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**Datasheet for the decision
of 12 May 2021**

Case Number: T 0172/17 - 3.2.02

Application Number: 08009043.4

Publication Number: 1997466

IPC: A61G5/00, A61G5/10, A61G5/14,
A61G5/12

Language of the proceedings: EN

Title of invention:
Wheelchair which stands up simplified

Patent Proprietor:
Vassilli s.r.l.

Opponent:
Permobil AB

Headword:

Relevant legal provisions:
EPC R. 99(1)(b), 99(1)(c)
EPC Art. 107, 123(2), 112(1)(a)
RPBA Art. 12(4)
RPBA 2020 Art. 13(2), 25

Keyword:

Admissibility of appeal - notice of appeal - (yes)
Remittal to the department of first instance - (no)
Amendments - allowable (no)
Amendment after summons - exceptional circumstances (no)
Referral to the Enlarged Board of Appeal - (no)

Decisions cited:

G 0009/91, G 0002/10, T 0582/91, T 0938/95, T 0288/89,
J 0014/19

Catchword:



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Case Number: T 0172/17 - 3.2.02

D E C I S I O N
of Technical Board of Appeal 3.2.02
of 12 May 2021

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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
8 November 2016 concerning maintenance of the
European Patent No. 1997466 in amended form.**

Composition of the Board:

Chairman M. Alvazzi Delfrate
Members: A. Martinez Möller
N. Obrovski

Summary of Facts and Submissions

I. The Opposition Division decided that, account having been taken of the amendments made by the patent proprietor according to auxiliary request 2 as filed by letter of 11 August 2016, the patent granted on European patent application No. 08 009 043.4 and the invention to which it related met the requirements of the EPC. The decision was dispatched on 8 November 2016.

II. On 18 January 2017 the appellant (opponent) filed notice of appeal and paid the appeal fee on the same day.

In the notice of appeal, it requested "the cancellation of the decision of the Opposition Division dated 8 November 2016 to refuse European patent application No. 08 009 043.4". Furthermore, it requested the grant of the patent "on the basis of documents to be indicated when the written statement setting out the grounds of appeal is filed".

III. Oral proceedings by videoconference took place on 12 May 2021.

IV. The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent (patent proprietor) requested that the appeal be rejected as inadmissible (main request) or dismissed as unfounded. In the alternative, the respondent requested that the oral proceedings be postponed, that the appeal be remitted to the

opposition division or that the patent be maintained on the basis of one of the first to third auxiliary requests, filed with the submission dated 12 April 2021.

- V. During the oral proceedings the respondent further requested that a question on the RPBA 2020 be referred to the Enlarged Board of Appeal.

- VI. Claim 1 according to auxiliary request 2, as filed by letter of 11 August 2016 and held allowable by the Opposition Division, reads as follows:

Wheelchair for disabled which stands up simplified characterized by the fact that for the adjustments of the seat height (4) and of its orientation compared to the loading structure of the wheelchair, it includes only 2 actuators and a first of said 2 actuators (8,11), (14), which provide singularly or in combination to the above said movements of the seat (4), is directly connected by hinging (12, 9) to the loading structure (1) of the wheelchair, being the said actuator (8, 11) composed of a lever (8) hinged to an edge (9) with the loading structure (1) and with the other edge (10) to the seat (4), and of a cylinder (11) with stem (28) which is layed (12) to the loading structure (1) of the wheelchair acts with the stem (28) in a lever (8) intermediate position (13) and the said second actuator (14) those which provides together with the said first actuator (8, 11) to the adjustment of the seat (4), has its loading structure (20) jointed to the lever (8) of the first one (8, 11) and therefore mobile compared to the loading structure (1) of the wheelchair and with an opposite edge is hinged in a point of the understructure of the seat (4), wherein the said first 2 actuators (8, 11, 14, 19, 17)

verticalize the seat level (4) and a third actuator (21, 22, 24, 23, 25) aligns the backrest (5) and legrest (6) laying to the seat (4) to achieve the verticalization of the entire wheelchair (1).

VII. The arguments of the appellant, as far as they are relevant for the decision, can be summarised as follows:

Admissibility of the appeal

The appeal was admissible. The decision was identified in the notice of appeal by the indication of the decision of the Opposition Division and the application number. Revocation of the patent in its entirety had been requested in the opposition proceedings; the appellant's intent was thus evident in view of the entire proceedings.

Article 123(2) EPC - Request not to admit the objection of an intermediate generalisation in claim 1 regarding the second actuator

This objection had been raised against claim 1 of the patent as granted during the opposition proceedings. The Opposition Division had ultimately found that claim 1 as granted did not comply with Article 123(2) EPC for another reason but had previously come to the conclusion that the objection was not convincing and not addressed it any further. When asked during the oral proceedings before the Opposition Division for further comments on extension of the subject-matter of the second auxiliary request, the appellant/opponent had not reiterated the objection because it was not a further objection. As the objection had never been

withdrawn and had been re-submitted in the grounds of appeal, it was part of the appeal proceedings.

Requests for remittal and for postponement of the oral proceedings

The respondent's requests for remittal or postponement if the objection were admitted were not justified. It was the respondent's duty to submit everything with its reply to the appeal. The respondent had not objected in its reply to the appeal to the admittance of the objection of an intermediate generalisation in claim 1. The respondent could not be surprised by its admittance or the fact that the Board was convinced by it.

Article 123(2) EPC - Objection of an intermediate generalisation in claim 1 regarding the second actuator

Only some of the features of claim 2 as originally filed had been incorporated into claim 1, resulting in an intermediate generalisation. The type of the second actuator and its structure were not included but were essential for the invention. A worm gear was the only type of actuator described in the patent, other types of actuators did not allow such a long travelling path in the limited space available below the seat of a wheelchair. It was also crucial to have the lever connected between the slide and the seat in order to transmit the required forces. The amendment failed the essentiality test.

Paragraphs [0004] and [0032] of the application as filed, relied on by the respondent, described the purpose of the patent but did not allow any conclusion as to the features required to carry it out.

First to third auxiliary requests - admittance

The first to third auxiliary request should not be admitted into the appeal proceedings. The relevant objection had been raised and maintained in opposition proceedings and re-submitted in the grounds of appeal. The respondent had had ample opportunity to react to it and should have filed the requests at the latest with its reply to the appeal. It could not be considered surprising that the Board's opinion differed from that of the department of first instance.

Request for referral of a question to the Enlarged Board of Appeal

The question submitted by the respondent was irrelevant for the present case because the objection had been presented and maintained before the Opposition Division.

- VIII. The arguments of the respondent, as far as they are relevant for the decision, can be summarised as follows:

Admissibility of the appeal

The appeal was not admissible. The decision was not properly identified in the notice of appeal because the decision by the Opposition Division was not a refusal but maintenance in amended form. Thus, Rule 99(1)(b) EPC was not complied with.

If the decision were to be regarded as having been identified, then it would only be the part of the decision refusing the proprietor's main and auxiliary requests. This would define the subject of the appeal

within the meaning of Rule 99(1)(c) EPC. The appellant was not adversely affected by this part of the decision.

Moreover, the appellant requested that the decision be set aside and the patent be granted on the basis of documents to be filed with the statement of grounds of appeal. This request was clear but inadmissible because the appellant could not have control over the subject-matter of the patent in suit.

Article 123(2) EPC - Request not to admit the objection of an intermediate generalisation in claim 1 regarding the second actuator

The objection under Article 123(2) EPC regarding the second actuator should not be admitted into the appeal proceedings. It had been raised in section 5.1 of the statement of grounds of appeal but not in the opposition proceedings against the claim set as maintained by the Opposition Division. An equivalent objection raised against claim 1 as granted had been found not to be convincing by the Opposition Division in its summons to oral proceedings. At the oral proceedings, claim 1 as granted had then been rejected for another reason. When discussing the claim set eventually maintained by the Opposition Division, the appellant/opponent had not raised the objection under Article 123(2) EPC, as was reflected in point 10.4 of the minutes. The objection had thus been implicitly dropped as regards this claim request.

Requests for remittal and for postponement of the oral proceedings

If the objection of an intermediate generalisation in claim 1 regarding the second actuator were to be admitted, the case should either be remitted to the Opposition Division for a decision on this issue or the oral proceedings should be postponed in order to give the respondent sufficient time to react to the objection.

Article 123(2) EPC - Objection of an intermediate generalisation in claim 1 regarding the second actuator

While the amendment was based on claim 2 as originally filed, some of the features of that claim could be left out. The appellant's submission that only a small group of actuators would work reflected what the skilled person would understand using their common general knowledge and it was therefore unnecessary to specify the type of actuator in claim 1. All conditions of the essentiality test were fulfilled by the amendment.

The invention as described in paragraphs [0004] and [0032] dealt with the number of actuators required in order to simplify the structure of a wheelchair. The invention was not about the type of actuators.

Paragraph [0022] of the A-publication introduced the second actuator as defined in claim 1 but did not limit the type of actuator, which was described only as an example, after a full stop and in a different paragraph.

First to third auxiliary requests - admittance

The requests should be admitted into the appeal proceedings. The respondent had no reason to believe that the Board would assess the issue differently from

the Opposition Division. It would be unfair to admit the appellant's new objection under the RPBA 2007 but not admit the respondent's auxiliary requests addressing it under the RPBA 2020. The requests used features of dependent claims already covered by the notice of opposition and prima facie overcame the objection.

Request for referral of a question to the Enlarged Board of Appeal

A referral was justified in view of Article 112a(c)-(d) EPC in combination with Article 113 EPC and the need for equally fair treatment of the parties referred to in point 2 of the reasons for decision G 9/91.

Reasons for the Decision

1. *Admissibility of the appeal*
 - 1.1 The respondent submitted that the decision was not properly identified.
 - 1.2 The notice of appeal contains an indication of the impugned decision. It is identified there by reference to the decision of the Opposition Division dated 8 November 2016 on European patent application No. 08 009 043.4. There is only one decision of the Opposition Division which is both dated 8 November and concerns that application: a decision on the maintenance of the patent in amended form.

It is true that the order of the decision is not correctly reflected in the notice of appeal, which states that the impugned decision is a decision "to

refuse the European patent application". However, the appellant's incorrect reproduction of the order of the decision cannot be construed as a reference to a different decision or to a partial refusal of the application in the Opposition Division's interlocutory decision, as is argued by the respondent. This would not be in line with either the wording used in the notice of appeal or the wording in the order of the impugned decision. In the given circumstances, the appellant's request in the notice of appeal can only be understood as a request to set aside the only decision dated 8 November 2016 taken by the Opposition Division, which concerns the maintenance of the patent in suit in amended form. Hence, the impugned decision can be identified. The requirements of Rule 99(1)(b) EPC are thus complied with.

- 1.3 The notice of appeal lodged against the impugned decision also requests its "cancellation". A request defining the subject of the appeal is thus present and the requirements of Rule 99(1)(c) EPC are complied with.
- 1.4 The respondent further submitted that the appellant had not been adversely affected by the impugned decision.

The Board does not share this view. As already explained above, the impugned decision concerns the maintenance of the patent in amended form. The appellant's request in opposition proceedings was that the patent be revoked in its entirety. This request was not granted. Hence, the appellant was adversely affected by the impugned decision and entitled to appeal pursuant to Article 107 EPC.

1.5 Finally, the statement in the notice of appeal requesting "the grant of the patent ..." deals with the new order which is to replace the order of the impugned decision and thus relates to the extent to which the decision is to be amended, which is a matter for the statement of grounds of appeal pursuant to Rule 99(2) EPC. The appellant subsequently clarified, within the time limit for filing the statement of grounds of appeal, that it was requesting that the patent be revoked in its entirety.

1.6 The requirements set out by Rule 99(1)(b)-(c) EPC and Article 107 EPC are thus complied with. The Board has no doubt that the other requirements referred to in Rule 101(1) EPC are also met. Hence, the appeal is admissible.

2. *The invention*

The invention relates to a wheelchair for the disabled. The wheelchair comprises two actuators which allow adjustments of the seat height and of the seat orientation compared to the loading structure of the wheelchair and a third actuator which allows alignment of the backrest and the legrest to the seat in order to achieve verticalisation of the wheelchair.

3. *Patent as maintained by the Opposition Division - Article 123(2) EPC*

3.1 *Request not to admit the objection of an intermediate generalisation regarding the second actuator*

3.1.1 The appellant submitted in its grounds of appeal that claim 1 as maintained by the Opposition Division (i.e. according to auxiliary request 2 as filed by letter of

11 August 2016) constituted an intermediate generalisation contravening Article 123(2) EPC because the features of claim 2 as originally filed relating to the type of actuator had been omitted.

The respondent submitted that this objection should not be admitted into the proceedings because it had only been raised in the statement of grounds of appeal.

- 3.1.2 The respondent's submission is incorrect. The objection was raised in the appellant's written submission dated 7 August 2015 (point A.3), addressed in the summons sent by the Opposition Division (point 4.4) and insisted upon in the appellant's written submission dated 12 August 2016 (point III).

The objection was also addressed during the oral proceedings before the Opposition Division in the context of the discussion of the patent as granted (see point 4.2 of the minutes), even if the Opposition Division ultimately found that claim 1 as granted did not comply with the requirements of Article 123(2) EPC for a different reason, as set out in point 3.1 of the impugned decision.

- 3.1.3 The amendments in claim 1 of the second auxiliary request in the opposition proceedings addressed the lack of compliance with Article 123(2) EPC found by the Opposition Division, but did not address the objection to the omission of the features relating to the type of actuator. It is undisputed that this objection was equally applicable to the second auxiliary request.

When discussing the second auxiliary request and upon being given "the opportunity to give further comments on extension of subject-matter" (point 10.4 of the

minutes), the appellant did not reiterate its objection to the omission of the features relating to the type of actuator.

In the Board's view, not reiterating an objection discussed in respect of a higher-ranking request when asked to give further comments in respect of a lower-ranking request cannot be construed as a withdrawal of that objection. It follows that the appellant presented and maintained the objection in the opposition proceedings.

- 3.1.4 Under Article 12(4) RPBA 2007, a Board of Appeal has discretion not to admit objections which could have been presented or were not admitted in the first-instance proceedings. This also applies to objections that were presented and subsequently withdrawn (Case Law of the Boards of Appeal, 9th edition 2019, V.A. 4.11.3 f)). However, as the objection in question was presented and not withdrawn, it must be taken into account by the Board under Article 12(4) RPBA 2007.

- 3.2 *Requests for remittal and for postponement of the oral proceedings*
 - 3.2.1 The respondent requested postponement of the oral proceedings or remittal if the disputed objection under Article 123(2) EPC to claim 1 as maintained by the Opposition Division were to be admitted into the proceedings.

 - 3.2.2 Regarding the request for postponement of the oral proceedings, the respondent argued that the oral proceedings should be rescheduled and a new communication pursuant to Article 15(1) RPBA 2020 providing a preliminary opinion and allowing the

respondent to present further auxiliary requests should be sent at least four months in advance. The respondent also submitted that it had been surprised that an objection regarding Article 123(2) EPC which had been dropped during the first-instance proceedings but presented again upon appeal had been admitted into the appeal proceedings.

As stated above (see point 3.1.3 of the reasons), the objection under Article 123(2) EPC was raised and maintained during the opposition proceedings and resubmitted in the statement of grounds of appeal. It was thus part of the appellant's appeal case. In its reply to the statement of grounds of appeal, the respondent even addressed the merits of this objection without, however, filing new claim requests or submitting that the objection should not be admitted into the appeal proceedings.

The communication pursuant to Article 15(1) RPBA 2020 issued on 31 March 2021 made clear that, in the Board's preliminary opinion, the appellant's objection under Article 123(2) EPC to claim 1 of the then only claim request was an important topic for the oral proceedings.

It was only after receiving the communication pursuant to Article 15(1) RPBA 2020, in which the Board had expressed its preliminary opinion that this objection was convincing, that the respondent requested that the objection not be admitted into the appeal proceedings. That the respondent was subjectively surprised by the Board's refusal of this request does not justify postponing the oral proceedings. A diligent party must always take into account the possibility that their

requests will not be granted. For these reasons, the respondent's request for postponement was rejected.

3.2.3 As regards the request for remittal, having taken into account that the appellant objected to the case being remitted, that the objection in question had already been raised during opposition proceedings and that claim 1 as maintained in the interlocutory decision was found by the Opposition Division to comply with the requirements of Article 123(2) EPC, the Board takes the view that a remittal to the Opposition Division is not justified.

3.3 *Objection of an intermediate generalisation regarding the second actuator*

3.3.1 The second actuator is defined in claim 1 as follows (amendments in this passage of claim 1 as compared to claim 2 as originally filed have been emphasised by the Board):

"the said second actuator (14) those which provides together with the said first actuator (8, 11) to the adjustment of the seat (4), has its loading structure (20) jointed to the lever (8) of the first one (8, 11) and therefore mobile compared to the loading structure (1) of the wheelchair, ~~being the said second actuator (14) composed of a worm gear (19) which moves a slide (16) and by a lever (17) which edges (15, 18) are connected to the said slide (15) and to the seat (4). and with an opposite edge is hinged in a point of the~~ understructure of the seat (4),"

3.3.2 The respondent submitted that, while the amendment was based on claim 2 as originally filed, it had been possible to omit some of the features of that claim. It

was a matter of dispute between the parties whether, based on the essentiality test, omitting some of the features of claim 2 as originally filed complied with Article 123(2) EPC.

- 3.3.3 According to the established case law, compliance with Article 123(2) EPC is assessed using the "gold standard": any amendment to parts of a European patent application or of a European patent relating to the disclosure (the description, claims or drawings) can only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of these documents as filed (Case Law of the Boards of Appeal, 9th edition 2019, II.E.1.1 and, in particular, G 2/10, point 4.3 of the reasons).

Tests such as the essentiality test have been sometimes used as an aid in assessing whether an amendment resulting from the deletion of features from a claim fulfills the requirements of Article 123(2) EPC. However, these tests cannot take the place of the gold standard (Case Law of the Boards of Appeal, 9th edition 2019, II.E.1.4.4.b) - c)).

- 3.3.4 In order to establish in the present case whether the inclusion of some of the features of claim 2 in claim 1 results in subject-matter extending beyond the content of the application as filed, it is necessary to analyse the relationship between those features of claim 2 as originally filed which have been included in claim 1 and those which have not.

This is also in line with how compliance with Article 123(2) EPC is assessed regarding the

incorporation of part of the features from a dependent claim (see T 582/91, point 2.2 of the reasons; T 938/95, point 3.3 of the reasons; T 288/89, point 2.2 of the reasons).

- 3.3.5 All features defined in claim 2 as originally filed relate to the same component of the wheelchair, namely its second actuator.

The second actuator is described in claim 2 as originally filed as an actuator "composed of a worm gear (19) which moves a slide (16) and by a lever (17) which edges are connected to the said slide (15) and to the seat (4)".

Comparing the seat positions in Figures 4 and 5 upon movement of the slide 15, it is clear that in the second actuator it is the lever 17 which, when the slide 15 is moved by the worm gear 19, transmits through its edge 18 the motion to the seat 4, causing its re-positioning.

- 3.3.6 Claim 1 is silent on the kinematic relationship within the second actuator between the loading structure (20) and the "opposite edge".

In contrast, claim 2 as originally filed defines the kinematic connection present between the loading structure (20), itself jointed to the lever (8), and the edge (18), this connection being achieved by means of the movable slide (15) and the lever (17). This kinematic connection plays a key role in achieving the re-positioning of the seat (4) using the second actuator.

In conclusion, the features of the second actuator from claim 2 as originally filed which have been included in claim 1 are structurally and functionally closely linked to further features from claim 2 as originally filed which have not been included in claim 1, such as the slide (15) and the lever (17). In claim 2 as originally filed, it is the combination of these features which provides the kinematic connection necessary for the adjustment of the chair as intended by the invention.

- 3.3.7 The description and the figures support this conclusion. The second actuator 14 is discussed in paragraphs [0006] and [0022]-[0025] of the A-publication and visible in Figures 1-6. It is consistently presented as being jointed to the lever/stem 8 and as being composed of a worm gear 19 which moves a slide 15 with a lever/stem 17 hinged on one edge to the said slide 15 and on the other edge to the seat 4.
- 3.3.8 The respondent submitted that the fact that, as also asserted by the appellant in its grounds of appeal, not only a worm gear as defined in claim 2 as originally filed but also a small group of actuators would work was part of the common general knowledge. The person skilled in the art reading the application as filed would take this into account, and would thus not consider the type of second actuator to be essential.

In the Board's view, this line of argument is not decisive. Irrespective of whether it would be possible to use a second actuator of a different type and with a different construction, the application as filed consistently presents the features of claim 2 as originally filed included in claim 1 in combination

with a particular second actuator. As explained above, the features of claim 2 as originally filed included in claim 1 are functionally and structurally related to the other features of the second actuator. Whether or not the person skilled in the art would consider the type of second actuator to be essential is thus irrelevant for assessing whether claim 1 in the present case complies with Article 123(2) EPC (see also point 3.3.3 of the reasons above).

- 3.3.9 The respondent further submitted that the invention as described in paragraphs [0004] and [0032] relates to the number of actuators rather than to the type of actuators.

The general purpose of the invention indicated in paragraphs [0004] and [0032] does not allow any conclusion as to the particular combination(s) of features disclosed in the application as filed. Thus, paragraphs [0004] and [0032] provide no basis for omitting certain features of claim 2 as originally filed.

- 3.3.10 The respondent further submitted that paragraph [0022] introduces the second actuator as defined in claim 1 without limiting the type of actuator.

Paragraph [0022] is part of the description of the embodiment shown in the figures. It does not present a feature of the second actuator isolated from the other features presented in subsequent paragraphs [0023]-[0025]. The fact that, as emphasised by the respondent, there is a full stop followed by a new paragraph does not alter this finding: the wording of paragraph [0023], which starts with "This last one is composed of a worm 19 ..." (emphasis added by the Board), leaves no

doubt that the second actuator of paragraph [0022] is being further specified. Hence, paragraph [0022] neither provides a basis for the amendment of claim 1 nor allows any conclusion as to whether any features can be extracted from claim 2 as originally filed.

3.3.11 In summary, the description and figures as filed similarly do not allow the skilled person to conclude that the subset of features from claim 2 as originally filed which has not been included in claim 1 is functionally and structurally unrelated to the other features of claim 2 as originally filed.

3.3.12 For these reasons, claim 1 comprises subject-matter not directly and unambiguously derivable from the application as filed. Hence, claim 1 does not comply with the requirements of Article 123(2) EPC.

4. *First to third auxiliary requests - admittance*

4.1 The Board did not admit the first to third auxiliary requests into the appeal proceedings.

4.2 These requests were filed after notification of the summons to oral proceedings and constitute an amendment of the respondent's appeal case which "shall, in principle, not be taken into account unless there are exceptional circumstances, which have been justified with cogent reasons" by the respondent (Article 13(2) RPBA 2020).

It lies in the very nature of appeal proceedings at the EPO that a Board of Appeal may reach a different conclusion than the department of first instance on an issue under dispute. Hence, the fact that the objection to the omission of the features relating to the type of

actuator was found convincing by the Board, although it had not been found convincing by the Opposition Division in its communication annexed to the summons to oral proceedings, might have been subjectively surprising for the respondent but cannot be regarded as surprising from an objective point of view. Moreover, the respondent's assertion that the first to third auxiliary requests prima facie overcame the lack of compliance with Article 123(2) EPC does not provide any justification for filing them at such a late stage of the proceedings. In conclusion, there are no exceptional circumstances which have been justified with cogent reasons.

- 4.3 The respondent submitted that it would be unfair to admit the appellant's objection under the RPBA 2007 but not to admit the respondent's requests addressing this objection under the stricter RPBA 2020.

The transitional provisions set out in Article 25 RPBA 2020 determine which version of the RPBA is applicable to which submissions. In the present case, Article 12(4)-(6) RPBA 2007 is applicable both to the statement of grounds of appeal by the appellant and to the respondent's reply to it, whereas Article 13(2) RPBA 2020 is applicable to any amendment to either of the parties' appeal cases made after notification of the summons to oral proceedings. There is thus no unequal or unfair treatment of the parties. It is not the party status but rather the point in time at which a submission by a party is made which determines the version of the RPBA applicable to it.

5. *Request for referral of a question to the Enlarged Board of Appeal*

5.1 At the end of the oral proceedings, the respondent requested that the following question be referred to the Enlarged Board of Appeal:

"Do - and if yes, under which criteria - [...] the 'Rules of procedure of the Boards of Appeal 2020' [give] an Appeal Board discretion to allow amendments filed by a patent proprietor in response to a preliminary opinion from the Board in order to overcome a new Art. 123(2) EPC objection that was not presented by the opponent before the Opposition Division and introduced - under the previous 'Rules of procedure of the Boards of Appeal' - into the proceedings for the first time by the appellant/opponent with the Grounds of the Appeal."

According to the respondent, such a referral is justified in view of Article 113(1) EPC and the principle of "equally fair treatment of the parties" (G 9/91, point 2 of the reasons).

5.2 Under Article 112(1) (a) EPC a Board of Appeal refers a question to the Enlarged Board of Appeal if it considers that a decision is required in order to ensure uniform application of the law or because a point of law of fundamental importance arises. Questions can be referred by a Board either of its own motion or following a request from a party.

5.3 Whether or not to refer a question is a discretionary decision by the Board (see Case Law of the Boards of Appeal, 9th edition 2019, V.B.2.3.2). In order for a referral to be admissible, the referred question must be relevant for deciding the case in question (see Case Law of the Boards of Appeal, 9th edition 2019, V.B. 2.3.3).

5.4 The Board refuses the respondent's request for referral for the following reasons:

Firstly, the proposed referral question is based on an erroneous assumption. Contrary to the respondent's assertion, the objection based on Article 123(2) EPC to the patent as maintained by the Opposition Division was not raised for the first time in the appeal proceedings (see point 3.1.3 of the reasons above). Accordingly, the answer to the proposed referral question would not be relevant for deciding the case in question.

Secondly, even if the assumption in the proposed referral question were correct, the proposed question has been formulated in such a manner that it can be answered without doubt by reference to the law. An amendment under Article 12(4) RPBA 2020 and an amendment to a party's appeal case under Article 13(1) RPBA 2020 - which can be an amendment to a patent application or patent - may, under both of these provisions, be admitted "at the discretion of the Board". Criteria for exercising this discretion are listed in both Article 12(4) RPBA 2020 and Article 13(1) RPBA 2020.

Although not specifically addressed in the proposed referral question, Article 13(2) RPBA 2020 does not remove a Board's discretion to admit an amendment of a party's appeal case either. The obligation expressed by "shall" is qualified by "in principle", and it is also up to the Board to assess whether "exceptional circumstances" exist. Moreover, under Article 114 EPC a Board may act of its own motion (paragraph 1) and may, i.e. has discretion to, disregard late-filed facts or evidence (paragraph 2). As the provisions of the EPC

rank higher in authority than the provisions of the RPBA, the latter are to be interpreted in a manner which is in conformity with the former (cf. J 14/19, point 1.9 of the Reasons). This means that, in view of Article 114 EPC, Article 13(2) RPBA is to be interpreted as conferring a certain degree of discretion on the Board. This interpretation is also confirmed by the explanatory remarks on Article 13(2) RPBA 2020 (see CA/3/19, points 59 and 60, and the table setting out the amendments to the RPBA and the explanatory remarks), according to which the Board may decide to admit the amendment "in the exercise of its discretion". As to the criteria, the explanatory remarks say that "[a]t 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".

Hence, in the Board's view, at no stage of the convergent approach under the RPBA 2020 is there an absolute prohibition of taking late-filed submissions into account.

The right to be heard and the principle of equal treatment do not give rise to a question of law of fundamental importance either. Articles 12 and 13 RPBA 2020 are applicable to both applicants/patent proprietors and opponents. Moreover, while some of the provisions of the RPBA 2020 apply only to submissions which are filed after a certain point in time, this is directly stipulated in Article 25 RPBA 2020 and does not violate the principle of equal treatment (see point 4.3 of the reasons above).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for referral to the Enlarged Board of Appeal is refused.

The Registrar:

The Chairman:



D. Hampe

M. Alvazzi Delfrate

Decision electronically authenticated