



Internal distribution code:

- (A) ☐ Publication in OJ
(B) ☒ To Chairmen and Members
(C) ☐ To Chairmen
(D) ☐ No distribution

**Datasheet for the decision
of the Enlarged Board of Appeal
of 29 September 2011**

Case Number: R 0003/10
Appeal Number: T 0136/09 - 3.2.04
Application Number: 01931465.7
Publication Number: 1284604
IPC: A22C 25/16
Language of the proceedings: EN

Title of invention:

Improved method for the manufacture of raw fish products

Patentee:

Salmon Brands AS

Opponents:

Trio Fish Processing Machinery
Pan Fish
Fjord Seafood
Marine Harvest International
Asociación de la Industria del Salmon de Chile AG

Headword:

Right to be heard in oral proceedings/SALMON BRANDS AS

Relevant legal provisions:

EPC Art. 100(a),(b),(c), 112a(2)(c), 113(1), 116(1)(2)
EPC R. 103(1)(a), 106, 108(3), 109(2)(a)(b), 110

Relevant legal provisions EPC 1973:

EPC R. 67

Keyword:

"Petition for review - admissible - yes"

"Objection raised after decision was given - Rule 106 complied with - yes - could not be raised earlier"

"Petition for review - allowable - yes - fundamental violation of petitioner's right to be heard in oral proceedings - yes - rejection of request on a ground not heard on"

"Presence of fundamental violation - to be determined on an objective basis - not relevant that no fault of the Board"

"Likelihood of success of potential oral submissions - whether submissions were already presented in writing - not relevant"

"Reimbursement of fee for petition - yes"

Decisions cited:

R 0010/08, J 0007/83, J 0032/95, T 0125/89, T 0405/96,

T 0400/02, T 0136/09

Catchword:

-



Case Number: R 0003/10

D E C I S I O N
of the Enlarged Board of Appeal
of 29 September 2011

Petitioner:
(Patent Proprietor)

Salmon Brands AS
Øklandsvågen
NO-5430 Bremnes (NO)

Representative:

Plougmann & Vingtoft A/S
Sundkrogsgade 9
P.O. Box 831
DK-2100 Copenhagen (DK)

Respondent I:
(Opponent 01)

Trio Fish Processing Machinery
PO Box 38 - Forus
NO-4064 Stavanger (NO)

Representative:

Smart, Peter John
Beck Greener
Fulwood House
12 Fulwood Place
London WC1V 6HR (GB)

Respondent II:
(Opponent 02)

Pan Fish
Maskinvelen 32
PO Box 342 - Forus
NO-4067 Stavanger (NO)

Representative:

Smart, Peter John
Beck Greener
Fulwood House
12 Fulwood Place
London WC1V 6HR (GB)

Respondent III:
(Opponent 03)

Fjord Seafood
Beddingen 8
NO-0250 Oslo (NO)

Representative:

Smart, Peter John
Beck Greener
Fulwood House
12 Fulwood Place
London WC1V 6HR (GB)

Respondent IV: Marine Harvest International
(Opponent 04) P.C. Hoofthlaan 3
NL-3818 HG Amersfoort (NL)

Representative: Smart, Peter John
Beck Greener
Fulwood House
12 Fulwood Place
London WC1V 6HR (GB)

Respondent V: Asociación de la Industria del Salmon de Chile
(Opponent 05) AG
Felix de Amesti 124, 6th Floor
Las Condes, Santiago (CL)

Representative: Smart, Peter John
Beck Greener
Fulwood House
12 Fulwood Place
London WC1V 6HR (GB)

Decision under review: **Decision of the Technical Board of Appeal
3.2.04 of the European Patent Office of
14 January 2010.**

Composition of the Board:

Chairman: P. Messerli
Members: B. Günzel
F. Edlinger
C. Rennie-Smith
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. The petition for review lies from Technical Board of Appeal 3.2.04's decision T 136/09 of 14 January 2010, by which European patent No. 1 284 604, application No. 01 931 465.7, was revoked. The petitioner is the patent proprietor, appellant IV in the case underlying the impugned decision.

II. Claim 1 of the patent entitled "Improved method for the manufacture of raw fish products" read as follows:

"1. A method of preparing a raw fish meat product comprising the steps of i) providing a fish, ii) at least partially separating fish meat parts from the main skeletal parts of said fish and iii) substantially removing pin-bones from said fish meat parts prerigor, to obtain the raw fish meat product."

Claims 2 to 6 were directed to preferred embodiments of the method of claim 1.

Claim 7 was directed to a raw fish meat product obtainable by the method according to any of the preceding claims comprising substantially boned fish meat wherein pinbones had been substantially removed pre-rigor.

III. Five oppositions were filed against the patent. They were identical and based on Article 100(a), (b) and (c) EPC - lack of inventive step, insufficiency of disclosure and extension of subject-matter beyond the content of the application as filed. Before the opposition division the patent proprietor defended the patent as granted and furthermore filed several auxiliary requests.

The opposition division maintained the patent in amended form on the basis of the petitioner's second auxiliary request. The opposition division considered that claims 1 and 7 of the patent as granted lacked novelty with regard to the disclosure of documents D6 and D7. Both documents disclosed that fish are to be caught and processed by filleting and pinbone removal in a manner encompassing pre-rigor processing. Furthermore, the data in the patent did not support the contention that any novel characteristics were present in a fish processed accordingly.

IV. Appeals against the decision of the opposition division were filed by the petitioner and by opponents 01, 04 and 05. The course of the appeal proceedings, to the extent that it is uncontentious, may be summarised as follows:

IV.1 In the appeal proceedings the petitioner defended the patent as granted, as a main request, and filed several auxiliary requests.

IV.2 In its communication in preparation for the oral proceedings the Technical Board of Appeal pointed out the following:

"1.1 Novelty is called in question in view of D6 to D11, D15, D16, D19, traditional fishing practice, and a new document D26.

...

For each of the above disclosures the parties will need to consider whether it conclusively indicates pre-rigor pinbone removal. This means that the skilled person (in the field of fish processing) considering the document or declaration in question as a whole and using his common general knowledge can derive this feature directly and unambiguously from it. D6 and D7, for example, do not mention pre-rigor pinbone removal in so many words but use terms such as "fresh out of the water" or

"freshest possible" contrasted (in the case of D7) with post rigor removal. D8, D15 (sections 2.5, 3.3 and table 1), D19 and D22 are more explicit in this regard.

...

1.2 Should novelty be established it may be necessary to discuss inventive step. Freshness is indisputably a major if not the most important concern in the fisheries industry; it requires early and swift processing before the processed and packaged product is transported to the consumer. This is borne out by D10a-d, D12, D15, D17, D20, D24, each emphasizing the importance of pre-rigor processing. In the view of the Board the question of inventiveness of pre-rigor pinbone removal is best considered in this context."

IV.3 Oral proceedings were held before the Technical Board of Appeal on 14 January 2010. In these oral proceedings the Chairman informed the parties that, due to the structure of the requests to be discussed, the Board had decided to handle the requests in groups starting with the main request and the auxiliary requests 5 and 10. The word was then given first to the representative of appellants I-III (opponents 01, 04 and 05) who attacked the main request as lacking novelty. The petitioner's representative replied thereto by defending the novelty of the claims. Before closing the debate the Chairman asked the parties whether they had any further comments. Both parties replied, "No". The Chairman also informed the parties that the Board would decide on the patentability of the main request. Upon resumption of the oral proceedings the Chairman announced the decision that claim 1 of the main request was novel but lacked an inventive step.

IV.4 The minutes of the oral proceedings contain the following passage:

"Following the decision of the Board on the main request, the proprietor objected that he did not have the opportunity to present arguments on inventive step. The objection was dismissed by the Board, by pointing out that before the closing of the debate on the main request, the Chairman has explicitly stated that the Board will decide on both novelty and inventive step, and also asked the parties if they have further comments, to which the proprietor's answer was "no"."

IV.5 The minutes of the oral proceedings were dispatched to the parties on 26 January 2010. On 11 February 2010 the petitioner requested that the minutes be corrected, since the minutes did not reflect the actual announcement made by the Board when closing the debate on the main request and did not disclose all the relevant facts. The statement "that the Board will decide on both novelty and inventive step" was not explicitly stated before the debate was closed. On the contrary, this statement was made after the objection was raised by the petitioner. Before closing the debate on the main request, the Chairman only explicitly stated "that the Board will decide on patentability". Nothing was specifically or explicitly mentioned about the Board's intention to decide on both novelty and inventive step. It was also stated in the minutes that the parties were asked "if they have further comments", to which the proprietor's answer was "no". This was true. However, the minutes failed to reflect the fact that the opponents' answer to the exact same question was also "no".

IV.6 The written reasons of decision T 136/09 were dispatched to the petitioner on 25 February 2010. No mention is made in these

reasons of the procedural events to which the minutes and the petitioner's request for correction referred.

As regards the method of claim 1 of the petitioner's main request and the corresponding claims 1 of auxiliary requests 5 and 10, the Board acknowledged novelty but denied inventive step.

The Technical Board held that, starting from any of documents D12, D15 or D20, the specific requirement of pinbone removal pre-rigor constitutes the sole difference of claim 1 as granted over this prior art. This feature ensures that before packing the processed product is pinbone free without compromising its high quality or freshness.

For the skilled person, a fisheries engineer with knowledge of existing pinbone removal techniques such as in D1 or D6 and who is intent on producing a high quality, pinbone free product, it is immediately obvious to try and carry out such known pinbone removal as part of pre-rigor processing, which therefore lacks an inventive step (points 3.1.2 et seq. of the Reasons).

The Board then adds (point 3.2 of the Reasons) that it reaches the same conclusion starting from the Wadsworth machine of D1 or D6 as closest prior art. Though neither document mentions using the machine pre-rigor, it is obvious in view of the central concern of freshness in the fishing industry that the skilled person will want to use the Wadsworth machine for optimum benefit, that is at the earliest possible stage. A large body of evidence - D12, D15, D20 above - recommends that this should be pre-rigor to avoid handling during rigor.

IV.7 On 1 March 2010 form 3305 with the heading "Communication of the Board of Appeal", signed by the registrar, was dispatched to the petitioner. At the bottom of that page a box is crossed reading "see annex(es): Decision on the request for correction." The following page is signed by the minute writer and the Chairman and gives reasons why "the Board holds that the request cannot be granted". Inter alia it is said therein:

"2. In the opinion of the Board, the facts in the minutes are correct. The objection of the proprietor concerning the discussion of the main request was dismissed with the reasoning given in the minutes. Further, the Board is of the firm opinion that the Chairman indeed expressly stated that the issue of patentability will turn on both novelty and inventive step. This statement was made not only before closing the debate, but also at the commencement of the debate concerning the main request.

...

4. The Appellant-Proprietor has indicated already in the oral proceedings that the course of events during the oral proceedings may form the basis for a petition for review under Article 112a EPC. In this case a party is free to present its full case in the petition, including the alleged incorrectness of the minutes."

V. On 20 April 2010 the petitioner filed a petition for review of decision T 136/09. The fee for the petition was paid on the same date. As grounds for the petition for review the petitioner submitted the following, additional to the uncontentious facts mentioned above:

V.1 In the oral proceedings before the Board the Chairman opened the discussion on the main request stating that the Board would

like to discuss novelty. The Chairman gave no indication that inventive step was also to be discussed.

The Chairman never explicitly mentioned, before closing the debate, that the Board would take a decision on both novelty and inventive step. Since only novelty had been discussed so far, the patent proprietor could not have anticipated the intention of the Board to decide on both novelty and inventive step, when the Chairman informed the parties before closing the debate that the Board would decide on patentability. As neither the opponents nor the patent proprietor had any further comments after discussing novelty, even though arguments relating to inventive step had been filed prior to the oral proceedings, it is clear that neither the opponents nor the patent proprietor had realized or understood that, after closing the debate, the Board would decide on both novelty and inventive step. The silence from the parties must also have come as a surprise to the Board, as inventive step was thoroughly discussed during the proceedings, both before the opposition division, and before the Board of Appeal (in writing) prior to the oral proceedings. During the discussion on novelty the Board raised various questions relating to novelty, but they never raised any direct questions in respect of inventive step, closest prior art, the person skilled in the art, etc, or any other inventive step related issues, and the parties were not clearly guided to the discussion on inventive step at this point of the proceedings. In the summons to oral proceedings, the Board had made it clear that if novelty was established, inventive step should be discussed. However, no clear indication was given by the Board that a combined decision would be taken on novelty and inventive step. In the ensuing discussion of inventive step of the various auxiliary requests the Board only admitted inventive step arguments directed to the new features added to the claims of the

auxiliary requests, and not to the claims as a whole, on the ground that a decision on inventive step of the main request had already been taken.

V.2 Furthermore, the decision of the Board of Appeal also contained arguments which were new to the patent proprietor and which would have been addressed had the patent proprietor been heard on the issues. In this respect, the petitioner referred to the statement concerning the skilled person in the first full paragraph on page 10 of the impugned decision and to the statements in the second sentence of the second full paragraph on the same page.

V.3 There is also a causal link between the violation of Article 113(1) EPC having occurred and the conclusions in the decision taken. If the patent proprietor had had the opportunity to present his arguments and to discuss the inventive step of the main request, the patent proprietor would have been able to clarify the misunderstandings and incorrect interpretations of the prior art made by the Board.

V.4 The petitioner filed signed declarations of five people who had attended the oral proceedings on behalf of the patent proprietor. As far as the alleged course of the oral proceedings is concerned, these declarations are identical and state:

...

"2) The Chairman opened the discussion by stating that the Board would like to discuss novelty in view of D1, D4, D6-D9, D12, D15, D19, D20, and D24. Furthermore in the opening remarks the Chairman gave no indication that novelty and inventive step was to be discussed together.

3) When closing the debate after the parties' submissions on novelty the Chairman explicitly stated "that the Board will

decide on patentability". Nothing was specifically or explicitly mentioned about the Boards intention to decide on both novelty and inventive step on (sic) the main request."

- V.5 The petitioner requested that the decision T 136/09 be set aside and that the proceedings be reopened in accordance with Rule 108(3) EPC. Reimbursement of the fee for the petition of review was also requested. In the event that the Enlarged Board of Appeal intended to issue a decision not to reopen the proceedings, oral proceedings were requested.
- VI. By Order of the Enlarged Board of Appeal as composed under Rule 109(2)(a) EPC of 25 January 2011 the petition for review was submitted to the Enlarged Board of Appeal as composed under Rule 109(2)(b) EPC for decision. The respondents were invited to file their written submissions, if any.
- VII. A reply was received by the representative acting on behalf of appellant I (opponent 01), appellant II (opponent 04) and appellant III (opponent 05). They essentially argued as follows:
- VII.1 The petition was inadmissible. Rule 106 EPC was not fulfilled. When the Chairman announced his decision and the discussion moved on to the next stage, the petitioner mentioned that he had not realised that they were supposed to be discussing inventive step. However, rather than asking for the decision on inventive step to be suspended and to be allowed to make submissions on the inventive step of the main request, the petitioner then simply moved on to the discussion of the next topic.
- VII.2 As regards the substance of the petitioner's contention, the representative of the respondents had no recollection that the subject-matter of the discussion was ordered to be limited to

the issue of novelty. Combined discussion of novelty and inventive step was clearly within the range of options open to a board of appeal. In any case, the Chairman having stated that the Board would decide on patentability and having asked the parties if they had further submissions to make, it came down to a failure of the representative to ask for permission to make submissions on inventive step.

- VII.3 As regards the allegation of new arguments having been relied on in the decision, a board was not required to give advance notice of its thinking at the oral proceedings before coming to a decision. Furthermore, the criticised passage of the decision did not contain arguments but rather a decision on a point in contention.
- VII.4 The concept of a causal link implied that the decision would have been different if the alleged procedural defect had not occurred. This conclusion could not be based on a mere speculation that the presentation by the petitioner of oral argument on the issue of inventive step would have altered matters. Furthermore, a completely separate reason for lack of inventive step was given in sections 3.2 and 3.3 of the decision, not mentioned in the petition. Also, Article 113 EPC, even in combination with Article 116 EPC did not warrant having to give a - second - opportunity to comment on all grounds at oral proceedings.
- VII.5 The respondents requested that the petition be rejected as inadmissible and unallowable.
- VIII. Oral proceedings before the Enlarged Board of Appeal were held on 29 September 2011.

Reasons for the Decision

1. Admissibility of the petition

1.1 The impugned decision of Technical Board of Appeal 3.2.04 was dispatched on 25 February 2010. The petition for review was filed in a reasoned statement on 20 April 2010. The fee for the petition was paid on the same day. These acts have been performed in time.

1.2 The petitioner is adversely affected by the impugned decision revoking its patent. As its main request the petitioner had requested maintenance of the patent as granted.

1.3 The petition has been sufficiently reasoned.

1.4 Rule 106 EPC has also been complied with.

1.4.1 In the petition the petitioner has in the first place raised the objection that as a result of the conduct of the oral proceedings by the Technical Board the petitioner had no opportunity at all to comment on the inventive step of the main request. Thereby its right to be heard under Article 113(1) EPC had been violated in a fundamental manner within the meaning of Article 112a(2)(c) EPC.

The minutes of the oral proceedings state that following the decision of the Board on the main request the petitioner objected that he did not have an opportunity to present arguments on inventive step.

Since a board of appeal is bound by its decision, once given, and cannot rectify it thereafter, the purpose of the obligation to raise objections under Rule 106 EPC being to provide the

boards of appeal with a possibility for rectifying the defect before a decision is taken, an objection under Rule 106, first alternative, EPC, can no longer be validly raised, once the decision has been given (R 10/08 of 13 March 2009, point 3 of the Reasons). Although the minutes of the oral proceedings do not directly say so, it is undisputed that a formal decision was announced on the main request, preventing the Technical Board from reopening the debate on that request when the objection was raised.

With respect to Rule 106 EPC the petitioner's submission that, when the Chairman closed the debate after the discussion on novelty, the petitioner was not aware that the Board's decision would also comprise a decision on inventive step, amounts to saying that the petitioner could not have raised his objection before the decision on the main request was given.

On the basis of the petitioner's submissions as set out in detail above under V.1, which in the context of admissibility the Enlarged Board has no reason to question, the petitioner only learned that the Board was also going to decide on the inventive step of the main request when, upon resumption of the proceedings, the Chairman announced the Board's decision that claim 1 of the main request lacked an inventive step. As has been set out in decision R 10/08 (*loc. cit.*), in such a situation the petitioner is to be given the benefit of the second alternative of Rule 106 EPC, as its objection could not have been raised before the decision was given.

- 1.4.2 The same applies to the petitioner's submission that the written decision was based on new arguments which were not raised before.

The petition is therefore in accordance with Rule 106 EPC and admissible.

2. Allowability of the petition

- 2.1 It is undisputed by the parties that the discussion of the main request in the oral proceedings only turned on novelty. The course of the discussion was that the representative of the opponents was invited to speak first. He presented his arguments against the novelty of the main request. When he had done so, the representative of the petitioner was invited to respond. He explained why he thought the main request was novel. The questions raised by the Board only concerned aspects related to the issue of novelty. It is, furthermore, undisputed that when thereafter closing the debate, the Chairman indicated that the Board would decide on patentability.
- 2.2 The petitioner's submission is that, when the Chairman closed the debate, in the circumstances of the case the petitioner had no reason to assume that the Board would decide on more than had been discussed so far orally, which was only whether the main request was novel.
- 2.3 In the signed declarations of the persons who attended the oral proceedings before the Technical Board on behalf of the petitioner it is indicated that the Chairman opened the discussion by stating that the Board would like to discuss novelty, but that in the opening remarks the Chairman gave no indication that novelty and inventive step were to be discussed together. Furthermore, when closing the debate after the parties' submissions on novelty, the Chairman stated "that the Board will decide on patentability" but nothing was specifically or explicitly mentioned about the Board's

intention to decide on both novelty and inventive step of the main request.

- 2.4 In the minutes of the oral proceedings one of the reasons given for dismissing the objection raised by the proprietor (after the announcement of the decision concerning the main request) is: "The objection was dismissed by the Board, by pointing out that before the closing of the debate on the main request, the Chairman has explicitly stated that the Board will decide on both novelty and inventive step,...". There is, however, no direct entry in the minutes stating that before closing the debate the Board had informed the parties that the Board will decide on both novelty and inventive step.

In point 2 of the reasons for rejecting the request for correction of the minutes, which were issued in close temporal connection with the oral proceedings, the circumstances in question are described in a different manner. It is said therein, "Further, the Board is of the firm opinion that the Chairman indeed expressly stated that the issue of patentability will turn on both novelty and inventive step. This statement was made not only before closing the debate, but also at the commencement of the debate concerning the main request."

It emerges from the terminology used that these remarks mainly refer to what was said at the commencement of the debate. The expression "patentability will turn on novelty and inventive step" makes no sense as a statement made after the discussion with the parties, when closing the debate.

- 2.5 More importantly, however, the statement that the issue of patentability will turn on both novelty and inventive step cannot on an objective view be understood as meaning that

novelty and inventive step were to be discussed and decided together. It can in fact mean no more than it says - that both issues are to be discussed and decided. Neither in the minutes nor in the reasons for rejecting the petitioner's request for correction is it stated anywhere that the Board had informed the parties before or after the discussion on novelty that the discussion of and/or the decision on novelty and inventive step would take place together.

- 2.6 It appears that, as a result of the Board's statement that the issue of patentability would turn on novelty and inventive step, a very unfortunate misunderstanding arose. While the Board may have intended to say that novelty and inventive step would be discussed **together** and decided **together**, that was not, or at least not clearly, expressed. The Board's statement in fact only told the parties that novelty and inventive step were both issues to be discussed and, that being the apparent meaning of the statement (see point 2.5 above), the petitioner assumed accordingly that both those issues would be discussed before any decision was taken. That the petitioner did not understand that the Board intended to discuss and decide both issues **together** is also apparent from its representative's answer "no" to the Chairman's question, before he closed the debate after the discussion on novelty, whether the parties had any further comments. The same answer "no" from the representative of the respondents, who had also only addressed the Board on the issue of novelty of the main request, can have done nothing to alleviate the petitioner's misunderstanding. Thus the petitioner only presented arguments on novelty because he thought, understandably, that there would be an opportunity later to address the Board on inventive step, in the event that the Board should acknowledge novelty and that a discussion of inventive step should thus become necessary. Such an expectation was all the more justified, since in its

communication accompanying the summons to oral proceedings, the Board had itself dealt with novelty and inventive step as separate points, its reasoning on each of those points having been based at least partly on different prior art and different arguments.

- 2.7 In Chapter I of Part II of the EPC the term "patentability" covers a variety of potential objections; the Chairman cannot have meant to address all those objections when he used the term "patentability", since most of them had never been a subject of the appeal proceedings. Hence, it is clear that the meaning to be attributed to the word "patentability" depends on the context in which it is used. Considering the circumstances of the present case set out above it has to be acknowledged that, when the debate was closed after the discussion on novelty, the petitioner had no reason to assume that the Board's decision would address more than had been previously discussed orally, i.e. novelty.
- 2.8 According to Article 112a(2)(c)(5) EPC the petition for review is allowable, and hence must be allowed, if a fundamental violation of Article 113 EPC occurred in the appeal proceedings.

Whether or not that is the case must be determined on an objective basis.

It is not relevant that the Board did not deliberately deny the petitioner the opportunity to speak on inventive step. It appears clear that in the present case the members of the Board thought that the parties did not wish to make separate submissions on that issue and, once a formal decision on the main request had been given, there was no possibility for the Board to reopen the debate on inventive step.

The boards of appeal have constantly held that determining whether a substantial procedural violation justifying the reimbursement of the appeal fee has occurred in first instance proceedings (Rule 103(1)(a) EPC, Rule 67 EPC 1973), is to be decided exclusively on an objective basis (J 7/83, OJ EPO 1984, 211, J 32/95, OJ EPO 1999, 713, T 405/96 of 8 November 1996 making reference to further decisions, T 400/02 of 22 August 2003).

A "substantial procedural violation" is an objective deficiency affecting the entire proceedings (J 32/95, point 4.1 of the Reasons, making reference to earlier decision J 7/83). As the Legal Board of Appeal acknowledged in decision J 32/95 (loc. cit.), there can be a substantial procedural violation even if the deciding body acted in good faith. It does not imply that the deciding body should be reproached in any way.

Thus, a substantial procedural violation was e.g. acknowledged to have occurred in cases in which a request for oral proceedings had not reached the file and, the deciding body not knowing that oral proceedings had been requested, the decision was taken without oral proceedings (T 405/96, point 2 of the Reasons, T 400/02, point 2 und 3 of the Reasons).

Such an objective approach must also be applied when it comes to determining whether a fundamental violation of the petitioner's right to be heard within the meaning of Article 112a(2)(c) EPC occurred. It is therefore not relevant that it was not the deciding Board's intention in any way to deprive the petitioner of its right to be heard orally on the issue of inventive step.

2.9 In the present case it cannot be denied that the violation of the petitioner's right to be heard orally was objectively a

fundamental one. As a result of the misunderstanding between the Board and the petitioner as to which aspect the Board's decision on the main request would address and of the Board having announced a formal decision on the lack of inventive step, the petitioner had no possibility to speak on inventive step at all. Since the Board's decision rejecting the main request was based only on lack of inventive step, while its novelty was acknowledged, the negative decision on the main request was exclusively due to the denial of inventive step by the Board.

- 2.10 In the oral proceedings before the Enlarged Board the respondent argued that in the case under appeal the relevant considerations for the assessment of inventive step were very close to the discussion having taken place on novelty. It could at best be said that claim 1 of the main request was just novel but it was then clearly obvious.

In the context of review proceedings the Enlarged Board is not entitled to go into the merits of a party's case. It is not entitled to assess whether or not and to what degree, if any, a party's standpoint which it alleges it would have taken had it been given the opportunity to present it, would have been well-founded.

More importantly, however, in the context of determining whether a party's right to be heard has been violated, this is not a relevant issue. The right to be heard is a fundamental right of the parties which has to be safeguarded, irrespective of the merits of the party's submissions. The necessity to respect it is absolute and therefore cannot be made dependent on a prior assessment of the merits of the party's submissions, which in the present case would involve an assessment of the

degree of likelihood that the arguments of the petitioner would have convinced the Board to acknowledge inventive step.

It is the very essence of the right to be heard that the party is given a full opportunity to defend its case and to persuade the deciding body that its position is the correct one. This right would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified.

In order to answer the question of whether a fundamental violation of the petitioner's right to be heard occurred as a result of the petitioner's not having been heard on inventive step, it is therefore irrelevant whether the respondents are right in their assessment of the clear obviousness of the claimed solution.

- 2.11 In a case such as the present, in which the ground of opposition, i.e. lack of inventive step, on which the revocation was based, was not discussed at all in the oral proceedings, it is also irrelevant that that issue was discussed in writing between the parties.

The purpose of oral proceedings is to allow each party to make an oral presentation of its arguments, to allow the Board to ask each party questions, to allow the parties to respond to such questions and to allow the Board and the parties to discuss issues, including controversial and perhaps crucial issues. The value of oral proceedings is that matters may as a result be clarified and the Board may ultimately be satisfied that a party's position is the right one, although it was not so satisfied by the written submissions alone.

Subject to the exception made in Article 116(2) EPC for oral proceedings before the Receiving Section, the right of any party for oral proceedings to be held on request and to present its case orally is absolute. It is, with respect to the party's right to be heard on its case, a more specific embodiment of the general principle enshrined in Article 113(1) EPC, but is by no means subordinate to the latter provision or less important in any respect.

According to the established jurisprudence (see e.g. T 125/89 of 10 January 1991, point 7 of the Reasons) the parties' absolute right to be heard in oral proceedings, Articles 113(1) and 116(1) EPC, is not restricted to new and substantial arguments which have not yet been presented in writing. Therefore, the fact that the petitioner made submissions on inventive step in writing is not a valid reason for denying that the petitioner's right to be heard under Article 113 EPC was violated in a fundamental manner, as a result of its not having had the opportunity to present its arguments orally on the decisive issue of inventive step, entailing the rejection of the petitioner's main request.

- 2.12 For these reasons, the decision under review has to be set aside and the proceedings have to be reopened, in order to give the petitioner the opportunity to present its arguments on inventive step orally. The petitioner's further objection, that the impugned decision relied on arguments which had not previously been put to the petitioner, need therefore not be dealt with here.
3. Pursuant to Rule 110 EPC the fee for the petition for review shall be reimbursed.

Order

For these reasons it is decided that:

1. The decision under review is set aside and proceedings before the Board of Appeal are re-opened.
2. The fee for the petition for review shall be reimbursed.

The Registrar:

The Chairman:

P. Martorana

P. Messerli