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**Datasheet for the decision
of the Enlarged Board of Appeal
of 10 June 2016**

Case Number: R 0007/13
Appeal Number: T 1575/09 - 3.2.07
Application Number: 98119184.4
Publication Number: 927768
IPC: C14B 1/56, C14C 11/00
Language of the proceedings: EN

Title of invention:

Engraved cylinder for fitting to machines for rolled finishing of hides, artificial hides, fabrics, synthetic materials and the like

Patent Proprietor:

GE.MA.TA. S.p.A.

Opponent:

BERGI SpA

Headword:

Petition for review

Relevant legal provisions:

EPC Art. 111, 112(1)(a), 112a(2)(c), 113(1)
RPBA Art. 20(1)

Keyword:

Petition for review (not allowable)
Violation of Art. 112a(2)(c) EPC (no)

Decisions cited:

R 0009/10, R 0009/11, R 0015/13

Catchword:

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Case Number: R 0007/13

D E C I S I O N
of the Enlarged Board of Appeal
of 10 June 2016

Petitioner: GE.MA.TA. S.p.A.
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Decision under review: Decision of Technical Board of Appeal 3.2.07 of
the European Patent Office of 17 December 2012.

Composition of the Board:

Chairman: W. van der Eijk
Members: W. Sekretaruk
G. Assi

Summary of Facts and Submissions

I. The patent proprietor's petition for review of 7 May 2013 is directed against the decision of Board of Appeal 3.2.07 in case T 1575/09 to revoke European patent EP 0927768. The board's written decision was received by the proprietor's representative on 12 March 2013. The petition for review is based on Article 112a(2)(c) EPC. The petitioner asserts that in the appeal proceedings four fundamental violations of its right to be heard occurred.

First violation: the board had misled the petitioner into withdrawing its request for referral of questions to the Enlarged Board of Appeal

II. Initially the petitioner had proposed that certain questions be referred to the Enlarged Board of Appeal, to clarify the limits to the admission of new documents in opposition appeal proceedings. The petitioner had considered the submission of an excessive amount of new evidence by the appellant/opponent to be an abuse of procedure. At the oral proceedings before the board there had been a three-hour discussion of the admissibility of the appeal, with a particular focus on whether or not the appeal created a "new case". The only conclusion the petitioner had been able to draw from the written proceedings and oral arguments was that the board took the view that the appeal did not create a "new case". It had therefore withdrawn its request for referral of the questions. Only upon receipt of the written decision had it become aware of the board's opinion that the appellant/opponent had in fact created a "new case", and that this did not affect

the admissibility of the appeal. Had the petitioner known the real reasons underlying the admissibility issue, it would not have withdrawn its request for referral.

Second violation: admission of D27/D27a into the appeal proceedings despite the petitioner's objections

- III. In the written proceedings before the board the petitioner had objected to the admission of documents D27/D27a which had been filed after expiry of the opposition period. It had explained why the documents were irrelevant. In its communication preparing the oral proceedings, the board had considered examining these documents. Although the petitioner had never dropped its objections, the board had stated in the reasons for the decision that it was common ground that the formula set out in claim 1 of the patent also applied to the angle of the helix slope of D27.

Third violation: "loss of a legal instance" (depriving the petitioner of the possibility of subsequent review) caused by the board's failure to remit the case to the department of first instance even though it had found that "the appeal is based entirely on new evidence"

- IV. In line with the boards' case law, the principle of fairness would have required remittal of a "new case" to the department of first instance. The board's failure to remit had deprived the petitioner of the possibility of subsequent review.

Fourth violation: breach of Article 20(1) RPBA

- V. By revoking the European patent on the basis of new evidence submitted only at the appeal stage (referred to as a "new case"), the board had deviated from the reasoning of various other board decisions, but neither during the oral proceedings nor in the decision had it given any reasons for doing so. At the oral proceedings, the petitioner had therefore had no opportunity to raise objections to the board's intention to deviate from the case law.
- VI. In a communication accompanying the summons to oral proceedings, the Enlarged Board informed the petitioner of its provisional view that the petition was not allowable. With its letter of 9 May 2016 the petitioner took issue with that opinion.
- VII. At oral proceedings held on 10 June 2016 the petitioner reiterated in connection with the first violation above that Board 3.2.07 had misled it on the "new case" issue, causing it to withdraw its request for referral of questions to the Enlarged Board. Regarding the second violation, it stressed that despite its strong objections the board had stated in the reasons for the decision that it was common ground that the formula set out in claim 1 of the patent applied also to the angle of the helix slope of D27. This could only mean that the board had not taken the petitioner's arguments into account.
- VIII. The petitioner requested that the decision under review be set aside and that the appeal proceedings be reopened before the board of appeal, that the board members who had taken part in case T 1575/09 be replaced, and that the petition fee be refunded.

Reasons for the decision

1. The petition meets the requirements with respect to the time limit and payment of the petition fee.
2. As the petition is clearly unallowable, the question of compliance with Rule 106 EPC in respect of the second alleged procedural violation can be left open (see e.g. R 15/13).

First alleged violation (see point II above)

3. With this part of the petition the petitioner basically complains that, had it had knowledge of the board's reasons for holding the appeal to be admissible, then it would not have withdrawn its request for a referral. The Enlarged Board of Appeal firstly notes that, according to the minutes of the oral proceedings of 17 December 2012, the issues of the admissibility of the appeal and the admission of new documents were debated. Consequently, the petitioner had the opportunity to present its point of view on all these issues during that debate, including the need to refer questions of law to the Enlarged Board of Appeal. The fact that at the end of the oral proceedings it withdrew its request for referral is not of a decisive nature. It can therefore be left open whether the decision to withdraw was prompted by the board or was rather based on a misunderstanding.

The reasons are as follows: Under Article 112(1)(a) EPC, boards refer to the Enlarged Board, either of their own motion or following a request from a party,

any question on which they consider that a decision is required in order to ensure uniform application of the law or to settle a point of law of fundamental importance. Whether or not a decision of the Enlarged Board is required is a question of substantive law, and a review of substantive law cannot be the subject of petition proceedings. A request of a party is thus not a condition for a referral. The only consequence of a request for referral is that a board - in case it does not accept the request - needs to expressly decide on it and reason such a decision. A failure to state the pertinent reasons, however, is not per se a ground for review. In the case at hand there was however no request to be decided upon at the end of the oral proceedings and therefore no need to discuss the issue in the written decision.

In the light of the above, the Enlarged Board of Appeal cannot see a fundamental violation of the petitioner's right to be heard even in case the petitioner was misled by the board.

Second alleged violation (see point III above)

4. The board follows the reasoning in decision R 9/11, point 3.2.1, third paragraph:

"Since both the decision to admit or not to admit a late-filed document and the decision to admit or not to admit a late-filed request are primarily discretionary decisions of the competent Board, they can only be reviewed to the extent that the way in which a Board exercised its discretion constituted a fundamental violation of Article 113 EPC. Whether the decision was

right or wrong and whether the members of the Enlarged Board would have reached the same decision is - as with all discretionary decisions - not the relevant criterion."

The only remaining question is whether or not the petitioner's relevant submissions and arguments were taken into account when taking the decision. The Enlarged Board has no doubts that this was the case here. This can be established from the file as a whole. The petitioner's argument was that document D27a reported on tests conducted with experimental knurls having inter alia a helix angle of 90 degrees. As an engraved cylinder as claimed in the opposed patent with a helical engraving of 90 degrees did not exist, the helix angle referred to in document D27a could not be the same helix angle as that referred to and calculated according to the formula given in claim 1 of the opposed patent (see petitioner's letter of 7 May 2013, page 9, point 2.2.2). As indicated by the petitioner in that letter, the board dealt with this argument in point 6.3.2 of its preliminary opinion, stating that it appeared obvious that a helix angle of 90 degrees could only be seen as indicating a limit, since at 90 degrees a helix became an arrangement of spaced rings. This proves that the petitioner's argument was indeed taken into account in the course of the appeal proceedings. The board repeated its view on this issue in point 2.1.3 of the reasons for the decision, stating:

"It is common ground that the above formula merely expresses the - generally known - geometric relationship between the angle of the helix slope, the helix pitch and the circumference of the cylinder.

It is further common ground that the angle of helix slope referred to with respect to the prior art in the patent in suit (cf. paragraph [0014]) and in D27 as well as in D27a are defined such that the above formula applies.

In the following this formula thus needs no further consideration."

It may, as the petitioner states, be incorrect that this view was commonly shared, but that does not constitute a violation of its right to be heard.

Third alleged violation (see point IV above)

5. The Enlarged Board is of the opinion that if a board decides not to remit a case to the department of first instance despite finding the appeal to be based entirely on new evidence, that does not affect a party's right to be heard. It follows the reasoning in decision R 9/10, points 8 and 9:

"8. First, there is no right to a remittal, only a discretion which may or may not be exercised in a party's favour under Article 111(1) EPC and which is the subject of considerable case-law.

...

9. Second, the right to be heard which has allegedly been lost is that of being heard again at first instance. However, if there is no right to a remittal, there is no right to a further hearing before the first instance so no right to be heard can have been denied. If, as in this case, there was no denial of the right to be heard in arriving at the decision on the remittal request, then all arguments as to other steps which

might have been taken if remittal had been ordered are speculative and irrelevant."

Fourth alleged violation (see point V above)

6. Article 20(1) RPBA aims to ensure uniform application of the law by requiring a board to give comprehensive grounds if it deviates from an earlier decision by another board. This legal concept has to be distinguished from the right to be heard. An alleged absence of such reasoning is not in itself a ground for a petition for review. In the case under review, the Enlarged Board understands from the decision that the board taking it did not consider that it was deviating from the boards' case law.

Order

For these reasons it is decided that:

The petition is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk