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**Datasheet for the decision
of the Enlarged Board of Appeal
of 22 March 2010**

Case Number: R 0009/09
Appeal Number: T 0071/06 - 3.2.07
Application Number: 00979685.5
Publication Number: 1258535
IPC: C22B 3/26
Language of the proceedings: EN

Title of invention:

Process for electrolytic production of highly pure zinc or zinc compounds from primary and secondary zinc raw materials

Patent Proprietor

Tecnicas Reunidas, S.A.

Opponent:

Outokumpu Oy

Headword:

-

Relevant legal provisions:

EPC Art. 123(2), 56, 113, 114(2), 134(8), 112a(1), (2), (4)
EPC R. 106, 107(1)(b), (2), 109(2)(a)
RPBA Art. 12(2)

Keyword:

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Decisions cited:

T 0071/06

Headnote:

"Petition rejected as clearly inadmissible"
"Objection raised in respect of a procedural defect during the oral proceedings(no) "



Case Number: R 0009/09

DECISION
of the Enlarged Board of Appeal
of 22 March 2010

Petitioner:
(Patent Proprietor)

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Representative:

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Decision under review:

**Decision of the Technical Board of Appeal
3.2.07 of the European Patent Office of
15 October 2008.**

Composition of the Board:

Chairman: P. Messerli
Members: M. Vogel
G. Raths

Summary of Facts and Submissions

I. This petition for review dated 20 May 2009 concerns the decision T 71/06 of 15 October 2008 of the Board of Appeal 3.2.07 - posted on 11 March 2009 - to dismiss the appeal of the appellant (patent proprietor), now the petitioner, against the decision of the Opposition Division dated 23 November 2005 to revoke its European Patent No. 1258535 based on application No. 00979685.5. The revoked patent related to a process for electrolytic production of highly pure zinc or zinc compounds from primary and secondary zinc raw materials. The petition was filed on 20 May 2009 and the petition fee was paid on the same day.

II. The proceedings in case T 71/06 can be summarised as follows:

1. In the appeal proceedings the Board issued on 28 July 2008 the summons to oral proceedings scheduled for 15 October 2008 together with a communication reflecting the preliminary opinion of the Board. In this communication the parties were advised that any further observations should be filed well in advance but at least one month before the fixed date.
2. On 11 September 2008 the former representative of the petitioner resigned from representation. With letter dated 3 September 2008 (received on 12 September 2008) the respondent/opponent filed D10 as new document, i.e. an extract of a document produced by employees of the petitioner for the International Symposium "Zinc 85" in Tokyo and

later published in the proceedings of said symposium. With letter dated 15 September 2008 the petitioner's new representative filed four new sets of claims and requested postponement of the oral proceedings for further discussion with its client with respect of the complexity of the case. This request was refused by the Board in a letter dated 29 September 2008. Contrary to the request of the petitioner, the Technical Board decided during the oral proceedings of 15 October 2008 to admit D10 into the proceedings as a document available to the public before the priority date. The Board found D10 relevant to this case. The petitioner requested to make comparison experiments with respect to D10. The Board refused this request since in its view such experiments would not be relevant. At the end of the oral proceedings the appeal was dismissed on the grounds that claim 1 of the main and first auxiliary requests did not meet the requirements of Article 123(2) EPC and the subject-matter of claim 1 of the second and third auxiliary requests did not involve an inventive step according to Article 56 EPC.

3. On 14 May 2009 the petitioner filed a request under Rule 140 EPC for correction of two transcription errors of the written decision issued on 11 March 2009. First, the decision did not mention on page 2 second paragraph that its representative requested adjournment of the oral proceedings to carry out comparative tests when the Board had admitted the late filed document D10. Secondly, the appellant missed on page 11 the

mention of the fact that Dr Manuel Illescas, accompanying person of its representative, Dr Peter Rauh, intervening on a question by the Board what the purpose of these experiments would be, was interrupted by the chairman stating that the Board had already decided on the issue of inventive step with respect to the second and third auxiliary requests and that therefore it was not allowed to present its arguments in favour of the importance of these tests.

III. The petitioner alleges that the Technical Board of Appeal failed to comply with the principle of a fair trial, namely of the right to a contradictory trial and its right to be heard according to Article 113 EPC under several aspects.

1. First, the Technical Board did not consider that with respect to the complexity of the case in its broadest sense and the late filed document D10, the refusal of its request for postponement of the oral proceedings violated its right to be fully heard and the principle of equality of arms and also the concept of a fair trial, in particular as it had no opportunity to make - as requested - comparison experiments in regard of D10 like it did before in regard of D1. Consequently, it had no chance to prepare its case properly. Contrary to the grounds of the decision, it had clearly not enough time for proper preparation and therefore it requested the adjournment one month before the scheduled oral proceedings.

- (a) Apart from this, the admission of D10 into the proceedings was against the law because its publication before the priority date was not proven and its filing only a few weeks before the oral proceedings was too late. The time left after the refusal of the Board on 25 September 2008 to postpone the oral proceedings was obviously too short for carrying out the comparative tests. Said tests were necessary to prove that the invention was based on an inventive step, all the more since these tests had to be performed on the basis of a more than 14 years old technology, no longer used.
- (b) The argument of the Board that the appellant should have been familiar with D10 since its contents originated from its own employees was not convincing as this document had not been introduced into the opposition proceedings until then. Under these circumstances, the petitioner could rely on the Board's intention to exercise its discretion pursuant to Article 114(2) EPC with the consequence that the parties would have had enough time to study the new document and to react on its relevance within the period left until the new date of the oral proceedings. This would be moreover true as under these conditions the appellant could be confident that the late filed document with an unclear date of publication would not be admitted, particularly as the respondent gave no convincing justification for the late

filing of D10. This was an abuse of procedure in breach of Article 12(2) RPBA ruling that the grounds of appeal and the reply shall contain a party's complete case.

2. Furthermore the petitioner was deprived from its right to be heard since during the oral proceedings the Board first decided on inventive step with regard to the combination of D1 and D10 and, only after this decision denying the requirements of Article 56 EPC of the second and third auxiliary requests, the Board refused the request on postponement for carrying out comparative tests with respect to D10. This way of proceeding was clearly in contradiction of what the Board had expressed before, i.e. that it would only decide on postponement when D10 would have become relevant for considering inventive step of any of the requests of the petitioner. The offered experiments would have made obvious that the claimed invention was not a mere optimization process but other than the combination of the teaching of D1 and D10 an improvement with surprising advantages. The experiments would have shown that the claimed process achieves a higher purity of the resulting zinc product than the process according to D10 and that the claimed process is not limited to short-term operation, contrary to the process according to D10. The appropriate technical features would have been introduced into the claims under appeal, in the light of the conclusions drawn from the comparative tests. However, the Board dismissed the request for conducting further tests. It said

it did not understand why these tests would be relevant as in its view these tests were only to prove what had been done by D10. But under the principles of a fair trial the Board was held to refer the case back to the first instance before admitting the new document and revoking the patent in the light of grounds based on this document.

3. Finally, the petitioner repeated the facts already stated in its request under Rule 140 EPC to correct the decision of the Board of Appeal (see above II.3) and enclosed an affidavit regarding Dr Illescas' intervention interrupted by the chairman of the Board during oral proceedings.
4. The petitioner requests *mutatis mutandis* that the decision of the Technical Board of Appeal on 15 October 2008 be set aside and the re-opening of the proceedings before the Board of Appeal be ordered.

Reasons for the decision

1. *Admissibility of the petition for review*
 - 1.1 In this review procedure the petitioner is according to the submitted authorisation lawfully represented by Dr Illescas, its Spanish legal practitioner (Article 134(8) EPC). Dr Illescas attended the oral proceedings before the Board of Appeal as accompanying person of the petitioner's representative.

1.2 The petitioner lodged an appeal against the decision of the Opposition Division to revoke European Patent No. 1258535. It requested that the decision under appeal be set aside and the patent be maintained on the basis of the main request or, in the alternative, on the basis of one of the first to third auxiliary requests, all filed with the letter dated 14 October 2008. This appeal was dismissed by the decision under review (T 71/06 - 3.2.07) with the consequence that the petitioner is adversely affected according to Article 112a(1) EPC.

The petition of review was filed on the grounds referred to in Article 112a(2) (c) and (d) EPC. It contains an indication of the decision to be reviewed and reasons for setting aside this decision. The petition therefore complies with the provisions of Article 112a(1) and (2) EPC and of Rule 107(1) (b) and (2) EPC.

1.3 The decision was notified in writing to the parties by registered letter posted on 11 March 2009. The two month period for filing a petition for review expired on Friday, 22 May 2009 (21 May 2009 was a public holiday in Germany). Consequently the petition of 20 May 2009 and the payment of the prescribed fee (Article 112a(4) 3rd sentence EPC) comply with Article 112a(4) EPC.

1.4 Pursuant to Rule 106 EPC, a petition under Article 112a(2) (a) to (d) EPC is only admissible where an objection in respect of the alleged procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such an

objection could not be raised during the appeal proceedings. The present petition refers to three procedural violations (see points III.1 - 3 above):

- refusal of the request for postponement of the oral proceedings,
- admission of D10 as a late filed document into the proceedings,
- refusal of the request to postpone the oral proceedings for carrying out comparative experiments with respect to D10.

It may appear that the first and third alleged violation are based on the same facts as for both violations the refusal of the postponement of the oral proceedings is at issue. Nevertheless the Enlarged Board considers both as independent with respect to the fact that the petitioner repeated during the oral proceedings its request for postponement in order to conduct the said tests. Accordingly, all three allegations have to be examined by the Enlarged Board in its composition according to Rule 109(2)(a) EPC with respect to whether the petition is clearly inadmissible or not in view of Rule 106 EPC.

- 1.5 The first alleged violation under Article 112a EPC refers to the petitioner's request for postponement of the scheduled oral proceedings with respect to its new representative appointed on 15 September 2008. It argued that this new representative needed a longer period than only one month to get familiar with the complex technical impact of the case and to discuss the case with its client in a meeting in Madrid. Refusing this request with a communication dated

24 September 2009, the Board would have violated the respondent's right to be heard under Article 113 EPC.

However, the Technical Board refused this request because serious substantive reasons for postponement of oral proceedings pursuant to items 2.2 and 2.3 of the Notice of the Vice-President DG3 dated 16 July 2007 concerning oral proceedings before the boards of appeal of the EPO (EPO SE No. 3 OJ EPO 2007, 115) were not given. This lack of substantive reasons results from the fact that all the arguments provided by the appellant are the consequence of the appellant's own decision to change its representative. And indeed the representative of the petitioner did not raise objections pursuant to Rule 106 EPC against the Board's decision not to postpone the oral proceedings. Accordingly, as far as the petition is based on this first objection, it is clearly inadmissible (Rule 109(2)(a) EPC in combination with Rule 106 and 108(1) EPC).

- 1.6 The second alleged violation concerns the admission of D10 although it was late filed. Also in respect of this second objection the Enlarged Board has no indication that the requirements of Rule 106 EPC are fulfilled. The petitioner submitted only the request to refuse D10 as late filed before and during the oral proceedings. But there is no hint neither in its petition nor in the minutes nor in the contested decision that it raised during the oral proceedings an objection under Rule 106 EPC with respect to a procedural defect in the sense of Article 112a(2)(c) and (d) EPC after the Board had taken its decision to admit D10 into the proceedings. The Enlarged Board has no doubts that during the oral

proceedings the petitioner made clear that it does not share the Technical Board's view on the admission of this document. However this is not an objection in the sense of Rule 106 EPC. This rule requires a separate objection directed to the procedural defect. This is mandatory in order to give the Technical Board an opportunity to revise the alleged procedural defect and to reserve the petitioner's right according to Article 112a EPC. Consequently, also as far as the petition is based on this second objection the petition is clearly inadmissible.

1.7 The third objection relates to the refusal of the appellant's request to postpone the scheduled oral proceedings for carrying out comparative tests with respect to D10. The petitioner submitted that the Board hindered it from showing that the requested comparative tests would have been necessary for proving an inventive step in the light of the prior art. But also in respect of the third objection the petition is clearly inadmissible as the petitioner failed to fulfil the requirements of Rule 106 EPC for the following reasons:

1.7.1 According to the clear wording of Rule 106 EPC a petition is only admissible if the objection concerning an alleged procedural defect was raised during the appeal proceedings and dismissed by the Board, except where such an objection could not be raised during the appeal proceedings. However, in the present case the petitioner did not submit in the grounds of its petition that it could not raise an objection pursuant to Rule 106 EPC before the Board closed the debate in order to deliberate the issue of inventive step. Just

at that point in time it should have pointed to an alleged procedural defect when the Board intended to discuss inventive step without having regard to the aspect of the requested comparative tests. An example that such an intervention was not impossible was given by the respondent who requested to take account in the protocol of the oral proceedings that it has not been heard with regard to the question of admissibility of auxiliary requests 1 - 3 concerning amendments made therein (point IX of the facts and submissions and point 6 of the reasons of the attacked decision).

- 1.7.2 The petitioner claims that its representative accomplished the procedural requirement of Rule 106 EPC by stating the following: The Board asked the appellant's representative what the purpose of the comparative experiments should be. Dr Illescas then took the floor and began to explain what the purpose would be, but was interrupted by the Chairman of the Board, who stated that the discussion relating to inventive step of the proposed auxiliary request had already been decided by the Board and that, therefore, the appellant was not allowed to argue back on this particular item (Affidavit of Dr Illescas, point 6; petition point 2.4). However, apart from the fact that this can hardly be qualified as an objection pursuant to Rule 106 EPC (see point 1.6 above), according to the minutes of the oral proceedings Dr Illescas was not the representative of the petitioner but an accompanying person. In this capacity, he could not validly make procedural declarations, such as one pursuant to Rule 106 EPC.

1.7.3 The Enlarged Board notes in passing that there is no reason to say that the Technical Board took its decision on inventive step without taking the offer of comparative experiments into consideration. The contrary is correct. The Technical Board considered the petitioner's arguments. But it came to the conclusion that such experiments offered by the appellant could not be relevant under any technical aspect for the issue of inventive step. Literally the Technical Board pointed out (point 7.3, p. 50 of the decision):

"Considering that D10 does not disclose any concrete concentration values of the washing solutions and further taking account of the appellant's arguments concerning a non-enabling teaching for a specific purity in D10 - which view is not shared by the Board - it is not apparent as to how such comparative tests with respect to D10 should be made at all, let alone credible ones.

Therefore the request for adjournment of the oral proceedings to carry out comparative tests with respect to D10 was refused."

2. *Conclusion*

It follows from the foregoing that in the present case the requirements of Rule 106 EPC have not been met. Therefore, the petition for review has to be rejected as clearly inadmissible. Under these circumstances, the request of the petitioner for correction of the decision is irrelevant (see point II.3 of the Summary of Facts and Submissions).

Order

For these reasons it is unanimously decided:

The petition is rejected as clearly inadmissible.

The Registrar:

The Chairman:

W. Roepstorff

P. Messerli