



Europäisches
Patentamt

Große
Beschwerdekammer

European
Patent Office

Enlarged
Board of Appeal

Office européen
des brevets

Grande
Chambre de recours

Internal distribution code:

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

**Datasheet for the decision
of the Enlarged Board of Appeal
of 7 October 2016**

Case Number: R 0012/14
Appeal Number: J 0001/13 - 3.1.01
Application Number: 07708721.1
Publication Number: 1980141
IPC: H05B 33/26
Language of the proceedings: EN

Title of invention:

Fabrication method for organic light emitting device and
organic light emitting device fabricated by the same method

Applicant:

LG Display Co., Ltd.

Headword:

Right to be heard/LG DISPLAY

Relevant legal provisions:

EPC Art. 111(1), 112a, 113(1)
EPC R. 22(3), 104(b), 106, 107, 136(1)
RPBA Art. 15(5), 17(2)

Keyword:

"Admissibility of petition (yes)"
"Allowability of petition (no) - fundamental violation of
Article 113 EPC (no) - failure to decide on relevant request
(no)"

Decisions cited:

R 0001/08, R 0004/08, R 0010/08, R 0011/09, R 0019/09,
R 0023/10, R 0006/12, R 0019/12, J 0026/95

Catchword:

-



**Europäisches
Patentamt**

Große
Beschwerdekammer

**European
Patent Office**

Enlarged
Board of Appeal

**Office européen
des brevets**

Grande
Chambre de recours

Case Number: R 0012/14

D E C I S I O N
of the Enlarged Board of Appeal
of 7 October 2016

Appellant:
(Applicant)

LG Display Co., Ltd.
128, Yeoui-daero
Yeongdeungpo-gu
Seoul 150-721 (KR)

Representative:

Cabinet Plasseraud
66, rue de la Chaussée d'Antin
75440 Paris Cedex 09 (FR)

Decision under review:

**Decision of the Legal Board of Appeal 3.1.01 of
the European Patent Office of 27 November 2013.**

Composition of the Board:

Chairman: W. van der Eijk
Members: R. Moufang
M. Poock
D. Rogers
M.-B. Tardo-Dino

Summary of Facts and Submissions

General

- I. The petition for review concerns the decision J 1/13 of the Legal Board of Appeal (hereafter: "Legal Board"), dismissing the appeal against the Receiving Section's rejection of a request for re-establishment of rights.
- II. LG Chem. Ltd. (Seoul, Korea) was the applicant of European patent application No 07708721.1, originally filed as international application PCT/KR2007/000570, and the petitioner in the present review proceedings. In the course of these proceedings (see sections XVII to XX and points 1 to 3 below), the application was transferred to LG Display Co., Ltd. (Seoul, Korea). When in the following the terms "applicant" or "petitioner" are used, they refer to that legal entity which had the status of applicant or petitioner at the relevant point of time.

The proceedings before the Receiving Section

- III. On 7 October 2009 a notice of loss of rights pursuant to Rule 112(1) EPC was issued, informing the applicant's European representative that the application was deemed to be withdrawn under Article 86(1) EPC due to non-payment of the renewal fee for the third year and the additional fee within the time limit. With two letters, both dated 3 February 2010, the applicant's European representative was informed about the refund of the search fee and the examination fee.

IV. On 2 April 2010 a request for re-establishment of rights in respect of the period for payment of the renewal fee was filed, together with a conditional request for oral proceedings. As regards all due care and the cause of non-compliance, the facts submitted by the applicant may be summarized as follows:

- The representative's firm Cabinet Plasseraud was certified ISO 9001 and has established a normally satisfactory system regarding the pursuit of patent applications and the payment of renewal fees.

- When entering the data of the case into a database, a well-qualified and well-experienced member of the representative's staff erroneously indicated, despite a double-check, that the instructions for paying renewal fees had to be obtained from the applicant itself, i.e. not from the "professional client" (Hanyang International Patent and Law, Korea), a patent attorney firm, who had sent the filing instructions. This had the consequence that several reminders for the time limit for paying the third year renewal fee, which were automatically generated by the database, were sent to the applicant's headquarters in Seoul and not to the professional client.

- Since no further instructions were received, the file was closed. This had the consequence that also the EPO's loss of rights communication was, without being brought to the representative's attention, re-sent by the representative's staff to the applicant's headquarters. The omission of

the time limit was noticed by the representative only in February 2010 when the refund of fees communications (see section III above) were received at her office.

V. The Receiving Section, after having sent two communications to and received two reply letters from the applicant, decided - without conducting oral proceedings - to reject the request for re-establishment of rights and to conclude that the application was deemed to be withdrawn with effect from 1 September 2009 for non-payment of the third year renewal fee and the additional fee within the time limit of Rule 51(2) EPC.

VI. According to the Receiving Section, the request for re-establishment was inadmissible for not having been filed within two months of the date of the removal of the cause for non-compliance with the missed time limit. In the reasons it was pointed out that several principles had been developed in the case law of the boards of appeal:

- The removal of the cause for non-compliance with the time limit was a question of fact and occurred on the date on which the person responsible for the application (i.e. the patent applicant or proprietor or his authorized representative, as the case may be) was made aware that the time limit had not been observed.
- The effective date of removal was not necessarily the date at which the omission had been discovered

but the date at which it should have been discovered if all due care had been observed.

- More than one person might be responsible for the application. In such a case the removal of the cause of non-compliance occurred on the date that any person responsible should have discovered the error made (see J 27/90, OJ EPO 1993, 422).

The Receiving Section then summarized some of the facts alleged by the petitioner and concluded - without further reasoning - that the request was inadmissible.

The appeal proceedings prior to the oral proceedings

VII. The applicant appealed the decision. In the statement of grounds it claimed that the contested decision was vitiated by a substantial procedural violation because it lacked adequate reasoning and did not duly respect the applicant's right to be heard (*inter alia* by denying oral proceedings). The applicant requested the reimbursement of the appeal fee and the remittal of the case to the Receiving Section in order to consider the question of admissibility of the request for re-establishment of rights. As an auxiliary request, the applicant requested that the Board of Appeal set aside the decision, that it consider the question of admissibility and that the case be remitted to the Receiving Section for examination of whether due care was taken. Furthermore, a conditional request for oral proceedings before the Board of Appeal was made.

VIII. On 16 September 2013 the Legal Board summoned the applicant to oral proceedings to take place on

27 November 2013. On 1 October 2013 it sent out a communication via fax which contained its preliminary view on some of the issues found to be relevant.

- (a) With respect to the request for remittal due to alleged procedural violations, it observed that any deficiencies in the decision did not amount to a violation of the right to be heard or to a substantial procedural violation caused by a fundamental lack of reasoning. Even if a substantial procedural violation were to be acknowledged, the Legal Board would not be inclined to remit the case to the Receiving Section since (a) the facts of the case with respect to the admissibility of the request for re-establishment were sufficiently clear for the Legal Board to decide this question itself and (b) remittal appeared not to be procedurally efficient since it might merely lead to a further appeal on precisely the same issue.

- (b) With respect to the admissibility of the request for re-establishment, it was observed that the removal of the cause of non-compliance was the date on which the person responsible was no longer prevented from taking the necessary actions. Addressing the question as to when the professional representative in charge should have noticed the non-observance of the time limit, the Legal Board expressed serious doubts as to whether not submitting the loss of rights communication to the responsible patent attorney was in line with what all due care required. This was considered as

an essential point to be discussed in the oral proceedings.

The communication then continued as follows:

"ee. Subject to the above point, it may also need to be considered whether the Appellant itself ought to have discovered the error:

There are several decisions of the Boards of Appeal stating that the responsible person in question is not only the representative but also the applicant itself [...].

Whereas, in the special circumstances of those cases, it was always the professional representative's knowledge or negligent ignorance that was decisive, there seems to be no reason to disregard the knowledge or negligent ignorance of the Appellant as a potential alternative reason why the cause of non-compliance is to be seen as removed. Thus, if the Appellant 'became aware of the omission' or 'ought to have discovered the error' at the same point in time or earlier than the professional representative its knowledge may trigger the time period of Rule 136(1) EPC.

ff. The questions to be considered in this context include:

- Whether an organisational fault did not exist if four reminders and - probably - a notice according to Rule 51 EPC regarding a specific patent application were not forwarded by the receiving department to the

competent unit within the Appellant's organization.

- Whether the Appellant's internal organization should at least have ensured that a letter stating the loss of rights of a specific patent application was forwarded to a competent person.
- Whether letters should at least have been sent back to the EPO if a competent person within the organisation could not be determined?"

(c) According to the communication any comments to it should be submitted one month before the date of oral proceedings at the latest.

IX. With two letters dated 25 October 2013 and 6 November 2013, the applicant replied to the Legal Board's communication. It referred *inter alia* to decision J 22/92, according to which an applicant unaware of the proceedings generally assumes that documents received from one of the various patent offices are copies of those already sent to the appointed attorneys or representatives. It furthermore submitted a declaration by a patent manager from its IP department, according to which it had filed 1500 or more European patent applications and more than 2000 PCT applications until 2012 and never dealt directly with foreign patent agents or foreign patent offices, but always through Korean patent firms.

Oral proceedings before the Legal Board

- X. Oral proceedings before the Legal Board took place on 27 November 2013. According to the minutes, the course of these proceedings was as follows:
- (a) The first issue discussed was whether the receipt of the loss of rights communication by the European representative was to be considered as the removal of the cause of non-compliance. After deliberation the chairman stated that this question had to be answered in the negative.
 - (b) It was then discussed whether the receipt of the loss of rights communication by the applicant itself was to be considered as the removal of the cause of non-compliance. After deliberation the chairman stated that, as far as the applicant was concerned, the cause of non-compliance was removed more than two months prior to the request for re-establishment of rights.
 - (c) The applicant then requested remittal of the case, emphasising (i) that it was only in the Legal Board's communication that the above issue had been addressed for the first time and (ii) that the reasons in the decision of the department of first instance had been overcome. The chairman stated that the obligations on the applicant's side had already been discussed so that a remittal as to this regard was questionable.

- (d) The applicant presented its final requests in writing which were annexed to the minutes and read as follows:

"Requests

We request

- that the decision under appeal be set aside,
- that the request for re-establishment be found admissible,

in particular:

- that the Board confirms that they ruled verbally in the oral proceedings that the request for re-establishment was filed within two months of the removal of cause of non-compliance as determined in the person of the EPO representative,
- that the Board holds that the request for re-establishment was filed within two months of the removal of cause of non-compliance as determined in the person of the Applicant,
- in the event where the Board would be minded to find the request for re-establishment inadmissible, that the case be remitted to the Receiving Section for examination of the admissibility, notably if the Board is of the opinion that the request for re-establishment was not filed within two months of the removal

of cause of non-compliance as determined in the person of the Applicant.

This request is formulated for precluding any fundamental violation of Art 113 EPC and/or any substantial procedural violation, notably in view of

(1) refusal of oral proceedings before the Receiving Section and the apparent deficiencies of the decision under appeal (see statement of grounds of appeal and communication from the Board of Oct 01, 2013) and

(2) the lateness of some arguments brought forward by the Board about 6 weeks prior to the oral proceedings of Nov 27, 2013, which jeopardized the Applicant's right to be heard and possibility to benefit from two levels of jurisdiction.

- the reimbursement of the appeal fee, at least in as far as the Board did recognize during the oral proceedings that the request for re-establishment was filed within two months of the removal of cause of non-compliance as determined in the person of the EPO representative (contrary to the finding of the decision under appeal).

- that the case be remitted to the Receiving Section for examination of the allowability of the request for re-establishment,

- in any event, that the present page be annexed to the Board decision and minutes of the oral proceedings."

(e) The chairman then closed the debate. Thereafter the decision was given according to which the appeal was dismissed and the request for reimbursement of the appeal fee was rejected.

Request for correction of minutes

XI. With a communication dated 3 December 2013 the minutes were dispatched to the applicant who requested their rectification with a letter dated 13 December 2013. The amendments sought essentially consisted in indicating the time which was spent for the discussion and the deliberation of the relevant issues, in rewording the summaries of the relevant issues and in replacing the sentence "The Chairman stated that the obligations on the appellant's side had already been discussed so that a remittal as to this regard was questionable" by the sentence "At the express request from the Board, the representatives were given a 45-min break to draft written requests." In a briefly reasoned communication signed by both the chairman and the minute writer the request for rectification of the minutes was not allowed.

Written reasons of the Legal Board's decision

XII. The written reasons of the decision dispatched on 23 May 2014 may be summarized as follows:

(a) The receipt of the loss of rights notice by the European representative's office did not constitute the removal of the cause of non-compliance so far as concerns the representative. In a case such as the present one, the receipt of a loss of rights notice only gave reason to check the database system for inconsistencies but was not to be seen as the same red alert as the - non expected - receipt of such a notice under other circumstances.

(b) However, as regards the applicant itself, the cause of non-compliance was removed more than two months before the request of 2 April 2010 was filed.

- While an applicant employing a professional representative might rely upon his agent to act diligently and according to his will, this did not exempt him from suffering the consequences of his own mistakes.

- The applicant was a large organisation with worldwide activities. Presumably, it had some system whereby incoming post at its head office was sorted and directed to the relevant departments, even when such mail was in the English language. However, although the Board had raised very specific questions about the applicant's systems, no evidence was provided as to what this system had been and therefore what might have happened to the loss of rights notice.

- While there could be many plausible accounts for the applicant's apparent inaction, a party wishing to establish that it did not notice, or for some reason did not react to an omission notified to it by a loss of rights notice despite taking all due care, had to produce some evidence dealing with this issue and not merely rely on assertions.

- In the decision J 22/92 the competent board appeared to have accepted as a fact that the applicant had assumed that documents it received were copies of those already sent to its attorneys and that the applicant was entitled to think in all good faith that the attorneys had already dealt with the problem. If there had been evidence in the present case that someone within the applicant's organisation, having considered the loss of rights notice, had for good reason made a similar assumption, the Board might well have been prepared to accept this. However, such evidence was absent.

- The loss of rights notice should have landed on the desk of someone within the applicant's organisation and alerted them to the omission to pay the renewal fee, which in turn should have caused that person at least to contact the Korean representative and thus the European representative. The cause of non-compliance in the person of the applicant had been removed in the days or weeks after its European representative had forwarded the loss of rights notice to the appellant on 12 October 2009.

(c) The request for re-establishment of rights was therefore inadmissible and the Receiving Section's decision to reject it had been correct.

(d) The request to remit the case in the event of the Board being minded to come to this last conclusion was refused. While nothing was said in the first instance proceedings about the position of the applicant itself and this issue was first raised only in the Board's communication of 1 October 2013, the Legal Board used its discretion under Article 111(1) EPC to decide the case itself for the following reasons:

- There was no legal right to have every aspect of a case decided at both first instance and on appeal.
- After the Board had issued its communication raising the issue, the applicant neither asked for more time to deal with the issue nor requested remittal. Instead it responded with arguments on the point and, to an extent, filed further evidence.
- It was only after the Board, at an advanced stage of the oral proceedings and after the point had been argued, had given an indication of its negative conclusion on it that the applicant for the first time formulated the request for remittal.

- The request was therefore made very late and without sufficient regard to the efficient conduct of the proceedings.

- (e) The request for reimbursement of the appeal fee was rejected since the appeal had been found not to be allowable.

The petition for review

XIII. The petition for review was filed on 22 July 2014. It is based on two grounds, namely that (a) a fundamental violation of the petitioner's right to be heard occurred (cf. Article 112a(2)(c) EPC) and (b) the Legal Board failed to decide on a request relevant for the decision (cf. Article 112a(2)(d) in conjunction with Rule 104(b) EPC). The petitioner's arguments made for substantiating these grounds may be summarized as follows:

- (a) The applicant was denied the opportunity to fully present its case and comments on the issue of the determination of the date of removal of the cause of non-compliance in the person of the petitioner itself.

- This issue was only brought up for the first time in the communication sent by fax on 1 October 2013. The actual significance and the exact scope of this issue remained largely unclear in particular since the communication did not identify this issue as critical or essential, but only as a possible topic for the debate. As the Legal Board invited the applicant

to submit any comments one month before the date of the oral proceedings at the latest, the applicant had less than one month for filing submissions relating to an entirely fresh issue.

- This fresh issue potentially required extensive fact-finding on the applicant's side. The Legal Board hinted to types of facts and evidence that could only be provided through an in-depth, time-consuming and extensive investigation. The applicant made an attempt to present preliminary comments and evidence regarding the relevance of the fresh issue to the case before the oral proceedings. It relied on EPO case law and on a declaration from one of its patent managers. However, this was found to be insufficient by the Legal Board.

- The applicant was taken by surprise by the development of the oral proceedings. After the petitioner presented its written requests, it could legitimately expect the debate to be resumed in order to discuss admissibility and/or allowability of the outstanding requests. However, the chairman immediately closed the debate and announced the decision. There were no further discussions, no further questions asked, no interim decision announced and no further deliberations.

- The Legal Board refused the applicant's conditional request for remittal to the Receiving Section without carrying out any

assessment of "the sufficiency of factual basis available to reach such decision" and without addressing the specific written objections under Article 113 EPC raised in direct connection with said request. The question whether a fundamental procedural violation occurred before the Receiving Section was not examined at all. In the reasons for the refusal it was emphasised that the applicant initially failed to request more time or to immediately request remittal so that the request was late filed, and thus contrary to procedural efficiency. However, two remittal-seeking requests were already on file, as part of the applicant's statement of grounds of appeal.

- (b) According to the statement of grounds of appeal, the applicant's main request was that the case be remitted to the Receiving Section immediately in view of substantial procedural violations so that the admissibility of the request for re-establishment of rights should be examined by the Receiving Section and not by the Legal Board. This request was never withdrawn by the applicant and was therefore still pending when the Board took its decision. However, the Legal Board's written decision was totally silent on this request.

XIV. The petitioner requested that the decision reviewed be set aside, that the fee for the petition of review be reimbursed and that the proceedings before the Legal Board be re-opened. It furthermore requested oral proceedings before the Enlarged Board of Appeal (hereafter: "Enlarged Board").

Proceedings before the Enlarged Board

- XV. The Enlarged Board, in its composition according to Rule 109(2) (a) EPC, summoned for oral proceedings and informed the petitioner about its preliminary view on some of the relevant issues. With a letter dated 12 February 2016 the petitioner submitted further arguments.
- XVI. At the end of oral proceedings which took place on 14 March 2016, it was decided that the petition for review be submitted to the Enlarged Board as composed under Rule 109(2) (b) EPC for decision.
- XVII. With letter dated 1 April 2016 a professional representative acting on behalf of LG Display Co., Ltd. requested to record this legal entity as new applicant or proprietor for various European patent applications and patents. A deed of assignment signed by the Vice Presidents of LG Chem. Ltd. and LG Display Co., Ltd. was submitted. One of the applications assigned is the application underlying the present petition for review (see Annex 1 of the deed of assignment and Annex 1 of the representative's letter).
- XVIII. In a communication annexed to a summons for oral proceedings the Enlarged Board informed both the representatives of LG Chem. Ltd. and of LG Display Co., Ltd. that the question of party status was a preliminary issue which might have to be decided by the Enlarged Board in the course of the forthcoming oral proceedings. The petitioner should therefore take the appropriate measures to ensure that both legal entities

- involved would be properly represented at these oral proceedings, either by one or both of the professional representatives involved.
- XIX. The representative of LG Display Co., Ltd. granted a sub-delegation to the representative of LG Chem. Ltd. for representing LG Display Co., Ltd. in proceedings regarding the request for re-establishment of rights for the application concerned including the present review proceedings. In a letter from Cabinet Plasseraud dated 7 September 2016, further submissions were made on behalf of the petitioner.
- XX. Oral proceedings before the Enlarged Board as composed under Rule 109(2)(b) EPC took place on 7 October 2016. Both LG Chem. Ltd. and LG Display Co., Ltd. were represented by representatives from Cabinet Plasseraud. After having heard the representatives on this issue, the Enlarged Board concluded that, for the purpose of the present review proceedings, LG Display Co., Ltd. had acquired the party status of petitioner. At the end of the oral proceedings, the chairman pronounced the Enlarged Board's decision.
- XXI. The petitioner requested that the decision reviewed is set aside, that the fee for the petition for review is reimbursed, and that the proceedings before the Board of Appeal are re-opened.
- XXII. The further arguments submitted by the petitioner in the letters dated 12 February 2016 and 7 September 2016 and in the oral proceedings can be summarized as follows:

- (a) The request made in the grounds of appeal for an immediate remittal in view of substantial procedural violations by the Receiving Section ("request for remittal I") was separate and distinct from the request for remittal made in the oral proceedings before the Legal Board ("request for remittal II"). If the Legal Board had doubts about the exact requests, it had the duty to clarify them and their status. The applicant did not object to the qualification of the annexed requests as "final" in the minutes since this term did not encompass the notion of "exhaustive" but only indicated that these requests were the ones filed last.
- (b) The applicant had not been heard on the request for remittal I. In the absence of an express and unambiguous withdrawal, this request on file had to be considered pending ("a iure nemo recedere praesumitur"). Since it was based on different facts and proceedings than the request for remittal II, it had not become obsolete. The Legal Board failed to decide on this request.
- (c) The Legal Board failed to recognize that the request for remittal II, i.e. the request made in the oral proceedings, was both timely and well founded. To file this request before the oral proceedings would have been entirely premature. The request was submitted in the oral proceedings as soon as the risk of a violation of the right to be heard became material.

- (d) When the applicant presented its requests in writing at the oral proceedings, it had legitimate expectations that a discussion of admissibility and/or allowability of at least some of the requests would take place. However, the chairman immediately closed the debate and announced the decision.
- (e) Only when the written reasons of the decision were received, it became clear to the applicant that the Legal Board entirely based its decision on a specific issue raised for the first time during oral proceedings, namely what happened to the loss of rights notice forwarded to the applicant's headquarters and why the applicant did not react to it. The crucial nature of that issue was completely unforeseeable for the applicant. This amounted to a fundamental violation of the applicant's right to be heard, as established in several decisions of the Enlarged Board (R 8/13, R 16/13, R 2/14). Before reaching a decision, the party must be given an opportunity to comment which has to be commensurate with the concrete situation. However, issues relating to re-establishment of rights are factually and legally more complex than other issues. Although the applicant did its best to submit preliminary evidence relating to the general question of removal of the cause of non-compliance in the person of the applicant, the Legal Board blamed it for not filing the necessary evidence.

Reasons for the Decision

Party status of petitioner

1. A transfer of a European patent application has effect vis-à-vis the EPO at the date when and to the extent that documents providing evidence of such transfer have been produced (see Rule 22(3) EPC). According to the established case law (see in particular J 26/95, OJ EPO 1999, 668) in appeal proceedings substitution of another party for the original applicant is possible only once the relevant department of first instance has made a corresponding entry in the register or where there is clear-cut evidence of a transfer. The Enlarged Board considers that a corresponding principle applies to review proceedings.

2. According to the deed of assignment signed by the Vice Presidents of LG Chem. Ltd. and LG Display Co., Ltd. and submitted with the letter dated 1 April 2016, several European patents and patent applications including the application underlying the present review were assigned to LG Display Co., Ltd. This document constitutes clear-cut evidence of the transfer. Following its submission, LG Display Co., Ltd. gained the status of applicant - and of petitioner - for the purpose of the present review proceedings.

3. It does not matter for the party status of the new applicant that the contested appeal decision had the consequence that the application was deemed to be withdrawn and that according to Article 112a(3) EPC the petition for review has no suspensive effect. Since the review proceedings might result in the setting aside of

the decision and to the reviving of the application, the true applicant must be allowed to become a party to the review proceedings.

Admissibility of the petition

4. The petitioner is adversely affected by the contested decision dismissing the appeal. The petition was filed on grounds referred to in Article 112a(2)(c) and (d) EPC. The petition therefore complies with the provisions of Article 112a(1) and (2) EPC.

5. The written decision was notified to the applicant by a registered letter dated 23 May 2014. Since on 22 July 2014 the petition was filed and the corresponding fee was paid, it also complies with Article 112a(4), second and fourth sentences, EPC. The other conditions in relation to the contents of the petition as foreseen in Article 112a(4) in conjunction with Rule 107 EPC are also fulfilled.

6. According to Rule 106 EPC 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. However, an exception applies where such objection could not be raised during the appeal proceedings. Compliance with the admissibility requirement laid down in Rule 106 EPC needs to be assessed with respect to each of the specific procedural violations alleged by the petitioner.

7. In its final requests submitted in writing in the oral proceedings before the Legal Board (see section X (d)

above), the applicant explained that the request for the remittal to the Receiving Section was formulated "for precluding any fundamental violation of Art[icle] 113 EPC and/or any substantial procedural violation, notably in view of [...] (2) the lateness of some arguments brought forward by the Board about 6 weeks prior to the oral proceedings of Nov 27, 2013, which jeopardized the Applicant's right to be heard and possibility to benefit from two levels of jurisdiction." It needs to be assessed whether this explanation constitutes an objection under Rule 106 EPC.

8. An objection under Rule 106 EPC must be expressed in such a form that the board of appeal is able to recognize immediately and without doubt that such an objection - i.e. 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. Furthermore the objection must be specific, which means it has to indicate unambiguously which particular defect is relied on (see R 4/08 of 20 March 2009, point 2.1).

9. Although the explanations given by the applicant for its request for remittal were not explicitly specified as being an objection under Rule 106 EPC, they clearly identified a ground for a petition of review by using the wording of Article 112a(2)(c) EPC ("fundamental violation of Article 113"). They furthermore addressed a particular defect relied on, namely the "lateness of some arguments brought forward by the Board about 6 weeks prior to the oral proceedings".

10. Notwithstanding the somewhat vague formulation ("some arguments"), this could - in the context of the concrete procedural situation - only be understood as referring to what the applicant considered to be a fresh issue, namely the determination of the date of removal of the cause of non-compliance in the person of the applicant itself. The sentence was sufficiently clear to warn the Legal Board that, in the applicant's view, it would fundamentally violate the right to be heard if it came to a negative decision on this issue without remitting the case to the Receiving Section. Even if one took the view that more was required for a valid objection under Rule 106 EPC, it has to be also considered that the petitioner claims to have been surprised by the sudden closure of the debate (see point 11 below) and that this alleged course of events would arguably have prevented the applicant from raising the objection in a more precise manner. Hence, if the applicant's explanations of its requests were not regarded as wholly sufficient for qualifying as an objection under Rule 106 EPC, the exception to Rule 106 EPC (see point 6 above) would apply. The petition is therefore admissible, insofar as it is based on the allegation that the petitioner's right to be heard was violated by the Legal Board's decision on a fresh issue without remittal, i.e. the request for remittal II.
11. The petitioner furthermore alleges that it had been taken by surprise by the events following the presentation of its written requests in the oral proceedings, since the Legal Board's chairman prevented any further discussion of these requests (and a discussion of the still pending request for remittal I) by immediately closing the debate and pronouncing the

decision. This course of events also precluded it from raising an objection against such violation of its right to be heard.

12. The Enlarged Board is aware that it has been held in other decisions (R 10/08 of 13 March 2009, point 8; R 6/12 of 18 January 2013, point 1.3.2) that a last point in time for an appellant to intervene is when a chairman closes the debate. Since thereafter a decision has to be expected, an appellant should request that the debate be re-opened if he is of the opinion that the board would otherwise commit a fundamental procedural violation.

13. However, in the appeal cases underlying the above-mentioned decisions a deliberation by the board of appeal took place between the closing of the debate and the pronouncement of the decision (see section II (c) of R 10/08 and point 1.3.2 of R 6/12). These cases have therefore to be distinguished from the present one where, according to the minutes and the petitioner's submissions, the Legal Board did not deliberate any more after the closing of the debate so that the pronouncing of the decision immediately followed the closing of the debate.

14. One would overstretch the obligations arising from Rule 106 EPC if this provision were interpreted as requiring an appellant to interrupt (or at least to make an attempt to interrupt) the chairman of a board of appeal in his speech. The Enlarged Board is therefore satisfied that in the present case no objection could reasonably be raised during the appeal proceedings with respect to the alleged deficiency that

the applicant's written requests were not discussed at all and that the Legal Board immediately decided upon them. Thus, the exception to Rule 106 EPC (see point 6 above) applies in this respect.

15. The petition alleges further procedural deficiencies, namely that, as it transpires from the written reasons of the decision, the Legal Board ignored essential arguments of the applicant and did not decide on a still pending request, i.e. the request for remittal I. The Enlarged Board accepts that the applicant could become aware of these alleged deficiencies only when the written reasons of the decision were notified to it. Hence, in this respect no objection under Rule 106 EPC could be submitted in the appeal proceedings so that the exception to Rule 106 EPC likewise applies.
16. It follows from the above that the petition is admissible in all its aspects.

Allowability of the petition

Failure to decide on relevant request (Rule 104(b) EPC)

17. The statement of grounds of appeal contained the then main request that, in view of substantial procedural violations in the first instance proceedings, the case be remitted to the Receiving Section for examining again the admissibility of the request for re-establishment of rights (see section VII above). It is the petitioner's position that this request had never been withdrawn and was therefore still pending at the end of the appeal proceedings so that the failure to decide on it and to consider it in the written reasons

constitutes a fundamental procedural defect pursuant to Article 112a(2) (d) in conjunction with Rule 104(b) EPC.

18. In the communication setting out its preliminary view, the Legal Board considered the applicant's initial request for remittal (see section VIII (a) above). It observed that any deficiencies in the appealed decision did not amount to a violation of the right to be heard or to a substantial procedural violation caused by a fundamental lack of reasoning. Even if a substantial procedural violation were to be acknowledged, the Legal Board would not be inclined to remit the case to the Receiving Section since (a) the facts of the case with respect to the admissibility of the request for re-establishment were sufficiently clear for the Legal Board to decide this question itself and (b) remittal appeared not to be procedurally efficient since remittal might merely lead to a further appeal on precisely the same issue.

19. According to the minutes of the oral proceedings before the Legal Board, the first point discussed was whether the receipt of the loss of rights communication by the European representative was to be considered as the removal of the cause of non-compliance (see section X (a) above). Thus the Legal Board did not start the proceedings by hearing the applicant on its pending main request, i.e. that the case be immediately remitted to the Receiving Section (without any substantive examination by the Legal Board) due to procedural violations of the first instance proceedings.

20. Since the Legal Board's indication in the communication that it was not inclined to allow this request was only (and could only be) expressed as its preliminary view, the applicant should have been given an opportunity to present its arguments on this point, before the discussion on substantive aspects started. However, it appears from the minutes that the applicant neither protested against this course of the proceedings nor raised an objection under Rule 106 EPC against it, although it was evident from the first issue discussed at the oral proceedings that the Legal Board adhered to its preliminary view and did not intend to remit the case immediately.
21. After the Legal Board had deliberated on the first admissibility issue relating to the re-establishment request, the chairman declared that, as far as the European representative was concerned, the receipt of the loss of rights communication could not be regarded as the removal of the cause of non-compliance. It was then discussed whether the receipt of the loss of rights communication by the petitioner was to be considered as the removal of the cause of non-compliance (see section X (b) above). Also at this stage, the petitioner neither protested against such substantive discussion nor raised an objection under Rule 106 EPC against it.
22. After the chairman announced that the Legal Board had come to a negative view with respect to the second admissibility issue, the applicant was given time - 45 minutes according to its own submissions (see section XI above) - to prepare and submit its requests in writing.

23. It is clear from the minutes that the Legal Board understood these requests as being the applicant's **final** requests for the purposes of Article 15(5) Rules of Procedure of the Boards of Appeal (RPBA). According to that provision, when a case is ready for decision during oral proceedings the chairman shall state the final requests of the parties and declare the debate closed.
24. The petitioner argued that, although it did not ask for a correction of the minutes insofar as the written requests were qualified as "final", this qualification only meant that these requests were the last requests submitted in the proceedings. They should not have been understood as being final in the sense that the applicant did not wish and expect a further discussion on them. They should also not be understood as final in the sense that other pending requests were implicitly withdrawn.
25. The procedural acts of a party have to be assessed from an objective standpoint, taking into account all the relevant circumstances. In the present case, the written requests were submitted at a point of time when the substantive issues of the case had already been discussed. The applicant had not objected to that substantive discussion. The applicant was given considerable time to prepare the requests. The requests then filed (see section X (d) above) were - at least *prima facie* - comprehensive and, although structured in a somewhat complicated way, pertinent to the procedural situation. They included as a main request that the request for re-establishment be found admissible (and

- the case be remitted to the Receiving Section for examination of allowability) and as an auxiliary/conditional request that the case be remitted to the Receiving Section for examination of admissibility (and allowability) of the re-establishment request.
26. If at this stage of the oral proceedings the applicant was of the opinion that the submitted requests should not be regarded as final requests for the purposes of Article 15(5) RPBA and if it expected a further discussion, it should have made this clear to the Legal Board. The same holds true if the applicant wished to submit the requests only in addition to the already pending requests. Article 15(5) RPBA serves the main purpose to achieve certainty at the end of the oral proceedings what the requests are on which the parties wish the board to give its decision. It occurs very frequently in proceedings before the boards of appeal that requests pending at the beginning of the oral proceedings are adapted or withdrawn in the course of the proceedings. If, as in the present case, a party submits, at an advanced stage of the oral proceedings, written requests which the board is entitled to regard as the party's final requests, the board can also safely assume that these requests are complete, i.e. that there are no further requests outstanding on which the party wishes the board to decide.
27. The Enlarged Board is unable to identify anything in the applicant's written requests which might have warned the Legal Board that, contrary to the ordinary meaning and scope of final requests, the applicant considered further requests as still pending.

The written requests contained the conditional request "in the event where the Board would be minded to find the request for re-establishment inadmissible, that the case be remitted to the Receiving Section for examination of the admissibility, notably if the Board is of the opinion that the request for re-establishment was not filed within two months of the removal of cause of non-compliance as determined in the person of the Applicant." In the petitioner's view this request for remittal II was separate and distinct from the original request for remittal I filed with the grounds of appeal (see section XXII (a) above).

It is true that, taking into account the procedural development of the case, both requests are not identical. Since the Legal Board had already indicated that it would decide the first admissibility issue (removal of cause of non-compliance in the person of the representative) in the applicant's favour and since this fact was also mentioned in the written requests ("that the Board confirms that they ruled verbally in the oral proceedings ..."), the request for remittal II could reasonably only be understood as aiming at the Receiving Section's examination of the second admissibility issue and not any more of the first. However, acknowledging this difference does not mean that the Legal Board had any reasons to suspect that the applicant wished to keep the request for remittal I still pending. Precisely because the applicant had already been able to convince the Legal Board with respect to the first admissibility issue, it was - and still is - difficult to see why, at this point of time, the applicant might have had an interest to turn the clock back by maintaining a request for remittal which

would preclude a decision on the first admissibility issue.

28. For the reasons set out above, it is concluded that the Legal Board committed no procedural violation by interpreting the applicant's written requests as being final and complete and as superseding previous requests including the request for remittal I submitted with the grounds of appeal. Hence, the Legal Board did not fail to decide on a request relevant for the decision and the petition is unallowable insofar as it is based on Article 112a(2)(d) in conjunction with Rule 104(b) EPC.

Fundamental violation of right to be heard (Article 112a(2)(c) in conjunction with Article 113(1) EPC)

29. The petitioner alleges that several violations of its right to be heard occurred in the proceedings before the Legal Board. The Enlarged Board will deal with them in turn.

- Failure to hear the applicant on request for remittal I -

30. The request for remittal I was the applicant's main request when the oral proceedings before the Legal Board started. The minutes do not indicate any discussion of the request, neither at the beginning of the debate nor later. It may therefore be assumed that the petitioner is correct in stating (see section XXII (b) above) that it was not heard on that request. However, no decision is required as to whether this course of the proceedings resulted in a procedural deficiency (which may be doubted since the applicant did apparently not actively seek an opportunity for

discussing the request). According to the established case law of the Enlarged Board, a violation of the right to be heard can only be considered as fundamental for the purposes of Article 112a(2)(c) EPC if a causal link exists between the procedural defect and the final decision (see R 1/08 of 15 July 2008, point 3; R 11/09 of 22 November 2010, point 8; R 19/09 of 24 March 2010, point 9.2). In the present case, the written final requests submitted by the petitioner did not include the request for remittal I so that this request was not pending any more when the decision was taken (see points 26 to 28 above). Thus the alleged violation of the right to be heard in respect of the request for remittal I cannot have been causal for the reviewed decision.

- Deciding on fresh issue without remittal -

31. The main thrust of the petition is that, by deciding on a fresh issue without remittal, the Legal Board unduly limited the petitioner's right to be heard. The petitioner maintains in particular that the fresh issue was brought up too late to allow the necessary time-consuming fact-finding investigations in Korea and that the criticality of the issue did not clearly transpire from the Legal Board's communication.
32. It is true that the Receiving Section's decision, insofar as it can be understood, was based only on the finding that the cause of non-compliance was removed in the person of the representative more than two months before the filing of the request for re-establishment. Thus, the Legal Board's communication raised an issue that was different from the one on which the Receiving

Section had relied. The Enlarged Board also acknowledges that the time span between the receipt of the communication and the oral proceedings was rather short taking into account the need for further investigation with the applicant's headquarters and preparation of additional evidence.

33. However, the legal principle on which the Legal Board relied, namely that the relevant person for determining the removal of the cause of non-compliance is not only the representative but also the applicant itself, had previously been endorsed in the case law of the boards of appeal and was also mentioned, albeit briefly and without further consequences, by the Receiving Section in the appealed decision (see point 1 of its reasons). It may therefore be expected that an applicant seeking re-establishment prepares its case in such a way that it is able to show observance of the two month time limit of Rule 136(1), first sentence, EPC not only with respect to the person of the representative but also the applicant itself, in particular in a case such as the present one where several EPO communications were transmitted by the representative to the applicant's headquarters.

34. It follows from the above that the issue raised by the Legal Board in its communication could, from an objective point of view, not have come as a complete surprise for the applicant. Thus, introducing this issue only six weeks prior to the oral proceedings and deciding on it without remittal does not, as such, amount to a fundamental violation of the right to be heard.

35. The petitioner's further argument that the relevance and scope of the new issue raised in the communication remained unclear until the written reasons of the decision were made available (see sections XIII (a) and XXII (e) above) is not persuasive. It may well be that the petitioner considered this new issue as less critical than the other admissibility issue on which the appealed decision was based. Nevertheless, the Legal Board's communication was quite explicit in this respect and even asked several specific questions addressing possible faults in the petitioner's internal organisation. The use of somewhat cautious language in formulations such as "it may also need to be considered whether the Appellant itself ought to have discovered the error" is quite characteristic for boards of appeal communications in general and reflects Article 17(2) RPBA according to which communications in the written phase of proceedings should be made in such a way as not to imply that the board is in any way bound by it.

- No further opportunity for presenting arguments -

36. The petitioner complains that after the submission of its written requests the Legal Board's chairman immediately closed the debate and announced the decision without providing a further opportunity for submitting arguments (see sections X (e), XIII (a) and XXII (d) above).

37. As already set out above in detail (see points 23 to 28), the Legal Board committed no error when it understood the submitted written requests as the applicant's final requests for the purposes of Article 15(5) RPBA. If the applicant wished to be heard

further on any of these requests, it would have been incumbent on it to alert the Legal Board correspondingly. No fundamental violation of the right to be heard can therefore be found in this respect.

- Discussion of the petitioner's arguments in the written reasons -

38. The petitioner furthermore maintains that, as shown by the written reasons of the decision, essential arguments with respect to the request for remittal were overlooked or ignored.

39. The Legal Board explained in the decision why it refused the request for remittal filed as part of the written requests in the oral proceedings, i.e. the request for remittal II, and why it chose to decide the second admissibility issue itself (see section XII (d) above). It acknowledged that nothing was said in the first instance proceedings about the position of the applicant itself and that this issue was first raised only in the Legal Board's communication. Nevertheless, it exercised its discretion under Article 111(1) EPC to decide the case itself for several reasons:

- (a) There was no legal right to have every aspect of a case decided at both first instance and on appeal.
- (b) After the Legal Board had issued its communication raising the issue, the applicant neither asked for more time to deal with the issue nor requested remittal. Instead it responded with arguments on the point and, to an extent, filed further evidence.
- (c) It was only after the Legal Board, at an advanced stage of the oral proceedings and after the point

had been argued, had given an indication of its negative conclusion on it that the applicant for the first time formulated the request for remittal.

(d) The request was therefore made very late and without sufficient regard to the efficient conduct of the proceedings.

40. The petitioner considers that this reasoning overlooks the fact that a request for immediate remittal was already on file when the applicant received the Legal Board's communication. Thus, there was neither a reason to request remittal again in response to the communication nor lateness in filing the request as part of the written requests submitted in the oral proceedings. Furthermore, according to the petitioner, the written reasons do not deal with its arguments made as part of the written requests that a remittal was justified in view of the procedural violations allegedly committed by the department of first instance and was also necessary in order to preclude a violation of its right to be heard by the Legal Board.

41. In the framework of the present petition for review, it is not the Enlarged Board's task to generally examine the correctness of the reasons in the contested decision. However, if reasons for a decision fail to take into account a party's essential and relevant arguments, Article 113(1) EPC may be infringed. According to the established case law, the right to be heard also requires that those involved be given an opportunity not only to present comments but also to have those comments considered, that is reviewed with respect to their relevance for the decision in the matter (see R 23/10 of 15 July 2011, point 2; R 19/12

of 12 April 2016, points 6 to 6.3). The boards have an obligation to discuss in their decisions issues and arguments to the extent that they are relevant for the decision. On the other hand, they may disregard irrelevant arguments, and the refutation of arguments may be implicitly inferred from the particular reasoning. Accordingly, the obligation of the boards to consider a party's argumentation is shaped by the circumstances of each case.

42. In the present case, the written reasons of the decision, as correctly stated by the petitioner, do not mention at all that a request for immediate remittal was already submitted at the beginning of the appeal procedure. Neither do they address the applicant's argument that a remittal was necessary in view of the procedural deficiencies in the first instance. However, the decision's silence in this respect can only be considered as evidence of ignoring essential submissions of the applicant if these points could not be justifiably regarded as irrelevant.

43. Since the initial request for remittal I was not part of the applicant's final requests (see point 28 above), the Legal Board could not deal with it in the decision as a still pending request. The Legal Board addressed the issue of remittal only after it had reached the conclusion that it did not follow the reasoning on which the appealed decision was based and which related to the removal of the cause of non-compliance in the person of the representative. Also in the oral proceedings, the Legal Board had already expressed this view before the applicant presented its written requests.

44. It can be understood from the structure of the decision and from the underlying procedural circumstances that the Legal Board regarded the request for remittal presented as part of the final requests, i.e. the request for remittal II, as separate and different from the initial request for remittal I. This understanding is indeed also shared by the petitioner (see section XXII (a) above). From that perspective it is not easy to see why arguments which were originally made in support of the request for remittal I and focused on alleged procedural violations by the Receiving Section remained still relevant for deciding upon the request for remittal II. Since the Legal Board disagreed with the reasons of the appealed decision, it could reasonably consider that the question as to whether the first instance proceedings were tainted with procedural deficiencies had become obsolete and did not have any influence on how to deal procedurally with a fresh issue not raised by the Receiving Section. In other words, the issue of remittal I had no bearing on the *ratio decidendi* of the decision under review, which was based on facts different from the ones to which the request for remittal I was related.

45. Furthermore, the written reasons of the reviewed decision implicitly respond to the applicant's argument that a negative decision on the request for remittal would cause a fundamental violation of Article 113 EPC in view of the introduction of a fresh issue by the Legal Board. The decision contains a plurality of considerations underlying the exercise of the discretion under Article 111(1) EPC for dealing with the fresh issue (see point 39 above).

46. It follows from the above that the Legal Board did not fundamentally violate the applicant's right to be heard by ignoring essential and relevant arguments submitted by the applicant.

Conclusion

47. None of the grounds on which the present petition is based is fulfilled. The Enlarged Board accordingly finds the petition unallowable.

Order

For these reasons it is decided that:

The petition for review is rejected as unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk