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**Datasheet for the decision
of 26 February 2021**

Case Number: R 0006/19

Appeal Number: T 0927/14 - 3.5.05

Application Number: 00989280.3

Publication Number: 1247229

IPC: G06F19/00

Language of the proceedings: EN

Title of invention:

METHOD AND APPARATUS FOR PATIENT MONITORING WITH WIRELESS
INTERNET CONNECTIVITY

Patent Proprietor:

Koninklijke Philips N.V.

Opponents:

Fresenius Medical Care Deutschland GmbH
Garmin Deutschland GmbH
Fitbit

Headword:

Relevant legal provisions:

EPC Art.112a(2)(c), 113(1), 114(2), 123(1)
EPC R.81(3), 100(1), 106, 137

Keyword:

Decisions cited:

R 0010/09, R 0020/10, R 0011/11, R 0015/12, R 0004/13,
R 0008/15, R 0006/17, R 0010/18

Catchword:

The basis for a board's (and opposition division's) discretion to admit or not claim requests is Article 123(1)EPC, (see Reasons points 5 to 10).

Violation of the right to be heard (No)



**Große Beschwerdekammer
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Case Number: R 0006/19

D E C I S I O N
of the Enlarged Board of Appeal
of 26 February 2021

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Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbH Johannes-Brahms-Platz 1 20355 Hamburg (DE)
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Representative:	Maikowski & Ninnemann Patentanwälte Partnerschaft mbB Postfach 15 09 20 10671 Berlin (DE)
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Decision under review: **Decision T 0927/14 of the Technical Board of
Appeal 3.5.05 of the European Patent Office of
20 February 2019.**

Composition of the Board:

Chairman: C. Josefsson
Members: D. Rogers
 P. Acton

Summary of Facts and Submissions

- I. The petition for review concerns appeal proceedings T 0927/14 of Board of Appeal 3.5.05, ("the Board"). The appeal was against a decision of the opposition division.
- II. The Petitioner was the patent proprietor during these proceedings and the appellant before the Board. The Petitioner will, where appropriate, also be referred to as the "Appellant" in this decision.
- III. Oral proceedings were held before the Board on 20 February 2019. At the end of the oral proceedings the chairman of the Board announced that the appeal and the objection in respect of a fundamental procedural defect were dismissed. The result of this was that the patent was revoked.
- IV. The minutes of the oral proceedings before the Board record that claim 1 of the new main request was considered by the Board not to fulfil the requirements of Article 123(2) EPC. The Appellant is recorded in the minutes as stating that it "... was taken by surprise ..." by this conclusion. The Board then considered the admission into the proceedings of auxiliary requests Ib, Ic and Id. For ease of reference, these requests will be referred to as the "Group I requests".
- V. Following the Board's decision at the oral proceedings not to admit any of the Group I requests, the Appellant filed, during the course of the afternoon, new auxiliary requests Ie, Ie', and I'. For ease of

reference, these requests will be referred to as the "Group II requests". The Board decided not to admit any of the Group II requests into the proceedings.

- VI. The minutes record that the chairman stated that auxiliary request Ie was not admitted into the proceedings "... in view of the very late stage of the proceedings, increased complexity of procedural issues and a lack of convergence with the new main request ...". Further, the minutes record that the chairman of the Board stated that auxiliary request Ie' was not admitted into the proceedings "... in view of the very late stage of the proceedings and a lack of convergence with the new main request... ", and that auxiliary request I' was not admitted into the proceedings for the same reasons expressed in the same terms (see page 6 of the minutes).
- VII. According to the minutes of the oral proceedings, at 18:00 hours the Appellant submitted a written objection under Rule 106 EPC. This concerns the Group II requests. This stated, as far as is material, the following:

"In view of the fact that the objection on auxiliary request Ia [the Enlarged Board notes that this was the "new main request" before the Board] regarding original disclosure was raised by the Boards of Appeal during the appeal proceedings for the first time, the Board should have applied its discretion in such a way so as to allow the appellant to appropriately react. It should have thus admitted auxiliary request Ie, Ie' and/or auxiliary request I' into the proceedings".

VIII. In its petition the Petitioner identifies three heads under which its right to be heard was violated by the Board:

- i. the refusal to admit the Group II requests;
- ii. the justifications for not admitting the Group II requests were different in the written decision from those given in the oral proceedings; and
- iii. the Board ignored the Petitioner's submissions that the limitation "while exercising" was included in an earlier request. This concerns the non-admission of the Group I requests.

IX. As regards head VIII.i above and the Group II requests, the Petitioner argues that the Board did not exercise its discretion correctly. This was because in this case the Petitioner had to deal with interventions that were effectively late filed new oppositions, and thus it should have been able to file claim requests in response. In addition, at page 6 of the petition, the Petitioner argues that as it did not know in detail the reasoning behind the Board's refusal to admit the new main request, it could not react and hence its right to be heard was violated - see 2nd paragraph, page 8 of the petition.

X. As regards head VIII.ii and the Group II requests, the Petitioner's case is that it was not able to argue that auxiliary request I' was not "late filed", because the admissibility discussion at the oral proceedings focussed on the "divergent" criteria.

- XI. As regards head VIII.iii and the Group I requests, the Petitioner argues that the Board refused the admission into the proceedings of the Group I requests because it found that the term "while exercising" contained in these requests was introduced late in the proceedings, on 18 January 2019 (about one month before the oral proceedings). The Board refused to admit these requests because it ignored the Petitioner's submission at the oral proceedings that this amendment had already been introduced into what was then auxiliary request Id at the much earlier date of 4 July 2018.
- XII. The Enlarged Board issued a communication setting out its preliminary opinion on the case.
- XIII. The Petitioner replied to this communication. As regards its objection set out in VIII.i concerning the Group II requests, it argued that the Board had exercised its discretion not to admit the Group II requests in an arbitrary manner and repeated the arguments set out at point IX above. Further, the Petitioner argued that a Board did not have any power not to admit a claim request as Article 114(2) EPC refers to a power to disregard late filed facts and evidence and does not refer to claim requests.
- XIV. At the oral proceedings before the Enlarged Board, the Petitioner repeated its written submission that, as regards the Group II requests, the normal rules regarding admitting requests should not apply in the case of late filed notices of intervention. In this case the Board had exercised its discretion whether or not to admit these requests in an arbitrary manner.

- XV. The Petitioner withdrew its offer of witnesses to confirm that it had made the argument that the “while exercising” feature had been filed as early as 4 July 2018 before the board (objection VIII.iii and the Group I requests), since the Enlarged Board had accepted this fact. The Petitioner argued that if the Board had exercised its discretion not to admit the Group I requests, without taking this argument into account, then this discretion was exercised on the mistaken assumption that this feature was newly introduced. This feature was a reaction to the interventions and had been first filed in a claim request at an early stage. The Board had mistakenly considered that this feature had only been introduced into the proceedings at a late stage. It was this perceived lateness that was a decisive factor in the Board’s decision not to admit. The failure by the Board to take this relevant argument into account, it is not mentioned in the decision, constituted a violation of the Petitioner’s right to be heard.
- XVI. The Petitioner requested that the Enlarged Board set aside decision T 0927/14 and re-open the proceedings before the Board.
- XVII. Oral proceedings were held on 26 February 2021 by video conference.

Reasons for the Decision

Admissibility of the Petition

Has the Petitioner complied with Rule 106 EPC?

1. The Enlarged Board considers this petition to be a petition under Article 112a(2)(c) EPC. A petition under such a ground is only admissible if an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board, except where such objection could not be raised during the appeal proceedings.
2. As regards the objection under VIII.i above concerning the Group II requests, an objection was raised during the oral proceedings before the Board. As regards objections under VIII.ii, the Group II requests, and VIII.iii, the Group I requests, above, the Enlarged Board is of the view that these could not be raised until the Petitioner had read the written decision of the Board.
3. The petition is therefore admissible.

Is the petition allowable?

4. The Enlarged Board will first deal with the Petitioner's argument that a board of appeal has no power not to admit claim requests, as if the Petitioner is correct on this point its Petition should succeed. This decision will then deal with the non-admission of the Group I requests and then of the Group II requests. This is a different order from the order in which the Petitioner presented its arguments but aids readability

as it is the chronological order in which these requests were presented.

Does a board of appeal have a power not to admit claim requests?

5. The Petitioner has argued that a board of appeal has no power not to admit claim requests. The Petitioner bases this argument upon the wording of Article 114(2) EPC which states that the EPO may disregard facts or evidence which are not submitted in due time by the parties. The Petitioner argues that claim requests are neither facts nor evidence and hence Article 114(2) EPC cannot be the basis for a power to disregard claim requests.

6. The Enlarged Board considers that Article 123(1) EPC is the basis for the EPO's discretion whether to admit or not admit claim requests. It is useful to look at the language of this article:

"The European patent application or European patent may be amended in proceedings before the European Patent Office, in accordance with the Implementing Regulations. In any event, the applicant shall be given at least one opportunity to amend the application on his own volition."

7. The first sentence of this article states the general possibility to carry out amendments in patent applications and in patents. However, the amendments and their admission into the proceedings shall be in accordance with the provisions of the implementing regulations. These provisions are stipulated in Rules

81(3) EPC for opposition proceedings and in Rule 137 EPC for examination proceedings.

8. The second sentence of Article 123(1) EPC explicitly provides applicants with a right - "In any event ... shall be given" - to at least one opportunity to amend an application. Were the first sentence of Article 123(1) EPC to mean that the patent proprietor or applicant always has the right to amend their patent or application, the second sentence of Article 123(1) EPC would be redundant.
9. The right, found in the second sentence of Article 123(1) EPC, to at least one opportunity to amend, is not extended to a patent proprietor in opposition proceedings, where the opposition division has the discretion, given in the first sentence of Article 123(1) EPC, not to admit such requests. In such proceedings an opportunity to amend shall be given only where necessary (Rule 81(3) EPC). This reflects the fact that opposition proceedings are *inter partes* and hence involve the EPO in balancing the interests of both parties.
10. Rule 100(1) EPC provides that provisions relating to proceedings before the department which has taken the decision impugned shall apply to appeal proceedings. For such proceedings the exercise of discretion of a board with regard to admitting or not new claim requests is further specified in Articles 12 and 13 RPBA.
11. In conclusion, the Enlarged Board rejects the argument of the petitioner that a board of appeal has no power not to admit new claim requests. Relying on the

regulatory framework presented above, it appears not necessary to answer whether also Article 114(2) EPC provides a basis for refusing such a request.

Non-admission of the Group I requests

12. Turning now to the objection set out under VIII.iii above, the Group I requests, the Petitioner argues that the Board's exercise of its discretion was arbitrary as it was exercised without taking into account the Petitioner's argument that the "while exercising" feature had been filed as early as 4 July 2018.
13. It is clear from page 5 of the minutes that the admissibility and the prima facie allowability of the Group I requests were discussed - this discussion took place between 10:45 and 11:50.
14. The minutes state that these requests were not admitted because they amounted to a fresh case and were not prima facie allowable. The minutes also note that it was discussed whether the feature "while exercising" found in these requests, and which the minutes describe as a "newly inserted feature", was an appropriate reaction to the 18 December 2018 letter of respondents 2 and 3 and the Board's 20 December 2018 communication.
15. The Petition can only succeed on this point if the Board exercised its discretion not to admit the Group I requests in a way that amounted to a violation of the Petitioner's right to be heard. The Petitioner's case is that, even though it was able to make its argument that the feature "while exercising" was not late filed, this argument was completely ignored by the Board. Thus

- the Petitioner's right to be heard was violated as this right requires that its arguments are actually substantively considered by a board.
16. The Board's decision deals with the admissibility of these requests at paragraphs 4.1 and 4.2. These set out that the Petitioner explained that the Group I requests had been filed in direct response to the new prior art documents B1 to B5 cited by respondent 2 on 9 February 2018 and B6 and B7 cited by respondents 2 and 3 on 18 December 2018. This statement was made orally at the oral proceedings before the Board.
 17. The Petitioner made further oral submissions regarding these requests and where support for them in the originally filed application could be found. These oral submissions concerned added matter.
 18. Respondents 2 and 3 then made oral arguments that the Group I requests related to an embodiment whereby the state or condition of a patient is monitored while he is exercising. They had first been filed on 18 January 2019, they were not in direct response to the new prior art documents B1 to B5 cited by respondent 2 on 9 February 2018 and B6 and B7 cited by respondents 2 and 3 on 18 December 2018.
 19. The Board noted, (see the last paragraph of point 4.1 of the decision), a contradiction between the Petitioner's position expressed orally before the Board, see point 15 above, and its position in its letter of 18 January 2019, page 18, last paragraph, where new prior art documents B1 to B5 cited by respondent 2 on 9 February 2018 and B6 and B7 cited by respondents 2 and

- 3 on 18 December 2018 were acknowledged as not being related to the monitoring of a healthy subject while exercising.
20. It can be inferred that the Board considered that as the Group I requests contained a feature, the "while exercising" feature, that did not address the issue raised by new prior art documents B1 to B7, these auxiliary requests constituted a fresh case and hence were inadmissible. It is also to be noted that the "while exercising" feature occurs only once in the version of auxiliary request Id filed on 4 July 2018, whereas in the auxiliary requests filed on 18 February 2019 this feature occurs twice and these requests contain numerous other amendments.
21. That the Petitioner had filed a request with the "while exercising" feature before 18 January 2019 does not appear to the Enlarged Board to cast doubt on the correctness or completeness of the Board's decision on this point as this feature was not considered to address the issues raised in the prior art documents B1 to B7.
22. The Enlarged Board notes that the Board's decision appears to turn on the Group I requests representing a "fresh case" rather than placing any particular emphasis on late filing. Neither the minutes, nor the Board's decision make any reference to "late filing" as a reason for not admitting the Group I requests.
23. Article 113(1) EPC is infringed if a board does not address submissions that, in its view, are relevant for the decision in a manner adequate to show that the

parties were heard on them, that is that the board substantively considered those submissions (see R 8/15, point 2.2.2). Thus in this case, if the Board had considered the Group I requests to be late filed, it should have explicitly addressed in its decision the Petitioner's argument that the Group I requests were not late filed as the feature "while exercising" had been introduced into a claim request at an earlier stage of the proceedings.

24. As a rule, it is the board that decides which of a party's submissions are relevant, irrespective of whether the party considers them to be essential (see top of page 13, R 10/18).
25. It is to be presumed that a board took account of a party's submissions that it did not address in the reasons for its decision. Thus, in a first step, the board took note of the party's submissions, and in a second step assessed whether they were relevant, and if so, whether they were correct (see paragraph bottom of page 14 to top of page 15, R 10/18).
26. The above presumption may be rebutted if there are indications in the file and/or the board's decision, that either the board did not address in its decision the submissions of a party that, on an objective basis, can be considered decisive for the outcome of the case, or dismissed such submissions without assessing them as to their correctness (see page 15, R 10/18).
27. In the present case the Enlarged Board considers that there are objective indications that the Board did not consider the Petitioner's argument that the "while

exercising" feature had been in a claim since 4 July 2018 as being either relevant and/or decisive. These are that the Group I requests were not admitted as they constituted a fresh case and were not a response to the filing of documents B1 to B7, and that neither the Board's decision (see para 4.1) nor the minutes refer to "late filing" as a reason for non-admission.

28. This would explain why the Board did not refer to the argument that the "while exercising" feature had been in a claim since 4 July 2018.

29. It follows from the above that no violation of the Petitioner's right to be heard can be established. Hence, the Petition is clearly unallowable in this respect.

Non-admission of the Group II requests

30. The Petitioner argues that the Board incorrectly exercised its discretion on whether or not to admit the Group II requests.

31. The Petition can only succeed on this point if the Board exercised its discretion not to admit the requests in a way that amounted to a violation of the Petitioner's right to be heard.

32. The case law of the Enlarged Board under Article 112a EPC has made it clear that a petition may only be used as a vehicle to review the merits of a decision relating to a procedural issue if one of the procedural defects listed in Article 112a(2) EPC is alleged to have occurred (see R 20/10, points 2.1, last para, and

- 2.5). This is obviously also the case when a review is sought of the way in which a board has exercised its discretion in relation to a procedural matter such as the admission of requests (see R 10/09, point 2.2).
33. The Enlarged Boards notes that the issue of admissibility of the Group II requests was discussed during the oral proceedings held before the board between 12:10 and 14:50 (see R 10/09, point 2.3; R 11/11 point 8; and R 4/13 point 5.5).
34. Further, in accordance with the established case law, the Enlarged Board has no power to control the normal exercise a board makes of its discretion whether or not to admit claim requests. Rather, the exercise of this discretion by a board is subject to only limited review, (see R 10/09, points 3.2, and 3.3; R 6/17, point 3.5; Case Law of the Boards of Appeal, 9th edition 2019, chap. V.B.3.4.3, third paragraph, page 1345).
35. With regard to the admittance of the Group II requests, the Enlarged Board fails to find anything that supports a finding that the Board exercised its discretion in an arbitrary or manifestly illegal manner.
36. The Petitioner also claims a second violation of the right to be heard as regards the Group II requests, in particular the Board's decision not to admit auxiliary request I'. The Petitioner states that in the oral proceedings before the Board, the main reason given for not admitting this request was that it was "divergent". In the written decision, the reason for non-admission was that it was "late filed". The Petitioner was thus not given the opportunity to plead its case on late

filing as this had not been a topic in the discussion of the admission of auxiliary request I' that took place in the oral proceedings before the Board.

37. The Enlarged Board notes that the minutes of the oral proceedings before the Board indicate that for all of the claim requests comprising the Group II requests the reason given for non-admission was "...the very late stage of the proceedings and a lack of convergence with the new main request". In addition, auxiliary request Ie was found to involve "... increased complexity of procedural issues". The "... very late stage of the proceedings and a lack of convergence with the new main request" are the exact reasons given in point 6.2 of the Board's decision for not admitting auxiliary request I' into the proceedings. The Petitioner's argument on this point appears to be without merit.
38. The Enlarged Board observes that 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 it will come to its conclusion. This is part of the reasoning given in the written decision (see R 15/12, point 5).
39. 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, 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 rely upon any unknown fact that the parties should have been informed about beforehand. The reasoning of the

Board, (see paras 5.1 to 6.2 of the decision) is directly based upon arguments made by the parties.

40. In the light of the above, the Petitioner's claim that its right to be heard was violated is tantamount to imposing on the boards a requirement that the parties are provided with a board's detailed reasoning for its decision before the decision is announced, and with an opportunity to comment on this detailed reasoning. Such a requirement clearly does not exist.
41. It follows from the above that also in respect of the complaint with regard to the non-admission of the Group II requests no violation of the Petitioner's right to be heard can be established. Hence, the Petition is clearly unallowable also in this respect.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as being clearly unallowable.

The Registrar:

The Chairman:



N. Michaleczek

C. Josefsson

Decision electronically authenticated