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**Datasheet for the decision  
of 28 May 2018**

**Case Number:** R 0006/17  
**Appeal Number:** T 0751/16 - 3201  
**Application Number:** 05017320.2  
**Publication Number:** 1625971  
**IPC:** B60Q3/04, B60K37/00  
**Language of the proceedings:** EN

**Title of invention:**  
Vehicle interior illumination structure

**Patentee:**  
Mazda Motor Corporation

**Opponent:**  
Daimler AG

**Headword:**  
Petition partially clearly inadmissible and partially clearly unallowable

**Relevant legal provisions:**  
EPC, Art. 101(3)(b), 112a(2)(c), (4), 113(1), 114  
EPC, R. 106, 109(2)(a)  
RPBA, Art. 12(2), 13(1), (3), 15(1)  
RBEB A, Art. 13, 14(2)

**Keyword:**  
Obligation to raise objections - objections raised (yes/no)  
Fundamental violation of the right to be heard (no)  
Review of substantive law excluded

**Decisions cited:**  
R0001/08, R0010/09, R0012/09, R0009/10, R0009/11, R0010/11,  
R0011/11, R0013/11, R0017/11, R0001/13, R0004/13, R0005/13,

R0007/13, R0009/13, R0010/13, R0011/13, R0012/13, R0013/13,  
R0014/13, R0004/14, R0003/15, R0006/15, R0005/16,  
T1557/05, T1883/12

**Catchword:**

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**Große Beschwerdekammer**  
**Enlarged Board of Appeal**  
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Case Number: R 0006/17

**D E C I S I O N**  
of the **Enlarged Board of Appeal**  
of **28 May 2018**

**Petitioner:**  
(Opponent)

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**Decision under review:**

**Decision of the Technical Board of Appeal 3201  
of the European Patent Office of 6 March 2017.**

**Composition of the Board:**

**Chairman:** C. Josefsson  
**Members:** I. Beckedorf  
D. Semino

## **Summary of Facts and Submissions**

- I. The petition for review lies from a decision of Technical Board of Appeal 3.2.01 in case T 751/16 of 6 March 2016 (hereafter: the Board) on an appeal against the decision of the opposition division to revoke European patent No. 1625971 pursuant to Article 101(3)(b) EPC.
  
- II. The patent proprietor filed an appeal against that decision and argued why, contrary to the appealed decision, the subject-matter of claim 1 of the patent as granted (hereinafter: claim 1) was novel over D4 and also inventive in view of that document. In their reply to the patent proprietor's statement setting out the grounds of appeal, the petitioner (opponent and respondent to the patent proprietor's appeal) essentially argued lack of novelty and inventive step (main and auxiliary requests) on the basis of D4. After the summons to oral proceedings and after the notification of the communication pursuant to Article 15(1) RPBA (hereinafter: the Board's preliminary opinion), the petitioner submitted a new line of argument for lack of novelty and inventive step based upon the disclosure of D2. The patent proprietor objected to the admittance of this new attack into the appeal proceedings.
  
- III. The Board held oral proceedings in the course of which the parties were heard in particular on the issues of novelty of the subject-matter of claim 1 over D4, inventive step of the subject-matter of claim 1 starting from D4 as closest prior art, and the admittance into the appeal proceedings of the new submission based on D2. After the Board had informed the parties of its positive opinion in respect of novelty and inventive step of claim 1, the

petitioner raised an objection under Rule 106 EPC. The petitioner reasoned the objection essentially by arguing that D2 had been filed with the notice of opposition but the decision under appeal had been based only on D4. The reference to D2 as a highly relevant novelty-destroying document became relevant in the appeal proceedings only because of a certain interpretation of the claimed subject-matter by the Board. The written petitioner's objection was submitted in German and annexed to the minutes. Said objection and their request that the case be remitted to the opposition division for further examination of novelty of the subject-matter of claim 1 over D2 were discussed with the parties.

- IV. In the decision under review the Board allowed the patent proprietor's appeal while dismissing the petitioner's request for remittal of the case to the opposition division and their objection under Rule 106 EPC. In the reasons, the Board explained why the subject-matter of claim 1 was novel and inventive with regard to D4 (Reasons, points 2 to 2.4.1); this part of the decision, however, has no bearing on the petition for review. In respect of the submissions concerning lack of novelty over and inventive step in view of D2, the Board exercised its discretion under Article 13(1) RPBA not to admit them into the proceedings - irrespective of the relevance of D2 - due to the substantial amendment of the party's case with complex technical issues and for reasons of procedural economy (Reasons, points 3 to 3.4) and rejected the petitioner's request to remit the case to the opposition division to examine novelty of the contested invention based on D2 (Reasons, point 4); this part of the decision is contested by the petitioner. The Board noted that the petitioner had failed to comply with the requirements of

Article 12(2) RPBA to present "the complete case" which could challenge the patent at the outset of the appeal proceedings. Instead the petitioner had introduced D2 as an amendment to their case, which had been triggered neither by the Board's preliminary opinion nor by an alleged new interpretation of the claim features. Since the appeal proceedings were wholly separate and independent from the opposition proceedings, the D2 novelty objection previously made did not automatically become part of the appeal proceedings. Rather, the submissions based on D2 represented a fresh case presented at a late stage of the proceedings that would require a substantially different discussion as compared to the case based on D4. Admitting these new attacks would be incompatible with the need for procedural economy (Reasons, points 3.2 and 3.3). The objection under Rule 106 EPC was dismissed because the petitioner had been heard on this issue and the Board did not deviate from the relevant case law (Reasons, point 5 *et seq.*).

- V. The petitioner filed a petition for review claiming four fundamental procedural deficiencies:

*(1) Non-admittance into the appeal proceedings of D2 and the respective novelty and inventive step attacks*

The petitioner essentially argued that the Board violated their right to be heard when it decided not to admit D2 and their submissions based on D2. At least some of the considerations of the Board when exercising its discretion, as laid down in points 3.1 to 3.3 of the Reasons, were incorrect and/or based on erroneous assumptions, thus, rendering the decision wrong. In the petitioner's view, an accurate exercise of the discretion under Article 13 RPBA

should have led to admitting D2 into the appeal proceedings for the following reasons:

- (a) D2 became highly relevant because of a new interpretation of the teaching of D4 in view of the claimed subject-matter mentioned for the first time in the Board's preliminary opinion. It led to a new approach to D2 to the effect that it became novelty destroying. The petitioner had reacted to it without any delay four weeks before the oral proceedings.
- (b) Since the Board itself had triggered the recourse to D2, it would have had to either admit that document into the proceedings and allow the petitioner to submit a new line of argument based on it or remit the case to the opposition division for further prosecution.
- (c) Thus, the Board was mistaken in its conclusion that the petitioner had created a "fresh case" (Reasons, point 3.3) and would have been obliged to consider D2 as well in order to avoid infringement of Article 113 EPC.
- (d) Admitting D2 and discussing it would not have substantially delayed the proceedings because D2 was a clear and concise document already introduced into the preceding proceedings. In this context the petitioner noted that the Board had in fact considered D2, having held that the opposition division had found D2 not novelty-destroying (Reasons, point 3.2).
- (e) The Board's argument that the appeal proceedings were a completely separate and independent procedure was not a pertinent point because the appeal proceedings were linked to the opposition proceedings. The new interpretation of D4 and the claimed subject-matter affected the review of the patent in the light of this new interpretation and the other documents.
- (f) The Board, when exercising its discretion under Article 13(1) RPBA, had erred in its position that

procedural economy outweighs the criterion of *prima facie* relevance (Reasons, point 5.2). In doing so, the Board had exceeded its discretion contrary to the objective of the EPC.

*(2) Incorrect assumption by the Board*

The petitioner alleged an incorrect assumption by the Board in relation to the technical effect of a distinguishing feature f) as a starting point for the consideration of the inventive step. Whereas the Board had deduced the technical effect of the distinguishing feature from the description of the patent in suit, the petitioner had relied upon the "correct" technical effect of that feature and had "assumed" that the Board had done so as well. The Board had never given an indication to the contrary, thus leaving the petitioner with no opportunity to comment on the Board's wrong assumption.

*(3) Lack of reasoning concerning the combination of documents D4 and D1*

The petitioner claimed a further violation of Article 113 EPC, as the Board had failed to decide and reason on inventive step in the context of a combination of the teachings of D4 and D1, even though this had been discussed during the oral proceedings.

*(4) Alleged other fundamental procedural defect*

The petitioner considered it a fundamental procedural defect that the Board did not rule on the patent proprietor's request for accelerated processing. The petitioner became aware of this deficiency only after the end of the oral proceedings when it was obvious that the request would no longer be decided. Had the Board wanted to decide or had it decided on this request, it would have



had to deal with the allegation of patent infringement justifying the request for acceleration. In that event, the Board should and would have recognised that there was actually no infringement of the patent.

VI. The Enlarged Board as composed under Rule 109(2)(a) EPC issued a communication pursuant to Articles 13 and 14(2) RPEBA informing the petitioner of its preliminary view that the petition for review appeared to be in part clearly inadmissible and in part clearly unallowable. The petitioner commented in detail on said communication, *i.a.* in respect of complaint (1) by new lines of argument based upon decision R 3/15 (not published in the OJ EPO) and the need to understand and apply Article 13 RPBA in the light of Article 113(1) EPC. In respect of complaint (4), the petitioner argued that the Board conducted the appeal proceedings in a procedurally restrictive manner as if it had granted the patent proprietor's request for accelerated processing.

VII. Oral proceedings before the Enlarged Board were held on 28 May 2018 at which the petitioner as the only party essentially reiterated their earlier written submissions and clarified their requests as follows:

that the decision under review be set aside,

that the proceedings before the Board of Appeal be re-opened,

that the members of the Board of Appeal who participated in taking the decision under review be replaced, and

that the fee for the petition for review be reimbursed.

At the end of the oral proceedings the decision was announced.

## **Reasons for the Decision**

### **1. Scope of the petition**

As clarified by the petitioner during the oral proceedings, the present petition for review is built on the allegation that the appeal proceedings leading to the decision under review involved a fundamental violation of the petitioner's right to be heard (Articles 112a(2)(c) and 113(1) EPC) in that

- (1) the Board had refused to admit into the appeal proceedings D2 and the petitioner's novelty and inventive step attacks based on this document under Article 13(1) RPBA;
- (2) the Board had based its decision on an incorrect assumption with respect to the definition of the technical effect of the distinguishing feature;
- (3) the Board had not decided on or, at least, had not reasoned why the claimed subject-matter involved an inventive step in view of the combination of the teachings of D4 and D1;
- (4) the Board had not decided on the patent proprietor's request for accelerated processing and had conducted the appeal proceedings in a procedurally restrictive manner as if it had granted that request.

### **2. Admissibility of the petition for review**

**2.1** The petitioner is adversely affected by decision T 751/16 setting aside the decision of the opposition division revoking European Patent No. 1 625 971, maintaining the patent as granted, and dismissing both the petitioner's requests for remittal of the case to the opposition division and their objection under Rule 106 EPC.

**2.2** The written decision was notified to the parties by registered letter with advice of delivery posted on 23 June 2017. As the reasoned petition was filed and the fee was paid on 22 August 2017, it also complies with Article 112a(4) EPC.

**2.3** Rule 106 EPC provides that a petition for review under Article 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

**2.4** The petitioner submitted an objection under Rule 106 EPC in respect of complaint (1) and argues that with regard to complaints (2) to (4) they could not have submitted any such objection because they became aware of the alleged deficiencies only after the Board had announced the decision at the end of the oral proceedings and/or notified the reasoned decision in writing.

**2.5** Rule 106 EPC has been clearly complied with as regards complaint (1).

**2.6** Concerning complaint (2) the petitioner objects to the definition of the technical effect of the uncontested distinguishing feature f) of claim 1 by the Board and argues that they were denied an opportunity to make submissions on this issue because they had assumed that the Board would define the technical effect differently, *i.e.* correctly as they had themselves done. However, the Board had already indicated the definition of the technical effect in its preliminary opinion under point 1.1: "The effect and the problem to be solved with the ornament seem to be described in paragraph [0051] of the published application (cf. P [0054] of

the patent description)." It is this definition mentioned by the Board in the decision under review (point 2.3 on page 10, last paragraph) that the petitioner referred to as critical. The issue of inventive step of the claimed subject-matter, of which the definition of the technical effect of the distinguishing feature forms an indispensable part, was discussed with the parties at the oral proceedings (cf. minutes of the oral proceedings before the Board, page 2, second indent).

Against this background, the petitioner's allegation that they had no opportunity to submit arguments on the Board's "incorrect" definition of the technical effect, and that, therefore, they had been denied the right to be heard, remain incomprehensible and are considered as a sweeping argument. Rather, the Enlarged Board notes that, whilst the assessment of inventive step cannot be considered in review proceedings (cf. R 1/08, Reasons, point 4; R 12/09 of 15 January 2010, Reasons, point 14; R 14/13, Reasons, point 6.2.4.2; R 6/15, Reasons, point 13, none published in the OJ EPO), the petitioner had been given the opportunity to submit their arguments in the course of the discussion of inventive step on the basis of the well-established problem-solution-approach, which includes *i.a.* the issue of the technical effect of the distinguishing features.

Hence, due to a lack of comprehensive substantiation by the petitioner in respect of complaint (2) the Enlarged Board cannot identify a deficiency in the appeal proceedings to which the petitioner could not have been objected before the Board announced the decision under review.

**2.7** Regarding complaint (3) the petitioner criticises a lack of reasoning of the decision under review with regard to a line of argument for lack of inventive step in view of a combination of the teachings of D4 and D1. The petitioner

alleges that this issue was discussed at the oral proceedings. However, the minutes of the oral proceedings before the Board mention only D4 in the context of the discussion about inventive step of the subject-matter of claim 1 and the Board's conclusions, of which the parties were informed by the Chairman after the deliberation of the Board (cf. minutes of the oral proceedings before the Board, page 2, second indent and the following paragraph). Likewise, the Board's preliminary opinion is silent as to D1, which had been mentioned in the petitioner's reply letter to the patent proprietor's statement setting out the grounds of appeal only randomly (cf. letter of 11 October 2016, one sentence each on pages 21 and 22). It is further noted that the minutes were sent to the parties by registered letter dated 10 March 2017, *i.e.* four days after the date of oral proceedings, and that the petitioner neither objected to nor requested a correction of the minutes. The minutes are to be considered a sound reproduction of the course of the oral proceedings before the Board from which it could be deduced that the petitioner had had ample opportunity to remind the Board of the need to discuss the teaching of D1 and to submit an objection under Rule 106 EPC in the event of the Board refusing that discussion.

As a consequence, the petitioner's complaint (3) is to be qualified as either unsubstantiated or, at least, precluded from further assessment due to the omission of an objection under Rule 106 EPC.

**2.8** Complaint (4) of the petitioner is directed to a request for accelerated processing filed by the patent proprietor (*sic!*, cf. letter of 25 May 2016, page 1) objected to by the petitioner (cf. letter of 11 October 2016, point 2 on page 2). Even if the petitioner was right in their contention that the Board had failed to decide on this request, the petitioner was

by no means negatively affected by the alleged deficiency. The petitioner attempts to justify an adverse effect by arguing

- (a) that the Board had conducted the proceedings in a restrictive manner as if it had granted the request for accelerated processing, thus leaving the petitioner in uncertainty as to the potential need to adapt their strategy accordingly; and
- (b) that had the Board been obliged to deal with the allegation of patent infringement that justified the request for accelerated processing, it would have recognised that there was actually no infringement of the patent.

However, the petitioner misconceives the nature and scope of a request for accelerated processing. In deciding whether or not to allow such a request, the competent board of appeal merely needs to examine the circumstances that are submitted as justification for the request. Patent infringement proceedings or negotiations on licensing might be considered as justification. But there is neither a need nor an opportunity for a board of appeal to examine the likelihood of success of those proceedings or talks.

The Enlarged Board does not know why the Board did not decide separately on the request for accelerated processing. It is possible that the Board considered that the overall circumstances of the proceedings, in particular the summoning to oral proceedings only nine months after the commencement of the appeal proceedings, were a clear enough indication to the parties that the processing was indeed accelerated. In any event, it is up to the parties to address a point that they consider relevant and that they believe might be overlooked and, where appropriate, to make a formal application for it to be dealt with and for a ruling (cf. R 17/11, not published in the OJ EPO, Reasons, point 19). If then a Board of Appeal does not give a party the opportunity to bring forward its

arguments, this may give rise to the complaint that the right to be heard under Article 113(1) EPC was infringed. However, in the present case, this is obviously not the case. The petitioner confirmed during the oral proceedings before the Enlarged Board that they had understood the "restrictive manner" in which the Board had conducted the appeal proceedings as being the consequence of the patent proprietor's request for accelerated proceedings. Thus, the petitioner had obviously assumed that said requests had been granted and acted upon by the Board and, hence, they could and should have adapted their procedural strategy accordingly, or could and should have raised this issue either in writing or at the oral proceedings.

The Enlarged Board, therefore, is not in a position to identify a deficiency in the appeal proceedings of which the petitioner became aware only after the Board had announced the decision under review and/or after the reasoned decision had been notified in writing.

**2.9** For the aforementioned reasons, the petition for review is clearly inadmissible in respect of complaints (2) to (4), but not concerning complaint (1). As a consequence, the assessment of its allowability is limited to complaint (1).

### **3. Allowability of the petition for review with regard to complaint (1)**

The petitioner submits that the Board decided on the appeal in violation of Article 113(1) EPC in a manner that gave the petitioner no opportunity to introduce D2 into the appeal proceedings and present a new line of novelty and inventive step attack based on D2.

**3.1** It has to be borne in mind that review proceedings under Article 112a(2)(c) EPC are confined to procedural defects so fundamental as to be intolerable for the legal system and overriding the principle that proceedings that have led to a final decision should not be reopened in the interest of legal certainty and that substantive issues are excluded (consistent case law since R 1/08, not published in the OJ EPO, Reasons 2.1, and the *travaux préparatoires* there cited).

**3.2** The facts of the case, as taken from the minutes of the oral proceedings before the Board and from the decision under review, show that the Board was not only aware of the petitioner's substantive arguments in respect of the new novelty and inventive step attack based on D2 but also as regards the petitioner's arguments justifying the late submission (cf. minutes, pages 2 and 3; decision, Facts and Submissions, points V. and VII., Reasons, point 3). The Board, in particular, referred to the petitioner's arguments that the new submission had been made in reaction to the Board's preliminary opinion, that the petitioner had considered D2 highly relevant for novelty, and that D2 had already been in the appeal proceedings because it had been submitted during the opposition proceedings that were then reviewed by the Board. The petitioner's arguments had thus been considered in detail by the Board in exercising its discretion under Article 13(1) RPBA; Article 13(3) RPBA is applicable as well. Thus, in the decision under review the Board extensively recapped and discussed the key arguments put forward by the petitioner.

**3.3** Although the petitioner invokes that they were not given an opportunity to state their case in view of the alleged lack of novelty and inventive step of the subject-matter of claim 1 over the disclosure of D2, it is to be noted from the



aforementioned facts that the Board took its decision solely on the basis of the arguments submitted by and discussed with the parties.

The petitioner does not claim that the decision under review was guided by any other (*i.e.* non-discussed) matters and arguments on this. What the petitioner essentially refutes is not that the Board did not allow arguments to be submitted on matters that were then considered by the Board in exercising its discretion under Article 13(1) RPBA, but that the petitioner's arguments were wrongly "categorised" or "subsumed" under the requirements of said provision.

**3.4** Hence, it is to be concluded from the petitioner's own submissions that the alleged application of wrong criteria should be judged a fundamental procedural violation. The petitioner objects in particular to the Board's conclusion that the petitioner created a "fresh case" that added to complex technical issues requiring a substantially different discussion as compared to the case based on D4, and that it was contrary to procedural efficiency to admit it into the appeal proceedings.

**3.5** The discretionary power conferred to a board of appeal by Articles 12 and 13 RPBA and by Article 114 EPC necessarily implies that the competent board of appeal must have a certain degree of freedom in exercising its discretionary power. The Enlarged Board should review the way in which the board of appeal has exercised its discretion when deciding on a particular case and must not consider substantive issues. In accordance with the established jurisprudence of the Enlarged Board (cf. R 10/09, Reasons, points 3.2, 3.3 and 5; R 9/10, Reasons, points 7 to 10; R 9/11, Reasons, point 3.2.1; R 10/11, Reasons, point 5.2; R 11/11, Reasons, point 8; R 13/11, Reasons, point 4; R 1/13, Reasons, point 16.3; R 4/13,

Reasons, point 5.5; R 5/13, Reasons, point 15; R 7/13, Reasons, point 4; R 9/13, Reasons, point 15; R 10/13, Reasons, point 15; R 11/13, Reasons, point 15; R 12/13, Reasons, point 15; R 13/13, Reasons, point 15; R 4/14, Reasons, point 11; none of these decisions published in the OJ EPO; Case Law of the Boards of Appeal, 8<sup>th</sup> edition 2016, chap. IV.F.3.3.3, p. 1228, and chap. IV.F.3.13.16, p. 1240), the Enlarged Board has no power to control the normal exercise a board of appeal makes of its discretion. Rather, the exercise of discretion by a board of appeal is subject to only limited review. Thus, it is the task of the Enlarged Board to review whether the Board did not abuse its discretion in an arbitrary or manifestly illegal manner whilst respecting the petitioner's rights under Article 113(1) EPC.

**3.6** Article 13(1) RPBA reads:

*"Any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of **inter alia** the **complexity** of the new subject-matter submitted, the current **state of the proceedings** and the need **for procedural economy**."* (emphasis added)

The Enlarged Board notes that the "*prima facie*" relevance of a document, upon which the petitioner relies as the most significant criterion of Article 13(1) RPBA, is not listed explicitly in that provision; nor is it mentioned in Article 13(3) RPBA dealing with amendments of a party's case after the summons to oral proceedings. However, the list of criteria in Article 13(1) RPBA is non-exclusive ("*inter alia*"), and the criterion of *prima facie* relevance has been applied by some boards of appeal as one criterion amongst others (cf. Case Law of the Board of Appeal, *supra*, chap. IV.C.1.1.4, p. 933).

Nonetheless, when comparing the reasons given by the Board in the decision under review with the wording of Article 13(1) RPBA, it is obvious that the Board, while clearly referring to terms of Article 13(1) RPBA, took into consideration those criteria that are explicitly mentioned in that provision. In other words, the Board did not apply wrong criteria leading to an abuse of discretionary power; rather it took into account statutorily accepted, *i.e.* the right, criteria.

Moreover, contrary to the petitioner's conclusion, based on the case law on late-filed documents, that the *prima facie* relevance is the decisive criterion, this criterion is certainly neither the most relevant nor does it stand alone, *i.e.* without interdependence on other criteria. The interest in procedural expediency and procedural economy is also expressed in the common approach not to admit late documents which, *prima facie*, are no more relevant than what is already on file (cf. of T 1557/05, Reasons, point 2.4, and T 1883/12, Reasons, point 3.1.3, neither of which are published in the OJ EPO).

**3.7** Thus, the petition for review is not about an alleged error by the Board in choosing and applying the right and avoiding the wrong criteria but rather it is about whether the Board's exercise of discretion on the merits was correct or incorrect.

The petitioner may well disagree with the Board's conclusion, but the power of the Enlarged Board to review a decision as to the exercise of discretion within the framework of Article 112a EPC is limited and, in the case at hand, clearly cannot be justified on the basis of an alleged abuse of discretionary power.

**3.8** As to the alleged unreasonableness of the Board's exercise of discretion, the petitioner in particular argued

that the Board had been wrong in its assumptions that the petitioner had created a "fresh case", that admitting D2 had substantially delayed the appeal proceedings, and that the petitioner could have introduced D2 and their novelty and inventive step attack based on this document earlier in the appeal proceedings.

**3.9** The Enlarged Board notes that the Board dealt with these points in detail in the decision under review under points 3.2 and 3.3 of the Reasons:

*"3.2 ... It is only ... after receiving the communication of the Board according to Article 15(1) RPBA, that the respondent filed submissions concerning lack of novelty over D2 and lack of inventive step starting from D2. These submissions cannot be seen as a reaction to the communication ..., as the opinion of the Board in respect of whether some features of the claim are disclosed or not by D4 does not justify raising a case on novelty and inventive step based on another document. The Board, moreover, did not include any element, such as a new interpretation of the features of the claim, which was not already mentioned in the appellant's statement of grounds. ... Nor can the Board follow the respondent's argument that the objections based on D2 were already in the proceedings since D2 was mentioned in the notice of opposition.*

*According to the established case law of the Boards of Appeal the appeal proceedings are wholly separate and independent from the proceedings at first instance. This means that the respondent cannot assume that arguments submitted during the proceedings before the opposition division are part of the appeal proceedings.*

*For this reason the respondent should have presented "the complete case" and should have specified "expressly all the facts, arguments and evidence" in its letter of reply which could challenge the patent even if the first instance decision*

*and consequently the statement of grounds of appeal are not concerned with some of these arguments."*

*"3.3 Further, the Board considers that the submissions based on D2 represent a fresh case presented at a late stage of the appeal proceedings which would require a substantially different discussion as compared to the case based on D4. In particular, when evaluating novelty and inventive step, the Board would be faced for the first time with the technical content of D2 and the related questions such as for example ..."*

**3.10** The Enlarged Board cannot see anything "unreasonable" in the aforementioned reasoning of the Board, nor is there any contradiction of either the Board's preliminary opinion or the course of the written and oral proceedings before the Board. Since the Board's preliminary opinion did not mention a claim interpretation or a technical effect of feature f) of claim 1 that had not been submitted by the patent proprietor in their statement setting out the grounds of appeal (cf. pages 7 to 12), the petitioner was by no means obliged to wait until the Board had issued a preliminary opinion assessing the patent proprietor's submission as to why the opposition division had been wrong to find that the claimed subject-matter lacked novelty over the disclosure of D4. The fact that the Board in its preliminary opinion indicated to follow the patent proprietor in their argumentation cannot justify a new line of argument based on a different document (D2) in reaction to that preliminary opinion.

In this respect, the Enlarged Board notes that the petitioner did not submit circumstances justifying why it had not introduced their line of argument based on D2 for lack of novelty and inventive step of the claimed subject-matter already with their reply to the patent proprietor's statement setting out the grounds of appeal. Indeed, the preliminary opinion of the opposition division that D2 was not novelty-

destroying (cf. point 6.1 of the annex to the summons to oral proceedings), should have prompted the petitioner to include this issue into their reply letter in an attempt to present their complete case within the meaning of Article 12(2) RPBA. As to the complexity and delaying effect of the petitioner's new line of argument, the Enlarged Board is satisfied with the detailed reasons given by the Board in point 3.3 of the Reasons of the decision under review.

**3.11** Hence, the decision of the Board not to admit into the appeal proceedings D2 and the new line of argument based on this document for lack of novelty and inventive step does not appear so unreasonable as to lead to assume an abuse of discretionary power by the Board.

**3.12** In so far as the petitioner argues that the Board in its preliminary opinion, adopted a new, surprising interpretation of the teaching of D4 that had not been discussed by the parties or the opposition division before, and that the situation was comparable to the case underlining decision R 3/15 (not published in the OJ EPO), the Enlarged Board cannot follow this somewhat different and new line of argument. As explicitly confirmed by the petitioner, the Board did mention its allegedly new understanding of the teaching of D4 in its preliminary opinion on which the parties could comment. And the petitioner had indeed done so with letter of 8 February 2017 and at the oral proceedings. Hence, the petitioner could by no means have been surprised by the Board's reading of document D4. And since on an objective basis the petitioner could not have been surprised by the Board's view, on which the petitioner had had an opportunity to comment and on which they had indeed commented, the petitioner could have been taken only by a "subjective" surprise. Such a mere subjective surprise in itself, however,

does not imply that the petitioner's right to be heard had been violated (cf. R 5/16, not published in the OJ EPO, Reasons, point 19).

Therefore, for this very reason the petitioner cannot now claim a violation of Article 113(1) EPC.

**3.13** Moreover, there is no doubt that the petitioner had the opportunity to state their case in respect of all the issues on which the decision under review was taken in respect of the late-filed document and new line of argument.

Considering that the petitioner was legally represented and, therefore, should have been familiar with the procedural framework of the appeal proceedings, the petitioner was in a position to defend their rights both as to the procedural and as to the substantive law at all stages of the proceedings. And the petitioner did so as evidenced by the discussion during the oral proceedings before the Board and by their objection under Rule 106 EPC, which was discussed at the oral proceedings as well.

After all, the petitioner had not been prevented from submitting all documents and arguments it wished to bring to the Board's attention. The fact that the Board did not admit into the appeal proceedings D2 and the line of arguments based on it cannot be qualified as a formal denial of the petitioner's right to be heard.

Consequently, there is no basis for assuming that the petitioner did not have sufficient opportunity to comment exhaustively on all aspects on which the decision was taken. Thus, no violation of Article 113(1) EPC was committed by the Board.

**3.14** Investigating any further would involve a review of the decision under review on the merits. The mere fact that the petitioner does not share the view of the Board and does not

accept the outcome of the decision under review cannot justify further elaborating on this because it would necessitate assessing whether the Board had correctly understood the argumentation submitted by the parties to the appeal proceedings and, above all, given the right answer to it. Such a review of the merits of the decision of the Board would be beyond the scope of the petition for review proceedings as a specific and limited means of redress provided for in the EPC.

**3.15** For the aforementioned reasons, as far as the petition for review is not clearly inadmissible, it is clearly unallowable.

#### **4. Conclusion**

The petition for review, therefore, is in part clearly inadmissible (in respect of complaints (2) to (4)) and in part clearly unallowable (concerning complaint (1)).



**Order**

**For these reasons the Enlarged Board of Appeal as composed under Rule 109(2)(a) EPC unanimously decides:**

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

The Registrar:

The Chairman:

P. Cremona

C. Josefsson