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**Datasheet for the decision
of the Enlarged Board of Appeal
of 20 April 2012**

Case Number: R 0013/11
Case Number: T 0023/10 - 3.3.02
Application Number: 02007397.9
Publication Number: 1232745
IPC: A61K 9/00
Language of the proceedings: EN

Title of invention:
Powder for use in dry powder inhalers

Patentee:
Vectura Limited

Opponent 02:
Norton Healthcare Limited

Headword:
Petition for review/VECTURA

Relevant legal provisions:
EPC Art. 112a(2)(c), 113, 116(1)
EPC R. 104
RPBA Art. 12(4), 17(2)

Keyword:
"Non-admission of auxiliary requests in the exercise of discretion under Article 12(4) RPBA is a violation of the right to be heard (no)"

Decisions cited:
R 0001/08, R 0002/08, R 0010/09, R 0012/09, R 0016/09,
R 0009/10, R 0015/10, R 0011/11



Case Number: R 0013/11

D E C I S I O N
of the Enlarged Board of Appeal
of 20 April 2012

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Decision under review: Decision of the Technical Board of Appeal
3.3.02 of the European Patent Office of
18 January 2011.

Composition of the Board:

Chairman: B. Günzel
Members: C. Rennie-Smith
S. Wibergh
R. Menapace
M. J. Vogel

Summary of Facts and Submissions

- I. The petition for review concerns decision T 23/10 of the Technical Board of Appeal 3.3.02 of 18 January 2011 to dismiss the petitioner's appeal against the decision of the Opposition Division to revoke European patent No. 1232745. The petitioner and patent proprietor filed the petition by fax on 15 July 2011 and paid the petition fee on the same date. The petition is based on the ground in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113 EPC occurred in the appeal proceedings.
- II. The patent in suit is a divisional patent and concerns carrier particles for use in dry powder inhalers. Claim 1 of the patent as granted claimed a powder for use in such an inhaler including active particles, carrier particles for carrying the active particles and particles of additive material attached to the surface of the carrier particles to promote release of the active particles. Dependant claim 11 as granted contained, through its dependency on claims 7 and 8 and thus indirectly on claim 1, the combination of materials in claim 1 with the added feature that the additive material comprises magnesium stearate in an amount that forms less than 1.5% by weight.
- III. The patent was opposed by two opponents, of which the first withdrew its opposition by a letter of 6 August 2010, shortly after commencement of the appeal proceedings (thus references herein to the "opponent" or "respondent" in the singular are to the second opponent). The petitioner's main request in the opposition proceedings was to maintain the patent as

granted. At oral proceedings on 27 October 2009 the Opposition Division decided that claim 11 of the patent as granted did not meet the requirements of Articles 123(2) and 76(1) EPC. Since a claim such as claim 11 as granted was also present in all the petitioner's auxiliary requests 1 to 7, those requests also failed. After an adjournment the petitioner did not file any further requests and the Opposition Division decided to revoke the patent.

- IV. The petitioner filed an appeal in which it maintained the same main request and auxiliary requests 1 to 7 as before the Opposition Division and also filed auxiliary requests 8 to 15 in which claim 11 was omitted. The Board of Appeal issued a communication dated 16 September 2010 in which it expressed the provisional opinion that claim 1 of the main request did not satisfy Articles 123(2) and 76(1) EPC, that it agreed with the decision under appeal as regards claim 11, and that it intended to remit the case to the first instance "in case that one of the requests on file meets the requirements of Articles 76 and 123(2) EPC". In a letter of 16 December 2010 replying to the communication, the petitioner withdrew its main request and auxiliary requests 1 to 7. At the oral proceedings before the Board on 18 January 2011 the remaining auxiliary requests 8 to 15 were held inadmissible in the exercise of the Board's discretion under Article 12(4) RPBA. The appellant did not file any further requests and objected that by not admitting its auxiliary requests 8 to 15 into the proceedings the Board had denied it the right to be heard and thus a fundamental violation of Article 113 EPC had occurred.

V. By an Order of 20 September 2011, the Enlarged Board in its composition under Rule 109(2)(a) EPC submitted the petition for review to the Enlarged Board in its composition under Rule 109(2)(b) EPC. By a communication of 12 December 2011 it informed the respondent that any written submissions should be filed within one month, and by a summons of 15 December 2011 the parties were summoned to oral proceedings on 20 April 2012. The respondent filed written submissions by an online letter dated and transmitted on 20 January 2012.

VI. On 1 February 2012 the Enlarged Board sent the parties a communication containing its provisional opinion that the petition was admissible and that, as regards allowability, it appeared that the petitioner had been given an opportunity to present comments on the admissibility of its auxiliary requests 8 to 15 but that there might be an argument that this opportunity was not adequate, this appearing to be the only point arising from the petition which could be the subject of the review.

VII. Oral proceedings before the Enlarged Board of Appeal took place on 20 April 2012 at the end of which the decision was announced.

VIII. The petitioner's arguments in the petition and at the oral proceedings before the Enlarged Board can be summarised as follows:

1. The principle of protection of legitimate expectations implies that measures taken by the EPO should not violate the reasonable expectations of

parties. The complete refusal of the Board of Appeal to admit sets of claims filed with the statement of grounds of appeal was unexpected, violated that principle and deprived the petitioner of its right to be heard under Article 113 EPC. The Board's application of its discretion under Article 12(4) RPBA was incorrect, and its refusal to admit auxiliary requests 8 to 15 into the proceedings resulted in an unreliable and unjust decision.

2. The first indication of an objection to claim 11 as granted arose, surprisingly for the petitioner, during the oral proceedings before the Opposition Division on 27 October 2009. The Opposition Division's preliminary opinion had stated that the requirements of Article 123(2) EPC were met, and the respondent had not objected to claim 11 in its notice of opposition. However, the Opposition Division decided that the subject matter of claim 11 did not meet the requirements of Articles 76(1) and 123(2) EPC. The petitioner filed no further requests in order to consider its position: no reasons were provided at the oral proceedings, at that time claim 11 was commercially important, and there was insufficient time available to determine whether it would be in its interest to delete claim 11. There is no reason why the petitioner should have deleted claim 11 simply to satisfy the respondent. In its written decision the Opposition Division referred to the combination of materials and the reference to claims 7 and 8 being an issue (see page 6 of the decision). This was not mentioned during the oral proceedings or at any time before by the Opposition Division or the opponents. Thus the petitioner had every right to consider the

written reasons before deciding how to proceed. There is no difference between the present case and that of decision T 269/02 of 20 July 2005 where it was stated that the petitioner must be given the opportunity to study the written substantiated decision of the Opposition Division in order to enable it to decide on the formulation of appropriate requests. The Board of Appeal did not follow this principle because it did not interpret decision T 269/02 correctly.

3. The grounds of appeal filed on 25 March 2010 included the main request and auxiliary requests 1 to 7 considered by the Opposition Division and also new auxiliary requests 8 to 15 in which claim 11 had been deleted. There is no absolute bar to filing new requests with an appeal (see "Case Law of the Boards of Appeal", 6th edition, 2010, page 890, second complete sentence). Even Article 12(4) RPBA does not go so far as to state that. As the Board acknowledges in its written decision, the petitioner provided detailed arguments why the decision of the Opposition Division was wrong and also filed amended claims in order to overcome the objection as a fall-back position. The cases referred to in the Board's decision (T 240/04 of 13 December 2007 and T 1705/07 of 28 October 2009) are not the same as the present case.

4. The preliminary opinion of the Board sent with the summons dated 16 September 2010 did not provide any hint of a problem with the admissibility of auxiliary requests 8 to 15. On the contrary, it clearly discussed the merits of all requests on file. Substantive discussions of the patentability of a claim can only take place in respect of an auxiliary request that has

been admitted into the proceedings. Thus, not only was there a legitimate expectation that auxiliary requests 8 to 15 had been admitted into the proceedings but also a deviation by the Board from the decision of the Opposition Division, in that it objected to claim 1. As a result, the petitioner withdrew the main request and auxiliary requests 1 to 7 in order to simplify the discussion of the new issue of claim 1; this was done in good faith and on the understanding that auxiliary requests 8 to 15 had been admitted into the proceedings. In view of the deviation of the Board from its preliminary opinion during the oral proceedings, the petitioner was not provided with an opportunity to prepare a full response to the objections of inadmissibility. Similarly, it is surprising that the Board did not note in its preliminary opinion the suggestion in its decision that the petitioner was abusing proceedings and could expect requests filed with the grounds of appeal not to be admitted.

5. While the petitioner understands that a preliminary opinion is not necessarily binding, it is unfair if it does not raise issues which are later to be considered as crucial. Moreover, by considering the substantive issue of added subject matter, the preliminary opinion effectively misled the petitioner into considering that this would form the basis of the oral proceedings. Since a preliminary opinion was provided it would not be sensible to ignore the comments in it. Under the RPBA, the Board may send a communication drawing attention to matters which seem to be of special significance or containing other observations that may help concentration on essentials during the Oral Proceedings (emphasis added by petitioner). Experienced

users are well aware that the Boards of Appeal expect parties to have paid attention to any matters raised in such opinions and to take necessary action.

6. The Board's written decision suggests that it was the respondent who raised the admissibility of auxiliary requests 8 to 15 into the proceedings. It says of the respondent's arguments (see point 2.1): "Although these arguments were intertwined with the respondent's request relating to remittal, they pertained, upon an objective reading, to the admission into proceedings of auxiliary requests 8 to 15" (Emphasis added by petitioner).

However, the respondent did not raise the issue. It was the legal member of the Board who read out and suggested requests to the respondent to which the respondent agreed. The Board of Appeal should have remained neutral.

7. The Board commented (see point 2.9 of its decision) that the new claim requests were not substantiated. However, given that the relevant amendment was the deletion of claim 11, this did not affect the response to the objections of the Opposition Division and the opponents already provided in writing before the Opposition Division which substantiated the new requests. If the Board considered the requests inadmissible for this reason, it is again inexplicable that it discussed substantive points of these requests in its preliminary opinion. It seems that this comment was included as additional justification of its decision not to admit the auxiliary requests.

8. With reference to the Enlarged Board's communication, it was indeed a case of an inadequate opportunity to be heard on the admissibility of the auxiliary requests 8 to 15. This case is factually different from decision R 11/11 of 14 November 2011 in which the admissibility of auxiliary requests was ventilated throughout the proceedings whereas here the issue was first raised at the oral proceedings, contrary to the expectation created by the preliminary opinion and to the petitioner's surprise.

9. In reply to questions from the Enlarged Board at the oral proceedings on 20 April 2012, the petitioner acknowledged that, when the Board of Appeal announced it would not admit auxiliary requests 8 to 15 into the proceedings, it did not try to re-introduce the main request and auxiliary requests 1 to 7 it had withdrawn and did not ask for an adjournment. The petitioner's representative observed that, from experience of one hundred oral proceedings, he thought it useless to re-introduce withdrawn requests but agreed that the Board's preliminary opinion had not in fact commented on auxiliary requests 1 to 7. He also acknowledged that he knew the admissibility of auxiliary requests was an issue which could arise at oral proceedings but he was surprised at the emphasis put on it in this case. Had he known in advance, he could have invested more time on that issue but, when asked how the adequacy of the opportunity would have differed according to how the issue was dealt with, he replied that he could not add anything.

IX. The respondent's arguments in its written submissions and at the oral proceedings before the Enlarged Board can be summarised as follows:

1. A petition for review is not a further instance of appeal. Rather, it provides the right for a judicial review founded on a limited number of grounds that have been exhaustively defined by the legislator (R 1/08 of 15 July 2008, point 2.1 of the Reasons; R 9/10 of 10 September 2010, point 10 of the Reasons). The situation objected to by the petitioner was considered in decision R 11/11 which clarified that in determining a petition based on alleged improper application of Article 12(4) RPBA the only relevant question is whether or not the Board of Appeal allowed the petitioner to make submissions on the admissibility of the requests (point 6 of the Reasons). The petitioner was given the opportunity to make submissions on admissibility as can be seen from the Board's decision (see section XIII and point 3.3) and the minutes of the oral proceedings (page 3, third paragraph) and it does not dispute this. Consequently, there was no violation of the petitioner's right to be heard and therefore the petition for review is unallowable.

2. As regards the adequacy of an opportunity to comment, some guidance is offered by the two cases in which petitions have succeeded. In decision R 7/09 of 22 July 2009 there was no opportunity at all, a fundamentally different situation to the present case. In decision R 3/10 of 23 September 2011 there was no opportunity at all to comment on inventive step at oral proceedings, again a fundamentally different situation. In the present case, the petitioner had a first

opportunity when filing its statement of grounds of appeal. It knew requests are admissible only in the Board's discretion. It must have known of Article 12(4) RPBA. Only the petitioner can explain why it did not address these matters in the grounds of appeal. It is not a complex point. All that was needed was to say why these auxiliary requests were not presented to the Opposition Division. Then the petitioner had an opportunity to address the issue of admissibility of the requests at the oral proceedings and said what it wanted to say. It did not ask for an adjournment, it was offered time for further consideration but chose not to file further requests. In those circumstances more time would not have made any difference.

3. In any case, the Board of Appeal did exercise its discretion correctly. The requests which the petitioner could have but declined to file before the Opposition Division merely involved the deletion of a single dependent claim as the petitioner admits (see the petition, page 7, lines 16-17). There is no plausible reason why the petitioner did not submit these requests other than because it intended to prolong and obstruct the proceedings. This is exactly the type of behaviour that the RPBA are intended to prevent.

4. The Board of Appeal made its decision in accordance with principles in the case law. The petitioner has contested the relevance of certain decisions referred to by the Board of Appeal. The Board of Appeal referred to decisions T 240/04 and T 1705/07 only as showing the general principle of a discretion not to admit requests which could have been presented before the Opposition Division. Decision T 269/02 was a decision made under

earlier rules of procedure not including any provision equivalent to present Article 12(4) RPBA but its principles are consistent with those applied in the present decision. In decision T 269/02 the required amendment was sufficiently complex that the patentee could not have been expected to make it before reading the decision. In the present case the amendment was trivial and could have been made at oral proceedings before the Opposition Division. Thus the difference is in the findings of fact, the principles applied are in substance consistent.

5. It is not plausible that the petitioner was so taken by surprise that it was unable to delete the dependent claim. The objection to claim 11 was first raised by opponent 1 in its notice of opposition in December 2007 (see page 9). The oral proceedings before the Opposition Division were held in October 2009 so the petitioner had nearly two years to consider possible amendment in the event of an adverse finding. The Opposition Division's preliminary opinion did say the patent met the requirements of Article 123(2) EPC but, following that opinion, opponent 1 presented further arguments why claim 11 included added subject-matter (see pages 17 and 18 of its submissions of 27 August 2009). That it was not the respondent who raised the objection is irrelevant.

6. The petitioner's argument that it needed time to consider how to react is also implausible - even assuming in its favour that it was surprised, it could easily have reacted by an amendment which the petitioner accepts would have been simple to make. It was also simple to determine that this amendment would

overcome the objection. The petitioner's argument that time was needed to decide if the amendment was commercially acceptable is irrelevant. The purpose of opposition proceedings is to determine whether requests meet the requirements of the EPC not whether they meet a party's commercial needs. These commercial complications have not been explained but the petitioner had no problem filing the requests during appeal proceedings.

7. A party has no right to receive a preliminary opinion (see R 1/10 of 22 February 2011 and G 6/95, OJ EPO 1996, 649). A communication is only a possibility: "the Board may send a communication" (Article 15(1) RPBA). Thus the petitioner can have no complaint that a communication was not exhaustive. In any case, the respondent had complained in detail in its reply and therefore the petitioner must have been prepared to justify its conduct. It is not relevant that the respondent did not specifically request that the auxiliary requests should not be admitted. The Board of Appeal is given a discretion by Article 12(4) of the RPBA not to admit requests and does not need to be asked to do this by another party.

8. The petitioner's comments that the Board of Appeal acted unfairly are, to the extent that they suggest that the Enlarged Board of Appeal should consider matters beyond the specific grounds of Article 112a EPC, irrelevant. In any case, it is the petitioner's own behaviour that resulted in the revocation of the patent before substantive issues were considered. The petitioner deliberately chose not to file a set of claims which would allow the Opposition Division to

consider the opposition properly. The petitioner then filed an appropriate set of claims on appeal, and asked the Board of Appeal to remit the case to the Opposition Division. There is no plausible reason why the petitioner would do this other than to prolong the proceedings. This is an abuse. If the petitioner had been allowed to behave in this manner, the result would have been that following opposition proceedings lasting from late 2007 to early 2011 no progress whatsoever would have been made on the substantive issues. This abuse is exactly what the relevant parts of the RPBA are intended to prevent, and the Board of Appeal was correct not to admit the auxiliary requests into the proceedings.

- X. The petitioner requested the Enlarged Board of Appeal to set aside the decision under review and to re-open the appeal proceedings before the Board of Appeal, to order that the members of the Board of Appeal who participated in the decision under review be replaced, and to order reimbursement of the petition fee.

The respondent requested that the petition be rejected as unallowable.

Reasons for the Decision

1. As indicated in the Enlarged Board's provisional opinion of 1 February 2012, the petition is admissible. However the Enlarged Board considers the petition not to be allowable for the following reasons.

2. Although the petition makes several references to the principle of legitimate expectations, and indeed takes that principle as its starting point (see section VIII, sub-section 1 above), the failure to observe that principle is not in itself a ground for a petition for review mentioned in Article 112a(2) or Rule 104 EPC, the grounds mentioned in those provisions being exhaustive (see R 16/09 of 19 May 2010, points 2.3.5 to 2.3.6 of the Reasons; and R 10/09 of 22 June 2010, point 2.4 of the Reasons). The only ground mentioned in those provisions and relied on in the petition is that in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113 EPC occurred.

3. The alleged violation is described in the petition as:

"the complete refusal of the Board of Appeal to admit sets of claims that had been filed with [the] Grounds of Appeal [which] was ... unexpected and violated the principle of legitimate expectations and, most importantly, deprived the [petitioner] of its right to be heard under Article 113 EPC...The Board of Appeal's application of its discretion under Article 12(4) RPBA was incorrect, and its refusal to admit Auxiliary Requests 8 to 15 into the proceedings resulted in an unreliable and unjust decision" (see petition, page 1, second paragraph); and

"the Board of Appeal contravened the [petitioner's] right to be heard as a result of the incorrect application of the discretion given to the Boards of Appeal under Article 12(4) RPBA, which the Board themselves (sic) state at point 2.4 of the decision, is intended to serve the purpose of ensuring fair and

reliable conduct of judicial proceedings" (see petition, page 10, first full paragraph; emphasis added in the petition).

4. It is therefore abundantly clear that the petitioner's real complaint is that the Board of Appeal decided in its discretion under Article 12(4) RPBA not to admit the petitioner's auxiliary requests 8 to 15 into the proceedings. The case-law of the Enlarged Board shows clearly that petition proceedings may not be used to review the exercise by a Board of Appeal of a discretionary power if that would involve an impermissible consideration of substantive issues (see R 1/08 of 15 July 2008, point 2.1 of the Reasons; R 10/09 of 22 June 2010, point 2.2 of the Reasons; R 9/10 of 10 September 2010, point 10 of the Reasons). This has recently been confirmed in the specific context of the discretion in Article 12(4) RPBA (see R 11/11 of 14 November 2011, point 6 of the Reasons).

5. It appears from both the minutes of the oral proceedings (see page 3, second full paragraph) and the decision under review (see sections XII to XV, pages 4 to 6) that the issue of the admissibility of the petitioner's auxiliary requests 8 to 15 was in fact discussed at the oral proceedings before the Board of Appeal. The petitioner does not appear to dispute this, indeed at several places in its submissions to the Enlarged Board it acknowledged and admitted that the issue was discussed at the oral proceedings (see section VIII above, sub-section 4: the petitioner observes the issue was raised as a "deviation" from the Board's preliminary opinion; sub-section 6: the petitioner complains it was raised by the Board and not

by the respondent; sub-section 8: the petitioner observes the issue was first raised at the oral proceedings; and sub-section 9: the petitioner's representative acknowledged it was an issue which could arise at oral proceedings but he was surprised at the emphasis placed on it). The respondent also confirms the issue of admissibility of the auxiliary requests was discussed at the oral proceedings (see section IX, sub-sections 1 and 2 above).

6. Since it is thus beyond doubt, indeed agreed by all concerned, that the petitioner was heard on the admissibility of its auxiliary requests 8 to 15, the only question which arises is, as the Enlarged Board observed in its communication (see section VI above), whether the petitioner's opportunity to comment on that issue was adequate. Although the petitioner did not present its arguments in that way in the petition, the question of adequacy of opportunity could, as the Enlarged Board's communication indicates, be extracted from the complaints that this issue was not mentioned in the Board's preliminary opinion and that the Board's decision during the oral proceedings, which the petitioner calls an unexpected departure from the preliminary opinion, did not allow the petitioner an opportunity to present a full and complete case (see petition, page 5, penultimate paragraph and the paragraph bridging pages 8 and 9).

7. The Enlarged Board considers the opportunity was adequate. As the respondent has observed (see section IX, sub-section 2 above), the petitioner (or its representative) must have known that auxiliary requests filed on appeal are only admissible in the Board of

Appeal's discretion and further must have known that Article 12(4) RPBA could lead to a finding of inadmissibility in the case of auxiliary requests which could have been presented at first instance. Indeed, that must or should have been a consideration also when the petitioner elected not to file further requests at the oral proceedings before the Opposition Division. The petitioner has now in the petition proceedings put forward various explanations why that was not done but, as in decision R 11/11 (see point 7 of the Reasons), the Enlarged Board observes that these are reasons why the petitioner did not file such requests then, and not reasons why it could not do so. It is quite clear from the petitioner's own submissions (see section VIII, sub-section 2 above) that it consciously chose not to do so.

8. In any event, and for the sake of completeness, the Enlarged Board does not accept that the basis of the petitioner's argument in this respect - that the decision of the Opposition Division was the first the petitioner knew of an objection to claim 11 as granted - is correct. The objection was made in the notice of opposition of the first opponent filed on 6 December 2007 (see section 5.6 on page 9) and repeated in its reply of 27 August 2009 to the Opposition Division's preliminary opinion (see section 6.4 on pages 17 to 18). That latter submission also contains additional comments in response to the petitioner's own reply to the notices of opposition of 25 September 2008 in which it referred to and presented arguments against this very objection (see page 14). It appears therefore that, far from being surprised by the objection being raised at the oral proceedings before the Opposition Division,

the petitioner was squarely on notice of the objection from the commencement of the proceedings, had prepared an answer to it more than a year before the oral proceedings, and was presented with the first opponent's rejection of that answer prior to the oral proceedings.

9. The argument that the petitioner was taken by surprise at the oral proceedings is therefore not credible and, without that argument, the other submissions in this respect - such as the need for time to consider the implications of amendment, the commercial importance of claim 11, and the need to wait for the written decision of the Opposition Division - must fall. The statement of the petitioner that the written decision of the Opposition Division contained reasoning never previously advanced either by the Division or the opponents (see section VIII, sub-section 2 above) is simply wrong, as a comparison of page 9 of the first opponent's notice of opposition and page 6 of the Opposition Division's decision shows. However, despite the implausibility of the petitioner's arguments why it did not file auxiliary requests at the oral proceedings before the Opposition Division, the Enlarged Board needs to make no finding as to why this was not actually done, or indeed why no explanation was provided when the requests were filed with the statement of grounds of appeal. Certainly there is no need to agree or disagree with the respondent's assertion that it was an abusive delaying tactic on the part of the petitioner, although it appears the Board of Appeal had some sympathy with that argument (see the decision, point 2.8 of the Reasons). As already mentioned (see point 7 above), the requests could have

been filed at first instance - indeed, in view of the first opponent's submissions, the petitioner would have had good reason to do so - and thus Article 12(4) RPBA applied.

10. The petitioner's argument as regards the adequacy of opportunity is based on the allegedly misleading nature of the Board of Appeal's preliminary opinion. The petitioner argues that, since the opinion commented on substantive matters, the petitioner understood that its auxiliary requests were admissible and, on that understanding, withdrew one group of its requests leaving only the other group (auxiliary requests 8 to 15) which it had filed as new with the statement of grounds of appeal. Then, the argument continues, the petitioner was surprised to find at the oral proceedings that admissibility of those remaining requests was in issue. The conclusion of the argument is that, if the petitioner had known that admissibility of those requests was still an issue to be discussed at the oral proceedings, it would have prepared better and presented a fuller case.

11. The Enlarged Board can understand how a communication containing a preliminary opinion may generate hopes of a particular outcome to the proceedings which, after subsequent developments, are not fulfilled. However, the Enlarged Board cannot agree that, by commenting only on substantive issues in its preliminary opinion, the Board could be considered to have decided already on questions of admissibility. It would have been quite wrong for the Board to have decided any issue prior to the oral proceedings, as that could clearly have denied either or both parties the right to be heard at the

oral proceedings to which they were entitled and which they had both requested (Articles 113(1) and 116(1) EPC). Moreover, any comment on admissibility would have been no more than provisional (see Article 17(2) RPBA). Although it was put forward in the petition (see page 5, third paragraph) that the petitioner understood from the preliminary opinion that a decision to admit the auxiliary requests into the proceedings had actually been taken, the Enlarged Board considers that it was not in fact the case as, at the oral proceedings before the Enlarged Board, the petitioner's representative candidly admitted that he knew admissibility of auxiliary requests was an issue which could arise at oral proceedings (see section VIII, sub-section 9 above). While the preliminary opinion is open to the criticism that it did not mention the issue of admissibility of auxiliary requests, the omission of an issue which the parties and the Board knew could arise cannot be characterized as misleading.

12. There is a further reason why the Enlarged Board considers that the petitioner should not have been surprised that admissibility of the auxiliary requests, although not mentioned in the preliminary opinion, was raised at the oral proceedings. In its reply to the grounds of appeal the respondent had raised the objection that before the Opposition Division the petitioner had deliberately chosen not to file a set of claims which the Opposition Division could have considered (see paragraphs (03) and (05) of the reply and section IX, sub-sections 7 and 8 above). Although this was raised by the respondent not as an objection to admissibility of the auxiliary requests under Article 12(4) RPBA but as an objection to any remittal

based on the claims in those requests, the respondent made an unambiguous attack on the petitioner's behaviour in not filing at first instance requests which it then filed on appeal. In the light of that attack it was not surprising that the Board of Appeal considered admissibility of the auxiliary requests under Article 12(4) RPBA. Accordingly the petitioner's argument must fail.

13. The petitioner's further argument that the question of admissibility of its auxiliary requests 8 to 15 was raised by the Board of Appeal and not by the respondent (see section VIII, sub-section 6 above) must also fail. It certainly did not prevent the petitioner being heard and it is unclear how it is suggested that it affected the adequacy of the opportunity to be heard. The petitioner's argument is that this somehow represented a lack of neutrality on the part of the Board but, even assuming that were the case, there is no submission from the petitioner explaining how this lead to a violation of Article 113 EPC. In any event, the Enlarged Board can see no valid criticism of the Board in this respect. While the respondent agrees (see section IX, sub-section 7 above) that it did not challenge the admissibility of the auxiliary requests 8 to 15 as such in its reply (but only made submissions on them in the context of its arguments against remittal), the petitioner acknowledges that admissibility was an issue which could arise (see section VIII, sub-section 9 above). That the Board might raise the question of Article 12(4) EPC if no-one else did was only to be expected and that the respondent, once the issue was raised, requested a finding of inadmissibility, is wholly unsurprising.

14. The petitioner having relied on an alleged inadequacy of opportunity to comment on the admissibility of its auxiliary requests, it was none the less unable to satisfy the Enlarged Board that it would have done anything differently if, for the sake of argument, the Board of Appeal's preliminary opinion had mentioned the issue. The petitioner submitted in the petition that it was denied the opportunity to prepare a full response to the inadmissibility objections and, at the oral proceedings before the Enlarged Board, that its representative would have invested more time on the issue but, when asked how the adequacy of the opportunity would have differed, could not add anything (see section VIII, sub-sections 4 and 9 above). That must be conclusive - if the petitioner itself cannot suggest anything additional it would have done or might have said if the matters of which it complains had not occurred, then its opportunity to be heard must have been adequate.
15. The petitioner sought to distinguish this case from that of decision R 11/11 by the fact that, in the case under review there, admissibility of auxiliary requests had been in issue throughout the appeal proceedings (see section VIII, sub-section 8 above). However, the Enlarged Board can attach no significance to that, not least because the admissibility of requests filed on appeal is always a matter for a Board's discretion and will therefore be decided, either at oral proceedings or otherwise, after the parties have made their submissions; so the matter will in fact be in issue throughout appeal proceedings whether the subject of submissions or not. Again, the Enlarged Board notes the

petitioner's acknowledgment that admissibility of such requests could arise at the oral proceedings (see section VIII, sub-section 9 above).

16. Further, there are in fact significant parallels between this case and R 11/11. In both cases the complaint was in essence that the non-admission of requests filed with the statement of the grounds of appeal violated the petitioner's right to be heard (see R 11/11, point 3 of the Reasons, and point 4 above). In both cases the reason for non-admission was the exercise of the discretion in Article 12(4) RPBA (see R 11/11, point 4 of the Reasons, and points 3 and 4 above). In both cases the petitioners argued that they could not have presented their requests in the first instance proceedings since they were taken by surprise and did not know the reasons for the opposition division's view (see R 11/11, point 5 of the Reasons, and point 8 above). In both cases it was not disputed that the petitioners were in fact heard on admissibility (see R 11/11, point 6 of the Reasons, and point 5 above). And in both cases the Enlarged Board has held that, in any event, the petitioners could have filed requests at first instance but did not do so (see R 11/11, point 7 of the Reasons, and point 7 above). The Enlarged Board sees no reason to differ here from the conclusion it reached (in a different composition) in decision R 11/11.

17. It appears that the petitioner's difficulties were not in fact caused by any actions or failings on the part of the Board of Appeal but were of its own making. Whether or not it really was surprised by the Opposition Division's decision, it did not file further

requests to overcome the objection to claim 11 in the opposition proceedings when it could in fact have done so. When it did file such requests with its statement of grounds of appeal, it did not anticipate the argument of inadmissibility under Article 12(4) RPBA by explaining why the requests could not have been filed at first instance, even though its representative knew admissibility of new requests on appeal was an issue which could arise. While the petitioner could understandably take some encouragement from the fact that admissibility of the requests was not mentioned in the Board's preliminary opinion, it drew from that the unwarranted conclusion that admissibility of the requests had already been decided even though, paradoxically, it also knew that the issue could arise at the oral proceedings.

18. The petitioner and its representative were responsible for the conduct of their case and it was for them to submit the necessary arguments to support their case on their own initiative and at the appropriate time (see R 2/08 of 11 September 2008, points 8.5 and 9.10 of the Reasons). If the petitioner was surprised by the result, such surprise may be an understandable subjective reaction but such subjective surprise cannot change the fact that the petitioner knew the issues which might be raised and had an adequate opportunity to comment thereon (see R 12/09 of 15 January 2010, point 13 of the Reasons; and R 15/10 of 25 November 2010, point 11 of the Reasons). Despite the assertions of a denial of the right to be heard, the detailed criticism of the reasons for the board's decision and the arguments over the cited case-law make the petition read more like the grounds of a second appeal than a petition for review,

demonstrating that the petitioner's real complaint is with the substance of the decision which the Enlarged Board of Appeal has no power to review.

Order

For these reasons it is decided that:

The petition for review is rejected as unallowable.

The Registrar:

The Chairman:

P. Martorana

B. Günzel