



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Große
Beschwerdekammer

Enlarged
Board of Appeal

Grande
Chambre de recours

Internal distribution code:

- (A) [] Publication in OJ
- (B) [X] To Chairmen and Members
- (C) [] To Chairmen
- (D) [] No distribution

**Datasheet for the decision
of the Enlarged Board of Appeal
of 19 July 2013**

Case Number: R 0011/12

Appeal Number: T 1377/08 - 3.3.05

Application Number: 00902267.4

Publication Number: 1143814

IPC: A23L 3/00, B01J 8/46

Language of the proceedings: EN

Title of invention:
Apparatus for gas treatment of products

Patent Proprietor:
John Bean Technologies AB

Opponent:
Marel Salmon A/S

Headword:
Right to be heard in oral proceedings

Relevant legal provisions:
EPC Art. 113
EPC R. 106
Notice of Vice-President DG3 concerning oral proceedings
before the boards of appeal

Keyword:
"Petition for review: not clearly inadmissible - clearly
unallowable"
"Violation of right to be heard - no"

Decisions cited:
R 0018/09, R 0003/10, R 0004/11, R 0017/11

Catchword:
-



Case Number: R 0011/12

D E C I S I O N
of the Enlarged Board of Appeal
of 19 July 2013

Petitioner: John Bean Technologies AB
(Patent Proprietor) Box 913
S-251 09 Helsingborg (SE)

Representative: Andersson, Mikael Per Robert
Awapatent AB
Box 1066
S-251 10 Helsingborg (SE)

Other Party: Marel Salmom A/S
(Opponent) Bøgildmindevej 3
DK-9400 Nørresundby (DK)

Representative: Tellefsen, Jens J.
Patrade A/S
Fredens Torv 3A
DK-8000 Aarhus C (DK)

Decision under review: **Decision of Technical Board of Appeal 3.3.05 of
the European Patent Office of 21 March 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: B. Günzel
F. Edlinger

Summary of Facts and Submissions

I. This petition for review concerns decision T 1377/08 of Technical Board of Appeal 3.3.05 of 21 March 2012, by which European patent No. 1143814, application No. 00902267.4, was revoked. The petitioner is the patent proprietor.

II. The subject-matter of the patent in suit is an apparatus for gas treatment of products. The characterising part of claim 1 of the patent reads as follows:

"1. An apparatus for gas treatment of products, comprising a housing (1) having top, bottom and side walls (2;3;4;5), . . . ,

characterised by walls (15-17) being separated from the walls (2-5) of the housing (1), said separated walls (15-17) being connected with the perforated walls (12) of the tunnel (11) and having an opening towards and connected to an outlet of the gas circulation means (18) in order to form a high pressure chamber (14) above the tunnel (11) and constituting a gas circulation channel from said outlet of the gas circulation means (18) to the perforated walls (12) of the tunnel (11), at least one vertical part of the walls (15-17) forming the high-pressure chamber (14) being removable so as to provide access to the inside of the high-pressure chamber (14)."

III. In the opposition proceedings the opponent (hereinafter: appellant) attacked the patent on the grounds of lack of novelty and lack of inventive step. The objection of

lack of novelty was based on an alleged public prior use and on document D6, submitted in the course of the opposition proceedings. Lack of inventive step was argued on the basis of D1 as representing the closest state of the art and on document D6 in combination with, *inter alia*, document D1. In the oral proceedings before the opposition division the opponent submitted document D7 and argued that the opposed patent did not involve an inventive step in the light of D6 as the closest state of the art, when taken in combination with D7 or D1. The proprietor (hereinafter: petitioner) submitted that D7 represented the closest state of the art.

- IV. The opposition division refuted the appellant's allegation of prior use and found the claimed subject-matter to be novel over document D6. With respect to inventive step, D7 was considered to be the closest state of the art. The claimed subject-matter was, however, found to be inventive over D7, also in combination with the teaching of any of the documents D1 to D6.
- V. On appeal the appellant pursued its allegation of prior use. With regard to the written state of the art it reiterated that the claimed subject-matter lacked novelty over D6. Lack of inventive step was argued based on D6 as representing the closest state of the art. The only feature by which the claimed subject-matter arguably differed from D6 was that D6 did not explicitly indicate "at least one vertical part of the walls forming the high pressure chamber being removable so as to provide access to the inside of the high-pressure chamber". The objective problem was "how to provide convenient access means to the interior of the

apparatus, in order to facilitate inspection, maintenance (repairs and cleaning)". To allow access to all parts of the machinery for cleaning and inspection was, however, common general knowledge and required by European standard EN 1672-2, and was evidenced by numerous examples in the state of the art, including D1.

The petitioner reiterated that the late filed document D6 was not *prima facie* relevant to novelty and inventive step and should not be allowed into the proceedings. The closest prior art was D7, as confirmed by the opposition division.

VI. In an annex to the summons to oral proceedings Technical Board of Appeal 3.3.05 informed the parties that the alleged prior use/sale did not seem to prejudice the novelty of the patent in suit and that therefore the board did not intend to summon any witness.

VII. By the impugned decision the board revoked the patent.

The reasons for the decision discuss in detail whether D6 or D7 should be regarded as the closest state of the art, the applicable principles to determine this, the arguments submitted in this respect by the petitioner and the reasons why the board does not accept the petitioner's arguments that not D6 but D7 represents the closest state of the art. The board then concludes that while D7 is distinguished from the claimed subject-matter in two respects, namely that in the apparatus according to D7 the walls of the "high" pressure chamber are not "separated from the housing" in the sense of claim 1 at issue and that the

"apparatus does have one vertical part of the walls forming the high pressure chamber which is removable so as to provide access to the inside of the chamber", D6 differs therefrom only by the absence of a removable wall providing access to the inside of the chamber. According to both the contested patent and the respondent (i.e. the petitioner, addition by this Enlarged Board), the problem underlying the contested patent is to be seen in the provision of a compact apparatus which meets the hygienic requirements of the food industry. However, neither aspect can be retained in the definition of the problem to be solved, since the claimed apparatus cannot be considered more compact than that disclosed in D6. The hygienic requirements of the food industry cannot be retained in the definition either, because the claimed apparatus is not specific to the food industry. Hence, the problem had to be reformulated "in less ambitious terms" as the provision of an alternative tunnel apparatus for gas treatment of products which is easy to maintain (due to at least one vertical part of the walls forming the high-pressure chamber being removable, addition by this Enlarged Board). The proposed solution is trivial, because it was common general knowledge that an apparatus which has to be cleaned or serviced must have sufficient access facilities for carrying out the necessary maintenance and cleaning on the sensitive parts located in the interior of the machine. The board refers furthermore to document D1, which discloses a food freezing tunnel provided with removable vertical access panels or doors for inspections and cleaning purposes. According to the board, it follows that the subject-matter of claim 1 is obvious in view of the disclosure of document D6 taken in combination with common general

knowledge, or alternatively in combination with the teaching of document D1.

VIII. On 2 July 2012 the petitioner filed a reasoned petition for review against that decision. The fee for the petition was paid on the same day. The petitioner argued essentially as follows:

1. In the oral proceedings before the board the petitioner's right to be heard was violated. The written decision to revoke the patent was based on D6 as the closest prior art. However, in the oral proceedings the petitioner never had the opportunity to be heard concerning the proper choice of the closest prior art. The board began the oral proceedings by stating that for reasons of procedural economy they wanted to discuss novelty and inventive step in view of D7. The rapporteur then pointed to several passages of D7 and stated that the patent in suit at best had a difference in that its claim stated separate walls whereas D7 only disclosed a separate wall. In the previous proceedings no-one had read the disclosure of D7 in the way the rapporteur presented it during the oral proceedings. As was apparent from the written decision, the rapporteur ultimately also realised that this was not a relevant or proper interpretation of the D7 disclosure. In the oral proceedings, the petitioner had to respond to this new line of argument and presented its arguments as to why the invention was novel and involved an inventive step in view of D7 as the closest prior art and considered in combination with common general knowledge. The petitioner also presented its arguments relating to D7 in combination with the European standard concerning cleaning of

apparatuses, D7 in combination with D1 and D7 in combination with D6. As a result of the board aggressively pursuing its line of argument based on D7 throughout the oral proceedings, the proper choice of the closest prior art was never questioned or discussed. The opponent/appellant had simply leaned back and followed the line of reasoning of the board. Had the board conducted the oral proceedings in accordance with a normal procedure, namely by allowing the opponent/appellant to present its case and the proprietor to present counter-arguments, all the relevant issues would have been discussed. Especially the issue of whether D6 was the closest prior art would undoubtedly have been discussed, considering that in the written submissions the opponent/appellant had argued in favour of D6 as the closest prior art.

2. During the oral proceedings before the board the technical disclosure of D6 was discussed briefly. The petitioner identified and explained four features of claim 1 which were not disclosed in D6. After these explanations from the petitioner the rapporteur returned to D7. It was never mentioned by the board that D6 should be considered the closest prior art. The board did not at any point during the oral proceedings indicate that they had any doubt concerning the use of D7 as the closest prior art. It was therefore the petitioner's impression that the petitioner's arguments relating to the differences between D6 and claim 1 had convinced the board that D7 was the closest prior art.

3. The situation in the present case was similar to that decided upon in decision R 3/10. In that case the board managed the case in a manner that made the

representative argue for novelty, and then the patent was revoked based on lack of inventive step, an issue that was never discussed orally. Similarly, in the present situation the case was managed in such manner that the petitioner had to defend its patent on one ground while the patent was revoked on a second, totally different ground that was never discussed in the oral proceedings. In the cited decision it was also emphasised that the fact that an issue may have been presented in the written submissions is irrelevant when it comes to the right to be heard orally under Article 113 EPC. To satisfy that right, a party must be given an opportunity to make an oral presentation of its arguments. The parties must be given the opportunity to discuss issues including controversial and crucial ones.

4. Furthermore, the board mentioned for the first time in the decision arguments as to why it believed D6, rather than D7, was the closest prior art. In this respect, it raised a completely new fact in the written decision by stating that claim 1 related to gas treatment of products in general and was not limited to food products.

5. Since the petitioner only learnt from the written decision that it was based on a ground that had not been discussed in the oral proceedings, there was no possibility for it to raise an objection under Rule 106 EPC during the proceedings before the board.

IX. The petitioner requested that the decision by the technical board of appeal be set aside, that the

proceedings before the board of appeal be re-opened and that the fee for petition be reimbursed;

oral proceedings were requested in case the Enlarged Board of Appeal considered not granting the above requests.

X. In a communication of 19 April 2013 accompanying the summons to oral proceedings the Enlarged Board of Appeal gave the petitioner its preliminary opinion on the case. In particular, the Enlarged Board pointed out that for the question of whether the petitioner's right to be heard was violated it was not relevant as such whether the issue of D6 as the closest prior art was discussed. What mattered was whether the petitioner had the opportunity to present its arguments on the issue orally. There was nothing on file indicating that in the oral proceedings the petitioner could not have presented its arguments relating to why D6 was not to be considered the closest prior art. Furthermore, as regards the petitioner's complaint about the board's finding (in point 2.3 of the reasons for the decision) that claim 1 of the patent in suit related to gas treatment of products in general and was not limited to food products, that view appeared to have been expressed in the proceedings by the petitioner itself, see e.g. page 27, first para. of the petitioner's response to the grounds of appeal.

XI. By letter dated 6 May 2013, the petitioner requested postponement of the oral proceedings to a later date. The reason given was that Mr Plesner, one of the petitioner's representatives who had attended the oral proceedings before the board, was unable to attend the

oral proceedings before the Enlarged Board on the date set due to other commitments before and after that date.

- XII. By communication dated 14 May 2013 the Enlarged Board's Registrar informed the petitioner that the Enlarged Board had decided not to allow that request.

No serious reasons which would justify the fixing of a new date had been put forward. Furthermore, there appeared to be ample time before the date set for the oral proceedings for another representative to take over the case.

- XIII. On 17 June 2013 the petitioner filed a statement by Mr Plesner concerning the course of the oral proceedings before the board.

- XIV. Oral proceedings were held before the Enlarged Board on 19 July 2013. In these oral proceedings the petitioner clarified that it did not contend that it could not have presented its view as to why D6 was not the closest prior art. However, as a result of the board's conduct of the oral proceedings it was under the impression that the rapporteur and the chairman had already made up their minds that D7 was the closest prior art. Considering that the appellant had also simply followed the line of reasoning based on D7 as the closest prior art, the petitioner's representative considered that it was unnecessary and that it would even be unreasonable for him to comment on D6 as the closest prior art or to ask whether he should do so. At the end of the oral proceedings the Enlarged Board announced its decision to dismiss the petition as clearly unallowable.

Reasons for the Decision

Petitioner's request for postponement of the oral proceedings before the Enlarged Board.

- 1.1 As the reasons for requesting postponement of the oral proceedings scheduled for 19 July 2013 the petitioner had indicated that Mr Plesner, one of the petitioner's representatives who had attended the oral proceedings before the board, would only return on 16 July 2013 from a long-planned private trip. Thereafter he would face severe jet-lag. Due to a planned birthday party on the 20th he would have to travel to his country cottage on the 18th since he would have friends staying overnight to celebrate with him on the 20th. They also had opera tickets for that day.

- 1.2 As the Enlarged Board communicated to the petitioner via its Registrar, no serious reasons which would have justified the fixing of a new date for oral proceedings could be seen in the reasons advanced. The petitioner's attention was drawn to the Notice of the Vice-President of Directorate-General 3 of the EPO dated 16 July 2007 concerning oral proceedings before the boards of appeal (see Special Edition No. 3, OJ EPO 2007, 115). That Notice mentions as an example of a serious reason holidays which have been firmly booked before the notification of the summons to oral proceedings. However, Mr Plesner's holiday already ended on 16 July 2013. Mr Plesner's planned birthday party on 20 July could not be regarded as being a serious reason which would have justified the postponing of the oral

proceedings to a later date. In the interest of legal certainty petitions for review should be dealt with expeditiously (R 18/09 of 27 September 2010, point 21 of the Reasons). Postponement of oral proceedings before the Enlarged Board is likely to lead to considerable delay, due to the commitments of the members of the Enlarged Board.

Admissibility of the petition

2.1 The impugned decision was notified to the petitioner on 2 May 2012. The reasoned petition was filed on 2 July 2012. The fee for the petition was paid on the same day. These acts were performed in time. There is also no doubt that the reasoning indicates the grounds for the petition in a sufficiently substantiated manner. Since the patent was revoked, the petitioner is also adversely affected by the decision.

2.2 The petition is based on the ground that the petitioner's right to be heard in the oral proceedings was violated by the fact that the board, in the oral discussion, pursued a line of argument based on D7 as the closest prior art and did not give the petitioner an opportunity to comment on the ground on which the revocation of the patent was based in the written decision, i.e. that D6 was taken as the closest prior art. Furthermore, in the reasons for the decision a new definition of the breadth of claim 1 and of the problem to be solved had been given which the board had not previously presented to the petitioner.

2.3 On the basis of these submissions it can be accepted for the purpose of the present decision that the

petitioner was not in a position to raise an objection under Rule 106 EPC during the appeal proceedings. The petition is therefore not regarded as clearly inadmissible.

Allowability of the petition

It is, however, clearly unallowable.

3.1 The petitioner does not deny that apart from the discussion on the alleged prior use, which was not acknowledged by either the opposition division or the board of appeal, the written discussion between the parties focused on the issue of whether D6 or D7 constituted the closest state of the art, ever since the introduction of these documents into the opposition proceedings. The appellant's position was that D6 was, if not novelty-destroying, then at least to be regarded as the closest written prior art, claim 1 at best being distinguished from D6 by one feature (see V above). The opposed patent did not involve an inventive step in the light of D6 when taken in combination with common general knowledge or alternatively with the documents on file, in particular D7 or D1. The petitioner, by contrast, took the view that D7 represented the closest prior art.

3.2 By the impugned decision the petitioner's patent was revoked for lack of inventive step in view of document D6, in combination with common general knowledge and/or document D1. The board held D6 to represent the closest state of the art. According to the petitioner its right to be heard in the oral proceedings was violated in a fundamental manner. During the oral proceedings it was

not discussed whether D6 should be considered the closest prior art. The manner in which, during the oral proceedings, the board focused ("aggressively", as the petitioner terms it) on there being no real difference between the patent in suit and the disclosure of D7 and the manner in which the board conducted the oral proceedings made its representative believe that the rapporteur and the chairman had already made up their minds that D7 was the closest prior art. Since in its pleadings the appellant had also simply followed the board's line of argumentation based on D7, the petitioner's representative had found that it was unnecessary and that it would even be unreasonable to argue why D6 was not the closest prior art or to ask the board whether he should comment on the issue.

3.3 The petitioner explicitly acknowledges that the technical disclosure of D6 was discussed in the oral proceedings. The petitioner terms it a "brief" discussion but it also set out in the oral proceedings before the Enlarged Board that the explanations it gave in the oral proceedings concerned four features of claim 1, which in its view were not disclosed in D6. Furthermore, inventive step of claim 1 was also discussed as such by the petitioner in the light of various combinations of documents including D6 on the basis of D7 as the closest state of the art.

3.4 In its communication accompanying the summons to oral proceedings, the board did not express any preliminary view on the written state of the art. It was therefore clear from the file as it stood that during the oral proceedings the petitioner should expect to have to address the appellant's arguments with regard to the

alleged lack of inventive step based on D6 as the closest prior art.

3.5 The petitioner does not deny this. It does, however, say that, as a result of the board starting the discussion with D7 as the closest prior art, the rapporteur then stating that between D7 and the patent in suit there was at best a difference in one feature, the petitioner then showing four features in D6 which differed from claim 1, and the rapporteur thereupon returning to D7 as the closest prior art, he had been led to believe that the board had accepted the petitioner's view on the differences between D6 and claim 1 and had in their own minds already decided that D7 was the closest prior art.

3.6 The Enlarged Board finds these explanations insufficient to demonstrate that, on an objective basis, the petitioner had good reason to conclude that the board had ruled out D6 as the closest prior art and had made up their minds to consider D7 as the closest prior art. The petitioner did not contend that the board actually said that at any time during the oral proceedings, but the petitioner came to its conclusion on the basis of the circumstances as it presented them. However, the fact that the board wanted to discuss D7 first "for reasons of procedural economy" may have had other reasons. It does not imply that the board had already decided in their own minds to regard D7 as the closest prior art. The reason for so proceeding could for example have been the fact that the opposition division had taken its decision on the basis of D7 as the closest prior art and had acknowledged inventive step, and that the board wished to ascertain first

whether this finding was valid or had to be reversed. Furthermore, on an objective basis, the mere fact that, after the petitioner had set out four differences between D6 and claim 1, the rapporteur "returned" to D7, could not be taken to mean that the rapporteur, let alone the board as a whole, were convinced by the petitioner's submissions on the differences between D6 and claim 1 and that, therefore, they had already made up their minds that D6 was not the closest prior art.

3.7 The mere fact that in oral proceedings the members of a board may themselves have actively introduced into the discussion only certain aspects of the case, such as here the importance of D7 as a starting point for the evaluation of inventive step, does not relieve a party from dealing with the arguments raised by the other party. This at least is the case until the board clearly indicates that it regards those arguments as not convincing. The petitioner did not contend that a statement to that effect was made by the board in the present case.

3.8 The written submissions of the parties determine in the first place what the case is about. These submissions also determine what has to be addressed by a party wishing to defend its case orally. It is for that party to make such submissions of its own initiative when it has the floor on a particular issue, rather than waiting for an express invitation by the board to comment on each and every detail of it (see R 17/11 of 19 March 2012, point 19 of the Reasons).

3.9 There is nothing on file to suggest that the petitioner would have had good reason to think that the appellant

did not maintain the position taken in its written submissions throughout the proceedings that D6 constituted the closest written prior art. Even if, as the petitioner submits, in the oral proceedings before the board, the appellant followed the line of reasoning of the board with respect to D7, that cannot be taken to mean that the appellant thereby abandoned its written submissions based on D6 as the closest prior art. When it comes to determining what a party wishing to defend its case should do in oral proceedings, it is not relevant whether the other party has addressed in the oral proceedings all the issues which it had already raised in writing. In this situation it is up to the party at least to ask whether the other party's silence on a particular issue is to be understood as meaning that the submission is not maintained.

- 3.10 The present case is not comparable to the situation underlying decision R 3/10 of 29 September 2011. In that case, the only issue discussed in the oral proceedings was novelty. Thereafter the debate was closed and the patent was revoked for lack of inventive step. The decisive factor for setting the impugned decision aside was that the statement by the chairman at the commencement of the debate that the issue of patentability would turn on both novelty and inventive step could not, on an objective view, be understood as meaning that novelty and inventive step were to be discussed and decided together. The party therefore, understandably, thought that there would be an opportunity later on to address the board on inventive step (see points 2.5 and 2.6 of the Reasons) and, hence, had no reason to address inventive step in the context of the discussion on novelty.

3.11 As set out above, the circumstances relied on by the petitioner in the present case were not such that, on an objective view, they justified the petitioner concluding that the board had accepted the petitioner's view on the differences between claim 1 and D6 and that they had already decided "in their minds" that D7 was the closest prior art.

3.12 In the oral proceedings before the Enlarged Board, the petitioner did not maintain its original complaint that the board had found for the first time in the impugned decision that claim 1 of the patent related to gas treatment of products in general and was not limited to food products, thereby entailing the board's redefinition of the problem solved. This was presumably in reaction to the Enlarged Board's comments on this issue in its communication (see X above).

3.13 Hence, the only complaint which could still be seen to remain is that the petitioner's right to be heard was violated because the board did not indicate to the petitioner in the oral proceedings that it was minded to regard D6 as the closest prior art, in accordance with the written submissions of the appellant.

It is, however, established case law of the Enlarged Board that a party has no right to be told in advance how the board of appeal will decide on the arguments put forward by the party. In order for the decision to comply with Article 113 EPC it is sufficient that the party concerned had an adequate opportunity to present its point of view to the board before a decision is taken, that the board considers the arguments presented

by the party and that the decision is based on a line of reasoning that can be said to have been in the proceedings, either as a result of having been submitted by a party, as in the present case, or as raised by the board (see R 4/11 of 16 April 2012, point 2.5 of the Reasons, with reference to further case law).

3.14 For these reasons the petition has to be rejected as clearly unallowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk