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**Datasheet for the decision
of 24 March 2017**

Case Number: T 0545/08 - 3.5.07

Application Number: 03755471.4

Publication Number: 1508106

IPC: G06F17/30

Language of the proceedings: EN

Title of invention:

High-performance change capture for data warehousing

Applicant:

Oracle International Corporation

Headword:

Change capture for data warehousing/ORACLE INTERNATIONAL

Relevant legal provisions:

EPC 1973 R. 71a, 86(3)
EPC Art. 113(1), 117(1)
EPC R. 116

Keyword:

Internet disclosures - standard of proof - sufficient degree of certainty (no) - objection properly reasoned (no)
Non-admission of late-filed evidence - discretion not properly exercised
Right to be heard - substantial procedural violation (yes) - reimbursement of appeal fee (yes) - remittal to department of first instance (yes)

Decisions cited:

G 0003/97, G 0001/12, T 0381/87, T 0750/94, T 0929/94,
T 0755/96, T 0373/03, T 1110/03, T 0019/05, T 1134/06,
T 1875/06, T 0990/09, T 2339/09, T 0286/10, T 2227/11,
T 0526/12, T 2294/12, T 1961/13

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 0545/08 - 3.5.07

D E C I S I O N
of Technical Board of Appeal 3.5.07
of 24 March 2017

Appellant: Oracle International Corporation
(Applicant) M/S 50P7
500 Oracle Parkway
Redwood Shores, CA 94065 (US)

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 29 October 2007
refusing European patent application No.
03755471.4 pursuant to Article 97(1) EPC 1973.**

Composition of the Board:

Chairman R. Moufang
Members: M. Rognoni
R. de Man

Summary of Facts and Submissions

- I. This appeal concerns the decision of the Examining Division refusing European patent application No. 03755471.4, which had originally been filed as international application PCT/US03/16402 and published as WO 03/100666. The application claims two priority dates, the first of which is 24 May 2002.
- II. After the international application entered the regional phase, a first communication pursuant to Article 96(2) EPC 1973 was issued, in which documents D1 to D4 were cited. The document D1 was identified as follows:

D1: WHITE, DANIEL: "Oracle 9i, ETL from the Database Out for Free", INTERNET ARTICLE, [Online] January 2002 (2002-01), pages 1-13, XP002265014 USA
Retrieved from the Internet: URL:http://www.innovative-consult.com/tech_solution/pdf/Oracle%209i%20ETL%20from%20the%20DB%20for%20free%20-%20DWhite.pdf [retrieved on 2003-12-12]

The document had already been cited in the international search report. Neither this report nor the first communication contained any explanations why document D1 was regarded as publicly available at the indicated time, i.e. in January 2002.

Apart from raising several objections under Article 84 EPC 1973, the Examining Division considered document D1 to be novelty-destroying for the subject-matter of all claims 1 to 8.

- III. In its reply dated 13 September 2005 the applicant replaced the original claims by a new set of claims 1

and 2, and argued that the claimed subject-matter was inventive over document D1.

- IV. The Examining Division issued a summons to oral proceedings and fixed 17 August 2007 according to Rule 71a EPC 1973 as the final date for making written submissions and/or amendments. In an accompanying annex it expressed the view that the subject-matter of the new claims lacked inventive step (Article 56 EPC) over document D1 in combination with notorious common knowledge. Following a reply in which the applicant submitted arguments against this view, the Examining Division introduced a further document D5 as evidence of the common general knowledge.
- V. In the oral proceedings before the Examining Division, the applicant disputed for the first time that document D1 was published at the date suggested by the Division. It submitted documents E1-E3 and argued that in view of this evidence the date indicated on the title page of the document (January 2002) could not be relied upon as the publication date. Thus, the applicant requested the grant of a patent on the basis of the originally filed claims (main request) or, in the alternative, of the claims filed with the letter dated 13 September 2005 (auxiliary request).
- VI. As set out in the minutes of the oral proceedings and in the grounds of the refusal decision, the Examining Division decided not to admit the newly submitted evidence under Rule 71a EPC 1973 since this would require further investigations concerning the publication date and make it impossible to announce a decision in the oral proceedings. Delaying the end of the procedure was, however, highly undesirable. Moreover, *prima facie*, none of the evidence appeared to

clearly establish that D1 had not been published before the priority date. The Division furthermore observed that the applicant had not challenged the publication date during the written procedure.

VII. The Examining Division therefore considered document D1 as part of the prior art, so that the objections concerning the original claims which had been formulated on the basis of D1 in the written procedure were still regarded as valid. Thus, the main request was not accepted under Rule 86(3) EPC 1973, because it would reintroduce deficiencies which had already been overcome in the written procedure. The auxiliary request was found to lack inventive step over document D1 as closest prior art.

VIII. With the notice of appeal, the applicant (appellant) requested that the decision of the Examining Division be set aside and that a patent be granted on the basis of the claims as originally filed (main request). An auxiliary request for oral proceedings was made.

IX. With the statement of grounds of appeal, the appellant submitted the following additional requests:

- reimbursement of the appeal fee for reasons of a substantial procedural violation;
- grant of a patent on the basis of claim 1 filed with the statement of grounds of appeal (first auxiliary request);
- grant of a patent on the basis of claims 1 and 2 filed with letter dated 12 [sic] September 2005 (second auxiliary request).

X. The appellant's arguments may be summarised as follows:

- The alleged publication date of document D1 was not established beyond reasonable doubt. A strict standard of proof had to be adopted in order to establish that a document retrieved from the Internet formed part of the relevant state of the art (see T 1143/06).
- The search report did not cite further evidence supporting the alleged publication date nor did it cite evidence that the website from which the document was retrieved was a reputable and reliable source of information. Document D1 itself did not qualify the date indicated on its front page further.
- The evidence submitted by the appellant in the oral proceedings, i.e. documents E1-E3, cast serious doubts on the assumed publication date and should have been admitted by the Examining Division. Not to do so was a violation of the appellant's right to be heard, in particular in view of the introduction of a fresh document (D5) shortly before the oral proceedings.
- The further document E4 submitted with the grounds of appeal additionally supported the appellant's point of view. The onus of proof for the correctness of the publication was no longer on the appellant.
- The Board should take all this evidence into account even though it was rejected by the Examining Division for lateness.

XI. In a following letter the appellant submitted a copy of decision T 373/03 and brought forward arguments why this decision was pertinent to the present case.

XII. The Board sent out a communication setting out its preliminary view on the issues it considered to be relevant. It may be summarised as follows:

- The Examining Division's decision not to admit documents E1 to E3 under Rule 71a EPC 1973 and to maintain D1 as prior art under Article 54(2) EPC 1973 without further investigations constituted a substantial procedural violation. Under these circumstances, it would be equitable to set aside the decision under appeal, to remit the case to the department of first instance for further prosecution and to order the reimbursement of the appeal fee.

- In order to avoid further delays in the examination of the application, the Board would nevertheless, with the appellant's consent, be prepared to carry out a substantive examination of the application and to arrive at a decision as to the patentability of the claimed subject-matter. In this context, the appellant's attention was drawn to documents

D6: "Innovative Consulting, Inc.", retrieved from the Internet: https://web.archive.org/web/20020210230924/http://www.innovative-consult.com/tech_solution/resources.htm, and

D7: "Oracle9i, Data Warehousing Guide", Release 1 (9.0.1), June 2001, Part No. A90237-01, pages 10-2 to 13-39.

The possible relevance of these documents was explained.

XIII. The appellant replied to this communication. It requested, as a main request, that the Board remit the case to the department of first instance, after having made a final determination of the date of disclosure of D1 having regard to the contested decision, the arguments submitted in the grounds of appeal, the arguments set out in the Board's communication, including the new citation D6, and the appellant's arguments filed in reply. The appellant's auxiliary request was "remittal to the first instance as set out in section 3.1. of the Communication", i.e. remittal (without assessing any substantive issues) and reimbursement of the appeal fee. Oral proceedings were only requested in the event that the Board were minded to reject both the main request and the auxiliary request.

The appellant provided arguments why, even in the light of document D6, document D1 should not be considered as having been made publicly available before the priority date.

Reasons for the Decision

Admissibility of the appeal

1. The appeal complies with the provisions referred to in Rule 101(2) EPC and is therefore admissible.

Procedural deficiencies of the first-instance proceedings

Overview

2. The contested decision is based on the assumption that document D1, an Internet disclosure, belongs to the prior art. Documents presented by the appellant in the oral proceedings in order to show that there was no sufficient basis for this assumption were not admitted as late-filed. Consequently, no consent was given under Rule 86(3) EPC 1973 to amending the application in accordance with the main request, i.e. reverting to the originally filed claims, and the then auxiliary request was found to lack inventive step over document D1 as closest prior art.

3. The appellant maintains that the Examining Division committed a procedural violation by relying on a document without properly ascertaining its status as prior art and by not admitting the appellant's evidence to the contrary (see section XI above). In the following, the Board will therefore assess whether, in the light of the general principles concerning the standard of proof with respect to Internet disclosures (see points 4 to 11 below), the Examining Division acted correctly when raising objections based on document D1 (see points 12 to 19 below) and refusing to admit documents E1 to E3 in the oral proceedings (see points 20 to 27).

Internet disclosures and standard of proof

4. The boards of appeal have dealt with issues relating to the reliability of Internet disclosures on several occasions. The crux of the matter is adequately summarised in the following passage of the Guidelines

for Examination in the EPO (November 2016) [in the following: "Guidelines"], G-IV, 7.5.1:

"The nature of the Internet can make it difficult to establish the actual date on which information was made available to the public: for instance, not all web pages mention when they were published. Also, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public - including examiners - to establish precisely what was published and when."

5. In decision T 1134/06 of 16 January 2007 (point 4.1), the Board held that, in order to establish that an Internet disclosure formed part of the state of the art, the same strict standard of proof as for prior use or prior oral disclosure, i.e. "beyond any reasonable doubt", had to be applied (see also decision T 373/03 of 2 September 2005, point 3.3). Circumstances which allowed the determination of availability to the public might also include factors that had a bearing on the reliability of the information, e.g. the manner in which information had been procured and date-stamped, how it had been preserved by the source, and whether it had remained unaltered since deposit.
6. Although this decision was cited with approval in some other decisions (see T 1875/06 of 8 January 2008, point 9; T 19/05 of 15 February 2012, point 2.3.2), its conclusions did not remain uncontested. Decisions T 286/10 of 21 May 2014 (points 2 to 2.3) and T 2227/11 of 18 February 2016 (point 2) did not find any justification for the application of the strict standard of proof beyond any reasonable doubt. Rather, only a

sufficient degree of probability leading to the boards' conviction that a fact has occurred was considered to be required. The yardstick of balance of probabilities was also applied in the context of Internet disclosures in decisions T 990/09 of 3 July 2012 (points 10 to 12) and T 2339/09 of 17 November 2011 (point 2).

7. It is no easy task to try to reconcile the different views expressed in the appeal case law about the proper standard of proof relating to the issue of availability to the public, in particular with respect to Internet disclosures. However, any such attempt has to respect the European Patent Convention's overarching principle of free evaluation of evidence (see decision G 1/12, OJ EPO 2014, A114, point 31, with further references), which would be contradicted by laying down firm rules of evidence defining the extent to which certain types of evidence were, or were not, convincing. Instead, the question whether a fact can be regarded as proven has to be assessed on the basis of all the relevant evidence (G 3/97, OJ EPO 1999, 245, point 5).

8. While the above-described standards of proof clearly differ on a conceptual level, in most cases adhering to one or the other in judicial practice does not need to lead to divergent results if the standard of "balance of probabilities" is applied with some qualification. In particular, the latter should, in the Board's view, not be misunderstood as implying that a fact has to be regarded as already proven when it has a probability which is "just tipping the balance slightly", for instance, a probability of 51% (if it were at all possible to express probabilities in this context in mathematical terms).

9. Although the standard of balance of probabilities has occasionally been paraphrased as meaning that one has to assess whether one set of facts is more likely to be true than the other (see T 381/87, OJ EPO 1990, 213, point 4.4.b)), such a literal interpretation of "balance" does not, in the Board's view, properly reflect the long-standing judicial practice of the boards of appeal in determining whether a particular piece of information has become publicly available. It may not be possible to identify a single decision where a patent was refused or revoked on the basis of prior art, be it a written disclosure, an oral disclosure or a prior use, because its availability to the public had been found to be just slightly more likely than its non-availability. Even in the above-cited case T 381/87, which appears to have been seminal for the development of the "balance of probabilities" standard, the board found (see point 4.4 a)) that on the evidence - two letters from a librarian of a renowned institution written with full regard as to the potential serious nature of their contents - it was "clearly much more likely that document (A) was placed on the open shelves of the Library on 26 November 1981, than that it was not so placed" and that "[a]ny uncertainty [was] of a minimal nature".

10. There are numerous decisions which refer to and apply the standard of balance of probabilities, but interpret it in a manner which does not leave any doubt that just slightly tipping the balance of probabilities is not sufficient when assessing the public availability of prior art. An often-cited case is T 750/94 (OJ EPO 1998, 32), which in point 4 of its reasons stated the following:

"When an issue of fact is being examined and decided by the EPO on the balance of probabilities, the more serious the issue the more convincing must the evidence be to support it. If the decision upon an issue under examination may result in refusal or revocation of a European patent, for example in a case concerning alleged prior publication or prior use, this means that the available evidence must be very critically and strictly examined, for example in order to ascertain whether or not something happened (the alleged prior publication or prior use) before the relevant filing or priority date. [...] A European patent should not be refused or revoked unless the grounds for refusal or revocation are fully and properly proved".

Corresponding reasoning can be found e.g. in the more recent decision T 526/12 of 31 August 2015, point 2.2, assessing the public availability of an Internet disclosure.

11. Thus, the facts on which any finding of public availability is based must be established with a sufficient degree of certainty in order to convince the competent organ of the EPO in view of all the relevant evidence that they have indeed occurred. This holds true even if the determination is made on the basis of probabilities and not on the basis of absolute certainty ("beyond any reasonable doubt"). It is thus correctly stated in the Guidelines (G-IV, 7.5.2) with respect to Internet disclosures:

"The standard for assessing these circumstances is the balance of probabilities. According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely

probable; the examining division must be convinced that it is correct."

The objection based on document D1 raised in the written proceedings

12. It is a general principle that, when raising objections, the burden of proof lies initially with the examining division. This means that objections must be reasoned and substantiated, and must show that, on the balance of probabilities, the objection is well-founded (see Guidelines, G-IV, 7.5.3). With respect to the publication date of a cited document, at least *prima facie* evidence is required. *Prima facie* evidence means evidence which is sufficient, on its own, to establish a fact or to raise a presumption of the truth of a fact unless controverted (see T 750/94, point 6; T 526/12, point 1.4). Thus, not every indication or hint qualifies as *prima facie* evidence.
13. If the objection is properly raised, it is then up to the applicant to prove otherwise or to at least submit evidence to displace the *prima facie* evidence. If the applicant successfully challenges *prima facie* evidence concerning a fact, e.g. the nominal publication date of a document, the burden of proof shifts back to the examining division to establish that the document was made available to the public (see e.g. T 929/94 of 7 July 1998, point 2.1).
14. In the present case, according to the international search report, document D1 was retrieved from the Internet on 15 December 2003, i.e. more than 18 months after the priority date of the application (24 May 2002). Neither the report nor the first communication pursuant to Article 96(2) EPC 1973, which

- cited document D1, contained any explanation as to why the document was considered to have been publicly available before the priority date.
15. In the context of Internet disclosures, such an absence of explanations is acceptable only where, in view of the circumstances of the case, it is self-evident - or at least easily understandable - why the document is considered to have become publicly available before a specific date. Those circumstances may include the nature, in particular the reliability, of the website from which the document was retrieved as well as intrinsic evidence deduced from information provided in the document itself.
 16. Document D1 was retrieved from an Internet site with the address www.innovative-consult.com. It consists of 13 pages. Its front page contains the title ("Oracle9i, ETL from the Database Out for Free"), a date ("January, 2002"), a firm logo with the text "innovative consulting IntelligentSolutionsforyourBusiness" and an address. The last page gives some information on the author (Daniel White), who is said to be a technology consultant with Innovative Consulting, a Pennsylvania-based professional services firm specialising in strategy consulting and implementation of high-performance business intelligence and data warehousing solutions. The last page also carries a copyright notice ("© 2001 Innovative Consulting Inc. ..."). There are no passages in the document indicating that, prior to its publication on the Internet, copies of it were made available to members of the public.
 17. The only circumstantial evidence on which the International Searching Authority and the Examining Division apparently implicitly relied for its assumption

that document D1 was made publicly available in January 2002 is the date on the cover page of the document. However, this date is not only imprecise, but also unqualified. In particular, the document does not specify the date as its date of publication. The indication of the date can therefore at best be considered as *prima facie* evidence that the document was created in January 2002, but not that it was made available to the public on that date (see also T 373/03, point 3.3).

18. Furthermore, the commercial website from which document D1 was retrieved cannot be considered, at least not without further investigations, as a source generally deemed to provide reliable publication dates, such as the websites of scientific publishers. Thus, irrespective of the standard of proof to be applied, i.e. "balance of probabilities" (see points 9 to 12 above) or "beyond any reasonable doubt", neither the information provided in document D1 itself nor its source of retrieval allowed, on their own, to conclude with a sufficient degree of certainty that the document was publicly available in January 2002. There was no *prima facie* evidence to rely on.

19. It follows that the Examining Division was not entitled to consider document D1 as prior art in its first substantive communication without providing further explanations and evidence as to the document's public availability before the priority date (see also T 1961/13 of 16 September 2014, point 5.1.6). Thus, the objection was not properly raised. It could not generate an obligation on the applicant's side to submit evidence against the assumed publication date in the written proceedings.

Refusal to admit documents E1 to E3 as evidence

20. While prior to the oral proceedings the appellant did not argue against the Examining Division's assumption that document D1 was prior art and, in its reply to the first communication, even amended the original claims in order to overcome the objections raised, it contested the assumption at the oral proceedings and submitted documents E1 to E3 (see below) as evidence to the contrary.
21. Document E1 contains a version of document D1 retrieved as a pdf file from the Internet site www.archive.org. It also contains a printout of the document's properties in German, according to which it was created ("erstellt") on 15 January 2002 at 15:32 and modified on 15 January 2002 at 16:06. The printout names "L Elliott" as creator ("Verfasser"). The appellant argued that document E1 supported its view that January 2002 was only the creation date, and not the publication date, of D1.
22. Document E2 was said to be a printout of a search carried out by the applicant on the website www.archive.org of the Internet Archive Wayback Machine with respect to the URL of D1 and for the time period from 1 January 2002 to 31 December 2003. The search results show no record of the URL of D1 in 2002 and only one page in 2003. The appellant argued that, since the Wayback Machine had not archived document D1 during the period between its creation and the priority date of the application, this was evidence that the document had not been published in that period.
23. Document E3 was said to be a printout of various web pages of the website <http://www.innovative-consult.com>

archived by the Wayback Machine. The appellant argued that they did not provide any hint that document D1 had been published on this website, so that D1 should not be regarded as prior art.

24. The Examining Division did not admit the new evidence pursuant to Rule 71a EPC 1973 for the reason that otherwise it could not come to a final conclusion without further investigations, so that the end of the procedure would be delayed. Moreover, *prima facie* none of the evidence submitted appeared to clearly establish that D1 had not been published before the priority date. The fact that the pdf file had been created on 15 January 2002 could instead be seen as a step towards the publication of the underlying Word document, because the pdf format was more suitable for publication. The fact that the Wayback Machine had not archived the pdf version of D1 under the URL used in the search report was not proof that the document had not been published earlier on the Internet using a different URL, because websites were frequently reorganised, or published in another form (e.g. as printed paper). Finally, no convincing conclusions could be drawn from the absence of a reference to D1 on printouts of some archived pages of the website www.innovative-consult.com. The Examining Division further noted that D1 had been authored by a consulting company, which could be expected to disseminate D1 to its clients, i.e. to make it available to the public.
25. It is well established in the case law of the boards of appeal that Articles 113(1) and 117(1) EPC enshrine the basic procedural right to give evidence in appropriate form, specifically by the production of documents, and to have that evidence heard. Failure to consider evidence will normally constitute a substantial

procedural violation in that it deprives a party of this basic right (see e.g. T 1110/03, OJ EPO 2005, 302, point 2.4, and T 2294/12 of 12 January 2016, point 1.1.3). Nevertheless, according to Article 114(2) EPC, facts and evidence which are not submitted in due time by the parties concerned may be disregarded. Rule 71a(1) EPC 1973 (which corresponds to Rule 116(1) EPC) stipulates that, when the EPO issues a summons for oral proceedings, a final date for making written submissions in preparation for the oral proceedings has to be fixed and that new facts and evidence presented after this final date need not be considered.

26. The discretionary power given by Rule 71a EPC 1973 (and Rule 116 EPC) is governed by Article 114(2) EPC. In ex parte proceedings, this discretion has to be exercised by considering all the relevant factors which arise in a particular case and by balancing the applicant's interest in obtaining proper patent protection for his invention against the EPO's interest in bringing the examination procedure to a speedy close by the issue of a decision (see T 755/96, OJ EPO 2000, 174).

27. When exercising its discretion in the present case, the Examining Division should have been aware that, although it had cited document D1 at the beginning of the examination procedure, it had never provided any further explanations and evidence as to the document's public availability before the priority date, so that the objections based on this document had not been properly raised before. Moreover, the arguments provided by the Examining Division for the exercise of its discretion are not persuasive. In particular, it is difficult to see why the fact that D1 was authored by a (consultant of a) consulting firm was taken as a hint for a specific publication date. Nor can this fact be a sufficient

basis for the assumption that D1 was disseminated to clients in the relatively short period between the creation date of the pdf file (15 January 2002) and the priority date of the present invention.

28. Under these circumstances, the Examining Division was not allowed to reject the appellant's further evidence as late-filed and to continue to rely on document D1 as prior art. It thereby infringed the appellant's right to be heard (Article 113(1) EPC in conjunction with Article 117(1) EPC). This procedural deficiency was causal for the contested decision, as the Examining Division itself recognised that, when admitting the evidence, it could not have come to a final conclusion without further investigations.

Consequences of the procedural deficiencies

29. The Examining Division's reliance on document D1 as prior art had consequences for both substantive requests pending at the oral proceedings and maintained in the appeal proceedings as the main request and second auxiliary request (see sections VII to IX above). On the one hand, the then auxiliary request was considered to lack inventive step over document D1 as closest prior art. On the other hand, the main request was not admitted under Rule 86(3) EPC 1973 for the reason that it would reintroduce deficiencies which had already been overcome in the written procedure. Although the Board accepts the premise underlying the contested decision that reverting to the originally filed claims is an amendment under Rule 86(3) EPC 1973 which cannot be made without consent of the Examining Division, the exercise of the discretion under Rule 86(3) EPC 1973 was tainted by the incorrect view that the status of document D1 as prior art could no longer be contested. The Examining

Division thus exceeded the proper limits of its discretion.

30. The procedural deficiencies identified above are considered to be fundamental, so that, according to Article 11 RPBA, the Board has to remit the case to the department of first instance, unless special reasons present themselves for doing otherwise. In view of the highly regrettable length of the appeal proceedings (due to a huge backlog of appeal cases, the present Board had, when it was newly created in November 2013, taken over many cases that had already been pending for several years), the Board indicated in its communication that it would, with the appellant's consent, be prepared to carry out a substantive examination of the application and to arrive at a decision as to the patentability of the claimed subject-matter (see section XII above). For this purpose, it drew the appellant's attention to two further documents, i.e. D6 and D7. Document D6 was mentioned with respect to the issue of public availability of document D1, and document D7 appeared to relate to subject-matter which overlapped, at least to a large extent, with the disclosure in document D1.
31. The appellant replied to this communication by formulating two procedural requests (see section XIII above). Its main procedural request is for the Board to remit the case to the department of first instance, after having made a final determination of the date of disclosure of D1, having regard to the contested decision, the arguments submitted in the grounds of appeal, the arguments set out in the Board's communication, including the new citation D6, and the appellant's arguments filed in reply. Other issues, in particular the assessment of novelty and inventive step

in the light of further documents, in particular document D7 introduced by the Board, should not to be examined. The appellant's auxiliary request is directed to a remittal without assessment of any substantive issues and to a reimbursement of the appeal fee.

32. Whereas the Board's communication suggested two alternative courses of action, the appellant's main request aims at a third course, i. e. that before remittal is ordered, (only) one specific substantive issue be assessed. The Board accepts that the discretionary power given to it by Article 11 RPBA is sufficiently broad to allow it in exceptional cases to examine specific substantive issues before remittal. However, a board will normally proceed in this manner only in clear-cut cases, in particular where a preliminary assessment shows that a certain issue can be decided easily in the interest of the appellant.

33. In the present case, the "piecemeal" course of action aimed at by the appellant's main request is not considered to be appropriate. If the Board came to the conclusion that, contrary to the appellant's view, document D1 had to be regarded as prior art, a remittal would no longer serve a meaningful purpose: the decision would then have been correct in substance with respect to the status of document D1, and in order to set it aside further substantive issues would need to be assessed. In addition, having made the determination aimed at by the main request, the Board would then also be prevented from acceding to the appellant's auxiliary procedural request. If, on the other hand, the Board refrains from determining the status of document D1, the appellant will have an opportunity to fully argue its case before the department of first instance, which may even initiate further factual investigations. The

appellant's main procedural request is therefore refused.

34. The appellant's auxiliary request corresponds to the first course of action suggested in the Board's communication. Since the above-described procedural deficiencies justify an application of both Article 11 RPBA and Rule 103(1)(a) EPC, the auxiliary request is allowable.

35. The request for oral proceedings was made under the condition that the Board would be minded to reject both the main request and the auxiliary request. Thus, the present decision can be given in written proceedings without infringing Article 116(1) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



P. Cremona

R. Moufang

Decision electronically authenticated