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**Datasheet for the decision
of the Enlarged Board of Appeal
of 10 July 2017**

Case Number: R 0008/16
Appeal Number: T 1659/14 – 3.2.08
Application Number: 05708580.5
Publication Number: 1725349
IPC: B21C47/14, F16C17/03
Language of the proceedings: EN

Title of invention:
LAYING HEAD WITH A VIBRATION DAMPING DEVICE

Patent Proprietor:
Danieli & C. Officine Meccaniche S.p.A.

Opponents:
Siemens Industry, Inc.
SMS group GmbH

Headword:
Petition partly clearly inadmissible and partly clearly
unallowable

Relevant legal provisions:
EPC Art. 4(3), 100(c), 112a(2), 112a(2)(c), 112a(2)(d), 113(1),
113(2), 123(2), 125
EPC R. 104 (b), 106, 109(2)(a), 109(3), 124(1)
RPEBA Art. 12(1)
RPBA Art. 12(1), 12(2)

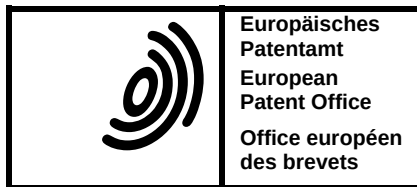
Keyword:
Fundamental violation of the right to be heard (no)
Fundamental violation of Article 113 EPC (no)
Fundamental procedural defect (no)

Decisions cited:

R 0006/11, R 0013/12, R 0006/14

Catchword:

1. Only parties adversely affected by a decision may resort to a procedure under Article 112a EPC. The term “fundamental violation” in Article 112a(2)(c) EPC also must be read in this light. An alleged violation cannot be fundamental, in the sense of “intolerable”, if it does not cause an adverse effect. (Reasons, point 23).
2. The principle of party disposition expressed in Article 113(2) EPC does not extend so as to permit a party to dictate how and in which order a deciding body of the EPO may examine the subject-matter before it. The only obligation on the EPO is not to overlook any still pending request in the final decision. A Board has no particular duty to give reasons why it chose to proceed as it did (Reasons, point 25).
3. A Board has no obligation to peruse the whole file of the first instance proceedings. It is the duty of the parties to raise issues again in the appeal proceedings, to the extent necessary, as stipulated by Articles 12(1) and (2) RPBA: “Appeal proceedings shall be based on [the submissions of the parties filed in the appeal proceedings, which] ... should specify expressly all the facts, arguments and evidence relied on” (Reasons, point 38).



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Case Number: R 0008/16

D E C I S I O N
of the Enlarged Board of Appeal
of 10 July 2017

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Decision under review: **Decision of the Technical Board of Appeal**
3.2.08 of the European Patent Office of
8 July 2016.

Composition of the Board:

Chairman: D. Rogers
Members: T. Bokor
G. Alt

Summary of Facts and Submissions

- I. In the opposition proceedings the patent was upheld with amended claims. The proprietor, (the petitioner in this case) and opponent 2 appealed. The appeal was assigned to board 3.2.08 (hereinafter "the Board") under the number T 1659/14. The Board revoked the patent for added subject-matter (Article 100(c) and 123(2) EPC).

For ease of reading the petitioner will be variously referred to as the proprietor, proprietor-appellant and petitioner.

- II. The proprietor-appellant filed a petition for review under Article 112a EPC against the decision of the Board. The petitioner contends that fundamental procedural defects occurred in the appeal proceedings, under Article 112a(2)(c) and (d) EPC, in conjunction with Rule 104(b) EPC.

Summary of events leading to the decision under petition

- III. In the appeal proceedings the Board issued a communication, in which the following points were raised, *inter alia*:
- that the proprietor-appellant should clarify its requests
 - admissibility of proprietor-appellant's main request (presumed to correspond to the granted claims)
 - allowability of proprietor-appellant's main request under Articles 100(c) and 123(2) EPC. In this regard, the issue of support for the feature "only two bearings" was raised, with a particular emphasis on the term

"only", and whether the bearings could be of the axial or radial type. In this context, the Board also referred to the arguments of the proprietor-appellant on proper claim interpretation. The communication stated that "Given the above, it is to be discussed whether "only two bearings" was disclosed in combination with the other features of claim 1 of the patent as granted."

- IV. The proprietor-appellant informed the Board with a letter dated 8 June 2016 that its main request was to maintain the patent as granted, while the auxiliary requests corresponded to requests filed before the Opposition Division, including the claims as held allowable.
- V. According to the Board's minutes, at the start of the oral proceedings the proprietor-appellant made the following requests:
 - a. The decision under appeal be set aside and the patent maintained as granted (main request) or that the patent be maintained on the basis of the claims of the First, Second, Third, Fourth or Fifth Auxiliary Request, as filed by letter of 8 June 2016 [though not apparent from the minutes or the decision, this Second Auxiliary Request apparently corresponded to the claims held allowable by the Opposition Division]
 - b. Documents D49 to D54 not be admitted into the proceedings
 - c. Opponent 1 not be allowed to discuss the maintenance of the patent as maintained by the Opposition Division.

- VI. According to these minutes, Appellant 2 (Opponent 2) requested that the decision under appeal be set aside and that the patent be revoked, and that the main request of the proprietor-appellant not be admitted into the proceedings.
- VII. According to the minutes, the claim requests were discussed as follows: First, Claim 1 as maintained was discussed for added subject-matter, and also "in relation to the Auxiliary Requests". The Board concluded that none of the Auxiliary Requests complied with Article 123(2) EPC. Thereafter the main request was discussed and admitted. This was followed by the discussion on Claim 1 of the main request, still under Article 123(2) EPC. Also for the main request the Board concluded that it did not comply with Article 123(2) EPC.
- VIII. Thereafter, according to the minutes, "Appellant 1 filed four new Auxiliary Requests replacing the requests filed with letter dated 8 June 2016" and subsequently "The admissibility of the new Auxiliary Requests was discussed". Before closing the debate, the Chairwoman established that there were neither further requests, nor comments. Finally, after a deliberation of the Board the Chairwoman announced the non-admission of the newly filed auxiliary requests and the revocation of the patent.
- IX. The written reasons of the Board's decision contains four distinct procedural decisions or substantive findings:
- a. permission for a representative to speak on behalf of the petitioner,
 - b. admission of the main request,

- c. non-compliance of the main request with Article 123(2) EPC (see points 2.1-2.4),
- d. non-admission of the auxiliary requests filed in the oral proceedings.

The decisions on the issues (a) and (b) were not reasoned. The board's explanation for this being that these points "... were taken in favour of the losing party [that is the proprietor-appellant] and thus do not affect the final decision". The findings on the issue (c) are mainly based on an analysis of the question whether the bearings are of the axial or radial type.

- X. In its petition the petitioner alleges a fundamental violation of its right to be heard (Article 113 EPC, Article 112a(2)(c) EPC), and further alleges that fundamental procedural defects under Article 112a(2)(d) EPC and Rule 104(b) EPC occurred.

Right to be heard violations

- XI. As to the violation of the right to be heard under Articles 112a(2)(c) and 113 EPC, the following points were raised as more or less separate petition grounds (annotation A to H introduced by the Enlarged Board of Appeal (hereafter "the EBA") for easier reference):
 - A. The written decision of the Board contained no reasons why the claims as upheld by the Opposition Division were not allowable, thus not permitting the petitioner to understand why the decision under appeal was reversed.
 - B. The Board's decision did not explain what happened to the earlier withdrawn requests, but only referred to

the petitioner's final requests that it confirmed at the end of the oral proceedings.

- C. The decision contained no reasons why the main request was admitted, and why this decision was only made after the decision not to admit the later withdrawn auxiliary requests. This lack of reasons in the decision violated the petitioner's right to be heard, because arguments need not only be heard, but also must be acknowledged in a decision of the EPO.
- D. The Board did not consider the main arguments of the petitioner, why the "only two bearing" feature does not add subject-matter. In this regard the petition stated the following: *"The main argument of the Proprietor was that the amendment regarding the feature "only two bearings" above mentioned did not introduce subject matter which extended beyond the content of the application as filed: actually the overall change in the content of the application resulted in the skilled person being presented with information which was directly and unambiguously derivable from that previously presented by the application, taking account of matter which is implicit to a person skilled in the art"*. The petitioner also submitted that the arguments not mentioned could well have changed the outcome of the decision.

Fundamental procedural defect

- XII. The petitioner submitted the following complaint as a fundamental procedural defect under Article 112a(2)(d) EPC:

- E. The Board did not decide on a request pursuant to Rule 104(b) EPC, in that the main request was discussed and decided on only after a discussion and decision on the claims as upheld. In this respect, the petitioner raised an objection under Rule 106 EPC.

Further procedural violations

XIII. In the petition further procedural violations by the Board were set out and criticised, without explicit reference to any provision of Article 112a(2) EPC:

- F. The petitioner was led into the inescapable trap of Article 123(2)/(3) EPC by the Examining Division, i.e. the European Patent Organisation itself provoked the error.
- G. The petitioner lost its patent on a "formalistic issue", against the spirit of Article 4(3) EPC, and after having spent considerable sums.
- H. The considerations underlying petition grounds F and G were not taken into account by the Board, when revoking the patent, in full knowledge of pending parallel infringement actions.

XIV. 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 inadmissible with respect to the petition grounds E to G, and it appeared to be clearly unallowable with respect to all grounds A to H under Rule 109(2)(a) EPC.

XV. With letter dated 23 June 2017, the petitioner commented on the preliminary opinion of the EBA. It submitted the

following arguments in respect of the petition grounds A to H:

- A, B: Articles 112(a)(c) and 113 EPC are an expression of the principle of the right to a fair procedure and to a fair hearing. This is violated when a decision is silent on a decisive issue, here the refusal of petitioner's requests.
- C: Not following the order of requests during their discussion is a violation of Article 113(2) EPC.
- D: Contrary to the finding in the opinion of the EBA, the non-admission of the later filed auxiliary requests was criticised by the petitioner. In the proceedings before the first instance the issue of the broadening of scope under Article 123(2) EPC was extensively argued by the petitioner, and the Board ought to have taken these arguments into consideration, which it did not. The same arguments, e.g. the reference to "the two bearings" in claim 6 were also repeated during the oral proceedings before the Board. The Board, however, only repeated the arguments of the opponent.
- E: As to admissibility, ground E is to be subsumed under Articles 112(2)(c) and 113(2) EPC. As such, a formal objection under Rule 106 EPC was not necessary. It was also not necessary because it became obsolete, hence it could not have been raised in the oral proceedings in the sense of Rule 106 EPC. Otherwise, such a formal objection was in fact made, but this is neither reflected in the minutes nor in the decision. The proprietor had no obligation to protest against the incorrectness of the minutes. A discussion of the requests in the wrong order means that a decision is made on a

version other than that approved by the proprietor of the patent, so that Article 113(2) EPC is violated.

F, G: As to the admissibility, Articles 112(a)(c) and 113 EPC are an expression of the principle of the right to a fair procedure and to a fair hearing, as explained in decision T 669/90. As such, Article 125 EPC must also be taken into account. It is also an expression of trust between parties and the EPO, and a matter of credibility for the latter. This principle of fairness is violated when important arguments of a party are completely disregarded.

XVI. With letter dated 6 July 2017, the petitioner submitted the declaration of the petitioner's representative, stating that a formal objection ("qualified rebuke") was made against the decision of the Board to discuss the First Auxiliary Request before the main request during the oral proceedings held on 8 July 2016. The declaration stated that the Board refused the complaint, following which it became apparent to the representative that a further discussion on this issue was pointless.

XVII. Oral proceedings were held before the EBA on 10 July 2017. At the oral proceedings the petitioner argued that petition grounds E, F and G were admissible and that grounds D and H were allowable. The petitioner submitted that an objection under Rule 106 EPC in respect of the petition grounds E, F and G could be inferred generally from the petitioner's submissions. These had to be interpreted even when the objection was not made explicitly. The petitioner considered that the minutes were not relevant in this respect, because only the

decision carries legal relevance. Concerning allowability of ground D, it was argued that the petitioner submitted specific arguments on added subject-matter in the oral proceedings but these were ignored by the Board. As to the allowability of ground H, the reasons given under grounds F and G were well known to the Board so that it ought to have taken them into consideration of its own motion. For petition grounds A to C the petitioner relied on its written submissions.

XVIII. The petitioner requests that

- the decision under review be set aside and the proceedings be re-opened,
and further, conditional on the success of the request on the decision under review,
- the members of the Board who participated in the decision under review be replaced, and
- reimbursement of the fee for the petition for review be ordered.

Reasons for the decision

1. The petitioner is adversely affected by the decision under review, and the petition was filed in accordance with the formal requirements pursuant to Article 112a(4) EPC and Rule 107 EPC.

Admissibility of the petition (Rule 106 EPC)

2. The petitioner explicitly stated that petition grounds A to D concern missing reasons in the written decision of the Board. The same is implicitly argued for the petition ground H. The EBA is satisfied that the

petitioner could only have realised upon receipt of the written decision that its arguments were ignored by the Board, or that the decision did not deal at all with important issues. The EBA is satisfied that the petition is not clearly inadmissible in respect of these grounds. (Rules 106 and 109(2)(a) EPC).

3. Given that there is at least one admissible petition ground, the petition is admissible.

*Petition ground E - Fundamental procedural defects
(Article 112a(2)(d) EPC): Decision on an auxiliary request
before the main request, no decision on a request*

4. It is apparent from the nature of the objection and it is consistent with the minutes that the petitioner was aware of the alleged procedural defect and it would have been possible to raise an objection under Rule 106 EPC in the oral proceedings.
5. The EBA pointed out in its communication (see point XIV above) that contrary to the statement of the petitioner (page 4, end of 2nd paragraph of the petition), there is no evidence in the file that such an objection was raised by the petitioner in the appeal proceedings. The EBA also pointed out that a correction of the minutes was apparently not requested, nor did the petitioner call the correctness of the minutes into question in the petition itself.
6. The petitioner submitted in its response to the communication (point XV above) and also in the oral proceedings before the EBA that a proper objection was made, as testified by its representative (point XVI

above), and that he saw no need to raise the question of the correctness of the minutes, either separately or later in the petition. In this respect the petitioner argued that unlike the decision, the minutes have no legal force, and requesting their correction is merely a possibility, but it is not obligatory.

7. The EBA considers that under the circumstances as presented by the petitioner, he would have been expected to object immediately to an omission from the minutes of his objection, already in view of Rule 124(1) EPC. There can be no doubt that a formal objection under Rule 106 EPC, entailing serious legal consequences, is a "relevant statement" of a party for the purposes of Rule 124(1) EPC. For all parties, and also for the EBA the minutes of the oral proceedings serve as the authentic record of such relevant statements. In this regard, reference is made to the Case Law of the Boards of Appeal (CLBA) 8th Edition, 2016: Chapter IV.F.3.5.4., and the decisions cited therein, see in particular R 0006/14 of 28 May 2015, Point 7 of the Reasons. While it is true that there is no strict formal obligation on parties to request a correction, not doing so will leave them with the burden of proof against the minutes in case of dispute. The EBA notes that even the Guidelines explicitly foresee that an affected party requests a correction of the minutes, see Guidelines, Part E, Chapter II.10.4, from the version June 2012 onwards, and essentially unchanged since. The EBA is well aware that the Guidelines are only binding for the proceedings of the first instance, nevertheless it illustrates that diligent parties can be expected to take certain steps even in the absence of specific provisions in the Convention itself.

8. The EBA finds it plausible and as such not improbable that the petitioner argued in the oral proceedings before the Board that the order of discussion of the requests should be different. The minutes are silent in this regard. However, a mere argument against the proposed procedure of the Board cannot be considered as a formal objection under Rule 106 EPC. Rather, such an objection must be made in a form so that it is immediately and doubtlessly evident that the objection is a formal one under Rule 106 EPC. Reference is made to the CLBA 8th Edition, 2016: Chapter IV.F.3.5.2.
9. In fact, the petitioner conceded at the oral proceedings before the EBA that an explicit and unmistakeable reference to Rule 106 EPC or to a violation of the right to be heard were possibly not made in the context of the discussion on the order of the requests. In this respect the petitioner contends that this was not necessary, as the Board had an inherent obligation to correctly interpret the petitioner's submissions. The EBA rejects this argument. Contrary to the opinion of the petitioner, the Board had no obligation to interpret a simple counter-argument made in the course of the discussion as a formal objection under Rule 106 EPC.
10. The petitioner also submitted that an objection under Rule 106 EPC was not possible in the sense of this rule, as the expected objection "could not have been raised in the appeal proceedings" after the decision by the Board to discuss the main request only after the auxiliary requests, because the objection would have become "obsolete". The EPA rejects this argument. Firstly, this submission plainly contradicts the statement in the

petition, namely that an objection was actually made. Secondly, such an objection under Rule 106 EPC can and should be made as long as the cause of the objection can be remedied by the Board. This was the case here. It is clear that the oral proceedings were not over even after the discussions on the main request, and the Board had the power to re-open the debate on either the main or the auxiliary requests.

11. The petitioner submitted that the petition ground E can also be subsumed under Article 112a(2)(c) EPC, and as such did not require an objection under Rule 106 EPC in order to be admissible. This is incorrect as Rule 106 EPC explicitly refers to all the petition grounds under Article 112a(2)(a) **to** (d) EPC (emphasis by the EBA), i.e. also including the petition ground under Article 112a(2)(c) EPC.
12. In summary, the EBA holds that under the circumstances of this case an objection under Rule 106 EPC could and should have been filed, but was not. Therefore, the petition ground E is inadmissible pursuant to Rule 106 EPC, and as such clearly inadmissible for the purposes of Rule 109(2)(a) EPC.

Further procedural violations

Petition grounds F and G - Error by the European Patent Organisation/ Loss of patent on a "formalistic issue"

13. The EBA understands the objections F and G as petition grounds on their own, and not merely additional arguments in support of the other and separate petition grounds. However, this does not change the fact that

they cannot be subsumed under any of the provisions of Article 112a(2) EPC, as pointed out by the EBA in its communication.

14. The petitioner argued that the petition grounds F and G are to be subsumed under Articles 112a(2)(c) and 113 EPC, the latter being expressions of the requirement for a fair procedure in general. The principle of a fair procedure is also recognised in the Contracting States and as such is a principle which must be taken into account by the EPO pursuant to Article 125 EPC. Furthermore, the present case was special, so that there was room to treat the petition grounds F and G under Article 112a(2)(c) EPC.
15. Article 113 EPC is restricted to two specific aspects of the procedure before the EPO, and in this manner, Article 112a(2)(c) EPC is similarly restricted to the violation of these two specific aspects, see also below at point 18. The EBA concurs with the petitioner that Article 113(1) EPC in particular concerns an aspect of a fair procedure. However, it is not possible to draw the inverse conclusion, namely that any unfairness in the procedure, whether real or merely perceived, will immediately and automatically mean a violation of Article 113 EPC. In this manner, it is not apparent to the EBA why the petition grounds F and G would fall under Article 112a(2)(c) EPC. It is settled case law of the Enlarged Board of Appeal that Article 112a EPC contains an exhaustive list of petition grounds, see CLBA 8th Edition, 2016: Chapter IV.F.3.3.2. Article 125 EPC expressly states that it is only applicable "in the absence of procedural provisions in the Convention". This is not the case here, and already

for this reason Article 125 EPC cannot be the basis for extending the scope of Article 112a EPC. These considerations hold also for "special" cases, apart from the fact that it is not apparent to the EBA what would make the present case special.

16. As stated in the communication of the EBA, it is manifest that none of the provisions of Articles 112a(2)(a), (b) or (e) EPC are applicable, while Article 112a(2)(d) EPC is not applicable absent a corresponding provision in the Implementing Regulations. The petitioner did not question these findings of the EBA.

17. Thus the Enlarged Board holds that the petition grounds F and G do not fall under any of the provisions of Article 112a(2)(a) to (e) EPC, and as such are not admissible.

Allowability of the petition

Petition grounds A to C

18. The Enlarged Board notes that Article 112a(2)(c) EPC is specifically limited to a fundamental violation of Article 113 EPC. This article is directed to two distinct issues: the right of a party to comment on decision grounds (Article 113(1) EPC), and the right of the proprietor to determine the text of the patent and the obligation of the EPO to base its decision only on a text which is approved by the proprietor (Article 113(2) EPC). All three grounds A to C appear to invoke the first issue, and only a part-aspect of C relates to the second issue.

Petition grounds A and B - missing reasons on claims as upheld by the Opposition Division

19. The Enlarged Board agrees with the petitioner that it is a corollary of the right to be heard in the sense of Article 113(1) EPC that under certain circumstances the absence of reasons in a decision may constitute a violation of this right.
20. The petition grounds A and B are related to the claims as upheld by the Opposition Division. These claims were pending at the beginning of the oral proceedings, as the Second Auxiliary Request, but were later withdrawn (together with other auxiliary requests), by way of replacing them with a set of auxiliary requests filed at the oral proceedings before the Board.
21. It may be true that the written decision of the Board did not permit either the petitioner or any other party to "understand why the decision of the Opposition Division was overturned". However, it was the free decision of the petitioner to replace the pending auxiliary requests with new ones before the final decision of the Board. In this manner the Board no longer had the competence to formally decide on them in the final decision because they were no longer in the proceedings. This follows from the principle of party disposition, according to which it is in the hands of a party to determine the subject-matter on which the EPO should decide. This principle is expressed in Article 113(2) EPC, see e.g. the commentary Singer-Stauder: Europäisches Patentübereinkommen, 7th Edition 2016, page 1074, Randnr. 7 to Article 113 and generally the chapter on Article 113(2) EPC. Thus no fundamental violation of Article 113(1) EPC exists as

regards this issue. On the contrary, giving reasons on withdrawn requests might well have given rise to an objection under Article 113(2) EPC.

Petition ground B - missing explanation of the fate of earlier requests

22. There was no need to include in the decision more details of the proceedings than absolutely necessary for understanding the substantive findings of the Board on the requests that were actually in the proceedings when the Chairman announced the decision. Otherwise the course of events was recorded in the minutes, so for any objective observer it is quite clear from the publicly accessible documents in the file why the claims as upheld were no longer mentioned in the decision.

Petition ground C - lack of reasoning on the admission of the main request and the order of treatment of requests

Lack of reasoning on the admission

23. The EBA considers that this ground falls under Article 113(1) EPC, and notes that this provision seemingly does not distinguish between decisions of the EPO which are for or against a party, but rather seems to dictate that a party must be heard in any case. The absence of the reasons is used to imply that the petitioner was not heard on the issue of the admission (even if the minutes do not support this contention). However, only parties adversely affected by a decision may file a petition. The term "fundamental violation" in Article 112a(2)(c) EPC must also be read in this light. An alleged violation cannot be fundamental, in the sense

of "intolerable" (see CLBA 8th edition, 2016: Chapter IV.F.3.1, 2nd paragraph), if it does not cause an adverse effect. The petitioner did not explain and the EBA itself cannot see what adverse effect might have been caused by not hearing the petitioner on this issue, given that the admission of the petitioner's main request was clearly a positive result for the petitioner.

24. Thus the omission of the reasons for the admission of the main request may not be a practice which is expressly endorsed by the Enlarged Board, it is not seen as a fundamental violation of Article 113(1) EPC under the circumstances of the present case.

Order of treatment of requests

25. As a matter of principle, the Board was free to examine the (pending) claim requests in any order, and therefore it was also free to conduct the discussion on them in any order, without having to give reasons. The principle of party disposition expressed in Article 113(2) EPC does not extend so as to permit a party to dictate how and in which order a deciding body of the EPO may examine the subject-matter before it. In written proceedings this would be impossible for a party to control anyway. The only obligation on the EPO is not to overlook any still pending request before a final decision is taken. The order of examination or discussion is a question of procedural economy, for which mainly the deciding body is responsible. As long as a discussion on the substantive issues of the still pending requests is possible, even if only by reference to discussions on other requests (see R 0006/11 of 4 November 2011, Reasons, point 5.2), such a procedure is unobjectionable and the Board has no

particular duty to give reasons why it chose to proceed as it did. Thus the petition ground C is clearly unallowable.

Petition ground D - violation of the right to be heard

26. Concerning the objection D, the Enlarged Board is also unable to see a violation of Article 113(1) EPC. The substantive outcome of the contested decision of the Board, i.e. the revocation of the patent was based on two distinct issues (apart from the admission of the main request, which was not adverse to the petitioner). The first issue was the non-compliance of the main request (claims as granted) with Article 123(2) EPC. The second issue, the non-admission of the newly filed auxiliary requests, was not criticised in the petition.
27. Concerning this latter issue, after receipt of the communication of the EBA the petitioner submitted that the petition also extended to the non-admission of the requests filed during the oral proceedings, but was unable to provide any identifiable basis for it in the petition itself. The EBA therefore disregards this issue, and deals only with the first one, the treatment by the Board of the Article 123(2) EPC objection.
28. The alleged non-compliance with Article 123(2) EPC could not have surprised the petitioner. The objection was already raised in the opposition proceedings. The Opposition Division referred to it in its preliminary opinion dated 21 November 2013 (point 6 on page 5). The decision of the Opposition Division does not discuss the patent as granted, because it was not maintained as a request by the proprietor, Nevertheless, Article 123(2)

EPC issues were discussed in the decision in great detail. On appeal before the Board, appellant-opponent 2 raised Article 123(2) EPC objections against the main request in its reply (besides arguing the general inadmissibility of the proprietor-appellant's main request). The communication of the Board referred to these issues and also identified the objected to feature, the "only two bearings". The response to the Board's communication by the respondent opponent 1 takes it up again. The decision of the Board discusses the issue of added subject-matter on several pages (points 2.1-2.4). Thus on the basis of the file, the objection under Article 123(2) EPC and specifically against the "only two bearings" feature was an issue throughout the proceedings.

29. It is not apparent that the petitioner wanted to, or indeed did provide some other and crucial arguments on the question of added subject-matter in the written phase of the proceedings. In all three of its written submissions in the appeal proceedings the petitioner merely referred to the earlier discussions on this issue, apart from arguing generally on the interpretation of the claim features, such as the axial or radial type of the bearing.
30. The Board's decision contains arguments, mostly references to the description, which are stated to come from the proprietor-appellant. It must be presumed that these arguments were first presented in the oral proceedings, and the Board obviously took them into account.
31. The petitioner submitted in its response to the communication of the EBA and further in the oral

proceedings before the EBA that it had raised several specific arguments on the issue of added subject-matter, which were not reflected anywhere in the decision. These were the following: (a) conclusions which could be derived from the axial and radial arrangement of the bearings, as explained by the petitioner's representative in the oral proceedings, (b) the wording of dependent claim 6: "the two bearings", with special emphasis on the wording "the", and finally (c) legal arguments generally on the question of original disclosure. The petitioner further stated that the issue of added subject-matter was extensively discussed before the Opposition Division, and the Board had a duty to study the whole file, hence also the earlier submissions of the petitioner.

32. In light of the file and the additional submissions of the petitioner, it is apparent that the petitioner was fully aware of the Board's and the opponents' objections under 123(2) EPC. The petitioner was given a full opportunity to present its case, also including its own arguments mentioned above. Thus there cannot be any violation of Article 113(1) EPC in this regard.
33. The question remains if the Board violated this article by not addressing in detail the specific arguments of the petitioner as set out in point 31 above.
34. These specific arguments are nowhere mentioned in the petition itself. The part of the petition that can be understood to relate to the allegedly overlooked argument(s) of ground D does not go beyond the generally worded argument which is cited in point XI, paragraph (D).

35. This general argument was clearly considered by the Board, in that the Board carefully analysed the “overall change in the content”, namely the “only two bearings” which is not found in the application as filed. Further the Board also examined what the skilled person would understand from the application (e.g. in point 2.3 of the Reasons), and it is also clear from the overall wording of the reasons in the contested decision that the Board was looking for an implicit teaching. It is possible that the petitioner formulated its arguments in different terms than the Board, but it is not required that a Board uses the very same words as a party (R 0013/12 of 14 November 2012, Reasons, point 2.2). Thus the decision of the Board is sufficiently reasoned and there is no violation of Article 113(1) EPC.
36. To the extent that the specific arguments advanced by the petitioner in the oral proceedings merely served to argue its general case, i.e. that the “only two bearings” feature was allowable under Article 123(2) EPC, the Enlarged Board points to the settled case law, according to which it is not necessary to consider each and every argument of the parties in detail (see CLBA 8th edition, 2016: Chapter IV.F.3.13.10,). Thus not addressing these arguments individually in the decision is not necessarily a fundamental violation of the petitioner’s right to be heard. Apart from that, the question of the axial and radial bearings is analysed in detail in the decision.
37. If the petitioner’s case of a fundamental violation of Article 113 EPC rested on the overlooking of any of these specific arguments, it would have been necessary to explicitly identify the overlooked specific argument or arguments already in the petition. The EBA notes that

Rule 109(3) EPC requires that the EBA decides "on the basis of the petition", i.e. the central arguments of the petitioner must be apparent from the petition. This is also demonstrated by the wording of Article 12(1) RPEBA, which explicitly refers to Rule 109(3) EPC, and permits the Enlarged Board to consider new submissions "if this is justified for special reasons", i.e. only exceptionally. No such special reason has been advanced and the EBA cannot identify any.

38. The EBA also rejects the argument that the Board should have known and therefore should have considered the petitioner's arguments from the file, as presented before the Opposition Division. The Board had no obligation to peruse the whole file of the first instance proceedings. It is the duty of the parties to raise issues again in the appeal proceedings, to the extent necessary, as stipulated by Articles 12(1) and (2) RPBA: "Appeal proceedings shall be based on [the submissions of the parties filed **in the appeal proceedings**, which] ... should specify expressly all the facts, arguments and evidence relied on".
39. The EBA finds that petition ground D is clearly unallowable in the sense of Rule 109(2)(a) EPC.

Petition ground H – lacking reasons with respect to petition grounds F and G

40. The EBA notes that the arguments forming the petition grounds F and G do not appear anywhere in the written submissions of the appeal proceedings. Neither in the petition, nor in its response to the communication of the EBA did the petitioner state that these arguments

belonged to its core arguments on the decisive issue of the "only two bearings". In fact, the petition did not state at all that the petition grounds F and G were actively argued before the Board, but merely implied that these arguments ought to have been taken into account by the Board of its own motion.

41. Although this issue was raised by the EBA in its communication, the petitioner, apart from acknowledging its admissibility under Rule 106 EPC, has said nothing on ground H. In the oral proceedings before the EBA the petitioner merely submitted that the grounds F and G were obviously known to the Board and ought to have been considered under the aspect of general fairness by virtue of Article 125 EPC.
42. On the basis of these submissions the EBA finds that at no time during the appeal proceedings were the petition grounds F and G presented as a specific argument, as regards the allowability of the amendment resulting in the "only two bearings" feature.
43. Even when assuming, for the benefit of the petitioner, that the arguments were explicitly made in the course of the discussion on the "only two bearings" amendment, (presumably in the oral proceedings before the Board), the EBA fails to see how these arguments could have been expected to influence the decision on the issue of the amendment, a purely technical issue which needs to be decided from the point of view of the skilled person and on the basis of the application as filed, and nothing else. It is not apparent that the course of the examination or the existence of an infringement action should have played any role for the Board in deciding the

issue under Article 123(2) EPC, contrary to the opinion of the petitioner. To that extent the Board could not have been reasonably expected to address these arguments in any detail. The Board may disregard irrelevant arguments, see e.g. R 0013/12 *supra*, Reasons, point 2.2.

44. Against this background, and in view of the reasons given above at point 36 in connection with the petition ground D, the EBA finds that the Board did not have to address the arguments underlying the petition grounds F and G. Thus the Board's omission of these arguments in the written decision is not a violation of Article 113(1) EPC. The petition ground H is clearly unallowable.
45. In summary, objections A to D and H are clearly unallowable, and objections E to G are clearly inadmissible, so that the petition as a whole must be rejected under Rule 109(2)(a) EPC.

Order:

For these reasons it is unanimously decided that:

The petition for review is rejected as partly clearly inadmissible and as partly clearly unallowable.

The Registrar

The Chairman

C. Eickhoff

D. Rogers