



**FÉDÉRATION INTERNATIONALE DES CONSEILS EN PROPRIÉTÉ INDUSTRIELLE
COMMISSION D'ÉTUDE ET DE TRAVAIL (CET)**

CET WORKING DOCUMENT

SUBJECT:	Petition for Review under Art. 112a EPC: The Enlarged Board of Appeal's practice with respect to violations of the right to be heard (Art. 113 EPC)	DATE:	4 December 2009
PURPOSE:	Information	REFERENCE:	EXCO/AR10/CET/1404
AUTHOR:	Daniel Alge	MEETING:	ExCo Buenos Aires, Argentina
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The Enlarged Board of Appeal's practice with respect to violations of the right to be heard (Art. 113 EPC) in cases for Petition for Review under Article 112a EPC

With the EPC 2000 (in force since 13 December 2007) the possibility for reviewing decisions made by the Boards of Appeal of the European Patent Office was introduced. It allows a party to appeal proceedings which was adversely affected by the decision of the Board of Appeal to file a petition for review if fundamental procedural violations had happened during appeal proceedings.

About twenty cases have now already been decided by the Enlarged Board of Appeal of the EPO (EnBoA). Most of these cases raised violations of the right to be heard during appeal proceedings. Up to now, only one of these cases ended in a successful challenge of the appeal decision (Case R 7/09, decided 22 July 2009).

In this case the patentee received a favourable decision by the Opposition Division. The opponent filed a notice of appeal that was delivered and received by the patentee. Then, the opponent filed the statement setting out the grounds of appeal. The responsible Registrar prepared a communication with this statement addressed to the proprietor's representative, setting out the usual four months date to reply to this notification". A copy of that communication and, previously, of the statement of grounds was entered in the (electronic) file. However, this communication had not reached the representative's office, to which it should have been sent by registered letter (at least the European Patent Office was not able to establish delivery of the critical communication: the Enlarged Board of Appeal was informed by the Supervisor of the EPO Mailroom Munich that no record of dispatch for that communication could be located).

As the patent proprietor did not submit any reply and the opponent had asked for oral proceedings only as an auxiliary request, the Technical Board of Appeal (TBA) entirely revoked the patent without oral proceedings.

Based on these circumstances, the patentee requested this Petition for Review, because he had not been given the opportunity to be heard in the appeal proceedings, contrary to Article 113 EPC (right to be heard), so that Article 112a(2)(c) EPC was met. The case was therefore re-opened before the TBA.

The EnBoA also dealt with the question whether the fact that the grounds of appeal were readily available to the public by electronic file inspection. The EnBoA made clear that this opportunity has no bearing on the right of parties to proceedings before the EPO, including appeal proceedings, to be individually and specifically informed by the Office as prescribed in the EPC, e.g. by Rule 100(1) in



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conjunction with Rule 79(1) EPC. The parties must be able to rely on the Office complying with the relevant provisions of the EPC (e.g. appropriate delivery of communications). It follows that at least for the purposes of Article 113(1) EPC, the parties and their representatives have no duty to monitor the proceedings themselves by regularly inspecting the electronic file.

However, more interesting is that the EnBoA already has provided guidelines under which a petitioner succeeds under this head (violation of Art. 113 EPC). In order to prevail on this issue:

- (1) A petitioner has to establish 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
- (2) The petitioner also has to prove that a causal link exists between this procedural defect and the final decision, otherwise the alleged defect could not be considered decisive and hence not fundamental.

These two grounds have already been provided in a number of decisions (R 1/08, R 11/08, R 6/09, R 13/09).

A Petition for Review is only admissible where an objection in respect of the procedural defect was already raised during the appeal proceedings and dismissed by the Board of Appeal (except where such objection could not be raised during the appeal proceedings).

Valid objections must – as defined in case R 4/08 (and many of the following decisions) – fulfil two criteria:

- (1) the objection must be expressed by the party in such a form that the Board of Appeal is able to recognize immediately and without doubt that an objection pursuant to Rule 106 EPC – that is one which is additional to and distinct from other statements, in particular arguing or even protesting against the conduct of the proceedings or against an individual procedural finding (here: the admission of amended claims into the proceedings) – is intended by the party concerned. This is a precondition for the Board to have been able to react immediately and appropriately by either removing the cause of the objection or, as provided in Rule 106 EPC, by dismissing it. It therefore ensures for the parties and the public at large, legal certainty as to whether the substantive decision of the Board of Appeal is open to review pursuant to Article 112a EPC. This is one of the evident purposes of the obligation to raise objections under Rule 106 EPC.
- (2) For the same reason the objection must be specific, that is the party must indicate unambiguously which particular defect of those listed in paragraph 2(a) to (c) of Article 112a and Rule 104 EPC it intends to rely on. This also follows from the wording of Rule 106 EPC itself: “A petition under Article 112a, paragraph 2 (a) to (d), is only admissible where an objection in respect of the procedural defect was raised ...“. A party who objects for instance to a board member allegedly having taken part in the decision under appeal (Article 112a(2) (a) EPC) cannot thereby acquire the right to a review in respect of e.g. a purported violation of Article 113(1) EPC (Article 112a(2) (c) EPC) or any ground under Article 112a(2) (e)/Rule 104 EPC.

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