

Petitioners:
(Proprietors of the patent)

Johnson Matthey plc
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Daimler AG
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HJS Fahrzeutechnik GmbH & Co. KG
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D-58706 Menden (DE)

Representative:

N. M. Lenz
Keil & Schaafhausen
Cronstettenstrasse 66
D-60322 Frankfurt Am Main (DE)

Respondent:
(Opponent 02)

Umicore AG & Co. KG
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D-63457 Hanau-Wolfgang (DE)

Representative:

Vossius & Partner
Siebertstrasse 4
D-81675 München (DE)

Decision under review: **Decision of the Technical Board of Appeal of 3.3.05 the European Patent Office of 28 May 2009.**

Composition of the Board:

Chairman: P. Messerli
Members: C. Rennie-Smith
L. Galligani
M. Vogel
R. Menapace

Summary of Facts and Submissions

- I. The petition for review concerns the decision in appeal T 128/08 of Board of Appeal 3.3.05, announced at the end of oral proceedings on 28 May 2009 and notified in writing on 5 August 2009, to revoke European Patent No. 1054722 ("the patent") entitled "System for NO_x reduction in exhaust gases". The appeal had been brought against the decision of the Opposition Division of 30 November 2007 to reject the opposition. In this decision, where the context requires, the plural word "petitioners" is used for convenience although one issue in the petition proceedings was whether one of several joint proprietors may file a petition for review. The petitioners are the three joint proprietors of the patent who were respondents in the appeal proceedings, namely Johnson Matthey plc, Daimler AG, and HJS Fahrzeugtechnik GmbH & Co. KG ("HJS"). The respondent to the petition and appellant in the appeal proceedings was the opponent, Umicore AG & Co. KG.
- II. The petition for review was dated, and filed by fax on, 7 October 2009 accompanied by a number of supporting documents including signed statements by Mr Steimle and Prof. Haverkamp who represented the petitioners at the oral proceedings before the Board of Appeal, they and others being offered as witnesses. The petition fee was paid on the same date. The petition stated it was filed in the name of and on behalf of HJS and was contained in a letter from Mr N. Lenz of Keil & Schaafhausen. An authorisation from HJS in favour of that firm was also filed on 7 October 2009. The petition requested the Enlarged Board of Appeal to set aside the decision of 28 May 2009, to re-open the proceedings before the

Technical Board of Appeal, to direct that the members who participated in taking the decision be substituted, to order reimbursement of the petition fee, and to accelerate the petition proceedings. If the Enlarged Board could not allow the first three of those requests in written proceedings, oral proceedings were also requested.

- III. In a letter also dated 7 October 2009 HJS filed a written request for correction of the minutes of the oral proceedings held before the Board of Appeal so as to remove the sentence "The Chairman then declared the debate closed" which it was argued did not happen. In an ancillary decision dated 5 November 2009, the Board of Appeal dismissed the request. In a letter dated 12 November 2009, the respondent submitted that the minutes should not be changed.
- IV. In a letter dated 13 October 2009 and received at the EPO by fax on the same date, the common representative of the joint proprietors of the patent, Mr Steimle, withdrew as representative and stated that Mr Lenz would be the new representative. On 16 October 2009 the EPO sent letters to both Mr Steimle and Mr Lenz confirming the change of representative announced by Mr Steimle in his letter. The letter to Mr Steimle said the change had been registered as from 7 October 2009.
- V. Mr Lenz sent three replies to the EPO's letter to him of 16 October 2009.

First, in a letter of 5 November 2009 Mr Lenz stated that he was not the representative of the other two proprietors (Johnson Matthey plc and Daimler AG) and

that official communications could be sent directly to those companies and gave for that purpose the names and addresses of persons at each company.

Second, Mr Lenz wrote to the EP0 on 3 December 2009 stating that in September 2009 Johnson Matthey plc and Daimler AG had transferred their interests in the patent to HJS evidence of which would follow.

Finally, Mr Lenz wrote to the EP0 on 18 December 2009 stating that his firm also represented Johnson Matthey plc and Daimler AG (though not saying since when and not filing any additional authorisations) and that the petition for review had been filed in the name of all the patent proprietors.

On 21 December 2009 an authorisation dated 11 December 2009 from Johnson Matthey plc in favour of Keil & Schaafhausen was filed at the EP0.

VI. In a letter dated and faxed on 21 April 2010 the respondent submitted that the petition was both inadmissible and unallowable.

On 21 April 2010, the Enlarged Board sent the parties a communication identifying certain issues of admissibility and allowability and giving its provisional and non-binding opinion on some of those issues. In letters dated and filed by fax on 11 and 12 May 2010 respectively, the petitioners and the respondent filed further written submissions in answer to the Enlarged Board's communication.

VII. The petitioners' submissions of 11 May 2010 enclosed a further statement of Prof. Haverkamp and again offered him and others as witnesses; an authorisation from Daimler AG in favour of Keil & Schaafhausen dated 24 September 2009; a copy of the petition as originally filed and another copy stating it was filed in the name of and on behalf of all three patent proprietors; and a statement dated 10 May 2010 from Ms S. Dixon of Johnson Matthey plc, which stated that the authorisation in favour of Keil & Schaafhausen dated 11 December 2009 "was intended to formalise the understanding between the parties at the date the petition was filed that Keil & Schaafhausen were also acting on behalf of Johnson Matthey plc."

VIII. The respondent's submissions of 12 May 2010 enclosed six signed statements of persons who attended the oral proceedings before the Board of Appeal and offered those persons as witnesses.

The respondent filed further written submissions dated and faxed on 18 June 2010 in reply to the petitioners' submissions of 12 May 2010.

The petitioners filed further written submissions dated and faxed on 24 June 2010 in reply to the respondent's submissions of 12 May 2010 and enclosing a written opinion of Prof. Dr B. Jestaedt on the admissibility of the petition.

IX. The petitioners' arguments can be summarised as follows.

Admissibility of Prof. Dr Jestaedt's opinion

The opinion added nothing new in terms of factual material and should be admitted into the proceedings.

Admissibility of the petition - joint proprietors, common representative

The petition for review was filed by all three patent proprietors. Mr Lenz' letters of 5 November and 3 December 2009 were based on a mistake. He had relied on unclear information from the proprietors, to the effect that he should not represent Johnson Matthey plc and Daimler AG because their rights in the patent had been transferred to HJS as sole proprietor. When it became clear this was not the case, the representative had in his letter of 18 December 2009 correctly informed the EPO that he represented all three proprietors.

As that letter made clear, the petition was filed by all three proprietors. Even if HJS was named as petitioner in the petition, that was a mistake which had been corrected since. By Rule 109(1) EPC provisions for appeal proceedings apply to petition proceedings. From G 3/99 (OJ EPO 2002, 347, 361 *et seq*) in which the Enlarged Board dealt with the case where an appeal was filed by a person who was not the common representative under the then Rule 100(1) EPC 1973 (now Rule 151(1) EPC), it appeared that any one of joint parties or any person acting on his behalf can perform an act to avoid missing a time limit provided the deficiency is

remedied within a further time limit set by the Board, that the deficiency can be remedied if the act is signed by the common representative and, if the common representative is no longer one of the joint parties, that the signature must be that of the new common representative.

The petition was filed on 7 October 2009 in the name of HJS, one of the proprietors, by its authorised representative Mr Lenz. The letter of 18 December 2009 informed the EPO that Mr Lenz also represented the other two proprietors and that the petition had been filed in the name of all three. At this date at the latest Mr Lenz was the common representative. The petition was thus pursuant to Rule 151(1) EPC signed by the new common representative. Purely as a precaution, copies of the petition signed by the common representative - one as originally filed and another stating it was filed in the name of and on behalf of all three patent proprietors - were filed with the petitioners' submissions of 11 May 2010. No communication under Rule 50(3) EPC setting a time limit had been sent so the confirmation of the petition by the new common representative was done in time. Under Rule 50(3) EPC the petition, being signed in due time, retains its original filing date. Thus the petition was filed in the name of all three proprietors with effect from 7 October 2009. This deals with both the question whether HJS as one of three patent proprietors can file a petition for review and the question whether an authorised person signed the petition.

At the date the petition was filed Mr Lenz was authorised by all three proprietors. An authorisation

from HJS was filed with the petition. An authorisation from Daimler AG dated 24 September 2009 was filed with the submissions of 11 May 2010. The third proprietor Johnson Matthey plc had on 21 December 2009 filed an authorisation dated 11 December 2009 and provided a statement that the authorisation existed at the date of filing the petition (see section VII above). Thus at that date the representative was authorised by all three proprietors. Moreover at the date of filing, Mr Lenz acted with a sub-authorisation from the then recorded common representative Dr Steimle because he approved the filing of the petition.

The opinion of Prof. Dr Jestaedt filed with the petitioners' letter of 24 June 2010 observed that Article 112a(1) EPC allowed any adversely affected party to appeal proceedings to file a petition for review. Under Article 107 EPC any party adversely affected by a decision can file an appeal and all other, non-appealing, parties are parties to the appeal as of right. Rule 151 EPC limits this principle of individual entitlement only in some exceptional situations - joint patent applicants, joint patent proprietors or joint opponents or interveners who do not name a common representative - and contains no express provision for appeal or petition proceedings; it does not necessarily mean that one of joint patent proprietors is precluded from filing an appeal or petition and its exceptional nature indicates it should not be so extended. Nor did G 3/99 decide whether, in the case of joint patent proprietors, only joint appeals are possible. Textbook opinion also supports the view that one of several proprietors may appeal and the exceptional nature of petition proceedings means

the same should apply to petitions for review. Further support is offered by German law by which joint patent proprietors are "Streitgenossen" and the filing of an appeal by one is treated as an appeal by them all.

Admissibility of the petition - Rule 106 EPC

Since the Board of Appeal did not state that the debate was closed and announced its decision to revoke the patent wholly unexpectedly, the petitioners could not, as regards not being heard on the method claims, comply with Rule 106 EPC since the decision had ended the appeal proceedings.

The first the petitioners knew of the Board's surprising interpretation of document D15 and the inclusion in its consideration of the SAE-Paper was when they read the written decision several weeks after the oral proceedings. They were thus unable to object to these denials of the right to be heard.

*Allowability of the petition - first ground -
Article 112a(2)(c) EPC in combination with
Article 113(1) EPC*

The petitioners argued that there had been fundamental procedural defects in the appeal proceedings on two grounds. As first ground, under Article 112a(2)(c) EPC in combination with Article 113(1) EPC, the petitioners' right to be heard had been denied in three respects. One of these arose from the conduct of the oral proceedings, the other two from the written decision.

1 - Method Claims

The Board of Appeal took the decision to revoke the patent in suit without giving the patent proprietors an opportunity to argue for the method claims of their main or auxiliary requests filed during the oral proceedings.

Oral proceedings were appointed for 28 and 29 May 2009. No communication was sent with the summons. The petitioners filed 11 auxiliary requests with their letter of 28 April 2009. At the beginning of the oral proceedings the Board produced a list of the documents (D1 to D51) on file. The petitioners' main request (the claims as granted) was discussed and both the independent apparatus claim 1 and independent method claim 9 were held by the Board not to be novel over document D30. The petitioners were allowed an adjournment to prepare new requests after which they presented a new main request with an independent apparatus claim 1 and independent method claim 6 and an auxiliary request with three method claims of which independent claim 1 differed as to its last feature from claim 6 of the main request. After a break in the proceedings, the admissibility of these requests was discussed and, after a further break, the Board held them admissible. After a further break to allow the respondent to prepare its arguments on patentability, it was apparent that it had no arguments against novelty, which is acknowledged in the Board's decision. In view of the time (about 5.30 pm) the chairman proposed to adjourn the proceedings to the following day as originally planned. However, the respondent suggested it be allowed one attack on inventive step.

This was approved and the respondent then presented argument exclusively against apparatus claim 1 of the main request based only on document D15 and not against the method claim 6 or independent method claim 1 of the auxiliary request. The petitioners argued against this and defended the view of the opposition division which had considered the subject-matter of the patent inventive over D15. Like the respondent, they only referred to the features of the apparatus claim of the main request. The petitioners agree with the respondent that the earlier discussions had covered both apparatus and method claims but disagree that the same was true at this stage - only the apparatus claims were discussed and not the method claims, even implicitly.

The Board interrupted the proceedings for a deliberation before the petitioners could speak to the method claim of the main request or to the auxiliary request. Contrary to Article 15(5) RPBA, the final requests of the parties were not called for and the debate was not declared closed. All parties would have resisted closing the debate - the petitioners to defend the method claims of the main and auxiliary requests and the respondent to make its other attacks on inventive step which it had already announced. The petitioners were denied the opportunity to discuss their method claims as they could not have expected, when the proceedings were interrupted, a final decision would be announced thereafter and certainly not a decision on the auxiliary request which had not been discussed at all. After re-opening the proceedings, the Board announced surprisingly its decision that the main and auxiliary requests were not allowable and the

patent was revoked. The oral proceedings were closed at about 6.45 pm.

By the unexpected announcement of a decision, the petitioners were denied the opportunity to be heard on the inventive step of the independent method claim 6 of the main request and particularly the method claims of the auxiliary request which were quite independent from the apparatus claims of the main request. The difference between the apparatus and method claims is undisputed and appears from the decision (see points 5.10 and 5.11). The respondent's attack on inventive step was based expressly on D15 only whereas the Board's decision deals with the method claims by reference to quite different prior art (D30, D30/A and D18 - see the decision, point 5.10) which, as is not disputed, was not discussed in the oral proceedings.

The petitioners were also denied the opportunity to file new requests with more precisely defined claims. The right to a fair procedure based on the principle of the right to be heard placed a duty on the Board to be satisfied that, before issuing its decision, the parties had been able to speak on all relevant, and from their point of view necessary, aspects of the case. That was clearly not the case here as essential requests were not discussed.

2 - Interpretation of D15 and the SAE-Paper

The Board's decision was based on an interpretation of document D15 on which the petitioners had no opportunity to comment. In point 5.9.3 of its decision, the Board held that D15 would have prompted the person

skilled in the art to combine the two quite different CRT and SCR systems disclosed separately from each other in D15, which was examined in the opposition proceedings and found "undamaging". The Board justified this interpretation by reference to the passage on page 27, left column, lines 3 - 16 and 22 - 27 of D15:

"an additional reductant, for example urea, has to be added to the exhaust gas, in order to reduce the nitrogen oxides by means of the SCR process and, thus, convert the NO_x into N₂."

In the Board's view, the use of the word "additional" showed that the authors of D15 considered that the CRT system was not sufficient for the treatment of exhaust gas and an additional means for reducing NO_x levels was suggested, namely the addition of a reductant. The parties were first presented with this interpretation of D15 in the written decision but it should only have been used against the petitioners after it had been identified to them. If the petitioners had been heard, they could have corrected this mistaken interpretation so that the patent would not have been revoked. While it may in principle be correct that a Board is not obliged to suggest all possible arguments to the parties, this cannot apply to reasons which underlie a decision as this would amount to a flagrant denial of the right to be heard.

3 - The SAE-Paper

As further support for the alleged combination in D15 of the CRT and SCR systems the Board referred in point 5.9.4 of its decision to the reference (9) in D15

entitled "Off-Highway Exhaust After-treatment: Combining Urea-SCR, Oxidation Catalysts and Traps" (the SAE-Paper) as a pointer to such a combination. The SAE-Paper was however not produced in either the opposition or the appeal proceedings. It was not on the list of documents provided by the Board. It was neither relied on by the opponent nor mentioned during the oral proceedings. It can only have been considered retrospectively when the written decision was prepared. A skilled person would not have relied only on the title of the SAE-Paper but would have studied the actual document. Even if the Board only relied on the title as used in D15, the petitioners should still have been given an opportunity to comment on the conclusions wrongly drawn from this. Thus in the written decision a new document was introduced into the (by then closed) proceedings on which the parties could not comment.

That the decision was based on grounds on which the petitioners were not able to comment is wholly confirmed by the six statements filed with the respondent's letter of 12 May 2010, in none of which is there a hint that the SAE-Paper or even its title was discussed in the context of D15 or that the meaning of the word "additional" was referred to. Nor do any of them indicate that in the discussion of inventive step any features of the method claims were discussed.

These procedural violations were fundamental because the Board based its decision on its mistaken interpretation of D15 and the SAE-Paper.

The Board's interpretation of D15 was also technically wrong. As shown by the statements (filed with the

petition) of two of the authors of D15, the word "additional" was not used to indicate a combination of two systems. By comparing the two systems, the authors' intention was to contrast them. The two systems were described completely separately from each other. Nor, if its contents are considered, did the SAE-Paper point to a combination as in the patent. Since the Board's opinion was clearly incorrect, the petitioners would certainly have succeeded in persuading the Board it was erroneous. If they had known before the decision of the Board's incorrect opinion and that a decision extending to the auxiliary request would be taken, they would have filed amended auxiliary requests. Four such requests were filed with the petition which explained (see the petition, sections 4.3 and 4.4) why those requests would be admissible and allowable.

*Allowability of the petition - second ground -
Article 112a(2)(d) EPC in combination with Article 6
European Convention on Human Rights ("ECHR")*

The petitioners argued that, as a second ground of the petition, under Article 112a(2)(d) EPC their right to a fair procedure under Article 6 ECHR, which applies by virtue of Article 125 EPC, had been infringed.

Though Rule 104 EPC does not mention Article 6 ECHR, it does not follow that Article 6 ECHR cannot be relied on in a petition for review. The petitioners do not rely on Article 112a(2)(d) EPC alone but also on Article 125 EPC under which the EPO takes account of principles of procedural law generally recognised in the Contracting States to which Article 6 ECHR undoubtedly belongs. Article 125 EPC stands in a systematic connection to

Article 112a EPC. This follows from the title "Common provisions governing procedure" of the chapter of the EPC which includes Article 125 which thus inevitably applies to Article 112a EPC: otherwise there would be an irresolvable conflict between the protection afforded by Article 125 EPC on the one hand and by Article 112a EPC on the other. This conflict can only be avoided or resolved either if the violation of procedural principles generally recognised in the Contracting States is acknowledged as a ground under Article 112a(2)(d) EPC or if Rule 104 EPC is in the light of Article 125 EPC read broadly so as to include the violation of such principles. To hold that a violation of Article 6 ECHR cannot be raised under Article 112a(2)(d) EPC automatically reduces the level of protection guaranteed by Article 112a(2)(d) EPC.

The purpose of Article 6 ECHR is to prevent arbitrariness and to ensure the right to be heard and the right to equality of arms. The petitioners were denied the right to be heard at several stages of the proceedings and their right to a fair procedure was thereby infringed. In particular, they were prevented by the sudden announcement of a decision from arguing for their auxiliary request and filing further auxiliary requests; the decision was based on reasons on which they were not able to comment; and the decision introduced a new document into the proceedings on which they could not comment.

There were flagrant breaches of the Board's judicial duty to explain and point out matters. It failed to send a communication as envisaged by Article 15(1) RPBA which would have allowed the parties to concentrate on

the essentials; it should have told the parties, at the latest before the end of the proceedings, that it had a diametrically opposite opinion to that of the opposition division; and during the oral proceedings it should have drawn attention to its different interpretation of the prior art from that presented by the parties. As a result, the petitioners were prevented from presenting relevant arguments and filing amended requests.

Apportionment of costs

There should be no apportionment of costs. The petition was not filed capriciously and there had been no deliberate misuse of procedure.

Acceleration

In the petition it was argued that accelerated proceedings would avoid the disproportionate effect of the damage caused by the interim right of third party users. This arises from the right to a fair hearing under Article 125 EPC together with Article 6 ECHR which requires that in a case such as the present a final decision over the patent be made speedily. Two decisions of the EPO (in examining and opposition proceedings) have held the petitioners to be the rightful proprietors of the patent. To be exposed to the results of third party use for an unjustly long time and then to have the patent right restored would not be in keeping with a fair hearing. In their written submissions of 11 May 2010, the petitioners acknowledged that the appointment of oral proceedings had disposed of this request.

X. The respondent's arguments can be summarised as follows.

Admissibility of Prof. Dr Jestaedt's opinion

The opinion should not be admitted into the proceedings because it was filed too late. The time limit for filing had passed and the petitioners had had plenty of time in which to file it earlier.

Admissibility of the petition - joint proprietors, common representative

Several proprietors can only act together and a petition for review must, like an appeal, be filed by the common representative (see G 3/99). Procedural steps such as filing a petition for review can only be taken by all proprietors acting together, and not by one or some of them acting alone. These requirements were not fulfilled here - the petition for review was filed *expressis verbis* and exclusively in the name and on behalf of only one of the three patent proprietors. The representative expressly confirmed, when asked by the EPO, that he did not act as common representative.

The petitioner HJS is, as one of three patent proprietors, not competent to petition. Article 112a(1) EPC permits any party to appeal proceedings who is adversely affected to petition. The parties to the appeal proceedings were on one side the group consisting of three joint proprietors with the status of patent proprietor and on the other side the opponent. Only the patent proprietor, i.e. the three proprietors acting together, can file a petition. This

follows from the basic principle that even under joint ownership the patent is a single entity which can only be asserted and defended by all. The petition was filed only by HJS and explicitly not by the other two proprietors. They did not join in within the time limit and cannot do so later.

The petitioners are wrong to consider the mistake can be cured. The passage from G 3/99 cited by the petitioners is not applicable: it concerns the special case of the procedural act of one of several persons who make up one party and acts for all of them without a common representative. In the present case, the petition was expressly filed by only one of three patent proprietors. The petitioner's representative did not assert he was acting for the whole group. He was not an unauthorised person in the sense of G 3/99 but a representative of a legal person who could only act together with the other members of the group.

Rule 151 EPC, which requires joint patent proprietors to act through a common representative, was not complied with. Correction of this deficiency on the basis of G 3/99 is not possible. The EPO had no need to call for a common representative because at the filing date of the petition and until 13 October 2009 Mr Steimle was recorded as such (see Rule 152(8) EPC). No time limit was set because none was needed - the EPO's letter of 16 October 2009 named Mr Lenz as the new common representative but his letter of 5 November 2009 made it quite clear he did not represent the proprietors other than HJS. His later declaration in his letter of 18 December 2009 that he acted on misinformation demonstrates that in fact he filed the

petition only in the name of HJS and that, at the time he did so, that was his express intention.

The respondent disagrees with Prof. Jestaedt's opinion. The textbook authorities cited in the opinion in fact argue the other way than he suggests.

Admissibility of the petition - Rule 106 EPC

The respondent's suggestion - that it present one attack on inventive step with the result that either the patent would be completely revoked or that the hearing would continue the next day - was clear, was agreed by the Board, and the petitioners had no objection. After the discussion the Board did not interrupt the proceedings for an interim discussion as alleged by the petitioners, rather it stated expressly that it would after its deliberation either make a decision or continue the proceedings the next day. The parties were also asked whether they had had an adequate opportunity to present their cases. It was clear to all that after the break the proceedings could end through rejection of both the main and auxiliary requests (see point 2 of the Board's decision). There was sufficient opportunity before the break to make any possible objections. There can be no question of an unexpectedly announced decision or a surprise. To the extent the petitioners assert they were unaware of the possibility of a decision, they could after the resumption of the oral proceedings, at the latest at the moment when all present realised the Board would give a final decision, have raised an objection.

*Allowability of the petition - first ground -
Article 112a(2)(c) EPC in combination with
Article 113(1) EPC*

The respondent argued that there were no procedural violations and that, if there were any violations, they were neither causally connected to the decision of the Board of Appeal nor fundamental.

1 - Method Claims

The petitioners' account of the oral proceedings is distorted. At the beginning the Board commented critically on the large number (35) of the petitioners' auxiliary requests, expressed its preliminary opinion on a number of objections, and opened the discussion of novelty of the claims as granted. That discussion included both the apparatus claim 1 and the method claim 9, so both types of claim were dealt with together from this point. The petitioners did not object to this. In explaining its decision (given at 11.06 am) on novelty of the granted claims, the Board explicitly referred to both claims 1 and 9 and commented on some of the features of both with reference to the state of the art and indicated that their remarks applied to the 35 auxiliary requests and that it would not accept such a large number. The petitioners were given a single opportunity to file two requests, a main and an auxiliary request. After a break of about one hour, they filed a new apparatus claim 1 and method claim 2 as independent claims and asked to defer filing dependent claims and the auxiliary request. The Board made clear again it would not tolerate a "trial and error" approach or any

"salami tactics". After a further pause, the petitioners filed their new main and auxiliary requests at 1.08 pm. There followed an extensive discussion of the admissibility of the requests which lasted until about 3.30 pm and included both the apparatus and the method claims. The petitioners themselves explained the alleged differences between all the independent claims and the prior art, and in particular the feature "to a level pre-determined to be optimum" of method claim 6 of the main request, the NO/NO₂ ratio in the method claims of both requests, and the meaning of this ratio for the "SCR catalyst" in claim 1 of the auxiliary request. After a deliberation the Board informed the parties of its doubts about the admissibility of the new requests, including the method claims 6 of the main request and 1 of the auxiliary request and, after further discussion, the petitioners amended the requests.

At 5 pm, the respondent suggested that, for reasons of procedural economy, it present its "most promising" attack on the requests. If that should succeed for both requests, the proceedings could be completed that day and if not, the remaining attacks could be dealt with the following day. The discussion which followed again covered the subject-matter of all the independent claims without exception. The arguments were not at all confined to the apparatus claims of the main request. On the contrary, the achieving of an advantageous NO/NO₂ ratio, which only appeared in method claims 6 of the main request and 1 of the auxiliary request, was extensively discussed. At 6.06 pm, the Board interrupted the proceedings until about 6.35 pm. Before the break, it expressly asked the parties if they had

had sufficient opportunity to present their cases and indicated again, referring to the respondent's suggestion, that after the break a final decision might be made or, if not, the proceedings would continue the next day. At 6.43 pm, the Board announced the final decision.

That the oral proceedings were as described by the respondent appears from the six witness statements by persons present at those proceedings filed with its letter of 12 May 2010.

The decision was not unexpected. The petitioners did have an opportunity to present arguments on the patentability of the auxiliary request. The method claims of both the main and auxiliary requests were discussed. Moreover, there was an adequate opportunity to present all arguments, objections and comments.

The method claims had already been raised in the written proceedings. The features which distinguish the method claim 6 of the main request, in its form as finally filed at the oral proceedings, from the apparatus claim were already contained in the original 17 auxiliary requests filed with the reply of 15 August 2008 - for example, method claim 1 of auxiliary request 7. Arguments against the patentability of this claim, based on inter alia D2 and D15, were presented by the respondent in its submissions of 27 March 2009.

After the rejection of the claims as granted for lack of novelty, the petitioners had the burden of proving the admissibility, novelty and inventive step of their newly filed requests. It was their responsibility to

present the appropriate arguments. The allegedly unmade argument therefore represents not a procedural error on the part of the Board but an omission on the part of the petitioners.

The petitioners were not denied the chance to file new requests with more precise claims. On the one hand, the Board had expressly allowed the petitioners to file one new main request and one new auxiliary request. On the other hand, there was sufficient opportunity during the oral proceedings to seek to file further requests but the petitioners made no attempt to do so.

2 - Interpretation of D15

The feature in D15 concerning an "additional reductant" was discussed in the written proceedings (see the respondent's submissions of 27 March 2009, section I-5.7) as well as in the oral proceedings. The argument was therefore not new. The Board's treatment of the issue in point 5.9.3 of its decision - that its interpretation of "additional reductant" is consistent with other statements in D15 - is essentially a repetition of the respondent's arguments in the opposition proceedings. The petitioners knew of the arguments based on D15 from the beginning of the opposition proceedings. Following the reply to the grounds of appeal, further arguments on the subject did not need to be considered. There is no right to be given a detailed list of the reasons for a decision before it is taken. In any event, this reason had been discussed both in writing and in the oral proceedings.

3 - The SAE-Paper

In point 5.9.4 of its decision the Board expressly refers to a "further pointer" and, far from introducing a new document, mentions only the title of the SAE-Paper cited in D15 as a further hint at the combination disclosed in D15. It is clear that, even without this "further pointer", the decision would have been the same.

Allowability of the petition - second ground - Article 112a(2)(d) EPC in combination with Article 6 ECHR

Here the petitioners rely substantially on a repetition of their other arguments. The only new point is the demand for a communication pursuant to Article 15(1) RPBA. However this is, according to the wording of that Article and as confirmed by case-law, entirely discretionary. The parties have no right to a communication. The decision is not based on unexpected reasons on which the parties could not comment. Rather, it appears that the petitioners are attempting to attack the decision in substance, which is not permitted.

Although the principles set out in the ECHR are among those generally recognised in the Contracting States according to Article 125 EPC, this does not require the Enlarged Board to review the observance of those principles. The petitioners' complaint that the Board of Appeal contravened the ECHR is only to be considered by the Enlarged Board insofar as it coincides with the criteria for review in Article 112a(2) EPC. The

possibility of challenging an alleged violation of the right to be heard is, as one expression of the principles of Article 6 ECHR, adequately provided by Article 112a(2)(c) together with Article 113 EPC.

Allowability of the petition - causality, fundamental procedural defect, the substantive decision

A procedural defect according to Article 112a(2)(c) or (d) must be a fundamental violation of Article 113 EPC or another fundamental procedural defect. It is also necessary to establish a causal connection between the procedural defect and the decision of the Board. The petitioners argue that the Board's decision would be different if their right to be heard had been allowed but this is not the case.

The parties had adequate opportunity to make their case both in writing and at the oral proceedings. Before the last interruption the Board asked the parties if they had anything to add and the petitioners did not, thereby indicating they would have had no more to say if they had been given a further opportunity. As for further requests, the petitioners had already been given a chance to file new main and auxiliary requests and the admissibility of any more requests would have been a matter for the Board's discretion and not a right. As for discussion of the method claims, it was at all times clear that both apparatus and method claims were being discussed together. The allegedly unexpected reasons in the written decision were only supporting arguments and not in themselves decisive. There is no requirement to inform parties of and discuss with them arguments underlying a decision. In

none of these matters is there any causal connection between the alleged fundamental procedural defect and the decision.

All procedural steps are within the authority and discretion of the Board and there were no, and certainly no fundamental, procedural defects. Thus it is in the Board's discretion to allow any changes to the parties' cases after the grounds of appeal or reply (Article 13(1) RPBA). The exceptional character of petition proceedings must also be borne in mind, in particular that they are confined to fundamental defects which have a causal connection with the result of the appeal proceedings, as shown by the *travaux préparatoires* for Article 112a EPC. While ascertaining the final requests of the parties is a basic requirement, an (established) failure to do so will not *per se* be a fundamental violation, there must be a further fundamental violation. In the present case, grounds and evidence were extensively discussed in both the written and oral proceedings. The petitioners took part in this discussion, at no time asked for an adjournment and made no attempt to amend their requests. The Board decided on the requests filed by the petitioners. A preliminary opinion of the Board is not obligatory, nor is the Board required to assist in framing requests. In particular, any failure by the parties to take an active part in the proceedings and to present on their own initiative arguments supporting their case cannot be shifted on to the Board. The petitioners have no right to have every request examined in detail. The parties must expect that, after a deliberation by the Board, a decision may be issued. In the present case it was *per se* clear what the

parties' requests were so the decision was made on the basis of the relevant requests. Finally, a subjectively-viewed surprise cannot alter the fact that the petitioners knew all the arguments of the respondent and were able to answer them, so that objectively there was no surprise.

Petition proceedings are not an opportunity to review the application of substantive legal issues. This applies particularly to the complaint about the Board's interpretation of "additional" in D15. The petitioners have dressed up their attack on the substantive assessment of the case by the Board as a procedural complaint but such a complaint must fail if it requires the Enlarged Board to consider the substantive conclusions reached in the decision under review.

Apportionment of costs

The petitioners should pay part of the respondent's costs because there was a misuse of the proceedings. The petition was filed in the name of one person, then several different stories were supplied, then at the end the explanation was said to be the result of misinformation. With more care, that could have been avoided and the respondent would have incurred less costs accordingly.

- XI. Oral proceedings before the Enlarged Board were held on 9 July 2010. The Enlarged Board informed the parties that it did not need to hear any of the offered witnesses at this point in time.

The petitioners requested the Enlarged Board of Appeal to set aside the decision the subject of the petition, to re-open the proceedings before the Technical Board of Appeal, to direct that the members who participated in taking those decisions be substituted, and to order reimbursement of the petition fee.

The respondent requested the Enlarged Board to dismiss the petition as inadmissible or unallowable, not to admit the opinion of Prof. Dr Jestaedt into the proceedings as late filed, and to make an apportionment of costs in its favour.

Reasons for the Decision

Admissibility of Prof. Dr Jestaedt's opinion

1. The Enlarged Board refused the respondent's request not to admit this opinion into the proceedings because it was filed late. Although filed late in the proceedings, the respondent had time to read and consider it. It could have indicated its objection to admissibility before, or even at the start of, the oral proceedings but did not do so until after the petitioners' representative had made oral submissions referring to the opinion. Further, the Enlarged Board did not consider the opinion added more than further argument on the issue of admissibility of the petition.

Admissibility of the petition - formal matters

2. The petition was filed within two months of notification of the decision in question, the

petitioners were adversely affected thereby, the prescribed fee was paid in time, contained the name and address of HJS as petitioner, indicated the decision to be reviewed and the reasons for setting that decision aside and facts and evidence on which it was based. Thus Article 112a(4) and Rule 107(1) and (2) EPC were complied with.

3. The parties disagree as to whether the petitioners' first complaint (that at the oral proceedings on 28 May 2009 they were not heard on the method claims of their requests) could have been the subject of an objection under Rule 106 EPC. As regards the petitioners' second and third complaints (the presence in the written decision of an unexpected interpretation of document D15 and of reliance on the SAE-Paper), if these matters only first appeared from the written decision, they could not have objected to them under Rule 106 EPC during the proceedings. However, since all complaints in the petition have to be rejected as unallowable, the Enlarged Board considers it unnecessary to make any findings on compliance with Rule 106 EPC.

Admissibility of the petition - joint proprietors, common representative

4. Regardless of the confusion in which the petitioners placed themselves in the present case, the fact is that, although the petition was originally filed in the name of and behalf of HJS only, HJS was at all material times (and even despite submissions to the contrary) one of the three joint proprietors of the patent and the petition was never retracted, either by HJS or its (purported) representatives.

5. However, it is also a fact that HJS, being only one of three joint proprietors, was not entitled to file the petition on its own. The Enlarged Board held in decision G 3/99 (OJ EP0 2002, 347) that an opposition filed by several persons in common is to be dealt with as an opposition filed by only one party and such a group of common opponents is to be considered as a single party represented by a common representative (see Reasons, point 15). It further held that, if such a group of common opponents should file an appeal, they can only do so jointly as a single party acting through their common representative (see Reasons, point 17). The same principle has been applied to the filing of an appeal by one of joint patent proprietors (see T 1154/06 of 9 December 2008, Reasons, point 1).
6. It is also to be noted that Rule 151 EPC, which concerns the appointment of a common representative, is stated to apply to joint proprietors of a European patent and also applies in appeal proceedings, if not on its face then beyond doubt by reason of Rule 100(1) EPC. It also applies to review proceedings by virtue of Rule 109(1) EPC which provides that provisions relating to proceedings before the Boards of Appeal shall apply in proceedings under Article 112a EPC unless, as is not the case here, otherwise provided. It follows that the principle that a plurality of persons acting in common be treated as a single party (a "group party") and the requirement that such a group party acts through a common representative both apply to petition proceedings.

7. It was also held in G 3/99 that there is no practical need to acknowledge the validity of procedural acts of one member of a group party who is not its common representative. Since such a procedural act is treated by the EPO in the same way as a missing signature, each member of the group party or any other person on his behalf can perform such an act to avoid missing a time limit, provided the deficiency is remedied within a further time limit set by the Board in a communication. Hence, where an appeal is filed by a non-entitled person, it shall be considered as not duly signed and the common representative be invited to sign it within a given time limit (see G 3/99, Reasons, point 20 and Order, paragraph 2). Applying this approach (for the reasons in point 6 above) to petition proceedings and specifically to the present case, the procedural deficiency was that the petition was originally filed by and on behalf of only one of three joint proprietors and by a representative who clearly was not the joint representative at the time. However, the joint proprietors subsequently - but only at the third attempt, and apparently after considerable confusion amongst themselves and their representatives - succeeded in remedying the procedural deficiency by supplying the signature of the new common representative before a time limit was formally set by the Office.

*Allowability of the petition - first ground -
Article 112a(2)(c) EPC in combination with
Article 113(1) EPC*

8. The Enlarged Board does not consider that any violation, let alone a fundamental violation, of Article 113 EPC

occurred in respect of the three matters complained of in the petition.

1 - Method Claims

9. Both the petitioners and the respondent have devoted much of their written arguments to their own, and unsurprisingly different, accounts of the oral proceedings before the Board of Appeal. Both have also filed a number of statements from persons who were present at those oral proceedings and invited the Enlarged Board to call those persons as witnesses. The Enlarged Board declined to do so because, even assuming in the petitioners' favour that their account of the oral proceedings was correct, it could not be satisfied that the petitioners had made a plausible case of a procedural defect.
10. Assuming therefore that the method claims were not discussed, the question then arises, why did the petitioners not mention those claims themselves in the discussion? There is no suggestion in the petition, and no indication elsewhere in the file, that the petitioners were prevented from discussing those claims and, since they were claims in their own requests, it would be only natural for them, and even expected of them, to do so. The only argument of the petitioners in this respect (which was only put forward after the Enlarged Board had made these observations in its communication), is that they were prevented from doing so by the way the oral proceedings developed: they say, in general agreement with the respondent, that one inventive step attack was presented at the end of the first day of oral proceedings but, in disagreement with

both the respondent (see section X above, "Method claims", second paragraph) and the Board of Appeal (see its ancillary decision of 5 November 2009, Reasons, point 2), that the Board interrupted the proceedings for a deliberation before the method claims were discussed even implicitly, did not close the debate, did not ask the parties if they had said everything they wanted, and did not make clear a decision might be announced after the deliberation.

11. Assuming again that petitioners' account is correct, it follows that they never saw fit to observe that, if the apparatus claims should be refused, the method claims were none the less inventive, and that they never questioned the reason for a deliberation at the end of a long day's proceedings after the respondent's "revocation now or continue tomorrow" suggestion had been approved. If that, however implausible, is what happened then the petitioners were by their own default responsible. A party which wants a decision in its favour must submit arguments in support of its case on its own initiative and at the appropriate time (see R 2/08 of 11 September 2008, points 8.5 and 9.10).
12. The petitioners do not dispute that they had an opportunity to be heard on the inventive step of their requests as regards document D15. What they said or did not say in using that opportunity was for them to decide. They had no reason to confine themselves to the apparatus claims just because (as they claim, again disagreeing with the respondent) the respondent had done so. They do not allege that the Board of Appeal actually prevented them from making the arguments they wanted, only that they expected the proceedings to

continue. According to the Enlarged Board's jurisprudence, if they were aware of the arguments put forward by the respondent, had an opportunity to answer them, and make no contention that the Board of Appeal refused to hear them, that is sufficient for the purposes of Article 113(1) EPC (see R 2/08 of 11 September 2008, Reasons, point 8.2; and R 4/08 of 20 March 2009, Reasons, point 3.3). The Enlarged Board cannot see any procedural defect in this complaint.

2 - Interpretation of D15

13. There is no doubt that the petitioners had an opportunity to comment on document D15. The document figured in both the opposition and appeal proceedings. It was filed in the opposition proceedings on 5 September 2002 by the then first opponent (which subsequently became a joint proprietor of the patent and is now one of the petitioners). It was the subject of submissions to, and was considered by, the opposition division in its decision (see pages 4 to 7 of that decision and sections III and IV of the Board of Appeal's decision). In the appeal proceedings it was the subject of submissions by both the appellant and the respondents (see sections X and XI of the Board's decision) and the petitioners do not dispute this at all, indeed the petition acknowledges it (see the statements of both Mr Steimle and Prof. Haverkamp, respectively Annexes A2 and A3 to the petition). However, the petitioners complain that the Board's written decision was based on an interpretation of D15 on which they had no opportunity to comment.
14. The Enlarged Board cannot see any procedural defect in this complaint either. It appears that the petitioners

are claiming that the Board of Appeal should have known in advance of the end of the proceedings, if not what its ultimate decision would be, at least the possible reasons (including the interpretation of documents before it) for that decision and should have offered the parties an opportunity to comment on those reasons. However, such a manner of proceeding would not only be impractical but would require a Board of Appeal, in assisting a party by giving it possible reasons to decide against it, to compromise its neutrality.

15. As the case-law of petition cases has already made clear, there is no requirement for a Board to put to a party every possible argument for or against it in advance of making a decision (see R 1/08 of 15 July 2008, Reasons, point 3.1). The petitioners acknowledge this but argue that there must be an exception for reasons which underlie a decision as this would amount to a denial of the right to be heard. In this they are wrong. Every possible argument necessarily includes those which are ultimately used in the decision each of which arguments may or may not, before the decision is taken, appear significant. On the same basis, if the petitioners' proposed exception for reasons which underlie a decision would apply, then all possible reasons would fall within the exception. The Enlarged Board's case-law is in this respect quite clear (see R 12/09 of 15 January 2010, Reasons, point 11 and the other case-law there cited).

3 - The SAE-Paper

16. The petitioners' third alleged procedural defect appears to the Enlarged Board to be wrong as a matter

of fact. The petition says (see pages 13 to 14, paragraph 2.2.2) that point 5.9.4 of the reasons in the Board of Appeal's decision refers to the referenced article (9) in document D15 (the SAE-Paper) which provides a pointer to the combination of an SCR System, the use of urea as a reductant, with an oxidation catalyst and a particulate filter. The petition then adds that the SAE-Paper was never introduced into either the opposition or appeal proceedings, did not appear on the list of documents produced by the Board at the start of the oral proceedings, and thus the Board's decision rests in part on new evidence on which the parties had no opportunity to comment.

17. However, point 5.9.4 of the Board's decision, which forms the basis of the petitioners' argument in this respect and which contains the only reference in the decision to the SAE-Paper, reads as follows:

"A further pointer to the combination of an SCR System, using urea as the reductant, with an oxidation catalyst and a particulate filter is provided by SAE technical paper SAE 930363, to which D15 refers expressly (see page 26, column to the right, line 21, reference 9; page 27, reference 9). Already the title of the paper, i.e. *"Off-Highway Exhaust Gas After-Treatment: Combining Urea-SCR, Oxidation Catalysis and Traps"*, gives an unambiguous and sufficient hint to the skilled person for combining the two key technologies concerned."

It appears from that to be quite clear that the Board of Appeal's decision referred only to the title of the SAE-Paper which appears in full in the list of

references on page 27 of D15 and is also referred to by its reference number in the text of D15 itself (see page 26, right hand column, first full paragraph). The title of the SAE-Paper is thus part of document D15. If the decision had relied on the content of the SAE-Paper, the position might be different, but that appears not to be the case. The petition argues (see page 13, penultimate paragraph) that the skilled person would never rely just on the title of a publication but would consider the article itself; however, since the decision in fact makes no more use of the SAE-Paper than the title as it appears in D15, that argument appears to be redundant.

18. The petitioners then also argue that, if the Board's decision was indeed (as appears clear to the Enlarged Board) referring only to the title of the SAE-Paper as used in D15, the petitioners should still have been given an opportunity to comment on the conclusions wrongly drawn from this. However, that argument must also fail because, as already mentioned, there is no requirement to give a party every possible reason for a decision in advance (see point 15 above).

*Allowability of the petition - second ground -
Article 112a(2)(d) EPC in combination with Article 6
ECHR*

19. Although the petitioners argue at some length (see section IX above) that Article 112a(2) and Rule 104 EPC must be so construed as to allow a complaint under Article 6 ECHR, the Enlarged Board has in Decision R 16/09 of 19 May 2010 held that the list of grounds contained in those two provisions is exhaustive and

that an alleged procedural defect which does not appear on that list cannot form the basis of a petition for review (see R 16/09, Reasons, point 2.3.5 to 2.3.6; and see also R 10/09 of 22 June 2010, Reasons, points 2.4 and 2.5). Accordingly, since a contravention of Article 6 ECHR does not appear on that list, this ground of the petition is *per se* unallowable.

Apportionment of costs

20. The respondent's request for an apportionment of costs related solely to the issue of the joint proprietors. It argued that it would have incurred less costs if the petitioners had not first filed the petition in the name of HJS only, then produced several different stories, and then finally an explanation said to be the result of misinformation. The respondent claims this was a misuse of the proceedings. The petitioners say there was no deliberate misuse. The Enlarged Board can agree to that extent with the petitioners - no-one would have deliberately filed the inconsistent and self-contradictory letters of 5 November, 3 December and 18 December 2009. However, those letters were merely the superficial aspect of a question which, once raised, needed to be resolved, namely whether one of several joint proprietors of a patent may file a petition for review. To make one party pay the other's costs of dealing with that issue, which may in time have implications for others beyond the present case, would not be equitable.

Acceleration

21. The petition requested acceleration of these proceedings (see the petition, page 2, point I.1 and page 26, point IV.4). While the reason for the request (to minimise free third party use under Article 112a(6) EPC) is readily understandable, that could apply in every case where a patentee is petitioner. The Enlarged Board's view is that petition proceedings should by their nature be dealt with as speedily as possible and therefore acceleration requests are unnecessary.

Order

For these reasons it is decided that:

The petition for review is rejected as unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli