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**Datasheet for the decision
of the Enlarged Board of Appeal
of 30 April 2010**

Case Number: R 0004/09
Appeal Number: T 0982/07 - 3.2.01
Application Number: 00988834.8
Publication Number: 1222107
IPC: B63B 25/18
Language of the proceedings: EN

Title of invention:

Method and arrangement for shipping reels; tweendeck and tweendeck arrangement in cargo space of ship

Patentee:

OY Langh Ship AB

Opponents:

Flinter Groningen B.V.
Wijnne & Barends 'Cargadoors-en Agentuurkantoren B.V.

Headword:

-

Relevant legal provisions:

EPC Art. 112a, 113(1)
EPC R. 106, 107, 124(1)

Keyword:

"Petition for review - clearly unallowable"

Decisions cited:

G 0005/88, G 0002/97, G 0001/99



Case Number: R 0004/09

D E C I S I O N
of the Enlarged Board of Appeal
of 30 April 2010

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(Patent Proprietor)

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Decision under review:

**Decision of the Technical Board of Appeal
3.2.01 of the European Patent Office of
23 October 2008.**

Composition of the Board:

Chairman: P. Messerli
Members: J.-P. Seitz
F. Edlinger

Summary of Facts and Submissions

I. Oy Langh Ship AB was the proprietor of European patent No. 1222107 disclosing a method for loading or shipping heavy reels on board a ship.

II. This patent was revoked by decision T 982/07 of the Technical Board of Appeal 3.2.01 pronounced at the issue of oral proceedings held on 23 October 2008, and posted on 20 January 2009.

Said decision was corrected in application of Rule 89 EPC 1973 by a further decision dated 12 March 2009.

III. The appeals of the opponents constituting the subject-matter of the decision for which review is sought, were directed against the interlocutory decision of the opposition division dated 25 April 2007 according to which, account being taken of the amendments made by the patent proprietor (current petitioner) during the opposition proceedings, European patent No. 1222107 and the invention to which it relates were found to meet the requirements of the EPC 1973.

IV. The patent had a filing date of 22 December 2000 and claimed priorities from various former applications, the earliest and latest having the following filing dates:

PR1: 30 December 1999;

PR5: 11 December 2000.

Document D18: "Coil decks raise comfort level",
MacGregor News, MacGregor Group AB, Issue 141 Autumn

2000, played a role in the appeal proceedings and was published after the first but before the last priority date.

V. Initially the patent proprietor requested that the appeals be dismissed. After having received a communication by the Board in which it indicated its provisional opinion that the claims as approved by the opposition division were unclear and included subject-matter extending beyond the original disclosure, the respondent filed amended sets of claims according to a main and three auxiliary requests.

VI. At oral proceedings held on 23 October 2008 both appellants requested the revocation of the patent. The patent proprietor (respondent) requested that the patent be maintained in amended form on the basis of the claims according to the main request or subsidiarily according to the first or second auxiliary requests respectively corresponding to the second and third auxiliary requests filed on 22 August 2008.

The debate was then closed and after deliberation the Board gave its decision to set aside the impugned decision and to revoke the patent.

VII. The reasons of this decision were posted to the parties on 20 January 2009.

Relying on Article 112a EPC the patent proprietor (hereinafter petitioner) filed on 27 February 2009 a petition for review by the Enlarged Board of Appeal requesting that:

- (1) the petition be allowed on the grounds presented in the corresponding request, and that the decision of the Technical Board of Appeal 3.2.01 issued 23 October 2008 in case T 982/07 be set aside;
- (2) pursuant to Rule 108(3) EPC reopening of the proceedings before the Technical Board of Appeal preferably in a new composition be ordered;
- (3) pursuant to Rule 110 EPC reimbursement of the fee for petition of review be ordered.

No oral proceedings have been requested.

The petitioner, who is adversely affected by the decision of the Technical Board of Appeal, bases its petition for review on the following grounds:

- (1) a fundamental violation of Article 113 EPC occurred in the course of the appeal proceedings when the Board based its decision on grounds on which the proprietor did not have an opportunity to comment (Article 112a(2)(c) EPC); and/or
- (2) a fundamental procedural defect defined in the Implementing Regulations occurred in the appeal proceedings (Article 112a(2)(d) EPC).

VIII. Aware of the provisions of Rule 106 EPC in respect of the admissibility of petitions for review, the petitioner put forward that the Board had found that the decision by the Enlarged Board of Appeal in G 1/99 concerning prohibition of *reformatio in peius* was a

hindrance for the amendment of claims to the detriment of the appellants. During the oral proceedings, the Board noted that decision G 1/99 prohibits *reformatio in peius*. This decision had not been presented earlier. The patentee studied the contents of G 1/99 after the end of the appeal proceedings, and noted that G 1/99 in fact provided an exception to the principle of prohibition. However, this incorrect citation of case law was later modified in the written decision, where the Board has changed its position and notes now that G 1/99 provides an exception to the prohibition of *reformatio in peius*. Notwithstanding, although it discussed the exception in the written decision, the Board did not apply it. This sequence of events effectively deprived the proprietor of a possibility to raise an objection in respect of a procedural defect during the appeal proceedings and to comment on the grounds on which the Board later, in the written decision, based its decision.

As a consequence the Board has revoked the patent directly after its deliberation and has further based its decision in writing on grounds that were not spelt out during the oral proceedings.

Hence these circumstances fulfil the requirements set out in R 1/08 namely that:

"the decision is based on reasoning relating to grounds which adversely affected the patent proprietor and which the patent proprietor had no opportunity to comment upon, and a causal link exists between the procedural defect and the final decision." (quote from

R 1/08 by the petitioner on page 2, point 7 of the petition).

For these reasons the petition for review must be considered as admissible since the petitioner had no possibility, being ignorant of the final reasoning of the Board, to raise an objection in the course of the oral proceedings.

- IX. During said oral proceedings the Board came to the conclusion that the main request was not entitled to the earliest claimed priority and that in respect of Document D18 becoming state of the art under Article 54(2) EPC 1973, the claimed invention was obvious.

Turning to the auxiliary requests the Board considered that they were indeed broader in scope than the claims maintained by the opposition division, and therefore would put, if allowed, both appellants (opponents) in a worse situation than if they had not appealed.

- X. The Board of Appeal further stated that, following the reasoning in G 1/99, the patent proprietor was not entitled to rely on the exception this decision made to the principle of prohibition of *reformatio in peius*, since the revocation of the patent by the Board was not the direct consequence of an inadmissible amendment held allowable by the opposition division in its interlocutory decision.

Indeed for the Board this situation did not arise in the case under consideration because the amendment in

question although not being entitled to priority did have a basis in the application as originally filed.

The amendment therefore was not inadmissible and did not have the direct consequence that the patent would have to be revoked.

XI. After notification of the decision in writing the patent proprietor first became aware of the reasoning underlying the rejection of the auxiliary requests. He now contends that in the course of the oral proceedings he was wrongfully informed of the real ambit of decision G 1/99 which actually provides for an exception to the principle of prohibition of *reformatio in peius* whereas on the contrary during oral proceedings said decision G 1/99 was alleged to establish said prohibition.

XII. The petitioner was therefore unable to raise a corresponding objection during the course of the oral proceedings. Furthermore a causal link exists between the alleged procedural defect and the final decision which affected the patent proprietor.

Therefore the petition for review filed on 27 February 2009 fulfilled the prerequisite set out in Rule 106 EPC and should be considered as formally admissible.

XIII. As regard the merits of its petition the petitioner brought forward the following:

(A) He was not entitled to appeal against the decision of the opposition division maintaining the patent

in an amended form corresponding to its main request.

- (B) While first requesting the rejection of the appeals of both opponents he duly defended its patent in the version accepted by the opposition division in the decision under appeal.
- (C) Becoming aware through a communication of the Board dated 18 June 2008 of the objections this body had in respect of the disclosure, in the priority document PR1, of an expression of the claims maintained by the opposition division, the patentee respondent filed amended sets of claims on 22 August 2008 according to a main and three auxiliary requests.
- (D) The Board found that the claims of the main request were not entitled to the first claimed priority and rejected them.
- (E) Turning to the auxiliary request which it found broader in terms of scope of protection conferred the Board relying on the principle established in decision G 1/99 considered that their admission would infringe the principle of *reformatio in peius*.
- (F) Precisely contrary to the erroneous assertions made by the Board during oral proceedings, said decision G 1/99 provides for an exception to the prohibition of *reformatio in peius*, in favour of a non-appealing patentee whose patent would otherwise have to be revoked.

(G) The information given to him by the Board was misleading and put him in a position where he had no available remedy. Further the Board failed to apply the teaching of G 1/99 in respect of the exceptions to the principle of prohibition of *reformatio in peius*.

(H) Furthermore the Board has violated the provision of Article 112a(2)(d) EPC, more precisely, those of Rule 104(b) EPC by dismissing the auxiliary requests with grounds that are in contradiction to the ratio of G 1/99.

Reasons for the Decision

1. *Admissibility of the petition*

1.1 The petition duly contains the name and address of the petitioner, it identifies the decision to be reviewed and indicates the reasons the petitioner has for setting aside said decision as well as the facts and evidence it is based upon.

The provisions of Rule 107 EPC are insofar fulfilled.

1.2 The petition for review is based on paragraph 2(c) and (d) of Article 112a EPC, and was filed on 27 February 2009, i.e. within two months of notification of the decision posted on 20 January 2009 and deemed received on 30 January 2009.

The prescribed fee was paid on 26 February 2009.

The provisions of Article 112a(4) EPC are therefore also fulfilled.

- 1.3 Although no objection in respect of the alleged procedural defect had been raised during the appeal proceedings (here during the oral proceedings) the Enlarged Board of Appeal is of the opinion that such an objection could not have been raised before the petitioner became aware of the grounds of the decision in writing posted for notification on 20 January 2009, which he now contends to be in direct contradiction with the misleading explanations and indications he received from the Board in the course of said oral proceedings.

The provisions of Rule 106 EPC are insofar fulfilled.

- 1.4 Hence the petition for review is admissible.

2. *Allowability of the petition for review*

- 2.1 The Enlarged Board of Appeal in its current composition of two legally qualified members and one technically qualified member shall only reject under Rule 109(2)(a) EPC a petition which is clearly inadmissible or unallowable; such decision requiring unanimity.

- 2.2 In the case in suit the petition is based on the alleged misleading information given by the Board during oral proceedings which according to the petitioner constituted a fundamental violation of Article 113 EPC, since the Board adopted in its reasoning in writing a completely contrary approach to

the indications it gave in the oral proceedings, thus depriving the petitioner of its right to comment on the grounds that directly caused the revocation of the patent.

2.2.1 *De facto* the petitioner has the burden of the proof of its allegations.

In the present case the Enlarged Board of Appeal can only come to the conclusion that he failed to discharge this onus for the following reasons.

For the purpose of the present proceedings the statement of events filed together with the petition can be deemed as presented in good faith and to reflect the development of the oral proceedings when the Board came to address the auxiliary requests.

Precisely this statement which may not be construed beyond its content, establishes:

- that the Board considered that the then pending auxiliary requests were broader in scope than the main request it just rejected,
- that therefore as stated by the Board the patentee not being appellant, their admission would infringe the principle of prohibition of *reformatio in peius*,
- that the petitioner was obviously not aware of the existence of said decision G 1/99, let alone of its content.

2.2.2 Secondly it is also a matter of fact that if the principles of law developed in decision G 1/99 were discussed at large during the oral proceedings, the petitioner can hardly allege after having received the written decision that he was denied the opportunity to comment on them or that he was deprived of the opportunity to file new auxiliary requests during the oral proceedings in order to meet the objections raised by the Board in respect of the then pending auxiliary requests whose respective scope of protection was found too broad.

2.3 *De jure* it appears that the reasons brought forward by the petitioner and for which review is sought must receive the precise legal qualification their actual nature deserves.

2.3.1 The petition for review filed with the Enlarged Board of Appeal appears indeed to concern the scope of application of the principle of good faith also known as the principle of the protection of legitimate expectations, in proceedings before the EPO, rather than the right to be heard. This principle is generally recognised among the Contracting States of the EPC and is well established in European Union Law (G 2/97, OJ EPO 1999, 123).

The Boards of Appeal have developed a substantial body of case law relying on the principle of good faith to be applied in the procedures before the EPO and which implies that measures taken by the EPO shall not violate the reasonable expectations of parties to such proceedings (G 5/88, G 7/88 and G 8/88, OJ EPO 1991, 137).

2.3.2 The protection of this principle requires that the user of the European patent system, here the patent proprietor in opposition appeal procedure, does not suffer a disadvantage as a result of having relied on erroneous information received from the Board of Appeal (G 2/97 supra, point 4.1).

Nevertheless users of the European patent system, who are parties in proceedings before the EPO must act in good faith, and have the responsibility to take all necessary procedural actions to avoid a loss of right. The Enlarged Board of Appeal, therefore, saw no justification for the suggestion that the principle of good faith imposes on a Board of Appeal an obligation to warn a party of deficiencies within the party's own responsibility (G 2/97 supra, point 4.2).

2.3.3 In the case in suit, even if for the sake of argument it is assumed that the information of the Board during oral proceedings was not clear enough, it remains nevertheless that the party, at least where, as here, it is represented by an authorized representative, is deemed to know the case law, and cannot plead lack of such knowledge as an excuse, "*Ignorantia legis non excusat*".

Moreover the petitioner had the opportunity if he was not aware of the principles set forth in decision G 1/99 to ask for a break in order to study said decision.

Furthermore, in the case in suit the Board could not have, without departing from its duty of neutrality in

inter partes proceedings, suggested to the petitioner any possible wording of a claim in order to escape the prohibition.

The petitioner, duly informed by the communication annexed to the summons to the oral proceedings, was deemed to be aware of the fact that the invention claimed according to his main request might lack the claimed priority, and should have accordingly drafted his auxiliary requests.

2.3.4 The question whether the exception mentioned in G 1/99 applies to the case at hand or (as stated in the impugned decision, point 6.2 of the Reasons) it does not, concerns the merits of the case and is therefore outside the scope of the present proceedings.

2.4 To summarise:

- it is not established that the Board gave any misleading information in the course of the oral proceedings,
- a party to the proceedings is expected to be aware of the relevant law and case law, at least where, as here, it is represented by an authorized representative,
- it is established that decision G 1/99 had been discussed during the oral proceedings, and that the petitioner who should have been aware of its teaching, did not ask for an interruption of the proceedings in order for him to react,

- it is not for the Enlarged Board of Appeal in its competence under Article 112a EPC to examine the merits of the decision and to go into the substance of a case.

2.5 Therefore, the petition for review is clearly unallowable and must be rejected. The request for reimbursement cannot be granted pursuant to Rule 110 EPC.

Order

For these reasons it is unanimously decided that:

The petition for review is rejected as clearly unallowable.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli