

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 6 June 2025**

**Case Number:** R 0014/24

**Appeal Number:** T 2229/19 - 3.3.08

**Application Number:** 13184864.0

**Publication Number:** 2677029

**IPC:** C12N9/52

**Language of the proceedings:** EN

**Title of invention:**

Methods for the manufacture of proteolytically processed polypeptides

**Patent Proprietor:**

Ipsen Bioinnovation Limited

**Opponent:**

ALLERGAN, INC.

**Headword:**

Petition for review

**Relevant legal provisions:**

EPC Art. 76(1), 101(3) (b), 112a(1), 112a(2) (c), 113(1),  
114(2), 138

EPC R. 106, 107, 109(2) (a), 109(2) (b)

RPEBA Art. 13, 14(2)

RPBA 2020 Art. 13(1), 13(2), 15(1)

**Keyword:**

Petition for review - clearly inadmissible - clearly  
unallowable

Compliance with Rule 106 EPC - no

Fundamental violation of Article 113(1) EPC - no

**Decisions cited:**

R 0012/21, R 0007/21, R 0008/17, R 0006/17, R 0016/13,

R 0008/13, R 0015/12, R 0019/11, R 0017/11, R 0010/11,

R 0010/09, R 0001/08



**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

Case Number: R 0014/24

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 6 June 2025**

**Petitioner:** Ipsen Bioinnovation Limited  
(Patent Proprietor) 102 Park Drive  
Milton Park  
Abingdon, Oxfordshire OX14 4RY (GB)

**Representative:** MacLean, Martin Robert  
Mathys & Squire  
The Shard  
32 London Bridge Street  
London SE1 9SG (GB)

**Other party:** ALLERGAN, INC.  
(Opponent) 2525 Dupont Drive  
Irvine CA 92612-1599 (US)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
Arabellastraße 30  
81925 München (DE)

**Decision under review:** Decision T 2229/19 of Technical Board of Appeal  
3.3.08 of the European Patent Office of  
6 October 2023

**Composition of the Board:**

**Chairman** C. Josefsson  
**Members:** M. Blasi  
G. Patton

## **Summary of Facts and Submissions**

- I. The petition, filed by the appellant-patent proprietor ("petitioner"), concerns decision T 2229/19 of Technical Board of Appeal 3.3.08 ("the Board"), taken at oral proceedings on 6 October 2023 and transmitted electronically to the parties as a reasoned written decision on 27 March 2024. With this decision, the appeal against the opposition division's decision to revoke European patent No. 2 677 029 was dismissed.
- II. The petitioner invokes the ground under Article 112a(2)(c) in conjunction with Article 113(1) EPC, i.e. that a fundamental violation of the petitioner's right to be heard had occurred. The petitioner contends that the Board based the decision under review on grounds on which the petitioner had had no opportunity to comment, and more specifically that the Board's decision not to admit auxiliary requests 2 and 3 into the proceedings was based on a novel interpretation of Article 13(2) RPBA and, as made clear in point 26 of the reasons of the written decision, on a finding by the Board that the claims of auxiliary requests 2 and 3 did not overcome the insufficiency of disclosure which had been found by the opposition division.
- III. In the petition for review, the petitioner requested that:
- decision T 2229/19 be set aside and that the proceedings before the Board be re-opened, and
  - the members of the Board who participated in decision T 2229/19 be replaced.
- As an auxiliary measure, the petitioner requested oral proceedings.

- IV. The Enlarged Board of Appeal, composed as prescribed in Rule 109(2)(a) EPC, summoned the petitioner to oral proceedings.
- V. In a communication pursuant to Article 13 and Article 14(2) RPEBA, the Enlarged Board informed the petitioner that, in its provisional opinion, the petition for review appeared clearly unallowable.
- VI. In a subsequent letter dated 6 May 2025, the petitioner made further submissions in writing in support of its petition for review.
- VII. At the oral proceedings before the Enlarged Board, the petitioner presented further arguments, addressing the admissibility and allowability of the petition, and confirmed that it maintained its requests that the decision under review be set aside, the proceedings before the Board be re-opened and the members of the Board who had participated in the decision be replaced. At the end of the oral proceedings, the Chairman announced the order of this decision.
- VIII. The case leading to the petition for review developed as follows:
  - (a) At the end of the opposition proceedings, the opposition division had revoked the patent pursuant to Article 101(3)(b) EPC as it had come to the conclusion that, taking into consideration the amendments made by the petitioner during opposition proceedings in the form of sets of claims of a new main request and auxiliary request 1, the patent and the invention to which it related did not meet the requirements of the EPC. Specifically, the

opposition division found that the set of claims of the main request, which was admitted into the proceedings, did not comprise subject-matter extending beyond the content of the application as filed and of the earlier application as filed, respectively, contrary to the opponent's objections against several claims. However, the invention defined in claim 1 of the main request was found not sufficiently disclosed. The set of claims of auxiliary request 1, filed during the oral proceedings and identical to that of the main request except for the fact that dependent claim 5 of the main request had been deleted, was considered not to comply with Rule 80 EPC and was not admitted.

- (a) The petitioner lodged an appeal against the decision to revoke the patent, maintaining the main request and auxiliary request 1. In the reply to the appeal, the opponent (respondent) pursued further its objections of added subject-matter, lack of sufficiency of disclosure and lack of inventive step in respect of the claims of the main request, and objected to the admittance and disputed the allowability of auxiliary request 1.
  
- (b) The Board summoned the parties to oral proceedings and, in a subsequent communication pursuant to Article 15(1) RPBA, informed the parties of its preliminary opinion on some issues. *Inter alia*, as regards the respondent's objections concerning added subject-matter of the main request, the Board agreed with the respondent regarding claims 2, 4 and 6, but did not agree regarding claims 3 and 5. Concerning sufficiency of disclosure of the invention defined in the claims of the main

request, the Board considered that the opposition division's decision was correct for essentially the reasons set out in points 3.2.1 to 3.2.6 of the decision under appeal and submitted by the respondent in the reply to the appeal. As regards auxiliary request 1, the Board noted that since claims 1 to 5 were identical to claims 1 to 4 and 6 of the main request, the same considerations on added subject-matter and sufficiency of disclosure applied *mutatis mutandis* in relation to the respective claims.

- (c) Subsequently, the petitioner filed a further letter and sets of claims of auxiliary requests 2 and 3. The set of claims of auxiliary request 2 differed from that of the main request in that claims 2, 4 and 6 had been deleted, and the set of claims of auxiliary request 3 differed from that of auxiliary request 1 in that claims 2, 4 and 5 had been deleted. In reply, the respondent likewise filed a further letter, *inter alia* objecting to the late filing of the auxiliary requests.
- (d) At oral proceedings before the Board, the issue of added subject-matter was discussed in relation to claims 1 to 4 of the main request. After the Board had informed the parties of its conclusions that at least dependent claims 2 and 4 of the main request did not meet the requirements of Article 76(1) EPC and that the same applied to the identical claims of auxiliary request 1, the issue of admittance of auxiliary requests 2 and 3 was discussed. Having heard the parties on this issue, the Board did not admit these requests and, in the absence of further requests, dismissed the appeal.

IX. The petitioner's arguments in support of the petition for review are summarised as follows:

As was clear from point 26 of the Reasons of the decision under review, the decision not to admit auxiliary requests 2 and 3 into the appeal proceedings was based on an assessment of whether or not the claims overcame lack of sufficiency. However, at no time during the oral proceedings was the petitioner given the opportunity to comment on that issue.

The Board decided to depart from prior case law and imposed a novel test for Article 13(2) RPBA from that previously used. The approach adopted by the Board was contrary to established practice of the boards of appeal, which consistently permitted dependent claims to be deleted from patents whenever such deletion overcame all issues discussed and where the deletion did not cause a change in the focus of an appeal.

The Board's actions amounted to a fundamental violation of the petitioner's right to be heard because the Board

- (i) was, as a matter of natural justice, obligated to request the petitioner to address the Board on the question of sufficiency of disclosure before rejecting an amendment on that ground where sufficiency had not previously been discussed at the oral proceedings.

The current case was identical to the case underlying decision R 12/21. If a board is minded to refuse admission of an amendment, it must specifically ask for comments on

the basis on which refusal is intended if this has not already been discussed.

- (ii) had erred by failing to exercise its discretion for its proper purpose, which has been consistently identified as not, in itself, being the refusal of new requests but rather the defence of a party's right to a fair hearing within a reasonable time. As the question of sufficiency was always central to the case and all parties were prepared to discuss sufficiency at the oral proceedings, conclusion of the proceedings without hearing the petitioner on sufficiency was contrary to this established purpose. The petitioner had had every legitimate expectation that sufficiency would be discussed at the oral proceedings. The boards of appeal consistently allowed amendments consisting in the deletion of dependent claims which did not lead to a change of the focus of the proceedings. This was the case here too. By proceeding as the Board did, the petitioner was denied the opportunity to make its oral submissions on sufficiency of disclosure. This was contrary to procedural fairness. The Rules of Procedure of the Boards of Appeal, as subsidiary legislation, must be construed to be consistent with Articles 138(2) and (3) EPC, which provide patent proprietors with a right to amend a patent in all proceedings where the validity of a European patent is considered and a patent is found partially invalid.

- (iii) was obliged under Article 13(1) RPBA to consider the current state of the proceedings when exercising its discretion, and failed to do so. More specifically, the references in Article 13(1) RPBA to matters being "resolved" or "overcome" meant that the provisions are backward-looking rather than forward-looking, since only matters which were considered and ruled upon by the Board in the context of oral proceedings could be considered "resolved" or "overcome". As there had not yet been any discussion on the issue of sufficiency of disclosure prior to auxiliary requests 2 and 3 not being admitted, the "current state" of the proceedings was actually not taken into account. The matter of added subject-matter had been resolved and overcome with auxiliary requests 2 and 3.

The case should be submitted to the Enlarged Board of Appeal as composed pursuant to Rule 109(2)(b) EPC for decision because the Enlarged Board in its current composition pursuant to Rule 109(2)(a) EPC had to distinguish the current case from a case which was decided by the Enlarged Board composed pursuant to Rule 109(2)(b) EPC, i.e. in a five-member composition.

## **Reasons for the Decision**

### *Admissibility of the petition for review*

1. The petition for review meets the requirements of Article 112a(1) and (4) EPC in conjunction with Rule 107 EPC.
2. Pursuant to Rule 106 EPC, a petition for review under Article 112a(2)(c) EPC is only admissible when an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board, except where such objection could not be raised during the appeal proceedings.
3. In the petition for review received on 24 May 2024, the petitioner, by referring to point 26 of the Reasons of the decision under review, complained that the decision not to admit auxiliary requests 2 and 3 was based on a novel interpretation of Article 13(2) RPBA and on a finding by the Board that the claims of these auxiliary requests did not overcome lack of sufficiency, upon which the petitioner had had no opportunity to comment.
  - 3.1 As regards the obligation under Rule 106 EPC to raise an objection in respect of this alleged procedural defect, the petitioner submitted that it had only become apparent with the issuance of the Board's reasoned written decision.
  - 3.2 In relation to the above complaints, the Enlarged Board accepts that an objection could not have been raised during the appeal proceedings before the Board, and therefore the exception provided for in Rule 106 EPC can be considered to apply in this respect.

4. In the subsequent letter dated 6 May 2025 and at the oral proceedings before the Enlarged Board, the petitioner also submitted that the Board had not applied the procedural provisions correctly, such that the petitioner did not have an opportunity at the oral proceedings to present its case about what it considered to be the heart of the case, namely the issue of sufficiency of disclosure. While the petitioner had had the expectation and every reason to believe that this issue would be discussed at the oral proceedings before the Board, and all parties were prepared for such a discussion, the proceedings concluded without the petitioner having been heard on this issue. The Board had failed to exercise its discretion for its proper purpose by not admitting auxiliary requests 2 and 3. This was contrary to procedural fairness and in conflict with the petitioner's right to amend the patent. The Board had thereby violated the petitioner's right to be heard (see also section IX.(ii) above).
- 4.1 These complaints concern issues which are unrelated to the reasoning provided in the decision under review and which cannot have become apparent only upon receipt of the reasoned written decision.
- 4.2 There is also no reason apparent why the petitioner could not have raised any objection in respect of these alleged procedural defects during the proceedings before the Board. It was not contended by the petitioner nor does it derive from the minutes of the oral proceedings before the Board that an objection under Rule 106 EPC had been raised.

- 4.3 As an explanation for not having raised any objection under Rule 106 EPC, the petitioner submitted at the oral proceedings before the Enlarged Board that it had been confused at the oral proceedings before the Board and assumed that it had overlooked something, such that it could have turned out later, when reading the reasoned written decision, that the Board had acted correctly in not admitting auxiliary requests 2 and 3.
- 4.4 While this may explain why the petitioner did not become active during oral proceedings, this is, however, no justification for not having raised any objection under Rule 106 EPC before the Board. Raising an objection under Rule 106 EPC would have enabled, and also obliged, the Board to consider the objection in respect of the alleged procedural defect in terms of whether a defect had arisen and, if so, whether, or to what extent, it could be remedied during the appeal proceedings.
5. Given that no objection under Rule 106 EPC had been raised against how the appeal proceedings were conducted in not giving the petitioner the opportunity to discuss sufficiency of disclosure, and against the non-admittance of auxiliary requests 2 and 3 as such (see also section IX.(ii) above), these complaints of the petitioner cannot be considered in the review proceedings before the Enlarged Board.

*Allowability of the petition for review*

6. In so far as the petitioner's submissions are to be considered on their merits (see above section IX. except for point (ii)), the petition for review is clearly unallowable.

7. The petitioner referred to point 26 of the decision under review and submitted that its right to be heard had been violated because the non-admittance of auxiliary requests 2 and 3 was based on a novel interpretation of Article 13(2) RPBA and on a finding by the Board that the claims of these auxiliary requests did not overcome lack of sufficiency, on which the petitioner had had no opportunity to comment. This represented a fundamental violation of Article 113(1) EPC within the meaning of Article 112a(2) (c) EPC.
8. The Enlarged Board can, however, not find that a violation of Article 113(1) EPC has occurred as contended by the petitioner.
9. In points 24 to 29 of the decision under review, the Board set out its reasoning for the decision not to admit and consider in the appeal proceedings auxiliary requests 2 and 3 pursuant to Article 13(2) RPBA. Point 26 of the decision under review referred to by the petitioner reads as follows:

*"In the exercise of its discretion, the board may, inter alia, take into account the suitability of the amendment to resolve issues admissibly raised by another party in the appeal proceedings or the board (Article 13(1) RPBA). In the current case, despite the fact that the amendment introduced with auxiliary requests 2 and 3 may overcome the objection under Article 76(1) EPC, this is not the case for the objection of lack of sufficiency raised under Article 83 EPC. The opposition division had found that the invention defined in the independent claims maintained in the set of claims of auxiliary requests 2 and 3 was not sufficiently disclosed in the application*

*(Article 83 EPC), an opinion that the board endorsed in its preliminary opinion. The deletion of the dependent claims in auxiliary requests 2 and 3 therefore did not result in claims which were clearly allowable."*

10. Article 113(1) EPC provides 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. This implies that a party may not be taken by surprise by the reasons for the decision referring to unknown grounds or evidence. A party has to have an opportunity to comment on the decisive aspects of the case.
11. On the other hand, the deciding board must be able to draw its own conclusions from the discussion of the grounds put forward. Thus the right to be heard does not go so far as to impose a legal obligation on a board to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion, or at least those foreseeable as the core of the discussion, it will come to its conclusion. This forms part of the reasoning given in the written decision (see also R 8/17, Reasons 15 and 16; R 16/13, Reasons 3.3; R 8/13 of 15 September 2015, Reasons 2.2; R 15/12, Reasons 5; R 1/08, Reasons 3.1).
12. As derivable from the minutes of the oral proceedings before the Board and in line with the petitioner's submissions, the issue of admittance of auxiliary requests 2 and 3 was discussed with the parties at the oral proceedings, having regard to the requirements of Article 13(2) RPBA. The parties were thus heard on the issue of admittance of auxiliary requests 2 and 3, and, subsequently, the Board decided on this issue.

13. It was not contended by the petitioner that the Board had restricted the discussion on the admittance of auxiliary requests 2 and 3 in a particular way, or that it had not allowed the petitioner to address the aspect which is the object of the petitioner's complaint, i.e. the issue of whether the claims of auxiliary requests 2 and 3 were suitable to overcome the lack of sufficiency of disclosure.
14. The petitioner, when reading the reasoned written decision, may subjectively have been surprised that the aspect of overcoming the issue of sufficiency of disclosure was taken into consideration by the Board when deciding on the admittance of auxiliary requests 2 and 3.
15. However, on an objective basis, it could not have come as a surprise that the Board, when deciding on the admittance of auxiliary requests 2 and 3 in application of Article 13(2) RPBA, additionally took into account aspects set out in Article 13(1) RPBA.
- 15.1 In this regard, the Enlarged Board notes that Article 13(2) RPBA governs the third and final stage in the appeal proceedings (NB: the amendment to Article 13(2) RPBA with effect from 1 January 2024 - see Decision of the Administrative Council of 13 December 2023 approving amendments to the Rules of Procedure of the Boards of Appeal (CA/D 24/23), OJ EPO 2023, A103 - is of no relevance to the case at hand). The first and second stages of the appeal proceedings are governed, in particular, by Article 12(4) RPBA and Article 13(1) RPBA, respectively.

15.2 It lies within the concept of the "convergent approach" - an expression established in the course of revising the Rules of Procedure of the Boards of Appeal in force since 1 January 2020 - that criteria which are explicitly mentioned in a provision governing an earlier stage of the proceedings ("level") continue to be relevant for the subsequent stage(s), in addition to those explicitly provided for that later stage.

15.3 Reference is made in this context to, for example, the explanatory remarks concerning Article 13(2) RPBA, OJ EPO 2020, supplementary publication No. 2, page 60, which read:

*"Proposed new paragraph 2 implements the third level of the convergent approach applicable in appeal proceedings. It imposes the most stringent limitations on a party wishing to amend its appeal case at an advanced stage of the proceedings ... The basic principle of the third level of the convergent approach is that, at this stage of the appeal proceedings, amendments to a party's appeal case are not to be taken into consideration. However, a limited exception is provided for: it requires a party to present compelling reasons which justify clearly why the circumstances leading to the amendment are indeed exceptional in the particular appeal ('cogent reasons'). For example, if a party submits that the Board raised an objection for the first time in a communication, it must explain precisely why this objection is new and does not fall under objections previously raised by the Board or a party. The Board may decide to admit the amendment in the exercise of its discretion.*

*At the third level of the convergent approach, the Board may also rely on criteria applicable at the second level of the convergent approach, i.e. as set out in proposed new paragraph 1 of Article 13."*

16. Hence it was objectively foreseeable in the circumstances of the case leading to the decision under review that the aspect of whether the claims of auxiliary requests 2 and 3, filed at the third level of the convergent approach, would overcome a lack of sufficiency of disclosure in relation to the main request and auxiliary request 1 might be considered by the Board when deciding on the admittance of these requests. Any surprise on the petitioner's part in this respect can only be considered a subjective surprise which cannot change the finding that the petitioner knew which issues might be considered by the Board when exercising its discretion, and had had adequate opportunity to comment on them.
17. Moreover, in the decision under review, it is stated that the petitioner had submitted that the amendment "*neither raised any new issue nor changed the factual situation of the appeal or affected procedural economy*" (see decision under review, section XI. and point 24).

Accordingly, the petitioner itself had likewise referred to criteria governing earlier stages of the "convergent approach" in its submissions concerning the admittance of auxiliary requests 2 and 3.

18. Thus, seen objectively, the petitioner was aware of the possible criteria the Board might take into consideration when deciding on the admittance of auxiliary requests 2 and 3, and was not prevented from presenting any arguments it might have had. It may well be that the Board did not disclose to the parties in advance all the specific aspects it would consider when deciding on the admittance of auxiliary requests 2 and 3. However, in the light of the general principles developed in the case law as set out above (see points 11 and 12), this cannot be seen as a violation of the petitioner's right to be heard.
19. The petitioner submitted that the case law referred to in point 12 above concerned cases in which the petitioner had been heard on a substantive issue such as inventive step, and submitted in the petition for review that surprising elements for denying inventive step appeared in the reasoned written decision. The decisive point, however, is whether a party can be seen to be objectively surprised by a decision. As explained in points 16 and 17 above, this has not been demonstrated by the petitioner in this case.
20. At the oral proceedings before the Enlarged Board, the petitioner also submitted that the Board's exercise of discretion was erroneous, while acknowledging that the Enlarged Board's review was limited.
21. Indeed, the review by the Enlarged Board of decisions taken by a board in exercise of its discretion is limited.
- 21.1 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. Accordingly, review proceedings cannot be based on an incorrect application of substantive 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 also Case Law of the Boards of Appeal, 10th edition, July 2022, V.B.3.1 and V.B.3.4.3, and the decisions cited in it, e.g. R 1/08, and R 19/11, point 2.2 of the Reasons).

21.2 The specific way in which the Board actually exercised its discretion on procedural matters falls outside the Enlarged Board's competence, since this would need a review of all the facts and circumstances of the case, which would necessarily mean going into the merits of substantive issues (see also R 10/09, point 2.2 of the Reasons; R 7/21, point 1 of the Reasons with further references).

21.3 The discretionary power provided for in Article 114(2) EPC, as well as in the relevant provisions in the Rules of Procedure of the Boards of Appeal, in this case Article 13(2) RPBA, is as such not subject to review by the Enlarged Board unless, under Article 112a(2)(c) EPC, a fundamental violation of Article 113 EPC occurred in the exercise of this discretionary power (see also R 17/11, point 10 of the Reasons with further references).

21.4 The exercise of discretion by a board is subject only to a limited review by the Enlarged Board, i.e. it is confined to a review of whether the Board's exercise of discretion was arbitrary or manifestly illegal (see also R 10/11, point 5.2 of the Reasons; R 6/17,

point 3.5 of the Reasons; R 7/21, point 2 of the Reasons), thereby involving a fundamental violation of the right to be heard.

22. The Board's reasoning for not admitting auxiliary requests 2 and 3 is set out in points 23 to 29 of the decision under review. The considerations also take into account the petitioner's submissions for justifying the presentation of these auxiliary requests at that stage of the appeal proceedings.
23. The Enlarged Board cannot find anything which would point to any arbitrariness or manifest incorrectness in the Board's exercise of discretion. The Board considered whether there were exceptional circumstances based on the petitioner's submissions and considered criteria set out in Article 13(1) RPBA.
24. The petitioner's arguments do not lead the Enlarged Board to come to a different conclusion.
  - 24.1 In the petition for review, the petitioner referred to a number of decisions in which the deciding board, after issuance of a communication pursuant to Article 15(1) RPBA, admitted into the appeal proceedings auxiliary requests which differed from the claim set under consideration in that one or more dependent claims had been deleted. The petitioner highlighted that also, according to the line of case law according to which the deletion of a dependent claim was considered an amendment to the party's appeal case, the boards, in exercise of their discretion, admitted the amended claim sets in all cases except for two, taking into account that there was no change in the factual situation or no shift in the focus of the

appeal which was accepted to constitute exceptional circumstances under Article 13(2) RPBA.

- 24.2 In the case that led to the petition for review, the Board held that the filing of the new sets of claims of auxiliary requests 2 and 3, even if only dependent claims were deleted, represented an amendment to the petitioner's appeal case within the meaning of Article 13(2) RPBA, and concluded that admittance was subject to the Board's discretion.
- 24.3 The fact that in most of the cases underlying the decisions to which the petitioner referred in the petition for review such an amendment was admitted by the deciding board does however not mean that the Board had to do so in the case underlying the petition for review. Exercising discretion, as provided for in Article 13(2) RPBA, implies that the Board could consider various criteria and take into account the specific circumstances of the individual case before it, including the petitioner's and the respondent's submissions presented in favour of or against admittance, respectively.
- 24.4 The petitioner further contended that the provision of Article 13(1) RPBA was formulated in a "backwards looking" way, i.e. as to whether issues considered and ruled upon by the Board at the oral proceedings were resolved or overcome by the amendment to the petitioner's appeal case. As the issue of sufficiency of disclosure had not been discussed and ruled upon by the Board at the oral proceedings, the Board had failed to take into account the criterion of the "current state of the proceedings".

24.5 Article 13(1), fourth sentence, RPBA reads as follows:

*"The Board shall exercise its discretion in view of, inter alia, the current state of the proceedings, the suitability of the amendment to resolve the issues which were admissibly raised by another party in the appeal proceedings or which were raised by the Board, whether the amendment is detrimental to procedural economy, and, in the case of an amendment to a patent application or patent, whether the party has demonstrated that any such amendment, prima facie, overcomes the issues raised by another party in the appeal proceedings or by the Board and does not give rise to new objections."*

24.6 In the case underlying the petition for review, the issue of sufficiency of disclosure had been decided upon in the decision under appeal and the corresponding objections had been maintained by the respondent in the reply to the petitioner's appeal. The Board, in its communication under Article 15(1) RPBA, had provided its provisional opinion on that issue, referring to relevant submissions (see also section VIII. above).

24.7 The Enlarged Board cannot see any arbitrariness or manifest incorrectness in the Board's approach to considering whether the subsequently filed claims of the auxiliary requests, i.e. those filed at the third level of the "convergent approach", resolve or overcome the issues raised by the respondent in the appeal proceedings and on which the Board had formulated its provisional opinion.

25. At the oral proceedings before the Enlarged Board, the petitioner referred to decision R 12/21, which it considered highly relevant, and argued that the

situation in that case was identical to the one in the current case and that the reasoning of that decision applied. In line with this decision, there had been an obligation on the Board to raise the aspect of sufficiency of disclosure itself at the oral proceedings and give the petitioner the opportunity to provide its comments, as nothing had indicated that the Board was minded to consider the issue of sufficiency when deciding on the admittance of auxiliary requests 2 and 3.

- 25.1 The Enlarged Board notes that each case before it has to be considered and assessed separately, taking into account all factual and legal circumstances of the individual case.
- 25.2 Furthermore, it also disagrees with the petitioner's suggestion that the circumstances underlying the current petition for review are identical to those underlying the petition for review decided upon in case R 12/21. In that case, the petitioner had made an attempt, at the oral proceedings when the auxiliary request was addressed, to make oral submissions on novelty of the claimed subject-matter of the auxiliary request, but was not allowed to do so by the board (see R 12/21, Facts and Submissions, points 1, 4 and 7; Reasons, point II.2.2.2). Claim 1 of the auxiliary request, filed after the board's communication under Article 15(1) RPBA, differed from claim 1 of the main request in that an additional feature taken from the description had been introduced into claim 1 (see R 12/21, Facts and Submissions, point 2). The discussion before the responsible board relating to the auxiliary request concerned only the admittance of this request, and submissions relating to *prima facie* novelty had not been part of that discussion.

The responsible board did not admit the auxiliary request. As set out in the reasoned written decision, the board based this non-admittance decision *inter alia* on a *prima facie* lack of novelty of the claimed subject-matter of the auxiliary request. The Enlarged Board's findings in point II.2.2.2 of the Reasons for the decision R 12/21 concerning the board's obligation to expressly address the issue of *prima facie* novelty in the context of the debate on the exercise of its discretion regarding the admission of the auxiliary request must be viewed in the light of these circumstances.

- 25.3 In the current case, the petitioner did not submit that it had made an attempt, at the oral proceedings before the Board, to make oral submissions on sufficiency of disclosure of the subject-matter claimed in auxiliary requests 2 or 3, let alone that it had not been allowed to do so.
- 25.4 Moreover, as acknowledged by the petitioner, the Rules of Procedure of the Boards of Appeal that were applicable to the case underlying decision R 12/21 were those as in force before 1 January 2020 (i.e. in their version of 2007). It may be noted that the wording of Article 13 RPBA 2007 is different from the version applicable to and applied in the current case. In Article 13(1) RPBA *prima facie* considerations are now explicitly mentioned in the list of possible criteria.
- 25.5 In the light of the above, the Enlarged Board considers that decision R 12/21 is not relevant to the current case.

26. At the oral proceedings before the Enlarged Board, the petitioner expressed the view that the Enlarged Board in its current composition pursuant to Rule 109(2)(a) EPC should submit the petition for review to the Enlarged Board of Appeal as composed pursuant to Rule 109(2)(b) EPC for decision, based on the consideration that decision R 12/21 had been taken by the Enlarged Board in a five-member composition.

However, the mere fact that the decision referred to and considered pertinent by the petitioner had been taken by the Enlarged Board of Appeal as composed pursuant to Rule 109(2)(b) EPC, i.e. in a five-member composition, is no reason to submit the current petition for review likewise to the Enlarged Board of Appeal as composed under Rule 109(2)(b) EPC for decision, nor does it prevent the Enlarged Board in its current composition pursuant to Rule 109(2)(a) EPC from arriving at a finding of clear inadmissibility or unallowability.

### *Conclusions*

27. The petitioner's complaints mentioned in point 4 above relating to the non-admittance of auxiliary requests 2 and 3 as such and to not having been heard on the issue of sufficiency of disclosure could not be considered in these review proceedings as no objection under Rule 106 EPC had been raised and the exception provided for in Rule 106 EPC does not apply.

28. As regards the complaint directed to the aspect of sufficiency of disclosure as a criterion relied upon in the reasoning for the Board's exercise of discretion, the Enlarged Board is unable to establish that a violation of Article 113(1) EPC has occurred, let alone

a fundamental one within the meaning of Article 112a(2)(c) EPC. In this respect, the petition for review is clearly unallowable.

29. Since the decision under review is not set aside and the proceedings are not re-opened, the petitioner's request for the replacement of the members of the Board who participated in the decision did not require consideration.

## 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:



M. Schalow

C. Josefsson

Decision electronically authenticated