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**Datasheet for the decision
of the Enlarged Board of Appeal
of 2 October 2012**

Case Number: R 0019/11
Appeal Number: T 0284/10 - 3.2.08
Application Number: 02803716.6
Publication Number: 1448916
IPC: F16H 35/02
Language of the proceedings: EN

Title of invention:

Synchronous drive apparatus with non-circular drive elements

Patentee:

Litens Automotive

Opponents:

Schaeffler Technologies GmbH & Co. KG
PEUGEOT CITROEN AUTOMOBILES SA
The Gates Corporation
Beetz & Partner

Headword:

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Relevant legal provisions:

EPC Art. 112a(2), 112a(2)(c), 113(1)
EPC R. 104, 106

Keyword:

"Petition for review not clearly inadmissible"

"No right to advance indication of reasons for decision"

"List of possible grounds for review in Article 112a(2) and Rule 104 - exhaustive" - "Adequacy of the reasoning of the board's decision; no ground" "Judicial ground of irrationality, known as *Wednesbury unreasonableness*, no ground"

"Petition for review clearly unallowable"

Decisions cited:

R 0001/08, R 0010/09, R 0012/09, R 0015/09, R 0016/09,
R 0018/09, R 0015/10, R 0001/11, R 0020/10

Catchword:

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Case Number: R 0019/11

D E C I S I O N
of the Enlarged Board of Appeal
of 2 October 2012

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Decision under review: **Decision of the Technical Board of Appeal
3.2.08 of the European Patent Office of
7 July 2011.**

Composition of the Board:

Chairman: W. van der Eijk
Members: G. Weiss
 M. Wieser

Summary of Facts and Submissions

I. The petition for review concerns decision T 284/10 of Board of Appeal 3.2.08 dismissing the appeal and maintaining the patent as granted.

II. The proceedings in case T 284/10 can be summarised as follows:

(a) Appeals were filed by opponents 01, 02 and 03 against the decision of the opposition division to reject the oppositions. After the written phase of the appeal proceedings Board of Appeal 3.2.08 summoned the parties to oral proceedings scheduled to take place on 7 July 2011.

(b) Oral proceedings were held on 7 July 2011 before the board. At the end of the oral proceedings the board announced its decision that the appeals were dismissed. The reasoned decision T 284/10 was notified to the parties by registered letter with advice of delivery on 14 September 2011.

III. The invention concerns the best way to eliminate or reduce torsional vibrations in a synchronous drive system by arranging a non-circular profile on one of the rotors which is such as to cancel or reduce the fluctuating load torque in the load assembly. In the invention as claimed the angular positions of protruding and receding portions of the non-circular profile and the magnitude of the eccentricity are such as to apply an opposing "fluctuating corrective torque". The corrective torque reduces or substantially cancels the fluctuating load torque.

D3 (DE 195 20 508) was considered the most relevant state of the art. Column 1, lines 43-51, in the English translation reads as follows: "The means for producing the irregularity may preferably be a "non-circular" driving or driven wheel, varying elasticity or thickness in the longitudinal direction of the wraparound means or one or more resiliently pre-stressed reactive elements, which when operated in a defined frequency and phase position, superimpose the given irregularity of the belt drive, thereby bringing about a resonance shift."

In paragraph 4.5 of the reasons for the written decision the board judges that the subject-matter of claim 1 is new in spite of D3: "However, D3 does neither mention the angular positions of the protruding and receding portions of the non-circular profile, nor indicate any importance of their positions in relation to the phase of the periodic fluctuating load torque. In particular and contrary to the view of the appellants, the indication of a given phase in column 1, lines 43-51, and column 3, lines 14-20, does not relate to the rotor with non-circular profile, but to the resiliently pre-stressed reactive elements." A similar statement was made in paragraph 5.1 in relation to the assessment of inventive step.

IV. On 23 November 2011 appellant-opponent 03 (referred to below as the petitioner) filed a petition for review of this decision pursuant to Article 112a EPC. The corresponding petition fee was paid on the same day. The petition was based on the ground referred to in Article 112a(2)(c) EPC, namely that a fundamental

violation of Article 113(1) EPC had occurred in the appeal proceedings.

- V. On 20 April 2012, as an annex to the summons to oral proceedings, a communication was issued informing the petitioner of the provisional view of the Enlarged Board, namely *inter alia* that it appeared that the petition might be clearly unallowable.
- VI. With letter received on 3 September 2012 the petitioner filed submissions taking account of the provisional view of the Enlarged Board. Furthermore, it asked the Enlarged Board to consider in its decision the English judicial review ground of irrationality, also known as "*Wednesbury unreasonableness*".
- VII. Oral proceedings before the Enlarged Board of Appeal in its composition pursuant to Rule 109(2) (a) EPC took place on 2 October 2012.
- VIII. The petitioner's arguments as put forward in writing and in the oral proceedings before the Enlarged Board can be summarised as follows:

Concerning the admissibility of the petition

(a) The board had dismissed the petitioner's argument that the subject-matter of claim 1 lacked novelty and inventive step on the basis of an incorrect reinterpretation of a passage in D3. Neither the board nor the patentee had previously suggested that the passage had to be interpreted in the way suggested by the board. The petitioner had not been heard on these determinative issues. The board's decision to adopt an

unforeseen and unforeseeable reinterpretation of the relevant passage of D3 had only become apparent upon receipt of the written decision. Thus, no objection under Rule 106 EPC could have been raised at an earlier stage.

(b) An argument of high relevance, put forward by the appellant during the oral proceedings, had not been addressed by the board in its written decision. This argument had been incompletely recorded in the summary of the petitioner's arguments and had not been discussed at all in the board's written decision. The board had decided the appeal without considering a highly relevant issue, contrary to Article 113 EPC. The petitioner could only determine from the reasoning in the written decision that the highly relevant argument had not been considered, so the exception set out in Rule 106 EPC applied.

Concerning the allowability of the petition

(a) The reinterpretation of D3, column 1, lines 43-51

The petitioner had not been heard on the board's reinterpretation of D3, which was the sole basis for the board's decision on novelty and inventive step. At no time in the procedure had it been suggested that, as had now been decided by the board, the relevant passage in D3 had to be interpreted such that the frequency and phase of the vibrations introduced into the system had to be taken into consideration only if those vibrations were introduced by means of a pre-stressed reactive element. No opportunity had been given to comment on the board's incorrect reinterpretation of D3 which, as

could be seen only now, was the decisive point on which the entire decision hinged. If such an opportunity had existed, the petitioner would have explained why the board's reinterpretation was technically incoherent, linguistically wrong, in contradiction with the context in suit and sufficiently bizarre that there was no way the appellant could have anticipated it. Thus, the petitioner was taken by surprise; he never had any reason to suppose that there could be a controversy over the meaning of the relevant passage of D3.

In some decisions of the Enlarged Board a inherent link between the discussions in the oral proceedings and the board's final decision had been made. In R 19/09 the reason for the board of appeal not to acknowledge an unexpected effect was not discussed in the appeal proceedings; however, the Enlarged Board dismissed this aspect, on the ground that it was questionable whether the procedural deficiency could have been causal for the final decision (see Reasons, points 6 to 9). In R 15/10 all parties had been heard on issues of clarity and the board decided that those of the opponents should prevail in its subsequent decision (see Reasons, points 7 and 8). In the present case under review, the board had made no suggestion concerning the interpretation of D3 and no debate had taken place on such an interpretation; nor had any reasons for another interpretation been put forward. In R 16/10 the board had "set out the interpretation or the scope given to this notion ["antagonism" or "impairment"] by the petitioner but then departed from this view and explained why." (see Reasons, point 2.2.2). In the present case under review, the petitioner was given no opportunity to argue on a new interpretation, nor did the board give an opinion on any new interpretation.

Even if there was no obligation for the Board to give the parties any indication of the reasons for its decision or of the possible outcome of the case, it may be advisable in some circumstances to accept that such an obligation may arise. In the present case, it seemed clear that, in the course of the discussions that took place during the oral proceedings, the board had discovered an alternative disclosure which changed an important aspect concerning a certain teaching. In such case, it was obliged to communicate this discovery to the parties.

The petitioner further submits that under Article 113(1) EPC the board should consider another aspect of the right to be heard, namely the adequacy of the reasoning of the decision, according to which the reasons given enable the parties concerned to understand whether the decision was justified or not (see R 19/10, Reasons, point 6.2). In the present case, the last sentence of the reasons, point 4.5, first paragraph of the decision under review is merely an assertion, a premise, a fact which was not explained, justified or reasoned.

(b) The failure of fully considering a key argument

The board had summarised on page 9 of its written decision one of the petitioner's arguments as follows: "To reduce the vibration, which was the aim of D3, the person skilled in the art would have tested different angular orientations of said non-circular profile. This experimentation was also rendered obvious by the indication in D3 that the phase of the vibrations introduced into the system was to be considered. By

performing these tests he would have found that some directions, corresponding to about 50% of the possible orientations, provided a reduction of the vibrations. The apparatuses tested in those directions already fulfilled all the requirements of claim 1, since they reduced the fluctuating load torque of the rotary load assembly."

Whilst accepting that the board, on page 9 of its written decision, correctly summarised this argument (see page 13, point G.1 of the petition), it was clear that a further development of this argument, put forward during the oral proceedings, had been disregarded by the board in the minutes of the oral proceedings as well as in the written decision. This "development" concerned the fact that "... if the invention of D3 is simply put into effect with the non-circular rotor set at an arbitrary phase, the result will be the claimed invention 50% of the time, and this on its own means that the invention is obvious." This was a qualitatively different argument from the argument dismissed in paragraph 5.1 of the board's decision and it simply had not been answered. As a result of these factual findings, it was impossible for the board to conclude on an objective basis that the decision would have been the same if this "developed" argument had properly been considered.

(c) The judicial ground of irrationality, otherwise known as *Wednesbury unreasonableness*

The Enlarged Board should acquaint or re-acquaint itself with an English administrative law procedure known as judicial review and consider whether to

incorporate into its own canon an equivalent of the judicial review ground of irrationality, otherwise known as *Wednesbury unreasonableness*. The decision under review fell within the definition of "*Wednesbury unreasonableness*" and the Enlarged Board should borrow from this and infer that the decision could not reasonably be explained as anything other than a fundamental breach of Article 113 EPC.

- IX. The petitioner requested that decision T 284/10 to dismiss the appeals be set aside and that the proceedings before Board 3.3.08 be re-opened. Furthermore it requested that the members of the board of appeal who participated in the decision be replaced and that the petition fee be reimbursed.

Reasons of the Decision

1. Admissibility of the petition for review
 - 1.1 The petitioner is adversely affected by decision T 284/10 dismissing the appeals and therefore maintaining the patent as granted. The petition for review was filed on the ground referred to in Article 112a(2)(c) 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 14 September 2011. The two-month period for filing the petition for review expired on 24 November 2011. As the petition was filed and the fee was paid on 23 November 2011, it also complies with Article 112a(4) EPC. The

other conditions in relation to the contents of the petition as foreseen in Article 112a(4) in conjunction with Rule 107 EPC are also fulfilled.

- 1.3 No objection under Rule 106 EPC was raised during the appeal proceedings. This poses the question of whether the exception in Rule 106 EPC applies.

The present petition is based on the allegations that, firstly, the board's decision had adopted a re-interpretation of a highly relevant passage of document D3 which only became apparent to the petitioner upon receipt of the board's written decision and that, secondly, the board had not considered in its written decision a highly relevant argument relating to the examination of inventive step, which had been submitted during the oral proceedings. This argument, if properly considered, would have led to the conclusion that the subject-matter of claim 1 lacked any inventive step.

Both these facts, alleged by the petitioner, could only have been noted upon receipt of the written decision. Therefore, the exception under Rule 106 EPC applies.

- 1.4 The petition for review is therefore not clearly inadmissible.

2. *Allowability of the petition for review*

- 2.1 With regard to the first issue, "The reinterpretation of D3, Column 43-51", the Enlarged Board notes that the petitioner does not dispute that the content of document D3 has been thoroughly discussed, both during the written procedure and in the oral proceedings held

on 7 July 2011 before the board of appeal, so that its right to be heard in this respect has not been violated.

- 2.2 In paragraph F.2 on page 12 of its petition, the petitioner summarised its position in relation to the re-interpretation of D3: "*...this petition should succeed under Art. 112a(2)(c). Firstly, the board decided novelty and inventive step on the basis of an incorrect reinterpretation of a passage D3 of which the appellant was not aware and upon which he had no opportunity to comment. Secondly, the reinterpretation of D3 was the reason why the board decided the issues of novelty and inventive step in the way that it did. Thirdly, the reinterpretation of D3 is demonstrably wrong and sufficiently bizarre that there is no way the appellant could have anticipated it.*"

According to established case law, the Enlarged Board of Appeal has no jurisdiction and competence whatsoever to enter into the merits of the case under the provisions of Article 112a EPC. It is not competent to consider - even indirectly - the substance of the appeal. The board which heard the case has sovereign power to assess the facts presented to it (see R 1/08 of 15 July 2008 and subsequent decisions).

The petitioner complained that in its written decision the board had adopted an interpretation of the critical passage of document D3 which should have been presented to the petitioner in advance so that it could have presented arguments on that view. However, as the Enlarged Board has already indicated in several previous decisions on petitions for review - some of them cited by the petitioner itself - such complaints

do not disclose a denial of the right to be heard. The Enlarged Board's jurisprudence clearly demonstrates the principle that parties are not entitled to advance indications of the reason or reasons for a decision before it is taken (see the summary of the case law in R 12/09 of 15 January 2010, Reasons, point 11 and the several other decisions there referred to and subsequent decisions R 15/09 of 5 July 2010, Reasons, point 4; R 18/09 of 27 September 2010, Reasons, points 14 to 15 and 18; and R 15/10 of 25 November 2010, Reasons, points 7 to 9). If that principle applies to the reasons for a decision generally, it must apply equally to an interpretation of a passage in the state of the art forming only part of such reasons. Thus, there can be no such denial if a board of appeal, after hearing all parties in *inter partes* proceedings, subsequently reaches its own conclusion which is then recorded in its written decision.

A board hearing *inter partes* proceedings is obliged to complete neutrality. This requirement would be breached if a board, after having dispatched a communication expressing its preliminary and non-binding opinion, at oral proceedings would inform a party of a possible different interpretation of a passage in a prior art document discussed at length at said oral proceedings, even if that interpretation differs from those suggested by the parties. Therefore, if the Enlarged Board comes to the conclusion that the considerations that persuaded the board of appeal to arrive at its decision were related to discussions taking place in this respect in the proceedings in question, the petitioner's argument cannot be successful. In other words, it is enough if the Enlarged Board finds that

the new considerations were not unrelated to the discussions arising in the proceedings in question.

In the present case it is evident that the relevant passage of document D3 was explicitly addressed in item 5.3 of the annex to the summons to oral proceedings. Also, in the decision itself the relevant technical issues which are of importance for the critical passage of document D3 and its possible interpretation, namely the angular positions of the protruding and receding portions of the circular profile and also the importance of their positions in relation to the phase of the periodic fluctuating load torque, are addressed, see the heading "arguments of the appellants and of opponent 1 ", item XI, pages 7 to 9 as well the heading "respondent's arguments", item XII, pages 11 and 12; in the part of the "Reasons of the decision" the board explained its judgment in points 4.3 to 4.5 as well in point 5.1.

Consequently, the Enlarged Board cannot establish a violation of the principle of the right to be heard justifying the setting aside of the decision under review.

On this first issue, the petitioner submitted further that examination of the grounds for review relating to the right to be heard should include consideration of the adequacy of the reasoning of the board's decision. The Enlarged Board cannot subscribe to this interpretation because it would go against the legislator's intention to establish an exhaustive list of grounds for initiating review proceedings in accordance with Article 112a EPC (see point 2.4 below).

The adequacy of the reasoning of the board's decision as put forward by the petitioner can only be considered as a new ground for review and would represent an indirect way of allowing the case to consider the substance of the appeal, which is *lege ferenda* and has been consistently confirmed in case law as being outside the ambit of the review procedure.

- 2.3 Concerning its second issue, the failure to fully consider a key argument, the petitioner submitted that an important inventive step argument had been overlooked and disregarded by the board in its decision. It argued that it was impossible to conclude on an objective basis whether the decision would have been the same if this argument had been properly considered.

The Enlarged Board notes that the petitioner states in item G.1 of its letter of 23 November 2011 that the board had correctly summarised this argument of the appellant/petitioner on page 9 of its written decision. The evaluation of this argument, which was obviously not found convincing by the board, is given in item 5.1 of the written decision.

The fact that the board was not convinced by the "development" of this argument put forward by the petitioner during the oral proceedings is a decision of the competent board on a substantive issue.

Article 112a EPC does not alter the fact that the boards of appeal alone are the final substantive instance in proceedings under the EPC. The Enlarged Board of Appeal cannot deviate from that, even through interpretation. Rather, it must confine itself strictly to the EPC's exhaustive list of grounds for setting

decisions aside. The substantive correctness of a decision's findings and conclusions is not reviewable - even indirectly - under Article 112a EPC.

2.4 Concerning the third issue, "the judicial ground of *irrationality*, otherwise known as "*Wednesbury unreasonableness*" and the invitation to the Enlarged Board to incorporate into its own canon an equivalent of the judicial review ground of irrationality, it is completely and unambiguously clear that the list of possible grounds contained in Article 112a(2) and Rule 104 EPC is exhaustive. This has been made abundantly clear in the Enlarged Board's jurisprudence (see R 1/08 of 15 July 2008, Reasons, point 2.1, last paragraph; R 16/09 of 19 May 2010, Reasons, points 2.3.5 and 2.3.6; R 10/09 of 22 June 2010, Reasons, point 2.4-5; R 18/09 of 27 September 2010, Reasons, point 19; R 1/11 of 27 June 2011, Reasons, point 2.2 and R 20/10 of 25 August 2011, Reasons, point 2.1). The grounds enumerated in the legislation being exhaustive, there is no scope for creating an additional ground by analogy with the judicial ground of *irrationality* as the petitioner seeks to do.

2.5 For the above reasons, the petition is clearly unallowable.

Order

For these reasons it is decided that:

The petition is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk