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SUBJECT: **Petition for review
according to Art. 112a EPC 2000**

PURPOSE: For information

DISTRIBUTION: Delegates

Information Paper

Petition for review according to Art. 112a EPC 2000

Under EPC 2000 (in force since 13 December 2008) it is for the first time possible for the Enlarged Board of Appeal ("EBA") to correct decisions of Appeal Boards which have been based on essential procedural errors (Art. 112a EPC).

The petition, however, may only be filed on specific, limited grounds, for example that a violation of the right to be heard (Art. 113 EPC) or another fundamental procedural defect (failure to arrange for the holding of oral proceedings requested by the petitioner; decision on the appeal was taken without deciding on a request relevant to that decision; Rule 105 IR EPC) occurred, or that the decision was significantly influenced by an established criminal act (Rule 105 IR EPC).

Up to date, four such requests have been filed, all relating to appeals in opposition cases (appeal nos. R 1/08 to R 4/08). These are now also available in the internet (http://www.epo.org/patents/appeals/petitions_en.html). Not surprisingly, all petitions have been based on the ground that the right to be heard was violated during appeal proceedings. In R 1/08 and R 3/08 the petition was also based on further fundamental procedural defects.

In the case R 1/08 the petitioner alleged a violation of the right to be heard in the fact that neither the Board of Appeal (nor the opponent) raised any objections against the auxiliary request during the written procedure. This request had only been discussed at the hearing (in which the opponent did not participate). This discussion, however, only consisted in the argumentation of the petitioner in favour of inventive step of the subject matter of the auxiliary request. Then the Board revoked the patent. In the written decision the inventive step of the auxiliary request was denied based on the same reasons as the main request without a detailed or separate discussion. Therein, the petitioner also recognised a substantial procedural violation. Another procedural deficiency was recognized by the petitioner in that the Board did not take further arguments with respect to advantages of the invention into consideration which were presented during oral hearing, because the other party (the opponent) had not taken part in the hearing.

In the case R 2/08 the (petitioning) opponent raised a lack of novelty attack, however, without providing evidence for this. A document which – according to the petitioner – destroys novelty of the opposed patent was identified only in the appeal proceedings. The lack of novelty argument was not accepted by the Board (ground filed too late). To that end, the GBK regarded this petition in a preliminary opinion as "evidently unfounded" (because the allegedly novelty destroying document was already considered by the Board in the decision with respect to inventive step (the Board felt that this document – in combination with another document – could not make the subject matter of the opposed patent obvious)) and the petitioner was therefore asked to comment.

Case R 3/08 was based on the rejection of the Board during oral proceedings to let an expert of the patent proprietor speak to an alleged essential misinterpretation of the invention by the Board. In addition, the petitioner also alleged that the right to be heard was violated because the Board of Appeal had refused that the hearing be postponed because the petitioner's preferred representative could not participate at the summoned date and therefore the representative of the written procedure has also to represent in oral

proceedings. Finally, a key procedural deficiency was also seen in the refusal of the Board to consider a late filed auxiliary request of the petitioner in proceedings. Quite surprisingly, the Opposition Division now scheduled for oral proceedings for 25 September 2008. It is not visible from the file whether the date is now possible for the preferred representative to participate and whether the expert is supposed to speak at this hearing. There is nothing available in the file which shows the reasons for this summons.

The most interesting question to be answered by the EBA seems to be present in case R 4/08. In these proceedings a claim feature, which was against Art. 123 (2) EPC (as not being present in the application as filed), was replaced immediately (1 month) before the oral hearing by a feature from the description (with a 24-page writ, containing 7 requests and about 6 cm paper). The petitioner (as opponent) requested to postpone the hearing to appropriately analyse the new claims. The Board did not allow this request. During the oral hearing the petitioner regarded himself as being unable to discuss the admissibility of the newly submitted claims because of too little time available before the hearing to review the newly submitted documents and requests.

In the now given the first decision on a review case in R 1/08 the EBA first clarified the nature of the review process as an extraordinary opportunity to correct clear procedural deficiencies in the framework of the appeal proceedings. The EBA made clear that this instrument is not a "third instance", which deals with substantive issues. Therefore, the procedure under Art. 112a EPC has to be applied very strictly and is exclusively restricted to the reasons referred to in Art. 112a EPC.

Thus, the GBK stated that in the case of a petition based on a violation of the right to be heard, the petitioner "has to establish firstly that the decision under review is based on an assessment or on reasoning relating to grounds or evidence which the adversely affected party was not aware of and had no opportunity to comment upon, and secondly that a casual link exists between this procedural defect and the final decision, otherwise the alleged defect could not be considered decisive and hence not fundamental"(see item 3 of the Reasons).

According to the EBA, these conditions were not given here. On the contrary, the Board of Appeal's decision was regarded as having been taken on the basis of the arguments provided in the written procedure. In addition, it was clarified by the EBA that there is no obligation on the Boards of Appeal to inform a party on all possible arguments in advance of the oral hearing. No violation of the right to be heard was therefore seen.

With respect to the argument regarding the rejection of the further arguments to inventive step, the EBA analysed that the deciding Board rejected these arguments only "inter alia" because the opponent had not attended the oral hearing. The main reason for rejection of these arguments was the lack of substantiation of the advantages of the invention. Accordingly, also here, no essential procedural violation was seen.

In view of this – first – decision it may be assumed that the present instrument will indeed be treated very strictly and straightforward by the EBA so that only in very exceptional cases, the decision of the Appeal Board may be expected to be reversed. This decision already gives clear guidance with respect to the substantiation of violations of the right to be heard so that it can be expected that also the three other cases still pending have only limited likelihood of succeeding.

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23 August 2008