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Petition for Review under Art. 112a EPC

Appeal Reference Number: T2097/10-3.2.04
Opposition against: EP 1 117 933 (99 947 419.0)
Proprietor: I....
Opponent: not a party to the proceedings anymore

In the name and by order of I..... Germany, we
request under Article 112a EPC:

1. a review of the decision of the Technical Board of Appeal 3.2.04 dated July 12, 2012 with Appeal Reference Number T 2097/10-3.2.04 regarding European patent EP 1 117 933 to the petitioner, which was granted in respect of a patent application having application No. 99947419.0;
2. that the decision be set aside under Article 112a, paragraph 5, EPC and that the re-opening of the proceedings in the appeal instance be ordered;
3. that the case be assigned to a Board of Appeal different from that which issued the appealed decision;

4. in case that requests 1) to 3) cannot be granted in written proceedings, we request oral proceedings under Article 116 EPC.

Please debit the fee for the petition for review in the amount of 2,760 Euros from the deposit account No. 2800 0609. The respective Form 1010 is enclosed with this request.

G R O U N D S

A

I.

As to the patent in dispute

1. The patent EP 1 117 933 („the Patent“) underlying the present proceedings protects a vacuum pump (patent paragraph [0001]) provided in particular for brake booster systems in motor vehicles, operating by way of a rotor rotating eccentrically in the pump housing in which vanes are movably guided.

The disk brakes of present-day motor vehicles generate a braking action that is considerably larger than that of the drum brakes used in the past. Their disadvantage is, however, that considerably higher braking forces must be applied so that a so-called brake booster is required for reducing the pedal forces required. These brake boosters operate at underpressure generated by a vacuum pump.

2. The requirements for the operational safety of this vacuum pump are particularly high since if it fails, drivers of little physical strength will have difficulties braking the vehicle. Such operational safety is achieved among other things in that the vacuum pump is directly mechanically coupled with the camshaft of the vehicle's combustion engine. This is to ensure that the vacuum pump always rotates while the engine is rotating. This avoids a V-belt or the like which might fail in operation.

The direct coupling of the vacuum pump with the camshaft ensues in the case of the engine making fast rotational speed changes that the vacuum pump likewise makes rapid rotational speed changes. Thus the stresses on the connection between the camshaft and the vacuum pump increase along with what is called the mass moment of inertia of the vacuum pump. These high stresses involve the risk of failure of the coupling which is disposed between the camshaft and the vacuum pump.

3. The invention proposes to use, instead of the – comparatively heavy-weight – steel rotors employed thus far in these vacuum pumps, plastic rotors showing a specific configuration. In this way the mass moment of inertia, the stresses on the coupling device, and also the manufacturing costs are reduced. However, when using plastic, new problems arise in particular regarding the susceptibility of the rotor to wear, which the present patent also solves.

To this end the following configuration of a vacuum pump is proposed (version of the independent claim with which the Board of Appeal maintained the patent, corresponding to the second independent claim of the auxiliary request resulting in the revocation of the patent by the Opposition Division):

Vacuum pump comprising a rotor (1) which can be driven, by which a vane in a housing can be set in rotation, whereby the rotor (1) consists of plastic and is constructed as one piece, wherein the rotor (1) provides for one counter surface (43) each for a supporting surface (41) of a coupling, whereby a torque that is transmitted by the drive shaft can be routed into the rotor (1) via the counter surface (43),
characterized in that
a wear protecting equipment is arranged between the rotor (1) and the coupling, whereas

a first length of a section (7) of the rotor (1) that is preferably shaped like a doubly flat piece (9) is equipped with a cup-shaped cap (51) preferably consisting of sheet metal.

4. The economic significance of this patent can best be recognized by the fact that meanwhile more than 40 million motor vehicles have been equipped with the vacuum pumps configured according to the patent, a number which continues rising by several thousand units every day. As far as the petitioner is aware, for such use, there do not exist any vacuum pumps having a plastic rotor which are not configured according to the patent in the world market. The failure rate of the pumps is very low.
5. The patent is part of a family of intellectual property rights, many members of which have been examined for their legal validity in various opposition, nullity, and utility model cancellation proceedings. All intellectual property rights have been maintained – some with restrictions – in these proceedings.

Thus the patent in dispute is a particularly valuable patent, the teaching of which results in increased safety in road traffic although the manufacturing costs are low.

Nevertheless the present patent was revoked in the first instance, due to fundamental procedural errors by the Opposition Division. In the second instance it was maintained with an independent claim which had already been subject-matter of the proceeding before the Opposition Division.

II.

Summary of the facts

1. On December 30, 2004 the opponent, who is not a party to the proceedings anymore, gave notice of opposition to the disputed European patent 1 117 933, requesting that the patent be revoked in the scope of the claims 1 to 16, 18 and 19, and 22 to 33. In

its request it referred to the documents D1 to D8, arguing that the protected invention did not involve an inventive step.

The proprietor objected to this with brief dated August 19, 2005. On March 19, 2010, i. e. about four and a half years later, the Opposition Division summoned the parties for oral proceedings on June 22, 2010, stating that in their preliminary opinion the subject-matter of the attacked claims involved an inventive step in respect of the documents D1 to D8.

2. One month prior to the oral proceedings, on May 21, 2010, patent attorneys gave notice that they acted as representatives for the opponent, filing a brief with which they submitted 26 new documents, contesting the novelty of the independent claims over the new documents D10 and D12, and the lack of inventive step of the independent claims in respect of the new documents D12, D15, D16, D17 and D18, respectively D12, D18, D19 and D20, and of the subclaims in respect of the new documents D9, D10, D12, D14, D18, D21, D23, D25, D26, D27, D28, D30 and D31. No reference was made to the disclosure of the remaining documents indicated. They further requested that now also the claims not attacked in the notice of opposition be revoked, asserting an inadmissible extension regarding the independent claims 1 and 2.
3. With brief dated June 18, 2010, making extensive references to the case law of the Boards of Appeal, the proprietor requested that the newly submitted documents not be admitted to the proceedings, called attention to the amended request, and requested, in case the documents should be admitted, postponement of the oral proceedings. With telefax dated June 21, 2010 the Opposition Division informed the parties that the date set for the oral proceedings was maintained.
4. The minutes of the oral proceedings on June 22, 2010 are not available in the online file inspection at the EPO. The petitioner therefore submits as

Exhibit WRST 1

the minutes they received. We kindly ask for said minutes to be no longer exempted from the file inspection.

5. At the beginning of the proceedings the petitioner had no knowledge about:
 1. which of the claims would be discussed;
 2. what grounds for opposition would be discussed in the proceedings;
 3. whether, and if so, which of the newly submitted 26 documents would be considered in the proceedings;
 4. what the opinion of the Opposition Division was regarding the newly introduced ground for opposition of inadmissible amendment;
 5. how the Opposition Division assessed the novelty and the inventive step of the independent claims in light of the 26 newly cited documents.
6. In the proceedings it became clear from the very start that the Opposition Division made every endeavour to conclude the proceedings as fast as possible.

The reasons are surmised to be: In the scope of the soccer world championship in South Africa, the group match of France vs. South Africa was scheduled for 16:00 hours Central European Time. The group match Greece vs. Argentina started at 20:30 hours. The petitioner cannot definitely judge whether the course of the proceedings was influenced by this fact (one of the members of the Opposition Division is French, another member is Greek). Both the course of the proceeding and comments by the Opposition Division members after the proceedings suggest this strongly though.

7. Contrary to the petitioner's requests, the Division admitted the documents D18 and D19 as relevant to the proceedings, although the decision then made no mention of these documents at all. Although it took cognizance of the argument brought by the petitioner that absent their consent the request could not be extended to the claims not originally attacked, it did not decide about this. Nevertheless these claims were then revoked as well.
8. During the further proceedings the Opposition Division found that claim 2 as granted violated Article 123 (2) EPC. It permitted the petitioner to draft a new auxiliary request but stated – repeating this a number of times during the proceedings – that another auxiliary request would not be allowed.

The petitioner objected, stating that it reserved the right to submit further auxiliary requests. Since the new documents and the new grounds for opposition had not been communicated to it before expiry of the time limit set by the Opposition Division, it had no opportunity to file these auxiliary requests within said time limit. It pointed out that it had been confronted with new facts, referring to Rule 116, paragraph 1, fourth sentence EPC, which in this case excluded a non-consideration for late filing.

It further pointed out that both the set of claims as granted and the set of claims according to auxiliary request 2 contained independent claims and that waiving any of these two claims with the subclaims referring back to it did not constitute a new request since it would not introduce new facts into the proceedings. It stated that it was a fundamental procedural right that a requester may waive part of an asserted claim.

9. During the further proceedings, at 15:28 hours, the Opposition Division stated that the subject-matter of the independent claim 1 was not based on an inventive step.

The further statements by the representative of the petitioner that he wished to submit another auxiliary request, and why the Division had to allow such an auxiliary request,

were cut off by the Chairman with the indication that the patent would be revoked, the oral proceedings were closed, and that the undersigned would have to submit any further arguments he wished to put forward to the Board of Appeal.

The fact that the undersigned was cut off in mid-statement for closing the proceedings is apparent from item 39 of the minutes.

This abrupt closure of the proceedings occurred at 15:30 hours. The group match France vs. South Africa in the soccer world championship started at 16:00 hours Central European Summer Time.

10. In the grounds for the decision the Opposition Division sets forth that the subject-matter of claim 1 had been obvious to the skilled person from the disclosure of D7 and based on his common general knowledge.

Document D7 had been filed with the notice of opposition although the opponent never considered it as the closest prior art and in particular not as a basis for arguing lack of inventive step. The preliminary opinion of the Opposition Division affirming the inventive step of this claim did not refer to D7. No argument was brought nor did any discussion take place on the question what is included in the common general knowledge of the skilled person. This would not have been possible already because at no time was the skilled person defined by the Opposition Division.

11. On October 6, 2010 the petitioner filed an appeal which it substantiated on December 7, 2010. It requested that the patent be maintained as granted respectively according to two auxiliary requests it submitted, and requested that the reimbursement of the appeal fee be ordered because of fundamental procedural defects of the proceedings before the Opposition Division. The opponent had withdrawn the opposition already on October 27, 2010.

In the grounds of appeal, the petitioner pointed out, among other things, the following fundamental procedural errors:

1. Erroneous exercise of the discretion by the Opposition Division by considering new grounds for opposition in the oral proceedings;
2. Erroneous exercise of the discretion by the Opposition Division by considering newly submitted documents respectively by refusing a postponement of the proceedings in respect of the large number of documents submitted one month prior to the proceedings, so that the petitioner had no opportunity among other things to examine the translations of foreign language documents for correctness;
3. Granting the amendment of the requests, i. e. extending the attack to all of the claims, which according to the case law of the Enlarged Board of Appeal is not possible anyway without a pertinent decision and contrary to the request by the petitioner;
4. Refusing the submission of new auxiliary requests contrary to Rule 116 and Article 113 EPC, although new documents and new grounds for opposition were introduced into the proceedings for the first time in the oral proceedings;
5. The incorrect representation in the minutes that the petitioner had opposed the introduction of new grounds for opposition in the oral proceedings for the first time.

Furthermore it was set forth in detail that the petitioner's right to be heard was fundamentally violated by these procedural defects.

Moreover, it commented on the patentability of the teaching protected by the patent.

12. The oral proceedings on July 12, 2012 before the Board of Appeal extended – including breaks – over seven hours. In the course of the discussion, some of which was highly controversial, between the petitioner and the members of the Board of Appeal, the Board arrived at the result that the proceedings before the Opposition Division did not involve any fundamental procedural error that would justify the reimbursement of the appeal fee.

It further arrived at the result that the independent claim 2 submitted with the auxiliary request was patentable under EPC criteria. However, the minutes do not indicate that „admitting“ this „new auxiliary request“ had been preceded by a lengthy, controversial discussion between the petitioner and the Board of Appeal during which the petitioner had also explicitly announced to raise an objection under Rule 106 EPC.

13. The claim which the Board of Appeal assessed as patentable is, except for the optional backreference to the first independent claim, literally identical with the independent claim 2 according to the auxiliary request, which was also available to the Opposition Division.

The Opposition Division thus revoked the patent although the set of claims submitted as an auxiliary request contained an independent, patentable claim, and the petitioner had explicitly asserted that it waived the first independent claim, which was found not to be patentable, and all the subclaims referring back thereto.

Thus the Opposition Division revoked a patent that is technically and economically valuable and protects a patentable invention, solely because it rated another independent claim not patentable, and did this based on a consideration which the Opposition Division communicated to the petitioner for the first time near the end of the proceedings without offering it the opportunity to eliminate the obstacle to the maintenance of the patent by simply waiving an independent claim.

14. As will be set forth in detail below, the Board of Appeal could arrive at its opinion that the proceedings before the Opposition Division did not involve any fundamental procedural error only because it did not take either cognizance or account of substantial statements of facts brought by the petitioner in its written and oral argument. Thus even the Board of Appeal violated the petitioner's right to be heard in a fundamental way, so that the present petition for review under Article 112a EPC is substantiated.

B

I.

Preliminary statement

1. In the following substantiation the petitioner will also make reference to the case law of the German Federal Supreme Court and the Federal Constitutional Court. The petitioner expressly points out that such reference is not intended to state that, as regards the interpretation of the EPC, the significance of German case law should extend beyond the significance of the case law in other contracting states. The petitioner does not feel obliged, however – and, being a medium-sized company, cannot accomplish anyway – to carry out a study comparing the laws in the EPC contracting states to find out about their views on the fundamental rights of their citizens to fair process. This task must remain reserved for the EPO or learned institutions. German case law will only be referenced because the petitioner and its representatives are familiar with it from their daily work and such referencing does not involve any unreasonable efforts.
2. In the proceedings presently under discussion the Board of Appeal set forth in the oral proceedings that the Federal Supreme Court ("BGH") case law (the petitioner had cited, among others, the BGH decision „Sensoranordnung“, GRUR 2012, page 149) was of no interest to it since, if it considered this case law, it would also have to consider the case law of the other contracting states. This is an incorrect opinion,

since this argumentation is only intended to show that there does exist an understanding of the rights ensuing from Art. 113, paragraph 1 EPC that differs from that of the Board of Appeal. For substantiating this, a reference to the case law of an individual contracting state is sufficient.

The Enlarged Board of Appeal obviously shares this view since in many decisions it only makes reference to the case law in individual contracting states without considering the case law of all contracting states for forming their opinion. In addition the case law on patent right in Germany is probably the most extensive one due to the large number of proceedings, so that it is easy to find decisions in comparable cases.

II.

Request under Article 24 EPC

1. The petitioner objects to the Chairman of the Enlarged Board of Appeal on the ground of suspicion of partiality under Article 24, paragraph 3 EPC. This request is substantiated as follows:

The Enlarged Board of Appeal apparently has either not realized the mandate which the legislator conferred to it by introducing Article 112a EPC, or it has not – at least to date – put it into practice.

Under the regulation of Article 112 EPC only a Board of Appeal or the President of the EPO was in a position to bring a case before the Enlarged Board of Appeal. It is therefore not surprising that only few decisions issued under Article 112 EPC are concerned with questions of fair procedural conduct.

2. Due to Article 112a EPC introduced with the EPC 2000, also the parties to the proceedings can bring a case before the Enlarged Board of Appeal for a violation of the principles of fair procedural conduct, primarily a violation of granting the right to be

heard. The Enlarged Board of Appeal would thus have the opportunity to develop general procedural principles tailored to the proceedings before the EPO with which, for instance, it could be prevented that a valid patent was revoked solely due to a procedural error, as happened in the present case.

In the numerous events relating to the introduction of the EPC 2000 it was heard from circles of the Enlarged Board of Appeal that they feared to be overwhelmed by a large number of requests under Article 112a EPC. It may have been for this reason that the Enlarged Board of Appeal saw fit to set forth in its very first decision on a petition for review (R 1/08, page 9, paragraph 1):

„The extraordinary nature of this legal remedy means that the provisions of Article 112a EPC are to be applied in a strictly-limited fashion”.

It is known that nearly all petitions for review decided thus far have been dismissed based on this proviso.

3. The undersigned already pointed out in a petition for review dated December 23, 2010 (Reference Number R 23/10) that Article 112a EPC can only – if at all – be interpreted narrowly in such a way that a detailed examination be made whether the right to be heard is in fact violated or whether an erroneous application of substantive law is wrongfully asserted instead.

The extent of the right to be heard must, however, never be subjected to a narrow interpretation. All the democratic states consider the right to be heard and the right to a fair procedural conduct to be elementary, basic rights which are anchored accordingly in all the Conventions on Human Rights.

4. Also the Board of Appeal expressed in the present case in the oral proceedings that the Boards had to aim their case law at limiting the number of appeals filed. In addition to the fact that in the petitioner's opinion this is incompatible with the EPC provisions, this is also based on a misunderstanding.

Specifically that party who considers its procedural rights violated and thus believes to have been treated unfairly, will seek to obtain corrective action by means of filing an appeal or a petition for review under Article 112a EPC. For example, if in the present case the Opposition Division had maintained the patent with the patentable claim, or if at least the Board of Appeal had then taken cognizance of and examined the petitioner's argument in detail, then the filing of an appeal or the present petition would not have been necessary.

5. Only if the Enlarged Board of Appeal takes the legislator's mandate, as the petitioner understands it, seriously and establishes clear rules for the lower-level instances, will the number of cases of violation of elementary procedural rights and thus the number of petitions for review under Article 112a EPC decrease.

Then it will not be required for the parties to frequently bring their cases before institutions such as the Federal Constitutional Court etc. in order to enforce corrections of the case law of the Enlarged Board of Appeal from outside.

6. In the petition for review R 12/09 the petitioner objected on the ground of a suspicion of partiality to all those members of the Enlarged Board of Appeal who at the same time are members of a technical or the Legal Board of Appeal.

The petitioner in the present case also doubts that the EPC provisions regulating the composition of the Enlarged Board of Appeal meet constitutional principles, in this respect referring to the statements of Prof. Dr. Rüdiger Zuck (GRUR Int. 2011, page 302) from the viewpoint of a person learned in German constitutional law. However, the petitioner follows the opinion of the Enlarged Board of Appeal in the decision R 12/09 indicated above insofar as the composition of the Enlarged Board of Appeal conforming with the EPC could not per se establish a ground of suspicion of partiality of its members.

7. The consent of the Enlarged Board of Appeal to the Rules of Procedure of the Boards of Appeal does, however, give rise to the suspicion of partiality. In particular Article 12, paragraph 4 RPBA grants to the Boards of Appeal the authority to dismiss any and all new argument, and thus extends far beyond the regulation of Article 114, paragraph 2 EPC. Contrary thereto, for example the German Patent Act ("PatG") under Sec. 83 PatG in conjunction with Sec. 530 and Sec. 296, paragraphs 1 and 4 ZPO (Code of Civil Procedure), provides for allowing late-filed means of attack and defence, if

„to the independent satisfaction of the court, their admission would not delay the termination of the litigation or if the party sets forth adequate justification for the delay.“

New argument can thus only be rejected in the case of misuse. In particular, it does not prejudice – see the pertinent German case law discussed below – the submission of new claim formulations in second instance proceedings.

8. Contrary to this, the Boards of Appeal, based on Article 12, paragraph 4 RPBA, have meanwhile taken to rejecting even minor amendments in the requests, even if they are submitted together with the grounds of appeal. It should come as no surprise that the patent proprietors affected in turn regard this as abusive conduct of the Boards of Appeal. Patents are proprietary rights which presumably enjoy the special protection of each of the constitutions in the legal systems of all the contracting states (for Germany, see Article 14 paragraph 1 of the Constitution ("Grundgesetz")). The patent proprietors contributed considerable efforts for these rights in their research and development departments and paid – not least of all to the EPO – a lot of money.

In this respect as well, the petitioner is of the opinion that, although it justifies the suspicion of partiality, a petition based thereon would likely offer no chances of success in view of the cited decision by the Enlarged Board of Appeal.

9. However, the petitioner objects to a participation of the Chairman of the Enlarged Board of Appeal in the present review proceedings on the ground of a suspicion of partiality.

Neither the petitioner's staff nor its representatives in the present proceedings personally know the Chairman and – already because he was nominated by the President of the EPO and confirmed by the Administrative Council – they have not the slightest doubts about his high legal qualification and personal integrity. Before changing to the head of the Enlarged Board of Appeal the Chairman was, however, in a leading position at the EPO, and he is thus responsible for the legal practice which the Enlarged Board of Appeal has to review.

10. Article 24, paragraph 1 EPC provides that members of the Boards of Appeal or the Enlarged Board of Appeal may not take part in a case in which they participated previously. In the present case the current Chairman of the Enlarged Board of Appeal certainly did not take part for example in the decision of the Board of Appeal or in the decision of the Opposition Division. At the time, however, he had joint responsibility in the EPO specifically where the decision of the Opposition Division is concerned, for the organisation of the proceedings, thus including the present opposition proceedings.

There are thousands of highly qualified judges in the EPC contracting states, and there are many highly qualified patent judges. Why a high-ranking member of the EPO was appointed Chairman of the Enlarged Board of Appeal given the present facts, is inconceivable to the petitioner and presumably also to most users of the EPO.

11. The request to assign the matter for further processing to a different Board of Appeal than that issuing the contested decision is also meant to be regarded as a request under Article 24, paragraph 3 EPC, and is substantiated as follows:

The Board of Appeal in charge of the case thus far has obviously not considered it its duty to review the decision of the Opposition Division as to whether the procedural conduct of the Opposition Division had ensured the right to be heard under Article 113 EPC. In the contested decision, the petitioner's argument in this respect in the grounds of appeal and in the oral proceedings, which is very detailed, is dealt with under the heading „Formalities“, mentioning neither the term „Right to be heard“ nor „Article 113 EPC“. As is shown by the course of the very controversial proceedings before the Technical Board of Appeal and also in the decision, instead of reviewing the procedural conduct of the Opposition Division under Article 113 EPC, it considered it its responsibility to justify the conduct of the Opposition Division versus the petitioner, criticizing the petitioner – contrary to the case law of the Enlarged Board of Appeal and the Technical Board of Appeal – for its own supposed omissions in the request. It believes, for example, that the petitioner, notwithstanding the refusal of the Opposition Division to allow another auxiliary request, would have had to file a request, without explaining how this could have been done in practice, to „obtain an appealable decision“ (decision by the Board of Appeal, page 8, paragraph 3). In any case all the decisions by way of which an Opposition Division decides on a patent, are subject to appeal. The petitioner therefore fears that, if the Board of Appeal is once again concerned with the matter, it will – as has happened thus far – not be able to make an unbiased assessment.

C**I.****As to the admissibility of the request**

1. The request submitted initially is admissible under Article 112a EPC.

The petitioner is adversely affected by the decision placed under review because among other things its request for reimbursement of the appeal fee was dismissed.

It asserts that the dismissal of this request has a causal connection with the fact that the Board of Appeal has not taken cognizance of their written and oral argument or has not discussed their argument and thus fundamentally violated its right to be heard under Article 113 EPC. The violation is fundamental because it led to dismissal of the request. Accordingly the request is admissible in view of Article 112a, paragraph 2, letter c) EPC.

2. The petitioner was not able to raise an objection in respect of the violation under Rule 106 EPC. The fact that no cognizance was taken of its argument or that it had not been considered for the decision, only became apparent from the reasons of the decision.

Thus the request is on the whole admissible.

II.

As to the concept of the right to be heard under Article 113 EPC

1. In the decision R 1/08 dated July 15, 2008 the Enlarged Board of Appeal made reference to the travaux préparatoires for the EPC 2000 regarding the interpretation of Article 112a EPC. The document cited in this respect, CA/PL 17/00 dated March 27, 2000, in which the President of the European Patent Office communicated to the Committee on Patent Law his opinion on the extension of the competence of the Enlarged Board of Appeal, points out in Section II. No. A.5 (not cited in R 1/08 in this respect) that in the contracting states Germany, Spain, and Switzerland there exists a means of legal redress to a constitutional court against last-instance court decisions if constitutional rights are violated.
2. Regarding the interpretation of the notion of the right to be heard, the petitioner firstly refers to the case law of the Federal Constitutional Court of the Federal Republic of Germany addressed in the travaux préparatoires, which court has been gaining

experience for a number of decades in examining whether the right to be heard was granted by German courts of law.

In the decision dated April 30, 2003 (1 PBvU 1/02) the Federal Constitutional Court dealt with the review of the granting of the right to be heard by specialised courts of law.¹ We submit said decision as

Exhibit WRST 2,

the summarising press release as

Exhibit WRST 3.

3. The proceeding was about the question whether and to what extent the Constitution requires that a judge's violation of the right to be heard, which is equal to a fundamental right, can be remedied by the specialised courts of law themselves (exhibit WRST 2, reasons item 1). This case is thus similar to the case providing the Enlarged Board of Appeal with the occasion for decision G 1/97.

In previous decisions the Federal Constitutional Court had not seen the necessity for the legislator to provide an option for finding remedies by a specialised court of law in the case that a court is in violation of the right to be heard which is relevant to its decision. The First Senate of the Constitutional Court intended to dissent from this view held by the Second Senate of the Federal Constitutional Court and therefore brought the matter before the plenary session of the Federal Constitutional Court (Exhibit WRST 2, items 6 and 7).

4. Regarding the right to be heard, the Federal Constitutional Court states (Exhibit WRST 2, reasons 38, 39):

¹ Article 103, paragraph 1 of the Constitution: "In court every person shall have the right to be heard."

"The right to be heard is not only an "original procedural right" of man, but it is also an objective procedural principle which is per se constitutive for proceedings in accordance with the rule of law in the sense of the Constitution (cf. BVerfGE 55, 1 <6>). Its constitutional significance is also acknowledged in the right to a fair trial under Art. 6, paragraph 1 of the European Convention on Human Rights and in Art. 47, paragraph 2 of the Charter of Fundamental Rights of the European Union.² An individual should not only be an object of the judge's decision, but it must be given the right to speak prior to a decision affecting his rights in order to be able, as a subject, to influence the proceeding and its outcome (cf. BVerfGE 9, 89 <95>). The right to be heard ensures for the parties a right to information, comments and consideration, so that they can shape their procedural conduct autonomously and specific to the prevailing situation. In particular is it an assurance for them to be heard with statements and requests.

The option of correcting a wrongful denial of the right to be heard is correspondingly significant to legal protection. Not until such a wrong is eliminated can the right to be heard be established in the proceedings. Access to the court is then possible not only in a formal way. This creates a significant part of a justification for the legislator to expect the parties to accept the decision, possibly even with no further option of correction (see above I 2 b)."

(Underlining added)

5. Based on these considerations the Federal Constitutional Court arrived at the opinion that the German legislator must before December 31, 2004 provide the legal possibilities to establish a review of decisions by a specialist court in case of a violation of the right to be heard – unless it is already provided for.

In the opinion of the petitioner the considerations of the Federal Constitutional Court on the right to be heard can be readily transferred to an interpretation of Article 113, paragraph 1 EPC.

6. The decision by the Federal Constitutional Court differentiates between the right to information, the right to commenting, and the right to consideration (see also:

² Also the President of the EPO refers to the Charter of Fundamental Rights of the European Union in the document PL/CA 17/00.

Vollkommer in "Festschrift für Ekkehard Schumann zum 70. Geburtstag [publication in honour of Ekkehard Schumann for his 70th birthday]", published by Peter Gottwald and Herbert Roth, page 507, 519, Tübingen 2002).

The right to information is violated if a party does not receive communication intended for it.

According to Vollkommer (loc. cit.) a violation of the right to information should be categorized as a so-called "accident case". This is given e. g. if a brief is not mailed from the court to a party by mistake.

The decision R 7/09 of the Enlarged Board of Appeal dated July 22, 2009 was also based on such an "accident case" since it was obvious that the grounds of appeal in the appeal proceedings were not sent to the petitioner.

A violation of the right to commenting is given if comments by the parties do not reach the court's cognizance due to conditions having their causes within the court. Such a violation of the right to commenting is given if the court does not comprehend at all, or grossly misunderstands, the core of the parties' arguments (Vollkommer loc. cit.).

The right to be heard is also violated if the facts set forth by a party were not considered in the decision.

7. The Civil Senate X of the German Federal Supreme Court which is primarily competent in patent law, writes with reference to the decision cited above of the Federal Constitutional Court (X ZR 29/07 dated July 20, 2010):

"The imperative of the right to be heard is intended to ensure that the decisions which the courts must make are free from procedural errors which are based on cognizance not taken and not considering the facts set forth by the parties."

8. In the opinion of the petitioner the statement of facts of any party is not considered for the decision not only if no note is taken of the party's argument, which is consequently not included in the reasons for the decision either, but also and specifically to a significant extent if the court, or in the present case the Board of Appeal, does not consider statements of facts relevant to the decision.

Recently even the Enlarged Board of Appeal appears to arrive at this view, which is presently supported on the case law of the Federal Constitutional Court:

9. In the decision R 6/11 dated November 4, 2011 the Enlarged Board of Appeal – referring to the previous decisions R 2/08 and R 4/08 – still holds that the right to be heard was observed if a party had had knowledge of those arguments of the other party on which the decision is based, and thus had also had opportunity to respond to them (reasons for the decision No. 5.3).
10. In the decision R 17/11 of March 19, 2012, however, the Enlarged Board of Appeal concedes (reasons for the decision No. 4), that Art. 113 (1) EPC guarantees to the parties the right that pertinent reasons and arguments are considered in a written decision, although this would not hold indefinitely. Reference is also made to decision R 19/10 of March 16, 2011 where this view is only "basically agreed with", immediately followed by a detailed presentation of its limits (reasons for the decision No. 6.2).
11. Finally, in the decision R 8/11 of November 29, 2011 the Enlarged Board of Appeal sets forth that Art. 113 (1) EPC granted the entitlement that the adjudicating body concerned permitted the parties to set forth sufficient argument on all the substantial aspects of the case, that it furthermore takes cognizance of such argument and that it discusses it in its decision (reasons for the decision No. 1.2.9). In the opinion of the petitioner this understanding of the term "right to be heard" is largely congruent with the understanding of the Federal Constitutional Court set forth above.

In the same decision R 8/11 the Enlarged Board of Appeal furthermore concedes, making reference e. g. to Article 6 of the European Convention on Human Rights, that Art. 113 (1) EPC is a central – or even the – procedural fundamental right the ensuring of which is the primary duty of any and all constitutional jurisdiction (reasons for the decision No. 1.2.6).

III.

As to the allowability of the request

1. The present case is somewhat unusual in that the petitioner needs to prove that a fundamental procedural error by the Board of Appeal in respect of Article 113 EPC resulted in that the Board of Appeal has wrongfully assessed fundamental procedural violations before the Opposition Division as not fundamental.³

In the opinion of the petitioner this can be set forth most easily by the fact that, referring to its statement in the grounds of appeal of the appeal proceedings, it first sets forth that during the proceedings before the Opposition Division a number of fundamental procedural errors were made, and then sets forth what the fundamental procedural errors of the Board of Appeal were and why they were causal for the decision by the Board of Appeal.

2. As the grounds of appeal set forth (see page 2, item 1., No. 5), the minutes of the oral proceedings before the Opposition Division contain substantial mistakes. The petitioner has drafted a report of nine pages on the proceedings based on detailed hand-written notes taken by participants in the oral proceedings which it will be happy to introduce into the present proceedings if the Enlarged Board of Appeal wishes it to do so. However, it assumes that the Enlarged Board of Appeal will not accept such a document as evidence.

³ The wording of the Board of Appeal that the course of the proceedings before the Opposition Division was „unfortunate“ allows the conclusion that it had indeed recognized procedural errors; however, it did not – as its decision shows – consider them fundamental.

It has been stated that the proceedings were extraordinary already because at the beginning of the proceedings the petitioner did not know anything about the agenda of the proceedings. In particular did it not know:

1. which of the claims would be discussed;
 2. what grounds for opposition would be discussed in the proceedings;
 3. whether, and if so, which of the newly submitted 26 documents would be considered in the proceedings;
 4. what the opinion of the Opposition Division was regarding the newly introduced ground for opposition of inadmissible amendment;
 5. how the Opposition Division assessed the novelty and the inventive step of the independent claims in light of the 26 newly cited documents.
3. At the beginning of the proceedings the petitioner requested that the opposition be rejected and that the opponent's request be rejected as late-filed to the extent to which it was extended over the request filed within the opposition period regarding the scope, the grounds for opposition, and the newly submitted documents.

IV.

Extension of the scope of the opposition

1. The petitioner pointed out both in its written brief of June 18, 2010 (see page 1, item 1, No. 1, and page 2, item 2, No. 1) that the patent was only attacked in a limited scope.

The minutes of the oral proceedings in the opposition proceedings show in margin No. 21, in this respect correctly, that the petitioner pointed out that the opponent never attacked claim 21.

Notwithstanding the request of the petitioner the Division neither discussed nor decided whether the extension of the request for revocation of the previously non-attacked claims would be admitted.

2. It then revoked the patent also in the scope of the non-attacked claims. The petitioner's argument, in particular with reference to decision G 9/91, in which the Enlarged Board of Appeal found that the Opposition Division is bound by the scope of the attack in the notice of opposition, was not attended to by the Opposition Division. Nor did it put it up for discussion in the oral proceedings or examine in the decision to what extent the exceptional case addressed in decision G 9/91 (prima facie lack of patentability of a non-attacked dependent claim) might be given in the present case.

The Opposition Division thus, in the absence of formal competence, revoked portions of the patent which were never subject-matter of the opposition proceedings. A more fundamental procedural error can hardly be imagined.

3. Furthermore, it also violated the petitioner's right to be heard under Article 113 EPC in this way. At no time in the oral proceedings did it indicate that it was its intention to also revoke the claims not attacked by the opposition. The decision to revoke these claims was supported on grounds on which the petitioner was unable to comment and – please note – which were never indicated in the written decision.

According to established case law of the Boards of Appeal any violation of the right to be heard constitutes reasons for reimbursing the appeal fee. In the present case the proprietor moreover could only achieve a „reanimation“ of the claims revoked in the absence of formal competence in the scope of appeal proceedings anyway, because of the binding effect of the decision.

V.

**Erroneous exercise of the discretion of the Opposition Division
when dismissing the request for postponement
or when allowing new documents**

1. One month prior to the oral proceedings and on the last day of the term set for this purpose, the opponent introduced 26 new documents into the proceeding, copies of which it sent to the EPO (and to the petitioner's representatives) after expiry of the time limit. This included foreign-language documents such as a Japanese document, a translation of which was submitted. In the accompanying brief the opponent did not comment on several of these documents.

The time limit for the petitioner for filing a comment had, however, already expired and, since the Opposition Division announced in the preliminary communication their intention to reject the opposition, the petitioner had no reason to draft and file any auxiliary requests.

2. The attacked patent includes two independent claims. A rough estimate that three auxiliary requests would have been drafted for defending each independent claim and for only 20 of these documents, results in 120 auxiliary requests that the petitioner would have had to draft as a precaution.

Given this situation, it is also highly significant that with 26 new documents in the proceedings, the petitioner's representatives had no chance whatever within the time available to discuss with the inventors and the specialists at the petitioner's the contents of the cited documents and possible suitable criteria for delimiting the invention over these cited documents.

Although both representatives of the petitioner are patent attorneys who received a university education in mechanical engineering and, subsequent to their studies,

worked in this scientific field for a number of years, they never developed vacuum pumps. They are therefore unable, without consulting with the developers, to recognize in all the configurations shown in the new documents to what extent e. g. The skilled person considers them as advantageous and what are the technical problems in manufacturing and economic problems with implementing the respective teaching. These aspects can, however, be important for assessing inventive step of the teaching of the patent-in-suit in comparison against these documents. Thus, without the assistance of the developers, the petitioner is unable to set forth part of the possible arguments, so that its right to be heard is again violated.

3. The petitioner requested postponement of the proceedings in writing prior to the proceedings. In this situation there were only two alternatives available to the Opposition Division for protecting the petitioner's right to be heard:
 1. Refusing to introduce the new documents and informing the parties thereof in writing to allow them to properly prepare for the proceedings;
 - or
 2. Postponing the proceedings and drafting a new preliminary communication in which they could have expressed their view of the new documents. The petitioner would then have been able to draft and file suitable auxiliary requests prior to the rescheduled oral proceedings.

Refusal of the request for postponement is also a major violation of the petitioner's right to be heard.

4. The Opposition Division wrongfully points out that the proprietor confirmed that the documents were known to them from previous, parallel proceedings.

The petitioner pointed out expressly, and in writing, that due to the extensive work involved they were unable to verify whether these documents had already been cited in earlier, parallel proceedings (see brief of the petitioner of June 18, 2010, page 4 bottom, No. 6). This is no confirmation.

VI.

Erroneous exercise of the discretion in allowing new grounds for opposition

1. The Enlarged Board of Appeal considered it compatible with the regulations of the EPC (decision G 10/91) that by way of exception the Opposition Division considers a ground for opposition which the opponent did not assert until after expiry of the opposition period. According to the Enlarged Board of Appeal the prerequisite therefor is that the newly asserted ground for opposition is prima facie opposed to maintaining the patent.

The opponent attacked both independent claim 1 and independent claim 2 on the ground for opposition of inadmissible extension. The Opposition Division dismissed the attack on independent claim 1.

Thus it expressly stated itself that this ground for opposition is not prima facie relevant at least to this claim.

2. The petitioner only learned one month prior to the oral proceedings that this ground for opposition is asserted and only learned during the oral proceedings itself that the Opposition Division admits this ground for opposition.

The Opposition Division should have balanced against one another the legal positions ensuing from Articles 113 and 114 EPC and should then have realized that the provision of Article 113 EPC, being a fundamental procedural right, should take preference if the proprietor is confronted with a new ground for opposition as late as

during the oral proceedings. It has failed to do so, and also for this reason the decision involves a procedural error .

3. The only ground given by the Opposition Division therefor (decision page 7) consists in the pure assertion that the reasons are significant to the decision. It cannot be taken from the decision that it has made any deliberations going beyond.

Insofar that the Division asserts in the decision that the proprietor had not contested the relevance of these grounds for opposition to the decision, this is wrong. The proprietor – as a matter of course – did so at great intensity.

VII.

Violation of the right be heard by refusing to admit further auxiliary requests and by closing the proceedings while the petitioner was bringing argument regarding the submission of another auxiliary request

1. According to Rule 116 EPC, facts and evidence need not be considered if the EPO receives them after the final date fixed for making written submissions unless admitted on the grounds that the subject of the proceedings has changed.

In the present proceedings there was a major change to the subject during the oral proceedings, but the Opposition Division still permitted the petitioner to file one auxiliary request only. This single auxiliary request was already „used up“ in that the petitioner had to respond to the inadmissible amendment of claim 2 as granted – again, new facts –found by the Opposition Division.

2. Notwithstanding the above, the Opposition Division pointed out in view of the auxiliary request drafted by the petitioner for eliminating the inadmissible amendment of claim 2 found by the Opposition Division that another auxiliary request would not be admitted. The petitioner objected, referring explicitly to Rule 116 EPC and to the changed

subject due to admitting the new documents. Unfortunately this discussion is not included in the minutes.

However, the minutes correctly report that the Opposition Division did not formally pronounce the decision and that they cut off the petitioner in mid-argument by way of closing the proceedings.

The minutes literally read (margin Nos. 38-40):

„The Chairman states that thus the auxiliary request does not meet the requirements of the EPC and therefore the patent shall be revoked, in spite of amendments under Article 101 (3) (b) EPC.

The Chairman refers, in particular in view of further comments of the proprietor, to the right to appeal within two months of notification of the decision.

The Chairman closes the proceedings at 15:30 hours.“

There were thus only two minutes between the end of deliberations at 15:28 hours (margin No. 36) and the closing of the proceedings.

3. Both the non-admission of new auxiliary requests while the subject was changed and the closing the oral proceedings while a party was bringing argument represent major violations of the right to be heard.

The Board of Appeal found in its decision that independent claim 2 contained in the auxiliary request on which the Opposition Division decided meets the requirements of the EPC.

The major procedural errors of the Opposition Division, in particular the non-admission of new auxiliary requests, in spite of documents newly introduced into the proceedings, resulted in the revocation of a valuable European patent that the proprietor defended with a valid, independent claim.

4. In its decision "Sensoranordnung" ("sensor arrangement") on the German part of the European patent EP 0 866 971 (X ZR 109/08 dated September 29, 2011) the German Federal Supreme Court drafted the following headnote:

„If the subject-matter of a patent claim is found not to be patentable, then this will not readily result in that the subject-matter of a subclaim referring back thereto may likewise be regarded as not patentable.

However, the patent must also be nullified in view of the attacked subclaim if it is neither asserted, nor it is otherwise apparent that the additional features lead to a different assessment of patentability.“

Thus, the Federal Supreme Court demands an examination for patentability of the subclaims even if the proprietor does not assert these in the scope of a separate auxiliary request, if their patentability is „apparent“.

In the present proceedings the petitioner explicitly set forth that they waived independent claim 1 and the subclaims referring back thereto, if the Opposition Division considered it as not patentable. Applying the standard of the German Federal Supreme Court, the Opposition Division would then even have had the duty to examine independent claim 2 for patentability on its own.

5. In the preliminary opinion the Opposition Division had expressed that the disclosure of documents D1 – D8, which were filed with the opposition, would not oppose the maintenance of the patent in the granted version.

In contrast thereto they now set forth in the decision (opposition decision, page 10) that D7 and the common general knowledge of the skilled person alone would suffice for leading the skilled person to the subject-matter of claim 1. Although the preceding argumentation is not quite clear to the petitioner, it might possibly be understood to mean that the Opposition Division considers the subject-matter of claim 1 rendered obvious also by a combination of D7 with D2.

The Opposition Division thus deviates from its earlier assessment. It did not make it clear to the petitioner that it wished to deviate from it; and the minutes do not report anything to this effect either.

6. In its decision "Werkstück" ("workpiece") (X ZB 3/10 dated June 16, 2011) issued in an appeal case on a German utility model, the Federal Supreme Court states in the headnote:

„Only then can the court in the final decision deviate from a legal opinion expressed in a legal advice if it becomes recognizable to the parties to the proceedings – be it from the course of the oral proceedings, be it from an explicit further advice from the court – that either the basis has changed on which the court has given the original advice, or that the court, with no changes in the basis for the decision, now considers a different legal assessment than that communicated to the parties.“

The Federal Supreme Court therefore set aside the decision of the Federal Patent Court due to a violation of the right to be heard and remitted the case to the Federal Patent Court for new proceedings.

7. The Federal Patent Court, in its decision 7 W (pat) 66/09 "Vorrichtung zum Führen eines Leiterpfades für eine Schiebetür" ("Apparatus for guiding a conductor path for a sliding door") dealt with the Opposition Division's duty to give advice in oral proceedings before the German Patent and Trademark Office. The (official) headnotes read:

1. The principle of granting the right to be heard, being a general principle of a constitutional state, must likewise be observed in opposition proceedings as in all administrative procedures.
2. This principle prohibits among other things so-called surprise decisions which are given if the patent division deviates from what the parties can expect based on a reasonable consideration of the proceedings thus far (see BVerfGE 84, 188, 190; 86, 133, 144 sq.; 96, 189, 204; 108, 341 sqq.). The course of proceedings which may form the basis of expectations by the parties includes in

particular the advice given by the patent division explicitly or tacitly during the proceedings. Such an advice is not only present if a reply is given to the explicitly asked question of any party (presently: whether auxiliary requests that were brought should be filed), but even if such question remains unanswered.

3. If a patent proprietor asks the question in opposition proceedings whether it should file the auxiliary requests it brought, then the patent division is not obliged to state anything on the chances of success of the requests submitted by the patent proprietor thus far. Such advice would normally be excluded not only because the concluding deliberations of the patent division prior to pronouncing its decision have not yet taken place, and thus already for factual reasons, but it would also be inadmissible because of a breach of neutrality relative to the other parties. However, the imperative of the right to be heard requires to reply to such a question at least by pointing out that a concluding assessment of the chances of success of the previous requests is not possible so that it is on the asking party to assess whether it wishes to file the announced auxiliary requests, which when in doubt would be advisable because the outcome of the proceedings is still open. The question can by no means remain unanswered and all the less can the patent proprietor be told that submitting auxiliary requests is "unnecessary". That such answer to the question involves additional effort and time because of the following discussion also of the further auxiliary requests in the proceedings which – again under the aspect of the right to be heard – becomes necessary, is inevitable in this case.
4. If the patent division has not answered the question of the patent proprietor about filing further auxiliary requests as discussed above, then the contested decision must normally be set aside and the case must be remitted to the German Patent and Trademark Office under Sec. 79, paragraph 1, No. 1 and 2 PatG. At the same time, the principles of fairness call for ordering the reimbursement of the appeal fee under Sec. 80, paragraph 3 PatG.

Thus, while in German proceedings with the outcome uncertain, the Opposition Division must advise the patent proprietor to file auxiliary requests so as to protect the patent proprietor's right to be heard, the Board of Appeal does not even see fit to realize that it is a fundamental procedural defect that in the present proceedings the Opposition Division prevented the petitioner from filing requests.

VIII.**Decision of the Board of Appeal submitted to review**

1. The petitioner considers it sad that the Board of Appeal treats the major violation of the right to be heard which the petitioner objected to owing to the procedural conduct by the Opposition Division under the heading „Formal objections - reimbursement of appeal fee“ (decision by the Board of Appeal, page 5).

It has been set forth that the right to be heard is an elementary, fundamental right and not a formality. The choice of the heading gives rise to assume, and this is also supported by the course of the proceedings and the decision, that the Board of Appeal is not aware of the significance of this fundamental right.

2. As was set forth above, the Opposition Division committed a major violation of the petitioner's right to be heard by their procedural conduct. The petitioner illustrated this in detail both in the grounds of appeal and in the oral proceedings.

In the grounds of appeal this situation is described in a dedicated section under the heading „**VI. Violation of the right to be heard**“ which extends from page 10 to page 12 of the grounds of appeal.

3. The Board of Appeal obviously took no note of this argument set forth by the petitioner; at least it did not consider it and has not dealt with it. In its entire decision there are no reflections as to whether the petitioner's right to be heard was violated in the opposition proceedings. The term „right to be heard“ does not appear in the decision, nor can a reference to Article 113 EPC be found in the decision.

This shows that the Board of Appeal has not in the slightest dealt with the substantiation of the petitioner's request for reimbursement of the appeal fee, namely the violation of its right to be heard. Therefore this request is substantiated according to Article 112a EPC, as will be shown in detail below.

4. In the following representation the petitioner refers on the one hand to its statements in the written grounds of appeal in which it clearly set forth the rights violation, and also to its statements in the oral proceedings which, as has been set forth, extended over seven hours including breaks.

IX.

Violation of the right to be heard by not considering the argument on admission of a selection out of 26 newly submitted documents

1. The petitioner firstly points out that in its opinion the Board of Appeal examined the appeal in the wrong sequence.

The petitioner firstly (grounds of appeal, pages 2-7) discussed the patentability of the protected invention. Thereafter (grounds of appeal, pages 7-12) it commented on the procedural conduct of the Opposition Division and substantiated the request for reimbursement of the appeal fee.

2. This sequence is required in the petitioner's opinion because when examining how fundamental the procedural violation is, it is decisive among other things whether it was causal of the decision (see R 1/08, page 11, No. 3). In the present case the Board of Appeal arrived on its own at the opinion that claim 2 contained in the auxiliary request, which was examined by the Opposition Division, is patentable. A different decision would thus have ensued if a new request had been considered in which claim 1 and the claims referring back thereto were abandoned, as the petitioner announced it in the opposition proceedings.

In their decision (decision by the Board of Appeal, page 5 bottom to page 6 top), however, the Board of Appeal solely refers to the admission of documents D18 and D19, to the grounds of the Opposition Division (documents are relevant and not very

extensive), and to the fact that the petitioner was not denied commenting on documents D18 and D19.

3. The substantiation of the request for reimbursement of the appeal fee in view of considering newly submitted documents (grounds of appeal, section IV.) is set forth in the grounds of appeal on pages 8 and 9 and was discussed in detail in the oral proceedings.

The petitioner's substantiation is by no means exhausted by the fact that documents D18 and D19 have been introduced into the proceeding. In this respect it substantiates its request with the fact that the opponent submitted a total of 26 new documents and up until the oral proceedings it was not clear to the petitioner whether, and which of, these documents would be introduced into the proceedings.

4. In particular, it pointed out the paper by Pagenberg/Stauder/Singer: „ ‚Show me your best piece of prior art‘ – or: Wie kann das deutsche Nichtigkeitsverfahren kuriert werden [How to cure the German nullity proceedings]?“ (GRUR Int. 2008, page 689) (grounds for appeal, page 9 top), setting forth that such conduct makes it impossible for the Opposition Division to adequately prepare for the opposition proceedings which is why Pagenberg/Stauder/Singer arrive at the term „Nullification in self-defence“.

This tactic has worked in the present proceedings since the patent was revoked in its entirety in the first instance.

The Board of Appeal has by no means dealt with this argument. It is obvious – it does not even deal with it in the introduction to the decision – that it took no cognizance thereof.

The proprietor further literally stated in the grounds of appeal (page 9 bottom):

„Notwithstanding this, the Opposition Division communicated one day prior to the oral proceedings that the request for postponement would not be granted, and it did not make it clear until during the oral proceedings that parts of the new documents would be introduced, whereby defending the patent was made disproportionately difficult to the patent proprietor since the precaution of a careful examination of 26 documents, some of which are very detailed and complex, and additional examination of translations e. g. from Japanese, is unacceptable on the part of the patent proprietor and its representatives, within the short period granted. A decision supported on these new documents thus violates the rights of the patent proprietor under Article 113 EPC.“

Thus, the petitioner has very carefully substantiated that it was specifically the submission of the 26 documents in sum which made a proper defence impossible and violated its right to be heard under Article 113 EPC, and it pointed out that moreover at the beginning of the proceedings it had no knowledge whatever what grounds for opposition and which of the claims would be subject-matter of the proceedings.

The Board of Appeal has obviously not taken note of this statement of facts either, which is not included in the summary of the petitioner's arguments in the decision of the Board of Appeal either. At any rate it has not considered it although the violation of the provision of Article 113 EPC is expressis verbis objected to.

X.

Violation of the right to be heard by admitting new grounds for opposition

1. In respect of admitting new grounds for opposition the Board of Appeal deals solely with decision G 10/91, which was already cited above, and the question whether the asserted ground for opposition prima facie opposed the maintenance of the patent, which it affirms in view of the decision of the Opposition Division (and its own decision).

The petitioner's argument on this point is not even mentioned, let alone considered or even discussed in any way.

In this respect it must again be stated that the Board of Appeal obviously did not take cognizance of the petitioner's argument.

2. The petitioner pointed out (grounds of appeal, pages 7-8) and supplemented this in detail in the oral proceedings that new grounds for opposition were referred to more than five years after expiry of the opposition period and no justification or excuse whatever was set forth. It further pointed out that an allegedly inadmissible extension could not be present „prima facie“ already because the opponent's argumentation on this point extended over four pages.

The Board of Appeal has never dealt with all these arguments.

XI.

Violation of the right to be heard by not considering the argument on the extension of the scope of opposition

1. The Board of Appeal sets forth, correctly in this respect (decision of the Board of Appeal, page 6 bottom to page 7 top) that the Opposition Division had not commented on original claims 17, 20 and 21 and the facts thereof. It believes, however, that the Opposition Division was only able to decide on the requests submitted, and shows at least implicitly that in their opinion the revocation of these claims is the petitioner's own fault, because it had not filed a request addressed to the maintenance of these claims.

Apart from the fact that the petitioner was precisely denied the option of filing another auxiliary request after discussing the question of inadmissible extension, this was neither possible nor even necessary according to the EPC provisions and their interpretation by the Enlarged Board of Appeal.

2. The Enlarged Board of Appeal sets forth in decision G 9/91 that it is not within the competence of the Opposition Division to evaluate claims which have not been attacked by way of opposition. If no request exists and cannot exist to revoke a claim, then the proprietor need not and cannot submit a request either to maintain the claim.

This would only then be the case if the Opposition Division had made use of the option provided by decision G 9/91 by way of exception of including these claims in the scope of examination as dependent claims due to a prima facie lack of patentability.

3. However – as the Board of Appeal states, correctly in this respect – the Opposition Division has not done so.

For the present petition for review under Article 112a EPC, however, it need not be examined whether the considerations of the Opposition Division are in contradiction to the considerations of the Enlarged Board of Appeal in decision G 9/91. What is decisive here is whether the Board of Appeal has dealt with the argument of the opponent.

4. The petitioner set forth (grounds of appeal, page 10) and also set forth in detailed argument in the oral proceedings that it objected to the extension of the scope of opposition. It further set forth that the Opposition Division did not make a decision about considering the amendment to the request.

According to the petitioner's opinion held in the grounds of appeal (see also above) the Opposition Division should have informed the proprietor that it would include in the examination of the opposition claims 17, 20 and 21, which were originally not attacked, and should have given the proprietor the opportunity of commenting. Then it would have had to make an interlocutory decision, communicating it to the parties. If the result had been that claims 17, 20 and 21 were to be included in the scope of

examination of the opposition, then it would further have had to give the petitioner the opportunity under Rule 116 to draft and file pertinent requests.

5. The Board of Appeal never dealt in the slightest with the petitioner's statement that claims 17, 20 and 21 were included in the scope of examination without any decision. Either it never took note thereof, or at least it did not consider it, whereby the right to be heard was again violated by the Board of Appeal.

XII.

Violation of the right to be heard by not considering the argument on non-admission of new requests

1. The statements of the Board of Appeal on the fact that the Opposition Division has not admitted new requests can be understood to mean that in the end it is the petitioner's own fault that no new requests were considered.

In respect of this item it is particularly apparent that the Board of Appeal never dealt in the slightest with the petitioner's argument .

2. The petitioner set forth both in writing and orally in detail that in such proceedings it is not correct and it is a violation of both Art. 113 EPC and Rule 116 EPC if one of the parties is permitted shortly prior to the oral proceedings to follow up with new grounds for opposition and documents, and on the other hand the proprietor is then denied the option to draft new claims which – as the petitioner explicitly pointed out – would only be a combination of the granted claims or a waiver of an independent claim and the subclaims referring back to it.

The Board of Appeal obviously took no note of this argument; at least it did not consider it.

In particular has the Board of Appeal not dealt with the petitioner's statement that it was denied the opportunity of filing new requests.

3. It has been set forth that the petitioner did not learn until during the oral proceedings that the newly asserted ground for opposition „inadmissible extension“ was admitted to the proceedings and that documents D18 and D19 out of the 26 newly submitted documents were admitted to the proceeding. This new fact only ensued in the oral proceedings, and this is why the petitioner was unable to draft requests before. It was thus in particular unable to „pull out of the pocket“ ready-made requests, presenting these to the Opposition Division.

The petitioner set forth literally (grounds of appeal, page 11):

„Following the deliberations of the Opposition Division about the proposal of accordingly amended patent claims, the Chairman, contrary to usual practices at the European Patent Office, simply closed the oral proceedings, refusing to allow requests of the patent proprietor for limiting the patent in the scope of the subclaims. Such requests do not introduce into the proceedings any new subject-matter, but only result in a reduced scope of protection, so that they cannot be regarded as late in oral proceedings, and a refusal to admit them is a violation of the right to be heard. Although the patent proprietor clearly set forth during the proceedings that it would optionally limit itself to a combination of the granted claims, the Opposition Division solely dealt with claims 1 and 2, not discussing the subclaims, but to the contrary cut the patent proprietor off from the opportunity to file meaningful auxiliary requests.“

The Board of Appeal never in the slightest dealt with all of these facts set forth by the petitioner, which the petitioner supplemented in detail in the oral proceedings.

4. The petitioner requested reimbursement of the appeal fee because of the major violation of its right to be heard. Instead of discussing this question, the Board of Appeal makes considerations about whether the petitioner could have considered any alternative actions, and if so which. This is not the question presently. The duty of the Board of Appeal is solely to examine whether the petitioner's right to be heard was violated.

In particular, however, the Board of Appeal has not considered the petitioner's statements that, up until being cut off in mid-speech, the petitioner was denied the opportunity of submitting a new request.

This is shown by its statements that the petitioner should have filed auxiliary requests despite the refusal of the Chairman. As has been set forth, the Chairman cut off the argument of the petitioner on new auxiliary requests so as to close the oral proceedings. How should a party file a request if the Chairman declares in mid-argument that he closes the oral proceedings?

The petitioner has clearly set forth that this is how it was, and this can moreover be taken from the minutes. The Board of Appeal does not deal with this argument at all and violates the petitioner's right to be heard itself in this point as well.

XIII.

**Violation of the right to be heard
by not considering the argument on the request for postponement
of the oral proceedings before the Opposition Division**

1. With telefax of June 18, 2010 the petitioner requested (see page 7) to postpone the oral proceedings in case the Opposition Division intended to admit the newly submitted documents into the proceedings.

As a reminder:

At the beginning of the proceedings the petitioner did not know

1. which of the claims would be discussed;
2. what grounds for opposition would be discussed in the proceedings;

3. what the opinion of the Opposition Division was on the allowability of the new ground for opposition of inadmissible amendment;
4. whether, and, if so, which of the newly submitted 26 documents would be considered in the proceedings;
5. what the opinion of the Opposition Division was regarding the newly introduced ground for opposition of inadmissible amendment;
6. how the Opposition Division assessed the novelty and the inventive step of the independent claims in light of the 26 newly cited documents.

The grounds of appeal read (see page 9) – this has been discussed in detail in the oral proceedings – that the proprietor was impeded in defending the patent in a way violating its right to be heard, since the Opposition Division refused to postpone the oral proceedings while still including into the proceedings new documents as a selection out of a large number of new documents, and a new ground for opposition.

2. The fact that this argument of the proprietor is correct with respect to the facts can already be taken from the revocation of the patent although patentability is given. Had the oral proceedings been postponed, the Opposition Division would have had opportunity to inform the petitioner that it intended to include in the proceedings the new grounds for opposition, and which documents it intended to consider, and the petitioner would then have had the opportunity to make adequate preparations for the oral proceedings and to draft appropriate auxiliary requests in the written proceedings.
3. Again, the Board of Appeal does not in the least deal with this argument by the petitioner in its decision. The petitioner's request for postponing the oral proceedings is not even mentioned in the entire decision of the Board of Appeal. Thus, the decision

of the Board of Appeal has again not taken cognizance of this argument of the proprietor, or at least it was not considered.

The request to set aside the decision of the Board of Appeal and to remit the matter to a different Board of Appeal for new proceedings is thus substantiated.

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Conclusion

1. The undersigned conducted over 200 oral proceedings in first-instance opposition proceedings before the European Patent Office. In the great majority of these proceedings the Opposition Divisions made careful efforts to give the parties sufficient opportunity to present their views, even if some of the proceedings extended into the late evening or the proceedings had to be postponed, unless the proceedings had not been scheduled for several days anyway, e. g. in the case of multiple opponents. In particular, the Opposition Divisions normally enable the proprietor to appropriately defend the patent by way of amending his requests according to the course of the proceedings. The undersigned has thus far never experienced oral proceedings before an Opposition Division that got out of hand quite like it happened in the present case.

For such an exceptional case the EPC provides means, in particular by way of Rule 103 EPC, which give the Board of Appeal, or, in the case of interlocutory revision, the department whose decision was impugned, the opportunity to establish a significant procedural defect, and to order reimbursement of the appeal fee.

If, however, as is presently the case, the Board of Appeal itself refuses to realize substantial procedural defects even in such an exceptional case, then the Opposition Divisions who take great care when conducting opposition proceedings to observe the

provision of Article 113, paragraph 1 EPC, need to ask themselves whether the input required therefor is at all justifiable.

2. It must further be feared that the decision by the Board of Appeal, which is available to the public after all, will show devastating effect on the course of future opposition proceedings.

Although the Board concedes in something like an obiter dictum that the course of the oral proceedings could not be called „fortunate without restrictions“, it still does not see fit to recognize a substantial procedural error. The petitioner considers this characterisation of proceedings that resulted in the unjustified loss of a valuable patent as most inappropriate.

3. The decision of the Board of Appeal opens up an entirely new tactic for future opposition proceedings. An opponent who considers a number of well-founded grounds for opposition can limit itself within the opposition period to submitting the less relevant grounds for opposition. The really relevant grounds for opposition and in particular the relevant documents will then not be filed until the very last date possible prior to the oral proceedings. Since, according to the Board of Appeal in this decision, it is solely relevant whether the grounds for opposition and the newly submitted documents are prima facie relevant, the Opposition Division must include them in the proceedings according to the opinion presently held by the Board of Appeal. If the proprietor then – as in the present case – is prevented, contrary to Rule 116 and Article 113 EPC, from responding to the course of the proceedings with appropriate auxiliary requests, then even a patent protecting a valuable and patentable invention, as in the present case, can be revoked in its entirety.

The petitioner fails to understand that this should be in conformity with the provisions of the EPC.

This only relates to the substantive part of the decision of the Board of Appeal though. The petition for review is of course solely supported by the fact that the Board of Appeal has not taken cognizance of, or has not considered, the petitioner's arguments in written and oral proceedings.

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European Patent Attorney

Enclosures:

Contested decision of the Board of Appeal T2097/10-3.2.04 of July 12, 2012
WRST 1 Minutes of the oral opposition proceedings of June 22, 2010
WRST 2 Decision 1 PBvU 1/02 of the Federal Constitutional Court of April 30, 2003
WRST 3 Press release on the decision 1 PBvU 1/02
Form 1010, 2,760 Euros