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**Datasheet for the decision
of the Enlarged Board of Appeal
of 4 April 2018**

Case Number: R 0007/16

Appeal Number: T 2171/14

Application Number: 07729977.4

Publication Number: 2029865

IPC: F01N3/02, F01N3/029,
F01N3/20, F01N3/36

Language of the proceedings: EN

Title of invention:
Engine exhaust gas additive storage system

Patent Proprietor:
Plastic Omnium Advanced Innovation and Research

Opponents:
DELPHI DIESEL SYSTEMS LTD
Kautex Textron GmbH & Co. KG
Continental Emitec Verwaltungs GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 112a(2)(c)
EPC R. 106

Keyword:
"Admissibility of petition - (yes)"
"Right to be heard fundamentally violated - (no)"
"Petition for review - clearly unallowable"

Decisions cited:

R 0001/08; R 0012/09; R 0009/10; R 0016/10; R 0015/12;
R 0002/13; R 0003/13; R 0014/13; R 0016/13; R 0001/15;
R 0008/15; R 0002/16

Catchword:

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Case Number: R 0007/16

D E C I S I O N
of the Enlarged Board of Appeal
of 4 April 2018

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Decision under review: Decision T 2171/14 of the Technical Board of
Appeal 3.2.06 of the European Patent Office
of 31 May 2016.

Composition of the Board:

Chairman: W. van der Eijk
Members: F. Blumer
G. Ashley

Summary of Facts and Submissions

- I. The petition for review concerns decision T 2171/14 of 31 May 2016 of Board of Appeal 3.2.06 (notified on 11 July 2016), revoking European patent no. 2 029 865 which was granted on 6 October 2010 to Inergy Automotive Systems Research SA. Said company, the petitioner in the present proceedings, was later renamed as "Plastic Omnium Advanced Innovation and Research".
- II. During examination proceedings, objections under Article 123(2) EPC were made and the feature "also incorporating at least one other active component of the storage system and/or of the injection system" in originally filed claim 1 was finally replaced by the feature "also incorporating at least one other active component (15, 11) which is active in storage and/or metering and which needs to be in contact with the liquid additive in, leaving or entering the additive tank". Said feature, adding a definition of the "active component", was later referred to as the "critical feature" by the Board of Appeal and the petitioner.
- III. Oppositions were filed by three opponents: Delphi Diesel Systems Ltd (opponent 1), Kautex Textron GmbH & Co. KG (opponent 2) and Emitec Gesellschaft für Emissionstechnologie mbH, later renamed to Continental Emitec Verwaltungs GmbH (opponent 3). All opponents relied, *inter alia*, on the ground for opposition under Article 100(c) EPC and all opponents objected to the critical feature in this context. In its interlocutory decision of 21 October 2014, the opposition division concluded that the patent could be maintained on the

basis of the then pending auxiliary request "V (new)" (later referred to as auxiliary request V). The opposition division did not address Article 100(c) EPC in the context of the main request and the higher-ranking auxiliary requests. For auxiliary request V, the section titled "Auxiliary Request V - disclosure" in the decision did not specifically address the question whether the critical feature and its combination with the other features of claim 1 were clearly and unambiguously disclosed in the original application.

- IV. Appeals were filed by all parties (patent proprietor and opponents 1, 2 and 3). The patent proprietor (petitioner) requested in its grounds of appeal that the patent be maintained on the basis of the patent as granted (main request) or any of auxiliary requests I to IV as filed with the grounds of appeal. In their grounds of appeal, all opponents raised objections, inter alia, under Articles 100(c) / 123(2) EPC in connection with the critical feature. In its response to the appeals of the opponents dated 6 July 2015, the patent proprietor filed auxiliary requests VI to XIII. The set of claims found by the opposition division to meet the requirements of the EPC was maintained as auxiliary request V (letter of 6 November 2015, page 2).
- V. After the summons to oral proceedings was issued, the Board of Appeal gave its preliminary view in a communication dated 30 March 2016. In point 1.1 (pages 2 to 5) of the communication the allowability of claim 1 as granted under Article 100(c) EPC was questioned in connection with the critical feature. A short remark was also made on page 10 of the

communication with respect to remittal, which had been requested by the petitioner in case the Board of Appeal admitted into the proceedings certain late-filed documents (see its letters of 6 July 2015, page 14, and of 6 November 2015, page 13).

VI. In its letter of 29 April 2016, the petitioner withdrew auxiliary requests I to IV and filed new auxiliary requests "VII new" and "VIII new" intended to replace auxiliary requests VII to XIII on file and made the following request: *"A remittal to first instance is requested to give a reasoned decision on article 100(c) EPC with respect to all requests (including the two new requests). If the Board were to decide not to remit the case to first instance, it is requested that the new requests are admitted into the appeal proceedings."*

VII. Oral proceedings before the Board of Appeal were held on 31 May 2016. During the oral proceedings, the petitioner re-stated its requests made in said letter, including the request for remittal in order to get a reasoned first instance decision on the ground for opposition under Article 100(c) EPC. The request for remittal was discussed and refused before the opponent's objections under Article 100(c) EPC against granted claim 1 were discussed. After the Board of Appeal gave its conclusion that Article 100(c) EPC prejudiced the maintenance of the patent as granted, the petitioner withdrew its auxiliary requests V (claims as maintained by the opposition division) and VI (as filed with letter dated 6 July 2015). After auxiliary request "VII new" and "VIII new" were discussed (the former having been found to violate Article 123(3) EPC and the latter not admitted), the

petitioner filed auxiliary requests "IX new" and "X new", which were both admitted into the proceedings but found to violate, inter alia, Article 123(2) EPC.

VIII. In its written decision (decision under review), the Board of Appeal found that the decision of the opposition division presented a fundamental deficiency in that there was no reasoned decision in regard to the specific objections under Article 100(c) EPC made against auxiliary request V, which objections had been made originally against the main request and had been maintained against the subject-matter of claim 1 of auxiliary request V found allowable by the opposition division (Reasons, point 5).

IX. Despite the fundamental deficiency, the Board of Appeal decided not to remit the case to the opposition division (Reasons, points 5.1 to 5.5, pages 21-28). It argued, inter alia, that the petitioner was not adversely affected by the lack of a reasoned first instance decision on the matter of Article 100(c) EPC since this was decided in the petitioner's favour. The Board of Appeal did not accept the petitioner's argument that the Board had made a fresh case by way of its preliminary opinion in the communication of 30 March 2016 since the relevant issues had been addressed from the beginning of the opposition proceedings. It pointed out that it had not been argued that the Board's analysis in its communication had resulted in a specific need for remittal of the case or that there was not sufficient time to respond to the arguments in the communication. The Board of Appeal also considered the prolongation of the overall procedure which would have resulted from a remittal,

mentioning specifically the ongoing infringement proceedings and the request of opponent 2 for accelerated proceedings.

- X. The main request was considered under point 6 of the Reasons under Article 100(c) EPC (pages 28-36). The introduction of the critical feature was found to introduce added subject-matter. Auxiliary request V (even though withdrawn) was briefly addressed, it was found to be unallowable for the same reasons as the main request (Reasons, point 7). Auxiliary request "VII new", in which the critical feature had been replaced by the feature "said baseplate also incorporating an additive heater", was found to be unallowable under Article 123(3) EPC (Reasons, points 10 and 11). Auxiliary request "VIII new" was not admitted into the proceedings since it appeared to be unallowable under Article 123(3) EPC as well and since it gave rise at least *prima facie* to further objections under at least Article 123(2) and Rule 80 EPC (Reasons, points 12 and 13). The requests which had only been filed during the oral proceedings (auxiliary requests "IX new" and "X new") and which essentially included the critical feature again, were admitted into the proceedings but found unallowable for similar reasons as the main request (auxiliary request "IX new", see points 14 and 15) and under Article 84 EPC (auxiliary request "X new", see points 16 and 17).

- XI. The decision under review was sent to the parties on 11 July 2016. The petition for review was filed on 16 September 2016; the corresponding fee was paid on the same day. The petitioner requested that the decision of the Board of Appeal be set aside and the

proceedings before the Board of Appeal 3.2.06 be reopened. The petitioner further requested oral proceedings in the event that the Enlarged Board was to consider not setting aside the decision under review.

XII. The petition was based, on the one hand, on Article 112a(2)(c) EPC (fundamental violation of Article 113 EPC), and, on the other hand, on Article 112a(2)(d) in connection with Rule 104(b) EPC (decision on the appeal without deciding on a request relevant to that decision). Both grounds concerned the Board of Appeal's failure to remit the case to the opposition division for consideration of Article 100(c) / 123(2) EPC (particularly, in connection with the addition of the critical feature) and the Board of Appeal's reasons for its decision under Article 100(c) EPC.

XIII. In its communication issued under Articles 13 and 14(2) Rules of Procedure of the Enlarged Board of Appeal, the Enlarged Board identified three objections made by the petitioner:

- a) the failure to remit the case with respect to the requests that were pending during the opposition proceedings (main request, claims as granted);
- b) the failure to remit the case with respect to the requests filed during appeal proceedings (auxiliary requests "VII new" and "VIII new");
- c) deficiencies in the Board of Appeal's reasons for not allowing the main request.

The Enlarged Board gave its preliminary view that objection a) was clearly inadmissible and clearly unallowable and that objections b) and c) were clearly unallowable.

XIV. The petitioner did not respond to said communication which was sent together with the summons for oral proceedings. Oral proceedings before the Enlarged Board were held on 4 April 2018.

XV. During oral proceedings, the petitioner maintained the original objection referred to under c) (point XIII above). As far as objections a) and b) are concerned, the petitioner shifted its focus and argued that insufficient reasons were given in the written decision for the Board's refusal to remit the case to the opposition division. The petitioner acknowledged that the request for remittal was discussed extensively during oral proceedings before the Board of Appeal and that the Board of Appeal made it clear during oral proceedings that the request for remittal was refused.

XVI. Taking into account the submissions made during the oral proceedings of 4 April 2018, the petitioner's lines of argument concerning the alleged fundamental violation of Article 113 EPC can be summarised as follows:

- The objection to the critical feature under Article 100(c) EPC was raised by an instance of the EPO only in the communication of 30 March 2016 (two months before oral proceedings). This late objection amounted to a "fresh case" which was

difficult to handle for the petitioner at such late stage of the proceedings.

- The Board of Appeal should have discussed the substance of the objections under Article 100(c) / 123(2) EPC before it decided on the remittal.
- The request for remittal did not concern specific requests, it was always meant and should have been understood as a request to remit the "case", i.e. all pending requests.
- The reasoning for the refusal of the request for remittal was "high-level", i.e. on a purely procedural level.
- The reasoning for the refusal of the remittal (point 5.4 of the decision under review) was inconsistent, partly incorrect and given only in the written decision.
- The reasoning for the refusal of the main request under Article 100(c) EPC (points 6.4.1 through 6.4.3 of the decision under review) was incorrect and insufficient, partially irrelevant.

Reasons for the Decision

1. The petitioner's objections
 - 1.1 The Enlarged Board in its communication of 7 February 2018 made the following distinction with respect to the Board of Appeal's failure to remit the case (see above point XIII):

- a) the failure to remit the main request, and
- b) the failure to remit auxiliary requests
"VII new" and "VIII new".

1.2 During oral proceedings before the Enlarged Board, the petitioner pointed out that its understanding had always been that the entire case (encompassing all requests then pending) should be remitted. Reference was made, *inter alia*, to Article 11 RPBA (which refers to the remittal of "a case" and to the petitioner's letter of 29 April 2016 (see, *e.g.*, the quote from said letter under point VI above). The Board of Appeal had also made clear that the remittal of the entire case was discussed and decided upon (as indicated on the minutes of the oral proceedings, page 3, third paragraph).

1.3 As a consequence, the petitioner no longer argued that the Board of Appeal did not decide on all relevant requests. The discussion during oral proceedings before the Enlarged Board focused on how the remittal had been discussed in appeal proceedings and how the non-remittal was reasoned in the decision under review, and the petitioner clarified that only insufficient reasoning of the written decision was the basis of its objections.

2. Admissibility of the petition

2.1 The decision under review of 31 May 2016 of Board of Appeal 3.2.06 was notified on 11 July 2016. The petition was filed on 16 September 2016, and the corresponding fee was paid on the same day. The formal requirements of Rule 107(1) and (2) EPC have been

complied with, and the petitioner is adversely affected by the decision under review.

2.2 During oral proceedings before the Enlarged Board the petitioner clarified that only insufficient reasoning of the written decision was the basis of its objections (see above point 1.3). Since the petitioner could not be aware of such deficiencies during appeal proceedings, no objection under Rule 106 EPC could be made (R 2/13 of 10 June 2013, Reasons, point 1; R 14/13 of 25 February 2015, Reasons, point 2).

2.3 The petition is therefore in compliance with Rules 106 and 107 EPC and admissible.

3. Allowability of the petition

3.1 Requirements for reasoning a decision

3.1.1 Under Rule 102(g) EPC the decisions of the Boards of Appeal shall contain reasons. Under Rule 111(2) EPC, examining and opposition divisions are obliged to give reasons for their decisions. While the violation of Rule 111(2) EPC may constitute a fundamental deficiency of a first instance decision in the terms of Article 11 RPBA, deficiencies in the reasoning of a decision in appeal are not a ground for a petition under Article 112a(2) EPC and can be the basis for a petition only if they amount to a fundamental violation of the right to be heard in view of Articles 112a(2)(c) and 113 EPC (R 1/15 of 3 June 2016, Reasons, point 3.5).

3.1.2 The right to be heard not only implies that a party is given the opportunity to present its views but also that its arguments are taken into account and

considered. The reasoning in a decision should be such that a party can establish that the deciding body actually considered its arguments and can understand why - in case of an adverse decision - its arguments were found not to be convincing. Assessing the completeness of the reasoning would usually be beyond the scope of scrutiny under Article 113(1) EPC. For compliance with the right to be heard, reasons may be incomplete, but as long as they allow drawing the conclusion that the board, in the course of the appeal proceedings, substantively assessed a certain point as being part of the procedure and that it found to be relevant, there will be no violation of Article 113(1) EPC (R 8/15 of 18 July 2016, Reasons, points 2.2.2 and 2.2.3).

3.1.3 A board of appeal is not obliged to consider each and every argument of the parties in detail in its decision (R 2/13 of 10 June 2013, Reasons, point 2.2; R 15/12 of 11 March 2013, Reasons, point 5). On the other hand, the Board of Appeal may not, to the surprise of the parties and *ex officio*, use reasons in the written decision which have not been presented and discussed during appeal proceedings (R 16/13 of 8 December 2014, Reasons, point 3.3; R 3/13 of 30 January 2014, Reasons, point 2.2). However, a board of appeal is not required to provide the parties in advance with all foreseeable arguments which may appear in the decision (R 1/08 of 15 July 2008, Reasons, point 3.1). In any case, whether a point is allegedly missing in a decision or is presented for the first time in a decision to the surprise of the parties, such argument, reason or evidence needs to be clearly identified by the petitioner in the proceedings under Article 112a EPC.

- 3.2 First objection: Failure to give reasons on the decision not to remit the case
- 3.2.1 Under Article 11 RPBA, a Board may decide that a case is exceptionally not remitted to the department of first instance after it has found fundamental deficiencies in the first instance proceedings. Such decision is subject to the discretion of the Board concerned.
- 3.2.2 In the context of the petitioner's arguments concerning the remittal it must be noted that the objection against the critical feature under Article 100(c) EPC was not a "fresh case" raised late in the appeal proceedings but an objection that had been made by all opponents from the beginning of the opposition proceedings (see the notices of opposition of opponent 1, section D.1, of opponent 2, section 4.1, and of opponent 3, section D). Even though the opposition division did not give a reasoned decision on the critical feature in view of Article 100(c) EPC, the petitioner was aware of the objection and could and should have considered its counterarguments long before the Board of Appeal issued its communication.
- 3.2.3 However, the refusal of a remittal cannot *per se* be a ground for allowing a petition. Only if a party has not been sufficiently heard on the remittal issue, the refusal of a remittal can lead to a ground for a petition under Article 112a(2)(c) and 113 EPC (see R 2/16 of 28 October 2016, Reasons, point 3; R 9/10 of 10 September 2010, Reasons, points 7ss.; R 12/09 of 15 January 2010, Reasons, points 6ss.).

- 3.2.4 The petitioner confirmed during oral proceedings that the remittal had been discussed extensively (about three hours) during oral proceedings. The decision under review gave detailed reasons for the refusal of the request for remittal (pages 20 to 28). The petitioner did not argue that its arguments concerning the remittal were not considered or that the Board of Appeal presented *ex officio* reasons or arguments in the written reasons only.
- 3.2.5 The petitioner's arguments concerning the reasoning focused on the fact that the substance of the issues under Articles 100(c) / 123(2) EPC was not taken into consideration when the remittal was discussed and that the written decision did not address these substantive issues in the context of the remittal.
- 3.2.6 The requested remittal should have given the petitioner the opportunity to be heard on the issues under Article 100(c) EPC before two instances (petition, last paragraph of page 7). However, a hearing before two instances implies that the first instance hears before the second instance. A detailed discussion of the substantive issues under Article 100(c) EPC before a decision on the remittal would have rendered any remittal pointless since the first instance would have been bound by the considerations of the Board of Appeal or could have expected that its decision would be reversed if it was not in line with the considerations of the Board of Appeal. It was therefore only logical to limit the discussion on the requested remittal to procedural aspects. As the reasons (pages 20 to 28) of the decision under review show, such procedural aspects

were extensively discussed (for example, whether the issues under Articles 100(c) / 123(2) EPC constituted a fresh case or what a remittal or non-remittal would imply for the parties in terms of time or their right to be heard). The petitioner has not argued that specific elements of this discussion were not reflected in the written decision.

3.2.7 The petitioner further argued that in the discussion under Articles 100(c) / 123(2) EPC (after the remittal was refused), arguments were made that could not have been considered during the discussion on the requested remittal. However, the fact that certain arguments on the extension of the originally disclosed subject-matter could not be considered in the context of the remittal is a consequence of the logical order mentioned above (point 3.2.6).

3.2.8 The objection against the reasoning for the decision not to remit the case is therefore not founded and the petition clearly cannot be allowed as far as the first objection is concerned.

3.3 Second objection: Failure to give sufficient reasons for not allowing the main request

3.3.1 The petitioner's objection that the Board did not give sufficient reasons for not allowing the main request under Article 100(c) EPC was maintained throughout the proceedings before the Enlarged Board. In its communication, the Enlarged Board explained that the substance of the reasons could not be reviewed in the present proceedings. Only if it could be demonstrated that specific arguments of the petitioner which it

raised during appeal proceedings were not heard or considered in the appeal proceedings, the Enlarged Board could explore the reasons given in the decision under review (communication of 7 February 2018, point 15, referring to R 16/10 of 20 December 2010, Reasons, point 2.2.5).

3.3.2 During oral proceedings before the Enlarged Board, the petitioner did not specify such arguments which were not heard but referred to a number of deficiencies in the reasons of the decision under review. The petitioner referred to the Board of Appeal's finding that the critical feature resulted from "further reflections" on the basis of a specific disclosure in the originally filed application (point 6.4.2, see also page 15 of the petition). The Enlarged Board is not persuaded by the petitioner's argument that such "further reflections" needed to be specified in the decision. It follows from the context that the reference to "further reflections" of the skilled person just implies that the feature in question was not clearly and unambiguously disclosed in the original application. The difference between the feature in the granted claim (the critical feature) and the relevant parts of the original application is dealt with extensively (points 6 to 6.6 of the decision under review) and no argument has been made that specific arguments concerning said difference were not considered.

3.3.3 During oral proceedings before the Enlarged Board, the petitioner further argued that there were discrepancies between the reasons for not allowing the main request under Article 100(c) EPC on the one hand (point 6) and

the reasons for not allowing auxiliary request "VII new" under Article 123(3) EPC on the other hand. The investigation of such discrepancies goes beyond the scope of review proceedings if the discrepancies cannot be shown to be related to a fundamental violation of the right to be heard.

3.3.4 For these reasons, the second objection concerning the reasoning for the decision not to allow certain requests under Article 100(c) / 123(2) EPC is not founded and the petition clearly cannot be allowed with respect to the second objection.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as being clearly unallowable.

The Registrar

The Chairman

P. Cremona

W. van der Eijk