



**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 4 November 2011**

**Case Number:** R 0006/11  
**Appeal Number:** T 0079/08 - 3.3.03  
**Application Number:** 02728552.7  
**Publication Number:** 1377617  
**IPC:** C08F 259/08  
**Language of the proceedings:** EN

**Title of invention:**  
High Build Dispersions

**Patentee:**  
E.I. DU PONT DE NEMOURS AND COMPANY

**Opponent:**  
SOLVAY SOLEXIS S.p.A.

**Headword:**  
Petition for review/DU PONT

**Relevant legal provisions:**  
EPC Art. 112a(2)(c), 113(1)  
EPC R. 104, 111(2)

**Relevant legal provisions (EPC 1973):**  
EPC R. 68(2)

**Keyword:**  
"No denial of opportunity to be heard"  
"No right to advance indication of reasons for decision"  
"Article 112a(2)(d) EPC extends only to grounds in Rule 104  
EPC; the list of grounds in Article 112a(2)(d)  
and Rule 104 EPC is exhaustive"  
"Petition for review clearly unallowable"

**Decisions cited:**

R 0001/08, R 0002/08, R 0004/08, R 0010/09, R 0012/09,  
R 0015/09, R 0016/09, R 0018/09, R 0015/10, R 0020/10,  
R 0001/11, T 0278/00

**Catchword:**

-



**Case Number:** R 0006/11

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 4 November 2011**

**Petitioner:**  
(Patent Proprietor)

E.I. du Pont de Nemours and Company  
1007 Market Street  
Wilmington  
DE 19898 (US)

**Representative:**

Morf, Jan Stefan  
Abitz & Partner  
Patentanwälte  
Postfach 86 01 09  
D-81628 München (DE)

**Other party:**  
(Opponent)

Solvay Solexis S.p.A.  
Via Turati, 12  
I-20121 Milano (IT)

**Representative:**

Benvenuti, Federica  
Solvay S.A.  
Département de la Propriété Intellectuelle  
Rue de Ransbeek, 310  
BE-1120 Bruxelles (BE)

**Decision under review:**

**Decision of the Technical Board of Appeal  
3.3.03 of the European Patent Office of  
28 October 2010.**

**Composition of the Board:**

**Chairman:** R. Menapace  
**Members:** C. Rennie-Smith  
W. Zellhuber

## Summary of Facts and Submissions

- I. The petition for review concerns decision T 79/08 of the Technical Board of Appeal 3.3.03 of 28 October 2010 to dismiss the petitioner's appeal against the decision of the Opposition Division to revoke European patent No. 1377617 entitled "High Build Dispersions". The petitioner and patent proprietor filed the petition by fax on 7 March 2011 and paid the petition fee on the same date. The petition is based on the grounds in Article 112a(2)(c) and (d) EPC. The previous proceedings, to the extent they are relevant for the purposes of the present petition proceedings, are summarized in the following sections II to VII.
- II. The patent was granted on 6 October 2004. All the independent claims contained the feature that "at least about 1.5 wt-% of said fluoropolymer particles comprise substantially rod-shaped particles having a length to diameter ratio of greater than about 5" ("rods"). An opposition was filed on 5 July 2005 on the grounds of lack of novelty and lack of inventive step (Article 100 (a) EPC) and insufficiency of disclosure (Article 100 (b) EPC). At oral proceedings on 24 October 2007 the Opposition Division held that the requirements of Articles 83 and 54 EPC were satisfied, but revoked the patent on basis of lack of inventive step. The decision contained the statement (see point 4.5) that, according to the examples of the patent, the weight percentage of rods compared to the overall amount of fluoropolymer particles was determined in a particular manner.
- III. The petitioner appealed. In its statement of grounds of appeal filed on 18 March 2008, it addressed the

Opposition Division's decision on inventive step but not the statement on how to calculate the weight percentage of rods because, in the petitioner's view, that related to sufficiency of disclosure which the Opposition Division had acknowledged. The petitioner filed a main and first and second auxiliary requests with the statement of grounds of appeal, third to seventh auxiliary requests on 27 January 2010, and an eighth auxiliary request on 9 March 2010. At least Claim 1 of all requests contained - as had the granted version of the patent in suit (cf. point II, above) - the feature that "at least about  $[n]$  weight % to about 20 weight % of said fluoropolymer particles comprise substantially rod-shaped particles having a length to diameter ratio of greater than 5", the value of  $n$  being 1.5, except in the fifth, sixth and seventh auxiliary requests, where it was 2.

- IV. At oral proceedings before the Board of Appeal on 12 March 2010 it was discussed how the weight percentage of particles having a length to diameter ratio of greater than 5 was to be determined and the petitioner submitted that the method in point 4.5 of the decision under appeal, which relied on calculating an average volume for the totality of particles present, was not correct. The Board observed that "the method of averaging adopted by both parties was consistent but not in accordance with that set out in the examples of the patent in suit" (see the Board's communication of 29 March 2010, point 4.4 and its written decision, section XV(e), page 18, lines 1 to 4). In this respect the petitioner filed a request for correction of the decision on 7 March 2011. At these oral proceedings the Board decided to continue the procedure in writing to

allow the respondent (opponent) to file better quality images of photographs on which it relied. The Board would then issue a communication setting a period of two months for the parties to make further submissions on the question of the correct calculation method for determining the proportion of rod-shaped particles. The parties were also invited to provide comparisons of the results that would be obtained using each of the two calculation methods discussed at the oral proceedings.

V. With its letter dated 3 June 2010 the respondent provided the better images and submitted that the calculation based on the averaged values of length and diameter for all particles and for rod-shaped particles ("the collective calculation method") would yield the values reported in examples 1 and 2 of the patent. In a letter dated 28 September 2010 the petitioner submitted that, in agreement with the technical experts of both parties, the patent did not teach use of the collective calculation method and that a skilled person would use the method based on the volumes of each individual rod-shaped particle ("the individual calculation method") in order to obtain the weight percentage of rods since this was the only correct mathematical method. With a further letter dated 22 October 2010, filed within the two-month period set by the Board of Appeal for further submissions, the petitioner filed an affidavit of a technical expert.

VI. Second oral proceedings were held on 28 October 2010. According to the petitioner, during the discussion of novelty the Board announced that neither the better quality photographs nor the affidavit would be allowed into the proceedings. The absence of that decision in

the summary of the oral proceedings in the Board's written decision was also the subject of the petitioner's request for correction. After discussing sufficiency of disclosure of the main request, the Board took a decision on the main request and all the auxiliary requests and closed the proceedings.

- VII. The Board of Appeal's written decision was issued on 29 December 2010. In a further decision dated 18 April 2011, the Board refused the petitioner's request to correct the earlier decision. The petitioner filed further written submissions dated 7 July 2011 arguing that the decision of 18 April 2011 supported its petition as regards the Board of Appeal's refusal to admit the affidavit of the petitioner's technical expert into the appeal proceedings. The alleged procedural violations relating to that refusal were withdrawn at the oral proceedings before the Enlarged Board.
- VIII. In a communication of 12 September 2011 the Enlarged Board of Appeal informed the petitioner of its provisional view that it appeared the petition might be clearly inadmissible as regards the alleged procedural violations subsequently withdrawn, and appeared to be clearly unallowable as regards the other alleged procedural violations for substantially the reasons given below. The petitioner responded to the communication by a further written submission dated and filed by fax on 4 October 2011.
- IX. The petition relies on six alleged fundamental procedural violations under Article 112a(2)(c) EPC (set out at (2) to (7) on pages 9 to 12 of the petition) and

two further alleged violations under Article 112a(2)(d) EPC (set out at (ii) on page 2 and (9) on page 13 of the petition). These alleged violations and the petitioner's related arguments, in writing and at the oral proceedings before the Enlarged Board, are summarized in (a) to (h) below.

As regards all the alleged violations under Article 112a(2)(c) EPC (that is, those at (a) to (f) below), the petitioner could not raise an objection under Rule 106 EPC during the appeal proceedings because, after the Board ruled that not only the main but also the auxiliary requests did not fulfil the requirements of Article 83 EPC, the chairman closed the oral proceedings.

- (a) The Board of Appeal at the oral proceedings on 28 October 2010 ruled on the auxiliary requests without giving the petitioner a chance to comment on those requests.

Neither the respondent nor the Board of Appeal raised any objections of insufficiency of disclosure of the claims according to the first to eighth auxiliary requests. The Board of Appeal said during the discussion that it now understood the method of calculation. This gave the petitioner's representative the impression that the Board would decide in his favour so, since he also had the auxiliary requests as a fallback position, he only provided part of his arguments supporting sufficiency of disclosure. He assumed that, even if he had misunderstood the Board, he would still have a chance to bring forward these



arguments with respect to the claims of the auxiliary requests, if necessary, which would have made a difference to the outcome of the decision of the Board. He was surprised when the Board after deliberation not only ruled on sufficiency of disclosure of the claims of the main request but also of all the auxiliary requests and he had no opportunity to comment on the Board of Appeal's actual view on sufficiency of disclosure with respect to the auxiliary requests.

- (b) The Board of Appeal at the oral proceedings on 28 October 2010 did not admit the affidavit of the petitioner's technical expert into the proceedings.

At the oral proceedings before the Enlarged Board the petitioner withdrew this alleged violation.

- (c) In its written decision issued on 29 December 2010 the Board of Appeal failed to acknowledge the correct method of calculation of the weight percentage of rods.

The Board's written decision (see point 4.6) criticized the petitioner for not explaining why the skilled person would assume that the individual values were to be used in order to calculate the weight percentage of the rods. However, the decision also failed to acknowledge that the method of calculation is not only part of the common general knowledge of a skilled person but also of the basic knowledge of a school teacher (as evidenced by the affidavit of a

secondary school teacher in Munich filed as Annex 4 to the petition). Furthermore, all skilled persons who gave their view during the appeal proceedings, including the respondent's technical expert (in an affidavit filed on 9 March 2010), agreed on the way of calculating the weight percentage of rods in the dispersion. Only the Board took a different view but did not explain why.

- (d) In its written decision issued on 29 December 2010 the Board of Appeal wrongly inferred from the patent (which, in accordance with usual practice, did not point to generally accepted scientific principles) that the inventor had not anticipated that the skilled reader would use the incorrect calculation.

The Board's written decision (see point 5.6) wrongly stated:

*"the evidence provided by the patent in suit itself is that the inventor was not aware of the significance of the method of calculating or even of a distinction between different methods".*

However, the inventors neither expected the incorrect method of calculation to be used nor that anyone might be confused by a purely mathematical operation known to a school teacher as much as to a person skilled in the art. It is usual scientific practice, also applied in drafting patents, that generally accepted principles are not usually pointed out. The

Board's criticism appears to require the inventor to anticipate that the skilled reader would use an incorrect instead of a correct calculation method.

- (e) The Board of Appeal based the reasoning in its written decision on the "poor quality" of images in the patent which was both wrong and never discussed during the written or oral proceedings.

The Board's written decision (see point 5.13) stated:

*"the patent in suit itself provides no means by which the validity of such an insight could be tested. Raw data is provided only in the nature of images of extremely poor quality".*

This reasoning of the Board is based on assumptions to which the petitioner could not respond. The influence of the "poor quality" of the images in the patent on the (in)sufficiency of disclosure of the invention was never discussed during the written or oral proceedings before the Board. Furthermore, the raw data filed in the international application leading to the opposed patent were of extremely good quality (as shown by the copy figures in Annex 5 to the petition which correspond to those filed in the USPTO as international receiving office).

- (f) The Board of Appeal based its decision on a different view of the calculation from that agreed by both parties and which was both completely wrong and not discussed.

The Board's written decision is based on facts or assumptions which were not discussed at any time during the opposition or appeal proceedings and against which no objection could be raised. The Board states (in point 5.16 of its decision) that both parties assumed that *"the skilled person would identify the nature of the calculation as being the source of the divergences [between the reported values of rod content and the values obtained by using the average values]"* [words in brackets added by the petitioner]. In spite of this mutual understanding of the parties, based on the knowledge of their technical experts, the Board took a different view only disclosed in its written decision namely: *"this assumption is in the Board's view not valid"*. This clearly shows the prejudiced opinion of the Board in ignoring both the technical experts and everything which had been said during the opposition and the appeal and relying only on its own unsubstantiated opinion which had not even been discussed during the oral proceedings. Further, in the same passage of its decision, the Board additionally comments on the possibility of alternative sources of error which could, in the Board's opinion, be the reason for the divergences. However, this is wrong: if the average values in the patent had been used to calculate the rod percentage, then there could be no *"errors in collating or in analysing the data, e.g. instrumental errors"* (as suggested in point 5.16) since no collation or analysis of data is involved in a purely mathematical calculation. The argument that there might exist alternative

sources of error was never discussed during the oral proceedings.

- (g) The Board of Appeal did not give reasons for not admitting the affidavit of the petitioner's technical expert into the proceedings.

At the oral proceedings before the Enlarged Board the petitioner withdrew this alleged violation.

- (h) The Board's written decision was not reasoned with respect to the auxiliary requests.

Rule 111 EPC requires that the decisions of the EPO which are open to appeal should be reasoned. This provision should by analogy apply to decisions of the Boards of Appeal because of the possibility of review. In this case, the decision referred to the auxiliary requests one to eight only in general terms but gave no reasons why they did not fulfil the requirements of Article 83 EPC.

In its written submissions of 4 October 2011 and at the oral proceedings before the Enlarged Board, the petitioner also advanced the following general argument relating to all of the alleged violations (c) to (h).

The Enlarged Board is not prevented from deciding on these alleged violations because they relate to substantive issues. In accordance with Article 112a(2)(d) EPC a Board of Appeal's written decision must be reasoned. This requirement is not fulfilled if a decision just contains reasons but the decision must also contain, in logical sequence, the

arguments which justify its order. If a party is unable to decide which of the various inconsistent findings indicated in a decision are correct and which are false, then this requirement is not satisfied (see for example decision T 278/00). Accordingly, while the petitioner agrees that substantive issues are not amenable to review, the Enlarged Board still needs to review the reasons of the decision. Since the Board of Appeal, in refusing to correct the decision, concluded that it "does not differ from the intention of the Board" (see the decision of 18 April 2011, Reasons, point 3), the parties have to speculate as to what the decision is intended to mean. Thus, the decision is not reasoned, not only with respect to the auxiliary requests (alleged violation (h)) but also with respect to alleged violations (c) to (g).

X. Oral proceedings were held on 4 November 2011 at the end of which the Enlarged Board of Appeal announced its decision.

XI. The petitioner requested

1. that the decision T 79/08 be set aside and the proceedings before the Board of Appeal be re-opened,
2. that the members who participated in taking the decision T 79/08 be replaced,
3. that reimbursement of the fee for the petition for review be ordered.

## Reasons for the Decision

### *Admissibility*

1. 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.
2. As regards the requirement in Rule 106 EPC to object to a procedural defect during the appeal proceedings, since the petitioner's case is that it was not heard on matters which only first appeared from the Board of Appeal's written decision, it could be said that the exception in Rule 106 EPC applies. This was apparently not the case with the alleged violations relating to the Board's decision not to admit an affidavit into the proceedings but these alleged violations were withdrawn at the oral proceedings before the Enlarged Board (see sections VII and IX(b) and (g) above).
3. Accordingly, the petition is not clearly inadmissible.

### *Allowability*

4. The Enlarged Board will consider in turn each of the alleged procedural violations (a), (c) to (f) and (h) referred to in section IX above and then consider the general argument relating to all the alleged violations (c) to (h).

5.       (a) *No chance to comment on the auxiliary requests.*

5.1       The petitioner alleges it was given no chance to comment on the auxiliary requests before the Board of Appeal ruled on them. However, a party has no absolute right to be heard separately on each and every one of its auxiliary requests, either at all or in its chosen order of preference. No such right (or necessity) can be derived from the right to be heard under Article 113(1) EPC. The right provided by that Article is to comment on grounds for a decision and not to comment on individual requests or to repeat comments on grounds which apply to two or more requests. Thus, the requirement of that Article that the parties have an opportunity to comment on the grounds for a decision is, by definition, satisfied if those grounds have been the grounds for a decision on the main request (or another auxiliary request) and the remaining requests are not allowed on the same grounds.

5.2       In the present case the finding of non-compliance of the main request with Article 83 EPC was based on the conclusion that the person skilled in the art could not be sure of the correct calculation method for the content of the substantially rod-shaped particles (cf. point III, above), that content being crucial and requiring the preparation of a dispersion having the correct fraction of substantially rod-shaped particles. However, the necessary information to achieve this was found to be absent from the patent in suit and it was held that the skilled person was not in a position - without undue burden and without inventive effort - to make good this deficit (see Reasons of the decision under review, points 5.17, 5.18 and 6, first paragraph).



As this reasoning is not in any way related to a particular value of the content in question, it must be equally valid for all those claims according to the auxiliary requests, which "rely on the definition of the content of rod-shaped particles" (see Reasons of the decision under review, point 6, second paragraph). This means that the reasons given for not allowing the main request also constitute the grounds under Article 113(1) EPC in respect of the auxiliary requests (including those with a value of 2 for the lower weight percentage), the essential legal and factual reasoning (see decisions cited in "Case Law of the Boards of Appeal", 6th Edition, page 438) being identical.

- 5.3 As regards the discussion of the issue of sufficiency under Article 83 EPC, the petitioner argues essentially that its representative had the impression that the Board would decide in his favour on the main request and only provided part of his arguments supporting sufficiency of disclosure assuming that, even if he had misunderstood the Board, he would have a chance to make these arguments with respect to the auxiliary requests. However, such considerations of a party (or its representative) are immaterial to the fulfilment of requirements pursuant to Article 113(1) EPC. The Enlarged Board's jurisprudence makes clear that the right to be heard is satisfied if the party is aware of, and thus has had the possibility to comment on, arguments of the other party on which the decision is based (see R 2/08 of 11 September 2008, Reasons, point 8.2; and R 4/08 of 20 March 2009, Reasons, points 3.2 and 3.3). That is even more true where a party's representative, in view of the discussions before and with the Board, felt himself in a position to make a

reasoned guess at the Board's finding on a critical issue and adapted the manner of conducting his case accordingly.

- 5.4 The petitioner's contention that a discussion of the claims according to the auxiliary requests would have led to a different decision of the Board of Appeal is mere speculation, even if such a consequence of allowing further discussions of an issue in dispute can never be excluded. Of course, whether by opening a discussion of the auxiliary requests or in another way, the Board of Appeal could have granted the petitioner a further opportunity to defend its position as to the requirement of Article 83 EPC which possibly - although not likely in the given circumstances - might have eventually changed the view of the Board of Appeal. However, once the party - as here - has had an adequate opportunity to comment within the meaning of Article 113(1) EPC, the granting of further such opportunities is purely within the discretion of the Board of Appeal in conducting the proceedings and thus a matter which is not open to review by the Enlarged Board of Appeal.

6. *(c) The Board of Appeal failed to acknowledge the correct method of calculation.*

The allegation that in its written decision the Board failed to acknowledge the correct method of calculation of the weight percentage of rods is pre-eminently a matter which concerns the substantive issues in the case and is thus not amenable to review (see R 1/08 of 15 July 2008, point 2.1 of the Reasons and the *travaux préparatoires* cited there). Even if (which the Enlarged

Board is in no position to decide) the Board of Appeal did fail to acknowledge a correct method, that is not a matter which could lead to a finding of a fundamental violation of Article 113(1) EPC. The Enlarged Board is confined to considering whether or not the parties were heard and, as is again clear from the petition itself which says the parties agreed on the method of calculation, the parties were indeed heard on the matter of that method. If, having heard the parties, a Board of Appeal then makes a decision with which one of them disagrees, there can be no violation of Article 113(1) EPC.

7. *(d) The Board of Appeal wrongly inferred from the patent that the inventor had not anticipated that the skilled reader would use the incorrect calculation.*

This also relates quite clearly to substantive issues in the case and therefore cannot be the subject of review for the same reasons as in point 6 above. The Enlarged Board simply cannot decide whether or not the Board of Appeal's observation about the patent in point 5.6 of its decision (see section IX(d) above) is wrong. In reality, the petitioner's complaint in this respect is no more than that the Board of Appeal has made a statement with which it disagrees but mere disagreement with a decision by a losing party is not enough to establish a procedural violation.

8. *(e) The Board of Appeal based its written decision on the "poor quality" of images in the patent.*

- 8.1 This also relates quite clearly to substantive issues in the case and therefore cannot be the subject of

review for the same reasons as in point 6 above. Whether or not the Board of Appeal was wrong to consider the images in the patent to be of poor quality is again just an example of the petitioner disagreeing with the Board's decision.

- 8.2 The additional assertion that the issue was never discussed during the written or oral proceedings appears incorrect. The words in the decision of which the petitioner complains are:

*"the patent in suit itself provides no means by which the validity of such an insight could be tested. Raw data is provided only in the nature of images of extremely poor quality".*

The whole passage in the decision from which that is taken reads (see point 5.13):

"Even accepting, for the sake of argument, that such insight would be within the range of normal, non-inventive ability of the skilled person, there remains the obstacle that the patent in suit itself provides no means by which the validity of such an insight could be tested. Raw data is provided only in the nature of images of extremely poor quality. In this connection it is recalled that the images provided by the [respondent] during the opposition proceedings were considered by the [petitioner] to be of insufficient quality to allow analysis (counting of the particles) notwithstanding that these images appear to be significantly clearer and of higher quality than those contained in the patent in suit". [The words underlined

were omitted by the petitioner in its quotation from this passage of the decision.]

The "insight" referred to in the opening words is that mentioned in the previous passage of the decision (see point 5.12) where the Board discusses at some length submissions of the petitioner. It is thus beyond doubt that the words the petitioner now complains of, far from representing a new issue introduced for the first time in the written decision, were in fact part of a lengthy consideration and ultimate rejection of an argument of the petitioner itself. There can of course be no question of denying a party an opportunity to be heard in relation to an argument which that party has itself presented. It appears that, at best, the petitioner did not read the decision sufficiently carefully before framing this complaint.

- 8.3 While the question of quality of images was discussed during the appeal proceedings, as shown by both the passage from the decision quoted above and the petition itself (see page 6, paragraph 17), if the petitioner's complaint is that the quality of images was not discussed as part of a reason for the Board's view of the petitioner's argument, that cannot amount to a violation of Article 113(1) EPC. The Enlarged Board's jurisprudence clearly demonstrates the principle that parties are not entitled to advance indications of the reason or reasons for a decision before it is taken (see the summary of the case-law in R 12/09 of 15 January 2010, Reasons, point 11 and the several other decisions there referred to; and subsequent decisions R 15/09 of 5 July 2010, Reasons, point 4; R 18/09 of 27 September 2010, Reasons, points 14 to 15 and 18; and

R 15/10 of 25 November 2010, reasons, points 7 to 9). If that principle applies to the reasons for a decision generally, it must apply equally to a comment forming only a part of such reasons.

9. *(f) The Board of Appeal based its decision on a different view of the calculation from that agreed by both parties and which was wrong and not discussed.*

9.1 All the Enlarged Board's observations in relation to the alleged violation (c) also apply to alleged violation (f). Since this also concerns substantive issues it cannot be the subject of review for the same reasons as in point 6 above. To the extent the Board of Appeal may not have discussed its own view of the method of calculation as mentioned in the reasons for its decision, neither the petitioner nor the respondent was entitled to any advance indication of such reasons as explained in point 8.3 above.

9.2 Moreover, the petitioner's argument is factually fundamentally flawed. It relies (see section IX(f) above) on the text of point 5.16 of the decision under review which reads as follows:

"Indeed the Board is aware that the entire foregoing section relies on making a key assumption - namely that the skilled person would identify the nature of the calculation as being the source of the divergences [between the reported values of rod content and the values obtained by using the average values]. This has in fact been assumed by both parties. However, this assumption is in the Board's view not valid. For example, it takes no account of the possibility of

alternative sources of error such as clerical errors in the patent in suit, or even errors in collating or in analysing the data, e.g. instrumental errors." [The words underlined were omitted, and the words in brackets added by the petitioner in its quotations from this text of the decision.]

On the basis of its own selective quotations the petitioner accuses the Board of Appeal of denying it the right to be heard and of prejudice (see again section IX(f) above).

- 9.3 However, a reading of the whole passage in its context makes quite clear that neither was the case. The passage begins with the words "*the Board is aware that the entire foregoing section relies on making a key assumption*". The "foregoing section" begins at point 5.12 which, as mentioned above (see point 8.2), marks the beginning of the Board of Appeal's lengthy consideration of the petitioner's own argument as to the approach the skilled person would take to the method of calculation (which in turn follows a section beginning at point 5, some three pages earlier where, after having already found the disclosure of the patent itself insufficient (see point 4.8), the Board turns to consider whether the skilled person could by common general knowledge understand how to calculate the content of rod-shaped particles). In point 5.12 the Board summarizes the petitioner's argument, disregards another inconsistent argument (of the petitioner), and says that the argument would require a level of insight approaching inventive step. That is the "insight" then referred to in point 5.13 which leads the Board to the problem that the patent provides no means to test the

quality of such an insight (see the passage cited in full in point 8.2 above). Points 5.14 and 5.15 then continue the same examination of the petitioner's argument to the conclusion that it had failed to show that the skilled person could rely on common general knowledge (see point 5.15). The "entire foregoing section" is thus the Board's own reasoned treatment (in points 5.12 to 5.15) of the petitioner's own argument and the statement in point 5.16 as to that section relying on a key assumption is the Board's own qualification of its own assessment of the petitioner's argument. Then, after observing that both parties made the same assumption, the Board proceeds to explain (again, at some length - see points 5.16 to 5.18) why that assumption of both parties was not accepted.

- 9.4 The petitioner's reliance on highly selective fragments of the Board's decision shows at best an unreasonably subjective reading of the decision. When those fragments are read in context it becomes abundantly clear that, far from denying the petitioner the right to be heard by raising matters not previously discussed, the decision goes to great lengths to explain why the Board did not agree, first with the petitioner's argument and then with an argument apparently agreed by both parties, all being arguments which were indeed discussed. Further, far from showing prejudice, it appears that the Board was at pains to deal with all the submissions made to it and to explain its own reasons for disagreeing with one or both parties.



10. *(h) The Board's written decision was not reasoned with respect to the auxiliary requests.*

This alleged violation is quite simply factually incorrect. It appears from the decision under review (see point 6, last two paragraphs) that the Board's written decision did in fact include reasons for rejecting the auxiliary requests, namely that in the view of the Board the auxiliary requests were subject to the same objection as the main request.

11. Finally, as regards the petitioner's general argument relating to all the alleged violations (c) to (h), this is based on a wholly false premise, namely that Article 112a(2)(d) EPC requires that a Board of Appeal's written decision must be reasoned.

- 11.1 Article 112a(2)(d) EPC imposes no such requirement whatsoever; it merely specifies that petitions for review may be filed on the grounds that

*"any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings;"*.

The reference to "other fundamental procedural defect" reflects the fact that the opening words of Article 112a(2) are: "The petition may only be filed on the grounds that:" which make it completely clear that petitions for review are limited to the grounds appearing after those words in (a) to (e). Thus the grounds included by (d) are limited to those other procedural defects "defined in the Implementing Regulations". The only provision in the Implementing

Regulations which defines such grounds is Rule 104 EPC which reads:

*"A fundamental procedural defect under Article 112a, paragraph 2(d), may have occurred where the Board of Appeal,*

*(a) contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or*

*(b) decided on the appeal without deciding on a request relevant to that decision."*

Thus, it is completely and unambiguously clear from Rule 104 EPC that the Implementing Regulations only add two further grounds for petitions for review to those in Article 112a(2) EPC and that the list of possible grounds contained in Article 112a(2) and Rule 104 EPC is exhaustive. This has been made abundantly clear in the Enlarged Board's jurisprudence (see R 1/08 of 15 July 2008, Reasons, point 2.1, last paragraph; R 16/09 of 19 May 2010, Reasons, points 2.3.5 and 2.3.6; R 10/09 of 22 June 2010, Reasons, points 2.4 and 2.5; R 18/09 of 27 September 2010, Reasons, point 19; R 1/11 of 27 June 2011, Reasons, point 2.2; and R 20/10 of 25 August 2011, Reasons, point 2.1). The grounds enumerated in the legislation being exhaustive, there is no scope for creating an additional ground by analogy with Rule 111 EPC as the petitioner seeks to do (see section IX(h) above).

- 11.2 Accordingly there is no ground for a petition for review, whether under Article 112a(2) EPC or otherwise, such as the petitioner puts forward that a decision of a Board of Appeal is not reasoned. In any event, such a

provision would be unnecessary in view of the words of Article 113(1) EPC and the related grounds for a petition in Article 112a(2)(c) EPC.

- 11.3 Further, for the sake of completeness, the Enlarged Board observes that, as already indicated in respect of the particular passages complained of by the petitioner (see points 8.2 and 9.2 to 9.4 above), the decision under review in the present case appears to be comprehensively and clearly reasoned. The petitioner's general complaint - that the decision contains inconsistent findings which are not in logical sequence such that the reader is unable to decide which of the various findings are correct and which are false - is a complaint which could only be made by a reader determined to disagree with the decision. An objective reading of the decision merely shows that the complaint itself is false.
- 11.4 The decision T 278/00 (OJ 2003, 546) to which the petitioner referred related to Rule 68(2) EPC 1973 (now Rule 111(2) EPC) which requires that decisions which are open to appeal be reasoned. Decisions of Boards of Appeal, which are open only to review but not to appeal, are clearly not covered by that rule. Further, as made clear above (see point 11.1-2), it is no ground *per se* for a petition that a decision is not reasoned. As an interpretation of Rule 111(2) EPC, the principles summarized in paragraphs 1 and 2 of the headnote of decision T 278/00 (quoted below) are as follows:

*" 1. The reasoning of a decision under appeal must be taken as it stands. The requirements of [Rule 111(2) EPC] cannot be construed in such a way that in spite of*

*the presence of unintelligible and therefore deficient reasoning, it is up to the Board or the Appellant to speculate as to what might be the intended meaning of it.*

*2. The Board must be in a position to assess on the basis of the reasoning given in the decision under appeal whether the conclusion drawn by the first instance was justified or not. This requirement is not satisfied when the Board is unable to decide which of the various inconsistent findings indicated in and justifying the decision under appeal is correct and which is false."*

Even if those principles were applicable to decisions under review, they would only apply in the presence of unintelligible and therefore deficient reasoning and inconsistent findings such that it is not possible to decide which are correct and which are false. However, as already indicated (see point 11.3 above), the Enlarged Board considers that this is not so in the case of the decision under review.

12. Accordingly the Enlarged Board finds no merit in any of the arguments of the petitioner and the petition is therefore unallowable.

## **Order**

### **For these reasons it is decided that:**

The petition is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

R. Menapace