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**Datasheet for the decision
of 5 March 2024**

Case Number: R 0002/23
Appeal Number: T 1213/19 - 3.2.05
Application Number: 12724706.2
Publication Number: 2699408
IPC: B29C67/00
Language of the proceedings: EN

Title of the invention:
METHOD FOR PRODUCING A THREE-DIMENSIONAL OBJECT

Patent Proprietor:
DWS S.R.L.

Opponent:
Formlabs Inc.

Headword:
Petition for review

Relevant legal provisions:
EPC Art. 112a, 112a(2) (a), 112a(2) (b), 112a(2) (c), 112a(2) (d),
113(1)
EPC R. 104(b), 106, 110, 124(1)
RPBA 2020 Art. 12(4), 12(5), 12(6), 13(2), 25(2)

Keyword:
Petition for review - clearly inadmissible or unallowable
Obligation to raise objection
Fundamental violation of Article 113(1) EPC (no)

Decisions cited:
R 0004/08, R 0006/14



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

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Case Number: R 0002/23

D E C I S I O N
of the Enlarged Board of Appeal
of 5 March 2024

Petitioner: DWS S.R.L.
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Decision under review: Decision T 1213/19 of the Technical Board of
Appeal 3.2.05 of the European Patent Office of
23 September 2022

Composition of the Board:

Chairman: C. Josefsson
Members: D. Rogers
C. Herberhold

Summary of Facts and Submissions

- I. The petition is directed against a decision T 1213/19 dated 23 September 2022 of Board of Appeal 3.2.05 revoking the patent ("the Decision"). The Petitioner was the Proprietor-Respondent before the Board. The minutes were sent to the parties on 30 September 2022, the decision was issued on 22 December 2022.

- II. During the course of the oral proceedings, the Board admitted document D8 into the proceedings. Document D8 was submitted by the opponent-appellant more than six months after the filing of its statement of grounds of appeal.

- III. During the course of the oral proceedings, the Board refused to admit the proprietor-respondent's (the Petitioner's) auxiliary requests 1, 1A, 3 and 4, into the proceedings (auxiliary request 2 had been withdrawn, see minutes, page 4, penultimate paragraph, last sentence). These requests had all been filed after notification of the summons to oral proceedings.

- IV. Before the Board, the Petitioner had also made a request for remittal to the first instance, firstly for discussing document D8 and having the possibility to properly amend the patent before the opposition division and secondly in order to discuss the auxiliary requests now on file before the opposition division. In this context, during oral proceedings the Board clarified that the first request had become obsolete after document D8 had been admitted because of it being prima facie novelty destroying. The Board refused the second request.

- V. The Petitioner argues that the Board's decision to admit document D8 into the proceedings involved a

fundamental procedural defect under Rule 104(b) EPC. The Petitioner considers that the Board made a legal mistake as to which provisions of the Rules of Procedure of the Boards of Appeal 2020 ("RPBA 2020") to apply when considering the admission of this document. The Petitioner only became aware of this legal mistake when it read the minutes and the Board's decision. Thus, the Petitioner was not in a position to make a Rule 106 EPC objection in this respect during the appeal proceedings.

VI. The Petitioner also considers that the Board's decision not to admit auxiliary requests 1, 1A, 3 and 4 was wrong and in addition constitutes a violation of its right to be heard. This violation arose from a combination of the decision to admit D8 and the decision not to admit the auxiliary requests. The consequence of these decisions was to deprive the Petitioner of the ability to file an amendment to overcome the disclosure of document D8, this constituting a violation of the Petitioner's right to be heard.

VII. The Petitioner claims to have made a Rule 106 EPC objection during the oral proceedings by making reference to a potential violation of Article 113(1) EPC. As evidence of this, the Petitioner refers to its request, in a letter dated 1 February 2023, to amend the minutes.

VIII. The Petitioner argues that the refusal to remit the case also amounts to a violation of the right to be heard. The Petitioner disagrees with the Board's view that its remittal request was conditional upon at least one of its auxiliary requests being admitted (see para 22 of Decision and para 3.3.1 of the petition). The Petitioner states that its remittal request was made in order to properly amend the patent before the

opposition division. The Petitioner argues that the Board was wrong not to remit, and by not remitting, the Petitioner was deprived of the possibility to comment on document D8 and to amend the patent based upon the disclosure of this document. This constituted a violation of its right to be heard.

- IX. The Petitioner argues that it made an objection in accordance with Rule 106 EPC, as regards non-remittal, at the oral proceedings. As evidence of this, the Petitioner refers to its request, in a letter dated 1 February 2023, to amend the minutes.

- X. In this case the oral proceedings took place on 23 September 2022, the minutes were sent to the parties on 30 September 2022, one week later. The Petitioner's request to amend the minutes was sent on 1 February 2023, 4 months after the oral proceedings.

- XI. The amendment requests for the minutes that are relevant for this decision concern the Petitioner's remittal request, and request to admit auxiliary requests. The Petitioner requested that paragraph 1 on page 4/6 of the minutes be changed from:

"After resumption the respondent referred to their request for remittal in order to be able to amend the patent in first instance proceedings"

to:

"After resumption the respondent referred to their request for remittal in order to avoid an unappealable decision on a document on which it is decided for the first time, i.e., to give the applicant the chance to appeal. Reference was made to a potential violation of Article 113(1) EPC".

And that the last full paragraph, second and third sentences, of page 4/6 of the minutes be changed from:

"The respondent acknowledged that this request for remittal had become obsolete... On the other hand, it was still requested to remit the case to the opposition division in order to discuss the auxiliary requests on file before the opposition division, in case they were admitted..."

To:

"The respondent took note that the Board's position is that this request for remittal had become obsolete... On the other hand, it was still requested to remit the case to the opposition division in order to discuss the auxiliary requests on file before the opposition division".

And that the third full paragraph of page 5/6 of the minutes be amended from:

"The parties had no further comments in this respect".

To:

"The respondent made reference to Article 113(1) EPC".

The Petitioner relies upon these requested amendments to support its position that it made Rule 106 EPC objections during the oral proceedings before the Board.

- XII. On 18 July 2023 the Board sent a communication to the Petitioner rejecting its requests to amend the minutes. The Petitioner was given two months to respond to this

communication. The Petitioner did not file any response.

XIII. The Enlarged Board sent a communication setting out its preliminary opinion on the case on 8 November 2023.

XIV. The Petitioner responded to this communication in a letter dated 1 December 2023. On page 2 of this letter, third para of section 3.1, the Petitioner argued that it was able to identify a request that the Board had not decided upon:

"It is respectfully submitted that a fundamental procedural defect pursuant to Rule 104(b) EPC occurred when the BoA decided to admit document D8 within the appeal proceeding without deciding on a request relevant to that decision, i.e. the main request filed by the Patentee during the appeal procedure to not admit document D8 within the procedure (see letter dated July 22, 2022), as in such occasion the BoA clearly misinterpreted the RPBA 2020."

XV. In its 1 December 2023 letter, the Petitioner further argued that the Board did not correctly apply the provisions of the RPBA 2020 when deciding to admit D8. The Petitioner argues that it was not in a position to make a Rule 106 EPC objection during the oral proceedings, as it only became aware that the Board had incorrectly applied the RPBA 2020 when it read the Decision. The Petitioner withdrew its request that the Enlarged Board hold oral proceedings, and requested that the Enlarged Board issue a decision on the merits.

XVI. The Petitioner's requests are set out verbatim below:

"It is requested that the Enlarged Board of Appeal sets aside the Decision T1213/19-3.2.05 and re-opens the proceedings before the Board of Appeal.

In particular, it is requested that the Enlarged Board of Appeal clarifies if the exception pursuant to Art. 25(2) RPBA 2020 applies with respect to the submission of document D8..., which was filed by the Appellant on 30.12.2019, about 6 months after the submission of the statements of the grounds of appeal and, therefore, if stricter criteria according to Art. 12, paragraphs 4 to 6, should have been applied to evaluate the admissibility of document D8.

As a consequence, it is requested that the Enlarged Board of Appeal clarifies if a misinterpretation of the board of appeal concerning the legal framework can be considered an exceptional circumstance within the meaning of Art. 13(2) RPBA 2020.

In addition, it is requested that the Enlarged Board of Appeal clarifies if the refusal of the admittance of the auxiliary requests filed by the Patent Proprietor on July 22, 2022, and on September 16, 2022, and the refusal of the request of remittal to the first instance proceedings determines a fundamental violation under Art. 113(1) EPC.

...

Moreover, refund of the petition fee is requested according to Rule 110 EPC."

Reasons for the Decision

Decision to admit document D8

1. The Petitioner's case is that the decision to admit document D8 involved a fundamental procedural defect under Rule 104(b) EPC. Rule 104(b) EPC provides that a fundamental procedural defect may have occurred when a board of appeal "...decided on the appeal without deciding on a request relevant to that decision".
2. The Petitioner has failed to identify a request that the Board did not decide on when deciding to admit document D8. The Enlarged Board also cannot identify any such request. The Petitioner's further arguments on this point, see para XIV above, merely confirm the Enlarged Board's conclusion on this point. Indeed, the request allegedly not decided on ("to not admit document D8") is decided on in the Decision (see para 1-8 of the reasons of the Decision).
3. The Petitioner has thus failed to substantiate its petition as regards the admission of document D8. The petition is thus clearly unallowable in this respect, irrespective of a Rule 106 EPC objection having been raised in this context or not.

Decision not to admit auxiliary requests

Rule 106 EPC objection

4. The Petitioner made no further comments on this issue in its letter of 1 December 2023 in reply to the Enlarged Board's preliminary opinion. The Petitioner claims to have made a Rule 106 EPC objection at the oral proceedings before the Board during the discussion of the admission of its auxiliary requests 1, 1A, 3 and

4. The evidence it provides for this is para 19 of the Decision and its request to correct the minutes.
5. Para 19 of the Decision deals with the Petitioner's argument that the right to be heard under Article 113(1) EPC meant that it should be given the opportunity to react to the belated filing of D8 and amend the claims accordingly.
6. Para 19 of the Decision does not appear to record any objections during the appeal proceedings that could be considered to be Rule 106 EPC objections. Such objections need to comply with two criteria. First, the objection must be expressed by a party in such a form that the board of appeal is able to recognize immediately and without doubt that an objection pursuant to Rule 106 EPC - that is one which is additional to, and distinct from other statements - has been made. In this case, this means that a Rule 106 EPC statement must be something other than a protest or argument for the admission of auxiliary requests, or an alleged reference being made to a potential violation of Article 113(1) EPC. This is a precondition for a board of appeal to have been able to react immediately and appropriately by either removing the cause of the objection or, as provided in Rule 106 EPC, by dismissing it. It therefore ensures for the party and the public at large, legal certainty as to whether the substantive decision of the board of appeal is open to review pursuant to Article 112a EPC. This is one of the evident purposes of the obligation to raise objections under Rule 106 EPC.
7. Second, for the same reason the objection must be specific, that is the party must indicate unambiguously which particular defect of those listed in paragraph 2(a) to (d) of Article 112a EPC it intends to rely on.

This follows from the wording of Rule 106 EPC itself (see para 2.1 of R 4/08).

8. The Enlarged Board is thus of the view that para 19 of the Decision does not provide any evidence that the Petitioner made a Rule 106 EPC objection at the oral proceedings.
9. Turning now to the requested correction of the minutes, parties are obliged to submit a request for correction of the minutes of oral proceedings promptly after receipt of the minutes (R 6/14, Reasons 7). The Enlarged Board understands this to require a party to submit a request for correction of the minutes in the shortest time possible after their receipt. Hence, if a party considers that the essentials of the oral proceedings or relevant statements within the meaning of Rule 124(1) EPC are incorrect or missing in the minutes of oral proceedings, they must file a request for correction of the minutes in the shortest time possible after their receipt. This ensures that the relevant facts and submissions are still fresh in the minds of the members of the deciding body and, if applicable, the other party or parties.
10. In this case the oral proceedings took place on 23 September 2022, the minutes were sent to the parties on 30 September 2022, one week later. The Petitioner's request to amend the minutes was sent on 1 February 2023, 4 months after the oral proceedings.
11. In a communication dated 18 July 2023, the Board rejected the request to correct the minutes. The Petitioner did not respond to this communication. The Enlarged Board therefore considers the Board's minutes to be an accurate account of the oral proceedings before the Board. The minutes thus contain no indication that the Petitioner made an objection under

Rule 106 EPC. Even if the corrections that the Petitioner requests were accepted, there is nothing in them which could fulfil the requirements for a sufficiently recognisable and specific Rule 106 EPC objection - see para 6 above for these requirements.

12. As a consequence of the failure to make a Rule 106 EPC objection during the appeal proceedings regarding the non-admission of the auxiliary requests, the Enlarged Board finds this aspect of the petition inadmissible.

Refusal to remit the case

Rule 106 EPC objection

13. The Petitioner claims to have made a Rule 106 EPC objection during the oral proceedings. The evidence for this is its request to correct the minutes. The Board rejected the Petitioner's requests to amend the minutes.
14. The Enlarged Board notes that the final requests of the Petitioner, as set out in the minutes, indicate that the remittal request was conditional upon the admission of one of the auxiliary requests into the proceedings. The Petitioner has not sought to amend this part of the minutes. This supports the conclusion that the Petitioner made no Rule 106 EPC objection as regards remittal, as its remittal request had become irrelevant once the Board had decided not to admit any of the auxiliary requests.
15. As a consequence of the failure to make a Rule 106 EPC objection during the appeal proceedings regarding the non-remittal of the case, the Enlarged Board finds this aspect of the petition inadmissible.

Requests concerning the interpretation of the RPBA

16. The requests of the Petitioner, that the Enlarged Board clarify certain articles of the RPBA, do not fall under any of the grounds for filing a petition for review. These requests are therefore inadmissible and/or unallowable.

Order

For these reasons it is decided that:

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

The Registrar

The Chairman



N. Michaleczek

C. Josefsson

Decision electronically authenticated