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**Datasheet for the decision
of the Enlarged Board of Appeal
of 13 May 2013**

Case Number: R 0015/11

Appeal Number: T 0832/09 - 3.2.02

Application Number: 03009955.0

Publication Number: 1352623

IPC: A61F 9/01

Language of the proceedings: EN

Title of invention:

Apparatus for customized refractive surgery

Applicant:

Ivis Technologies S.r.l.

Headword:

Fundamental violation of Article 113 EPC/IVIS TECHNOLOGIES

Relevant legal provisions:

EPC Art. 24(2) and (3), 111, 112a(2)(c), 113(1)
EPC R. 108(3)
RPBA Art. 15(1)
BDSRA Art. 2, 3, 4(1)
EHCR Art. 6

Keyword:

"Petition allowable (yes) - no opportunity to comment on grounds on which the decision under review was based"
"Replacement of members of the Board of Appeal (no) - no reasonable suspicion of partiality; the criteria and standards according to the case law on replacement under Article 24(3) EPC apply"

Decisions cited:

G 0001/05, J 0015/04, T 0584/09



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Case Number: R 0015/11

D E C I S I O N
of the Enlarged Board of Appeal
of 13 May 2013

Petitioner: IVIS TECHNOLOGIES S.r.l.
(Applicant) Via Luigi Corsi 50
I-74100 Taranto (IT)

Representative: Bruni, Giovanni
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I-10129 Torino (IT)

Decision under review: **Decision of the Technical Board of Appeal
3.2.02 of the European Patent Office of
14 April 2011.**

Composition of the Board:

Chairwoman: B. Günzel
Members: R. Menapace
A. Ritzka
C. Rennie-Smith
K. Garnett

Summary of Facts and Submissions

I. By decision T 832/09 which was announced at the end of the oral proceedings held on 14 April 2011 and notified in written form to the parties on 22 July 2011 the Board of Appeal 3.2.02 dismissed the appeal against the decision of the Examining Division to refuse European patent application No. 03009955.0. As to the appellant's sole auxiliary request, which had been filed with the statement of grounds of appeal, the Board held that it did not meet the requirements of Article 84 EPC, in that at least the expression *"refraction related to an aconic surface best approximating the corneal front surface"* in claim 1 was found to be unclear.

II. A petition for review in respect of that decision was filed on 23 September 2011 by the (new) representative on behalf of the applicant (appellant) - henceforth "the petitioner" - and the relevant fee was paid on the same day. The petition was based, in accordance with Article 112a(2)(c) EPC, on the grounds that a fundamental violation of the petitioner's right to be heard had occurred.

III. In support of this ground the petitioner put forward the following:

(i) A clarity objection had never been raised by the Board in relation to the auxiliary request. In the communication accompanying the summons it was indicated that the main issue of inventive step would be discussed first and then that *"should the subject-matter of any of the requests be regarded as inventive*

by the Board, the other requirements of the EPC, including those of Articles 123(2), 76(1), 84 and 83 EPC, will have to be discussed as well", and that the Board found "it appropriate to proceed in this order", which statements did not amount to a specific objection under Article 84 EPC regarding the auxiliary request. Nor did the Board say or ask anything during the oral proceedings which could be understood by the petitioner as such an objection. Nor is anything of this kind recorded in the minutes. The Reasons for the decision only contain the conclusions which the Board of Appeal drew from the description in respect of the alleged lack of clarity and they neither mention nor imply that clarity was discussed. The Facts and Submissions of the decision equally do not mention at all a discussion of the auxiliary request, whether any submissions from the petitioner or any comments, questions or invitations from the Board of Appeal.

(ii) In fact, says the petitioner, after the subject matter of the main request had been discussed (and found to lack inventive step), the auxiliary request was discussed. After a discussion on its admissibility and the announcement of its admission into the proceedings, the petitioner was invited to explain the request and then indicated the basis of the amendments in the application as originally filed. In addition the petitioner argued the requirement of inventive step and explained the functioning of the claimed invention; the term "refraction related to an aconic surface best approximating the corneal front surface" was not addressed at all by the Board of Appeal.

(iii) After these explanations the oral proceedings were interrupted for deliberation by the Board. At that point in time, even with the utmost foresight it could hardly have been predicted that the Board of Appeal would proceed with the proceedings by giving a final decision. However, after resuming the oral proceedings the Chairman started to pronounce a final decision by stating that the Board had come to the conclusion that the auxiliary request did not comply with the requirements of Article 84 EPC. The petitioner's representative immediately tried to intervene and to address this requirement. However, the Chairman interrupted him, refused to give him the floor, stating that the decision had already been taken and that the reasons for lack of clarity of the auxiliary request would be given in writing. Therefore the petitioner was prevented from raising a procedural objection under Rule 106 EPC.

IV. No objection under Rule 106 EPC has been recorded in the minutes of the oral proceedings, which show the usual structure and text, in particular, after reciting the petitioner's final requests, the standard wording "The chairman declared the debate closed. After deliberation the following decision was given: ...". There are no written notes of the petitioner listed in the minutes under "Documents presented" or annexed to them.

V. The Facts and Submissions make no mention of any objection or arguments concerning clarity/Article 84 EPC of the auxiliary request. In the relevant passage in the Reasons for the decision under appeal one reads under point 3, second paragraph "The crucial paragraphs

of the description referred to by the [petitioner] in this respect are not understood." And again, point 3, last subparagraph, states: "The explanations given by the [petitioner] at the oral proceedings, both orally and in the form of additional written notes, failed to convince the Board with respect to the clarity problems and did not provide any relevant additional information regarding the content of the application as filed".

- VI. As to the statement in the decision concerning the petitioner's references to the description, the petitioner says that these references were made by the petitioner in relation to submissions concerning the basis for the amendment, differences from the prior art and more generally the functioning of the invention.
- VII. As to the "additional written notes", the petitioner says that in the course of its submissions on inventive step in relation to the subject matter of the main request it submitted notes explaining the differences of the claimed invention from the state of the art (D1) and any conclusions the skilled person could derive from it. These notes are attached to the petition as Exhibit 1. They do not, says the petitioner, concern the crucial passage found by the Board to be unclear (see point I, above).
- VIII. By order of the Chairman dated 5 April 2012 the composition of the Enlarged Board of Appeal was enlarged, in accordance with its Business Distribution Scheme, to five members (Rule 109(2) EPC).

IX. The petitioner requested that:

1. the decision under review be set aside, the proceedings be re-opened, and the members of the Board of Appeal who participated in the decision under review be replaced;
2. reimbursement of the fee for the petition for review be ordered.
3. to appoint oral proceedings in the case the Enlarged Board of Appeal is not minded to allow request no. 1,

X. By letter dated 1 March 2013 the petitioner withdrew its request for oral proceedings as far as its request for replacement of the members of the Board of Appeal under Rule 108(3) EPC was concerned and made clear that this request for replacement covers all three members of the board of appeal who participated in the taking of the decision under review, it not being satisfied by the fact that by virtue of the current Business Distribution Scheme of the Boards of Appeal ("BDSBA") two of the three members of the Board of Appeal concerned (only), namely the chairman and the legally qualified member, are excluded from taking part in the re-opened appeal proceedings.

XI. At the same time the petitioner submitted also extensive written arguments in support of the latter request, in particular:

- (i) In a situation requiring the setting aside of a decision because of a substantial procedural violation

the remittal of the case to the Board of Appeal in the same composition might provoke the impression of prejudice. In particular the party concerned may easily get the impression that the judges who were responsible for conducting the proceedings in which the procedural violation occurred are less capable of assessing the case on a different and strictly objective basis than a newly appointed judge. Reference was made to the relevant case law of the German Federal Supreme Court on remittals to the German Federal Patent Court and it was submitted that in Germany in normal civil law cases remittal to another Senate seems to be a routine order which does not require any detailed reasoning.

(ii) In contrast to the facts underlying decision R 21/11, in the present case the cause for the procedural violation was the conduct of the proceedings by the Board of Appeal which concluded that there was a deficiency under Article 84 EPC without having heard the appellant on this point. Nevertheless, the members of the Board of Appeal must have been convinced that their assessment of the case was correct; otherwise they would not have taken the decision. That is in particular true for the rapporteur from which it cannot be expected that he will be unaffected by his previous position in the reopened proceedings. There is also a psychological tendency to play down one's own mistakes and that applies also to judges.

(iii) The petitioner should have a fair chance to have its case decided as objectively as possible. In the present case the petitioner has good reason to worry that the previous rapporteur is not free from influence from his previous judgement and that a newly appointed

rapporteur will be able to approach the case on a more objective basis. This should be sufficient for justifying the requested order. Moreover, "Justice must not only be done, it must also be seen to be done" (case law on Article 6 of the Convention on Human Rights which has been endorsed by the Enlarged Board of Appeal in proceedings before the EPO). The case should be given to a rapporteur whose objectivity in the assessment of clarity is beyond any legitimate doubt from the petitioner's perspective.

- XII. By a letter dated 19 April 2013 the petitioner referred to the interlocutory decision T 584/09, in which the Board of Appeal replaced the remaining two members who had taken part in the decision which had been set aside by decision R 21/11 of the Enlarged Board of Appeal. This was in reaction to statements from the two members informing the Board that they did not want to take part in the further proceedings in order to avoid any appearance or suspicion of partiality.

The petitioner maintained that the Board of Appeal, without stating any specific indications which might give rise to a suspicion of partiality, decided to replace the members in view of the fact that, exactly as in the present case, the previous chairman was no longer available and the petitioner had requested the replacement of [the/all] members of the Board of Appeal.

Furthermore, the statements of the two members concerned in which they said that they did not want to take part in the further proceedings in order to avoid any appearance of suspicion of partiality were said to confirm the petitioner's position that a member of a

Board who formed his opinion in previous proceedings carefully and thoroughly may be affected by his previous position.

Reasons for the Decision

Admissibility of the petition for review

1. In accordance with Article 112a(4) EPC, the petition was filed and the prescribed fee was paid within two months of notification of the decision under review. The requirements of Rule 107 EPC in respect of the contents of the petition have been fulfilled.
2. As regards the obligation to raise objections under Rule 106 EPC the Enlarged Board of Appeal makes the following observations:
 - 2.1 As set out more in detail below (point 4, "Allowability") there is nothing in the file of the appeal proceedings in question which supports the conclusion that the petitioner was or should have been aware during the appeal proceedings that compliance of the sole auxiliary request with Article 84 EPC was at issue.
 - 2.2 According to the petitioner (see point III, above), the chairman, just before announcing the decision on the appeal, made a negative statement as to the compliance of the auxiliary request with Article 84 EPC, but refused to give the petitioner's representative the floor when he immediately tried to intervene and to address this requirement (see point III(iii), above for

details) which, according to the petitioner, had never been discussed before or during the oral proceedings.

- 2.3 In the circumstances of the present case it is immaterial for the purposes of Rule 106 EPC whether or not these submissions give a true account of the conduct of the final stage of the oral proceedings before the Board of Appeal. If they do, the total and final refusal to hear the petitioner effectively hindered the petitioner from exercising its right to be heard and, at the same time, prevented its representative from raising a relevant objection under Rule 106 EPC (either directly or in reaction to the refusal to comment on the new objection). If for whatever reason the petitioner's submissions regarding the final stage of the oral proceedings in question were not taken into account by the Enlarged Board of Appeal, then there would be no indication at all that the petitioner could possibly have been aware before notification of the decision under review that it would be based, within the meaning of Article 113(1) EPC, on the lack of clarity in respect of the auxiliary request.
3. Thus, on either view, the relevant objection could not be raised by the petitioner during the appeal proceedings. It follows that Rule 106 EPC is satisfied.

Allowability

4. There is no explicit or implicit indication in the file of the appeal procedure from which it can be derived that in respect of the auxiliary request a possible lack of clarity (Article 84 EPC) was at any time

discussed with the petitioner or that at least an objection was raised in this respect.

- 4.1 The petitioner is correct in saying that the statement in the communication accompanying the summons concerning a potential discussion of *inter alia* Article 84 EPC (point III(i), above) did not amount to a specific objection under that provision regarding the auxiliary request. It expressed, at best, a conditional and quite general intention of the Board of Appeal when drafting the communication. It cannot help establish whether or not the petitioner was then actually given the opportunity to comment on that requirement within the meaning of Article 113(1) EPC.
- 4.2 The reasoning in point 3, last paragraph of the decision under review (point I, above) is equally inconclusive in this respect, also insofar as it refers to explanations given by the petitioner during the oral proceedings, both orally and in the form of additional written notes. There is nothing in this paragraph or elsewhere in the Reasons including, in particular, the Facts and Submissions, which indicate or imply that at any time during the oral proceedings the petitioner was aware or could have been aware that compliance with Article 84 EPC was at issue. The reference in point 3, second paragraph to the "crucial paragraphs of the description referred to by the [petitioner]" (see point V, above) are in this respect too vague in the face of the petitioner's assertion about this (see point VI, above). The written notes referred to in the decision are not further identified by the Board and the notes produced by the petitioner bear out what is said in the petition (see point VII) above, i.e., they

do not concern the crucial passage in the claim found to be unclear.

- 4.3 Neither do the petitioner's submissions, in particular its account of the final stage of the oral proceedings before the Board of Appeal (point III(iii), above) suggest in any way that the right to be heard was granted in respect of the critical ground for the decision in question - on the contrary, see point 2.3 above.
5. The Enlarged Board does not have the power or ability to investigate further whether or not there might be other facts or indications which would suggest that at any time the petitioner was indeed aware or could have been aware that the Board of Appeal had doubts as to the compliance with Article 84 EPC, an awareness which would have been the minimum prerequisite for an opportunity to comment on that ground within the meaning of Article 113(1) EPC. In the absence of any such indication it is clearly not for the party which alleges a breach of its right under that provision to prove the negative (*negativa non sunt probanda*). Nor can the Enlarged Board, in the absence of any such indications, re-construct the detailed course of the entire appeal proceedings, in particular of the oral proceedings, in a case where the decision of the Board of Appeal has been challenged under Article 112a(2)(c) EPC. Any relevant document on file, in particular the parties' written submissions, any communication under Article 15(1) RPBA, the minutes of the oral proceedings or the facts and submissions and/or the reasons for the decision pursuant to Article 111 EPC may serve the purpose of establishing what took place, it being the

usual practice of the Boards of Appeal to include the relevant information in the facts and submissions and/or the reasons for the decision (rather than in the minutes of the oral proceedings). It is for the Board of Appeal to draft its own texts in a way that enables the reader, taking into account all documents on file, to conclude that the right to be heard within the meaning of Article 113(1) EPC was respected with regard to the grounds on which the decision of the Board of Appeal is based.

6. No such conclusion regarding non-compliance of the auxiliary request with Article 84 EPC, on which ground the appeal was eventually dismissed, is present in the reasons for the decision under review, in particular not in point 3, last paragraph (point 4.2, above). Had the clarity issue been raised earlier and in a manner enabling the petitioner to comment on it, one would expect that this would be indicated by the Board of Appeal or otherwise reflected in the written reasons for the decision under review, e.g. by dealing with the party's reaction - normally counter-arguments or amended requests, or both - in the Summary of the facts and submissions and/or in the Reasons for the decision.
7. Under these circumstances the Enlarged Board of Appeal is not in a position to establish that the petitioner's right to be heard has been respected. So it has to be assumed that a violation of the petitioner's rights under Article 113(1) EPC occurred which qualifies as fundamental within the meaning of Article 112a(2) (c) EPC because it concerned the ground on which the appeal was eventually dismissed by the decision under review.

Request for replacement of the members of the Board of Appeal under Rule 108(3) EPC

8. What the petitioner's argumentation in support of that request (point XI, above) boils down to is, in effect, that the replacement of all members of the Board of Appeal should be an automatic ("routine") measure whenever the violation of the petitioner's rights which led to the setting aside of the decision of the Board of Appeal was a mistake of the Board of Appeal itself (and not, as e.g. in case R 21/11, due to circumstances outside the Board's control), such a mistake bringing a suspicion of partiality upon each member of the responsible board.
9. However, such a narrow understanding of the Enlarged Board's discretion to replace or not to replace Board members cannot be derived from the wording of Rule 108(3), second sentence, EPC, nor does it properly reflect its purpose.

Rule 108(3), second sentence, EPC stipulates quite generally that the Enlarged Board may order the replacement of board members who participated in the decision set aside. Hence, even if the decision of the Board was flawed by a fundamental procedural deficiency within the meaning of Article 112a EPC, the replacement of board members still lies in the discretion of the Enlarged Board. This means that replacement does not ensue automatically from the fact of a deficiency within the meaning of Article 112a EPC having occurred. On the contrary, the rule is that the proceedings are re-opened before the Board of Appeal responsible under the business distribution scheme (see Revision of the

European Patent convention (EPC 2000), Synoptic presentation EPC 1973/2000 - Part II: The Implementing Regulations, OJ EPO Special edition 5/2007, 166). This serves the interest of procedural economy, since the board members who are familiar with the case will normally most efficiently deal with the case again.

More importantly, however, the principle relied on in decision R 21/11 of 15 June 2012, namely that the replacement of members of the Board of Appeal should not be ordered without good reason, is not merely a matter of procedural economy. As the business distribution scheme of any court, the BDSBA (see Supplement to OJ EPO 1/2013, 12 for the current version) and the adherence to it is an important element of an independent, reliable and efficient judicial system which meets the standards set by, inter alia, Article 6 ECHR. Any change of a Board's composition without good reason would be contrary to the evident purpose of the BDSBA - and, thus, also detrimental precisely to "the public's confidence in the judicial character of appeal proceedings" which the petitioner referred to - and must, therefore, remain restricted to situations where for objective or clearly established subjective reasons an individual member can or should no longer participate in the case. This is not only reflected in the above cited wording of Rule 108(3), second sentence, EPC: "The Enlarged Board of Appeal may order ...". but also in the wording "... that members [not: the members] ... shall be replaced" in Rule 108(3) EPC and in Article 4(1) of the BDSBA: "If a member designated ...".

10. Just as a decision under Article 24(4) EPC, an order under Rule 108(3) EPC causes a change of the composition of the Board of Appeal as originally determined pursuant to Articles 2 and 3 BDSBA. In decision G 1/05, OJ EPO 2007, 362, point 8 of the Reasons, the Enlarged Board underlined the importance of Board members' discharging their duty to sit in the cases allocated to them in the particular composition as determined by the provisions applicable thereto, *viz*, the right of the parties to a hearing before a judge or court in the particular composition as determined by those provisions. This means not only that Board members cannot withdraw from the proceedings at will, but also that the provisions on business distribution must apply for a case re-opened before the board, unless there is a compelling reason for proceeding otherwise, It is therefore appropriate , when exercising the power of discretion conveyed by Rule 108(3), second sentence, EPC, to consider the criteria and standards that have been developed for the replacement of members of the Board of Appeal following an objection of suspected partiality pursuant to Article 24(3) and (4) EPC. Actually, it is the allegation of suspected partiality on which the petitioner's request to replace (also) the rapporteur is based.
11. It is commonly recognised in the jurisprudence of the Boards of Appeal and elsewhere that the suspicion of partiality must be justified on an objective basis and that purely subjective impressions or vague suspicions are not enough (G 1/05, OJ EPO 2007, 362, point 20 of the Reasons). The question whether or not an objection on the ground of suspected partiality is justified can

only be decided in the light of the particular circumstances of each individual case (G 5/91, OJ EPO 1992, 617). Such a suspicion is not objectively justified for the sole reason that a position on the matter was adopted in a prior decision of a board of appeal in which the board member concerned had participated (G 1/05, see also J 15/04 of 30 May 2006).

12. In the present case there is nothing concrete in support of a reasonable suspicion of partiality regarding the rapporteur. In particular, it appears that the omission to grant the petitioner an opportunity to present its comments on the question of clarity was a mere oversight to which the rapporteur did not (actively) contribute. Under these circumstances the rapporteur's ability to approach the petitioner's submissions during the re-opened appeal proceedings with an open, unbiased mind is not in doubt, so that the Enlarged Board does not see a reason for exercising its power under Rule 108(3) EPC in the way as requested by the petitioner.
13. This conclusion is not affected by the petitioner's reference to decision T 0584/09 (point XII, above) in which the replacement was decided under Article 24(4) EPC by the Board of Appeal following statements pursuant to Article 24(2) EPC that the two members concerned did not want to participate in the further proceedings in order to avoid suspicion of partiality. In contrast, the present request for replacement (of the one remaining member) is to be decided on by the Enlarged Board of Appeal under Rule 108(3) EPC and in the absence of any objective basis for a suspicion of partiality. It is, however, completely open how, in the

re-opened proceedings, the Board of Appeal, in the event of a statement by the member concerned pursuant Article 24(2) EPC or an objection by the party pursuant to Article 24(3) EPC, would decide on the question of replacing that member.

14. The order to reimburse the fee for the petition is based on Rule 111 EPC.

Order

For these reasons it is decided that:

1. The decision under review is set aside and the proceedings before the Board of Appeal 3.2.02 are re-opened.
2. The request that the members of the Board of Appeal who participated in the decision under review be replaced is rejected.
3. Reimbursement of the fee for the petition for review is ordered.

The Registrar:

The Chairman:

W. Crasborn

B. Günzel