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**Datasheet for the decision
of 10 September 2010**

Case Number: R 0009/10

Appeal Number: T 0893/07 - 3.4.01

Application Number: 04291741.9

Publication Number: 1496564

IPC: H01Q 1/24, H01Q 21/29

Language of the proceedings: EN

Title of invention:
Diversity antenna system

Applicant:
Sony Corporation

Opponent:
-

Headword:
Fundamental violation of Article 113 EPC/SONY

Relevant legal provisions:
EPC Art. 111(1), 112a, 113
EPC R. 106, 107(1)(2), 109(2)(3)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Petition for review - clearly unallowable"

Decisions cited:
R 0001/08, R 0004/08, R 0005/08, R 0012/09, T 0111/98

Catchword:

-



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Board of Appeal

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Case Number: R 0009/10

D E C I S I O N
of the Enlarged Board of Appeal
of 10 September 2010

Petitioner: Sony Corporation
(Applicant) 7-35, Kitashinagawa 6-chome
Shinagawa-ku
Tokyo (JP)

Representative: Thévenet, Jean-Bruno
Cabinet Beau de Loménie
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Decision under review: **Decision of the Technical Board of Appeal
3.4.01 of the European Patent Office of 11
February 2010.**

Composition of the Board:

Chairman: P. Messerli
Members: C. Rennie-Smith
W. Zellhuber

Summary of Facts and Submissions

- I. The petition for review concerns the decision T 893/07 of Board of Appeal 3.4.01, announced at the end of oral proceedings on 11 February 2010 and notified in writing on 1 April 2010, to dismiss the appeal against the decision of the Examining Division of 5 December 2006 to refuse European patent application No. 04291741.9 (published under No. 1496564) entitled "Diversity antenna system". The petitioner was the applicant and appellant. The Examining Division had refused the patent application on the grounds of added subject-matter, lack of novelty and lack of inventive step.
- II. The petition for review was both dated and filed on-line on 11 June 2010 and the petition fee was paid on the same date. The only ground relied on in the petition was Article 112a(2)(c) EPC, an alleged fundamental violation of the right to be heard under Article 113 EPC.
- III. The petitioner's arguments can be summarised as follows.

Admissibility

The written notification of the Board of Appeal's decision was dated 1 April 2010 and so deemed to be notified on 11 April 2010 under Rule 126(2) EPC. Thus the petition was filed within the two month time limit in Article 112a(4) EPC on 11 June 2010. As regards the obligation to raise objections under Rule 106 EPC, at the oral proceedings held on 11 February 2010 the petitioner's professional representative objected that, in the circumstances of the present case, the

petitioner's right to be heard required the Board of Appeal to remit the case to the Examining Division, i.e. that refusal to remit breached the applicant's right to be heard. Thus an objection was indeed raised against the violation of Article 113 EPC during the appeal proceedings. The Board of Appeal ignored this objection and refused to remit the case to the Examining Division, as evidenced by its written decision.

Allowability

The Board of Appeal's decision to refuse the appeal on the basis of a document cited for the first time on appeal, without remitting the case to the Examining Division for further examination, was a fundamental violation of Article 113 EPC.

1 - Summary of proceedings

The European patent application was filed on 8 July 2004. The search report dated 30 August 2004 cited D1 against all the claims and D2 against claims 6 and 7. A communication issued by the Examining Division on 26 September 2005 raised objections of lack of novelty and inventive step over D1 and lack of clarity of the independent claims. On 26 January 2006 the petitioner filed a new set of claims, a suitably adapted description, supporting arguments and a precautionary request for oral proceedings. On 21 July 2006 the Examining Division issued a summons to oral proceedings, set a final deadline of 17 October 2006 for written submissions and raised an objection under Article 123(2) EPC to claim 1 as filed on 26 January

2006. On 16 October 2006 the applicant submitted an amended version of claim 1 and further arguments, withdrew the request for oral proceedings and requested a decision on the state of the file. The oral proceedings were held nevertheless on 17 November 2006 at which the decision to refuse the application was made. The grounds in the written decision dated 6 December 2006 were that claims 1 to 4 lacked novelty over D1, claim 5 lacked inventive step over D1 and common general knowledge, and the amended claims filed on 16 October 2006 contravened Article 123(2) EPC.

The petitioner filed a Notice of Appeal on 18 January 2007 and Grounds of Appeal on 13 April 2007 which included amendments intended to overcome all the objections raised in the decision under appeal. For this reason interlocutory revision and resumption of examination proceedings could have been expected but did not occur which could have been a substantial procedural violation. On 12 November 2009 the Board of Appeal summoned oral proceedings to be held on 11 February 2010. In a communication dated 4 December 2009, the Board acknowledged the novelty of the invention over the prior art previously cited but presented numerous and complex new objections relating to the amended claims including six clarity objections, three new objections under Article 123(2) EPC, a new objection that claim 1 lacked inventive step over D2, and a new objection that claim 1 lacked novelty over a new document D3 which had not been cited before. Thus after two and a half years of inaction and only ten weeks before the oral proceedings, the petitioner was faced with a new case to defend.

On 11 January 2010 the petitioner filed further amended claims to overcome the new objections. At the oral proceedings the petitioner's professional representative submitted various arguments which the Board accepted as overcoming the objections raised in both the decision under appeal and its own communication. However, the Board raised a new objection at the oral proceedings that the amended claims lacked inventive step over D3. The representative argued that the case should be remitted to the first instance to consider this objection and remittal thus became the main issue. The petition relied on the Board's summary of its arguments for remittal at point 3.1 of its decision:

"3.1 The appellant's representative reminded the Board that the summons to attend oral proceedings before the examining division had been issued after a single communication of the examining division and that, as a consequence, the appellant/applicant had had only limited opportunities to defend his case before the first instance department. She further emphasized that the current request remedied all objections relied upon by the examining division in its refusal and that the jurisprudence of the boards of appeal implied, in such situations, that the case be remitted back to the examining division in order to ensure that the applicant had the benefit of two instances. In support of this view, reference was made *inter alia* to decisions of the boards of appeal T 180/95, T 47/90 and T 139/87. Finally, the appellant stressed that the document reflecting the closest prior art had been **introduced *ex officio* by the Board of Appeal for the**

first time into the proceedings in the annex to the summons to attend oral proceedings before the Board.

In conclusion, the appellant's representative held that the balance between conflicting principles such as, on the one hand, the right of the appellant to be heard and, on the other hand, the right of the public to have a fair knowledge of the rights resulting from a patent application within a reasonable period of time was on the side of the appellant." (Emphasis added by the Enlarged Board to indicate text omitted, presumably unintentionally, by the petitioner.)

The Board of Appeal rejected these arguments for the following reasons. Issuing a single official communication during examination proceedings was not convincing evidence of a lack of sufficient opportunity for the petitioner to defend its position. Document D3, introduced by the Board of Appeal ten weeks before oral proceedings, was a family member of a document cited in parallel proceedings in the USA so the petitioner "could not be considered unprepared to the introduction of D3 into the appeal proceedings" (see the decision, Reasons, point 3.2). There was more jurisprudence on remittal than that cited by the petitioner: T 111/98 decided that "Amendment of the claims in response to the citation of a new document is not as such a sufficient reason to remit the case to the department of first instance". The Board then based its summary entirely on reasoning from T 111/98:

"In view of this decision, what actually appears to be essential when a board exercises its discretion to remit a case is whether the factual framework has

substantially changed during the appeal proceedings" (see Reasons, point 3.2 of the decision, emphasis added by the petitioner).

At the end of the oral proceedings the Board, in the light of T 111/98, refused to remit the case to the Examining Division, decided that the invention lacked inventive step having regard to D3, and dismissed the appeal.

The petitioner's reasons for asserting that the decision under review should be set aside were that:

1) it mis-interprets the extent of the right to be heard provided by Article 113 EPC by following decision T 111/98 which is inherently flawed, and/or

2) it unfairly restricts the applicant's right to be heard provided by Article 113 EPC

a) by not considering the balance between different legal factors and decisions relevant to a decision on remittal to the first instance in the circumstances of the present case, and

b) by incorrectly applying T 111/98, notably by failing to consider whether the present case corresponded to the first of the two "exceptions" specified in T 111/98 for allowing remittal to the first instance when a new document is introduced into proceedings on appeal.

2 - Petitioner's view of the right to be heard

In order for Article 113 EPC to fulfil its intended purpose, the right to be heard must provide a party with both notice of the legal argument or objection advanced against it and a real and effective possibility to reply. The approach adopted by the Board in the present case recognises the need for notice of the objection but considers only one occasion for a response of some kind will satisfy the right to be heard. That is overly formalistic - Article 113 EPC requires not just a possibility to present some kind of case but a real and effective opportunity to obtain and present arguments which properly reflect the merits of the case.

Factors which affect what is required to provide such a real and effective opportunity depend on the circumstances of the particular case but include the specific nature of the legal arguments advanced against a party, the complexity and number of those arguments, and further arguments presented in response to its case especially during oral proceedings. It may be necessary to gather and/or properly organize evidence, conduct experiments, locate suitable witnesses, analyse the case, determine an appropriate defence, and present arguments. Moreover, in all cases, a certain minimum time is required to obtain advice, take strategic decisions and instruct representatives.

3 - Mis-interpretation of the extent of the right to be heard by following T 111/98

Decision T 111/98, which provided the main reason for the Board to refuse remittal in the present case (see the citation from point 3.1 of its decision above), is flawed and should not be followed, notably because it unduly restricts the right of parties to be heard.

T 111/98 considered (see Reasons, point 1.2) the question whether the introduction of a new document into appeal proceedings – changing the factual framework of the case after delivery of the decision under appeal – requires or justifies a remittal of the case to the first instance. It concluded:

a) Article 111(1) EPC provides a Board of Appeal with the discretion to "exercise any power within the competence of the department which was responsible for the decision appealed" or to "remit the case to that department for further prosecution."

b) The provision of a discretionary power would make no sense if the boards were *ipso facto* obliged to remit the case whenever new matter was raised in appeal proceedings, irrespective of the nature of such matter.

c) Thus, in accordance with T 557/94 and T 966/95, Article 111 EPC confers on a Board of Appeal the power to act *inter alia* as the first and only instance in deciding upon a case taking into account a document first filed in appeal proceedings, without the possibility of further appellate review.

The reasoning in (b) and (c) is flawed in logic and in law.

As regards point (b), the provision of a discretionary power "makes no sense" only if there are no circumstances under which this power could be exercised by the Board of Appeal. However, there are many different circumstances in which Boards of Appeal are free to exercise unfettered discretion regarding remittal or non-remittal of cases to first instance when new matter is raised – new arguments or grounds of objection, new experimental evidence, amendments of claims. The Board in T 111/98 was concerned only with the specific case of remittal when the "new matter" was a new document introduced on appeal. Thus the justification - based on "making sense" of the discretion - for a Board of Appeal to act as the first and only instance in such a case was not made out. It not only makes sense, but is a correct interpretation of the law, for the discretionary power provided by Article 111(1) EPC to remit (or not) a case to the first instance to exist yet to be subject to obligations on the Board of Appeal to remit cases in certain circumstances where overriding considerations – for example the applicant's need for two instances to ensure a correct respect of his right to be heard - determine that this is just and appropriate.

As regards point (c), as well as being based on the flawed reasoning in (b), this was said to be in conformity with T 557/94 and T 966/95. T 966/95 was a decision of the same Board as issued T 111/98 and, as regards remittal, is in substantially identical terms so cannot be considered an independent endorsement of

T 111/98. Although in T 557/94 a different Board rejected an argument for remittal based on Article 32 TRIPS, it did not endorse a generalized approach of Boards of Appeal acting as a first and only instance. Indeed, it said (see Reasons, point 1.2):

"Quite a different matter is whether the rights of the parties to fair proceedings are impaired if a new document is first introduced in appeal proceedings. The case law of the boards of appeal of the EPO calls for careful consideration when such a procedural situation arises".

Although the Board in T 557/94 declined to remit despite a new document, this was probably influenced by the fact that non-remittal would not disadvantage the patentee because the Board was inclined to maintain the patent even in the face of the new document. Thus, T 557/94 does not provide the support claimed for it by T 111/98.

4 - Failure to balance different factors

T 111/98 is not the only decision which deals with remittal of cases to the first instance, or even the only such decision relating to remittal in cases where new documents are cited on appeal. Historically, EPO jurisprudence on this issue tends to favour remittal in cases where a new document is cited on appeal: see, for example, T 28/81, T 147/84, T 258/84, T 273/84, T 170/86, T 198/87, T 205/87, T 215/88 and T 611/90. Indeed, the Board of Appeal cited T 111/98 to show that the jurisprudence regarding remittal if a new document is filed on appeal was not unanimous (see Reasons,

point 3.2). However, despite the different points of view expressed in different decisions, the Board declined to weigh up the balance of legal factors but merely followed the approach in T 111/98 and thereby erred in law. In particular, it did not take into account whether the petitioner's right to be heard was sufficiently respected by a decision at a single instance.

The Board of Appeal in T 111/98 had to consider in *inter partes* proceedings whether the admission of a new document on appeal should lead to remittal when the relevant document had been cited more than two years before the oral proceedings. In the present case the Board made much of the fact that the new document introduced ten weeks before the oral proceedings had an equivalent which had been cited in separate proceedings on a parallel patent application in another jurisdiction. That cannot discharge the Board from its duty to give a party a proper opportunity to respond to the objections and arguments based on that document especially since they are entirely independent of any arguments that may have been used in the other jurisdiction.

5 - Omission to consider one "exception" in T 111/98

The Board of Appeal's decision stated (see Reasons, point 3.2):

"Furthermore, the Board notes that, contrary to the view defended by the appellant, the jurisprudence of the boards of appeal is not unanimous when deciding on the possible remittal of a case to the department of

first instance. As for instance stressed in decision T 111/98, remittal depends on the circumstances of the case. In particular, "Amendment of the claims in response to the citation of new document during appeal proceedings is not as such a sufficient reason to remit the case to the department of first instance" (cf. T 111/98, head note; Reasons, point 1.2). In view of this decision what actually appears to be essential when a board exercises its discretion to remit a case is whether the factual framework has substantially changed during the appeal proceedings. In the Board's judgement, the introduction of D3 into the present appeal proceedings does not, however, amount to a substantial change in the factual framework."

Decision T 111/98 (see Reasons, point 1.2) said:

"In the Board's view remittal, due to the admission of a new document, should therefore rather be an exception e.g. if, without remittal, a party would not have had sufficient opportunity to defend itself against an attack based on a new document, or if the factual framework has changed to such an extent that the case is no longer comparable with the one decided by the first instance."

In the decision under review, the Board of Appeal considered only the question of whether the current case corresponded to the second of those "exceptions". It did not consider whether or not the current case corresponded to the first of the two exceptions - which also corresponds specifically to the question of whether or not a party's right to be heard has been properly respected. This was a misapplication of

decision T 111/98. If for no other reason, it is appropriate to re-open the appeal proceedings to give proper consideration to this.

If the Enlarged Board of Appeal agrees to re-open this case for this reason, it would be helpful if it could also confirm the correct principles to be applied by the Board of Appeal when deciding whether or not the applicant has had "sufficient opportunity to defend itself against an attack based on a new document". The petitioner believes the proper principles to be those it summarized (see section III.2 above). If those principles are applied to the present case, it will be realized that the applicant has not been given a real and effective possibility to present its case, particularly in view of the fact that the actual objection which led the Board to reject the present appeal was raised for the first time during the oral proceedings.

- IV. The petition requested (by implication) that the Enlarged Board of Appeal set aside the decision of 11 February 2010 and re-open the appeal proceedings. There was no request for oral proceedings.

Reasons for the Decision

Procedural matters

1. Since the petitioner did not request oral proceedings and since the Enlarged Board in its composition pursuant to Rule 109(2)(a) EPC has, on the basis of the petition (see Rule 109(3) EPC), found unanimously that

the petition is clearly unallowable, this decision has been issued without any other procedural steps being necessary.

2. The petition does not contain any requests as such but this is not mandatory (see R 5/08 of 5 February 2009, Reasons, points 6-8). In any event, a request to set aside the decision under review and re-open the appeal proceedings is at least implied in the last paragraph at the foot of page 7 and the second and third paragraphs on page 16 of the petition.

Admissibility

3. The petition was filed within two months of notification of the decision in question, the petitioner was adversely affected thereby, the prescribed fee was paid in time, and the petition identified grounds contained in Article 112a(2) EPC and complied with Rule 107(1) and (2) EPC.
4. As regards the requirement in Rule 106 EPC to object to a procedural defect during the appeal proceedings, the petitioner says that it objected to the Board of Appeal that its right to be heard was breached by the Board's refusal to remit the case to the Examining Division. The Board's decision confirms that the petitioner's right to be heard was at least mentioned in argument (see the decision, Reasons, point 3.1, last sentence). There is however no confirmation, either in the petition or in the minutes of the oral proceedings or in the decision, that the petitioner made an objection under Rule 106 EPC *per se* as should be done according to the approach set out in the Enlarged Board's

decision R 4/08 of 20 March 2009 (see Reasons, point 2). However, any doubt as to this requirement can be resolved in the petitioner's favour since the petition is clearly unallowable.

Allowability

5. The only ground relied on in the petition is Article 112a(2)(c) EPC which specifies a fundamental violation of Article 113 EPC. The only applicable provision of that Article can be Article 113(1) EPC which provides that decisions of the European Patent Office (which includes the Boards of Appeal) may only be based on grounds or evidence on which the parties have had an opportunity to be heard - in short, the right to be heard. The petitioner's case that its right to be heard was denied is based solely on the Board's decision to refuse to remit the case to the first instance in accordance with the petitioner's auxiliary request (see the petition, page 2, second paragraph; page 5, penultimate paragraph to page 16, fifth paragraph; and section III.3 to 5 above). That refusal, according to the petitioner, denied it the chance of dealing adequately, i.e. at two instances, with document D3.
6. The Enlarged Board generally agrees with the petitioner's submissions (see section III.2 above) that the right to be heard means an adequate opportunity to be heard. However, these submissions do not affect the present case. On the issue which the petitioner itself calls the "main issue" (see section III.1, third paragraph above) - namely whether or not the case should have been remitted to the first instance - the

petitioner was, as the petition itself acknowledges, heard. There was quite clearly no denial of the right to be heard on that issue since the petitioner relies on the summary in the decision (see Reasons, point 3.1) of its own arguments (see the petition, page 5, last paragraph, and page 6; and section III.1 above, third paragraph) and makes no complaint whatsoever that it was denied any opportunity to be heard on this issue.

7. As mentioned above (see point 5), the petitioner's case that its right to be heard was denied is based solely on the Board's decision to refuse to remit the case to the first instance. Thus the petitioner's one and only real complaint is not that it was not heard on the issue of remittal but that the Board of Appeal, after hearing the petitioner, did not order remittal. This appears not only from its reasons for setting the decision aside (see the end of section III.1 above), but also from its opening argument (see section III above, under the heading "Allowability") and its argument about Rule 106 EPC that its right to be heard was breached by the refusal to remit (see section III above, under the heading "Admissibility"). However, and apart from what is said in point 6 above, there are several reasons why the actual decision cannot be reviewed in petition proceedings.
8. First, there is no right to a remittal, only a discretion which may or may not be exercised in a party's favour under Article 111(1) EPC and which is the subject of considerable case-law. The petition itself acknowledges this in the first part of its long attack on T 111/98 (see the petition, pages 11 to 14; and section III.3 above) and in its expression of hope

that the Enlarged Board will "confirm the correct principles to be applied by the Board of Appeal" (see the petition, page 16, paragraph 3; and section III.5 above, last paragraph).

9. Second, the right to be heard which has allegedly been lost is that of being heard again at first instance. However, if there is no right to a remittal, there is no right to a further hearing before the first instance so no right to be heard can have been denied. If, as in this case, there was no denial of the right to be heard in arriving at the decision on the remittal request, then all arguments as to other steps which might have been taken if remittal had been ordered are speculative and irrelevant (see R 12/09 of 15 January 2010, point 8).
10. Third, the issue whether to remit or not was a matter of substance in the appeal proceedings which the Enlarged Board cannot consider in petition proceedings (see R 1/08 of 15 July 2008, Reasons, point 2.1). The petitioner itself demonstrates this by basing the petition on its disagreement with the Board's interpretation of the case-law (see again its reasons for setting aside the decision under review in section III.1 above). Further, the Enlarged Board cannot in petition proceedings act as a third instance or second-tier appellate tribunal (see again R 1/08 of 15 July 2008, Reasons, point 2.1). However, that is exactly what the petition seeks when it asks the Enlarged Board for a decision setting out the principles to be applied by the Board of Appeal in a re-opened case (see section III.5 above, last paragraph).

11. For completeness, the Enlarged Board notes there are two other comments in the petition which are critical of the Board of Appeal - that it raised new objections in its communication only ten weeks before the oral proceedings and that it raised another new objection at the oral proceedings (see page 5 of the petition for both). Neither of those criticisms is used to support the alleged fundamental procedural defect as such but, even if they were, the Enlarged Board's view would not be different.
12. The first of those points - that new objections were raised in the Board's communication - cannot have any bearing on the petition at all since it appears from the petition itself (see again page 5) that the petitioner overcame all objections in both the decision under appeal and the Board's communication. The Board's written decision confirms this by only dealing with the objection of lack of inventive step over D3 which was apparently first raised at the oral proceedings.
13. The second point - namely, that the objection of lack of inventive step over document D3 was only raised at the oral proceedings - simply forms part of the misguided argument that the refusal to remit the case to the first instance was a denial of the right to be heard. Even if one accepts that the objection was raised late (and, since novelty over D3 was an objection raised in the communication, inventive step over D3 was at least a foreseeable objection from that point in time too), this appears to be the true reason why the petitioner wanted remittal. By "true reason" the Enlarged Board means that, although the petitioner observes that the objection was only raised at the oral

proceedings, its stated complaint is of inadequate opportunity to deal with D3 without remittal. D3 was raised in the communication ten weeks before the oral proceedings, there was no request to adjourn those proceedings, and the petitioner came prepared to argue novelty over D3, did so and succeeded. In truth, the request for remittal was only maintained, not because D3 was introduced ten weeks before, but because the Board, at the oral proceedings, considered inventive step over D3 and ultimately found against the petitioner on that. But, as already explained (see points 5 to 10 above), the petitioner was heard on its request for remittal which was refused in the exercise of the Board's discretion which was part of the substance of the case.

14. Thus, even if the petitioner's criticisms are elevated to the status of supporting arguments, there is no question of a denial of the right to be heard and no fundamental procedural defect. The petition is clearly unallowable.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli