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**Datasheet for the decision
of 30 November 2023**

Case Number: R 0024/22
Appeal Number: T 0634/18 - 3.4.01
Application Number: 13166842.8
Publication Number: 2713177
IPC: G01R33/54, A61B5/055
Language of the proceedings: EN

Title of the invention:

Medical imaging apparatus and control method thereof with
classification and recommendation of protocols

Patent Proprietor:

Samsung Electronics Co., Ltd.

Opponent:

Siemens Healthcare GmbH

Headword:

Petition for review

Relevant legal provisions:

EPC Art. 111(1), 112a(1), 112a(2)(c), 112a(4), 113(1), 114(2)
EPC R. 106, 107(1)(a), 108(2), 109(2)(a)
RPEBA Art. 13, 14(2)
RPBA 2020 Art. 11, 13(1), 13(2), 15(1)
RPBA 2007 Art. 12(4)

Keyword:

Petition for review - clearly unallowable
Fundamental violation of Article 113(1) EPC (no)

Decisions cited:

R 0001/08, R 0010/09, R 0009/11, R 0010/11, R 0017/11,
R 0019/11, R 0015/12, R 0008/13, R 0016/13, R 0006/17,
R 0008/17

G 0004/95



**Große Beschwerdekammer
Enlarged Board of Appeal
Grande Chambre de recours**

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: R 0024/22

D E C I S I O N
of the Enlarged Board of Appeal
of 30 November 2023

Petitioner: Samsung Electronics Co., Ltd.
(Patent Proprietor) 129, Samsung-ro
Yeongtong-gu
Suwon-si
Gyeonggi-do 443-742 (KR)

Representative: D'Halleweyn, Nele Veerle Trees Gertrudis
Arnold & Siedsma
Bezuidenhoutseweg 57
2594 AC The Hague (NL)

Other party: Siemens Healthcare GmbH
(Opponent) Henkestraße 127
91052 Erlangen (DE)

Decision under review: Decision T 634/18 of the Technical Board of
Appeal 3.4.01 of the European Patent Office of
29 June 2022

Composition of the Board:

Chairman: I. Beckedorf
Members: M. Blasi
A. Haderlein

Summary of Facts and Submissions

- I. The petition for review (petition) concerns decision T 634/18, which was taken by Technical Board of Appeal 3.4.01 (the Board) in relation to European patent No. 2 713 177.
- II. The petition was duly filed in a timely manner by the respondent-patent proprietor (the petitioner). It is based on Article 112a(2)(c) EPC, that is, on the ground that fundamental violations of the petitioner's right to be heard under Article 113(1) EPC occurred.
- III. In the decision under review, the Board set aside the opposition division's decision rejecting the opposition, and revoked the patent. This decision was the result of the Board's
- admitting, pursuant to Article 12(4) RPBA 2007, document 015, which had been filed with the appellant-opponent's statement of grounds of appeal
 - not remitting the case, pursuant to Article 111(1) EPC and Article 11 RPBA 2020, to the opposition division for consideration of document 015
 - holding that the subject-matter of claim 1 of the patent as granted (main request) and of auxiliary requests I and II lacked novelty over the disclosure of document 015
 - not admitting auxiliary request IIbis pursuant to Article 13(1) RPBA 2020
 - holding that the subject-matter of claim 1 of auxiliary request III lacked an inventive step having regard to the disclosure of document 015 alone and
 - not admitting auxiliary request IIIbis pursuant to Article 13(1) RPBA 2020, auxiliary requests IIIter and IIIquater pursuant to Article 13(2) RPBA 2020

and auxiliary requests IV, V, VI and VII pursuant to Article 12(4) RPBA 2007.

- IV. The Enlarged Board of Appeal (Enlarged Board), in its composition pursuant to Rule 109(2) (a) EPC, summoned the petitioner to oral proceedings as requested, and issued a communication pursuant to Article 13 and Article 14(2) RPEBA. In accordance with Rule 108(2) EPC, the petitioner was also invited to provide its address as required under Rule 107(1) (a) EPC.
- V. Within the time limit set in the Enlarged Board's communication, the petitioner provided the missing address. No written comments on the Enlarged Board's preliminary opinion were submitted.
- VI. Oral proceedings before the Enlarged Board took place on 30 November 2023, in the course of which the petitioner made oral submissions in relation to items (iii) and (iv) (see section VIII below). The present decision was announced before the close of oral proceedings.
- VII. As its final requests, the petitioner requested that:
- decision T 634/18 be set aside
 - the proceedings before the Board be re-opened and
 - the members of the Board who had participated in decision T 634/18 be replaced.
- VIII. The petitioner's case is summarised as follows.

The Board committed several fundamental violations of the petitioner's right to be heard by:

- (i) admitting into the proceedings document 015, first filed by the appellant-opponent with the statement of grounds of appeal

- (ii) not remitting the case to the opposition division despite acknowledging that the admittance of document O15 created a fresh case
- (iii) deciding that the subject-matter claimed in auxiliary request III lacked an inventive step on the basis of objections raised for the first time during the oral proceedings before the Board, without informing the petitioner of the exact reasons for this decision
- (iv) not admitting auxiliary requests IIIter, IIIquater, IV, V, VI and VII, submitted as a reaction to the admittance of document O15 into the appeal proceedings and to the decision denying inventive step as regards auxiliary request III

The petitioner's right to be heard was violated by each of items (i) to (iv) individually, and by the combination of the chain of events (i) to (iv). The Board was not correct in finding that document O15 could be dealt with by the petitioner in appeal proceedings without undue burden. The combined chain of events resulted in the petitioner's not having had a fair chance to adequately address a fresh inventive step objection raised against subject-matter claimed in auxiliary request III, since the reasoning for the Board's finding on the lack of inventive step was only communicated to the petitioner in the written reasoned decision. The objection of lack of inventive step was based on document O15, which had first been submitted by the appellant with the statement of grounds of appeal, and was substantiated by the appellant only at the oral proceedings before the Board. The Board's view that auxiliary requests IV to VII (which built on auxiliary request I) lacked convergence with higher-ranking requests did not take into account that

document O15 had created a fresh case. It was unfair to the petitioner that the Board allowed a fresh case to be made by the appellant without remitting the case to the opposition division for further prosecution, and without admitting the auxiliary requests the petitioner had submitted in response, on the basis that they would have created a fresh case.

Reasons for the Decision

Admissibility of the petition

1. The petition is not clearly inadmissible, as it meets the requirements of Article 112a(1) and (4) EPC in conjunction with Rule 107 EPC.
2. The deficiency of the missing address was remedied by the petitioner in accordance with Rule 108(2) EPC.
3. Pursuant to Rule 106 EPC, a petition for review is only admissible where the objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board of appeal, except where this objection could not be raised during the appeal proceedings.
4. In the circumstances of the current case, the petitioner complied with the obligations under Rule 106 EPC. As can be derived from the minutes of the oral proceedings and its enclosures, the petitioner raised an objection in relation to each item which, in its view, constituted a procedural defect. It is on these asserted procedural defects, which were dismissed by the Board, that the petition is now based.

Allowability of the petition

5. However, the petition is clearly unallowable. The Enlarged Board does not agree that the petitioner's right to be heard was violated by the Board as the petitioner contends.
6. Article 113(1) EPC states that decisions of the European Patent Office - and hence also decisions of the boards of appeal - may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. The right to be heard is a fundamental principle and is of fundamental importance in ensuring a fair procedure between the EPO and a party to proceedings before it. In *inter partes* proceedings, Article 113(1) EPC reflects the principle that each party should have a proper opportunity to reply to the case presented by an opposing party (see also G 4/95, OJ EPO 1996, 412, Reasons 10, and Case Law of the Boards of Appeal - "CLBA", 10th edn., 2022, III.B.1 and further references there).
7. While Article 113(1) EPC presupposes that the opportunity to present comments must not be of a purely theoretical nature, it does not release a party from its obligation to present its response promptly (see also Article 114(2) EPC and Article 123(2) EPC); nor does it guarantee, under all circumstances, a specific way of replying.
8. As regards the asserted individual violations of the right to be heard associated with items (i) to (iv) (see section VIII above), as indicated by the petitioner, the following is noted. In relation to all items (i) to (iv), the petitioner had had the opportunity to make submissions either in writing or orally at the oral proceedings before the Board. At the oral proceedings, amongst other things the following

issues were discussed, as also reflected in the minutes of the oral proceedings before the Board (minutes) and not contested by the petitioner:

- admittance of document O15 into the proceedings and remittal of the case to the opposition division for further prosecution (items (i) and (ii); see minutes, page 2, third paragraph; page 3, fourth paragraph)
- claim 1 of auxiliary request III as regards inventive step, starting from document O15 as the closest prior art (item (iii); see minutes, page 3, fourth paragraph)
- admittance of each of auxiliary requests IIIter, IIIquater, IV, V, VI and VII into the proceedings (item (iv); see minutes, page 3, penultimate paragraph; page 4, third and fifth paragraphs)

Accordingly, the petitioner was heard on these issues and was able to present its comments on each of them at the oral proceedings. No violation of the petitioner's right to be heard can be established in this regard.

Admittance of document O15, non-remittal of the case to the opposition division and non-admittance of auxiliary requests IIIter, IIIquater, IV, V, VI and VII

9. The petition comprises a complaint about the result of the Board's decisions under items (i), (ii) and (iv) (see section VIII above), i.e. that:
 - Document O15 was admitted into the proceedings.
 - The case was not remitted to the opposition division for further prosecution.
 - Auxiliary requests IIIter, IIIquater, IV, V, VI and VII were not admitted.

10. This complaint concerns the question of whether the Board correctly applied the law, i.e. the procedural provisions governing the admittance of facts, evidence, objections or requests into the appeal proceedings, and

of how the Board exercised its discretionary power in relation to these issues in the circumstances of this specific case.

11. As derivable from the wording of Article 112a(2) EPC, a petition for review can only be based on fundamental procedural defects or on a criminal act having occurred in the proceedings before a board of appeal, i.e. issues which are intolerable for the legal system and override the principle that, in the interest of legal certainty, proceedings which have led to a final decision should not be re-opened. Accordingly, review proceedings cannot be based on an incorrect application of the law by a board of appeal, or on procedural defects which are not of a fundamental nature. It follows that the Enlarged Board has no competence under Article 112a EPC to examine the merits of a board's decision and to go into the substance of a case, not even indirectly (see for example R 19/11, Reasons 2.2, and further decisions cited in CLBA, supra, V.B.3.1 and V.B.3.4.3). Thus, the way in which a board exercised its discretion on a procedural matter falls outside the Enlarged Board's jurisdiction, since this would necessitate a review of all the facts and circumstances of the case and hence going into the merits of substantive issues (see also R 10/09, Reasons 2.2).

12. For the case in hand, this means that the Enlarged Board is not permitted to review whether or not the Board's conclusions were correct, which includes the question of whether or not it was correct to admit or not admit documents or claim requests into the appeal proceedings, or whether it was correct not to remit the case to the opposition division for further prosecution.

13. The discretionary power provided for in Article 114(2) EPC and in the relevant provisions in the Rules of Procedure of the Boards of Appeal, is as such not subject to review by the Enlarged Board unless a fundamental violation of Article 113 EPC within the meaning of Article 112(2)(c) EPC occurred in the exercise of this discretionary power (see also R 17/11, Reasons 10, with further references).
14. However, that is not the case here, as the issues of admittance of document O15 and the auxiliary requests and of remittal were debated during the oral proceedings before the Board (see point 8 above).
15. Moreover, the Enlarged Board cannot establish that the Board acted arbitrarily or in a manifestly illegal manner when taking these procedural decisions (for such considerations, see also R 10/11, Reasons 5.2; R 6/17, Reasons 3.5). In this regard the following points are noted.
 - 15.1 In Reasons 2 to 9 of the decision under review, the Board explained its considerations concerning the admittance of document O15. Exercising its discretion in accordance with Article 12(4) RPBA 2007, the Board decided to admit the document, which had first been submitted by the appellant-opponent with the statement of grounds of appeal, "in view of the high prima facie relevance" (see decision under review, Reasons 8), and provided reasons why, contrary to the petitioner's assertion, that criterion could be taken into account (see decision under review, Reasons 7).
 - 15.2 The Board's considerations in deciding not to remit the case to the opposition division pursuant to Article 111(1) EPC and Article 11 RPBA 2020 are given in Reasons 70 to 75 of the decision under review. These considerations relate to whether the parties could deal

with new issues arising from admitted document O15, i.e. the new objections of lack of novelty and inventive step based on that document, without undue burden in the appeal proceedings, and what the impact of a remittal would be on the overall proceedings. The Board also took the aspects relied upon by the petitioner into account (see decision under review, Reasons 78 to 80). As set out above in point 12, in review proceedings the Enlarged Board cannot examine whether or not it would have come to the same conclusion. This also includes the Board's finding in Reasons 73 of the decision under review that any issues relating to document O15 could be dealt with by the parties on appeal, notably the petitioner, without undue burden.

- 15.3 The Board made its decision on the admittance of auxiliary requests IIIter and IIIquater, which had been "filed in the week before oral proceedings, more than 9 months after notification of the summons to oral proceedings (and the Board's accompanying provisional opinion)" (see decision under review, Reasons 56), on the basis of Article 13(2) RPBA 2020. The Board was of the view that there were no exceptional circumstances within the meaning of Article 13(2) RPBA 2020, so it decided not to take auxiliary requests IIIter and IIIquater into account. In Reasons 57 to 61 of the decision, also addressing the petitioner's arguments, the Board explained:
- why it considered that the petitioner had had the opportunity to respond to the submissions relating to document O15, filed for the first time by the appellant-opponent with the statement of grounds of appeal, and the appellant's subsequent submissions
 - why it was of the view that its "preliminary opinion [in the communication under Article 15(1) RPBA 2020] was based on the facts, evidence and arguments put before it" and did not

contain anything "that would amount to exceptional circumstances" (see Reasons 60)

15.4 The considerations behind not admitting auxiliary requests IV, V, VI and VII into the appeal proceedings were set out in Reasons 62 to 69 of the decision under review. Like admitted auxiliary requests I to III, these requests had been filed within the time limit for replying to the appeal, and their admittance was considered on the basis of Article 12(4) RPBA 2007. In exercising its discretion, the Board relied on the aspect that auxiliary requests IV to VII went in "a completely different direction than the higher-ranking requests" (see Reasons 64; also Reasons 66 and 67), and provided its reasoning for this point of view. The aspects invoked by the petitioner (see Reasons 65; note that the reference to "opponent" instead of "proprietor" in said passage is an obvious mistake) were also taken into account.

16. Therefore, having regard to the Board's considerations as set out in the decision under review, the Enlarged Board cannot identify anything which would suggest that the Board took these procedural decisions in an arbitrary or manifestly illegal manner. Thus, the Enlarged Board cannot conclude that a violation of the petitioner's right to be heard was associated with items (i), (ii) and (iv) (see section VIII above).

Not informing the petitioner of the exact reasoning on lack of inventive step in relation to auxiliary request III

17. The petitioner also complained that it had not been informed, before the Board took its decision on inventive step in relation to auxiliary request III, of the exact reasons why the claimed subject-matter was considered not to involve an inventive step (see also item (iii), section VIII above).

18. The objection of lack of inventive step based on document O15 alone in relation to auxiliary request III had been submitted by the appellant-opponent at the oral proceedings and had been the topic of a discussion (see petition, page 4, third and fourth paragraphs; minutes, page 3, fourth paragraph; Reasons 85 of the decision under review). At the oral proceedings before the Enlarged Board, the petitioner acknowledged that the objection had indeed been presented by the appellant-opponent, but stressed that not all the details subsequently set out in the Board's written reasoned decision had been known to it. The fact that the petitioner had not known the exact reasons meant that auxiliary request III had been rejected without its having had an opportunity to adequately reply or comment on those reasons.

19. The requirement under Article 113(1) EPC that decisions may only be based on grounds or evidence on which the parties have had an opportunity to present their comments implies that a party may not be taken by surprise by reasons for a decision that refer to unknown grounds or evidence. "Grounds or evidence" under Article 113(1) EPC may be understood as the essential legal and factual reasoning on which a decision is based (see also for example R 8/17, Reasons 15, and further decisions cited in the CLBA,

supra, III.B.2.3.2). A party must have an opportunity to comment on the decisive aspects of the case.

20. On the other hand, the deciding board of appeal must be able to draw its own conclusions from the discussion of the grounds put forward (see for example R 8/17, Reasons 16, with reference to R 16/13, Reasons 3.3). Thus, the right to be heard does not go so far as to impose a legal obligation on a board of appeal to disclose in advance to the parties how and why it will come to its conclusion on the basis of the decisive issues under discussion - or at least those foreseeable as the core of the discussion. This is part of the reasoning given in the written decision (see also R 8/13, Reasons 2, with reference to, for example, R 1/08, Reasons 3.1; R 15/12, Reasons 5).
21. As there was no obligation under Article 113 EPC for the Board to disclose in advance its detailed reasoning for finding a lack of inventive step in relation to auxiliary request III, the petitioner's complaint that its "not knowing the exact reasons for this decision" (petition, page 4, second paragraph) amounted to a violation of Article 113(1) EPC cannot succeed.
22. The petitioner also submitted that, although at the oral proceedings before the Board the appellant-opponent had presented several inventive step objections starting from document O15 in relation to auxiliary request III, the first of which relied on document O15 alone, the Board's statement in its written reasoned decision that, after a discussion of these inventive step objections, it had "explicitly stated that it followed the lines of the opponent's first inventive step attack based on O15 alone" (see decision under review, Reasons 85) was not correct. In fact, as reflected in the minutes of the oral proceedings, the Board had stated only that the

subject-matter claimed in auxiliary request III lacked an inventive step in view of document O15, without indicating further details.

23. Even assuming the facts as contended by the petitioner, namely that the Board did not specify at the oral proceedings which of the appellant-opponent's inventive step objections starting from document O15 had led to a finding of lack of inventive step in relation to auxiliary request III (i.e. whether it was document O15 alone or in combination with other prior art), the Enlarged Board does not see in this any violation of the petitioner's rights deriving from Article 13(1) EPC. The petitioner must have reckoned with the possibility that the Board might agree with the line of reasoning presented by the appellant-opponent during the proceedings. The fact that the objection based on document O15 alone was presented at oral proceedings by the appellant-opponent and understood as such by the petitioner was not contested. Moreover, the petitioner did not submit that the Board's reasoning on the lack of inventive step as set out in the decision under review was based on anything not addressed in the appeal proceedings, including the discussion at the oral proceedings; in other words, it did not submit that it constituted a surprising reasoning.
24. In light of the above, the Enlarged Board fails to see that, by not having been informed by the Board of the exact reasons for its decision in relation to auxiliary request III, the petitioner's right to be heard was violated by the Board.

Combination of the individual findings leading to the situation that the petitioner had not had a fair chance to adequately address the objections based on newly filed document O15

25. Lastly, the petitioner complained that the combination of the individual decisions concerning items (i) to (iv) (see section VIII above) led to a situation which was procedurally unfair to it. While document O15, first filed on appeal, was admitted into the proceedings (despite creating a fresh case, as acknowledged by the Board), the case was not remitted to the opposition division for further prosecution, nor were all of the petitioner's auxiliary requests admitted into the proceedings. Hence, while the creation of a fresh case by the appellant-opponent was allowed, the petitioner was not allowed this.

26. However, in the decision under review the Board explained why the petitioner could have anticipated the issue of inventive step based on document O15, and why the Board considered that there had been adequate opportunity for the petitioner to provide counter-arguments and submit auxiliary requests.

27. The Enlarged Board cannot find fault with the Board's view that the right to be heard and to react to the new document presented by the appellant-opponent for the first time on appeal did not relieve the petitioner of the duty to file its auxiliary requests as early as possible or exempt these requests from being examined with regard to their admittance according to established criteria (see Reasons 84 of the decision under review; see also R 9/11, Reasons 3.2.2 in relation to Article 13(2) RPBA 2007).

28. As regards the course of events in the case on which the petition is based, the following points are noted.

- 28.1 Document O15 was submitted for the first time on appeal. As set out in the decision under review (see Reasons 59), document O15 had been relied upon in the statement of grounds of appeal in relation to the main request and the auxiliary request filed in opposition proceedings. The focus was on novelty, but inventive step starting from document O15 was also addressed by the appellant-opponent.
- 28.2 Auxiliary requests I to VII, which had been filed within the time limit for replying to the appeal, were admitted under Article 12(4) RPBA 2007, except for those that went in "a completely different direction than the higher-ranking requests" (see decision under review, Reasons 64).
- 28.3 When considering under Article 13(1) RPBA 2020 whether or not to admit auxiliary requests IIbis and IIIbis, which had been filed by the petitioner in reply to the appellant-opponent's second submission of 19 December 2019, in which auxiliary requests I to VII had also been addressed, the questions considered relevant by the Board were whether or not these claim requests were suitable to resolve the novelty and inventive step objections based on document O15, and whether they gave rise to further objections, such as added subject-matter or lack of clarity.
- 28.4 When considering under Article 13(2) RPBA 2020 whether or not to admit auxiliary requests IIIter and IIIquater, which had been filed only one week before the oral proceedings, the issue considered relevant by the Board was the lack of exceptional circumstances arising from the content of the Board's communication under Article 15(1) RPBA (see decision under review, Reasons 60 and 83).

29. In light of this, the Enlarged Board cannot agree with the petitioner that it had not had the opportunity, or a fair chance, to adequately present its case against the novelty and inventive step objections based on document O15. Moreover, the Enlarged Board does not see any imbalance based on arbitrariness by the Board between, on the one hand, admitting document O15 (despite this "creating a fresh case") and, on the other hand, not remitting the case to the opposition division and not admitting auxiliary requests IIIter, IIIquater and IV to VII.
30. Therefore, the Enlarged Board concludes that the petitioner's right to be heard was not violated by the chain of events of items (i) to (iv) (see section VIII above).

Conclusion

31. The petitioner's complaints in the petition are not associated with any violation of Article 113(1) EPC, let alone a fundamental one within the meaning of Article 112a(2)(c) EPC. The decision under review is therefore not to be set aside.
32. As a consequence of the Enlarged Board's finding, the remaining requests that
- the proceedings before Technical Board of Appeal 3.4.01 be re-opened and
 - the members of the Board who participated in the decision be replaced
- cannot be granted.

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

I. Beckedorf

Decision electronically authenticated