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**Datasheet for the decision
of the Enlarged Board of Appeal
of 15 November 2013**

Case Number: R 0016/12
Appeal Number: T 1625/09 - 3.4.01
Application Number: 99932677.0
Publication Number: 1095282
IPC: G01R 1/073
Language of the proceedings: EN
Title of invention:
Multi-point probe
Patent Proprietor:
Capres A/S
Opponents:
SmartTip BV
Octrolix B.V.
Headword:
-

Relevant legal provisions:

EPC Art. 56, 83, 100(a), 100(b), 100(c), 112a(1), 112a(2),
112a(2)(c), 112a(4), 113(1), 123(3)
EPC R. 106, 107, 107(2)

Keyword:

"Petition for review clearly inadmissible (no)"
"Petition for review clearly unallowable (yes)"
"Fundamental violation of the right to be heard (no)"
"New complaint not admitted"

Decisions cited:

R 0001/08, R 0004/08, R 0005/08, R 0004/12

Catchword:

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Board of Appeal

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Case Number: R 0016/12

D E C I S I O N
of the Enlarged Board of Appeal
of 15 November 2013

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Decision under review: **Decision of the Technical Board of Appeal**
3.4.01 of the European Patent Office of
7 May 2012.

Composition of the Board:

Chairman: W. van der Eijk
Members: I. Beckedorf
D. H. Rees

Summary of Facts and Submissions

- I. The patent proprietor (hereinafter: the petitioner) petitions against the decision of the Technical Board of Appeal 3.4.01 (hereafter: the Board) of 7 May 2012 setting aside the decision of the Opposition Division and revoking European Patent N° 1 095 282.
- II. In opposition proceedings, the Opposition Division had rejected the oppositions of both opponents. Its decision had been based on grounds of the oppositions according to Article 100(a) and (b) EPC. The opponents' subsequent requests to amend the minutes and/or the reasons of the decision to the effect that the ground of opposition according to Article 100(c) EPC had been raised additionally were refused by the Opposition Division.
- III. In appeal proceedings, the Board, when summoning to oral proceedings, informed the parties to the appeal of its preliminary opinion on the grounds of opposition pursuant to Article 100(a), (b) and (c) EPC, the last in particular concerning the question of whether it had been raised and considered during the opposition proceedings. The petitioner objected to this ground of opposition being admitted into the appeal proceedings.
- IV. The Board based its decision in essence on the lack of sufficient disclosure (Article 100(b) EPC, Reasons point 2.5) and found,

"that the problem of improving the measuring accuracy ... for a multi-point probe for testing electric properties on a specific location of a test sample cannot be

solved with a testing probe as claimed by claim 1 and illustrated in the sole embodiment of the patent in suit, which probe has a second multitude of conductive electrodes especially being suitable for active guarding in the claimed arrangement.

Therefore, the Board concludes that neither conventional knowledge nor technical information provided by the patent in suit ... enable a skilled person to successfully put the claimed invention into practice."

The 15 auxiliary requests filed by the petitioner after oral proceedings had been summoned were not admitted into the proceedings in accordance with Article 13(1) RPBA because they were found either not to overcome the objection under Article 100(b) EPC or to contravene Article 123(3) EPC.

- V. With letter of 7 September 2012 the petitioner filed a reasoned petition for review. The petitioner claims a fundamental infringement of its right to be heard and essentially argues that the sufficiency of disclosure (Articles 100(b) and 83 EPC) had been the only issue discussed during the oral proceedings before the Board. However, the arguments discussed, involving the so-called problem-solution-approach, related rather to an assessment of inventive step (Articles 100(a) and 56 EPC) but the petitioner had been denied the opportunity to present its arguments for the fulfilment of Article 56 EPC. The reasons for the decision under review, in particular points 2.2 to 2.4, made it apparent that the Board included essential parts of an inventive step assessment, which belongs to a fundamentally different ground for opposition (i.e.

Article 100(a) EPC) on which it had not been heard and in relation with which it had had no opportunity to submit new requests.

Since the oral proceedings began with an assessment of sufficiency of disclosure, it became apparent only after the negative decision on this ground that inventive step, being the key ground for revoking the patent, would not be discussed.

- VI. In an annex to the summons to oral proceedings, the Enlarged Board informed the petitioner of its provisional opinion concerning both the admissibility and the allowability of the petition.
- VII. In its reply the petitioner submitted that it had had no opportunity to submit an objection under Rule 106 EPC because it became aware of the alleged procedural violation only after the conclusion of the oral proceedings that were closed "abruptly" right after its request to present additional arguments and requests in support of fulfilment of Article 56 EPC had been denied.

In respect of the allowability issue, the petitioner puts forward two lines of arguments: Firstly, a patent proprietor must be allowed a formal opportunity to present comments on a ground for opposition on which a decision is based. It must know which grounds for opposition the decision is to be based on. If a decision is based on several grounds for opposition, then this must be explicitly stated during the oral proceedings. Secondly, if a patent proprietor explicitly requests to discuss a particular ground for opposition, then it should be allowed to do so.

VIII. Oral proceedings were held before the Enlarged Board on 15 November 2013. In these oral proceedings, the petitioner clarified that the petition was directed against an alleged discrepancy between the discussion during the oral proceedings before the Board, focussed on the ground for opposition according to Article 100(b) EPC, and the Board's written decision essentially based on the ground for opposition according to Article 100(a) EPC.

The petitioner submitted that it had asked the Board twice for an opportunity to discuss the issue of inventive step, and on the second occasion it had also asked to be allowed to file a new request, but these requests had been refused. On no occasion did it raise an objection under Rule 106 EPC because, after the first refusal, it still expected that the discussions on Article 100(b) EPC were to be followed by a debate on Article 100(a) EPC. After the second refusal, it was too late to raise an objection because the oral proceedings were abruptly closed.

In respect of the allowability of the petition, the petitioner argued that a patent proprietor should be allowed to discuss any particular ground for opposition it requests. However, the petitioner could not cite any case law supporting this view. It clarified that, at the oral proceedings, the first member of the Board raised all the issues dealt with in the decision under review. However, contrary to the submission in the notice of petition (section A) and as a result of subsequent consideration, the petitioner put forward that the issue of the "measurement accuracy" (Reasons,

point 2.4) was not discussed at the oral proceedings; rather the discussion had been based on reduction of current leakage.

IX. The petitioner requested,

that the decision under review be set aside and that the proceedings before the Board of Appeal be re-opened.

Reasons for the decision

1. *Identity of the petitioner*

The petition for review had been filed in the name of "Capres A/S", thus not congruent with the patent proprietor's registered name "Capres APS". However, the petitioner has proven the change of its legal form by filing a printout from the Danish commerce and companies Agency. Considering this clarification of its company name and form, there is no doubt as to petitioner's legal identity and party status.

2. *Scope of the petition*

The present petition for review is built on the allegation that the appeal proceedings leading to the decision under review involved a fundamental infringement of the petitioner's right to be heard (Articles 112a(2)(c) and 113(1) EPC) in that the Board based its decision only formally on the ground for opposition according to Articles 100(b) and 83 EPC (insufficiency of disclosure of the invention) whereas

actually it was focussed on the distinct ground for opposition according to Articles 100(a) and 56 EPC (lack of inventive step). The latter had not been discussed during the oral proceedings before the Board and in relation to which the petitioner had not been given the opportunity to argue on and to file new requests.

3. *Admissibility of the petition for review*

3.1 The petitioner is adversely affected by the decision under review pursuant to Article 112a(1) EPC. The petition for review was filed within the time-limit according to Article 112a(4) EPC on the ground referred to in Article 112a(2)(c) EPC and in accordance with Rule 107 EPC.

3.2 Rule 106 EPC provides that a petition under Article 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

In its decision R 4/08 of 20 March 2009 the Enlarged Board considered in detail the meaning to be given to the admissibility requirement in Rule 106 EPC that an objection in respect of the procedural defect must have been raised during the appeal proceedings. In that decision the wording and nature and purpose of the requirement to raise such an objection were all considered. In point 2.1 of the Reasons of the decision the Enlarged Board concluded:

"Firstly, the objection must be expressed by the party in such a form that the Board of Appeal is able to recognize immediately and without doubt that an objection pursuant to Rule 106 EPC - that is one which is additional to and distinct from other statements, in particular arguing or even protesting against the conduct of the proceedings or against an individual procedural finding ... - is intended by the party concerned. This is a precondition for the Board to have been able to react immediately and appropriately by either removing the course of the objection or, as provided in Rule 106 EPC, by dismissing it. It therefore ensures for the parties and the public at large, legal certainty as to whether the substantive decision of the Board of Appeal is open to review pursuant to Article 112(a) EPC. This is one of the evident purposes of the obligation to raise objections under Rule 106 EPC.

Secondly, for the same reasons the objection must be specific, that is the party must indicate unambiguously which particular defect of those listed in paragraph 2 (a) to (c) of Article 112a and Rule 104 EPC it intends to rely on."

The principles developed in that decision have thereafter become established jurisprudence of the Enlarged Board and have been applied in numerous cases since (see: Case Law of the Boards of Appeal, 7th edition 2013, chap. IV.E.9.2.5, p. 1067 et seq.).

- 3.3 It is uncontested that the petitioner did not raise any formal objection. The petitioner explicitly acknowledged during the oral proceedings before the

Enlarged Board that its two (*sic!*) requests to submit arguments on inventive step and to file new claims addressing this issue had been refused by the Board, but that it failed to formally raise an objection under Rule 106 EPC.

3.4 Although the petitioner's submissions in this respect do not clearly explain why the petitioner did not protest already against the Board's first refusal, the Enlarged Board supposes that it was the petitioner's assumption that, despite the Board's first refusal, the discussion on sufficiency of disclosure were to be followed by a discussion on inventive step, thus making an objection superfluous. In addition to this, the Enlarged Board takes note of the petitioner's assertion that, before the oral proceedings were concluded, it had not sufficient time to raise an objection to the Board's second refusal concerning both the petitioner's repeated request to discuss inventive step and its first request to be allowed to file new requests.

3.5 The Enlarged Board has grave doubts whether an unjustified assumption (see the discussion of allowability below) or an allegedly abrupt end to the oral proceedings are sufficient to make the petition admissible. However, to the benefit of the petitioner, and especially in view of the conclusions on allowability below, the petition is accepted as not clearly inadmissible.

4. *Allowability of the petition for review*

It is, however, clearly unallowable.

4.1 The petitioner invokes Article 112a(2)(c) EPC as the ground for petition for review. It submits that the Board decided on the appeal in a manner that gave the petitioner no opportunity to present its comments and to file new requests in view of the issue of inventive step, in violation of Article 113(1) EPC.

4.2 Against this, it has to be born in mind that review proceedings under Article 112a(2)(c) EPC are confined to procedural defects so fundamental as to be intolerable for the legal system and overriding the principle that proceedings which have led to a final decision should not be re-opened in the interest of legal certainty and that substantive issues are excluded (consistent case law since R 1/08 of 15 July 2008, Reasons point 2.1, and the *travaux préparatoires* there cited).

4.3 The petitioner has put forward two lines of arguments, first, that a patent proprietor should be allowed to discuss any particular ground for opposition it requests, here to discuss inventive step despite the fact that the Board started with the issue of sufficiency of disclosure and was able to come to a decision based on that ground alone (see below point 4.3.1), and, second, that the Board wrongly based its decision formally on the aspect of sufficiency of disclosure (see below points 4.3.2 to 4.3.4).

- 4.3.1 The Enlarged Board cannot follow the petitioner's first argument. Neither the EPC nor the Rules of Procedure of the Boards of Appeal provide any legal basis for such a general approach in favour (only) of a patent proprietor as a party to appeal.

Such an entitlement is not supported by the principle of party disposition. That principle relates merely to the parties' right to dispose of their requests by advancing, withholding or withdrawing them as they see fit.

More relevant to the present case is another principle of appeal proceedings, *i.e.* the principle of efficiency, requiring a Board of Appeal to focus on those points that are relevant for the decision. Since the Board considered that the case could be decided in respect of the issue of sufficiency of disclosure as *ratio decidendi*, discussing any other ground would have concerned an issue that did not form a necessary part of the Board's final decision (*orbiter dictum*).

- 4.3.2 As regards the petitioner's second argument, the Enlarged Board notes that the facts of the case, as taken from the decision under review, show that the Board was well aware of the petitioner's arguments in respect of the issue of whether the technical features of claim 1 of the patent as granted could be carried out by a person skilled in the art (see: Facts and Submissions, points VII. and IX.). The Board, in particular, referred to the petitioner's argument concerning the disclosure of feature (d) of claim 1 and its opinion that this feature "*allowed for active guarding of the probe arms and thus solved the*

objective technical problem of achieving a reduction of the current leakage from probe arms." The parties' arguments were then in detail considered by the Board under the aspect of sufficiency of disclosure (Article 100(b) EPC) that finally was held not to be fulfilled (see: Reasons for the decision under review, points 2 et seq.).

Thus, in the decision under review the Board extensively recapped and discussed the (key) arguments and objections put forward by the (appellants) opponents and, likewise, the (key) arguments submitted by the petitioner both in the written proceedings and during the oral proceedings.

- 4.3.3 Although the petitioner argues that it had not been given an opportunity to state its case on the question of whether the subject-matter of claim 1 of the patent as granted involved an inventive step and that the decision under review was to be understood as being based on this aspect, it is to be noted from the aforementioned facts that the Board took its decision solely on the basis of the arguments submitted by and discussed with the parties.

The petitioner, in its petition for review and, once again, during the oral proceedings before the Enlarged Board, does not claim that the decision under review was guided by any other (i.e. not discussed) matters and arguments. What the petitioner essentially raises, thus, is not so much an allegation that the Board did not allow the submission of arguments on matters that were then considered by the Board in reaching its conclusion, but that the submitted arguments were

wrongly "categorized" or "subsumed" under the ground of opposition according to Articles 100(b) and 83 EPC instead of Articles 100(a) and 56 EPC.

- 4.3.4 Hence, it is to be understood from the petitioner's submissions that it considers that the alleged application of the wrong legal basis in the substantive law (Articles 100(a), 56 EPC instead of Articles 100(b), 83 EPC) should be judged to be a fundamental procedural violation.

However, even if the Board was wrong in qualifying the parties' arguments under the ground for opposition according to Article 100(b) EPC such a legal error relating to the substantial law is not a ground for a petition for review as exclusively provided for in Article 112a(2) EPC.

- 4.4 Finally, as far as the petitioner invoked a further (new) allegation during the oral proceedings before the Enlarged Board, namely that the Board did not discuss the issue of the "measurement accuracy" (see: Reasons of the decision under review, point 2.4, last paragraph, p. 13) with the parties to the appeal at the oral proceedings, this late allegation cannot be admitted into the petition for review proceedings for the following reasons.

- 4.4.1 First, the petitioner's oral submission is clearly contrary to its explicit written submission (petition for review, point A, p. 2/4 bottom and 3/4 top):

"The concluding remarks of the first member in the oral proceedings, are reflected in 2.4 last paragraph..

At this point in the oral proceedings, the patent proprietor explained that the reasoning by the first member relates to an assessment of inventive step rather than sufficiency of disclosure. The Board of Appeal did not respond factually to the statement. The proprietor also asked to be allowed to present arguments for the fulfilment of Article 56 EPC, which was denied.

The oral proceedings continued..."

With this, the petitioner explicitly acknowledges that a discussion at the oral proceedings also covered the aspect of the measurement accuracy. It has offered no explanation why this acknowledgement did not reflect the true events at the oral proceedings before the Board. A mere change in its "subsequent consideration" *eo ipso* does not suffice as convincing justification.

- 4.4.2 Secondly, it follows from Rule 107(2) EPC that a petition must be sufficient for the petitioner's case to be properly understood on an objective basis and must be so presented as to enable the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect which can be the subject of an objection under the provisions on review (see: R 5/08 of 5 February 2009, where the petition was held inadmissible). An entirely new complaint, such as the one that the petitioner submitted for the first time during the oral proceedings before the Enlarged Board, which had not been raised in the petition for review, has no bearing whatsoever on the findings as to the petition's admissibility and merits reached on the basis of the grounds, facts, arguments and evidence set

out in the petition (see: R 4/12 of 20 December 2012, Reasons, point 16).

- 4.5 Thus, there is no doubt that the petitioner had been given the opportunity to state its case in respect of all the issues on which the decision under review was taken.

Considering that the petitioner was legally represented and, therefore, should have been familiar with the appeal proceedings, the petitioner was in a position to defend its rights both as to the procedural and as to the substantive law. The petitioner was not objectively hindered from submitting all the arguments it wished to bring to the Board's attention or even from filing new requests. The fact that the Board did not admit into the appeal proceedings the 15 auxiliary requests filed by the petitioner on 4 April 2012 cannot be qualified as a (formal) refusal to receive and examine any additional request(s) that actually were not but could have been filed during the oral proceedings.

In view of the preliminary opinion expressed by the Board in its annex to the summons to oral proceedings and of the discussion during the oral proceedings, it was a pressing task for the petitioner itself to address the issues that were put up for discussion by the Board, regardless of whether these issues were qualified as a ground of opposition under Article 100(a) or (b) EPC, both grounds of opposition being a subject-matter of the appeal proceedings; and according to the decision under appeal referring to such arguments, the petitioner did so.

Furthermore, if the petitioner thought it could overcome the objections made by the opponents and the Board by filing new requests it had the opportunity to do so, again regardless of whether these objections were qualified as a ground of opposition under Article 100(a) or (b) EPC.

4.6 Consequently, there is no basis for concluding that the petitioner did not have sufficient opportunity to comment exhaustively on all aspects on which the decision was taken. Therefore no violation of Article 113(1) EPC was committed by the Board.

4.7 Investigating any further would involve assessing whether the Board had correctly understood the argumentation submitted by the parties to the appeal proceedings and, above all, given the right answer to it. The (mere) fact that the petitioner does not share the view of the Board and does not accept the outcome of the decision under review would be a matter for a review of the merits of the decision, but such a review of the merits is not a means of redress provided for in the EPC.

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

Order

For these reasons it is unanimously decided that:

The petition is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk