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Datasheet for the decision of the Enlarged Board of Appeal of 25 April 2016

Case Number: R 0006/15

Appeal Number: T 1502/12 – 3.2.01

Application Number: 05735044.9

Publication Number: 1868846

IPC: B60R 1/02

Language of the proceedings: EN

Title of invention:
Device for orienting the external rear-view mirrors of a vehicle to void the moment of dead angle

Patent Proprietor:
Serra, Alessandro

Opponent:
AUDI AG

Headword:
Misleading statement by Board member/SERRA, A.

Relevant legal provisions:
EPC Art. 23(4), 112(1)(b), 112a(2)(c),112a(2)(d),
EPC R. 104(a), 104(b), 106, 109(2)(a), 113(1)
RPBA Art. 15(4), 15(6)

Keyword:
Petition for review - clearly unallowable

Decisions cited:
R 0002/08, R 0009/08, R 0008/09, R 0013/09, R 0016/09, R 0004/11

Catchword:

Case Number: R 0006/15

D E C I S I O N
of the Enlarged Board of Appeal of 25 April 2016

Petitioner: (Patent Proprietor)
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Decision under review: **Decision of the Technical Board of Appeal 3.2.01 of the European Patent Office of 20 April 2015.**

Composition of the Board:

Chairman: W. van der Eijk
Members: T. Bokor
W. Sieber

Summary of Facts and Submissions

I. The petition for review concerns decision T 1502/12 dated 20 April 2015, in which the Technical Board of Appeal 3.2.01 set aside the contested opposition division's decision and revoked European patent No. 1868846 for lack of inventive step (Article 56 EPC). The petitioner is the respondent (patent proprietor).

II. The relevant course of events in the proceedings of case T 1502/12 can be summarised as follows:

(a) The contested decision of the Technical Board was announced at the end of oral proceedings held on 20 April 2015. According to the minutes, before the final decision, the conclusion of the Board that claim 1 does not involve an inventive step was announced separately. This was followed by a question from the Chairman whether there were further comments or requests, and there were none. Thereafter the Chairman declared that the debate was closed. The announced decision used the standard wording to set aside the appealed decision and to revoke the patent.

(b) Following the oral proceedings, the petitioner in a letter dated 5 May 2015 expressed its astonishment with the decision recorded in the minutes (i.e. that the patent is revoked) “..., because at the end of the debate, one of the members of the Board, while the Chairman was pronouncing the decision, looking at me, said ‘The appeal is dismissed, and accordingly, the patent remains as before the appeal.’”. For that reason

it contested the decision as apparent from the minutes of the oral proceedings, and asked for an explanation of what happened, “mainly if some considerations in the negative have been aroused during the further, private, debate which surely, followed the hearing.”

(c) The Technical Board noted in a communication dated 26 May 2015 that the minutes of the oral proceedings correctly represented the course of the oral proceedings.

III. The reasoned petition was filed on 24 September 2015, and the prescribed fee was paid on the same day. The petitioner contends that fundamental procedural defects occurred in the appeal proceedings, under Article 112a(2)(d) EPC. In the petition the progress of events was presented in a wording that is only slightly different from the earlier letter of the petitioner (see point II(b) above):
“At the end of the oral proceedings ..., while the Chairman was pronouncing the decision, one of the other members of the Board of Appeal, answering a question posed by Mr. ... [the representative of the petitioner], looking at him, left Mr. ... under the impression that the appeal was dismissed and, accordingly, that the patent remained confirmed as before the appeal”.

The petitioner stated that the later received written decision confirmed the content of the minutes, but was nevertheless “completely different from the decision given during the oral proceedings”.

The petitioner further submitted that its representative only refrained from making comments because he was told that the “appeal ... had been set aside [sic]”.

IV. In the second part of the petition the petitioner alleged a further fundamental procedural defect under Article 112a(2)(d) EPC, on the basis that the Board erroneously decided the issue of inventive step and argued “ex post facto”, which was inadmissible. In addition, the Board generally misinterpreted the prior art.

V. The Enlarged Board of Appeal (hereafter “the EBA”) sent a Communication under Articles 13 and 14(2) RPEBA to the petitioner, in which the EBA expressed its preliminary opinion that the petition appeared to be clearly unallowable pursuant to Rule 109(2)(a) EPC, for reasons essentially corresponding to the reasons of the present decision.

VI. With letter dated 8 February 2016, the petitioner expressed his opinion that relying on an “ex post facto” approach was not an error in the application of substantive law, but a serious procedural error. The petitioner further argued that it was the duty of the Enlarged Board of Appeal to intervene under Article 112(1)(b) EPC in case of serious procedural errors. This Article would also empower the President of the EPO to refer this as a point of law to the EBA, and this latter must then set aside the wrong decision of the Board of Appeal.

VII. The petitioner requested that the contested decision be set aside and that the proceedings be re-opened.

Reasons for the Decision

1. The petition is essentially based on two alleged procedural defects. The first is a discrepancy between the decision as apparent from the minutes and the written decision on one side and the course of events as subjectively perceived by the representative of the petitioner on the other side. The second is the wrong application of the law. In the following, these are discussed separately.

Admissibility of the petition

2. The EBA takes note of the statement of the petitioner that its letter dated 5 May 2015 (see point II.(b) above) is to be taken as an objection under Rule 106 EPC. This letter does not satisfy the requirements of Rule 106 EPC, because it reached the deciding Board after the termination of the appeal proceedings, which ended with the announcement of the decision in the oral proceedings on 20 April 2015. However, this is not decisive in the present case. The EBA accepts that on the basis of the subjectively perceived events the discrepancy could not have been realised by the representative during the appeal proceedings, so that the petitioner could not have raised an objection during the appeal proceedings pursuant to Rule 106 EPC. The same applies to the alleged defect of the wrong application of the law, which only became apparent to the petitioner from the written reasons of the decision. Thus the EBA is satisfied that

the petition is not clearly inadmissible (Rule 109(2)(a) EPC).

3. The formal requirements (time limit, fee) have been also met. The petition is admissible.

Allowability of the petition
General considerations

4. The petition is apparently based on Article 112a(2)(d) EPC, given that the petitioner explicitly refers to this article in the petition. This Article stipulates that a "... petition may only be filed on the grounds that ... any other fundamental procedural defect **defined in the Implementing Regulations** occurred in the appeal proceedings." (emphasis by the EBA). The (only) implementing rule to Article 112a(2)(d) EPC is Rule 104 EPC, explicitly referring to it. Rule 104 EPC contains the exhaustive list of procedural defects which may give rise to an objection under Article 112a(2)(d) EPC, (see R 16/09, Reasons No. 2.3.5 to 6). These are the following: failure to arrange requested oral proceedings (Rule 104(a) EPC) and deciding on the appeal without deciding on a request relevant for the decision (Rule 104(b) EPC).

5. In the present case the EBA is unable to recognise any of the alleged procedural defects as being even remotely relevant to the possible petition grounds under Article 112a(2)(d) EPC, or in fact being relevant to any other possible ground under Article 112a EPC, as explained below. On that basis alone, the petition must be rejected as clearly unallowable pursuant to Rule 109(2)(a) EPC.

6. For the sake of completeness, beyond the rejection of the petition based on Article 112a(d) EPC in conjunction with Rule 104 EPC, the EBA also examined whether the alleged facts could be seen as a petition ground under Article 112a(2)(c) EPC. Other possible petition grounds under Article 112a(2)(a),(b) or (e) are not even remotely apparent from the alleged facts, and need not be addressed.

The first procedural defect: the alleged discrepancy

7. The EBA has serious reservations whether the facts, i.e. the progress of events as submitted by the representative correspond to the real course of the procedure. The course of events as submitted by the representative are not only in apparent contradiction with the minutes of the oral proceedings, but also appear to the EBA as highly improbable and implausible. However, this contradiction needs not be resolved, as the petition is clearly unallowable, even if the EBA would accept the version of the events as presented by the petitioner.

8. Even if accepting, for the sake of argument, the statements of the petitioner at face value, and objectively looking at the events in this light, only a relatively minor defect can be identified, which from a formal point of view indeed can be qualified as a procedural defect. This would be the failure of the Chairman to comply with the provisions of Article 15(4) of the Rules of Procedure of the Boards of Appeal (RPBA), last published in Supplementary publication to OJ EPO 1/2015, p. 40. The non-compliance could be seen in that the Chairman should have prevented the other member of

the Board from talking to the parties or generally making any statements whatsoever while the Chairman was reading out the decision. It has neither been submitted nor is it apparent from the file that the decision **as read out by the Chairman** was in any way different from the order recorded in the minutes and in the written reasoned decision. Instead, the petitioner consistently refers to the conversation of the representative with another member of the Board which allegedly conveyed the impression that the petitioner succeeded. Even if this were so, which appears highly implausible in the light of the totality of the circumstances, the representative could have been expected to pay attention to the Chairman rather than to the other member. It is noted that pursuant to Article 15(6) RPBA only the Chairman is entitled to announce the decision of the Board during the oral proceedings, and statements by the other members of the Board have no formal legal effect. Furthermore, pursuant to Article 15(4) RPBA it is the Chairman who presides over the oral proceedings. If the petitioner was under the impression that a member of the Board is speaking simultaneously with the Chairman, he should have objected to this immediately, so that no statements or instructions of the Chairman were missed or misunderstood. However, such an objection is neither apparent from the petitioner's own submissions nor from the minutes of the oral proceedings.

9. Even if assuming, in favour of the petitioner, that its submissions that the representative refrained from commenting on the decision is to be taken as an objection under Article 112a(2)(c) EPC, such an objection would also have to be dismissed as clearly unallowable. As pointed out in point VI above, the petitioner submits in

this regard the following: “If Mr. ..., at the end of the oral proceeding, had been told that the decision under appeal had been set aside, he would surely have made comments. In other word, Mr. ..., on April 20, 2015, made no comment because he had been told that the appeal, and not the decision under appeal, had been set aside.”

10. This argument must also fail. It is not foreseen that parties are given an opportunity to comment on the **decision**, whether before or after it has been announced. Article 113(1) EPC merely requires that parties are given an opportunity to comment **on the grounds or evidence** upon which a decision will be based. In this regard the petitioner explicitly submits that its representative certainly would have commented on the decision **after** its announcement. Even if he would have been given the opportunity to do so, this would not have served any purpose, as the final decision, once announced, immediately becomes final and legally effective, and the deciding Board cannot retract it, irrespective of possible later comments thereon by either party.

11. Furthermore, the EBA notes that according to the minutes, after the discussion on inventive step, the conclusion of the Board that the invention was not found to involve an inventive step was announced to the parties. Following this, i.e. apparently still **before** the announcement of the final decision, the parties were asked if they wished to comment, and none of them used the opportunity to do so. At this point in time, it ought to have been clear to the representative that a decision to revoke the patent is to be expected, and he could have made comments. Hence, in this manner Article 113(1) EPC has been apparently respected, all the more as the petitioner was apparently

also heard on the specific issues concerning inventive step.

12. On this basis, the first procedural defect clearly does not fall under any of the admissible petition grounds under Article 112a EPC. This opinion of the EBA was laid out in its communication (see point VIII. above) and was thus known to the petitioner. The petitioner did not comment on this assessment of the EBA concerning the first procedural defect.

The second procedural defect: wrong application of the law

13. The petitioner stated in the petition and also in his response to the Communication of the EBA (see point IX. above) that the Board of Appeal used wrong principles in establishing the lack of inventive step. The EBA holds that this objection does not relate to a procedural defect, but it is firmly a question of substantive law, namely whether or not the Board of Appeal applied the substantive law correctly. While it is true that the prohibition of the ex-post-facto approach is a recognised principle and firmly settled case law in the EPO, both before the Examining and Opposition Divisions and the Boards of Appeal, the application of this principle (or the omission of its application) still cannot be regarded as a question of procedure, but remains a question of substantive law. As such it cannot be reviewed by the EBA. Under no circumstances can the petition for review be a means to review the correct application of substantive law (R 2/08, R 9/08, R 8/09, R 13/09 and R 4/11, see also CLBA Seventh Edition, 2013, Chapter IV.E.9.2.1, page 1064 in the English language edition). Hence, this objection

of the petitioner must also be rejected as clearly unallowable.

14. The petitioner in its response to the Communication of the EBA (see point IX above) seeks to justify the petition with respect to the second procedural defect with reference to Article 112(1)(b) EPC, and argues that the inadmissible ex-post-facto approach is a question of procedural law, given that the Board in the present case followed a deviating line in the assessment of inventive step, which should give rise to proceedings under Article 112(1)(b) EPC. This argument appears to be based on a fundamental misunderstanding of the purpose and application of this provision, quite apart from the formal problem that the apparently required active initiating role of the President of the EPO is also not given in the present case. But more importantly, Article 112(1)(b) EPC foresees that the President of the EPO may request an **opinion** of the EBA if the President perceives a significant divergence in the case law of the Boards of Appeal. However, given that the President has no entitlement to intervene in pending appeal proceedings on its own motion (see Article 23(4) EPC), such a request for an opinion of the EBA is not put forward within the proceedings of a pending appeal, but constitutes an independent procedure before the EBA. In such proceedings, the EBA does not have any powers to set aside a decision of a Board of Appeal, but merely issues an opinion which is binding on the Boards in future cases, see also Article 21 RPBA. Furthermore, Article 112(1)(b) and Article 112a EPC concern fundamentally different proceedings, and Article 112(1)(b) EPC provides no legal basis whatsoever for interpreting the powers and duties of the EBA in proceedings under Article 112a EPC. In

particular, merely because Article 112(1)(b) EPC opens up the procedural possibility for the EBA to examine points of law of either substantive or procedural nature (provided that they can be qualified as involving a non-uniform application of the law or as being a point of law of fundamental importance), this does not transform questions of substantive law into questions of procedure susceptible for review under Article 112a EPC.

15. Accordingly, also the second line of argument of the petitioner must inevitably fail, and the petition is thus clearly unallowable.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar The Chairman

P. Martorana W. van der Eijk