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**Datasheet for the decision  
of 2 September 2021**

**Case Number:** R 0003/20  
**Appeal Number:** T 1624/16 - 3.2.01  
**Application Number:** 07123489.2  
**Publication Number:** 2072363  
**IPC:** B60T13/74, B60T17/22  
**Language of the proceedings:** EN

**Title of invention:**

Method and device for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning

**Patent Proprietor:**

IVECO S.p.A.

**Opponents:**

WABCO GmbH  
Knorr-Bremse Systeme für Nutzfahrzeuge GmbH

**Headword:**

-

**Relevant legal provisions:**

EPC Art. 14(2), 112a(2)(c)(d), 113(1)  
EPC R. 104(b), 106, 109(2)(a)  
RPBA 2007 Art. 13(1)

**Keyword:**

Objection under Rule 106 EPC raised (no)  
Petition for review clearly inadmissible (yes)

**Decisions cited:**

-

**Catchword:**

Fundamental violation of Article 113 and Rule 104 (b) EPC



**Große Beschwerdekammer  
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**Case Number:** R 0003/20

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 2 September 2021**

**Petitioner:**  
(Patent Proprietor)

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**Decision under review:**

**Decision T 1624/16 of the Technical Board of  
Appeal 3.2.01 of the European Patent Office of  
10 July 2019.**

**Composition of the Board:**

**Chairman:** I. Beckedorf  
**Members:** B. Müller  
M. Alvazzi Delfrate

## **Summary of Facts and Submissions**

### **I. The decision under review**

The patent proprietor's petition is directed against the decision of Technical Board 3.2.01 (hereinafter: "the Board") in appeal case T 1624/16. By that decision, the Board set aside the decision of the opposition division rejecting the two oppositions filed against European patent number 2 072 363 and revoked the patent. The Board gave its decision further to the appeal of opponent 2 (opponent 1 had filed no appeal and no observations in the appeal proceedings and did not attend the oral proceedings before the Board). The decision was pronounced in the oral proceedings of 10 July 2019 and the reasoned written decision was posted on 2 January 2020.

The title of the invention is "Method and device for controlling the intervention of the electric parking brake of a vehicle, in condition of dynamic functioning".

### **II. The facts and arguments submitted by the petitioner in the petition**

(a) *The facts underlying the petition*

(i) First ground for the petition: violation of Article 113(1) EPC for lack of opportunity to counterargue against non-admittance of a request under Article 14(2) EPC

On 11 June 2019, i.e. "less than a month before the oral proceedings" before the Board, the petitioner received a "surprising", "very brief and vague" negative preliminary opinion of the Board on "pending claim 1" of the main request,

i.e. the patent as granted. In reply to this opinion, on 27 June 2019, the petitioner filed auxiliary requests 1 to 6 (the main request was directed at the dismissal of the appeal, i.e. maintenance of the patent as granted).

In the oral proceedings on 10 July 2019, to the petitioner's renewed surprise, the Board "changed its view about the interpretation of the term 'prevention of the intervention'". As a consequence, the petitioner made a **request under Article 14(2) EPC to bring the translation of auxiliary requests 1 to 6 into conformity with the application as filed** in Italian language by replacing the term "prevention of the intervention" with "inhibition of the intervention". In both the first and second auxiliary requests claim 1 corresponded to the version as granted, without any amendment. The remaining auxiliary requests comprised amendments from the description. Therefore it was not the petitioner's intention to question the Board's discretion "in maintaining such requests" (see the upper part of page 3 of the petition), i.e. these remaining requests.

(The Enlarged Board notes that, according to the decision under review (in point 3.1), the petitioner filed the amended auxiliary requests 1 to 6 during the oral proceedings, "after the board had given its negative opinion with regard to novelty of the subject-matter of claim 1 as granted".) The petitioner submitted that it considered the two terms "prevention" and "inhibition" equivalent and that it appeared only during the discussion with the Board that "prevention" was considered to have a wider meaning than "inhibition".

On 2 December 2019 the petitioner filed a request for correction of the minutes of the oral proceedings because they did not "truly reflect that the request of Patent Proprietor

was made according to Art. 14(2) EPC" (see penultimate paragraph of page 3 of the petition). The Board refused that request and issued the decision under review.

The Board refused "to admit the amended requests" to the appeal proceedings pursuant to Article 13(1) RPBA 2007. The petitioner submits that, in the decision under review, the Board acknowledged that "the request" merely contained a request to bring a translation into conformity, in the form of the substitution of the term in issue (i.e. substituting "prevention" with "inhibition"). Accordingly, the question arose why a request under Article 14(2) EPC had not been admitted or, in other words, was considered an inadmissible amendment. Pursuant to Article 14(2) EPC the request should have been considered *a priori* allowable.

The petitioner concluded: "The above is a clear violation of Art. 113 EPC since no possibility of counter arguing against the Board Opinion has been given, in light of the fact that a request of conformity of the translation and not for an amendment has been pursued by the Patent Proprietor."

(ii) Second ground for the petition: violation of Article 113(2) EPC

Under Article 14(2) EPC a translation might be brought into conformity with the original filed text before the EPO. Article 113(2) EPC provided that the EPO had to examine and decide upon the text submitted to it.

Since the Board arbitrarily dismissed the petitioner's conformity request, the Board examined and decided upon a text which did not correspond to the text submitted to the EPO.

In the context of this ground for petition, the petitioner also stated that both the opponent and the patent proprietor addressed the question of a "correction" under Article 14(2) EPC "according to the meaning of Rule 106 EPC", i.e. the duty to raise an objection (see below, point II.(b)).

(iii) Third ground for the petition: violation of Rule 104(b) EPC

In its decision, the Board "merely hides under the general 'principle of need for procedural economy' for not providing a clear decision about the relationship between a conformity of the translation request according to Art. 14(2) EPC and an amendment under Art. 123 EPC."

Therefore, there had not been a decision on the appeal on a request relevant to the decision, as encompassed by Rule 104(b) EPC.

Furthermore, point 3.4 of the decision was contested. In that point the Board held that, changing the wording of, e.g., claim 1 by replacing the term "prevention" with "inhibition" would start a new discussion on whether the claimed subject matter had changed or not.

The Board's arguments in this point were "captious", because they did not take into account the discussion during the oral proceedings and, in particular, there was no explanation about the refusal of the request according to Article 14(2) EPC. For the petitioner "prevention" had the meaning of "inhibition".

(b) *The admissibility of the petition*

As to the admissibility of the petition, the petitioner submits (on page 1 of the petition) that

- the petition for review was filed within the two-month time limit of Article 112a(4) EPC, and the fee paid on that date;
- "The present petition for review is deemed to be allowable **according to Rule 106 EPC** in view of **procedural defects raised during the Appeal**, as detailed [in the grounds for the petition] below." (Emphasis added.)

As to Rule 106 EPC, the petitioner added (at the bottom of page 4 of the petition) in the context of the second ground for petition (violation of Article 113(2) EPC): "...as stated in the decision... both the Opponent and the Patent Proprietor raised and addressed during the Appeal the question of the Art. 14(2) EPC correction (**according to the meaning of Rule 106 EPC**). See below excerpts of the decision:". (Emphasis added, emphasis in the original omitted.) Those excerpts relate to the arguments of opponent 2 and the petitioner put forward in the oral proceedings on auxiliary requests 1 to 6 filed during those oral proceedings in connection with Article 14(2) EPC.

They are entitled "[Opponent arguments against the Patent Proprietor Request]" and "[Patent Proprietor arguments in favour of the Request]", respectively.

### **III. Communication by Enlarged Board**

The Enlarged Board issued a communication in preparation of the oral proceedings arranged upon the petitioner's respective

auxiliary request. Therein (see point B.1, page 6) it was of the provisional view that (only) two grounds for review were relied on (emphasis added):

The Enlarged Board considers that the petition is based on the following grounds:

- that a fundamental violation of Article 113(1) EPC occurred (Article 112a(2)(c) EPC), because the petitioner was not provided with an opportunity to reply to the Board's interpretation of Article 14(2) EPC given in the oral proceedings; ...

- that the Board violated Rule 104(b) in conjunction with Article 112a(2)(d) EPC in deciding on the appeal without deciding on a request relevant to the decision... The assertion of a violation of Article 113(2) EPC in this context is considered **an argument in support of a violation of Rule 104(b) EPC, not a separate ground for the petition.**

In the Enlarged Board's preliminary view, the petition was clearly inadmissible (Article 109(2)(a) EPC) for failure to comply with the duty to raise an objection in the meaning of Rule 106 EPC.

The petition would not be allowable either. In particular, the Board not having admitted auxiliary requests 1 to 6 to the proceedings, those requests did not become part of the appeal proceedings (see last paragraph of page 14).

#### **IV. The petitioner 's reply to the Communication**

##### *(a) Summary*

As to the requirements of filing an objection under Rule 106 EPC, the petitioner submitted that the Board was clearly able to discern that it was violating Article 113 EPC and Rule 104(b) EPC both during the oral proceedings and "at the request of correction of the Minutes".



*(b) Whether the first auxiliary request was on file*

The petitioner made an "important clarification" in respect of the perceived position taken by the Enlarged Board in its communication that the **first** auxiliary request was not on file: the request to the Board was a correction of the auxiliary requests already on file.

As stated during the oral proceedings, and totally disregarded by the Board, according to Article 14(2) "Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the application as filed".

The first auxiliary request therefore corresponded to the request on file and should not have been disregarded by the Board of Appeal, as discussed in detail in the petition.

*(c) Discussion of whether the petitioner raised an objection under Rule 106 EPC*

*(i) Article 14(2) EPC quoted throughout the proceedings*

During the oral proceedings, and as stated in the request for correction of the minutes, the petitioner asked for a correction and clearly stated that, according to Article 14(2) EPC, the correction should have been admitted *per se* to the proceedings, because it concerned a request on file. Therefore the Board was clearly advised, "both before **and after**" (emphasis added) its decision, as detailed below.

When the petitioner quoted Article 14(2) EPC "through all the proceedings" the Board should immediately have understood this as a violation of the petitioner's right to be heard and a procedural defect.

Moreover, the petitioner was clearly adversely affected by the decision of the Board to deny its right according to Article 14(2) EPC, and no further explicit objection under Rule 106 EPC should have been raised to make clearer to the Board that procedural and substantive violations under Art. 113 EPC (in particular paragraph 2) and Rule 104(b) EPC were occurring.

In view of the above procedural violations such objection was distinct and unambiguously clear in the meaning of R 4/08 [point 1 of the Reasons]: the requirement pursuant to Rule 106 EPC was fulfilled in so far as the petitioner might be understood as implicitly asserting a fundamental violation of Article 113(1) EPC by alleging that the reasons given in the written decision for the admission of the proprietor's auxiliary requests had not been discussed during the oral proceedings "since the Petitioner was not satisfied by the decision of the Board of Appeal to deny the request under Art. 14(2) EPC."

(ii) Differences between violations under Article 113(2) and Rule 104(b) EPC

Moreover, the petitioner submitted that the violation of Art. 113(2) EPC and the violation of Rule 104(b) EPC were **distinct** and therefore should be considered as **separate grounds**, for the following reasons.

Article 112a EPC indicated at point (c) that a fundamental violation of Article 113 EPC was an admissible ground for a petition for review; the fundamental violation had occurred against Art. **113 (2) EPC because the Board of Appeal decided on a text, which was not the one submitted by the Proprietor.** Auxiliary requests 1-6 were submitted in reply to the statement of the grounds for appeal by the appellant (opponent)

and therefore they were part of the proceedings. According to Article 123(2) EPC, the auxiliary requests were based on the application as filed, whose authentic text according to Article 70(2) EPC was the original Italian text. By "requiring" the translation of the application as filed according to Article 14 (2) EPC, on which the auxiliary requests were based, the patent proprietor **set out the text and thus the meaning of those auxiliary requests on which a decision should have been taken**. However, the final decision of the Board was based on **a different text**, which was not the one submitted by the proprietor (petitioner).

(iii) Remittal

A further indication that an **objection** had been addressed to the Board to reconsider the denial of the petitioner's request under Article 14(2) EPC during the oral proceedings was the following, taken from the minutes:

The respondent [petitioner] requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of the set of claims of one of the first to sixth auxiliary requests, filed during the oral proceedings of 10 July 2019 or, further alternatively, that the case be remitted to the opposition division for further prosecution. (emphasis by the petitioner)

The cited paragraph clearly and unambiguously stated that the patent proprietor (petitioner) believed that a **further discussion** should be pursued, since the Petitioner was **not satisfied** by the wrong decision of the Board of Appeal to **deny the request under Article 14(2) EPC** because a decision had been taken based on a text which did not correspond to the text agreed by the proprietor of the patent.

Further and analogous proof could be found in the opponent's comments on the petitioner's request for correction of the minutes of 19 December 2019: "Hierauf entgegnete die

Patentinhaberin lediglich, dass sie dem Antrag auf Rückverweisung an die erste Instanz zustimme", i.e. "The patent proprietor merely replied that he agreed to the request for referral back to the first instance", i.e. the petitioner would have been satisfied to discuss the matter, even if such discussion had taken place again before the opposition division but, clearly, the **petitioner objected to the rejection made by the Board during the oral proceedings**. The petitioner asked during the oral proceedings to have a full discussion of the real text of the patent.

Accordingly, the Board was objected to during the oral proceedings and advised that a **procedural error** had been made.

(iv) Minutes of the oral proceedings before the Board

The petitioner's request for correction of the minutes included the following passages:

- (i) "In particular, they [the minutes] show deficiencies with regard to the aspects mentioned, i.e. essential submissions and similarly important procedural statements are missing and incorrectly reflected in the minute."
- (ii) "The Patent Proprietor trusts that the registrar may correct the Minutes so that they may correctly comply with what really happened during the Oral Proceedings dated July 10, 2019".

According to excerpt (i) it was clear that the petitioner noted (literally):

- Deficiencies
- Important missing procedural statements
- Incorrect reflections

According to excerpt (ii) it was clear that the Petitioner noted (literally):

- "Incorrect compliance of what really happened during the Oral Proceedings."

Therefore, the Board of Appeal was clearly advised that a procedural violation had been committed and that the minutes did not correctly reflect what happened during the oral proceedings. The **request for correction** of the minutes [made after the hearing] clearly **advised the Board again** that the decision taken was not based on the agreed text of the patent and that a procedural error had been made and that both a violation of Art. 113(2) EPC and of Rule 104(b) EPC occurred.

(v) Lengthy adjournment of the oral proceedings

During the oral proceedings the Board asked the petitioner twice for the legal basis for the mentioned correction request under Article 14(2) EPC and adjourned the oral proceedings for three hours ("...the Board of Appeal asked twice to the Petitioner the legal basis for asking the mentioned Art. 14(2) correction request during a three hour 'stop' of the proceedings") (page 4, antepenultimate paragraph, of the petition).

That question and the long duration of the adjournment were clear indications that the Board had been advised about the importance of the request that the Board totally disregarded. The petitioner objected to this disregard during the oral proceeding **repeating twice "during" the adjournment period and subsequently ("further")**, after the decision of the Board, that the correction according to Article 14(2) EPC of only the first auxiliary request should have been *per se* admitted.

Accordingly, the two above-mentioned indications of **objection** against the Board were sufficient according to Art. [sic] 106 EPC in view of what happened during the Oral Proceedings. It was furthermore demonstrated that the Board voluntarily disregarded the petitioner's request.

#### **V. The oral proceedings before the Enlarged Board**

In the course of the oral proceedings the petitioner submitted that there were three asserted grounds for review (not two, as assumed in the Enlarged Board's communication). They all revolved around the petitioner's assertion that the Board did not accept its request to bring the translation in line with the original Italian text pursuant to Article 14(2) EPC by "correcting" the term "prevention" by "inhibition". Rather, the Board treated this request as an amendment to the claim requests. This **single procedural defect** prompted the infringement of three different provisions of the EPC and gave rise to three corresponding different grounds for petition:

- the petitioner was not heard on the requested correction as opposed to amendment thereby infringing Article 113(1) EPC (first ground for petition),
- the board "decided" on non-corrected versions of the auxiliary requests (for failure to allow the request for correction under Article 14(2) EPC), thereby infringing Art. 113(2) (second ground for petition) and
- the board declined to decide on the request for correction under Article 14(2) EPC thereby infringing Rule 104(b) EPC (third ground for petition).

The Board was advised twice that a correction should be admitted, before the Board had given its opinion on admittance of auxiliary requests 1 to 6 filed during the oral proceedings,

and also after it had given such opinion following a three-hour break for deliberation on the correction.

In respect of the final requests made before the Board as set out in the minutes, the chairman of the Enlarged Board drew the petitioner's attention to the fact that it had not asked for their correction. The petitioner agreed, but submitted that the request for correction of the minutes included a request for correction of the final requests as a logical consequence.

The petitioner contended that the requests filed on 27 June 2019 further to the Board's preliminary opinion issued before the hearing were the requests "on file". After the Board had expressed its position on claim 1 of the main request (patent as granted) in the hearing, the petitioner filed a request, i.e. one single request, to bring the translation in conformity under Article 14(2) EPC in replacing, in all the auxiliary requests 1-6, the term "prevention" with "inhibition". The amended ("corrected") auxiliary requests 1-6 were merely the expression of that one single request under Article 14(2) EPC.

It may be true that the chairman, at the end of the oral proceedings, after having dealt with the unrelated issue of reimbursement of the appeal fee for procedural violation by the opposition division, asked whether there were any requests or comments. The petitioner did not raise an objection at this latest stage of the proceedings, because it believed that the topic of Article 14(2) EPC had been finally dealt with and the board's opinion that the chairman had announced, could not be overcome any longer.

The petitioner's **final requests** were that

- the decision under review be set aside;
- the proceedings before the Technical Board of Appeal be reopened;
- the members of the Board who participated in the decision be replaced; and
- the fee for the petition for review be reimbursed.

## Reasons for the Decision

### 1. **The divergent meanings attributed to the requests filed in the oral proceedings held before the Board**

#### 1.1 *The minutes of those proceedings*

They read (on pages 2-3):

After a break for deliberation by the board, the chairman expressed the view of the board that the subject-matter of claim 1 of the main request was not novel over the disclosure of document D2.

...The respondent then requested a short break for considering its requests, which was allowed.

**Next the respondent submitted a first to sixth auxiliary request to replace the auxiliary requests on file. ... [last full paragraph on page 2/4]**

The parties were heard on admissibility of the thus corrected auxiliary requests... The appellant objected to the admission of the auxiliary requests and requested to postpone the proceedings in order to have the opportunity to discuss the case with his client or that the case be remitted to the opposition division in case the board would allow the auxiliary requests into the proceedings. The respondent agreed to this latter request.

After a break for deliberation by the board, the chairman stated that the board had decided to not admit the new auxiliary requests into the proceedings.



1.2 *Petitioner's request for correction of the minutes*

By letter of 2 December 2019, the petitioner requested correction of the minutes since they were deemed not to fulfil the requirements of Rule 124 EPC. It stated verbatim:

In particular, they show deficiencies with regard to the aspects mentioned, i.e. essential submissions and similarly important procedural statements are missing and incorrectly reflected in the minute.

Substantially, it is noticed that:

- The first to sixth auxiliary requests were filed on June 27, 2019, in reply to a negative preliminary assessment of the Board of Appeal which surprised the Patent Proprietor;
- The Proprietor merely required a correction of such filed auxiliary request because of an essential term (prevention) was interpreted in an incorrect way during the novelty discussion preceding the request of the correction of the auxiliary request.

Indeed, the Proprietor asked for a correction during the proceedings based on the above interpretation and on the original Italian text of the filed application.

- Moreover, the correction reported into the minutes was caused by a typographical error and requested by the Board of Appeal, i.e. it was not a Patent Proprietor request, as it seems from the minutes.

Accordingly, the last full paragraph of page 2/4 of the minutes should be re-phrased to recite

**"Next the respondent submitted a request of correction of the auxiliary requests on file in view of the preceding novelty discussion..."**

1.3 *Communication in response to the correction request of 17 December 2021*

In that communication the Board stated (in point 2):

"The request for correction of the minutes is based on the allegation that the respondent merely requested a correction of the auxiliary requests on file.

According to the recollection of the board and the notes made during the oral proceedings the respondent delivered by hand at 11:02 hrs to the Board auxiliary requests 1 to 6 (12 sheets of paper, signed by the respondent's representative). The respondent submitted that these new requests shall replace the auxiliary requests on file.

This is what is stated in the minutes of the oral proceedings by "Next the respondent submitted a first to sixth auxiliary request to replace the auxiliary requests on file."

#### 1.4 *The assessment of the Enlarged Board*

In its petition, the reply to the Enlarged Board's communication and the oral proceedings before the Enlarged Board the petitioner maintained its view that the minutes were incorrect, in particular because a correction of the auxiliary requests filed before the oral proceedings before the Board on 27 June 2019 was requested, i.e. that the earlier requests were not replaced by the latter requests.

The Enlarged Board notes that the petitioner does not deny having "delivered by hand... to the Board auxiliary requests 1 to 6 (12 sheets of paper, signed by the respondent's representative)." These sheets of paper, which are signed and dated, are attached to the minutes of the oral proceedings before the Board and part of the public file.

In the petitioner's view, however, these requests constitute a "correction" of the pending auxiliary requests and not new auxiliary requests, with "correction" meaning bringing the translation in conformity with the application as filed pursuant to Article 14(2) EPC.

In the Enlarged Board's opinion the question of whether the auxiliary requests filed during the oral proceedings are mere "corrections" in this meaning or new requests replacing the previously filed auxiliary requests is a question of substantive law. It must therefore remain an open one when it comes to assessing whether or not the petitioner raised objections within the meaning of Rule 106 EPC in respect of all three grounds for the petition relating to procedural defects mentioned in point V above.

All three grounds relate to the question whether the sheets of paper filed during the oral proceedings before the Board are to be treated as new requests or as "corrections" of the pending requests pursuant to Article 14(2) EPC.

According to the first ground the petitioner was not heard on this issue, under the second ground, the Board assessed the wrong version of the requests, i.e. not the version filed before the oral proceedings as corrected, but requests that the Board considered to be new, and under the third ground, the Board did not deal with the request for correction underlying the contents of the sheets of paper filed during the oral proceedings.

Given that the three grounds are thus closely linked, the Enlarged Board will assess compliance with Rule 106 EPC for all three grounds jointly.

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

### 2.1 *General aspects*

The petitioner is adversely affected by the decision under review, and the petition for review was filed, and the corresponding fee paid, within the prescribed time limit and in the prescribed form in accordance with Article 112a(4), second sentence, EPC and Rule 107 EPC. The petition is based on Article 113(1) EPC, corresponding to the ground for review of Article 112a(2)(c) EPC, and Rule 104(b) EPC adopted on the basis of Article 112a(2)(d) EPC.

### 2.2 *Duty to raise an objection*

#### 2.2.1 Rule 106 EPC: interpretation of the term "objection" and evidence of an objection in the case law

Rule 106 EPC provides:

A petition under Article 112a, paragraph 2(a) to (d), 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.

The purpose of this rule is "to give the board a chance to react immediately and appropriately by either removing the cause of the objection or by dismissing it". See the EPO publication "Case Law of the Boards of Appeal of the EPO", 9th edition 2019, hereinafter referred to as "Case Law", at point V.B.3.6.1 and the decisions cited there.

An overview of the case law of the Enlarged Board of Appeal on the requirements of a valid objection is set out in the "Case Law" at point V.B.3.6.2.

Sub-paragraph (a) is entitled "**Recognisable immediately as an objection, defect clear and unambiguous**". It reads as follows:

Raising an objection under R. 106 EPC is a procedural act and a precondition for access to the extraordinary legal remedy under Art. 112a EPC (R 4/08, R 7/08, R 3/11, R 7/11, R 16/12). The **objection must be expressed by the party in such a form that the board is able to recognise immediately and without doubt that an objection under R. 106 EPC is intended**. It also must be **specific, indicating clearly and unambiguously on which procedural defect the petitioner intends to rely** (see **R 4/08**, R 7/08, R 8/08, R 1/10, R 17/10, R 7/11, R 5/12, R 6/12, R 16/12: established jurisprudence, R 3/14, R 8/16).

An objection under R. 106 EPC is **additional to and distinct from other statements, such as arguing or even protesting against the conduct of the proceedings or against an individual procedural finding** (R 2/08, R 7/08, R 9/09, R 1/10, R 14/11, R 21/11, R 16/12). An objection must be **expressly described as such** (R 8/08, R 21/11). However, **even if** an objection does **not** contain an explicit reference to R. 106 EPC, **it can qualify as an objection under R. 106** (R 21/09; see also R 17/14, R 12/14).

Point V.B.3.6.4 deals with "**Minutes as evidence** that the objection was raised":

The test whether an objection was validly raised during oral proceedings is normally the minutes which, as prescribed by R. 124(1) EPC, must contain the relevant statements of the parties (R 4/08, R 17/10, R 8/16). The **absence in the minutes of an objection under R. 106 EPC and of any request for correction of the minutes is a strong indication that such an objection**, if any, was at least **not duly qualified** (R 3/11; see also R 5/14, R 6/13, R 3/14).

In R 7/11 the Enlarged Board noted that unless duly corrected, the minutes of the oral proceedings authenticate the facts they relate to, and in R 2/12 of 17 October 2012 the Enlarged Board stated that If a party is really convinced that a violation of its right to be heard has occurred during the oral proceedings the subsequent objection must be clearly raised as such, so that it will oblige the board of appeal to react, and require this to be recorded in the minutes in accordance with R. 124 EPC.

In R 8/17 the board stated that the **petitioner's own submissions did not allow the conclusion that it had raised an objection in the oral proceedings** which could qualify as an objection under R. 106 EPC and 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).

...

2.2.2 Application of the above case law on Rule 106 EPC to this case

(a) The petitioner's submissions

The Enlarged Board understands the petitioner's submissions made in the **petition** to the effect that the petition is supposed to comply with Rule 106 EPC due to the fact that both the petitioner and opponent 2 raised and addressed procedural defects pertaining to a correction under Article 14(2) EPC in the course of the oral proceedings before the Board (see point II.(b) above). The excerpts from the decision under review quoted to establish this assertion relate to arguments of the petitioner and opponent 2 put forward in the context of the second ground for petition (Article 113(2) EPC). The arguments are in respect of auxiliary requests 1 to 6 filed during those oral proceedings.

The excerpt relating to the petitioner's arguments consists of two paragraphs quoted on page 5 of the petition. This excerpt is entitled by the petitioner as "[Patent Proprietor arguments in favour of the Request]". Referring to Article 14(2) EPC it is stated in the quotation that, in the proceedings before the opposition division already, the petitioner had pointed out that in the originally filed Italian application the term "inibizione" had been used. In the

petitioner's view, the replacement of "prevention" by "inhibition" was correct. It was also justified to make the corresponding amendments during the oral proceedings, because it was the discussion in those proceedings only which made the understanding of the verb "to prevent" clear.

The excerpt from the decision under review relating to the arguments of opponent 2 consists of the paragraph quoted at the top of page 5 of the petition. This paragraph is entitled by the petitioner as "[Opponent arguments against the Patent Proprietor Request]" and sets forth why the auxiliary requests filed during the oral proceedings before the Board should not be admitted.

In its **reply** to the Enlarged Board's communication attached to the summons to oral proceedings and in those proceedings, the petitioner complemented its submissions regarding the application of Rule 106 EPC as set out above, in point IV with a view to rebutting the Board's adverse opinion.

The petitioner made several assertions to establish that it had raised an objection under Rule 106 EPC:

- it quoted Article 14(2) EPC throughout the proceedings, the Board asked the petitioner twice for the legal basis for the mentioned Art. 14(2) correction request and the Board adjourned the oral proceedings for three hours.
- The petitioner requested remittal of the case to the opposition division
- The petitioner requested correction of the minutes of the oral proceedings before the Board.

- Certain decisions in review proceedings supported its case.

(b) Analysis

- Objection in respect of the procedural defect

Pursuant to Rule 106 EPC an "objection in respect of the procedural defect" must be raised. This means that in the present case objections would have had to be raised in respect of all three asserted violations (see point 1 above) that were all allegedly caused by one and the same fact, i.e. the non-admittance of auxiliary requests 1 to 6 to the appeal proceedings. In so doing, the Board allegedly did not allow the request under Article 14(2) EPC even though it should have considered this request to be a *priori* allowable.

- The excerpts quoted in the petition (at page 5)

The Enlarged Board is unable to glean from the submissions by the petitioner and opponent 2 in the context of the second ground for petition only (violation of Article 113(2) EPC) that the representative of the petitioner or opponent 2 raised an objection within the meaning of Rule 106 EPC as interpreted by the case law reproduced above (in point 2.2.1) in the oral proceedings before the Board. It should be recalled that the case law laid down the criterion that the "objection must be expressed by the party in such a form that the board is able to recognise immediately and without doubt that an objection under R. 106 EPC is intended". The excerpts



quoted by the petitioner do not qualify as objections, because they do not meet this criterion.

The excerpt relating to the petitioner in support of its assertion of an objection having been raised (entitled "[Patent Proprietor arguments in favour of the Request]") does not include any criticism of the Board's way of conducting the oral proceedings, let alone does it use the term "objection". Rather, it explains the petitioner's position regarding the application of Article 14(2) EPC to the facts of the present case. More specifically, the excerpt mentions no violation of the right to be heard (Article 113(1) EPC), the duty to examine and decide only upon a text which corresponded to the text submitted to the EPO (Article 113(2) EPC) or of the Board's failure to decide on a request relevant to the decision (Rule 104(b) EPC), i.e. the three violations alleged to have taken place in the course of the oral proceedings.

No such violations can be inferred from the excerpt by implication, either. While it is not necessary to use the term "objection", a ground for a petition for review an objection must be "specific, indicating clearly and unambiguously on which procedural defect the petitioner intends to rely" (see above, point 2.2.1). This may be the case, for instance, where a violation of the right to be heard is asserted clearly, as in case R 21/09 (Reasons, point 1.4) or R 12/14 (Reasons, point 9). The excerpt, however, does not mention any violation of Article 113(1,2) or Rule 104(b) EPC, but essentially explains why the board should accept the replacement of the term "prevention" by "inhibition" that the petitioner sought in the oral

proceedings. Such mention would not have been possible anyway, i.e. the excerpt could not mention any such violation, because it deals with the petitioner's submissions **before** the Board had announced its position on admittance of the auxiliary requests filed during the oral proceedings, implying that it did not accept the petitioner's stance regarding the application of Article 14(2) EPC in the present case. The two asserted violations however obviously relate to that announced position. Submissions made before the announcement cannot logically constitute an objection to the later position.

Analogous considerations apply to the excerpt relating to opponent 2 quoted at the top of page 5 of the petition (entitled "[Opponent arguments against the Patent Proprietor Request]") on which the petitioner also relied to establish that an objection under Rule 106 EPC was made. The question of whether an objection filed by a party other than the petitioner could qualify as an objection under Rule 106 EPC therefore need not be answered.

Against the above backdrop, the Enlarged Board is unable to discern how the Board could have been alerted to a possible violation of Article 113(1,2) or Rule 104(b) EPC on the basis of the submissions made by the petitioner and opponent 2 in the oral proceedings before the Board quoted in the excerpts, and thus, how the purpose of Rule 106 EPC could have been fulfilled by those submissions. As stated above, that purpose is "to give the board a chance to react immediately and appropriately by either removing the cause of the objection or by dismissing it".

- The submissions made in reply to the Enlarged Board's communication and the in the course of the oral proceedings before the Enlarged Board.

Nor do the points raised in the reply to the Enlarged Board's communication or in the oral proceedings lead the Enlarged Board (see above, points IV and V, respectively) to arriving at a different conclusion.

*Objection under Article 14(2) EPC raised "throughout the proceedings"*

The Enlarged Board has difficulty in ascertaining from the file at which point in time the petitioner, apart from expressing its position **before** the Board had announced its opinion on the auxiliary requests filed during the oral proceedings, raised this point again. In the oral proceedings before the Enlarged Board the petitioner asserted that it did so after that announcement. Yet there is no reflection thereof in the minutes.

In any case, no matter what the petitioner's assertion that it quoted Article 14(2) EPC throughout the proceedings might amount to, such repeated quotation or objection to the Board's alleged incorrect interpretation of that provision is immaterial in the context of Rule 106 EPC. Under that rule, an objection must be raised against a **procedural defect**. Not allowing the petitioner's request for correction under Article 14(2) EPC and instead treating the auxiliary requests filed during the oral proceedings before the Board as amendments would, if incorrect, amount to an infringement of substantive, not procedural law, and

could thus not constitute a procedural defect in the meaning of Rule 106 EPC.

It must also be noted that a petitioner asserting having raised an objection for violation of the right to be heard on a certain issue in oral proceedings, while at the same time laying out extensively that it discussed that very issue with the board, is contradicting itself. In other words: a petitioner setting out how it had explained its position to the Board cannot be heard with a claim that it had objected to not being heard on that very point in oral proceedings.

Consequently, the Enlarged Board is unable to see how "the citation of Article 14(2) EPC through all the proceedings" should immediately read a violation of the right to be heard of the Petitioner and a procedural defect." (See middle of page 2 of the reply.)

Furthermore, it is not intelligible how the assertions that

- the Board asked the petitioner twice for the legal basis for the mentioned Article 14(2) EPC correction request and

- the Board adjourned the oral proceedings for three hours

could qualify as indications of objection under Rule 106, let alone fulfil the strict criteria established by the case law (see above, point 2.2).

The first assertion relates to a question by the Board, not a comment by the petitioner to the Board. The second assertion is mere conjecture implying that a Board deliberated on the issue of a procedural defect

raised, while there is no indication that the petitioner raised such defect. Apart from that, it is not for the Enlarged Board to speculate about the reasons for the Board's above question or the three-hour break.

*Remittal*

The petitioner's agreement to a possible remittal of the case to the opposition division for further prosecution again is unconnected with the raising of a procedural defect under Rule 106 EPC. Remittal is one of the two options provided by Article 111(1) EPC in case the Board finds an appeal to be allowable.

*The minutes of the oral proceedings*

Nor can the Enlarged Board identify any objection having been raised by the petitioner in accordance with Rule 106 EPC from the plain text of the minutes of the oral proceedings held before the Board, or by implication from those minutes.

According to the pertinent part of the minutes of the oral proceedings,

... the respondent submitted a first to sixth auxiliary request to replace the auxiliary requests on file. In the course of the discussion the respondent corrected the third and the sixth auxiliary request.

**The parties were heard on admissibility of the thus corrected auxiliary requests (annex).** The appellant objected to the admission of the auxiliary requests and requested to postpone the proceedings in order to have the opportunity to discuss the case with his client or that the case be remitted to the opposition division in case the board would allow the auxiliary requests into

the proceedings. The respondent agreed to this latter request.

**After a break for deliberation by the board, the chairman stated that the board had decided to not admit the new auxiliary requests into the proceedings.**

The appellant was then heard on the request for reimbursement of the appeal fee. The respondent stated it had no comments on this request.

The parties were asked to confirm their final requests.

The appellant requested that the decision under appeal be set aside, that the patent be revoked and that the appeal fee be reimbursed.

The respondent requested that the appeal be dismissed or, alternatively, that the patent be maintained on the basis of the set of claims of one of the first to sixth auxiliary requests, filed during the oral proceedings of 10 July 2019 or, further alternatively, that the case be remitted to the opposition division for further prosecution.

**The chairman asked the parties if they had any further observations or requests. There were none.**

The chairman then declared the debate closed.

(Emphases added.)

The request for correction of the minutes, which the Board refused, is immaterial in this respect. It was intended to clarify that the petitioner had made a request under Article 14(2) EPC. It did not criticise the minutes, neither expressly nor by implication, for having failed to include an objection made under Rule 106 EPC.

The petitioner's additional submissions regarding the request for correction of the minutes made in the reply to the Enlarged Board's communication and during the oral proceedings before the Enlarged Board are equally unconvincing. They do not establish that an objection in the meaning of Rule 106 EPC was raised during the hearing. Objections asserted to have been raised in the correction request would be belated and relying on them therefore has no purpose.

Apart from the request to replace the phrase "submitted a first to sixth auxiliary request" by "submitted a request for correction of the auxiliary requests", the request for correction is unspecific: it is not clear what parts of the minutes are supposed to be corrected to bring out an objection under Rule 106 EPC. This is shown clearly by the petitioner's submissions in the reply to the Enlarged Board's communication. The Enlarged Board is at a loss to understand how the Board, on the basis of general terms used in the reply, such as

- Deficiencies
- Important missing procedural statements
- Incorrect reflections
- Incorrect compliance of what really happened during the Oral Proceedings

could have been alerted to a specific procedural defect of the kind relied on, i.e. a violation of Article 113(1,2) or Rule 104(b) EPC, in order to reconsider a stance taken.

The further assertion that an objection under Rule 106 EPC was made in the request for correction of the minutes of the oral proceedings is beside the point,

because the Board had already pronounced the order of its decision at the end of those proceedings. The request for correction of the minutes can only relate to what was said in the past, during the oral proceedings.

*Decisions in review cases*

The decisions in review cases under Article 112a EPC that the petitioner cited in the oral proceedings before the Enlarged Board are not to the point either:

- R 9/11: According to the petitioner, it was held in this decision that the board of appeal did not have discretion in disregarding request for correction. As the chairman stated in the oral proceedings before the Enlarged Board, case R 9/11 relates to substantive issues.

- R 21/09 : The respondent did not mention Rule 106 EPC. Nevertheless, the objection was clearly raised and entered in the minutes relating to a specific procedural defect (« ... l'objection clairement soulevée et notée au procès verbal de la chambre de recours, portant sur un vice de procédure précis ...»). The facts of the present case are clearly different, as extensively laid out above.

- *Objection could have been raised during the oral proceedings*

Pursuant to Rule 106 EPC, an objection is a requirement for admissibility of a petition "except where such objection could not be raised during the appeal proceedings".



The Enlarged Board is of the opinion that this exception does not apply in this case. An objection could have been raised in the course of the oral proceedings. The right point in time would have been after a break for deliberation by the Board, when the chairman stated that the Board had decided to not admit the new auxiliary requests into the proceedings. **This statement made it clear that the Board did not accept the view obviously held by the petitioner that amendments made to claim requests pursuant to Article 14(2) EPC were valid independent of admittance of these requests** into the proceedings under procedural rules, such as Article 13(1) RPBA 2007 in the present case.

If the petitioner's representative had thought that, in addition to the arguments that he had provided in the oral proceedings as summarised in the above excerpt, the petitioner should also have been afforded an opportunity to reply to the Board's interpretation of Article 14(2) EPC, then he should have raised objections in relation to the three asserted violations, as they all relate to Article 14(2) EPC.

The petitioner's representative should in any case have raised an objection before the closure of the debate, at the latest in reply to the chairman's question whether the parties had any further observations or requests. "Decisions" announced in the course of oral proceedings before a board on specific points are not final and, in principle, subject to reconsideration before the final decision is pronounced as order at the end of the oral proceedings (see R 5/19, point I.2.2 of the Reasons).

In the petition, the petitioner refers to the reasons for the decision under review several times, but does not claim that they were surprising and does not allege an additional and separate violation of Article 113(1) EPC based on those reasons. More precisely, the petitioner criticises point 3.4 providing the reasons for non-admittance of the auxiliary requests filed during the oral proceedings and thus the non-acceptance of the petitioner's interpretation of Article 14(2) EPC. As stated, this conclusion followed clearly already from the announcement of non-admittance in the oral proceedings, and an objection could have been filed from that announcement and before the closure of the debate. There is thus no reason for the Enlarged Board to consider of its own motion that an objection could not have been filed in relation to the reasons of the decision, so that insofar Rule 106 EPC did not apply.

This finding cannot be called into question by the petitioner's assertions made for the first time in its reply to the Enlarged Board's communication (on page 2). The petitioner argued that an objection was raised in the meaning of R 4/08 (point 1 of the Reasons): the requirement pursuant to Rule 106 EPC was fulfilled in so far as the petitioner might be understood as **implicitly** asserting a fundamental violation of Article 113(1) EPC by alleging that the reasons given in the written decision for the admission of the proprietor's auxiliary requests had not been discussed during the oral proceedings "since the Petitioner was not satisfied by the decision of the Board of Appeal to deny the request under Art. 14(2) EPC." The Enlarged Board assumes that the alleged implicit assertion in

respect of the reasons given in the written decision was made in the petition and not in the oral proceedings when those written reasons were not available.

In this respect it is noted, first, that the Board did **not** admit the auxiliary requests. Second, according to the minutes as reproduced in pertinent part above, the parties were heard on "admissibility of the thus corrected auxiliary requests". The petitioner did not explain in which respect the reasons given in the written decision were not discussed during the oral proceedings. The Enlarged Board is therefore unable to assess this assertion.

### 2.3 *Conclusion*

The petition must be rejected as clearly inadmissible (Rule 109(2) (a) EPC) due to the petitioner's failure to raise an objection pursuant to Rule 106 EPC in respect of the three asserted procedural defects under Article 112a(2) (c), (d) EPC in conjunction with Rule 104(b) EPC.

### 3. **The remaining requests**

The remaining requests that

- the proceedings before the Technical Board of Appeal be reopened;
  - the members of the Board who participated in the decision be replaced; and
  - the fee for the petition for review be reimbursed
- must equally be refused. Since the petition is clearly inadmissible, the Enlarged Board cannot order reopening of the proceedings before Technical Board of Appeal 3.2.01 under Rule 108(3) EPC and replacement of the

members who participated in the decision. Reimbursement of the petition fee cannot be ordered because the condition of Rule 110 EPC that the proceedings before the Board are reopened has not been met.

## Order

### **For these reasons it is decided that:**

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

The Registrar:

The Chairman:



N. Michaleczek

I. Beckedorf

Decision electronically authenticated