

Pending Petitions for Review before the Enlarged Board of Appeal

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1. Introduction

EPC 2000 entered into force on **December 13, 2007**.

One of the changes was the introduction of a petition for reviewing decisions of the Boards of Appeal.

1. Article 112a EPC

„(1) Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review of the decision by the Enlarged Board of Appeal.“

1. Article 112a EPC

(2) The petition may only be filed on the grounds that:

(a) a member of the Board of Appeal took part in the decision in breach of Article 24, paragraph 1, or despite being excluded pursuant to a decision under Article 24, paragraph 4;

(b) the Board of Appeal included a person not appointed as a member of the Boards of Appeal;

(c) a fundamental violation of Article 113 occurred;

(d) any other fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings; or

(e) a criminal act established under the conditions laid down in the Implementing Regulations may have had an impact on the decision.“

1. Article 112a EPC

(3) The petition for review shall not have suspensive effect.

(5) The Enlarged Board of Appeal shall examine the petition for review in accordance with the Implementing Regulations. If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision and shall re-open proceedings before the Boards of Appeal in accordance with the Implementing Regulations.

1. Rule 106 EPC

A petition under Article 112a ... is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

2. Pending Petitions for Review

Case **R1/08**: Petition for Review under Art. 112a EPC against the decision of 17.12.07 of the Technical Board of Appeal 3.3.02 in case T1344/05 (EP 97600009.1 / Publ.No. 916347).

Case **R2/08**: Petition for Review under Art. 112a EPC against the decision of 28.1.08 of the Technical Board of Appeal 3.2.03 in case T0843/05 (EP 00936978.6 / Publ.No. 1181422).

Case **R3/08**: Petition for Review under Art. 112a EPC against the decision of 21.2.08 of the Technical Board of Appeal 3.2.06 in case T1623/06 (EP 01943244.2 / Publ.No. 1328375).

Case **R4/08**: Petition for Review under Art. 112a EPC against the decision of 29.2.08 of the Technical Board of Appeal 3.2.05 in case T1094/05 (EP 98116534.3 / Publ.No. 0879703).

3. Case R 1/08

The Proprietor-Respondent filed a Petition for review of this decision on 3 April 2008 on the grounds of:

Article 112a (2)c) EPC that fundamental violations of Article 113. EPC had occurred.

Article 112a (2)d) EPC that a fundamental procedural defect, as defined in the Implementing Regulations to the said provisions, had occurred in the appeal proceedings; this defect arising from the lack of reasoning with respect to the auxiliary request in the decision for which the review is sought.

3. Case R 1/08

Proprietor's arguments:

Neither before nor after the submissions in the oral proceedings did the Board give any opinion or raise an objection with regard to the inventive Step of the subject matter claimed in the auxiliary request.

The Board closed the debate and after deliberation announced the decision that the patent was revoked.

3. Case R 1/08

Proprietor's arguments:

In the written procedure the non-attending Appellant-Opponent I had not raised any objection against the subject matter of either request. In addition, the Board of Appeal had not expressed any objections or opinions in respect of the auxiliary request in either the written procedure or the oral proceedings.

Therefore, the Proprietor-Respondent was not given the opportunity to reply to the negative approach of the Board of Appeal in its assessment of the merits of the auxiliary request.

3. Case R 1/08

Proprietor's arguments:

During the oral proceedings the Proprietor-Respondent, who attended in the absence of Appellant-Opponent I, relied on an advantage arising from a technical feature in the Claim in order to support his arguments in favour of inventive step of the subject matter claimed in his main request.

3. Case R 1/08

Proprietor's arguments:

The Board, however, refused to consider this argument on the ground that *"the advantages were raised for the first time during the oral proceedings in the absence of the appellant, with the result that the alleged effect cannot be taken into account for the assessment of inventive step"*. This would be tantamount to an extension or Prolongation of the rights of a voluntarily absent party, and the decision of the Enlarged Board of Appeal G 4/92 should not be read in this sense.

3. Case R 1/08

The Petitioner raised no objection regarding procedural defects during the oral proceedings held on 17 December 2007 before the Board of Appeal because written decision is alleged to be based on grounds and arguments which the patent proprietor was not aware of and the alleged harmful event took place after deliberation. At that time, the debates were closed and the Petitioner was no longer entitled to file any submissions or objections.

3. Case R 1/08

The Enlarged Board of Appeal accepted the conclusion that the Petitioner was unable to raise the objections during the oral proceedings and, therefore, the Provision of Rule 106 EPC in *fine* applies.

3. Case R 1/08

In the case in suit the Petitioner acknowledged that the Board of Appeal "*asked the representative to provide his argument with respect to the inventive step of the subject-matter of the Auxiliary Request*" and that the Board raised no objection with regard to the admissibility of said request. It is in such a case not convincing when the attending party Claims to have been taken by surprise; on the contrary, it was made aware of the Board's intention to deal with the merits of the auxiliary request.

3. Case R 1/08

Arguments of the Enlarged Board:

The reasoning given by the Board of Appeal in respect of the auxiliary request is directly related to the arguments put forward in writing by the Proprietor-Respondent, and hence is based on "grounds or evidence" on which the party concerned had the opportunity to comment,

No Provision of the EPC requires that a Board of Appeal must provide a party with all foreseeable arguments in favour or against a request in advance

3. Case R 1/08

Result:

The petition for review was not allowed

4. Cases R 2/08-R4/08

Arguments:

R 2/08: The board did not consider the newly-filed ground of opposition of lack of novelty.

R3/08: Technical Experts announced to speak at the oral proceedings were not heard.

R4/08: The patentee was not heard with regard to the auxiliary requests which were considered to suffer from the same problems as the main request.



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