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**Datasheet for the decision
of the Enlarged Board of Appeal
of 7 December 2012**

Case Number: R 0009/11

Appeal Number: T 0642/08 - 3.3.09

Application Number: 99917109.3

Publication Number: 1084035

IPC: B32B 27/36

Language of the proceedings: EN

Title of invention:
Heat-shrinkable multilayer film

Patent Proprietor:
Kureha Corporation

Opponent:
Cryovac, Inc.

Headword:
Fundamental violation of Article 113 EPC/KUREHA CORPORATION

Relevant legal provisions:
EPC Art. 112a(2)(c), 113(1)
EPC R. 104, 106
RPBA Art. 13(1), 13(2)

Keyword:
"Non-admission of auxiliary requests in the exercise of discretion under Article 13(1) and (3) RPBA - violation of right to be heard (no)"

Decisions cited:
R 0017/11



Case Number: R 0009/11

DECISION
of the Enlarged Board of Appeal
of 7 December 2012

Petitioner: Kureha Corporation
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Tokyo 103-8552 (JP)

Representative: Klusmann, Peter
Hoffmann Eitle
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Other party: Cryovac, Inc.
(Opponent) 100 Rogers Bridge Road, Building A
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Representative: UEXKÜLL & STOLBERG
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Decision under review: Decision of the Technical Board of Appeal
3.3.09 of the European Patent Office on
15 March 2011.

Composition of the Board:

Chairman: W. van der Eijk
Members: G. Weiss
P. Ranguis
B. Günzel
I. Beckedorf

Summary of Facts and Submissions

I. The petition for review concerns decision T 642/08, in which Board of Appeal 3.3.09 (hereinafter "the Board") maintained European patent No. 1084035 in amended form.

II. The proceedings in case T 642/08 can be summarised as follows:

(a) An appeal was filed by the opponent against the interlocutory decision of the opposition division to maintain the patent in amended form. After the written phase of the appeal proceedings, the Board summoned the parties to oral proceedings scheduled for 15 March 2011.

(b) In an annex to the summons to oral proceedings issued on 1 December 2010 the Board indicated that the only issue to be discussed at those proceedings appeared to be inventive step. In this context, D4 appeared to be the closest prior art; the film which was alleged to be publicly available seemed to be less relevant. In its provisional non-binding opinion the Board indicated that the claimed subject-matter was not obvious from D4 in combination with either D5 or D10.

(c) On 15 February 2011 the opponent-appellant submitted additional arguments concerning lack of inventive step, and filed new document D24: US-A-3 551 540. It argued that the subject-matter of claim 1 lacked inventive step in view of the combination of D4 with D24.

(d) At the oral proceedings held on 15 March 2011, the proprietor-respondent requested the Board to decline to admit late-filed document D24. The Board however, after discussing this matter, considered that D24 was *prima facie* highly relevant for the issue of inventive step and consequently, exercising its discretion, admitted it into the proceedings. A discussion on the merits of the main request took place and the Board came to the conclusion that it was not allowable on the ground of lack of inventive step in view of D4 in combination with D24.

(e) The proprietor-respondent then withdrew the auxiliary request on file and submitted auxiliary requests A, B and C. A discussion on the admissibility of these new requests took place. See points X and XI below for the content of these discussions.

(f) After deliberation, the Board informed the parties that only auxiliary request C would be admitted into the proceedings. The proprietor-respondent then filed a written statement and requested that it be included in the minutes of the oral proceedings. This statement read as follows:

"Respondent is of the opinion that the fact that D24 is admitted so late (1 month prior to oral proceedings) in the proceedings followed by the subsequent denial of the admissibility of late filed claims is in violation of the right to be heard (R 113) [sic] and R 112 [sic]. The board also failed to ask why we believed that the Auxiliary Request A and B would overcome any of the objections. It is considered and submitted as a procedural violation of the right to be heard."

(g) The written decision T 642/08 concerning maintenance of the patent was notified to the parties by registered letter with advice of delivery on 27 April 2011.

- III. On 7 July 2011 the proprietor-respondent (hereinafter "the petitioner") filed a petition for review by the Enlarged Board of Appeal of this decision, under Article 112a EPC. The petition was based on the grounds referred to in Article 112a(2) (c) and (d) EPC.
- IV. Oral proceedings before the Enlarged Board of Appeal in its composition pursuant to Rule 109(2) (a) EPC took place on 18 January 2012. At the end of the oral proceedings the Enlarged Board decided to continue the proceedings in a five-member composition under Rule 109(2) (b) EPC (see minutes of the oral proceedings) with the involvement of the other party, i.e. the appellant-opponent (hereinafter "the respondent").
- V. In a communication dated 25 January 2012 the Enlarged Board informed the parties of its five-member composition, and set them a two-month time limit for filing any submissions.

On 2 April 2012, the petitioner filed witness statements by Mr I. Kitada, Mr T. Ueyama, Mr T. Uehara, Mr Y. Endo and Mr R.-J. de Lang, one of the professional representatives who had attended the oral proceedings before the Technical Board.

On 4 April 2012, the respondent filed declarations from Mr B. Childress, Mr R. B. Hurley, Ms C. Fraire,

Ms S. Di Fiore and Dr B. Janssen, and requested oral proceedings if the Enlarged Board did not intend to reject the petition for review on the basis of the written submissions. On 22 August 2012 the petitioner filed further submissions.

VI. In a communication in preparation for the oral proceedings, sent to the parties on 19 October 2012, the Enlarged Board identified certain issues of admissibility and allowability and gave its provisional and non-binding opinion.

VII. Oral proceedings before the Enlarged Board in its five-member composition were held on 7 December 2012.

The petitioner requested the Enlarged Board to set aside the decision challenged in its petition, to re-open the proceedings before the Board and to direct that the members who took the decision thus set aside be replaced.

The respondent requested the Enlarged Board to reject the petition as unallowable.

VIII. The petitioner's arguments on the allowability of the petition, as presented in its written submissions and at the oral proceedings, may be summarised as follows:

After the Board had decided to admit document D24 into the proceedings, the petitioner had not been given the opportunity to address the arguments raised by the respondent and the Board against admitting newly filed auxiliary requests A and B. The Board, before closing the debate on the admissibility of the new requests,

had failed to allow the petitioner to address at least once the arguments put forward by the Board and the respondent which had not been raised during the written proceedings. These new auxiliary requests had been meant and submitted as a proper reaction to the new situation on the file. Also, the discussion had not addressed the issue of inventive step. From the chronology of this discussion it followed that the petitioner had only explained the amendments in the requests and where the basis for the amendments was to be found. The Board had indicated that it would be rather unwilling to accept product-by-process claims and that these did not overcome the objections raised against the main request. The respondent had argued on the merits of these requests. No further discussion had taken place. After the Board's decision not to admit auxiliary requests A and B, the petitioner had immediately filed an objection. The Board had failed to ask it why it thought that the auxiliary requests overcame the objections. Thus, a severe violation of Article 113 EPC had occurred.

This violation of Article 113 EPC justifying the petition was also linked to the fact that the Board had not invited the petitioner to comment on the auxiliary requests as regards the *prima facie* issue of inventive step. Mr de Lang's statement that the amendment involved a significant technical effect could not be understood as a discussion of Article 56 EPC; Mr de Lang had confirmed that no inventive step discussion had taken place.

The decision under review contained a contradiction and point 5.2 of the Reasons did not reflect the facts. It

was not true that the respondent spoke first, that the Board commented afterwards and that the petitioner spoke last. From point 6.2 of the Reasons it was clear that the petitioner spoke first, then the Board, which contradicted the sequence of events set out in point 5.2 of the Reasons. Further, it was not true that both parties were given the opportunity to argue on the question of admissibility.

Furthermore, the filing of the auxiliary requests at this stage of the oral proceedings should be considered as a response to the admission of D24 into the proceedings. Thus the requests should have been admitted and could not be regarded as late filed; they had been submitted at the earliest possible opportunity. Moreover, in exercising its discretion under Article 13(1) and (3) RPBA the Board had violated the principle of fairness in EPO proceedings and failed to weigh up all the circumstances of the case, in particular by accepting the very late filing of D24 by the respondent but dismissing the petitioner's attempts to respond to the new issues by filing auxiliary requests. Every advantage had been given to the respondent. Such an approach was contrary to the principle of fair proceedings and had deprived the petitioner of its rights under Article 113 EPC.

Article 13(2) RPBA had to be read as entitling the petitioner to file amendments. Thus, the auxiliary requests had not been filed late but in due time within the meaning of Article 114(2) EPC.

IX. The respondent's arguments on the allowability of the petition, as presented in its written submissions and at the oral proceedings, may be summarised as follows:

First, the petitioner's position was based on an incorrect recollection of events. The petitioner had filed new auxiliary requests A to C and, immediately and before asking the petitioner for comments, the Board chairman had noted the new issue concerning the product-by-process claims (claim 16 for auxiliary request A; claim 1 for auxiliary request B). An exchange between the chairman and the petitioner had taken place. The chairman had added that these claims differed in one aspect from the main request and asked whether this difference was or could be sufficient to overcome the issue on inventive step. Then the petitioner had been invited explicitly to comment. The petitioner had argued only on claim 1 of the auxiliary request A and had not mentioned claim 16 in relation to the inventive step issue. This was not surprising considering the preceding discussion on the inventive step of the main request. However, it was very surprising that the petitioner had chosen to amend the requests by product-by-process claims - as the chairman had pointed out before inviting the parties to speak.

The five declarations filed by the petitioner were all identical, whereas the respondent's declarations were individual statements. Mr Childress's declaration was based on notes taken during the oral proceedings.

Concerning the standard for admitting late-filed requests into the proceedings, the respondent cited two decisions of the Boards of Appeal: in T 1273/04 the

deciding Board had admitted an amended claim filed in oral proceedings which was clearly allowable by virtue of a clearly permissible amendment; in T 1311/05 it had declined to admit a new request filed in oral proceedings, since the new wording of the claim did not clearly overcome the issue under Article 56 EPC discussed with regard to the main request.

Lastly, concerning the *prima facie* discussion on the issue of inventive step in respect of the auxiliary requests, Mr de Lang's statement clearly indicated that this issue had been discussed.

Reasons for the Decision

1. *Admissibility of the petition for review*

- 1.1 The petitioner is adversely affected by decision T 642/08 maintaining European patent No. 1084035 in amended form.

The petition for review was filed on the grounds referred to in Article 112a(2)(c) and (d) EPC.

The petition therefore complies with the provisions of Article 112a(1) and (2) EPC.

- 1.2 The written decision was notified to the parties by registered letter with advice of delivery posted on 27 April 2011.

The two-month period for filing the petition for review expired on 7 July 2011. As the petition was filed and

the fee was paid on 7 July 2011, it also complies with Article 112a(4) EPC.

- 1.3 The petition is based on the allegation that, during the debate at the oral proceedings of 15 March 2011 about the admissibility of newly filed auxiliary requests A and B, the Board failed to allow the petitioner to address arguments put forward by the respondent and the Board itself before closing the debate.

Upon the resumption of the oral proceedings, and after the announcement that auxiliary requests A and B would not be admitted into the proceedings, the petitioner raised an objection under Rule 106 EPC. A hand-written version of that objection was attached to the minutes of the oral proceedings.

On that basis, Rule 106 EPC can be regarded as complied with.

- 1.4 The petition for review is therefore admissible.

2. *The grounds of the petition - scope of the petition*

- 2.1 The petition alleges fundamental procedural defects on two grounds, namely Article 112a(2)(c) and (d) EPC.

- 2.2 The petitioner complains that, at the oral proceedings on 15 March 2011, its right to be heard was denied in three ways:

(a) firstly, the Board decided on the admissibility of newly filed auxiliary requests A and B without giving

the petitioner an opportunity to comment on objections raised by the Board and the respondent (see points 5.I to 5.V of the petition);

(b) secondly, the Board decided to admit document D24 and rejected claims filed in response to that late document, thereby effectively depriving the petitioner of a reasonable opportunity to respond adequately to the introduction of the new document (see point 5.VI of the petition);

(c) thirdly, the Board violated the right to fair proceedings by first allowing D24 to be filed late filing and then refusing new claims filed by the petitioner, thereby demonstrating bias which was contrary to the principle of fair proceedings (see point 5.VII of the petition).

2.3 As regards complaint (c), an alleged violation of the principle of procedural fairness is not as such a ground for a petition for review.

Consequently, complaint (c) can only be seen in terms of a violation of Article 113 EPC and hence Article 112a(2)(c) EPC. The petitioner agreed with this at the oral proceedings on 7 December 2012.

Thus, the only remaining ground for the petition is that, at the oral proceedings before the Board on 15 March 2011, a fundamental violation of Article 113 EPC occurred.

3. *Allowability of the petition for review*

3.1 *Complaint (a): At the oral proceedings on 15 March 2011, the Board decided on the admissibility of newly filed auxiliary requests A and B without giving the petitioner an opportunity to comment on the objections raised by the Board and the respondent*

3.1.1 The petition invokes the ground of Article 112a(2)(c) EPC. In the petitioner's submissions and according to its handwritten statement, the Board decided on the appeal in violation of Article 113 EPC in a manner that gave the petitioner no opportunity to present its comments.

3.1.2 The facts of the case show that, after admitting document D24 into the proceedings, the Board discussed extensively with the parties the subject-matter of claim 1 of the *main request* on its merits with regard to inventive step in view of D4 in combination with D24 (see points 4.1 to 4.4 of the reasons for the decision). The Board concluded that the *main request* was not allowable.

After the Board's conclusion on the non-patentability of claim 1 of the main request, the petitioner filed new auxiliary requests A, B and C and withdrew the previous auxiliary request.

Claim 1 of auxiliary request A corresponds to claim 1 of the main request, to which the feature of dependent claim 14 has been added. Claim 15 (process claim) is identical to claim 15 of the main request; claim 16

(product-by-process claim) of auxiliary request A corresponds to claim 1 of the main request, to which the following wording has been added: "*... wherein the multilayer film is obtainable by a method as defined in claim 15*".

Claim 1 of auxiliary request B corresponds to claim 16 of auxiliary request A, i.e. claim 1 of the main request, to which the following wording has been added: "*... wherein the multilayer film is obtainable by a method as defined in claim 15*". Claims 2 to 15 correspond to claims 2 to 15 of the main request.

3.1.3 The issue of the admissibility of the newly filed auxiliary requests was then examined.

It is not contested by the petitioner that first of all the Board chairman invited the petitioner to explain the differences in, and the support for, the auxiliary requests. In the petition (page 4, second paragraph) it is further indicated that the "*[p]atentee also briefly referred to the experimental section and [0060] of the patent to emphasise that the subject matter of claim 1 of this request is associated with beneficial properties, namely that the material suffers from little if any shrinking after printing.*"

Then, after the explanations of the petitioner, the respondent and the Board gave their comments as to why the new auxiliary requests did not overcome the objections raised with respect to the *main request*.

The statement of Mr de Lang, who was the authorised patent attorney for the petitioner, indicates that "*the*

Opponent ... inter alia criticised the new requests for lack of inventive step." This is also confirmed by the petition, which states that the respondent "*... not only addressed the differences and support issues, but he also argued on the merits of these requests*" (see page 4, fourth paragraph).

At this stage the Board also emphasised the feature formulated as a product-by-process and newly added to claim 16 of auxiliary request A and claim 1 of auxiliary request B. The petition stresses that the Board indicated that it "*... would be rather unwilling to accept product-by-process claims, as one could not verify whether or not these claims truly make a contribution to inventive step*" (see page 4, fifth paragraph).

- 3.1.4 The Enlarged Board concludes from the petitioner's own submissions and statements that before the closure of the debate a discussion was held on the admissibility of the new auxiliary requests and various objections were raised (see above) by the Board chairman and also by the respondent. The petitioner, however, did not comment on these objections.

It would seem that from these two objections alone, made by the respondent and the Board before the closure of the debate, it was apparent that the two new auxiliary requests A and B could not be admitted into the proceedings, which would also explain - as indicated in point 5.2 of the reasons for the decision - why no argument was put forward by the petitioner to counter them. Along the same lines, reference is made to the explanations of the respondent in reply to the

petition, page 11 of its submissions ("*...it was not prima facie apparent how the introduction of the process feature into the product claim could overcome the inventive step raised against the main request, the proprietor's representative chose not to respond to that question, and tried to shift the discussion to a consideration of Claim 1 of Auxiliary Request A and an advantage regarding printability as demonstrated by the examples of the patent in suit*").

3.1.5 In any event, there is no doubt that the petitioner had the opportunity to state its case in respect of the admissibility of the auxiliary requests and, in particular, to address the merits of process claim 15 and product-by-process claim 16 of auxiliary request A as well as product-by-process claim 1 of auxiliary request B. Nor has it been alleged that it was prevented from doing so.

3.1.6 It is part of the responsibility of any party (here: the petitioner) to state its case and to choose which line of argumentation and which particular arguments it wishes to put to the Board. This procedural responsibility cannot be placed on the Board; a party cannot just wait to be explicitly asked whether it wishes to expand on its previous submissions.

Hence, at the latest when the chairman is closing the debate on a specific issue, a party must not just passively follow the other party's submissions and the Board's remarks but must actively take the initiative to ensure that the Board continues the debate on the admissibility of a request, or it must amend the request in response to the Board's remarks. Since the

closure of the debate normally marks the point in the proceedings when the Board intends to start its deliberation on a specific issue, and thereafter potentially take a decision on it, a party wishing to present further submissions on that issue must intervene at that moment, without waiting to be asked.

Because the petitioner did not do so in this case, the chairman was justified in closing the debate on the admissibility of the new auxiliary requests. The petitioner could not expect the Board, which has to stay neutral in *inter partes* proceedings, to prompt the petitioner to make further submissions or ask for further explanations.

No violation of Article 113(1) EPC was therefore committed by the Board in this connection.

- 3.1.7 Moreover, if there are doubts or expectations as to what is going to be deliberated, it is up to the party to verify this before the oral proceedings are interrupted for deliberation.

Any party is expected actively to participate in the oral proceedings and safeguard its interests. In this respect the Enlarged Board refers to its decision R 17/11 of 19 March 2012, point 19 of the Reasons, in which it stressed that in appeal proceedings it is incumbent upon a party to make sure that the points it wishes to raise are actually raised in the proceedings. If it considers that an issue is going to be overlooked, it should raise it.

In that sense, the petitioner had the opportunity to raise the points it considered necessary before the Board interrupted the proceedings for deliberation. The Board was therefore not at fault in deciding to deliberate on the admissibility of the auxiliary requests and in pronouncing its conclusion after deliberation.

The petitioner's right to be heard has thus not been violated (Article 113(1) EPC).

3.2 *Complaints (b) and (c): the admission of D24, the non-admission of auxiliary requests A and B, and the application of the principle of fair proceedings*

3.2.1 The admissibility of requests filed at a late stage in the appeal proceedings is subject to Article 13(1) RPBA, which provides that any amendment to a party's case after it has filed its grounds of appeal or reply - and a new set of claims with a new feature is clearly such an amendment - is admissible not as of right but at the Board's discretion. That discretion is to be exercised in view *inter alia* of three criteria, namely the complexity of the new subject-matter, the current state of the proceedings, and the need for procedural economy. The concept of "complexity" in Article 13(1) RPBA is not merely confined to the technical content of a proposed amendment to a party's case. It also extends to any procedural complexity the amendment would entail.

This provision also applies when a new document has been admitted into the proceedings, even if this occurs during oral proceedings. This discretionary power is exercised under the conditions set out above. It is for

the Board to exercise this power, taking account of the particular circumstances of each case.

Since both the decision to admit or not to admit a late-filed document and the decision to admit or not to admit a late-filed request are primarily discretionary decisions of the competent Board, they can only be reviewed to the extent that the way in which a Board exercised its discretion constituted a fundamental violation of Article 113 EPC. Whether the decision was right or wrong and whether the members of the Enlarged Board would have reached the same decision is - as with all discretionary decisions - not the relevant criterion.

- 3.2.2 In this respect, the petitioner argues that the Board did not take into consideration the fact that document D24 was late filed when deciding not to admit auxiliary requests A and B. The petitioner is of the opinion that the auxiliary requests were not late filed within the meaning of Article 114(2) EPC.

The petitioner further maintains that Article 13(2) RPBA, providing that other parties are entitled to submit their observations on any amendment not held inadmissible by the Board *ex officio*, was to be read as giving the petitioner a right to file new requests in reaction to the late-filed but admitted document D24.

However, apart from the fact that not only the document's admissibility had been discussed with the parties but also its disclosure in view of the patent in suit had been extensively disputed by both parties, the petitioner's right according to Article 13(2) RPBA

does not inevitably extend to having all auxiliary requests - without any further examination of their *prima facie* allowability - automatically admitted into the proceedings.

3.2.3 Hence, the petitioner can succeed only if it can be demonstrated that the Board declined to admit auxiliary requests A and B into the proceedings arbitrarily or on grounds that were not relevant to the exercise of its discretion, thereby unlawfully depriving the petitioner of its right to have these requests admitted and discussed in full. However, the Enlarged Board sees no evidence of that on file. The arguments used for admitting D24 and not admitting requests A and B, as mentioned in points 3, 3.1 and 5.1 to 5.3 of the reasons, are within the scope of Article 13(1) and (3) RPBA. Furthermore they were mentioned during the oral proceedings and the petitioner was not denied the opportunity to comment on them, as the Enlarged Board has shown under point 3.1 above.

In consequence, the Enlarged Board is not convinced that there was a "biased distribution contrary to the principle of fair proceedings" or that the petitioner's right to be heard has been fundamentally violated.

4. For the above reasons, the petition is unallowable.

Order

For these reasons it is decided that:

The petition for review is rejected as unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk