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**Datasheet for the decision
of the Enlarged Board of Appeal
of 15 June 2011**

Case Number: R 0017/10
Appeal Number: T 1550/05 - 3.3.05
Application Number: 01300083.1
Publication Number: 1118382
IPC: B01J 13/08
Language of the proceedings: EN

Title of invention:
Microcapsule and process for production thereof

Patentee:
Kureha Corporation

Opponent:
Papierfabrik August Koehler AG

Headword:
-

Relevant legal provisions:
EPC Art. 112a, 113
EPC R. 104, 106, 107, 124

Keyword:
-

Decisions cited:
R 0004/08, R 0008/08, R 0006/09

Catchword:
-



Case Number: R 0017/10

D E C I S I O N
of the Enlarged Board of Appeal
of 15 June 2011

Petitioner: Kureha Corporation
(Patent Proprietor) 3-3-2, Nihonbashi-Hamacho, Chuo-ku
Tokyo 103-8552 (JP)

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Other Party: Papierfabrik August Koehler AG
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Representative: Hagemann, Heinrich
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Decision under review: Decision of Technical Board of Appeal 3.3.05 of
the European Patent Office of 30 March 2010.

Composition of the Board:

Chairman: J.-P. Seitz
Members: R. Menapace
W. Sieber

Summary of Facts and Submissions

- I. The petition for review concerns decision T 1550/05 of Board of Appeal 3.3.05, revoking European patent No. 1118382.
- II. The proceedings leading to said decision can be summarised as follows:
- (i) The opponent lodged an appeal against the interlocutory decision of the opposition division posted on 28 October 2005 finding that the patent as amended met the requirements of the Convention. The grounds of appeal dated 28 February 2006 were accompanied by document "D6" on further comparative experiments.
 - (ii) With letter dated 9 November 2006 the respondent (patent proprietor) filed "Experimental record (2)" "D8".
 - (iii) On 14 January 2010 the board of appeal issued summons to oral proceedings scheduled to take place on 30 March 2010.
 - (iv) On 1 March 2010 the appellant (opponent) filed further observations, including remarks on the experiments "D6", and a further experimental report in German ("Versuchsbeschreibungen") as "D9".
 - (v) In reply, on 24 March 2010 further observations were filed on behalf of the proprietor (respondent), in which it was argued *inter alia*

that under the circumstances the conduct of the appellant in filing the experimental report D9 (called "D12" by the patent proprietor) less than one month prior to the oral proceedings amounted to an abuse of procedure and the report should be disregarded for that reason alone. Furthermore, it was extensively explained why, in the proprietor's view, the evidence in the report was not highly relevant and therefore should not be admitted into the proceedings.

(vi) At the end of the oral proceedings on 30 March 2010 the decision under review was announced.

III. Nine days later a clean copy of the minutes of the oral proceedings was sent to each party by registered letter. The minutes are silent on the experimental report D9 and no objection pursuant to Rule 106 EPC is recorded in them.

IV. The reasons for the decision were notified to the parties by registered letter dated 6 August 2010 and received by the patent proprietor's representative on 12 August 2010.

V. On 15 October 2010 a petition for review pursuant to Article 112a EPC was filed on behalf of the patent proprietor (hereinafter referred to as the "petitioner") and the prescribed fee was paid.

The petition was based on Article 112a(2)(c) EPC, namely fundamental violations of the petitioner's rights under Article 113 EPC, on the grounds that the board of appeal

- (i) argued for the first time during the oral proceedings that the experiments in document "D8", which had been filed by the petitioner over three years before, showed differences between the stirring procedure and on the basis of that considered that these differences were not necessarily related to the differences between claim 1 and the closest prior art represented by document D5. As these arguments, which were crucial in reaching the decision under review, had not been raised by either the opponent or the board of appeal prior to the oral proceedings, they came as a great surprise to the petitioner, who had not been given sufficient opportunity to respond;

- (ii) had not granted the petitioner sufficient time to react to D9 which was received by the petitioner's representative on 9 March 2010 after the Office forwarded it to him; the Japanese patent proprietor (respondent) did not receive the English translation until 13 March 2010. This left only 17 days for the petitioner to prepare any rebutting evidence, while the opponent had every opportunity to file additional evidence even earlier than only one month before the oral proceedings, in particular in view of the fact that D9 was filed in response to criticisms from the petitioner that had been made over three years earlier, in its letter of 9 November 2006. However, the board of appeal did not discuss or consider the petitioner's arguments and request set out in its letter of 24 March 2010, which

were made in response to extremely late-filed evidence from the opponent. This was clear from the minutes and the reasons for the decision under review, which were silent on the petitioner's arguments regarding the contents of D9; in particular, no decision or comment was made on the petitioner's request to disregard D9. The board of appeal therefore relied on late-filed evidence to reach its decision without taking into consideration the petitioner's comments thereon.

The petition was also based on Article 112a(2)(d) in conjunction with Rule 104(b) EPC, on the ground that the board of appeal ignored the petitioner's request to disregard D9 and the petitioner's comments on the relevance of D9, which document strongly influenced the board of appeal in reaching the decision under review and prompted it to apply greater weighting to the opponent's experimental evidence, as opposed to the petitioner's evidence.

It was further argued, that the requirements of Rule 106 EPC were met, because the issue of admissibility of the evidence D9 was raised in the petitioner's letter of 14 March 2010. Additionally, the petitioner could not have foreseen that the board of appeal would ignore the requests and comments in that letter.

VI. The petitioner requests that the decision under review be set aside and that the Enlarged Board of Appeal order the re-opening of the proceedings before the board of appeal. If the Enlarged Board of Appeal

intends to reach a decision other than in accordance with this request, oral proceedings are requested.

Reasons for the decision

Admissibility of the petition for review, formal requirements

1. In accordance with the provision of Article 112a(4) EPC, the petition was filed, and the prescribed fee was duly paid, within two months of notification of the decision of the board of appeal.

The petitioner is adversely affected by the decision under review (Article 112a EPC) and the requirements of Rule 107 EPC in respect of the contents of the petition for review have been fulfilled.

2. However, this is not the case for the requirement of Rule 106 EPC:

- 2.1 As the Enlarged Board held in case R 4/08, raising an objection pursuant to Rule 106 EPC is a procedural act and, except where such objection could not be raised during the appeal proceedings, a precondition for access to an extraordinary legal remedy against final decisions of the Boards of Appeal. Pursuant to Rule 106 EPC a petition under *inter alia* Article 112a(2)(c) EPC (*i.e.* on the ground that, as the petitioner alleges, a fundamental violation of Article 113 EPC occurred) is admissible only if an objection in respect of the procedural defect was raised during the appeal proceedings and then dismissed by the board of appeal. Therefore, such an objection must be expressed by the

party in such a manner that the board of appeal is able to recognize immediately and without doubt that a formal objection within the meaning of Rule 106 EPC was raised, so that the objection can be dealt with by the board either by meeting or by dismissing it.

2.2 Evidence for the fact that such a qualified procedural objection was raised during oral proceedings is normally that it appears in the minutes, which, as prescribed by Rule 124(1) EPC, must contain the essentials of the oral proceedings and the parties' relevant statements, the latter certainly including any objection pursuant to Rule 106 EPC. However, the minutes of the oral proceedings on 30 March 2010 contain nothing about an objection by the petitioner, nor did he object to the contents of the minutes as notified to him about six months before he filed the present petition. Anyway, the petitioner has not claimed that he raised during the oral proceedings any objection which would qualify under Rule 106 EPC.

2.3 The petitioner's letter of 24 March 2010 requesting that D9 not be admitted into the proceedings on the ground that its late filing constituted an abuse of the proceedings by the other party (see II(v), above) cannot be considered as qualifying as an objection within the meaning of Rule 106 EPC. The request and the arguments in support were directed against the conduct of the other party, not against a procedural violation within the meaning of Article 112a(c) or Rule 104 EPC, which by definition can be committed by a board of appeal only. Moreover, at that time the board of appeal had not yet reacted in any way to either the respondent's conduct in question or to the petitioner's

criticisms. However, an objection under Rule 106 EPC must be expressly described as such; it cannot be formulated prematurely and without specifying the alleged fundamental procedural defect within the meaning of Article 112a EPC (R 8/08, R 6/09).

- 2.4 The exception that "such objection could not be raised during the appeal proceedings" (Rule 106 EPC) does not apply in respect of any of the alleged procedural defects.

Even assuming, for the sake of argument, that in the oral proceedings it was too late to confront the petitioner with arguments against the probative strength of D8 without depriving it of a fair opportunity to respond (see V(i) above), there was nothing to stop the petitioner during the oral proceedings from objecting to such a procedural violation, for example by requesting an interruption or a postponement of the oral proceedings in order to prepare its defence against this (allegedly) new and surprising line of attack.

The same opportunity existed for the petitioner in regard to the consideration of D9 (V(ii) above) and the (alleged) failure to decide on the petitioner's request to disregard this document (relied upon under Rule 104(b) EPC - V. above). There is no reason to assume, nor has it been contended, that during the oral proceedings on 30 March 2010, at the end of which the debate was closed and the decision under review was announced, the petitioner was prevented in any way by the board of appeal from commenting on the admissibility of D9 (again) and/or from raising an

explicit formal objection against the taking into account of (the content of) that document. For the purposes of Rule 106 EPC it is, therefore, immaterial that (apparently) no explicit decision was taken on the request to disregard D9. The admission of late-filed documents and/or other evidence is a matter for the board's discretion and, therefore, as such not subject to review under Article 112a EPC.

3. In conclusion, the requirement under Rule 106 EPC is not met in respect of any of the alleged procedural violations on which the petitioner relies.

Allowability of the appeal

4. In view of the above, the allowability of the petition need not be examined.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly inadmissible.

The Registrar:

The Chairman:

P. Martorana

J.-P. Seitz