Internal distribution code:

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

Datasheet for the decision of 14 July 2021

Case Number: T 0466/20 - 3.4.02

Application Number: 08001713.0

Publication Number: 1953527

IPC: G01N15/12, G01N15/14, G01N33/49

Language of the proceedings: EN

Title of invention:
Sample analyzer and computer program product

Patent Proprietor:
SYSMEX CORPORATION

Opponents:
Beckman Coulter, Inc.
Beckman Coulter GmbH

Headword:

Relevant legal provisions:
EPC Art. 10(1), 10(2)(a), 14(3), 14(4), 19(1), 19(2), 107, 108, 111(1), 112(1)(a), 113(1), 114(1), 116, 117(1)(d)
EPC R. 3, 102, 103(1)(a), 106, 111(1), 111(2), 113(1), 140
RPBA 2020 Art. 11, 12(5), 20, 21

Keyword:

Admissibility of both appeals - (yes)
Objection under Rule 106 EPC - (dismissed)
Flaw in the decision under appeal - (yes) - change in the composition of the opposition division - written decision issued on behalf of an opposition division whose chairman was not present at the first oral proceedings and on the first day of the second oral proceedings
Remittal - (yes) - fundamental deficiency in first-instance proceedings
Remittal to an opposition division in a different composition and under the responsibility of another Director of the opposition division - (no)
Remittal to an opposition division in a different composition - (no)
Referral to the Enlarged Board of Appeal - (no)
Reimbursement of both appeal fees - (yes)

Decisions cited:

G 0005/91, G 0012/91, G 0008/95, G 0003/98, G 0002/99, G 0001/05, J 0005/81, J 0016/17, T 0244/85, T 0271/85, T 0390/86, T 0243/87, T 0251/88, T 0392/91, T 0506/91, T 0939/91, T 0433/93, T 0528/93, T 0960/94, T 0476/95, T 0628/95, T 0225/96, T 0613/97, T 1221/97, T 0862/98, T 0071/99, T 0699/99, T 0054/00, T 0434/00, T 0611/01, T 0837/01, T 0042/02, T 0400/02, T 0900/02, T 1081/02, T 0095/04, T 0515/05, T 1170/05, T 0825/08, T 2362/08, T 0810/09, T 0577/11, T 2076/11, T 2582/11, T 0135/12, T 1929/12, T 0266/14, T 1788/14, T 0786/15, T 1647/15, T 2475/17, T 2994/18

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

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

Case Number: T 0466/20 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 14 July 2021

Appellant I: (Patent Proprietor)	SYSMEX CORPORATION 5-1, Wakinohama-Kaigandori 1-chome, Chuo-ku Kobe-shi, Hyogo 651-0073 (JP)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Appellant II: (Opponent 2)	Beckman Coulter GmbH Europark Fichtenhain B 13 47807 Krefeld (DE)
Representative:	Maiwald Patent- und Rechtsanwaltsgesellschaft mbH Elisenhof Elisenstraße 3 80335 München (DE)
Party as of right: (Opponent 1)	Beckman Coulter, Inc. 250 S. Kraemer Boulevard Brea, CA 92821 (US)
Representative:	Maiwald Patent- und Rechtsanwaltsgesellschaft mbH Elisenhof Elisenstraße 3 80335 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 4 February 2020 concerning maintenance of the European Patent No. 1953527 in amended form.**

Composition of the Board:

Chairman	R. Bekkering
Members:	T. Karamanli
	F. J. Narganes-Quijano

Summary of Facts and Submissions

I. The patent proprietor and opponent 2 appealed against the interlocutory decision of the opposition division posted on 4 February 2020 regarding European patent No. 1 953 527 ("the patent").

II. The events in the course of the first-instance opposition proceedings up to the issuing of the contested decision that are relevant to the present decision are as follows:

(a) Opponent 1 filed a notice of opposition against the patent. Opponent 2 filed an intervention during the first-instance opposition proceedings and acquired the status of an opponent.

(b) The first oral proceedings took place on 4 March 2019 before the opposition division in a three-member composition. The minutes of the first oral proceedings were issued on 17 April 2019 and the corrected version thereof was issued on 19 July 2019. EPO Form 2309.2 of both versions contained the names and the handwritten signatures of the second examiner (minute-writer) and the then-chairman of the opposition division.

According to the minutes, it was discussed at the first oral proceedings whether the claims of the patent proprietor's Main Request (patent as granted) and Auxiliary Requests 1 to 3 met the requirements of the EPC. After the discussion and deliberation regarding the claims of these requests, the then-chairman informed the parties of

the conclusion of the opposition division. After he had informed the parties of the opposition division's conclusions regarding the claims of Auxiliary Request 3 and the requirements of novelty and inventive step, the parties agreed to continue in writing for the adaptation of the description. Then the chairman "*announced the decision that the claims of AR3 met the requirements of the EPC.*" Form 2309.2 (last page of the minutes) reads: "*After deliberation of the opposition division, the chairman informed the party/parties as follows: The proprietor is/are given a period of **2 months** to: to adapt the description to auxiliary request 3 (auxiliary request 16 as renumbered on 28-02-2019).*"

(c) After all the parties had filed written submissions, a summons to second oral proceedings was issued on 31 July 2019. Point 4 of the communication annexed to this summons reads:

"*A first Oral Proceedings was held on 04.03.2019. At the end of this proceedings the **chairman** announced that the Main request lacked novelty (Art. 54 EPC) and Auxiliary Requests 1 (= AR10) and 2 (= AR44) lacked clarity (Art. 84 EPC). Auxiliary Request 3 met the requirements of the EPC. Auxiliary Request 3 is Auxiliary request 16, corresponding to the fifth Auxiliary request as filed on 13.02.2018).*
*The **chairman** announced to continue in writing to put the description into conformity with Auxiliary Request 3.*"

Point 8 of that communication reads:

"*The only point open for discussion is the adaptation of the description. Basis for the discussion will be the submissions dated 08.03.2019 and 23.07.2019.*"

(d) The second oral proceedings commenced on 6 December 2019 before the opposition division in the same composition as at the first oral proceedings. According to the minutes issued on 19 December 2019, after discussion of the patent proprietor's multiple requests for adaptation of the description filed on 4 October 2019, the opposition division twice gave the patent proprietor the opportunity to file a further request for adaptation of the description to overcome the objections raised up to then. Thereupon, both opponents objected "*to the Opposition Division as a whole as being biased/ suspect of partiality in favor of the Patentee*". The oral proceedings were then adjourned on 6 December 2019 at 17.20 hrs.

On 8 December 2019, both opponents filed a further objection of suspected partiality against the then-chairman of the opposition division and requested that that chairman be replaced for the rest of the proceedings.

The second oral proceedings were resumed on 9 December 2019 at 13.30 hrs before the opposition division in a three-member composition with the same first and second examiners as before and a new chairman in place of the former chairman. The new chairman announced the decision of the Director in charge that the objection against the former chairman's impartiality was not justified. He also

informed the parties that, however, the statements made by the representatives of the opponents in the context of the request gave rise to the concern of inducing possible bias of the former chairman when continuing the proceedings, and that therefore the Director had decided, and the former chairman had voluntarily agreed, that the former chairman be replaced by the new chairman.

(e) The minutes of the second oral proceedings were issued on 19 December 2019. EPO Form 2309.2 contained the names and the handwritten signatures of the (same) second examiner (minute-writer) and the new chairman of the opposition division.

III. The written reasoned interlocutory decision under appeal was posted on 4 February 2020. EPO Form 2339 (Sheet 1) of the decision, which indicates the handwritten date of 21 January 2020, contained the names and the handwritten signatures of the two examiners who had participated on all days of the first and second oral proceedings and of the new chairman of the opposition division, who had participated in the oral proceedings on 9 December 2019 only. The Grounds for the decision (EPO Form 2916) were enclosed therewith.

In the Reasons for the decision (section II), subsection IIa entitled "***Procedural Matters***" contains the following "***Preliminary remark***":

"*The newly composed Opposition division adopted the interlocutory decision of the previously composed Opposition division from 04.03.2019.*"

In section III entitled **"DECISION"**, the opposition division summarised its conclusions as follows:

*"(1). The **Main Request** does not meet the requirements of Article 100(a) EPC in combination with Article 54 EPC. The content of **D2** and **D3** (as one single manual reference), **D6, D7, D19a-D19c, D20** and **D24,** and the prior use in view of **D2** and **D3** as evidenced by **D30** destroy its novelty.*

*(2). The **Auxiliary Request 1** does not meet the requirements of Article 84 EPC.*

*(3). The **Auxiliary Request 2** does not meet the requirements of Article 84 EPC.*

*(4). The **Auxiliary Request 3** as filed on 04.03.2019 meets the requirements of the EPC.*

*(5). The **adapted description Main Request** filed on 09.12.2019 meets the requirements of the EPC.*

*(6). The **adapted description AR1-AR7** filed on 04.10.2019, **adapted description AR8** filed on 06.12.2019 at 15:00 and **adapted description AR9** filed on 06.12.2019 filed at 17:00 are on file.*

*(7). **D44** is admitted into the proceedings.*

*(8). The letters of 03.12.2019 **(Opponents)** and 05.12.2019 **(Proprietor)** are admitted into the proceedings.*

*(9). The **note of protest** filed on 09.12.2019 by the **Opponents** is on file.*

(10). The request on impartiality of the Opposition division as a whole is not admitted into the proceedings.

(11). The Opposition division will not be enlarged with a legal member.

(12). The request to ***exchange Chairman due to impartiality*** *is not admitted into the proceedings.*

(13). The ***Chairman was exchanged*** *in order to avoid any concern of a bias when continuing the proceedings in the face of the details of the Opponent's request challenging the Chairman's impartiality.*

Therefore, the Opposition division concludes that, taking into consideration the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates meet the requirements of the EPC. The patent will be maintained in amended form on the basis of Auxiliary Request 3 as filed on 04.03.2019, amended description MR with amended paragraphs [0001], [0009], [0011], [0014], [0017] and deleted paragraph [0012] as filed during the oral proceedings on 09.12.2019 pursuant to Article 101(3)(a) EPC, provided that the requirements of Rule 82(2) EPC are fulfilled."

IV. By letter dated 16 June 2020, the patent proprietor filed a request for accelerated processing of the appeal and submitted reasons and documentary evidence in support thereof.

V. In a communication annexed to the summons to oral proceedings dated 26 June 2020, the board informed the

parties that it had decided to accelerate the appeal proceedings pursuant to Article 10(3) of the Rules of Procedure of the Boards of Appeal (RPBA 2020, see OJ EPO 2019, A63) and that it would issue a communication under Article 15(1) RPBA 2020 in due time.

VI. By its reply dated 28 October 2020, opponent 2 filed a copy of the decision of the German Regional Court of Mannheim dated 16 March 2020 (document D55) and a copy of the decision of the German Regional Court of Mannheim dated 10 July 2020 (document D56) and provided further arguments (see reply dated 28 October 2020, point 2).

VII. By its reply dated 28 October 2020, the appellant-patentee filed documents D50 and D51 and requested *inter alia* that these two documents be excluded from public inspection under Rule 144(d) EPC in conjunction with Article 1(2)(a) of the decision of the President of the European Patent Office dated 12 July 2007 concerning documents excluded from file inspection (hereinafter "President's Decision", originally published in OJ EPO 2007, Special edition No. 3, 125).

VIII. In a communication of 1 March 2021 pursuant to Rule 100(2) EPC, the board informed the parties that documents D50 and D51 had been provisionally excluded from file inspection in accordance with Article 1(3) of the President's Decision until a final decision on the request was taken.

IX. In a communication of 20 April 2021 under Article 15(1) RPBA 2020, the board gave its preliminary opinion. The board *inter alia* took the preliminary view that the appeal of the patent proprietor and that of opponent 2 were admissible.

X. By its letter dated 17 May 2021, the patent proprietor informed the board that it had filed the following further three submissions on that same day:

- The first submission, which notably contained "*a request for correcting, pursuant to Rule 140 EPC, the Opposition Division's written decision dated February 4, 2020*" and which was addressed to the opposition division in the new composition.
- The second submission, which contained "*a reiterated request for correcting the minutes dated December 19, 2019 of the oral proceedings held on December 6 and 9, 2019*" and which was addressed to the minute-writer, the former chairman and the new chairman of the opposition division.
- The third submission, which was addressed to the "*Director Opposition and Centralized Formalities, Directorate HBC The Hague/Berlin*" and which "*call[ed] upon*" the director "*to allow from an organisational point of view the members of the Opposition Division to act without delay on the two above mentioned submissions*".

The patent proprietor also raised an objection under Rule 106 EPC in relation to the last paragraph of point 7.3 of the board's communication under Article 15(1) RPBA 2020.

XI. A corrected version of the minutes of the second oral proceedings dated 19 December 2019 was issued on 29 June 2021. According to the corrected minutes, EPO Form 2309.2 of the minutes of the second oral proceedings of 6 December 2019 contained the names and handwritten signatures of the (same) minute-writer and the former chairman of the opposition division, and EPO

Form 2309.2 of the minutes of the second oral proceedings of 9 December 2019 contained the names and the handwritten signatures of the (same) minute-writer and the new chairman of the opposition division.

XII. Oral proceedings before the board were held on 13 and 14 July 2021.

At the oral proceedings on 14 July 2021, appellant II (opponent 2) submitted the following questions for referral to the Enlarged Board of Appeal:

"*(1) In case of procedural irregularities or a fundamental violation of a party's right to be heard under Art. 113 EPC during first instance, does a Board of Appeal have the power to remit the case to the first instance (Art. 11 RPBA) with an order for a new composition of the respective Opposition Division?*

(2) If the answer to the first question is yes, are there specific requirements for the order?

(3) Can such an order be based on the totality of the procedural circumstances or do they need specifically be linked to one or more members of the Opposition Division?

(4) Is a possible subjective bias of one or more members of the Opposition Division sufficient to allow for such an order, or is an objective bias required?

(5) Is a declaration of a Board of Appeal that a decision of an Opposition Division is null and void (legally invalid) due to at least one of said procedural irregularities and/or a violation to be heard provide sufficient reason for an order to re-hear

the case in a different composition of the respective Opposition Division?"

At the oral proceedings on 14 July 2021, the patent proprietor maintained its objection under Rule 106 EPC as raised in its letter dated 17 May 2021.

XIII. At the end of the oral proceedings on 14 July 2021, the parties submitted the following **final requests** in writing:

(a) **Requests of appellant I (patent proprietor):**

"*1. Opposition Division's interlocutory decision dated 4.02.2020 be set aside and both the opposition and intervention be rejected (patentee's statement of grounds of appeal dated 12.06.2020, p. 1; patentee's letter dated 28.10.2020, p. 1; Board's communication dated 20.04.2021, point 3.1), and the patent maintained based on one of the requests listed in the patentee's statement of grounds of appeal, pp. 1-2 (claims) and section 14 (specification);*

2. exclude D50 and D51 from public inspection (patentee's letter dated 28.10.2020, p. 54, section 5.2.1.3(a); Board's communication dated 20.04.2021, point 3.4, last sentence);

3. leave the question open as to whether D47, D48, D49, D65, and D66 are to be admitted into the proceedings until a discussion of patentability (see patentee's letter dated 28.10.2020, sections 5.2.1.2 and 5.4.2.5 regarding D47, D48, and D49);

4. auxiliarily, if request 3 is not granted, not to admit D47, D48, D49, D65, and D66 into the proceedings;

5. if the case is not remitted to the first instance, the scheduling of oral proceedings in the event that the Board would envisage any other decision than setting aside the first instance decision and rejecting the opposition and intervention."

(b) **Requests of appellant II (opponent 2):**

"• *It is requested to remit the case to the department of first instance to an Opposition Division in a different composition (i.e. the members of the present Opposition Division be replaced) and under the responsibility of another Director of the Opposition Division.*

• *It is requested to remit the case to the department of first instance to an Opposition Division in a different composition (i.e. the members of the present Opposition Division be replaced).*

• *In case the Board of Appeal considers to not remit the case to the first instance, it is requested to set the Opposition Division's Decision aside and to revoke the opposed patent in its entirety. As an auxiliary request oral proceedings are requested.*

• *It is requested to declare the Proprietor's appeal inadmissible.*

• *It is requested to set aside the decision of the Director of the Opposition Division in charge (Mr. Arnold van Putten) that the objection against the former Chairman (Brian Routledge) was not justified, to find that the objection was justified, and that the regulations of Art. 24(3) EPC and the Guidelines,*

Chapter E-XI and their legal consequences have to be applied.

• Further, in view of the fundamental violations of the first instance proceedings, reimbursement of the appeal fee is requested.

• It is requested to declare the "corrected version" of the minutes dated December 19, 2019 issued on June 29, 2021 as legally invalid and as an auxiliary request not admit them into the procedure (Art. 13(2) RPBA).

• In case the present Board does not intend to remit the case to the first instance department with an order to be re-heard in a different composition, it is requested to refer the referral questions submitted during oral proceeding on July 14, 2021 to the Enlarged Board of Appeal.

• Not to admit Auxiliary Requests 3A, 3B, 3C, 3D, and 3F as belated (Art. 12(4) RPBA).

• Not to admit the following auxiliary requests: 0A, 0B, 0C, 0D, 1, 1A, 1B, 1C, 1D, 1E, 2, 2A, 2B, 2C, 2D, 2F, 3, 3A, 3B, 3C, 3D, 3F, 4, 4A, 4B, 4C, and 4D due to lack [sic] *convergence (see Opponent's response to appeal grounds dated October 28, 2020, page 100, marginal 435)*

• Admit documents D46, D47, D48, D49 filed with Opponent's appeal grounds dated June 12, 2020.

• Admit documents D55 and D64 filed with Opponent's response to Patentee's appeal grounds dated October 28, 2020.

• Admit documents D66 and D67 filed with submission May 12, 2021.

• Admit documents D65 and D66 filed with our submission dated July 12, 2021.

• To not admit D46 filed with Patentee's grounds of appeal dated June 12, 2020.

• D50/D51 to be included in the EPO's public register."

(c) **Requests of the party as of right under Article 107, second sentence, EPC and respondent (opponent 1):**

"*• It is requested to remit the case to the department of first instance to an Opposition Division in a different composition (i e. the members of the present Opposition Division be replaced) and under the responsibility of another Director of the Opposition Division.*

• It is requested to remit the case to the department of first instance to an Opposition Division in a different composition (i.e. the members of the present Opposition Division be replaced).

• In case the Board of Appeal considers to not remit the case to the first instance, it is requested to set the Opposition Division's Decision aside and to revoke the opposed patent in its entirety. As an auxiliary request oral proceedings are requested.

• It is requested to declare the Proprietor's appeal inadmissible.

• It is requested to set aside the decision of the Director of the Opposition Division in charge (Mr. Arnold van Putten) that the objection against the former Chairman (Brian Routledge) was not justified, to find that the objection was justified, and that the regulations of Art. 24(3) EPC and the Guidelines, Chapter E-XI and their legal consequences have to be applied.

• It is requested to declare the "corrected version" of the minutes dated December 19, 2019 issued on June 29, 2021 as legally invalid and as an auxiliary request not admit them into the procedure (Art. 13(2) RPBA).

• Not to admit Auxiliary Requests 3A, 3B, 3C, 3D, and 3F as belated (Art. 12(4) RPBA).

*• Not to admit the following auxiliary requests: 0A, 0B, 0C, 0D, 1, 1A, 1B, 1C, 1D, 1E, 2, 2A, 2B, 2C, 2D, 2F, 3, 3A, 3B, 3C, 3D, 3F, 4, 4A, 4B, 4C, and 4D due to lack [*sic*] convergence (see Opponent's response to appeal grounds dated October 28, 2020, page 100, marginal 435)*

• Admit documents D46, D47, D48, D49 filed with Opponent's appeal grounds dated June 12, 2020.

• Admit documents D55 and D64 filed with Opponent's response to Patentee's appeal grounds dated October 28, 2020.

• Admit documents D66 and D67 filed with submission May 12, 2021.

• Admit documents D65 and D66 filed with our submission dated July 12, 2021.

• *To not admit D46 filed with Patentee's grounds of appeal dated June 12, 2020.*

• *D50/D51 to be included in the EPO's public register."*

XIV. The arguments of **appellant I (patent proprietor)**, where relevant to the present decision, may be summarised as follows:

Admissibility of opponent 2's appeal

Opponent 2's appeal was not admissible because its statement of grounds of appeal was deemed not to have been filed under Article 14(4), last sentence, EPC and therefore it did not comply with Article 108, third sentence, EPC.

The letters of opponent 2 dated 23 April and 12 June 2020, which jointly constituted its statement of grounds of appeal within the meaning of Article 108, third sentence, and Rule 99(2) EPC, were filed in two different official languages of the EPO (German and English) and thus did not comply with Rule 3(1) EPC.

At least those parts of opponent 2's submissions relating to topics which had been discussed in opponent 2's letter of 23 April 2020 and in opponent 2's letter of 12 June 2020 should not be admitted into the appeal proceedings in accordance with Article 12(5) RPBA 2020. Since these parts had been discussed twice, they were not concisely set out and hence did not comply with Article 12(3), second sentence, RPBA 2020. If these submissions by opponent 2 were admitted into the appeal proceedings, the patent

proprietor and the board would have to study two sets of submissions on the same topics in two different languages, with possibly overlapping (i.e. redundant and thus unconcise) and/or diverging (i.e. inconsistent and thus unclear) arguments.

Admissibility of the patent proprietor's appeal

The patent proprietor was adversely affected by the decision under appeal under Article 107, first sentence, EPC, since the opposition division had refused the patent proprietor's Main Request and Auxiliary Requests 1 and 2 (minutes dated 19 December 2019, section 93; decision under appeal, section 54). The Main Request and Auxiliary Requests 1 and 2 discussed during the oral proceedings held on 4 March 2019 had always been maintained by the patent proprietor, and this had been well understood by the opposition division, as could be seen from the minutes dated 19 December 2019, section 91 ("*(...) PROP (...) confirmed the requests on file*"), followed by item 93, first three hyphens, explicitly referring to the Main Request and Auxiliary Requests 1 and 2 discussed on 4 March 2019, as well as from the decision dated 4 February 2020 itself, section 54. Opponent 2, which was represented during the oral proceedings on 9 December 2019, had heard the patent proprietor confirming the requests on file (minutes dated 19 December 2019, item 91) and then the chairman referring explicitly to them and announcing decisions on the Main Request and Auxiliary Requests 1 and 2, but opponent 2 had not intervened at that point in time. If opponent 2 had believed that the patent proprietor's Main Request and Auxiliary Requests 1 and 2 were no longer on file at that point in time, it could, and should, have

intervened by requesting a clarification or a correction (for example under Rule 140 EPC) of the decisions which the chairman had announced.

The term "Main request" used in the minutes dated 19 December 2019, section 3.1, first hyphen merely referred to the main request for the adaptation of the description, and did not affect the patent proprietor's Main Request and Auxiliary Requests 1 and 2 discussed during the oral proceedings held on 4 March 2019. In support of this submission, reference was made to: the corrected minutes dated 19 July 2019, point 5.38, last sentence; the communication accompanying the summons dated 31 July 2019, points 4 and 8; the patent proprietor's letter dated 4 October 2019 (page 9, last paragraph; page 10, last two lines, and page 16); and the minutes dated 19 December 2019 (section 1, last sentence; sections 3.1, 25, 35, 36 and 40; section 70, first and third sentences; section 71, first sentence; and sections 77, 80, 83, 86 and 89).

In addition, surrender of a substantive right in general, and withdrawal of substantive requests in particular, could not simply be presumed (G 1/88, point 2, last sentence, and point 3 of the Reasons; T 1157/01, point 6 of the Reasons, third paragraph; T 388/12, point 4 of the Reasons).

Opponent 2's request formally to correct the opposition division's interlocutory decision dated 4 February 2020 by replacing "Auxiliary Request 3" with "Main Request" was inadmissible because it was not within the board's competence to make formal corrections to the first-instance department's decision (G 8/95, point 3.4 of the Reasons; T 810/09, point 1.5, first paragraph, second sentence, of the Reasons), and the requested

correction was not directed to a linguistic error, an error of transcription or an obvious mistake anyway (Rule 140 EPC).

It was unnecessary to hear the members of the opposition division as witnesses as requested by opponent 2.

Patent proprietor's objection under Rule 106 EPC

The second sentence of the last paragraph of point 7.3 of the board's communication under Article 15(1) RPBA 2020 ("*This seems to constitute a substantial procedural violation.*") was a preliminary opinion of the board (as was clear from the use of the term "seems"). By contrast, the first sentence ("*For the above reasons, the minutes of the oral proceedings held from 6 to 9 December 2019 violate Rule 124(3) EPC.*") was so emphatic that a reasonable reader might understand the statement to mean that the board had already effectively decided on this point without hearing the patent proprietor on it at the oral proceedings, thereby violating the patent proprietor's right to be heard under Article 113(1) EPC. It followed from Article 112a(2)(c) EPC that the occurrence of a fundamental violation of Article 113(1) EPC was a valid ground for raising an objection under Rule 106 EPC.

Change in composition of the opposition division during opposition proceedings - flaw in the decision under appeal

The decision under appeal did not suffer from any formal deficiency. In particular, there was no formal deficiency in relation to the authentication of the

decision under appeal in accordance with Rule 113(1) EPC.

The former chairman of the opposition division asked both to step down as chairman and to be discharged from his duties and responsibilities as a member of the Opposition Division, and this request was accepted by his Director in charge. Since the former chairman had been relieved of his duties and responsibilities on the morning of 9 December 2019, he no longer had the duty to sign the decision. As of 9 December 2019, the new chairman was the "employee responsible" within the meaning of Rule 113(1) EPC and thus entrusted with all the duties and responsibilities of the former chairman, including the duty to sign the written decision dated 4 February 2020. The fact that the former chairman had not signed the decision under appeal therefore did not violate any procedural rule of the EPC. According to Rule 111(1), first sentence, EPC, if oral proceedings were held before the opposition division, the decision could be given orally, and according to Rule 111(1), second sentence, EPC the decision should subsequently be put in writing and notified to the parties. However, it was not clear from Rule 113(1) EPC who was actually responsible for the decision of an opposition division. Nor did Rule 113(1) EPC require all three members of the opposition division to sign the decision. The Notice from the European Patent Office dated 27 March 2020 on electronic authentication of decisions was issued after the contested decision and was therefore not relevant here.

In addition, in accordance with decisions G 12/91, point 2, second and third sentences of the Reasons, and T 577/11, point 3.1, second paragraph of the Reasons, all interlocutory decisions given orally at the first

oral proceedings by the previously composed opposition division had become effective for and binding on the newly composed opposition division by virtue of being pronounced. It had also been clear to all parties that the purpose of the second oral proceedings was to discuss the adaptation of the description, and nothing else. The listing of the decisions in point 93 of the minutes dated 19 December 2019 could not change this because this listing was not meant to cover only the decisions given orally at the second oral proceedings by the newly composed opposition division but also those given at the first oral proceedings by the previously composed opposition division. It was also clear from the decision under appeal that the newly composed opposition division had neither created nor contributed to the interlocutory decisions of the previously composed opposition division. The newly composed opposition division had expressly stated in the decision under appeal that it had "*adopted the interlocutory decision of the previously composed Opposition division from 04.03.2019*". In support of this, reference was made to points 57 and 61 of the decision under appeal, point 5.38 of the (corrected) minutes dated 19 July 2019, and point 70 of the minutes dated 19 December 2019. Since the operative parts of the interlocutory decisions pronounced by the previously composed opposition division had evidently been binding on the newly composed opposition division, it was clear that the term "adopted" used in points 57 and 61 of the decision under appeal also meant that the newly composed opposition division had adopted the reasons for all the interlocutory decisions given by the previously composed opposition division. Thus, in the decision under appeal, the reasoning for all the interlocutory decisions given at the first oral proceedings and up to 9 a.m. of the second oral

proceedings on 9 December 2019 came from the previously composed opposition division, whereas the reasoning for all the other decisions came from the newly composed opposition division.

There was no indication or evidence that the new chairman had influenced or otherwise contributed to those parts of the final written decision containing the reasons for the interlocutory decisions given by the previously formed opposition division. On the contrary, it was clear from the wording of the passage in question in the decision under appeal that he had not done so. Furthermore, the new chairman had to be considered to have acted in accordance with Article 14(1) of the EPO Service Regulations for permanent and other employees, i.e. to have acted honestly and truthfully at all times. In case of doubt, the burden of proof would have been on the opponent.

Further, the procedure which the opposition division had adopted in the present case for authenticating the written decision under appeal was in full conformity with the procedure followed in decision T 699/99. The approach approved in decision T 699/99 was also applicable to the first-instance proceedings. The newly composed opposition division had effectively proceeded in the same way as the board of appeal in case T 699/99. Thus, the approach taken in the present case did not violate any provisions of the EPC. If the board had had doubts as to the correctness of the decision under appeal in view of decision T 699/99, it should have contacted the department of first instance to investigate of its own motion under Article 114(1) EPC (see decisions T 225/96, T 837/01 and T 266/14).

Decision T 699/99 was no more binding on the board than decision T 42/02, and the board was thus not required to consider decision T 42/02. However, it could consider decision T 699/99, which had been issued after decision T 42/02 and thus superseded it. Both decisions concerned the change of a member of the board of appeal or the opposition division. Where there was a change of the chair on a board of appeal, Rule 102 EPC did not require the former chair to authenticate the decision. The same applied to Rule 113(1) EPC, since the EPC provisions for the opposition division should not be interpreted more strictly than the provisions for a board of appeal. Rather, they should be interpreted pragmatically.

In addition, the decisions cited by opponent 2, i.e. T 42/02, T 243/87, T 390/86 and T 900/02, dealt with facts differing from those of the present case, so the conclusions reached in these cases were not applicable to the case at hand.

Remittal of the case to the department of first instance

Even if the board were to find that the written decision dated 4 February 2020 contained a formal deficiency, the board should exercise its discretion not to remit the case to the department of first instance because a purely formal deficiency was not a fundamental deficiency within the meaning of Article 11 RPBA 2020. Even if a formal deficiency were to be regarded as a fundamental deficiency, the question would arise whether there were exceptional circumstances for not remitting the present case to the department of first instance. Under Article 111(1),

second sentence, EPC there was no automatic remittal even in the case of a fundamental deficiency (see e.g. T 515/05, point 5.2, first paragraph; T 1647/15, reasons 3.1, last sentence) and this also applied under Article 11 RPBA 2020 (see e.g. T 2994/18 and T 786/15, point 4.2 of the Reasons). In the case at hand there were exceptional circumstances for not remitting the present case. Firstly, the opponents' arguments had been considered in the decision under appeal and thus no purpose would be served by remitting the case to the opposition division, which would most likely come to the same decisions on Auxiliary Request 3. These considerations were in line with those discussed for example in decisions T 515/05 and T 1929/12. Secondly, remittal would not serve the interests of justice in view of the circumstances of the present case. In that respect, decision T 1647/15 was referred to.

Remittal of the case to an opposition division in a different composition (i. e. the members of the present opposition division being replaced) and under the responsibility of another Director of the opposition division

The opponents' argument that the current Director of the opposition division might have been involved in the process of correcting the minutes of 19 December 2019 and the contested decision was not justified. The letter of 17 May 2021 sent to the current Director of the opposition division was for organisational reasons and nothing else. There was also no evidence that the Director had been involved in the correction of the minutes. Moreover, there was nothing wrong with the measures taken by the EPO’s Directorate "Operational Quality and Risk Management" and the EPO User Services.

Remittal of the case to an opposition division in a different composition (i. e. the members of the present opposition division being replaced)

According to the wording of Article 111(1) EPC, the case was to be remitted to "that" department, i.e. to the department that had been responsible for the decision under appeal, for further prosecution. This was the default situation. However, if the opponents' arguments were to be accepted, then remittal of a case to the opposition division in unchanged composition would never be possible in the event of procedural violations. In the present case, there were also no indications to assume bias on the part of the members of the opposition division. Nor were there any reasonable grounds to believe that the opposition division, in the same composition, would have difficulty in re-hearing and re-deciding the case without being tainted by its previous decision and circumstances.

Referral to the Enlarged Board of Appeal

There was no need for a referral to the Enlarged Board of Appeal.

Discretionary decision of the Director in charge on the objection of suspected partiality against the former chairman of the opposition division

The Director in charge did not exercise his discretion wrongfully as he had taken due account of the

circumstances of the case and had applied the "objective" test to assess whether those circumstances gave rise to an objective concern of partiality.

*XV. The arguments of **appellant II (opponent 2)** and of the **party as of right (opponent 1)**, where relevant to the present decision, may be summarised as follows:*

Admissibility of the patent proprietor's appeal

The patent proprietor's appeal was not admissible. The patent proprietor was not adversely affected by the decision under appeal since, according to the minutes dated 19 December 2019 of the oral proceedings held from 6 to 9 December 2019, the amended patent as maintained by the opposition division fully corresponded to the patent proprietor's main request.

In support of this objection, reference was made to sections 3, 3.1 and 70 to 74 of the minutes dated 19 December 2019. In addition to these sections, throughout the minutes it was clearly outlined that the subject of the discussion was always the Main Request, which according to section 3.1 was based on Auxiliary Request 3 as found allowable by the opposition division in the oral proceedings held on 4 March 2019 and the repeatedly updated description (see e.g. sections 19, 21, 35, 36, 77, 80, 83, 86 and 89 of the minutes dated 19 December 2019). In particular from sections 3.1 and 93 of these minutes it was clear that the subject of the new Main Request discussed throughout the oral proceedings held from 6 to 9 December 2019 was the claim set which had been discussed as Auxiliary Request 3 in the oral proceedings on 4 March 2019, as well as the repeatedly updated description discussed

during the oral proceedings held from 6 to 9 December 2019.

Accordingly, the interlocutory decision dated 4 February 2020 should be formally corrected in accordance with the patent proprietor's requests.

Moreover, by letter dated 10 January 2020, the patent proprietor had requested correction of item 3.1. of the minutes dated 19 December 2019 and had asked for confirmation that its previous requests (to maintain the patent as granted as well as further Auxiliary Requests 1 and 2) were explicitly maintained. This request for correction had been rejected by the opposition division in its decision dated 18 March 2020, confirming that in the opposition division’s opinion the minutes were correct and contained all essentials of the oral proceedings.

It was further requested that the members of the opposition division who took part in the oral proceedings held from 6 to 9 December 2020 be heard as witnesses pursuant to Article 117(1)(d) EPC in the event that the board had any doubts that the minutes of the oral proceedings were correct and that the patent proprietor was not adversely affected by the decision under appeal.

Admissibility of opponent 2's appeal

The board's preliminary opinion expressed in its communication under Article 15(1) RPBA 2020 that opponent 2's appeal was admissible was agreed with.

Patent proprietor's objection under Rule 106 EPC

The position taken by the board in the preliminary opinion that the minutes violated Rule 124(3) EPC corresponded exactly to the patent proprietor's opinion explicitly expressed in its submissions previously filed with a request for correction of the minutes dated 19 December 2019.

Change in composition of the opposition division during opposition proceedings - flaw in the decision under appeal

The decision under appeal was not legally valid as it was not in line with the EPC and the principles developed by the established case law (see decisions T 390/86, T 243/87, T 699/99, T 42/02 and T 900/02; and section III.K.1.1. of the Case Law Book).

The written decision under appeal contained arguments and reasons regarding the issues which had been discussed at the first and the second oral proceedings. However, the new chairman had only participated in the second oral proceedings on 9 December 2019 in place of the former chairman and had discussed and deliberated on only the adaptation of the description, but had not participated in the oral proceedings held on 4 March 2019 and on 6 December 2019. The written reasoned decision under appeal (Form EPO 2339) had not been signed by the former chairman but only by the new chairman and the two examiners who had participated on all days of both oral proceedings. This constituted a fundamental violation of procedural requirements, since it was established case law that a signed written decision issued after oral proceedings should be the decision of those members of the department of first instance who had conducted the oral proceedings. In the

event that one member of the opposition division had been replaced after the oral proceedings, there was no longer any guarantee that the written reasoned decision which was authenticated subsequently accurately reflected the point of view of all members who had taken part in the respective oral proceedings (see e.g. decisions T 390/86 and T 243/87, and further case law cited in section III.K.1.1 of the Case Law Book). However, it had to be clear to the parties and to the public who of the deciding body participated in which part(s) of a written decision. It was established case law that when a member of a deciding body was substituted after or during oral proceedings, a decision had not only to be taken with the contribution of the substituted member and, after his substitution, with the contribution of the new member, but the written reasoned decision had also to reflect the actual situation. According to decision T 42/02, point 8 of the Reasons, it also had to be ensured that the written reasoned decision for that part of the oral proceedings in which the former composition had been conducting the oral proceedings was not affected by a new member who had not participated in (parts of) the oral proceedings (i.e. on March 4 and December 6, 2019 in the present case). The view of the new chairman of the opposition division on the subject-matter discussed at the previous oral proceedings had not been communicated to the parties and the parties had not been given a chance to comment thereon, thereby contravening Article 113 EPC.

According to points 5.37 and 5.38 of the minutes dated 19 July 2019, the claims of Auxiliary Request 3 were considered to comply with the requirements of the EPC and the description had yet to be adapted. Therefore, no binding decision within the meaning of Article

101(3)(a) EPC had been given at the first oral proceedings. Further, interlocutory decisions did not terminate the proceedings and could only be appealed together with the final decision, unless separate appeal could be made (Guidelines for Examination in the European Patent Office, E.X.3). The opposition division was legally bound by its interlocutory decision on the claims only. Therefore, the decision was fragmented. However, there was no legal basis for doing so. Therefore, in the case at hand, no binding interlocutory decision had been announced at the first oral proceedings, so a new hearing before the new opposition division on all issues would have been necessary. However, if a binding interlocutory decision had been announced by the former opposition division, it and the new opposition division would have had to follow decision T 42/02, point 9 of the Reasons, and issue and sign a separate written decision, i.e. two written decisions would have had to be issued. Instead, a single written decision had been issued and signed by the newly composed opposition division, although the new chairman of the opposition division had not participated in all days of the two oral proceedings. Since the decision under appeal with respect to the findings during oral proceedings did not refer to the respective composition of the opposition division at the point in time of those findings, it was not clear to the parties and to the public to what extent the new chairman had also contributed to the written reasons of decisions which had been taken by the former opposition division. The situation at hand was therefore comparable to that in case T 42/02. In addition, the new chairman, acting as senior expert for opposition proceedings, had claimed in point 61 of the decision under appeal that his knowledge of the case was not limited to the time invested in the morning of

9 December 2019. In other words, it was obvious that the new chairman had been involved somehow in the proceedings before 9 December 2019. This statement showed that the new chairman did not have a fresh view on the case, but rather relied on (possibly biased information from the former chairman and) information from the opposition division in the former composition.

The "adoption" of the former opposition division's interlocutory decision of 4 March 2019 by the newly composed opposition division (see item 57 of the contested decision) did not remedy this situation.

The patent proprietor argued that the former chairman had no longer been the "responsible employee" for the oral proceedings he had chaired. This argument had to fail. The director of the opposition division in charge could not release the former chairman from the duties and responsibilities in respect of the oral proceedings he had chaired. The former chairman would still have been responsible for issuing the written decision on the aspects where he had chaired the hearing.

In case T 699/99, the situation was different from that in the case at hand and therefore decision T 699/99 did not apply here. Rather, decision T 42/02 applied and could not have been superseded by decision T 699/99. However, neither of these decisions was binding on the board, but provided guidance with respect to the interpretation of the relevant EPC provisions.

Decision T 699/99 concerned the replacement of the legal member of a board of appeal after the first oral proceedings, a member who was no longer available. In the case at hand, however, the former chairman would have been available to draft and sign the reasoned

decision for that part of the opposition proceedings where he had acted as chairman. In the case at hand, no interlocutory decision had been taken as far as Auxiliary Request 3 was concerned either because the statement in the minutes dated 19 July 2019 was not an interlocutory decision and adaptation of the description was still required. Further, the approach taken by the board of appeal in T 699/99 made it abundantly clear that the new legal member of the board had not taken part in the drafting of the written reasons for the interlocutory decision, where he had not been part of the panel. However, in the case at hand, there was nothing in the decision under appeal to indicate that the new opposition division had followed the approach taken in T 699/99. Even if decision T 699/99 were applicable here, there was no such indication in the decision under appeal, unlike in the decision in case T 699/99. The new opposition division had simply "adopted" the decisions taken by the opposition division in the former composition. However, there was no indication or hint in the decision under appeal that the new chairman had not taken part in the discussion and/or drafting on all subject-matter of the opposition case in the written reasons. Therefore, it could not be ruled out from the written decision that the new chairman had influenced the written reasons for the part of the oral proceedings held on 4 March 2019 and 6 December 2019 as well, and that the reasons for the decision might not have been formed on the occasion of the respective oral proceedings on 4 March 2019 and 6 December 2019, nor that they had been communicated to the parties on said occasion(s). Moreover, the patent proprietor's arguments were without merit in respect of decision T 699/99. It did not matter whether the new chairman had acted honestly or whether he had been aware of decision T 699/99. It is undisputed that he

had signed the written decision and was thus responsible for the content of the whole written decision in accordance with Rule 113(1) EPC.

In addition, Rule 102 EPC did not apply to decisions of a first-instance department, but Rule 113(1) EPC did. In accordance with Rule 113(1) EPC, a single signature was not sufficient because the "employee responsible" was each and every member of the opposition division under Article 19(2) EPC, and therefore decisions of an opposition division had to be signed by all the members of the opposition division who were responsible for the content of the decision. This was also confirmed in the Notice from the European Patent Office dated 27 March 2020 on electronic authentication of decisions. In view of this, it was suggested that the board refer questions to the Enlarged Board of Appeal if it considered that a decision of an opposition division did not require the signature of each of its three members.

Nor was there a signature missing in the case at hand. The decision under appeal was merely signed by an opposition division in an incorrect composition as far as the issues discussed at the first oral proceedings and on the first day of the second oral proceedings were concerned.

Remittal of the case to the department of first instance

In view of the present fundamental deficiencies within the meaning of Article 11 RPBA 2020, a remittal was necessary.

Remittal of the case to an opposition division in a

different composition (i e. the members of the present opposition division being replaced) and under the responsibility of another Director of the opposition division

After remittal of the case, the current Director responsible for the opposition division should not be involved in or associated with the opposition division or the determination of its composition. In a personal letter of 17 May 2021 to the Director, the patent proprietor had personally requested him to support the members of the opposition division to act without delay on the patent proprietor's requests for correction of the minutes of 19 December 2019 and the contested written decision. In view of the measures taken by the EPO's Directorate "Operational Quality and Risk Management" and the EPO User Services in relation to this letter, it could not be ruled out that the current Director of the opposition division might have been involved in the process of "correcting" the minutes. Therefore, any possible influence of the current Director on a possible re-hearing should be ruled out.

Remittal of the case to an opposition division in a different composition (i e. the members of the present Opposition Division being replaced)

Reference was made in particular to decision T 433/93, but also to decisions T 611/01, T 95/04 and T 2362/08. If the decision under appeal and the minutes in the case at hand were not legally valid, a remittal based thereon already justified ordering a different composition. In addition, there were reasonable grounds to suspect that the very same composition of the opposition division would have difficulties in re-hearing and re-deciding the case at hand without being

tainted by its previous decision and circumstances. This was even more true since a re-hearing would not be based on a rather "formal" error, e.g. that a submission had not been forwarded to the members of the division as in case T 71/99 and a possible different decision could be reasoned by different facts. In the present case, the re-hearing would have to take place before an opposition division where each member had committed several substantial procedural violations and violations of a party's right to be heard, even after the appeal was already pending, as shown by the corrected minutes of 19 December 2019, which had been issued on 29 June 2021. Thus, there was a clear link between the procedural irregularities and all the members of the opposition division. In such a situation, the party that had argued that procedural violations and violations of the right to be heard had occurred would certainly be in a disadvantageous position for the re-hearing. A fair re-hearing could thus not be expected. There was also the risk that the present opposition division that had been involved in the issuing of the written decision under appeal would only try to remedy the procedural violations which had occurred, but not re-hear the case with the necessary neutral mindset. Therefore, as was decided in case T 433/93, for the proper administration of justice alone, and to avoid any possibility that the previous composition of the opposition division was tainted by its previous decision, the case should be re-heard by an opposition division in a different composition.

Finally, as held in decision T 2475/17, point 3.1.5 of the Reasons, by ordering a change in the composition of the opposition division the board would not put itself in the place of the EPO's President or his representatives, as the board would not order the exact

composition of the opposition division, but would allow the department of first instance to select the new members of the opposition division according to its rules, while at the same time ensuring by the order that the parties had a chance to have a fair and lawful re-hearing of the case.

Referral to the Enlarged Board of Appeal

In the event that the board had doubts as to whether or not the boards of appeal had the competence to remit the case with the order to re-hear the case in a different composition, or the board had doubts regarding the standards to be applied for such an order, the questions submitted during the oral proceedings before the board should be referred to the Enlarged Board of Appeal for clarification and application of uniform standards and interpretation of the law.

Discretionary decision of the Director in charge on the objection of suspected partiality against the former chairman of the opposition division

In deciding on the objection of suspected partiality against the former chairman of the opposition division, the Director in charge had wrongfully exercised his discretion, primarily because he had ignored that the requirement of Article 24(3) EPC applied not only to so-called "objective" bias but also to "subjective" bias.

Reasons for the Decision

1. *Admissibility of the patent proprietor's appeal*

The patent proprietor's appeal is admissible since it complies with Articles 106 to 108 and Rule 99 EPC. It meets in particular the requirements of Article 107, first sentence, EPC for the following reasons:

1.1 Under Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. A party is adversely affected within the meaning of Article 107 EPC if the decision under appeal does not accede to that party's requests (see decision T 244/85, OJ EPO 1988, 216, point 3 of the Reasons, and further decisions cited in "Case Law of the Boards of Appeal of the European Patent Office" (in the following "Case Law"), 9th edition 2019, V.A.2.4.2 a)). The relevant issue in this respect is the difference between the formally-submitted requests and the order of the appealed decision (T 434/00, point 3 of the Reasons). A party is therefore adversely affected if the decision under appeal does not accede to its main request or to auxiliary requests preceding the allowed auxiliary request (see e.g. decision T 392/91). Whether this is the case has to be assessed by comparing the final requests submitted at the first-instance proceedings with the substance of the decision under appeal (see for example decisions T 244/85, *supra*, point 4 of the Reasons, and T 506/91, point 2.3 of the Reasons).

1.2 In the case at hand, the opposition division decided that the patent proprietor's Main Request did not meet the requirements of Article 54 EPC (see Reasons for the decision under appeal, section II(b), point 66, and in particular point 66.6.8, last paragraph), and that

claim 1 of Auxiliary Requests 1 and 2 did not meet the requirements of Article 84 EPC (see Reasons for the decision under appeal, section II(b), point 69, and in particular point 69.3, last sentence, and section II(b), point 71, and in particular point 71.3, last sentence). Therefore, according to its reasons, the decision under appeal did not accede to the patent proprietor's Main Request and Auxiliary Requests 1 and 2 (see also section III, points (1). to (3).) Accordingly, in view of the reasons for the decision under appeal, the patent proprietor is adversely affected within the meaning of Article 107 EPC, even if the opposition division found that the lower-ranking "Auxiliary Request 3 as filed on 04.03.2019" and the "adapted description Main Request" met the requirements of the EPC (see Reasons for the decision under appeal, section III, points (4). and (5).).

1.3 It is also established case law that a party is not adversely affected by the decision under appeal if the patent proprietor withdraws his main request or preceding auxiliary requests and agrees to the allowed auxiliary request (see, for example, decisions T 506/91, T 528/93, T 613/97, T 54/00 and T 434/00).

1.4 The opponents essentially argued that, in view of the minutes dated 19 December 2019, the subject of the discussion during the oral proceedings from 6 to 9 December 2019 was always the Main Request, which according to section 3.1 of the minutes was based on Auxiliary Request 3 as found allowable by the opposition division in the oral proceedings of 4 March 2019 and the repeatedly updated description.

1.5 However, it is clear from the file, and in particular from the decision under appeal, the (corrected) minutes

sent on 19 July 2019 and the minutes sent on 19 December 2019, that the patent proprietor had not withdrawn its Main Request and Auxiliary Requests 1 and 2 and that these requests had been discussed during the oral proceedings on 4 March 2019.

1.6 In the decision under appeal, the requests on which the decision is based are referred to in section I, point 54. According to point 54.1, the Main Request consists of the description, claims and drawings of the patent specification, i.e. of the patent as granted. According to point 54.2, Auxiliary Request 1 consists of the description and drawings of the patent specification and of the claims 1 to 19 as filed by letter dated 23 February 2018, these claims being footnoted as follows: "*(*) Claim request renumbered as AR10 on 28.02.2018*". According to point 54.3, Auxiliary Request 2 consists of the description and drawings of the patent specification and of the claims 1 to 19 filed during the oral proceedings on 4 March 2019. According to point 54.4, Auxiliary Request 3 consists of description pages 4-11 of the patent specification, pages 2, 3 received on 13 March 2019 with the letter of 8 March 2019, and description paragraphs 1, 9, 11, 14 and 17 filed during the oral proceedings on 9 December 2019, the previous paragraph 12 being deleted; claims 1 to 16 filed during the oral proceedings on 4 March 2019; and the drawings of the patent specification. Point 55 states that the claims under consideration are attached to the decision under appeal in its Annex F. Annex F comprises *inter alia* claims according to a Main Request and Auxiliary Requests 1 to 3.

1.7 Point 5.39 on the last page of the minutes dated 19 July 2019 reads: "*Upon invitation of CH, PROP indicated that all other requests on file were*

maintained, with the main request and AR1-AR2 as discussed during the oral proceedings ...". The minutes dated 19 December 2019 clearly indicate that the only subject for discussion during the oral proceedings held from 6 to 9 December 2019 was the adaptation of the description to the claims of Auxiliary Request 3 (see e.g. point 1 of these minutes), and that the basis for this discussion was the amended description according to the various main and auxiliary requests filed by the patent proprietor (see e.g. points 3.1, 8, 9, 21, 25, 40, 45, 62, 70, 73, 74, 75, 77, 80, 83 and 89 of these minutes). This is also supported by Annexes 1, 2 and 6 to the minutes dated 19 December 2019. Further, according to point 93 of the minutes posted on 19 December 2019, the decisions announced by the chairman concerned the Main Request and Auxiliary Requests 1 and 2 filed during the oral proceedings on 4 March 2019.

There is nothing in the minutes dated 19 December 2019 to clearly suggest that the patent proprietor would have withdrawn any of its higher-ranking requests which had been discussed during the oral proceedings on 4 March 2019. In particular, this cannot be inferred from the passage in point 3.1. of the minutes dated 19 December 2019, as this passage must be seen in the context of the entire course of the first-instance proceedings.

1.8 In view of the above, the opposition division rejected the Main Request filed by the patent proprietor, as well as Auxiliary Requests 1 and 2, because the claims of these requests did not meet the requirements of the EPC. It considered the patent as amended to meet the requirements of the EPC only to the extent of the claims of "Auxiliary Request 3 as filed on 04.03.2019"

and the "adapted description Main Request". Hence the patent proprietor is adversely affected by the decision under appeal.

1.9 In this context, the board notes that the passages of the minutes posted on 19 December 2019 referred to above have not been amended in the corrected version of these minutes issued on 29 June 2021. The board also notes that opponent 2 had requested that the members of the opposition division who took part in the oral proceedings held from 6 to 9 December 2020 be heard as witnesses according to Article 117(1)(d) EPC in the event that the board had doubts about the correctness of the minutes of the oral proceedings and that the patent proprietor was not adversely affected by the decision under appeal. However, there was no reason to accede to this request, as the board does not doubt the correctness of the minutes dated 19 December 2019 with regard to the patent proprietor's requests and thus, for the reasons stated above, does not question whether the patent proprietor is adversely affected by the decision under appeal.

2. Admissibility of opponent 2's appeal

Opponent 2's appeal is admissible since it complies with Articles 106 to 108 and Rule 99 EPC. It meets in particular the EPC language requirements and the requirements of Article 108, third sentence, and Rule 99(2) EPC for the following reasons:

2.1 Article 14(4) EPC is not applicable in the present case, since this provision provides for cases where documents are filed in a non-official language of the EPO by persons benefiting from the "language privilege". Instead, Article 14(3) and Rule 3 EPC are

the relevant provisions for cases where an official EPO language other than the language of the proceedings is used for documents other than the application.

According to Rule 3(1) EPC, "*any party may use any official language of the European Patent Office*" in written proceedings. It cannot be deduced from this wording that only one official EPO language may be used in a document of a party that is not a patent application. There are also no indications of this in the other relevant provisions of the EPC. It is also common practice for parties in appeal proceedings to quote passages from other documents in their submissions, such as the statement setting out the grounds of appeal, which are written in a different official EPO language than their submissions.

2.2 The board notes that the first letter dated 23 April 2020 from opponent 2 is written in English and is headed "*Submission of documents for the Grounds of Appeal*". It contains as an attachment a copy of a document dated 13 March 2020 in German ("*Erwiderung auf den neuen Klageantrag vom 18. März 2019*") that had been submitted to the German Regional Court of Mannheim in parallel infringement proceedings. Although certain passages of this document are referred to in the letter dated 23 April 2020, the document submitted as an annex is considered as evidence of what was submitted by opponent 2 to the German Regional Court of Mannheim in the parallel infringement proceedings. According to Rule 3(3) EPC, documentary evidence may be filed in any language. Moreover, the title and the last sentence on page 1 of the letter dated 23 April 2020 indicate that this letter is rather to be seen as a cover letter for the submission of a document serving as evidence.

The second letter dated 12 June 2020 is headed "***Grounds of Appeal***" and contains opponent 2's requests and its detailed grounds of appeal. Therefore, this letter is the actual statement setting out the grounds of appeal as announced in the previous letter dated 23 April 2020 (see last sentence on page 1: "*We **will** refer to this document and its content in the Grounds of Appeal, which **will** be submitted within the time limit.*" (emphasis added by the board)).

2.3 In view of the above, opponent 2's statement of grounds of appeal meets the EPC language requirements and the requirements of Article 108, third sentence, and Rule 99(2) EPC. For similar considerations, the board sees no reason not to admit some parts of opponent 2's statement of grounds of appeal under Article 12(5) RPBA 2020 (which is applicable in accordance with Article 25(1) and (2) RPBA 2020), as requested by the patent proprietor.

3. *Patent proprietor's objection under Rule 106 EPC*

3.1 In response to the board's communication under Article 15(1) RPBA 2020, the patent proprietor raised an objection under Rule 106 EPC. It submitted that its right to be heard under Article 113(1) EPC had been violated because the board had already effectively decided in the last paragraph of point 7.3 of its communication under Article 15(1) RPBA 2020 that the minutes of the oral proceedings held from 6 to 9 December 2019 contravened Rule 124(3) EPC, without having heard the patent proprietor in that regard during oral proceedings.

3.2 The board does not share the patent proprietor's view. It is evident from the overall context of the board's

communication under Article 15(1) RPBA 2020 that the board did not conclude or decide that the minutes of the oral proceedings held from 6 to 9 December 2019 did not meet the requirements of Rule 124(3) EPC.

The following general remark is made right at the beginning of the board's communication:

"*This communication is sent pursuant to Article 15(1) of the revised version of the Rules of Procedure of the Boards of Appeal (RPBA 2020, OJ EPO 2019, A63), which applies in the present case in accordance with Article 25(1) RPBA 2020. Any opinions expressed herein are provisional and do not bind the board as regards its final decision. The purpose of this communication is to set out some of the issues to be discussed at the oral proceedings before the board.*"

From this general remark alone, it is clear that the subsequent remarks in the communication do not contain any decisions by the board.

Further, it is also quite clear from the specific section 7 entitled "*Signing of the minutes posted on 19 December 2019 of the oral proceedings held from 6 to 9 December 2019*" that the board's opinion on this issue was a provisional one. In point 7.3 of the board's communication, the first paragraph reads: "*The **board** is of the preliminary view that the minutes of the oral proceedings held from 6 to 9 December 2019 do not comply with the provisions of the EPC.*" Again, it is evident from this paragraph that the board had only formed a preliminary opinion on the question of whether the minutes at hand met the requirements of the EPC, including those of Rule 124(3) EPC.

Point 7.3, last paragraph, of the board's communication reads:

"*For the above reasons, the minutes of the oral proceedings held from 6 to 9 December 2019 violate Rule 124(3) EPC. This seems to constitute a substantial procedural violation.*"

In light of the general remark and the first paragraph of point 7.3, this last paragraph of point 7.3 cannot be understood by a reasonable reader as containing a decision of the board, but rather as part of the board's preliminary opinion on the question of whether the minutes met the requirements of the EPC.

3.3 In view of the above, the patent proprietor's right to be heard under Article 113(1) EPC had been observed. Therefore, the patent proprietor's objection under Rule 106 EPC was dismissed.

4. *Change in composition of the opposition division during opposition proceedings - flaw in the decision under appeal*

In the case at hand, on no occasion was the opposition division composed of more than three technically qualified examiners. Thus Article 19(2), first half-sentence, EPC was complied with in the course of the first-instance proceedings. The other requirements of Article 19(2), first sentence, EPC were also met. This was not disputed by the parties.

It is also not in dispute that the composition of the three-member opposition division changed during the second oral proceedings held from 6 to 9 December 2019.

It is also undisputed that the chairman whose name and signature are indicated in the contested interlocutory decision was a member of the opposition division only on 9 December 2019, the last day of the second oral proceedings, whereas previously another person had been chairman and member of the opposition division. Thus, the question is whether the written reasoned decision under appeal posted on 4 February 2020, which states the name of and is signed by the new chairman of the opposition division and the first and second members, who had both participated on all days of the first oral proceedings and of the second oral proceedings, complies with the requirements of the EPC.

4.1 Under Rule 113(1) EPC, EPO decisions must be signed by, and state the name of, the employee responsible. Where the decision, as in the case at hand, is produced by the employee responsible using a computer, Rule 113(2), first sentence, EPC provides that the signature may be replaced by an EPO seal. First-instance decisions on oppositions fall within the responsibility of the opposition division (Article 19(1) EPC), whose composition must meet the requirements of Article 19(2) EPC. To allow verification by the parties and the public that all the members of the opposition division have assumed responsibility for the content of their decision, it is the practice of the EPO that the authenticity of the sealed decision under appeal can be verified by inspecting the accompanying form (EPO Form 2339) containing the handwritten signatures of the employees of the opposition division concerned, i.e. of each member of the opposition division (see also point 2 of the Notice from the European Patent Office dated 27 March 2020 concerning electronic authentication of decisions and other documents relevant to the decision-making process (OJ EPO 2020, A37), which confirms

this). In view of this clear legal situation, there is no reason to accede to opponent 2's suggestion to refer questions regarding the requirement to sign to the Enlarged Board of Appeal.

The board endorses the view expressed in decision J 16/17, point 2.3 of the Reasons, that the requirement in Rule 113(1) EPC is not a mere formality but an essential procedural step in the decision-making process. The requirement of Rule 113(1) EPC aims to prevent arbitrariness and abuse and to ensure that it is verifiable that the competent body has taken the decision, and it is therefore an embodiment of the rule of law. As a consequence, a violation of the requirement pursuant to Rule 113(1) EPC amounts to a substantial procedural violation and renders the decision flawed (see for example J 16/17, point 2.3 of the Reasons, and T 2076/11, points 4 and 5 of the Reasons).

4.2 It clearly follows from Article 19 EPC that the power to examine and decide on oppositions to a European patent must always be exercised personally by the examiners appointed for that purpose, and it is clear from the provisions of Articles 113(1) and 116 EPC that this personal exercising of said power must be apparent to the parties and the public (see decision T 390/86, OJ EPO 1989, 30, point 7 of the Reasons). It is established case law that a written reasoned decision pursuant to Rule 111(1), second sentence, and (2) EPC issued after oral proceedings should be the decision written on behalf of, and represent the views of, those members of the opposition division who conducted the oral proceedings and who gave the decision orally at those oral proceedings pursuant to Rule 111(1), first sentence, EPC, and no others (see for example decision

T 390/86, point 7 of the Reasons, and Case Law, III.K. 1.1 and III.K.1.3.2). Therefore, such a written decision must be signed by the members of the opposition division who were involved in reaching the decision pronounced orally, and only by them (see for example decision T 390/86, point 7 of the Reasons; T 243/87, points 3 to 5 of the Reasons; T 960/94, and T 2076/11). The signatures are considered as evidence that the written decision was taken by the members of the opposition division and is supported by them (see for example T 390/86, point 7 of the Reasons). As soon as just one member of the opposition division has been replaced after the oral proceedings, there is no longer any guarantee that the subsequent written reasoned decision correctly reflects the views of all three members who participated in the oral proceedings or, where applicable, of the majority of the opposition division (see for example decision T 243/87, point 3 of the Reasons). The written reasons must also not be influenced by the views of a new member which were neither formed on the occasion of the respective oral proceedings nor communicated to the parties on this occasion (see decision T 42/02, point 8 of the Reasons). Therefore, a change of composition of an opposition division between the oral proceedings and the issuing of a written decision should be avoided and, if that is not possible, parties should be offered new oral proceedings in the event of a change (T 900/02, point 13 of the Reasons).

In the board's view, the above principles also apply to the case at hand, in which the composition of the opposition division changed in the course of the second oral proceedings.

4.3 In the case at hand, the written sealed decision issued on 4 February 2020, and thus after the first oral proceedings on 4 March 2019 and the second oral proceedings held from 6 to 9 December 2019, does not indicate all the names of those members of the opposition division who took part in the oral proceedings on 4 March 2019 and 6 December 2019. Nor does EPO Form 2339 contain the handwritten signatures of all those members. Instead, the sealed decision states the name of those members of the opposition division who held the oral proceedings only on 9 December 2019 and EPO Form 2339 contains their handwritten signatures.

4.4 It is mainly in dispute between the parties in the case at hand whether, in the first oral proceedings on 4 March 2019, interlocutory decisions were announced by the opposition division in the former composition which were binding on the new chairman.

In this context, the patent proprietor referred to decisions G 12/91, OJ EPO 1994, 285, point 2, second and third sentences, of the Reasons, and T 577/11, point 3.1, second paragraph, of the Reasons. In the cited passage of decision G 12/91, the Enlarged Board of Appeal held that a decision given orally becomes effective and binding by virtue of being pronounced. In the cited passage of decision T 577/11, the board of appeal confirmed this for interlocutory decisions announced in the course of oral proceedings on a specific point and found that such a decision excluded any re-opening of the debate. These findings are not called into question by the board. However, they do not concern the present question of whether an interlocutory decision was pronounced orally at all.

4.5 According to the minutes dated 19 July 2019, the previous opposition division came to the conclusion that "*D2 and D3 anticipated the novelty of claim 1 of the Main Request*" and that Auxiliary Requests 1 and 2 "*did not comply with Article 84 EPC*" (see points 2.19, 3.17 and 4.11 of these minutes). With respect to the claims of Auxiliary Request 3, the previous opposition division came to the conclusion that "*the claims of AR3 met the requirements of Article 56 EPC*", and it was agreed "*to continue in writing for the adaptation of the description*" (point 5.37 of the minutes). Then the former chairman "*announced the decision that the claims of AR3 met the requirements of the EPC*" (point 5.38 of the minutes). The patent proprietor was given a two-month period to adapt the description to Auxiliary Request 3 (point 5.38 of the minutes and EPO Form 2309).

At the end of the oral proceedings on 9 December 2019 the new chairman *inter alia* "*announced to the parties the following decisions:*
- The Main Request filed during oral proceedings on 04.03.2019 did not meet the requirements of Article 54 EPC,
- AR1 filed during oral proceedings on 04.03.2019 did not meet the requirements of Article 84 EPC,
- AR2 filed during oral proceedings on 04.03.2019 did not meet the requirements of Article 84 EPC,
- the claims of AR3 filed during oral proceedings on 04.03.2019 met the requirements of the EPC,
...." (see page 8 of the minutes dated 19 December 2019).

4.6 In view of the minutes dated 19 July 2019 and 19 December 2019, it remains unclear

(a) whether the former opposition division came to the conclusion that the claims of the Main Request and Auxiliary Requests 1 and 2 did not meet the requirements of the EPC, and **merely expressed its intention** to maintain the patent as amended on the basis of the claims of Auxiliary Request 3 as soon as an amended description was filed, and the new opposition division announced the decisions on these requests on 9 December 2019, or

(b) whether the former opposition division came to the conclusion that the claims of the Main Request and Auxiliary Requests 1 and 2 did not meet the requirements of the EPC and pronounced **the interlocutory decision binding on the new chairman** to maintain the patent on the basis of the amended claims according to Auxiliary Request 3 as soon as an amended description was filed.

4.7 However, the question of whether or not the former opposition division had announced an interlocutory decision on the claims of Auxiliary Request 3 at the oral proceedings is not relevant to the decision in the present case, as in both case (a) and case (b) the written decision under appeal is tainted with a substantial procedural violation and is thus flawed.

4.8 In case (a), the written decision under appeal was issued after the second oral proceedings and sets out *inter alia* the reasons for not allowing the Main Request and Auxiliary Requests 1 and 2 and the reasons for finding that the claims of Auxiliary Request 3 meet the requirements of the EPC. These issues had been discussed with the parties only at the first oral proceedings before the former opposition division and not during the second oral proceedings. Hence, until

the second day of the second oral proceedings, the opposition proceedings and in particular all communication between the opposition division and the parties on these issues was not in writing only but also presented orally in the first oral proceedings. The new chairman thus did not have the opportunity to take note of and appreciate all the facts and arguments of the parties presented before his appointment in the same way as the former chairperson.

However, the right to be heard pursuant to Article 113(1) EPC may be exercised in writing, but also orally at oral proceedings. The holding of oral proceedings therefore forms an essential part of the right to be heard enshrined in Article 113 EPC. Thus, all findings at the oral proceedings which are relevant to the final decision should be made in the presence and with the involvement of the members giving the final decision, even in cases where no oral interlocutory decision is pronounced. The written reasons must also not be influenced by the views of a new member which were neither formed on the occasion of the respective oral proceedings nor communicated to the parties on this occasion (see decision T 42/02, point 8 of the Reasons). The written decision should therefore be in the name of and signed by those members of the opposition division who conducted the oral proceedings and heard the parties at those oral proceedings on the issues on which a decision was pronounced at the same oral proceedings or, as in case (a), at later oral proceedings. Changes in the composition of an opposition division after oral proceedings should therefore be avoided even in cases where no interlocutory decision has been given orally, and if that is not possible parties should in general be

offered new oral proceedings in the event of a change (see also T 862/98, point 2.3.2 of the Reasons).

In the case at hand, as soon as the chairman of the opposition division had been replaced during the second oral proceedings, it should have been clear that the new chairman had not had the opportunity to take note of and appreciate all the facts and arguments of the parties presented before his appointment in the same way as the former chairman, and that there was no longer any guarantee that the subsequent written reasoned decision on issues discussed at the first oral proceedings correctly reflected the views of all three members who participated in the first oral proceedings. Nevertheless, no new oral proceedings were offered to the parties. Hence the above principles have been contravened. Issuing the written decision on issues discussed at the first oral proceedings on behalf of an opposition division whose chairman had not been present at the first oral proceedings amounts to a substantial procedural violation of both Articles 113(1) and 116 EPC, as the decision was issued on behalf of a chairman before whom the parties were given no opportunity to present their comments at oral proceedings.

4.9 In case (b), the EPC provisions and the established case law set out in points 4.1 and 4.2 above apply to the interlocutory decision given orally at the first oral proceedings. Therefore, the written reasoned decision confirming this orally-announced interlocutory decision must be issued on behalf of the very same members of the opposition division who were present at the first oral proceedings, as the task of giving a written reasoned decision is personal to those members of the opposition division present at the oral proceedings and cannot be delegated to a differently-

composed opposition division, even if two of the members remain the same.

4.10 The patent proprietor argued that the situation in the case at hand was like that in case T 699/99 and that the procedure which the opposition division had adopted in the present case for authenticating the written decision under appeal was in full conformity with the procedure followed in decision T 699/99, superseding decision T 42/02, and therefore did not violate any provisions of the EPC.

However, the board finds this argument not convincing.

It is stated in decision T 699/99:

"*It follows from Article 7(2) Rules of Procedure of the Boards of Appeal that the new member is bound to the same extent as the other members by this interim decision. However, if, as in the present case, the reasons for the interim decision have not yet been provided in written form to the parties, but were intended to be integrated into the final written decision, the new member is not allowed to deliberate on or otherwise contribute to those parts of the final written decision which give or reflect the reasons for the interim decision. This is in line with the principle that any decision announced orally must only be written on behalf of and represent the views of the members responsible for that oral decision. Its written reasons shall not be influenced by the views of the new member which were neither formed on the occasion of the respective oral proceedings, nor communicated to the parties on this occasion (see decision T 42/02 of 28 February 2003, point 8).*" (see point 3 of the Reasons)
[The board notes that "*Article 7(2) Rules of Procedure*

of the Boards of Appeal" cited in this passage corresponds to the current Article 8(2) RPBA 2020].

and

"*Thus, the new legal member has refrained from deliberating on or contributing to points 7 to 9 of the Reasons below. The same applies to those passages in the above sections III-V, IX and X of the Summary of Facts and Submissions which relate to the Main Request of the respondent. These parts of the decisions only represent the views of the board in its composition at the first oral proceedings. In this respect, the previous legal member, who is unable to act since his service for the Boards of Appeal ended in 2004, is not replaced by an alternate (application of Article 7(3), first sentence, Rules of Procedure of the Boards of Appeal by analogy).*"(see point 4 of the Reasons).

In the board's view, and as the opponents correctly pointed out, decision T 699/99 does not supersede decision T 42/02, as a board of appeal cannot overrule the decision of another board of appeal, but can at most deviate from it and, if necessary, give reasons for it (Article 20 RPBA 2020).

The board considers that the approach applied in decision T 699/99 is not applicable to the present case, which concerns the requirements for a written decision of the opposition division in the event of a change of its composition. As explained above, under Rule 113(1) EPC the written decision of the opposition division must be signed by, and state the name of, the employee responsible, i.e. by all the members of the opposition division, and this task of giving a written reasoned decision is personal to those members of the

opposition division present at the oral proceedings and cannot be delegated to a differently-composed opposition division. Decisions of the boards of appeal, by contrast, are certified as authentic by the chairperson and the registrar by their signature or by other appropriate means (Rule 102, first sentence, EPC).

Furthermore, the statement in point 57 of the decision under appeal that the "*newly composed Opposition division adopted the interlocutory decision of the previously composed Opposition division from 04.03.2019.*" does not specify that the reasons given in the written decision in respect of the issues decided in the first oral proceedings on 4 March 2019 exclude that the new chairman might have contributed to drafting those reasons. There is also no indication in the decision under appeal that the approach in T 699/99 was adopted in the case at hand. Rather, the decision constantly refers to "the" opposition division and does not distinguish between any interlocutory decisions taken orally by the former opposition division at the first oral proceedings and any interlocutory decisions and the final decision taken orally by the new opposition division at the second oral proceedings. Consequently, the views and contributions of the two chairpersons, each of whom participated in only one of those oral proceedings, indistinguishably entered into and influenced the entire decision in an indeterminate manner, possibly also with respect to those parts of the statement of reasons relating to any interlocutory decisions delivered at the respective oral proceedings in which the respective chairperson did not participate.

The patent proprietor referred to decisions T 225/96,

T 837/01 and T 266/14 and took the view that if the board had had doubts about the correctness of the contested decision in view of decision T 699/99 it should have turned to the opposition division to investigate *ex officio* under Article 114(1) EPC.

In principle, Article 114(1) EPC also applies in appeal proceedings and requires the board to establish the facts of its own motion, but this principle of examining *ex officio* does not apply without restriction (see decisions cited in Case Law, V.A.3.4). Cases T 225/96 and T 837/01 dealt with the lack of signature of members of the department of first instance in the contested decision. According to the case law of the boards, if the signature was omitted merely by mistake, although the member actually participated in the writing of the decision under appeal, the decision could be rectified by the opposition division by obtaining the signature under Rule 140 EPC (see e.g. T 837/01, point 3 of the Reasons; T 225/96, point 2 of the Reasons). In the case at hand, however, the issue was not the lack of signature of the former chairman of the opposition division but the fact that the new chairman had signed the decision under appeal. Secondly, the question arose whether the approach applied in decision T 699/99 was applicable in the present case, which the board, however, answered in the negative. Only if this question had to be answered in the affirmative might an official investigation on the part of the board have been necessary in view of decision T 699/99.

4.11 In view of the above, the decision under appeal is tainted with a substantial procedural violation and flawed. The decision under appeal must therefore be set aside for this reason alone. It is thus unnecessary to

examine whether there were further procedural violations, as alleged by the opponents, which would have justified setting aside the decision under appeal.

5. Remittal - Article 111(1), second sentence, EPC and Article 11 RPBA 2020

5.1 According to Article 111(1), second sentence, EPC, the board may either exercise any power within the competence of the department of first instance or remit the case to that department for further prosecution. When exercising this discretion, the board takes account of the provisions of Article 11 RPBA 2020, which applies under Article 25(1) RPBA 2020 in the case at hand. According to Article 11, first sentence, RPBA 2020, the board is not to remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the first-instance proceedings constitute such special reasons (Article 11, second sentence, RPBA 2020).

5.2 The substantial procedural violations in the first-instance proceedings established above affected the entire process of the decision-making and the decision's reasoning, and constitute fundamental deficiencies in the first-instance proceedings within the meaning of Article 11, second sentence, RPBA 2020. They are thus special reasons within the meaning of Article 11, first sentence, RPBA 2020 which speak in favour of a remittal.

5.3 On the basis of the following considerations, the board is of the opinion that the reasons put forward by the patent proprietor do not speak against a remittal to

the opposition division.

Firstly, according to the established case law of the boards of appeal, violations of the requirement pursuant to Rule 113(1) EPC are not formal deficiencies but constitute a substantial procedural violation (see point 4.1 above).

Secondly, the board considers the decisions relied on by the patent proprietor not to be relevant to the present case since these decisions concern substantial procedural violations which did not affect the entire process of the first-instance decision-making and the decision's reasoning, and the board of appeal found itself in a position to rule on the substantive issues in connection with which the substantial procedural violations had occurred.

In case T 515/05, the appellant in the first-instance oral proceedings was not allowed to present its arguments on the new ground for opposition introduced by the opposition division, and the board considered that remittal was not appropriate, essentially because (i) the arguments of the appellant had been taken into account in the decision under appeal, (ii) the appellant in the meantime had had the opportunity, and indeed availed itself of it, to expand its line of argument before the board, and (iii) no concrete reason was given by the appellant for the necessity for remittal. In case T 1929/12, while the decision under appeal had not explicitly addressed and refuted the appellant's arguments discussed in the first-instance oral proceedings and therefore it was found to suffer from a fundamental deficiency within the meaning of Article 11 RPBA 2007, the board found that there were special reasons for not remitting the case under

Article 11 RPBA 2007 because both the board and the appellant were able to deal with the decision under appeal in view of the minutes, and the examining division would most likely have stood by its opinion and eventually issued another, better reasoned, decision to the same effect. In cases T 786/15 and T 2994/18, not all the appellant's arguments or objections had been addressed in the reasoning of the contested decision. In both cases, the board found that this was contrary to Rule 111(2) EPC and, consequently, to Article 113(1) EPC and therefore constituted a substantial procedural violation amounting to a fundamental deficiency. Nevertheless, for reasons of procedural efficiency, among others, the cases were not remitted to the division of first instance under Article 11 RPBA 2020. In case T 1647/15, the procedural violations consisted of the opposition division's refusal to take evidence of the alleged prior use and a possible suspicion of bias on the part of a member of the opposition division. The board of appeal considered that a referral back to the first-instance body under Article 11 RPBA 2007 would have served no purpose, as the board had concluded only on the basis of the parties' submissions and the documents on file that the alleged prior use had taken place and that the possible suspicion of bias had not affected the entire process of first-instance decision-making, but was merely the result of an uncontrolled outburst at the end of exceptionally long and intense oral proceedings.

5.4 In view of the above, the board considers it appropriate to remit the case to the department of first instance for further prosecution in accordance with Article 111(1), second sentence, EPC and Article 11 RPBA 2020.

5.5 Due to the change in the opposition division's composition and the unclear result of the first and second oral proceedings (see point 4.6 above), new oral proceedings will have to be offered to the parties by the department of first instance.

In this context, the board also wishes to note the following:

The board agrees with the view taken in decision T 42/02 (point 9 of the Reasons) that, if an opposition division feels it necessary to orally announce binding interlocutory decisions, the correct procedure under such circumstances would be to issue a written interlocutory decision (not allowing separate appeal pursuant to Article 106(3) EPC) dealing with the issues decided at the first oral proceedings followed by a final decision dealing with the remaining issues, each decision being properly signed by only the three examiners concerned. The board notes that, even if an interlocutory decision had been pronounced at the first oral proceedings in the case at hand, it is not apparent from the file that the former chairman of the opposition division had been prevented from signing a written interlocutory decision. Moreover, even if the chairman had been prevented from signing, according to the case law of the boards of appeal it would then have been sufficient, as a general rule, for the other members of the former division to sign and to note the reason for the absence of the signature of the member prevented from signing (see e.g. T 1170/05). In no event may the signature of a member unable to act be replaced by the signature of a person who has not been a member of the opposition division taking the oral decision. However, even if an interlocutory decision had been pronounced at the first oral proceedings in

the case at hand, it would now no longer be possible to comply with the provisions of Rule 111(1), second sentence, EPC, since the first oral proceedings had taken place almost two years before and the (flawed) written decision had been dispatched almost one year after the first oral proceedings. Thus, the opposition would have to be re-examined by the opposition division (see also decisions T 390/86, point 8 of the Reasons and T 42/02, point 9 of the Reasons).
Re-examination of the opposition by the opposition division would also be required even if no interlocutory decision had been pronounced at the first oral proceedings in the present case, since the entire first oral proceedings and the second oral proceedings on the first day did not take place before the opposition division before which the second day of the second oral proceedings took place, but before the opposition division in its former composition.

6. *Remittal of the case to an opposition division in a different composition (i.e. the members of the present opposition division being replaced) and under the responsibility of another Director of the opposition division*

Article 10(1) EPC provides that the European Patent Office (EPO) is managed by the President, who is responsible for its activities to the Administrative Council. To this end, the organisation of the examining and opposition divisions, and in particular their composition, is under the management of the President of the EPO according to Article 10(2)(a) and (1) EPC, although in practice this responsibility is delegated to a director (see also T 71/99, point 4 of the Reasons). This delegation to a director is part of the

President's power to manage the Office. No legal basis which would allow the boards of appeal to substitute themselves for the management of the Office and order a change in this delegation is apparent to the board. Therefore, it is not necessary to address the arguments put forward by the parties.

Thus, the opponents' requests cannot be allowed.

7. *Remittal of the case to an opposition division in a different composition (i.e. the members of the present opposition division being replaced)*

The opponents essentially requested that the board order a change in the composition of the opposition division.

7.1 In principle, the organisation of the examining and opposition divisions, and in particular their composition, is under the management of the President of the EPO according to Article 10(2)(a) and (1) EPC, although in practice this responsibility is delegated to a director (see also T 71/99, point 4 of the Reasons). Therefore, in principle, the composition of the opposition division is the sole responsibility of the department of first instance (see e.g. decisions T 71/99, point 4 of the Reasons; T 2076/11, point 8 of the Reasons).

7.2 Some boards of appeal have held that there is no legal basis for the board to order a change in the composition of the opposition division (see e.g. decisions T 400/02, point 5.1 of the Reasons, and T 1081/02, point 6 of the Reasons) and that the board has no power to order a change in the composition of the opposition division to be entrusted with the case

after its remittal (see e.g. decisions T 1221/97; T 400/02, point 5.3 of the Reasons; T 2475/17, point 3.1.4 of the Reasons).

7.3 However, there are also decisions in which boards of appeal have ordered a change in the composition of the department of first instance. The board notes that in cases where a differently-composed first-instance department was considered appropriate the composition of the opposition division did not comply with Article 19(2) EPC (see for example T 251/88, T 939/91, T 476/95, T 825/08, T 2582/11, T 135/12 and T 1788/14) or the substantial procedural violations at issue were linked to various irregularities in the conduct of the proceedings which could be traced back to the way the actual members of the first-instance department in question chose to conduct the proceedings (see e.g. T 611/01, T 433/93, OJ EPO 1997, 509, T 95/04 and T 2362/08). In the latter cases, reference was made to the general principle of law that nobody should decide a case in respect of which a party may have good reasons to assume partiality. This principle applies not only to the members of the boards of appeal according to Article 24(1) EPC, but also to the members of the departments of first instance of the EPO taking part in decision-making activities affecting the rights of any party (see decision G 5/91 of 5 May 1992, OJ EPO 1992, 617). The bias of the members of the opposition division which issued the contested decision does not have to be factual. Therefore, a change of composition is justified not only where there is actual bias, but also where there is a well-founded concern, i.e. an appearance of bias (see decision G 1/05 of the Enlarged Board of Appeal of 7 December 2006, OJ EPO 2007, 362, point 19 of the Reasons), which however must be founded on an objective basis; purely subjective impressions or

vague suspicions are not sufficient for this (G 1/05, *supra*, point 20 of the Reasons).

7.4 Even if there is no possible bias against a party, a differently constituted body may also be appropriate if a party has good reason to believe that there would otherwise not be a fair re-hearing (see T 433/93, *supra*; see also T 628/95).

7.5 In the case at hand, the board found that substantial procedural violations had occurred in the first-instance proceedings which affected the entire process of first-instance decision-making. However, the mere fact that a substantial procedural violation has been committed does not necessarily mean that there is a *prima facie* case of bias. If this were to be assumed, it would mean that, in cases of remittal under Article 111(1), second sentence, EPC and Article 11 RPBA 2020 because of fundamental deficiencies within the meaning of Article 11, second sentence, RPBA 2020, an amended composition would always have to be ordered. This in turn would contradict the wording of Article 111(1), second sentence, EPC, according to which the default situation is referral of the case to the department of first instance which was responsible for the decision appealed against. Furthermore, it is also evident from the approach of the Enlarged Board of Appeal that procedural violations do not necessarily have to lead to a change of composition. In cases in which the Enlarged Board of Appeal granted a petition for review under Article 112a EPC on the grounds of a fundamental violation of Article 113 EPC, it did not order a change in the composition of the board of appeal in any of these cases, although Rule 108(3), second sentence, EPC explicitly provides for this possibility (see T 2475/17, point 3.1.2 with further references to case

law of the Enlarged Board of Appeal). Therefore, the board does not accept the opponents' argument that a remittal based on a fundamental deficiency alone justified the ordering of a different composition.

7.6 The board also has no reason to suspect partiality on the part of the members of the opposition division during the conduct of the proceedings, or to assume that they would necessarily be partial or prejudiced if they re-heard the case. The opponents have also not convincingly argued that there was any actual or possible bias against them by the members of the opposition division who were responsible for the decision under appeal. They also referred to several decisions, such as for example, T 433/93 (*supra*) and argued that the case at hand should be re-heard and re-decided by a different composition of the opposition division, since these members had already issued a written decision containing reasons and therefore there were reasonable grounds to suspect that the same composition of the opposition division would have difficulty in re-hearing and re-deciding the case without being biased because of its previous decision. However, in the board's view, there must be special circumstances for such a presumption, because the mere fact that the opposition division has taken or reasoned a decision cannot necessarily lead to a change of composition with regard to the standard situation under Article 111(1), second sentence, EPC, as set out above. Nor is the board convinced by the opponents' arguments that the parties had grounds to suspect that the opposition division in the same composition would have difficulty in re-hearing and dealing with the case with an open mind without being biased because of its previous decision.

Hence the fundamental deficiencies established above are not considered a sufficient reason to order a change of composition of the opposition division.

In the case at hand, new oral proceedings will have to be offered to the parties by the department of first instance (see point 5.5 above). The opposition division in the composition that signed the decision under appeal will have to hear the parties on most of the issues dealt with in the decision under appeal for the first time and decide on them, since only the second day of the second oral proceedings took place before that opposition division.

The above also applies if, as the opponents allege, the new opposition division may have committed further procedural violations in the proceedings at first instance, even after the appeal was pending.

7.7 In view of the above, even if the board had the necessary power to order a different composition of the opposition division, the board is of the opinion that there would be no compelling reasons in the case at hand for ordering this.

8. *Request for referral to the Enlarged Board of Appeal*

Opponent 2 requested that several questions be referred to the Enlarged Board of Appeal (see point XII above).

8.1 Under Article 112(1)(a) EPC, a board of appeal, either of its own motion or upon request from a party, refers any questions of law to the Enlarged Board of Appeal in order to ensure uniform application of the law or, if an important point of law arises, if it considers that a decision is required for the above purposes. The

referred question must be relevant for deciding the case in question (see Case Law, V.B.2.3.3, first paragraph). It must not have a merely theoretical significance for the original proceedings, which would be the case if the referring board were to reach the same decision regardless of the answer to the referred question (G 3/98, OJ EPO 2001, 62; G 2/99, OJ EPO 2001, 83).

The requirement "to ensure uniform application of the law" is met if in the particular case the board deems it necessary to deviate from the interpretation or explanation of the EPC contained in another decision of a board of appeal, or if there are diverging decisions of two boards. However, a referral under Article 112(1)(a) EPC is made only when the board considers that a decision of the Enlarged Board of Appeal is required. In this context Articles 20 and 21 RPBA 2020 also have to be taken into consideration. Under Article 21 RPBA 2020, a referral of questions to the Enlarged Board of Appeal must be made in cases where the board considers it necessary to deviate from an interpretation or explanation of the EPC contained in an earlier opinion or decision of the Enlarged Board of Appeal. However, if a board wishes to deviate from an earlier decision taken by a board of appeal, a referral is not compulsory (see Article 20 RPBA 2020).

"An important point of law" within the meaning of Article 112(1)(a) EPC arises if that point is of fundamental importance in the sense that it is relevant to a substantial number of similar cases and is therefore of great interest not only to the parties in the appeal in question but also to the public at large (see for example T 271/85, OJ EPO 1988, 341, point 5 of the Reasons). A question regarded as an important point

of law does not need to be referred to the Enlarged Board of Appeal if the question can be answered beyond all doubt by the board itself (see for example J 5/81, OJ EPO 1982, 155, and Case Law, V.B.2.3.7 with further references).

8.2 The board is of the opinion that the questions posed by opponent 2 (see point XII above) do not satisfy these prerequisites.

As stated in point 7.7 above, even if the board had the necessary power to order a different composition of the opposition division, the board believes that there would be no compelling reasons in the case at hand for ordering this. As a consequence, a decision on the question (1) proposed by the opponent 2 to be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC is not required to enable the board to decide the appeal case at hand.

Questions (2) to (5) need be referred to the Enlarged Board only if the board considers this to be necessary. Such is not the case here, as the board has itself been able to answer them beyond any doubt by reference to the Convention (see points 7.3 to 7.6 above).

8.3 For these reasons, the board deems a decision of the Enlarged Board of Appeal not necessary and opponent 2's request for a referral to the Enlarged Board of Appeal must be refused.

9. *Further issues*

9.1 Regarding opponent 2's request for formal correction of the opposition division's interlocutory decision of

4 February 2020, as the patent proprietor rightly submitted the competence to correct errors in a written decision under Rule 140 EPC lies with the opposition division which issued the written decision and not with the board (G 8/95, point 3.4 of the Reasons; T 810/09, point 1.5 of the Reasons). In addition, since the decision under appeal is to be set aside there is no need for the board to decide on this issue.

9.2 With respect to opponent 2's request that the decision of the Director in charge on the objection of suspected partiality against the former chairman be "lifted", the board considers that this request is superfluous or at least devoid of purpose, as the former chairman of the opposition division was replaced by another chairman, even though the director had decided that there was no bias.

9.3 Since the board did not decide on the merits of the case, there is no need to deal with any requests that documents D50 and D51 be put in or be excluded from the public part of the file (see points VII, VIII and XIII above), or with any requests concerning the admittance of auxiliary requests and documents or relating to the allowability of requests directed to the patent itself (see point XIII above).

10. *Reimbursement of the appeal fee*

In view of the above findings, the reimbursement of both appeal fees in full pursuant to Rule 103(1)(a) EPC is equitable by reason of the substantial procedural violation established in point 4 above.

Order

For these reasons it is decided that:

1. The appeals of the patent proprietor and opponent 2 are admissible.

2. The request for referral to the Enlarged Board of Appeal is refused.

3. The objection under Rule 106 EPC is dismissed.

4. The decision under appeal is set aside.

5. The case is remitted to the department of first instance for further prosecution.

6. Both appeal fees are to be reimbursed.

The Registrar: The Chairman:

L. Gabor R. Bekkering

Decision electronically authenticated