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**Datasheet for the decision
of the Enlarged Board of Appeal
of 16 December 2011**

Case Number: R 0003/11
Appeal Number: T 0446/08 - 3.2.05
Application Number: 99109290.9
Publication Number: 0965778
IPC: F16J 15/08
Language of the proceedings: EN

Title of invention:
Metal gasket with two half beads

Patentee:
ISHIKAWA GASKET CO. LTD.

Opponent:
ElringKlinger AG

Headword:
Petition for review/ISHIKAWA GASKET CO. LTD.

Relevant legal provisions:
-

Keyword:
"No duly qualified objection within the meaning of Rule 106 EPC"

Decisions cited:
R 0004/08, R 0008/08, R 0007/11

Catchword:
Petition for review clearly inadmissible.



Case Number: R 0003/11

D E C I S I O N
of the Enlarged Board of Appeal
of 16 December 2011

Petitioner:
(Patent Proprietor)

ISHIKAWA GASKET CO. LTD.
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Representative:

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Other Party:
(Opponent)

ElringKlinger AG
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Representative:

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Decision under review:

Decision of the Technical Board of Appeal
3.2.05 of the European Patent Office of
4 October 2010.

Composition of the Board:

Chairman: B. Günzel
Members: J.-P. Seitz
H. Meinders

Summary of Facts and Submissions

- I. European Patent No. 0965778 was granted to ISHIKAWA GASKET Co. LTD and opposed by ElringKlinger AG.

By its decision posted on 20 December 2007 the Opposition Division decided to reject the opposition holding that the grounds under Article 100(a) EPC did not prejudice the maintenance of the patent as granted. The Opponent filed an appeal against this decision on 19 February 2008 and the corresponding statement of grounds on 17 April 2008.

This statement was replied to on 2 October 2008 by the proprietor.

- II. The following requests had been submitted:

- by the appellant/opponent that the decision under appeal be set aside and that the patent be revoked;
- by the respondent/patent proprietor that the appeal be dismissed.

In a communication posted on 13 July 2010 annexed to the summons to the requested oral proceedings pursuant to Article 15(1) of the Rules of Procedure of the Boards of Appeal (RPBA), the Board 3.2.05 conveyed its provisional, and therefore non-binding, opinion to the parties.

Said communication referred to the following documents:

A1: JP-A-08-93918 and its English translation,

B1: Drawing No. 003130 ElringKlinger GmbH, cylinder head gasket having part No. 452 160, material "Metaloflex" (last amendment dated 18 February 1997),

D1: US-A-5,711,537.

As regards document B1, the communication reminded the parties that, according to the case law of the Boards of Appeals of the European Patent Office, a single sale to a single customer not subject to a secrecy agreement is sufficient to establish a public prior use, and that since the cylinder head gasket No. 452160 appeared to have been sold to Daimler-Benz AG before the priority date of the patent in suit, the cylinder head gasket shown in document B1 seemed to belong to the prior art.

In the provisional view of the Board, however, this piece of prior art did not seem to anticipate all features of claim 1 of the patent in suit, and novelty, therefore, could be acknowledged.

More particularly, the attention of the parties was then drawn to Articles 12(2) and 13 of the RPBA, according to which any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered only at the Board's discretion.

It further informed the parties that the criteria for exercise of discretion include *inter alia* whether or not there are good reasons for the late filing and whether or not the amendments and submissions are

relevant to the resolution of the issues to be discussed during the oral proceedings.

The Board set a time limit of one month before the scheduled date for oral proceedings in order to give itself and the other party sufficient time to consider new filed documents or requests. The parties were reminded that under Article 114(2) EPC together with Article 13(3) RPBA the Board may disregard facts or evidence which are not submitted in due time.

- III. Oral proceedings took place on 4 October 2010, and after discussion of novelty of Claim 1 as granted, the respondent proprietor, which up to that time had only requested that the appeal be dismissed, filed two auxiliary requests.

The Board refused to admit them into the appeal proceedings and revoked the patent.

- IV. The corresponding reasoned decision in writing, T 446/08, was posted on 3 December 2010 and deemed to have been notified on 13 December 2010.
- V. The proprietor (respondent in the appeal proceedings and hereafter the petitioner) filed on 3 February 2011 a petition for review by the Enlarged Board of Appeal of the above-mentioned decision. The corresponding fee was paid on the same day.

The petition relies on the grounds of Article 112a(2) (c), (d) EPC that a fundamental procedural defect consisting of a violation of the right to be heard under the provisions of Article 113 EPC and a violation

of the provisions of Rule 104(b) EPC occurred in the appeal proceedings, more particularly in the course of the oral proceedings held on 4 October 2010.

VI. The petitioner requested:

(1) that the Board's decision of 3 December 2011 (sic) be set aside and the proceedings before the Technical Board of Appeal be re-opened: and

(2) that the fee for the petition for review by the Enlarged Board of Appeal be refunded in view of the procedural defect that incurred in the appeal proceedings.

Oral proceedings have not been requested.

VII. In order to support its requests the petitioner submitted that the decision of the Technical Board, that claim 1 as granted lacked novelty in view of the prior use taught in document B1, was based on a totally surprising and new construction by the Board of the disclosure of said document.

For this very reason the petitioner filed two auxiliary requests after the issue of novelty of claim 1 as granted had been thoroughly discussed.

While refusing to admit such requests into the appeal proceedings the Board did not duly exercise its discretion, since the subject-matter of the independent claims 1 of these requests had already been addressed by the Board, and by both parties in the opposition as well as in the appeal proceedings.

More importantly, in the petitioner's eyes the Board's reasoning in respect of the refusal to admit the auxiliary requests as outlined on page 8, first paragraph of the decision for which review is sought, is false and in contradiction to the facts. In particular, the amendments to independent claim 1 of both auxiliary requests could not surprise the appellant/opponent nor the Board of Appeal. For the sake of completeness, it added that the appellant/opponent itself did not request the rejection of the auxiliary requests for alleged non-admissibility.

Moreover, at the end of the oral proceedings, the Chairman of the Board of Appeal expressed the opinion that the amendments in the auxiliary requests would obviously render the available prior art obsolete, so that this would also be a reason for the non-admissibility of these auxiliary claims.

Since this statement conveys the assumption that the auxiliary requests defined a patentable invention, and since they were nevertheless not admitted into the proceedings, this also shows that the Board did not properly exercise its discretion under the provisions of Articles 12(2) and 13 RPBA.

The petitioner then submitted that in accordance with Rule 106 EPC it objected to the rejection of the auxiliary requests for the aforesaid reasons. However, the Board did not allow a more detailed discussion of the admissibility of the auxiliary claims in the oral proceedings, (cf petition page 5, point 7).

Therefore the Board's decision not to accept these requests constitutes a serious procedural defect according to Rule 104(b) EPC and a clear violation of the petitioner's right to be heard according to Article 113 EPC.

Reasons for the Decision

1. The requirements under Article 112a EPC concerning the time limit and the payment of the petition fee are met and the petitioner is adversely affected by the decision for which review is sought.
2. The Enlarged Board of Appeal in its current composition pursuant to Rule 109(2)(a) EPC is empowered to examine the petition for review and to reject it only if it is clearly inadmissible or unallowable; such decision requires unanimity and, under Rule 109(3) EPC, is taken on the basis of the petition.
3. Under the provisions of Rule 106 EPC, a petition for review under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during these appeal proceedings.
 - 3.1 Raising an objection pursuant to Rule 106 EPC is a procedural act and, when it is possible, a precondition for access to review by the Enlarged Board. It is an extraordinary legal remedy against final decisions of

the Boards of Appeal. Therefore such an objection must be expressed by a party in such a form that the deciding body is able to recognize immediately and without doubt that an objection pursuant to Rule 106 EPC is intended. For the same reason such an objection must be specific, that is the party must indicate unambiguously which particular defect amongst those exhaustively listed in paragraph 2(a) to (c) of Article 112a and Rule 104 EPC it intends to rely on. (See R 4/08 of 20 March 2009, point 2.1 of the Reasons, R 8/08 of 19 May 2009, point 1.2.3 of the Reasons and R 7/11 of 5 October 2011, point 2.1 of the Reasons).

4. This pre-requirement was not fulfilled in the case under consideration.
- 4.1 Although it does not follow from the minutes of the oral proceedings that the Chairman's statement that the auxiliary requests were, in his opinion, not admissible was made before the debate was closed, this is nevertheless clearly and unambiguously derivable from the petition itself (see in particular point 6 *in fine*, page 5 and point 7, page 5). It follows that nothing prevented the petitioner from raising an objection pursuant to Rule 106 EPC.
- 4.2 In fact on its own admission, the petitioner implicitly recognises that it was able to identify the alleged procedural violation during the course of the oral proceedings held before the Board of Appeal (see in this respect page 5, of the petition and in particular point 7). The alleged objection is, however, not reflected in the minutes of the oral proceedings nor in the decision in writing. To the contrary, apart from

the usual phrases that the parties addressed the Board, after which the matter was discussed with the parties, and the reciting of the requests of the parties, the minutes contain the following:

"The Chairman asked the parties if they had any other observations or requests and there were none."

This clearly contradicts the petitioner's position that the objection pursuant to Rule 106 EPC was in fact raised.

The absence in the minutes of an objection under Rule 106 EPC and of any request for correction of the minutes are strong indications, that such objection, if any, was at least not duly qualified, which is a necessary condition (see point 3.1 above).

- 4.3 Besides, the assertion by the petitioner that the admission of the auxiliary requests had not been objected to by the appellant (opponent) is incorrect.

In the "Facts and Submissions" point VI *in fine* of the decision in writing, it is stated that the appellant/opponent did indeed request that the auxiliary requests not be admitted in the proceedings, owing to their lateness.

For these reasons the petition for review of decision T 446/08 is clearly inadmissible and must accordingly be rejected.

Order

For these reasons it is unanimously decided that:

The petition of review is rejected as clearly inadmissible.

The Registrar:

The Chairman:

P. Martorana

B. Günzel