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**Datasheet for the decision
of the Enlarged Board of Appeal
of 17 June 2013**

Case Number: R 0001/13

Appeal Number: T 0808/11 - 3.5.03

Application Number: 97113024.0

Publication Number: 822672

IPC: H04B 7/005, H04B 7/216

Language of the proceedings: EN

Title of invention:

Downlink transmission power control scheme for mobile communication system using site diversity

Patent Proprietor:

NTT DoCoMo, Inc.

Opponent:

Nokia Corporation

Headword:

Petition for review/NTT

Relevant legal provisions:

EPC Art. 112a(2)c, 113(1)
EPC R. 106, 107(1) (a)
RPBA Art. 13(1) (2), 15(4) (5) (6), 19(1)

Keyword:

"No right of admissibility for requests filed to overcome late-raised objections"

"Article 113(1) EPC does not overrule Article 13(1) RPBA in the case of such requests"

"Remark made during oral proceedings by one member of board of appeal (here, the chairman) has no determinative effect"

"Petitioner's subjective surprise at board of appeal decision is not relevant to objective review of that decision"

"Petition for review - clearly unallowable"

Decisions cited:

R 0002/08, R 0004/08, R 0011/08, R 0012/09, R 0003/10,
R 0015/10, R 0006/11, R 0009/11, R 0013/11

Catchword:

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Case Number: R 0001/13

DECISION
of the Enlarged Board of Appeal
of 17 June 2013

Petitioner: NTT DoCoMo, Inc.
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Decision under review: **Decision of the Technical Board of Appeal
3.5.03 of the European Patent Office of
18 September 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: C. Rennie-Smith
P. Gryczka

Summary of Facts and Submissions

- I. The petition for review concerns the decision T 808/11 of the Technical Board of Appeal 3.5.03 of 18 September 2012 to dismiss the petitioner's appeal against the interlocutory decision of the Opposition Division to maintain European patent No. 0822672 in amended form. The petitioner and patent proprietor filed the petition by fax on 28 December 2012 and paid the petition fee on the same date. The petition is based only on the ground in Article 112a(2)(c) EPC, namely that a fundamental violation of Article 113 EPC occurred in the appeal proceedings. The alleged fundamental violation is the decision of the Board of Appeal not to admit the petitioner's new third and fourth auxiliary requests ("the new requests") into the proceedings and to dismiss the appeal immediately after announcing that.
- II. The patent in suit is entitled "Downlink transmission power control scheme for mobile communication system using site diversity". The opposition division held that claim 1 of both the patent as granted and of the second auxiliary request before it lacked novelty over document O1 (EP-A-0645940), that the first auxiliary request was inadmissible, but maintained the patent on the basis of the third auxiliary request before it.
- III. The petitioner appealed and filed a main and five auxiliary requests with its statement of grounds of appeal. The subsequent appeal proceedings, to the extent relevant to the petition proceedings, can be summarized as follows.

1. A preliminary opinion of the Board of Appeal was sent with the summons to oral proceedings issued on 26 March 2012. With reference to the auxiliary requests, the Board stated in point 4.2 of the opinion that:

"It will need to be discussed whether any of the requests comply with Article 123(2) and/or Article 84 EPC".

Although the Board made some detailed comments in respect of Article 123 EPC, no specific objection was made with respect to Article 84 EPC. Point 9.1 of the preliminary opinion read:

"The parties' attention is drawn to Article 13 RPBA... relating to amendment to a party's case. If amended claims are filed by the appellant, it will be necessary at the oral proceedings to discuss their admissibility and, if these claims are held admissible, to discuss the question of whether or not the amendments, the claims and their subject-matter comply with the requirements of the EPC, in particular Articles 123(2) and (3), 83, 84 and 52(1) EPC, respectively (cf. Article 101(3) EPC)."

2. In reply the petitioner filed on 8 August 2012 a new main and six new auxiliary requests as an attempt to overcome the objections raised. In its reply of 21 October 2011 to the statement of grounds of appeal, the opponent (respondent in the appeal proceedings) had also not made any specific clarity objections regarding the previous auxiliary requests and in particular raised no objection under Article 84 EPC with reference

to the term "site diversity period". Thus the petitioner asserted that, in the absence of any objection from either the Board or the respondent, it had relied on the fact that the term "site diversity period" was in accordance with Article 84 EPC.

3. Oral proceedings before the Board of Appeal were held on 18 September 2012. Following a discussion of the invention and the disclosure of document 01, claim 1 of both the main and first auxiliary requests was not allowed for lack of novelty over that document. Then, during the discussion of the second auxiliary request, the Board raised a new objection under Article 84 EPC that the term "site diversity period" was not clear. The petitioner filed five declarations of persons present at the oral proceedings to show that the chairman of the Board recognized that this objection was raised for the first time during the oral proceedings.

4. In response to that new objection, the petitioner filed its new third and fourth auxiliary requests. Claim 1 of the new third auxiliary request introduced an amendment to define "site diversity period" more precisely

"said site diversity period being a period characterized by the mobile station being simultaneously connected to only said two base stations"

and the new fourth auxiliary request added the further wording

"and wherein a diversity combining can be carried out among said two base stations".

The petitioner asserted that it was evident from the wording of the amendments that the new requests were filed during the oral proceedings in response to the new objection and this was also recognized by the Board (see the written decision, reasons, point 6.1, first sentence).

5. A debate on the new requests then took place. The petitioner's representative and others attending the oral proceedings on its behalf recollect that the chairman indicated at the end of the discussion that amended claim 1 appeared to be clear. The petitioner asserts that this is supported by the fact that, shortly before the debate was closed and triggered by that indication (as confirmed by two of the aforesaid declarations), its representative obtained the petitioner's authorization to agree to remittal of the case to the first instance for consideration of inventive step if the claims were found by the Board to be clear.

6. After a deliberation, the Board announced that the new requests were not admitted into the proceedings due to a *prima facie* lack of clarity, dismissed the appeal and closed the proceedings.

7. The written decision was issued on 18 October 2012. On the same date the petitioner sent a letter requesting correction of the minutes to show *inter alia* that:

"at the end of the discussion concerning the new third and fourth auxiliary requests as filed during the proceedings, the chairman indicated that the claims appeared to be clear".

In answer to an invitation from the Board of Appeal to comment on the petitioner's request, the respondent in a letter dated 12 November 2012 objected to the petitioner's proposed corrections and requested a correction to show that it had not at any time agreed to the admissibility of the petitioner's new requests. The respondent did not recall the chairman's indication that the claims of the new requests appeared to be clear but did recall that there was a detailed discussion on admissibility which had ranged across clarity, support, added matter, novelty and inventive step.

8. In a communication dated 21 November 2012 the Board of Appeal rejected both requests for correction of the minutes and noted (at point 4):

"In particular, the chairman's remark that the claims of the newly filed third and auxiliary request [sic - the word "fourth" was clearly omitted in error] appeared to be clear was made not 'at the end of the discussion concerning the new third and fourth auxiliary requests' (as formulated in the Appellant's letter dated 18 October 2012), but at the beginning of this discussion."

The petitioner maintained its position that the chairman's statement was made at the end of the discussion, accepted that it might well be the case

that it was also made at the beginning, and submitted that there was no doubt that the Board gave an indication during the oral proceedings that the newly filed claims appeared to be clear.

IV. In a communication dated 24 April 2013 the Enlarged Board informed the petitioner of its provisional opinion.

1. It noted that, as regards Rule 107(1)(a) EPC, the petition did not contain the address of the petitioner and invited the petitioner to remedy this deficiency within one month.

2. As regards admissibility of the petition and the requirements of Rule 106 EPC, the Enlarged Board noted that the discussion of the new requests at the oral proceedings before the Board of Appeal had principally concerned the question of clarity whereas the petition advanced arguments to the effect that the Board was obliged to admit, and/or had no discretion not to admit, the new requests. However, the Enlarged Board could find no reference to any such arguments having been addressed to the Board of Appeal.

3. Further, whether such arguments were in fact addressed to the Board of Appeal or not, the Enlarged Board could not find any explanation in the petition why an objection under Rule 106 EPC was not made that, by not admitting the new requests when it had to, the Board would be in contravention of Article 113(1) EPC.

4. In view of those matters, the preliminary opinion made no comment on the allowability of the petition

- although, as regards the petitioner's view that the new requests had to be held admissible, the Enlarged Board drew the petitioner's attention to decision R 9/11 of 7 December 2012.
- V. In reply the petitioner filed a faxed letter dated and transmitted on 24 May 2013 providing its address and subsequently filed written submissions in response to the Enlarged Board's preliminary opinion in a faxed letter dated and transmitted on 10 June 2013 (see section VII.11 below).
- VI. Oral proceedings before the Enlarged Board of Appeal took place on 17 June 2013 at the end of which the decision was announced. The petitioner's additional arguments submitted at the oral proceedings are summarised below (see section VII.12 below).
- VII. The petitioner's arguments in the petition, in answer to Enlarged Board's preliminary opinion and at the oral proceedings before the Enlarged Board can be summarised as follows.

Admissibility

1. Rule 106 EPC provides for an obligation to raise an objection to a procedural defect "except where such objection could not be raised during the appeal proceedings". The procedural defect - namely, the decision not to admit the new requests - was abruptly announced upon reopening the proceedings after a deliberation and followed immediately by the decision to dismiss the appeal and close the oral proceedings without any chance for the parties to intervene. Under

these circumstances, no objection under Rule 106 EPC could have been raised (see also R 10/08 of 13 March 2009, reasons, point 3).

2. Further, the decision not to admit the new requests was surprising since the Board had provided a positive opinion before closing the debate. Thus, there was no reasonable or foreseeable expectation that the Board would conclude that the requests would not be admitted, so no objection could have been raised by the petitioner. Such surprise would still be justified even assuming that the Board had given the positive indication at the beginning and not at the end of the discussion. In fact giving a positive indication at the beginning of the discussion would be reasonably interpreted by the petitioner as meaning that the Board considered the new requests likely to be allowable. In other words, a positive statement, even if made at the beginning of the discussion, was to be correctly understood as meaning that there were no doubts on admissibility. In view of such reasonable expectations, the petitioner had no reason to raise an objection against possible procedural defects which came as a surprise and contrary to the positive indication previously given.

3. Thus, the exception in Rule 106 EPC applies, since the earliest chance to raise an objection would have been after the decision was given and the debate closed, and since the actual decision could not have been reasonably expected in view of the earlier positive indication.

Allowability

4. The petitioner was faced with a late objection, a fact which is evident from the file alone and for which the declarations filed with the petition only provide further support, and the new requests were filed during the oral proceedings in response to that late objection. The amendments in those requests related clearly and solely to that objection and constituted a rightful reaction by the petitioner. Therefore the new requests ought to have been admitted into the proceedings under Article 113 EPC.

5. The right to be heard under Article 113 EPC enshrines the possibility of a full reaction to overcome any late raised objection. This right can be safeguarded only by allowing a full discussion on the merits of new requests. Such a thorough discussion can in turn only be achieved by admitting new requests filed in response to the late objection. A *prima facie* assessment based on a cursory review made to establish whether a new request is likely to overcome an objection, such as that carried out in this case, is not adequate in view of the right to a thorough discussion under Article 113 EPC of all points at issue - see R 3/10 of 29 September 2011, reasons, point 2.10:

"This right [the right to be heard] would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified" (Petitioner's insertion).

Thus not admitting the new requests offended the petitioner's right to defend its case fully and resulted in a fundamental violation of Article 113 EPC.

6. Further, Article 113 EPC overrules Article 13(1) RPBA invoked by the Board of Appeal (see the written decision, reasons, point 6.2, last sentence). The fundamental right to a thorough discussion of new requests filed in response to late objections cannot be overruled by an assessment as to the likelihood of a new request overcoming the late objection, nor can the submission of such requests be considered to be late. It follows that the Board has no discretion in respect of the admissibility of requests filed in response to new objections and that the Board's rejection of the new requests as not admissible was not justified. For this reason also the decision under review amounted to a fundamental violation of Article 113 EPC.

7. Further, according to consolidated EPO jurisprudence, *prima facie* examination is a legal assessment made available to Divisions and Boards for excluding those late filed submissions, e.g. new claims or fresh prior art, which may represent an abuse of the procedure. In the present case, the petitioner was presented with a late objection to a term not previously objected to and which it had relied on as being allowable. Responding to such an objection by filing new requests cannot represent a procedural abuse but rather follows from the legitimate right to respond to new issues. Thus a *prima facie* assessment resulting in non-admissibility is also a fundamental violation of the right to respond fully to new issues and represents a fundamental violation of Article 113 EPC.

8. Notwithstanding the above and assuming that the Board did have a discretion under Article 13(1) RPBA not to admit new requests in response to new objections, the Board exercised that discretion in an unduly restrictive manner within the provisions of that Article.

8.1. The new requests could not be considered as late filed since they were a legitimate and rightful response to a late objection. Moreover, the new subject matter did not introduce any complexity as it did not create a new case but rather represented an attempt to overcome the late raised objection.

8.2. Nor could the exercise of the Board's discretion be based on the state of the proceedings since, at that point in time, the petitioner had been presented for the first time during oral proceedings, and thus surprisingly, with a new objection to a term which had been on file since the beginning of the appeal procedure.

8.3. Nor could procedural economy justify the adverse exercise of discretion, since that would outweigh the right of the petitioner to defend its case, especially since a new objection had been presented at such a late stage.

8.4. It follows that, even if the Board did have a discretion not to admit new requests in response to a new objection under Article 13(1) RPBA, that discretion was in this case exercised so as to offend the more fundamental rights enshrined in Article 113 EPC.

9. For the above reasons the petitioner suffered a fundamental violation of its right under Article 113 EPC fully to discuss and defend its case in response to a late objection. The Board of Appeal's clarity concerns relating to the meaning of just the word "period" (not "site diversity period" as objected to at the oral proceedings) only became clear from the written decision. Had the Board admitted the new requests into the proceedings, a more thorough discussion would have taken place revealing that clarity could have been achieved by a further minor amendment, as the Board recognized in the decision (see reasons, point 5.2, last sentence, and point 6.2, first sentence). Consequently, the violation of Article 113 EPC was fundamental not only in that it deprived the petitioner of a full discussion on the merits of the new issue, but also in that it hindered the petitioner from solving the new issue in the "easy fix" manner which later became apparent from the written decision.

10. Further, the petitioner was taken by surprise by the sudden change of opinion of the Board. Based on the Board's positive indication, the petitioner could reasonably assume that any further submissions or requests were superfluous and thus it refrained, in order to behave according to indications of the Board and to avoid an unnecessary lengthening of the oral proceedings, from presenting further arguments or amendments to overcome the new objection. The petitioner was thus taken by surprise by the change of course and found itself in a situation where it could not exercise its right to defend its case properly. A

fundamental violation of Article 113 EPC occurred as a consequence.

11. In response to the Enlarged Board's preliminary opinion (see section IV above) the petitioner submitted the following arguments.

11.1. Regarding the Enlarged Board's observation that it could find no reference to the arguments that the Board of Appeal was obliged to admit, and/or had no discretion not to admit, the new requests having been addressed to the Board of Appeal, the petitioner submitted that the chairman had given an indication that the new requests were clear so the petitioner had no reason to make and was not induced to make further submissions in relation to admissibility. The position would have been different if the Board had not given any hint at all as to whether the claims were clear. It was not only common sense but expected practice to rely on and follow what the Board indicated and only develop further arguments on points where the Board had not given an indication.

11.2. No objection was raised under Rule 106 EPC that, by not admitting the new requests when it had to, the Board would be in contravention of Article 113(1) EPC because, on the basis of that positive indication, there was no reason to expect that a procedural violation would occur.

11.3. The present case could be distinguished in several ways from R 9/11 referred to in the Enlarged Board's communication. This was subsequently explained at the oral proceedings (see section 12.3 below).

12. At the oral proceedings before the Enlarged Board on 17 June 2013, the petitioner made the following additional submissions (in addition to referring to its arguments in the petition).

12.1. The request of the opponent (respondent in the appeal proceedings) to amend the minutes of the oral proceedings before the Board of Appeal acknowledged that a substantial amount of the argument at those proceedings was about the admissibility of the appeal and of the petitioner's requests.

12.2. Even if the Board's response to the requests to amend the minutes was correct in saying the chairman's indication that the new requests were clear was made at the beginning of the debate, it was a ruling on admissibility of the requests. Rule 15(4) RPBA says the chairman presides over the oral proceedings; if the chairman gives an indication, a party has to rely on it as the petitioner did. The Board of Appeal said the objection had been overcome, so after that statement the objection was not there any more and the petitioner was left thinking the only remaining issue was inventive step.

12.3. In R 9/11, the petitioner filed requests responding to a new document filed one month before the oral proceedings, whereas in the present case the petitioner filed new requests responding to an objection made half an hour before. In R 9/11, one request was admitted, in the present case, no requests were admitted. In R 9/11, no indication of admissibility was given, in the present case a positive indication was given.

12.4. The procedural defect was fundamental because, if a thorough discussion had been allowed, there would have been an "easy fix" as point 6.2 of the written decision shows. When asked by the Enlarged Board whether in *inter partes* proceedings a Board of Appeal should tell a party about an "easy fix", the petitioner said this case was different because the Board had given the impression that it was convinced by the amendment in the new requests.

12.5. In reply to a question from the Enlarged Board during the oral proceedings, the petitioner said that, if the opponent objected to the admissibility of the new requests, it did so on the basis of added matter and novelty. In reply to the next question, the petitioner agreed that the opponent did object to the late filing of the requests but this was allowed since the Board of Appeal had given the petitioner the opportunity to file them and indicated they were clear, so the petitioner was made to rely on that indication. In reply to a further question whether or not the chairman of the Board actually said that the new requests were admissible, the petitioner agreed he did not. When asked by the Enlarged Board for the legal authority for the proposition that the Board of Appeal was obliged to admit the new requests, the petitioner referred to R 3/10, reasons, point 2.10 (see section VII.5 above).

VIII. The petitioner requested the Enlarged Board of Appeal to set aside the decision under review, to re-open the proceedings before the Board of Appeal and to order reimbursement of the petition fee.

Reasons for the Decision

Admissibility

1. It appears to the Enlarged Board that the petition was filed within two months of notification of the decision in question, that the petitioner was adversely affected thereby, that the prescribed fee was paid in time, and that (subject to the formal defect of the omission of the petitioner's address, subsequently corrected) the petition complied with Rule 107 EPC.

2. In its preliminary opinion the Enlarged Board posed the questions (see section IV.2 and 3 above) why the case made in the petition that the Board of Appeal was obliged to admit, and/or had no discretion not to admit, the new requests was not addressed to the Board of Appeal and, whether such arguments were in fact addressed to the Board or not, an objection under Rule 106 EPC was not made that, by not admitting the new requests when it had to, the Board would be in contravention of Article 113(1) EPC.

3. The petitioner answered this point by submitting (see sections VII.11.2 and 11.3 above) that, because the chairman had given an indication that the new requests were clear, the petitioner had no reason to make and was not induced to make the submissions on admissibility in the petition and, because of that positive indication, there was no reason to expect that a procedural violation would occur and thus no objection was raised under Rule 106 EPC that, by not

admitting the new requests when it had to, the Board would be in contravention of Article 113(1) EPC. For the reasons mentioned below in relation to allowability (see point 18 *et seq*), the Enlarged Board considers this argument based on the petitioner's interpretation of what it claims to have been a positive indication to be unconvincing.

4. The petitioner also submitted (see section VII.3 above) that the proviso in Rule 106 EPC should apply because an objection against the alleged procedural defect could not have been raised before the decision was rendered. The Enlarged Board can see that, on the petitioner's own account of the oral proceedings, including its unconvincing interpretation of the chairman's observation, it can allege that it did not know of the alleged procedural violation until after the appeal proceedings were closed.

5. Whether it is correct to allow the application of the proviso in Rule 106 EPC when the reason advanced for the inability to raise an objection arises, in part or in whole, from a petitioner's own misguided appraisal of events is a matter which need not be decided in this case in view of the Board's decision that the petition is clearly unallowable.

Allowability

6. The petition goes to considerable - and unnecessary - lengths to demonstrate matters of fact which the Enlarged Board sees as established from the file, namely:

(a) that the Board of Appeal's objection under Article 84 EPC against claim 1 of the second auxiliary request was raised for the first time during the oral proceedings before the Board;

(b) that the new requests were filed during the oral proceedings in response to that objection; and

(c) that the chairman of the Board remarked that the claims of those newly filed requests appeared to be clear.

7. While there is inconsistent evidence as to whether the chairman's remark was made at the beginning or at the end of the debate on the admissibility of the new requests, the petitioner places the same reliance on the remark regardless of when it was made and even accepts the possibility that it was made both at the beginning and at the end of the debate (see sections III.8 and IV.2 above). Thus the Enlarged Board sees no need to decide when during that discussion the remark was made. However, the Enlarged Board does not share the interpretation which the petitioner has placed on the remark (see point 18 *et seq* below).

8. Article 113(1) EPC provides:

"(1) The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."

9. The only violation of that provision alleged by the petitioner is the decision of the Board of Appeal not to admit the new requests into the appeal proceedings. However the Enlarged Board cannot find any suggestion in the petition of a denial of the petitioner's opportunity to present its comments on the admissibility of those requests. Indeed, the petitioner refers to and relies on the discussion of the admissibility of those requests which took place during the oral proceedings. Further, the petition itself, all of the five declarations filed therewith, the petitioner's request to amend the minutes, the respondent's observations on that request, and the Board's communication responding to that request all refer to such a discussion. Further still, while the minutes of the oral proceedings do not actually mention the discussion on that subject they do, by reference to the filing of the new requests with annexed copies and by reciting the formal requests of the petitioner, provide further confirmation that a discussion of the new requests took place. The same is true of the Board of Appeal's written decision which refers to the filing of the new requests and the appellant's view thereon.
10. The Enlarged Board's case law makes clear that it is sufficient for the purposes of Article 113(1) EPC that a reason for a decision under review corresponds to an argument which has been put forward by another party so that the petitioner was aware of it and thus was not taken by surprise. In such circumstances and in the absence of any contention or indication that a Board of Appeal has refused to hear the petitioner, it cannot be established that the petitioner had no opportunity to

comment within the meaning of Article 113(1) EPC (see R 4/08 of 20 March 2009, reasons, point 3.3).

11. In decision R 4/08, the petitioner was the opponent and the decision related to that opponent's alleged lack of opportunity to comment on the admissibility of the patent proprietor's new requests. The principle in that decision must apply with at least as much - if not more - force when, as in this case, the petitioner is the patent proprietor and the issue is the admissibility of the petitioner's own requests. It is not merely undisputed fact but also part of the case advanced by the petitioner that it knew the objection (lack of clarity) to its previous request, that it filed its new requests to overcome that objection, that it argued its case for admissibility of those requests, and that the Board decided not to admit the requests because they were *prima facie* not clear and thus did not overcome the objection. Far from showing a denial of an opportunity to comment, the petition confirms that the opportunity occurred.

12. The petitioner's view of Article 113(1) EPC (see section VII.4 to 8 above) appears to be at variance with the case law (see point 10 above) and the Enlarged Board does not agree with the petitioner's various arguments based on its view of the law. The petitioner refers to Article 113 EPC but quite clearly intends only Article 113(1) EPC. Its arguments, four in number, are to the effect that the Board of Appeal did not consider the new requests sufficiently or was obliged to admit the new requests or exercised its discretion incorrectly and each argument is said to demonstrate a violation of Article 113 EPC. That is inconsistent with

the petitioner's statement in the petition (see the first paragraph under "Grounds and Admissibility" on page 1):

"The present petition is filed under Article 112a(2)(c) EPC on the grounds that a fundamental violation of Article 113 EPC occurred in the appeal proceedings of case T0808/11-3.5.03. The negatively affecting decision, hereinafter also "the decision", violates Article 113 EPC in having not admitted the new third and fourth auxiliary requests (also "the new requests") into the proceedings and in having dismissed the appeal immediately after announcing the non admittance."

It is evident that the decision of the Board of Appeal is the only alleged violation of Article 113 and that the petitioner's arguments do not each demonstrate a separate violation but are intended to provide reasons why the decision is said to be a violation. The Enlarged Board considers each of the four arguments in points 13 to 17 below.

- 13.1 The petitioner's first argument is that Article 113 EPC enshrines the possibility of a full reaction to overcome any late-raised objection, a right that can only be safeguarded by allowing a full discussion on the merits of new requests filed in response to a late objection which in turn can only be achieved by admitting such new requests. A *prima facie* assessment to establish whether a new request is likely to overcome an objection is not adequate to satisfy this supposed right to a thorough discussion under Article 113 EPC of all the points at issue. As support

for this proposition, the petitioner cited a passage from decision R 3/10 (at point 2.10 of the reasons).

13.2 This argument is based on the false premise that "Article 113 EPC enshrines the possibility of a full reaction to overcome any late raised objection". In fact Article 113(1) EPC does no such thing. It simply provides that decisions shall not be based on matters on which parties have not been heard or, to be precise, on which parties concerned have not had an opportunity to comment. The decision in question here was whether or not to admit the petitioner's new requests and, as already explained (see point 9 above), the petitioner had and used the opportunity to comment on that issue.

13.3 The petitioner's suggestion that the right to be heard carries with it, in the case of requests filed in response to late objections, a right to a full discussion which transcends the requirement of admissibility is simply incorrect. A late objection may lead to more latitude in the **filing** of requests in response but there is no certainty of **admissibility**, let alone of a more thorough discussion if admissibility is achieved. If the petitioner was correct, any request filed in response to a late objection would be admissible even if it clearly had no prospect of overcoming the objection. The requirement of admissibility for late-filed requests serves several purposes - *inter alia* to ensure the requests offer a prospect of success - and the requirement is not suspended for latecomers, however understandable the lateness of filing their requests may be. If that were not the case, Article 13 RPBA would have little or no

purpose (as the petitioner's second argument tacitly recognizes - see point 14.2 below).

13.4 In decision R 9/11 of 7 December 2012 (see reasons, point 3.2.2) the Enlarged Board held that Article 13(2) RPBA, which gives parties a right to comment on new submissions filed by others, does not give those parties automatic admissibility of their new requests; it follows that there can be no such right of automatic admissibility for those making the new submissions. The petitioner submitted (see sections VII.11.3 and VII.12.3) that R 9/11 was distinguishable from the present case and, in as much as the facts are different, that is correct but that does not mean that the legal significance of the earlier case is to be ignored (see R 11/08 of 6 April 2009, reasons, point 11). The procedure for new requests is in fact well summarized in the warning to the appellant in the Board of Appeal's communication of 26 March 2012 (see section III.2 above):

"If amended claims are filed by the appellant, it will be necessary at the oral proceedings to discuss their admissibility and, if these claims are held admissible, to discuss the question of whether or not the amendments, the claims and their subject-matter comply with the requirements of the EPC..."

The Enlarged Board also notes that, in the opposition proceedings, the petitioner filed an amended first auxiliary request during the oral proceedings which was held inadmissible for several reasons, apparently after the Opposition Division had conducted the usual admissibility appraisal without (so far as the

Opposition Division's decision and the minutes of the oral proceedings show) any objection on the part of the petitioner.

- 13.5 The petitioner's only support for its argument was a one-sentence passage it cited from the Enlarged Board's decision R 3/10 which, with an insertion added by the petitioner, reads:

"This right [the right to be heard] would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified".

The complete passage from which that sentence is taken reads as follows:

"It is the very essence of the right to be heard that the party is given a full opportunity to defend its case and to persuade the deciding body that its position is the correct one. This right would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified".

Thus, in the case of the admissibility of its new requests, the petitioner had to be given a full opportunity to defend its case for admissibility and to persuade the Board of Appeal that its position was correct. As already observed (see point 9 above), that is what happened in the present case. In its proper context, the second sentence means no more than that a party should not be denied an opportunity to be heard because he may ultimately succeed or fail. That also

happened in the present case in which the petitioner was heard on the admissibility of the new requests even though it ultimately lost (although it would appear from the petitioner's own view of the chairman's remark that the Board's evaluation while hearing the petitioner was that it was likely to succeed). The passage from R 3/10 is entirely consistent with the Enlarged Board's other jurisprudence on the right to be heard (see points 10 to 11 above).

14.1 The petitioner's second argument is that Article 113 EPC overrules Article 13(1) RPBA since the fundamental right to a thorough discussion of new requests filed in response to late-raised objections can neither be overruled by an assessment as to the likelihood of a new request overcoming that objection nor be considered late-filed, so the Board has no discretion in respect of the admissibility of such requests.

14.2 This argument is no more than a necessary corollary of the previous argument which, as already observed (see point 13.3 above) would mean that Article 13 RPBA has little or no purpose. It is therefore an argument which the petitioner had to make to be consistent. However, the reasons for rejecting the argument are also consistent with those for rejecting the previous argument - it starts from the same false premise of a "right to a thorough discussion" and, once that false premise is dispelled, the argument cannot take matters any further.

15. The petitioner's third argument is that, according to consolidated EPO jurisprudence (an expression the petition does not explain), *prima facie* examination is

a legal assessment for excluding those late filed submissions which represent an abuse of the procedure. Since in the present case, the petitioner was responding with new requests to a late objection, the new requests were not an abuse of procedure so a *prima facie* assessment resulting in non-admissibility was also a fundamental violation of the right to respond fully to new issues and represents a fundamental violation of Article 113 EPC. Again, this argument supposes that the petitioner's fallacious view that Article 113 EPC provides a "right of full response" which would avoid any requirement of admissibility is correct. The argument is also circuitous and self-serving - it pre-supposes that an admissibility assessment is only required for submissions which represent (undefined) abuses of procedure, then asserts that the petitioner's new requests were not an abuse of procedure, and thus absolves those requests from the need for an admissibility assessment.

- 16.1 The petitioner's fourth and final argument was that, despite the previous arguments and assuming that the Board did have a discretion under Article 13(1) RPBA not to admit new requests in response to late objections, the Board exercised that discretion in an unduly restrictive manner. Thus, by reference to the provisions of that Article, the new requests could not be considered late and did not introduce any complexity as they attempted to overcome the objection; the state of the proceedings could not apply since the petitioner was responding to a new objection to terms which had been on file since the beginning of the appeal procedure; and procedural economy could not justify the adverse exercise of discretion since that would

outweigh the right of the petitioner to defend its case. Thus the Board's exercise of its discretion under Article 13(1) RPBA offended the more fundamental rights enshrined in Article 113 EPC.

16.2 Yet again this argument supposes "more fundamental rights enshrined in Article 113 EPC" than can be read into that Article and, additionally, that those rights alleged to flow from Article 113 EPC override Article 13 RPBA. It is a combination of the three earlier arguments presented as an assessment by reference to the three criteria - complexity of new subject-matter, the state of the proceedings, and procedural economy - mentioned in Article 13(1) RPBA. The petitioner however overlooks that Article 13(1) RPBA states that the Board's discretion shall be exercised in view of *inter alia* those criteria. Thus other considerations relevant to the admissibility issue in question can, and in practice are, taken into account. In the case of a new request with amended claims, one well-established criterion is whether the claims are likely to overcome the objection or objections in response to which the request has been filed.

16.3 While the exercise of its discretion by the Board in this particular case is a substantive issue with which the Enlarged Board cannot interfere in petition proceedings (see for example R 9/11 of 7 December 2012, reasons, point 3.2.1), it seems highly probable that in arriving at the decision under review the Board of Appeal did use the criterion of whether the claims were likely to overcome the objection in question. That is not only suggested by the reference in the respondent's

letter of 12 November 2012 to a detailed discussion on admissibility which ranged across clarity, support, added matter, novelty and inventive step (see section III.7 above), but is endorsed by the petitioner itself which referred to that reference as an acknowledgment that a substantial amount of the argument at the oral proceedings was about the admissibility of the new requests (see section VII.12.1 above), and is also confirmed by the decision under review which states in terms (see reasons, points 6.1 and 6.2) that the new requests were inadmissible because they were not clear within the meaning of Article 84 EPC.

17. For the reasons in points 9 to 16 above, and apart from the fact that the petition itself shows that the petitioner had an opportunity to comment on the admissibility of the new requests, the Enlarged Board cannot accept that the petitioner's arguments demonstrate any violation of Article 113 EPC. In further support of that conclusion the Enlarged Board notes, as it did in its preliminary opinion, that the petition offers no explanation as to why, when the petitioner had the opportunity to discuss admissibility of the new requests before the Board of Appeal, it made no reference to the arguments on which it now relies to show a violation of Article 113 EPC. If, when it filed the new requests, the petitioner believed that the requests were automatically admissible and that the Board had no alternative but to proceed directly to a consideration of their allowability, it is to say the least strange that it did not make that submission to the Board of Appeal. The petitioner's only answer to this is that it did not do so because of the chairman's comment, or more precisely the interpretation the

petitioner placed upon that comment. However, the petitioner and its representative were responsible for the conduct of their case and it was for them to submit the necessary arguments to support their case on their own initiative and at the appropriate time (see R 2/08 of 11 September 2008, reasons, points 8.5 and 9.10; and R 13/11 of 20 April 2012, reasons, point 18). That they did not say to the Board of Appeal when, as the case they now make in the petition proceedings makes clear, they had the opportunity to do so, that the Board was obliged to admit the new requests can only mean either that they did not at the time believe in (or perhaps even think of) those arguments and/or that they chose not to make the submission.

18. All its previous arguments being wholly unconvincing, the only remaining argument deployed by the petitioner to support a denial of opportunity to comment is that the petitioner was surprised by the decision not to admit its new requests because of the remark by the chairman of the Board that the requests appeared to be clear. The petitioner submitted, though not in the petition, that it took that remark as a ruling on admissibility and that the legal basis for that is Article 15(4) RPBA (see section VII.12.2 above). The Enlarged Board also finds this argument unconvincing for three reasons - the very nature of the remark, the purported legal basis of the argument, and its own jurisprudence on "surprise" arguments.

19.1 As regards the nature of the chairman's remark, the Enlarged Board notes that it was no more than a remark by one member of the Board of Appeal during the discussion on the admissibility of the petitioner's new

requests. Prior to the petition - in the petitioner's request to amend the minutes of the oral proceedings - and in the declarations filed with the petition, it is only referred to as an "indication" or "expression" by just the chairman. In the petition however it is elevated to the status of an indication or opinion of the whole Board, for example:

"the positive indication given by the Board" (page 2),

"the Board acknowledges that the positive opinion was given" (page 9) and

"the Board gave an indication" (also page 9),

and this is used to suggest there was a

"sudden change of opinion of the Board" (page 13).

The petitioner then proceeds to suggest that it was misled by alleging that

"correctly relying on this positive indication given by the Board, [it] had no doubts that at least admissibility of the new requests was accepted" (page 2)

and that it

"could reasonably assume that any further submissions or requests were superfluous and thus refrained, in order to behave according to indications of the Board and to avoid an unnecessary lengthening of the oral

proceedings, from presenting further arguments" (page 13).

At the oral proceedings before the Enlarged Board, the petitioner went still further (see section VII.12.2 above) and called the remark a "ruling" on the admissibility of the requests which meant that the clarity objection had been overcome. It also submitted that it was "made to rely" on the chairman's indication (see section VII.12.5 above) as if it was compelled to accept it without question.

19.2 The Enlarged Board sees no merit in such re-interpretation of a remark made by one member of the Board into first an opinion of the whole Board and subsequently into a ruling of the Board. The petitioner and its representatives must have known at the time that the remark was that of one member only and any additional significance they gave it had nothing to do with the proceedings. To seek subsequently to elevate the remark into something more in order to support a petition for review is not merely unconvincing but implausible. The submission that the chairman's remark prompted the petitioner's representative to take instructions from the petitioner on a possible remittal of the case to the Opposition Division carries no weight - the fact that the petitioner or its representative chose to take any steps on the basis of their inherently implausible interpretation of the remark cannot make that interpretation any less implausible.

19.3 The very wording of the petitioner's argument reveals its weakness. It claims that the positive indication of the chairman's remark meant there was no expectation that the Board **would** conclude that the new requests would not be admitted so no objection **could** have been raised by the petitioner (see section VII.2 above). Such an argument is logically flawed: the expectation of one (desired) result does not preclude arguing against another (undesired) result. The petitioner's various submissions on this theme all suffer from this "would/could" weakness, for example:

"Based on the Board's positive indication, the petitioner **could reasonably assume** that any further submissions or requests were superfluous and thus it refrained from presenting further arguments" (see section VII.10 above);

"the chairman had given an indication that the new requests were clear so the petitioner **had no reason to make and was not induced to make** further submissions" (see section VII.11.1 above); and

"No objection was raised under Rule 106 EPC because, on the basis of that positive indication, there was **no reason to expect** that a procedural violation would occur" (see section VII.11.2 above).

It is apparent that the petitioner conducted its case in reliance on its own assumptions. It was of course entitled to do that - as already observed (see point 17 above), the petitioner and its representative were responsible for the conduct of their case and it was for them to submit the necessary arguments to support

their case on their own initiative and at the appropriate time (see R 2/08 of 11 September 2008, reasons, points 8.5 and 9.10). It follows that only the petitioner and its representative can be responsible if such assumptions prove incorrect and the petition for review procedure is not a remedy for the consequences.

20. As regards the legal basis for the argument, the Enlarged Board observes first that the petitioner did ultimately acknowledge the weakness of the argument when, in reply to a question asked during the oral proceedings, it agreed that the chairman of the Board had not actually said that the new requests were admissible. It thus became plain beyond doubt that the petitioner's argument was based only on the interpretation it had chosen to give to the remark. The Enlarged Board also has no hesitation in dismissing the petitioner's argument that Article 15(4) RPBA has the effect that, if a chairman gives an indication, a party has to rely on it. Article 15(4) RPBA reads:

"The Chairman presides over the oral proceedings and ensures their fair, orderly and efficient conduct."

Those words simply cannot be interpreted to mean that a remark or indication by the chairman has to be relied on by a party without question, let alone that it has the status of a ruling or the removal of a previous objection. If the chairman could make remarks with any such effect during oral proceedings and before the parties have concluded their submissions, that would in itself amount to a violation of Article 113(1) EPC. It would also contradict Articles 15(5), 15(6) and 19(1) RPBA.

21. Lastly the Enlarged Board observes that this line of argument is contrary to its established case law which has consistently held that, while surprise may be an understandable subjective reaction of a party which expects to but does not succeed, it cannot affect an objective review of the decision - so if the petitioner knew the issues which might be raised and had an opportunity to comment thereon, its subsequent surprise is of no relevance (see R 12/09 of 15 January 2010, point 13 of the Reasons; R 15/10 of 25 November 2010, point 11 of the Reasons; R 13/11 of 20 April 2012, reasons, point 18; and in particular R 6/11 of 4 November 2011, reasons, point 5.3, in which as in the present case the petitioner's belief that the Board would decide in its favour was held to be immaterial to the fulfillment of requirements pursuant to Article 113(1) EPC).
22. The petition does not show that any denial of opportunity to comment occurred and thus no violation of Article 113 EPC has been established. Therefore it is not necessary to consider the petitioner's arguments that the alleged violation was fundamental. It follows from the absence of any violation of Article 113 EPC that the petition is 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