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**Datasheet for the decision
of the Enlarged Board of Appeal
of 2 June 2014**

Case Number: R 0021/13

Appeal Number: T 0300/10 - 3.2.03

Application Number: 01112296.7

Publication Number: 1160416

IPC: E21B 1/00, B25D 17/24

Language of the proceedings: EN

Title of invention:
Damper pressure control apparatus for hydraulic rock drill

Patent Proprietor:
FURUKAWA CO., LTD.

Opponent:
Sandvik Mining and Construction Oy

Headword:
-

Relevant legal provisions:
EPC Art.112bis;
EPC R. 106

Keyword:
Obligation to raise an objection pursuant to Rule 106 EPC:
exception to this rule[no].Petition clearly inadmissible[yes]

Decisions cited:
R 0014/11

Catchword:
-

Case Number: R 0021/13

DECISION
of the Enlarged Board of Appeal
of 2 June 2014

Petitioner: FURUKAWA CO., LTD.
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Decision under review: Decision of the Technical Board of Appeal
3.2.03 of the European Patent Office of
3 July 2013.

Composition of the Board:

Chairman: W. van der Eijk
Members: M.-B. Tardo-Dino
T. Kriner

Summary of Facts and Submissions

I. The petition for review concerns the decision T 0300/10 of Technical Board of Appeal 3.2.03, announced at the end of oral proceedings on 3 July 2013, to dismiss the appeal filed by the patent proprietor against the decision of the opposition division to revoke European patent No 1 160 416. The decision in writing was sent to the parties on 16 September 2013.

The title of the invention is *Damper pressure control apparatus for hydraulic rock drill*.

The petitioner is the patent proprietor FURUKAWA CO. LTD.

The petition was received on 15 November 2013 and the corresponding fee paid on the same day.

The previous proceedings can be summarised as follows:

The opposition division had found the subject-matter of claim 1 as granted not new over D1.

In the statement of grounds the petitioner criticised inter alia the opposition division's interpretation of claim 1 and D1 and its conclusion that the invention lacked novelty. The petitioner requested that the patent be maintained as granted or, in the alternative, on the basis of one of the four auxiliary requests also filed with the statement of grounds.

By letter of 27 August 2010 the respondent/opponent replied to the statement of grounds

filed by the petitioner and argued that none of the requests was allowable.

By letter dated 2 September 2011 and received on 6 September 2011, the petitioner, in response to the opponent's submissions, filed a new main request and new auxiliary requests I and II which replaced its existing main request and auxiliary requests I-IV.

By letter of 17 October 2012 the Board of Appeal sent a communication giving its preliminary opinion on the original main request (as granted) and auxiliary requests I-IV as filed with the statement of grounds.

By letter dated 17 December 2012 the petitioner, taking into consideration the provisional view of the Board, withdrew its second auxiliary request and commented on the provisional opinion expressed by the Board regarding the first, third and fourth auxiliary requests discussed in its communication.

The opponent/respondent sent two letters. One, dated 19 December 2012, expressed its surprise that the Board seemed to dispute, contrary to what had been accepted up to now, that feature (7) of the characterising portion of claim 1 could be derived from D1. The second letter, dated 5 February 2013, pointed out that the Board was dealing with claims of a main request and auxiliary requests I-IV which, according to the online file inspection, were no longer the subject-matter of the appeal procedure. Due to the unclear situation in this respect, the respondent commented also on the requests filed with the letter of 2 September 2011.

The Board informed the parties that its composition had changed on 2 April 2013 and issued two communications:

- on 24 April 2013 to clarify that the current claims were those of the main, first and second auxiliary requests filed by the petitioner with letter of 2 September 2011, as they were the latest requests on file and
- on 26 April 2013 to give its preliminary opinion on these claims, as announced in the communication of 24 April 2013.

By letter of 29 May 2013 in response to the second preliminary opinion of the Board, the petitioner requested maintenance of the patent as granted (main request), or alternatively on the basis of the first or second auxiliary request filed on 2 September 2011, all as filed with this letter.

According to the minutes of the oral proceedings before the Board of Appeal and the ensuing written decision, the Board considered the petitioner's request to maintain the patent as granted as late filed because, in the Board's view, it had been withdrawn and replaced by the new requests filed on 2 September 2011. However, the Board admitted the request on the ground that some confusion had arisen due to the first communication of the Board which *"unfortunately was unaware of these new requests"* (Point 2.1 of the reasons for the decision under review). During the oral proceedings the subject-matter of claim 1 of the main request was found to be not novel.

The petition

- (a) The petition for review was based on the ground that:
- (i) a fundamental violation of Article 113 EPC (112a(2)(c) EPC) occurred (point 1 of the petition), and
 - (ii) another fundamental procedural defect defined on the Implementing Regulations occurred in the appeal proceedings (Article 112a(2)(d) EPC) (point 2 of the petition).

Under (i) the petitioner complained that it had not been informed that the Board in its new composition did not share in its second communication the provisional opinion it had expressed in its former composition in the first communication. Nor did the Board inform the parties in its second communication that the claim as granted was not an issue. It was also argued that the Board, in its first communication, did not give the reasons why the amended claims (filed on 2 September 2011) had not been admitted.

Under (ii) the petitioner contended that the change in the composition of the Board of Appeal changed the admittance of the amendments and the understanding of the teaching of D1. It again argued that the Board in its new composition did not indicate before discussing D1 that it did not share the opinion set out in the first communication.

(b) In addition, during the oral proceedings before the Enlarged Board the petitioner explained that it had understood that the Board of Appeal in the first preliminary opinion had rejected the new requests filed on 2 September 2011 on the basis of Article 13 RPBA; that was at least how it had understood the last paragraph of the communication which drew the parties' attention to Article 13 RPBA for the further proceedings in the event that they intended to file amendments. According to the petitioner the Board, in the decision under review, had shifted the responsibility onto the Board in its former composition in not taking them into consideration but in fact the Board had never made the status of these requests clear in its second preliminary opinion. This was a fundamental procedural defect.

The petitioner also argued that, even if it did not dispute that a board may change its preliminary opinion during oral proceedings, in the case at hand the technical analysis given by the Board of Appeal in its communication, especially about the incompressibility, was technically detailed and the new understanding of D1 was based on a change of the interpretation of technical and physical rules, which, given the Board's former opinion, should have been explained to the petitioner. As to the admissibility issue, the petitioner submitted inter alia that the interpretation of D1 by the Board became apparent only when reading the written reasons of the decision, and that if the second communication issued by the Board had made this new

interpretation clear, the petitioner would have offered an expert opinion.

II. On 5 March 2014 the Enlarged Board sent a communication accompanying the summons to oral proceedings informing the petitioner that its preliminary view was that the petition was clearly inadmissible and in any case clearly unallowable.

III. With a letter dated 2 May 2014 the petitioner replied, defending the admissibility and allowability of the petition.

IV. Oral proceedings were held by the Enlarged Board in its composition according to Rule 109(2)(a) EPC on 2 June 2014. The petitioner's requests were the same as those in its originally filed petition (except for the request for oral proceedings) namely that:

- the Enlarged Board set the decision under review aside, and remit the case to the Technical Board of Appeal with the order to reopen the proceedings for further prosecution,
- the members of the Board who participated in this decision be replaced.

At the end the Enlarged Board announced its decision.

Reasons for the Decision

Admissibility

1. **Article 112a and Rule 107 EPC**
2. The formal requirements regarding the time limit and the payment of the petition fee and the formal requirements of Rule 107 are met.
3. **Rule 106 EPC**
- 3.1 Pursuant to Rule 106 EPC a petition for review 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 an objection could not be raised during the appeal proceedings.

According to the Enlarged Board's case law, the purpose of the requirement of Rule 106 EPC that the objection must be raised unless it was not possible for the petitioner to do so, is not only a precondition for the admissibility of the petition but also a means to put the Board in a position to decide in accordance with Rule 106 EPC on the alleged procedural violation, namely to dismiss the objection or, when appropriate, to remedy the deficiency. This procedural act enables the parties to get a reaction from the Board and on this basis to assess whether the ensuing substantive decision is open to review (see for example R 0014/11 of 5 July 2012, point 2.8.4 of the reasons).

3.2 In the current petition, the alleged grounds supporting the petition for review concern the change of opinion by the Board of Appeal about the novelty issue, and the unclear treatment of the amended claims that the Board of Appeal gave in its two successive compositions, which according to the petitioner, amounted to a violation of its right to be heard and to severe procedural defects.

The petitioner contended that it could not raise an objection under Rule 106 EPC because during the oral proceedings it had no idea of the reasons why the Board had changed its technical analysis.

As a matter of fact, during the oral proceedings the Board reversed its preliminary opinion given in its first communication about the novelty of claim 1 as granted with respect to D1. The Enlarged Board notes in an aside that the preliminary opinion expressed by the Board in its first communication was at variance with the decision of the opposition division, which had held that D1 anticipated the features of claim 1, and with the opponent's permanent stance. This change of opinion was immediately apparent during the oral proceedings since the petitioner, after the Board had announced that the subject-matter of claim 1 was not novel over the disclosure of D1, raised substantive objections regarding the characterising portion of claim 1 which resulted in a re-opening of the debate on the same issue of novelty.

After the second round of discussion the Board remained of the opinion that claim 1 lacked novelty. At this point in time it was definitively clear to the

petitioner that the Board no longer endorsed the analysis made in its first communication. That at this point in time it did not know the technical reasons for the reversal, as expanded on afterwards in the decision, has no bearing because the alleged procedural violation, namely that the petitioner was not in a position to fully prepare and present its case, occurred during the oral proceedings.

In other words, the clear announcement by the Board that claim 1 as granted lacked novelty, thereby confirming the decision of the opposition division and accepting the respondent's position, at variance with its first communication, made the petitioner aware of the change in the technical approach which, the petitioner says, occurred in such circumstances that its right to be heard was violated. Therefore the cause of the alleged violation, namely the way in which the change of approach occurred during the oral proceedings, was known. The reasons for this change concern the substantive approach of the subject-matter and the petitioner itself acknowledged that these substantive issues could not be challenged in a petition for review.

- 3.3 In conclusion, the alleged violation of the right to be heard arose during the oral proceedings and the Enlarged Board does not accept the petitioner's argument that the procedural violation became only apparent with the written reasons for the decision. Therefore no exception to Rule 106 EPC is to be found and the petitioner should have raised the objection during the oral proceedings.

3.4 As to the complaint related to the treatment of the amended claims (those filed on 2 September 2011), the petitioner argued that it could not prepare a correct defence because it had not known until the written decision, so the Enlarged Board understands, that the amended claims had not been considered in the first communication and that the claim as granted was not an "issue" in the second communication or, in other words, the petitioner complained that the Board had not indicated that it changed its mind about the claims as granted or that its second communication substituted its previous one.

The Enlarged Board does not find any factual support for the contention that it was only when reading the decision that the petitioner understood that the Board had been "unfortunately unaware" of the amended claims. Nor is the interpretation by the petitioner of the Board's communications credible for the following reasons. The fact that the Board in its first communication seems to have overlooked the petitioner's letter of 2 September 2011, as noticed by the opponent did not result in uncertainty for the petitioner in determining which requests were dealt with by the Board in each of its communications: it was clear that the communication of 26 April 2013 of the Board of Appeal in its new composition was considering the requests filed on 2 September 2011.

On page 1 of this second communication prior to oral proceedings the rapporteur wrote: *"With letter of 02 September 2011, the appellant filed a new main request and new first and second auxiliary requests, which were said to substitute all requests on file. These are the latest requests on file and as stated in the*

communication of the Board dated 24 April 2013, form the basis of this provisional opinion".

Against the procedural background mentioned above, especially the misunderstanding about the requests on file until the second communication of the Board, partly due to the fact that the petitioner's letter of 17 December 2012 did not explicitly reinstate the request to maintain the claims as granted, and given the fact that the first opinion of the Board about the claims as granted departed from the decision under appeal and the persistent stance of the respondent/opponent, the petitioner, when it filed again the claim as granted (29 May 2013) after the second communication of the Board, could have sought clarification about the first opinion of the Board of Appeal since the Board had made clear that it was giving its opinion on the pending requests replacing the requests on file and subsequently not on the claims as granted.

It results from the above that the petitioner was aware of the alleged procedural situation, if not prior to the oral proceedings then, at least it could not have failed to realise it during these proceedings. Under these circumstances it nevertheless raised no objection under Rule 106 EPC.

Thus the same conclusion is to be drawn as in point 3.3 above.

4. Therefore it results from the above that the petition is to be rejected as clearly inadmissible.

Order

For these reasons it is decided that:

The petition is unanimously rejected as clearly inadmissible.

The Registrar

The Chairman

P. Martorana

W. van der Eijk