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**Datasheet for the decision
of 18 June 2018**

Case Number: R 0008/17
Appeal Number: T 1477/15 - 3.2.02
Application Number: 01114582.8
Publication Number: 1145729
IPC: A61M25/00, A61M25/01
Language of the proceedings: EN

Title of invention:

A ready-to-use urinary catheter assembly

Patent Proprietor:

Coloplast A/S

Opponents:

Hollister Limited
Dansac A/S
Kain-Märk Gesellschaft m.b.H.
Medical4You B.V.

Headword:

Violation of right to be heard/HOLLISTER

Relevant legal provisions:

EPC Art. 56, 76(1), 112a, 113(1), 123(2)
EPC R. 106, 107, 108(3), 109, 126(2)
RPBA Art. 13(3)

Keyword:

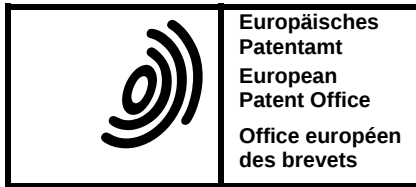
Raising of objection under Rule 106 EPC (no) - petition
clearly inadmissible in part
Violation of right to be heard (no) - surprise reasoning (no)
- ignoring of essential arguments (no) - petition clearly
unallowable in part

Decisions cited:

R 0001/08, R 0004/08, R 0021/09, R 0017/10, R 0023/10,
R 0006/12, R 0015/12, R 0019/12, R 0008/13, R 0013/13,
R 0016/13, R 0012/14, T 0468/09, T 0801/13, T 1155/13

Catchword:

-



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Case Number: R 0008/17

D E C I S I O N
of the Enlarged Board of Appeal
of 18 June 2018

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Decision under review: **Decision T 1477/15 of the Technical Board of
Appeal 3.2.02 of 23 February 2017.**

Composition of the Board:

Chairman: C. Josefsson
Members: R. Moufang
G. Eliasson

Summary of Facts and Submissions

- I. The petition for review concerns decision T 1477/15 of Technical Board of Appeal 3.2.02 (hereinafter: "the Board"), which was pronounced in oral proceedings on 23 February 2017, its written reasons being despatched on 26 July 2017. This decision dealt with appeals by the proprietor of European patent No. 1 145 729 (hereinafter: "the patent") and opponents 1, 2 and 5 against the opposition division's interlocutory decision that the patent as amended on the basis of the proprietor's auxiliary request 2 fulfilled the requirements of the EPC. The Board set the contested decision aside, dismissed the proprietor's appeal and ordered the department of first instance to maintain the patent on the basis of claims 1 to 11 of auxiliary request 3 and an adapted description, both filed by the proprietor in the course of the appeal proceedings. The Board later corrected an error in its decision under Rule 140 EPC.
- II. The decision being reviewed was the third decision taken by the Board in the opposition proceedings against the patent, which concerns a ready-to-use urinary catheter assembly. In appeal cases T 468/09 and T 801/13 it had already set aside two revocation decisions of the opposition division based on the grounds for opposition under Article 100(b) and (c) EPC, respectively. During the third appeal proceedings, which included oral proceedings on two consecutive days in November 2016 (= first oral proceedings) and on 23 February 2017 (= second oral proceedings), the Board dealt with several further issues, which included objections as to added subject-matter and lack of

inventive step raised against the proprietor's auxiliary request 3.

III. Claim 1 of auxiliary request 3 reads as follows (reference signs omitted):

"A urinary catheter assembly comprising at least one urinary catheter, the catheter having a catheter tube coated on its external surface on a substantial part of its length from its distal end with a hydrophilic surface layer in the form of a hydrophilic coating intended to produce a low-friction surface character of the catheter by treatment with a liquid swelling medium prior to use of the catheter and a catheter package made of a gas impermeable material formed by a multiple layer thermoplastic film material comprising aluminium, the package having a cavity for accommodation of the catheter, wherein the cavity accommodates said liquid swelling medium for provision of a ready-to-use catheter assembly."

IV. In the written reasons for its decision, the Board explained inter alia why the subject-matter of claim 1 of auxiliary request 3 was found to be inventive and not to contain added-subject matter and why the adapted description was found to comply with the requirements of the EPC. These parts of the reasons (see points 10, 12 and 13 = pages 36 to 39 and 43 to 58 of the decision) may be summarised as follows:

(a) Inventive step

During oral proceedings, the opponents had presented several lines of attack in respect of lack of inventive

step, starting either from document D1 or from document D34 as closest prior art.

The invention presented in the patent aimed to solve a problem arising with intermittent catheters. The closest prior art could only be an assembly comprising an intermittent urinary catheter having a hydrophilic surface layer producing a low-friction surface character when activated. An intermittent catheter was a catheter that the skilled person would designate as such. In his eyes a catheter which could be intermittently used for emptying the bladder of a patient in a situation in which no other choice was available would not necessarily qualify as an intermittent catheter. There were some objective elements which normally distinguished intermittent catheters from indwelling catheters. While D34 did not disclose an intermittent catheter, D1 did so. Thus D1 was the closer prior art for the assessment of inventive step.

There remained two differences between the urinary catheter assembly according to claim 1 and that disclosed in D1. In the light of these differentiating features, the objective problem could be seen as to provide an improved intermittent catheter assembly at lower cost whilst retaining comparable properties. It was not obvious for the skilled person to produce a catheter assembly with the differentiating features. The claimed solution therefore involved an inventive step.

At the oral proceedings, the opponents – despite the fact that the Board had asked them at the beginning of

the discussion of inventive step to formally present all the lines of argument they wished to pursue and, having heard the parties, had indicated that D1 was closer than D34 – had wished to present lines of argument starting from D34, and indeed from other documents. However, under the problem-solution approach one important step was to determine the closest prior art, i.e. the most promising springboard towards the invention. Taking this step avoided examining several other starting points which would be less promising, i.e. less likely to lead to the invention in an obvious way. When obviousness had been examined starting from the closest prior art and the subject-matter of the claim had been found inventive, it was no longer necessary to check its inventiveness starting from another document. This way of proceeding had been accepted by the Enlarged Board of Appeal, for instance in decision R 13/13. For these reasons, the Board did not allow a discussion of the objection of lack of inventive step starting from D34. Concerning a discussion starting from other documents (D2 or D4) not even cited by the opponents when the Board had asked them to present their lines of argument, the Board decided not to allow them into the proceedings pursuant to Article 13(3) RPBA. Otherwise the whole inventive-step discussion would have had to be reopened, even though the opponents had been given the opportunity to present all their lines of argument at the beginning of the discussion. Moreover, none of them had filed any submission to that effect during the three months between the first and second oral proceedings, in which the same request was discussed unamended.

(b) Added subject-matter and adaptation of the description

The Board addressed objections of added subject-matter in point 10 of the decision. It stated that two features of claim 1 of auxiliary request 3 had been amended, compared to claim 1 of the patent as granted, and explained why these amendments did not add matter over the application as originally filed. It also considered an objection of added subject-matter against dependent claim 10. In addition, it gave reasons why the adaptation of the description proposed by the proprietor complied with the principles to be applied in this context.

V. The petition was filed by opponent 1 (hereinafter: "the petitioner"), which claimed that the Board had fundamentally violated its right to be heard on three counts, namely

- (1) by not allowing any discussion, and not considering written arguments, with respect to inventive step on the basis of documents D2 and D4 as closest prior art, as well as incorrectly applying Article 13(3) RPBA;
- (2) by giving misleading guidance, thereby creating an undue burden on the petitioner's legal defence, as well as using surprise reasoning in its written decision, and
- (3) by not considering key arguments of the petitioner in its decision.

- VI. The petition contained a conditional request for oral proceedings and a request for treating the petition in an accelerated manner due to pending infringement proceedings. The petitioner's further requests are reproduced in section XI below. Its factual submissions and arguments are summarised in section XII below.
- VII. Opponent 5 submitted a letter dated 20 November 2017 in which it briefly commented on the petition.
- VIII. The Enlarged Board of Appeal (hereinafter: "the Enlarged Board"), in its composition according to Rule 109(2)(a) EPC, issued a summons to oral proceedings and informed the petitioner of its preliminary view on some of the relevant issues.
- IX. With a letter dated 15 May 2018 the petitioner submitted further arguments.
- X. Oral proceedings before the Enlarged Board took place on 18 June 2018. The petitioner was heard on the issues it considered to be relevant. At the end of the oral proceedings, the chairman pronounced the Enlarged Board's decision.
- XI. The petitioner requested that
- the decision under review be set aside and the proceedings be re-opened in accordance with Article 112a(5) and Rule 108(3) EPC;
 - the members of the Board who had participated in taking the contested decision be replaced pursuant to Rule 108(3) EPC;

- reimbursement of the fee for petition for review be ordered.

XII. The petitioner's submissions made in the petition for review, in its response to the Enlarged Board's communication and in the oral proceedings may be summarised as follows:

(a) Non-allowance of discussion of documents D2 and D4 as candidates for closest prior art

In the petitioner's written submissions throughout the whole proceedings, prior-art documents D2 and D4 played an integral part in its case against the validity of the patent and were also discussed in depth in its grounds of appeal and in further submissions. In the first oral proceedings before the Board, there was a long discussion on the question of which criteria were decisive for determining the closest prior art with respect to the (then) first auxiliary request. As a result of this discussion the Board explicitly stated that the closest prior art would have to be "a catheter for intermittent catheterization".

In the second oral proceedings the Board stated at the beginning of the discussion on inventive step in respect of auxiliary request 3 that the closest prior art would have to be an "intermittent catheter". Upon enquiry by the petitioner, the Board stated that there was no difference between the two terms used. In the following discussion the Board focused in particular on whether D1 or D34 constituted the closer prior art.

Later in the oral proceedings, the petitioner requested the opportunity to present orally its arguments starting from documents D2 and D4, which it had already submitted in written form. The Board decided not to allow any discussion of inventive step based on D2 and D4 as potential starting points as closest prior art. It based this decision on Article 13(3) RPBA.

Not allowing this discussion amounted to a fundamental violation of the petitioner's right to be heard for the following reasons: applying Article 13(3) RPBA in the present case was obviously incorrect, since that provision concerned amendments to a party's case, and the petitioner had not amended its case with respect to the arguments based on D2 and D4. The petitioner had never waived its related written arguments, and there was also no rule in the EPC regarding the waiving of lines of argument. The fact that none of the opponents had filed any submissions on this point in the interval between the first and second oral proceedings could not be held against them. Moreover, the proprietor itself, throughout the opposition proceedings, had insisted on D4 being the closest prior art.

Furthermore, when orally presenting its lines of attack, the petitioner had been misled by statements made by the Board during the oral proceedings. Since the Board had used the term "catheter for intermittent catheterization", the petitioner had had to conclude that this meant a catheter suitable for performing intermittent catheterization. This had impeded the petitioner's preparations for successfully attacking auxiliary request 3 and thus violated its right to be heard. In particular, the Board's instructions in the

first oral proceedings had led the petitioner to believe that D34 was a better starting point for an inventive step discussion and not to rely on D4 as a primary line of argument.

(b) Surprise reasoning in decision

A key point for the Board's determination of the closest prior art was the manner in which it defined the term "intermittent catheter". These definitions were of a subjective nature ("an intermittent catheter is a catheter that the skilled person would designate as such" and "catheters intended to be intermittent ones") and had no support in the patent or in the proprietor's submissions. Since they were the Board's own creation and not part of the discussions, the petitioner had never been given the opportunity to comment on them. The same was true of the objective elements used in the written reasons for distinguishing between intermittent and indwelling catheters. They had been introduced by the Board sua sponte and were not based on any arguments of the proprietor. In view of this completely unexpected reasoning, a clear violation of the petitioner's right to be heard had occurred.

The Board had furthermore used surprise reasoning for its decision not to allow a discussion of documents D2 and D4 in the oral proceedings. It had referred to the fact that the petitioner had not filed any further submissions between the two oral hearings. This was a surprise argument, since the parties had not been invited to file such submissions in that period.

(c) Ignoring relevant arguments

The decision entirely disregarded the petitioner's extensive written arguments on documents D2 and D4 as possible starting points for the assessment of inventive step. Independently of the question whether to allow this to be discussed in the oral proceedings, the Board had an obligation to consider the arguments at least in the written decision. The petitioner had never withdrawn or waived its arguments on this issue. However, the Board had completely ignored them, which amounted to a further violation of the right to be heard. If the petitioner had not been present in the oral proceedings, the Board would undoubtedly have had to address these arguments. There was no reason why the petitioner should be put in a worse position merely because it had attended the oral proceedings.

In addition, the Board had entirely disregarded the petitioner's arguments with respect to added subject-matter in the claims of auxiliary request 3. In its written submissions, the petitioner had explained in detail that auxiliary requests 1 and 2 contravened Articles 123(2) and 76(1) EPC, in particular because the embodiment of figure 1 of the contested patent did not conform to the amended claim language "the cavity accommodates the liquid swelling medium". Since the patent incorrectly stated that figure 1 was an embodiment which fell within the scope of claim 1, the meaning of the term "cavity" in the patent was different to the term "cavity" as used in the application as filed, and the claim extended beyond the content of the application as filed. The petitioner had also endorsed the arguments of opponent 2, according to

which the view that figure 1 was encompassed by claim 1 could not be reconciled with the Board's more recent decision T 1155/13, which related to a patent of the same family. It was emphasised during the oral proceedings that the Board's claim interpretation in T 801/13 was inconsistent with decision T 1155/13 and that the objection of added matter applied to all of the proprietor's requests. Nevertheless, the decision nowhere acknowledged or addressed these important arguments.

(d) Admissibility requirement of Rule 106 EPC

With respect to the issue that the Board had not allowed a discussion of inventive step based on D2 and D4, the objection pursuant to Rule 106 EPC had been raised in the oral proceedings. Objections pursuant to that rule did not explicitly have to refer to it. By protesting against the Board's decision not to allow a discussion of inventive step starting from D2 and D4, the petitioner's representative had expressed his concern regarding the possible violation of the petitioner's right to be heard according to Article 113(1) EPC. The Board had thus been put in the position to react to this concern. No more was necessary in the present case. Requiring any further formal protest in addition to the explicit request to hear the petitioner's arguments regarding D2 and D4 would effectively undermine the possibility of filing a petition for review. The Board had deliberated on the issue and rejected the petitioner's protest and request to allow further arguments against inventive step. It had also provided extensive reasoning in its written reasons to justify this decision. Thus, the Board had

obviously recognised the protest and the procedural defect about which the petitioner complained.

In addition, if the petitioner's protest were not considered to be an objection under Rule 106 EPC, the exception stipulated in that provision would apply. The Board had made formal decisions by stating that it had reached the conclusion that, starting from document D1, auxiliary request 3 met the requirements of Article 56 EPC and by concluding after deliberation that the petitioner was not entitled to present other lines of argument against inventive step. Since the Board was bound by these decisions, the petitioner could no longer effectively raise the objection. The purpose of an objection under Rule 106 EPC, i.e. to give the Board the opportunity to correct itself, was no longer achievable.

With respect to all other issues raised in the petition, no objection under Rule 106 EPC was possible since the petitioner only became aware of these procedural violations when reading the written reasons for the decision.

Reasons for the Decision

Observations by opponent 5

1. When the Enlarged Board composed according to Rule 109(2)(a) EPC examines a petition for review as to whether it is clearly inadmissible or unallowable, it decides pursuant to Rule 109(3) EPC without the involvement of other parties and on the basis of the

petition. Therefore the observations filed by opponent 5 (see section VII above) are to be disregarded.

Admissibility of the petition

2. The petitioner is adversely affected by the contested decision maintaining the patent in amended form. The petition was filed on the ground referred to in Article 112a(2)(c) EPC. The petition therefore complies with the provisions of Article 112a(1) and (2) EPC.
3. The written decision was notified to the petitioner by means of a registered letter dated 26 July 2017 and deemed to be delivered on 5 August 2017 (see Rule 126(2) EPC). Since the petition was filed on 5 October 2017 and the corresponding fee was paid on 4 October 2017, the petition also complies with Article 112a(4), second and fourth sentences, EPC. The further conditions in relation to the contents of the petition as laid down in Article 112a(4), first sentence, in conjunction with Rule 107 EPC are also fulfilled.
4. According to Rule 106 EPC a petition under Article 112a(2)(a) to (d) EPC is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board. However, an exception applies where such objection could not be raised during the appeal proceedings. Compliance with the admissibility requirement laid down in Rule 106 EPC needs to be assessed with respect to each of the specific procedural violations alleged by the petitioner (see decision R 12/14 of 7 October 2016, reasons 6).

5. With respect to the complaints set out above in sections XII(b) and (c), the petitioner claims that they only became visible through the written reasons for the decision. The Enlarged Board accepts that the exception to Rule 106 EPC applies in that respect.
6. With respect to the complaints relating to the non-allowance of a discussion of whether documents D2 and D4 may qualify as potential closest prior art, the petitioner claims that it raised an objection pursuant to Rule 106 EPC in the oral proceedings. However, neither the minutes nor the written reasons for the decision contain any indication of such an objection.
7. An objection under Rule 106 EPC must be expressed in such a form that the board of appeal is able to recognise immediately and without doubt that such an objection - i.e. one which is additional to and distinct from other statements, in particular arguing or even protesting against the conduct of the proceedings or against an individual procedural finding - is intended. Furthermore, the objection must be specific, which means it has to indicate unambiguously which particular defect is relied on (see R 4/08 of 20 March 2009, reasons 2.1; R 12/14, supra, reasons 8).
8. The factual submissions made by the petitioner on this point are rather vague. It acknowledges that no reference to Rule 106 EPC was made. It states that **by protesting** against the decision of the Board the representative expressed his concern regarding the possible violation of the right to be heard. This is quite different from stating that the representative

explicitly warned the Board that in his view such a violation would occur if the discussion was not allowed. The further statement in the petition that "[r]equiring any further formal protests of the Petitioner in addition to the explicit request to hear the Petitioner's arguments regarding D2 and D4, would effectively undermine the possibility to petition for review" implies that the petitioner indeed did no more than explicitly request that these arguments be heard.

9. Also, the affidavit of the petitioner's representative submitted as exhibit HL 1 with the petition does not assist the petitioner on this crucial point: it merely states that the representative requested the opportunity to present arguments regarding lack of inventive step on the basis of starting points other than D1 and D34, namely documents D2 and D4, and that this request was rejected by the Board. The affidavit does not even mention that the petitioner protested against this rejection.
10. Thus, the petitioner's own submissions do not allow the conclusion that it raised an objection in the oral proceedings which could qualify as an objection under Rule 106 EPC. It is also apparent that the Board did not understand the petitioner to have raised such an objection, since otherwise it would have had to mention the objection both in the minutes and in the decision. Furthermore, if the petitioner had considered the minutes to be incomplete in this regard, one would have expected it to submit a corresponding request for correction (see R 17/10 of 15 June 2011, reasons 2.2). However, no such request is on file.

11. The fact that the Board deliberated on the request for further discussion of inventive step and provided detailed reasons in the written decision why it considered that not allowing this discussion did not infringe the opponents' right to be heard appears to be normal judicial practice and, contrary to the petitioner's view, cannot be taken as evidence that the Board was aware of being confronted with an objection under Rule 106 EPC.
12. The petitioner further argues that, since the Board had already made formal decisions on the controversial issues, it was bound by them and so any objection the petitioner might have raised thereafter could not serve any useful purpose. However, neither the minutes nor the decision indicate that the Board took any binding interlocutory decision on these issues. According to the petitioner's factual submissions the Board merely stated that it had reached certain conclusions. However, informing the parties about the opinion to which a board of appeal has come on a certain issue is, contrary to the petitioner's view, different from taking a binding (interlocutory) decision on that issue. For this reason, it is well-established in the case law that a party may also raise an objection under Rule 106 EPC at a later stage of the proceedings before the formal announcement of a decision (see decision R 21/09 of 19 March 2010, reasons 1.7: "[...] Le fait que l'objection n'ait été soulevée qu'après la discussion de la requête principale et de deux requêtes subsidiaires n'a aucune incidence sur la recevabilité en l'espèce, puisque l'objection a été faite pendant les débats"; and decision R 6/12 of 18 January 2013, reasons 1.3.3: "[...] En plus, le moment auquel la

requérante aurait pu intervenir était celui où le président de la chambre a prononcé la clôture des débats pour délibération, c'est-à-dire bien avant le moment où le président a prononcé la décision."

13. It follows from the above that the petition for review is clearly inadmissible with respect to the complaint that not allowing the discussion of documents D2 and D4 as possible closest prior art was a fundamental violation of the petitioner's right to be heard. With respect to the other complaints, the petition is admissible.

Allowability of the petition

Fundamental violation of the right to be heard by surprise reasoning

14. According to the petitioner, the written reasons for the decision showed an understanding of the term "intermittent catheter" which came as a surprise, since it had been neither communicated to nor discussed with the parties. The petitioner maintains that it had therefore been deprived of any opportunity to comment on a point which became crucial for the determination of the closest prior art. Thus, its right to be heard had been violated in a fundamental manner.
15. Decisions of a board of appeal may only be based on grounds or evidence on which the parties have had an opportunity to present their comments (Article 113(1) EPC). This implies that a party may not be taken by surprise by the reasons for the decision, referring to unknown grounds or evidence. "Grounds or evidence"

under Article 113(1) EPC is to be understood as the essential legal and factual reasoning on which a decision is based (see also decision R 16/13 of 8 December 2014, reasons 3.3). A party has to have an opportunity to comment on the decisive aspects of the case.

16. On the other hand, the board must be able to draw its own conclusion from the discussion of the grounds put forward (see decisions R 8/13 of 15 September 2015, reasons 2-1; R 16/13, supra, reasons 3.3). Thus, the right to be heard does not go so far as to impose a legal obligation on a board to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion – or at least those foreseeable as the core of the discussion – it will come to its conclusion. This is part of the reasoning given in the written decision (R 1/08 of 15 July 2008, reasons 3.1; R 15/12 of 11 March 2013, reasons 5; R 16/13, supra, reasons 3).
17. In the present case, the petitioner acknowledges that the question of how to determine the closest prior art was extensively discussed in the oral proceedings and that the Board indicated criteria which the closest prior art had to fulfil. Although the petitioner claims that the Board used different formulations in the first and second oral proceedings, i.e. “a catheter for intermittent catheterization” and “intermittent catheter”, and that it was misled and confused by this inconsistency, one fails to see how this prevented the petitioner from putting forward all the arguments it might have had with regard to this issue.

18. It may well be that the Board did not disclose to the parties in advance all the elements of its analysis for arriving at the decision on this issue. However, in the light of the general principles developed in the case law as set out above, this cannot be seen as a violation of the petitioner's right to be heard. The analysis provided by the Board in the written reasons does not appear to contain anything so surprising that the parties should have been informed about it beforehand.
19. While the petitioner maintains that the Board's understanding of the term intermittent catheter was unexpectedly subjective, it follows from the written reasons that the Board's position was clearly more nuanced (see page 45 of the decision, 2nd paragraph: "[...] Secondly, in the Board's opinion, there are some objective elements which normally distinguish intermittent catheters from indwelling catheters. The former do not have balloons or other elements to maintain the catheter in position in relation to the body of the patient, their low-friction surfaces have shorter activation times, and they are not impregnated with drugs for delivery to the patient over days or weeks."). It is also noted that the distinction between indwelling and intermittent catheters was an important issue throughout the whole opposition appeal proceedings and had already been addressed by the Board in its second decision (T 801/13 of 27 February 2014, reasons 4) in the following terms: "Urinary catheters are essentially of two types: indwelling catheters which are meant to remain in the urethra for a longer period of time and which are in general inserted in hospital and intermittent catheters which are meant for

- introduction into the urethra in particular by the patient for a single emptying of the bladder and then taken out again after the emptying."
20. The petitioner also complains that the objective criteria referred to in the written reasons were introduced by the Board *sua sponte* and not based on any arguments of the proprietor. However, as already emphasised (point 16 above), the right to be heard does not go so far as to impose a legal obligation on a board to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion, it will come to its conclusion. In the present case the petitioner was well aware of the crucial nature of the choice of the closest prior art, including the determination of the criteria which were relevant in that context, and therefore was not prevented from presenting all the arguments it might have had.
21. The petitioner further argues that the Board used surprise reasoning for the decision not to allow a discussion of documents D2 and D4 in the oral proceedings, since the Board referred to the fact that the petitioner had not filed any further submissions between the two hearings.
22. Although the written reasons do indeed contain a remark to that effect, this point appears to have been of only minor importance for the Board's decision. It transpires from the passages summarised above (see section IV(a)) that the decisive reason for not allowing a discussion of documents D2 and D4 was that the Board, when it began to hear the parties on inventive step, asked the opponents to present all the

lines of argument that they wished to pursue and that at this stage they presented several lines of attack, but did not mention documents D2 or D4 as possible closest prior art. Therefore, the Board considered it not to be in line with a proper conduct of proceedings to allow the opponents at a later stage to pursue further lines of argument, starting from documents that were not mentioned at the beginning of the discussion. The Board's remark that none of the opponents had filed any submission to that effect between the two oral proceedings appears to have been a secondary consideration, based on a fact which as such was known to the parties.

23. It is not a matter for the Enlarged Board to assess in substance the correctness of the petitioner's view that the Board should not have made the above remark at all. The only question to be decided is whether the Board, by not disclosing this particular point in advance to the parties, prevented them from putting forward relevant arguments concerning the allowance of a discussion of further lines of attack and thereby fundamentally infringed their right to be heard. The answer to this question must be in the negative. As already noted in points 16 and 20 above, not every argument a board uses in the analysis of the case and in the written reasons needs to be presented in advance to the parties. This holds true in particular when, as in the present case, the argument was apparently of only secondary importance.

24. It follows from the above that no violation of the petitioner's right to be heard can be established with regard to its allegations of surprise reasoning in the

written decision. Hence, the petition is clearly unallowable in that respect.

Fundamental violation of the right to be heard by ignoring essential arguments

25. According to the established case law, Article 113(1) EPC may be infringed if the reasons for a decision fail to take into account a party's essential and relevant arguments. The right to be heard also requires that those involved be given an opportunity not only to present comments but also to have those comments considered, i.e. reviewed as to their relevance for the decision in the matter (see R 23/10 of 15 July 2011, reasons 2; R 19/12 of 12 April 2016, reasons 6 to 6.3). The boards have an obligation to discuss in their decisions issues and arguments to the extent that they are relevant for the decision. On the other hand, they may disregard irrelevant arguments, and the refutation of arguments may be implicitly inferred from the particular reasoning. Accordingly, the boards' obligation to consider a party's argumentation is shaped by the circumstances of each case.
26. One of the petitioner's complaints is that the written arguments on documents D2 and D4 as closest prior art were not reflected in the written reasons and thus ignored by the Board. This amounted to a fundamental violation of its right to be heard.
27. As already summarised (see section IV(a) and point 22 above), the Board explained in some detail in the written decision why it did not allow a discussion on documents D2 and D4 as possible starting points for

assessing inventive step in the second oral proceedings. It is not a matter for the Enlarged Board to review the merits of the petitioner's complaint concerning the non-allowance of the discussion as such, since the petition is regarded as inadmissible in that respect (see point 13 above). It can therefore not be assumed that the position the Board took on this procedural issue was incorrect. Viewed from that perspective, the Board cannot be criticised for not considering any further the petitioner's written submissions on D2 and D4 as closest prior art. Indeed, it would have been highly questionable and contradictory to deal in substance with an argument of a party in the written reasons after not allowing a discussion on it in the oral proceedings. The procedural situation in the present case differed from the situation where arguments of a non-attending party are not reflected in the decision.

28. The petitioner further complains that some of its arguments in support of the objection of added subject-matter (Article 123(2) EPC) were not reflected in the decision and thus ignored by the Board. The petitioner as well as opponent 2 had argued in particular that the patent, when describing the embodiment of figure 1 as falling within the scope of claim 1, extended beyond the content of the application as filed, since this changed the meaning of the term "cavity" as originally used. In order to remedy this deficiency, the description had to be adapted by deleting the embodiment of Figure 1 (see petitioner's statement of grounds of appeal, page 27, and opponent 2's statement of grounds of appeal, pages 22 to 24). Not acknowledging and addressing these important arguments

constituted a fundamental violation of the right to be heard.

29. It is true that the Board neither mentioned nor addressed this issue in the decision being reviewed. However, as already noted (see point 25 above), the obligation of a deciding body to deal with arguments in the written reasons is shaped by the circumstances of each case.
30. In the present case, it cannot be disregarded that the Board had already made its position on this point entirely clear in the previous decision T 801/13, in which it had found claim 1 of the main request to comply with Article 123(2) EPC. The relevant passages in points 5 and 7 of that decision read as follows:

"5. The wording of claim 1 according to the main request being the same [...] as that of claim 1 of the main request in the former appeal proceedings (T 0468/09), the interpretation of claim 1 given in the decision of the Board in points 4.3 and 4.4 is relevant here. The Board considered that the wording of the claim covered both the embodiment of figures 1 and 2 (point 4.3) in which the catheter is in a cavity and the end portion of the cavity (or compartment) contains a spongy material retaining the liquid swelling material until it is pressed out of the spongy material and flows into the cavity in order to prepare the low friction surface ([0011] to [0013] and [0029] to [0032]), and the embodiment not shown in the figures in which the liquid swelling medium is put into the cavity directly during the manufacturing process (point 4.4.)

without the presence of any spongy material ([0014 and [00378])). [...]

7. The respondents/opponents also submitted that there was no basis in the application as filed for the feature that the cavity accommodates the liquid swelling medium. It was always the compartment which did so. And even in the case of a single space, part of the space could be the compartment and another part the cavity.

The Board does not share this opinion. [...]

Therefore, in all these embodiments the 'cavity' and the 'compartment' form a single space. It follows that when the liquid swelling medium is in this single space, it is within the cavity and/or within the compartment. In such a case, the Board considers it pointless and even confusing to draw an artificial distinction between a part of the space which would be called 'cavity' and another part of the space which would be called 'compartment'. [...] The present wording that the cavity accommodates the liquid swelling medium therefore does not contain any teaching not already present in the mentioned embodiments."

31. Thus, with regard to the main request, the Board had already decided in T 801/13 that claim 1 also covered the embodiment of figures 1 and 2 and satisfied Articles 76(1) and 123(2) EPC. It may therefore reasonably be assumed that, when writing its third decision in the same opposition proceedings, the Board either considered the issue to be res judicata or at least did not see any need to replicate the arguments it had already provided in its second decision, and thus only implicitly rejected the opponents' repeated

contentions to the contrary. The fact that the Board did not address the objection once more is therefore as such not sufficient evidence for concluding that it had ignored the petitioner's (and opponent 2's) arguments.

32. The petitioner nevertheless insists that there were further compelling reasons in the present case which required the Board to deal with the issue again. Opponent 2 had based its interpretation of claim 1 on the reasons given by the Board in the more recent decision T 1155/13 of 7 May 2014, which concerned a related patent. The petitioner claims to have emphasised repeatedly in its written submissions as well as in the oral proceedings that the Board's interpretation in T 801/13 was incompatible with decision T 1155/13.
33. The Enlarged Board is unable to identify any such evident inconsistencies between the two decisions. The features of the claim under consideration in T 1155/13 differed from those of the claims considered in T 801/13 and the reviewed decision in that they specified that a compartment accommodated the liquid swelling medium, and that the liquid swelling medium was confined in a storage body of a spongy or gel-like material located in the compartment. As transpires from the written file, opponent 2 essentially argued that certain passages of decision T 1155/13 ruled out the possibility that the embodiment of Figure 1 could be part of the claimed invention in the present case (see pages 23 to 24 of opponent 2's grounds of appeal). This argumentation was based on the assumption that the claim language "the cavity accommodates the liquid swelling medium" was synonymous with the claim feature

"the compartment is entirely integrated with the cavity" considered in T 1155/13 (see page 23, 4th paragraph, of opponent 2's grounds of appeal). However, in the Enlarged Board's view, the correctness of that assumption is far from evident.

34. It follows from the above that the Board was not obliged to provide explicit reasons in its decision as to why it did not reconsider an issue that it had already dealt with in detail in its decision T 801/13.
35. Thus, no fundamental violation of the right to be heard can be established with regard to the petitioner's complaint that the Board had ignored essential arguments.

Concluding remarks

36. For the reasons set out above, the Enlarged Board unanimously concludes that the petition is to be rejected as being in part clearly inadmissible and in part clearly unallowable. It also follows that the fee for the petition cannot be reimbursed.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

P. Cremona

C. Josefsson