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**Datasheet for the decision
of the Enlarged Board of Appeal
of 26 January 2011**

Case Number: R 0014/10
Appeal Number: T 0147/09 - 3.2.04
Application Number: 01963380.9
Publication Number: 1307115
IPC: A43B 7/12
Language of the proceedings: EN

Title of invention:

Process for waterproofing a semimanufactured product of shoes, clothing items and accessories, and semimanufactured products obtained by said process

Patentee:

Nextec S.r.l.

Opponent:

W.L. Gore & Associates GmbH

Headword:

Fundamental violation of Article 113 and R. 104(b) EPC

Relevant legal provisions:

EPC Art. 112a, 113
EPC R. 104(b), 106, 107, 109
RPBA Art. 15(5)

Keyword:

"Petition for review - not clearly inadmissible - clearly unallowable"

Decisions cited:

G 0012/91, T 0005/81, T 0228/89, T 0382/96



Case Number: R 0014/10

DECISION
of the Enlarged Board of Appeal
of 26 January 2011

Petitioner: Nextec S.r.l.
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Representative: Pizzoli, Antonio
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Other Party: W.L. Gore & Associates GmbH
(Opponent) Hermann-Oberth-Strasse 22
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Representative: Klunker . Schmitt-Nilson . Hirsch
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Decision under review: **Decision of the Technical Board of Appeal
3.2.04 of the European Patent Office of
1 June 2010.**

Composition of the Board:

Chairman: J.-P. Seitz
Members: B. Schachenmann
G. Eliasson

Summary of Facts and Submissions

- I. The petition for review concerns decision T 147/09 of the Board of Appeal 3.2.04 revoking European patent No. 1 307 115 of the petitioner. The petition is based on the grounds of Article 112a(2)c) and d) in combination with Rule 104(b) EPC.
- II. The patent as granted contained an independent claim 1 (followed by dependent claims 2 to 19) for a "process for waterproofing a semimanufactured product of shoes, clothing items and accessories" and an independent claim 20 (followed by dependent claims 21 to 25) for the semimanufactured product. The patent was maintained by the opposition division in amended form with product claims 1 to 19 as granted and amended process claims 20 to 24.
- III. The proceedings before the Board of Appeal 3.2.04, as far as relevant for the petition, can be summarized as follows:
- (a) The opponent/appellant contested the decision of the opposition division to maintain the patent on the ground that the subject-matter of the claim 20 as amended and claim 1 as granted were not patentable over the prior art. The patentee/respondent defended the patent as maintained by the opposition division.
 - (b) In an annex to the summons to oral proceedings dated 17 March 2010 the Board of Appeal indicated some points in connection with method claim 1 and

product claim 20 which might need consideration by the parties at the oral proceedings.

- (c) In response, with letter dated 23 April 2010, the patentee/respondent confirmed its main request to maintain the patent as amended in the opposition proceedings, followed by the statement: "In any case, we hereby request as an auxiliary measure to limit claims 1 and/or 20 according to the enclosed amended versions." At the bottom of the letter it was indicated: "Encl.: 4 auxiliary requests". Enclosed were four sheets, the first comprising an amended claim 1 and the other three each comprising an amended version of claim 20, under the respective headings:

"1⁰ auxiliary request - claim 1"

"1⁰ auxiliary request - claim 20"

"2⁰ auxiliary request - claim 20"

"3⁰ auxiliary request - claim 20"

- (d) At the oral proceedings before the Board of Appeal, which took place on 1 June 2010, the discussion only concerned product claim 20 in its different versions. In the course of the proceedings the patentee/respondent filed a further version of product claim 20 under the heading "4⁰ auxiliary request".

- (e) After this discussion but before the debate was formally closed, the Chairman read out the requests of the parties as follows: "The appellant (opponent) requested that the decision under appeal be set aside and that the European patent No. 1 307 115 be revoked". - "The

respondent (patentee) requested that the appeal be dismissed and the patent be maintained in the amended form held allowable by the opposition division, or, in the alternative, that the patent be maintained on the basis of claim 1 and claim 20 according to any of the first, second and third auxiliary requests filed with the letter of 23 April 2010, or on the basis of the further amended claim 20 according to a fourth auxiliary request filed at the oral proceedings before the Board".

- (f) After deliberation of the Board of Appeal the decision was given that the patent was revoked. Immediately after, the patentee/respondent objected that the Board had not considered its request for the maintenance of the patent based only on claims 1-19. Before closing the oral proceedings, the Chairman dismissed this objection on the grounds that there was no identifiable request in the procedure which only contained the process claims and that the requests, which all included both the process and the product claims, had been read out prior to deliberation of the Board and the announcement of the final decision.

- (g) With letter dated 7 July 2010 the patentee/respondent requested a correction of the minutes to indicate that only claim 20 in its different versions was discussed during the oral proceedings and that its request should read that the patent be "... maintained on the basis of

claim 20 according to any of the first, second ...".

- (h) With communication dated 20 September 2010 the patentee/respondent was informed by the Board of Appeal that its request for correction could not be granted since the requests as recorded in the minutes and read out before the Board took its final decision were correct. Consequently, the requested correction would not correspond to the requests presented in writing during the appeal proceedings or orally at the oral proceedings.

IV. The patentee/respondent filed a petition for review on 13 September 2010. Additional written submissions followed on 18 October 2010, 23 December 2010, 24 December 2010 and 26 January 2011. In his written submissions and at the oral proceedings before the Enlarged Board of Appeal the petitioner argued essentially as follows. The Board of Appeal 3.2.04 had failed to decide on the relevant requests of the petitioner because it had wrongly assumed that independent (process) claim 1 and independent (product) claim 20 were inseparably joined in the auxiliary requests, so that the rejection of claim 20 in any version necessarily entailed the revocation of the patent in its entirety. This erroneous assumption, coupled with the omission of any request for explanation from the patentee, resulted in a fundamental violation of Article 113(1) and 113(2) EPC, since the Board of Appeal therefore failed to decide on a request relevant to the decision under review. Furthermore, Rule 104(b) EPC had been violated.

In particular, concerning the requests, the letter of 23 April 2010 had clearly referred to a possible limitation of "*claims 1 **and/or** 20*" (emphasis added by the petitioner). This formulation by no way meant that both claim 1 and claim 20 were necessarily jointly maintained. The heading "*1^o auxiliary request*" on the two sheets filed with the letter of 23 April 2010 containing a claim 1 and a claim 20, respectively, simply meant that the patentee had the same degree of preference for each of them. As a matter of fact, claim 1 and claim 20 were totally independent from each other, so that there was no basis to assume that they should be either jointly maintained or jointly revoked. This was confirmed in the letter of 23 April 2010 by the fact that the enclosures were indicated as "***four auxiliary requests***" (emphasis added by the petitioner), which evidently meant that the first two sheets constituted two different requests. Thus, it was clear that the auxiliary request based on amended claim 1 was disjoint from the three auxiliary requests based on amended claim 20.

However, had the Board of Appeal found anything unclear in these submissions, it would have been its duty to clarify the requests. Failing to ask for such clarification was a violation of Rule 104(b) EPC and misinterpreting a request constituted a substantial violation of Article 113(2) EPC. In any case, the patentee was not aware of and had no opportunity to comment upon the assumption of the Board of Appeal that the first two auxiliary requests filed with letter of 23 April 2010 were considered as a single auxiliary request.

Contrary to the minutes, what was actually discussed at the oral proceedings was only a part of the "matter", i.e. only product claim 20. At the end of the discussion it was therefore not clear that the forthcoming decision would be a final one. What was expected was an interim decision about product claim 20 and a continuation of the proceedings with respect to process claim 1. The omission of any advice as to how the Board of Appeal was intending to proceed which resulted in a sort of "sudden death" unfairly prejudiced the petitioner. Even if it were not fully clear to the Board of Appeal that the petitioner's request encompassed the possible maintenance of claim 1 independently from claim 20 and vice versa, it was in any case reasonable to assume that there would be an opportunity to delete the product claims in the event they were considered invalid. Under such circumstances the petitioner had the legitimate expectation that there would be an opportunity to discuss the process claims if the product claims were regarded as not allowable.

The decision of the Board of Appeal to revoke the patent in its entirety after discussion of product claim 20 came as an unfair surprise to the petitioner. The fact that the representative confirmed the main request and the four auxiliary requests based on claim 20 after the discussion did not imply that these were all of his requests on file, but also manifested his assumption that the deliberation of the Board of Appeal related to claim 20 only, not to the whole patent.

- V. The petitioner requested
- as main request that the decision T 147/09 - 3.2.04 be set aside, that the appeal proceedings be re-opened and that the fee for petition be refunded pursuant to Rule 110 EPC;
 - as auxiliary request that evidence be obtained by seeking for an opinion of an expert on the following legal question: *"Is it a principle of the procedural law generally recognized in the contracting states that a court has to ask the parties for clarification of their requests in cases where the version of a request causes doubts with view to the procedural demand or is considered unclear in order to comply with the fundamental right to be heard?"*;
 - as a further auxiliary request that the proceedings be stayed in order to give the petitioner the opportunity to obtain and file a corresponding legal opinion and to notify the petitioner accordingly.

Reasons for the Decision

The Enlarged Board of Appeal in its current composition can only unanimously reject the petition for review if it is clearly inadmissible or unallowable. It shall decide on the basis of the petition (Rule 109(2)(a) and (3) EPC).

Admissibility of the petition for review

1. The petitioner is adversely affected by the decision T 147/09 to revoke its patent. The petition for review was filed on the grounds of Article 112a(2)c) and d) in combination with Rule 104b) 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.
2. The written decision T 147/09 was notified to the parties by registered letter posted on 5 July 2010. The two month period for filing a petition for review expired on 15 September 2010. The present petition for review was filed and the fee was paid on 13 September 2010. The petition therefore also complies with Article 112a(4) EPC.
 3. 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 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. In the circumstances of the present case the petition is based on the submission that the Board of Appeal did not consider all the requests of the petitioner, a fact which only became apparent after the final decision had been given. Therefore, the exception of Rule 106 EPC applies here.
 4. Accordingly, the Enlarged Board of Appeal is satisfied that the petition is not clearly inadmissible.

Allowability of the petition for review

5. As follows from the facts referred to above, the Board of Appeal, when taking the decision under review, had no doubts about the requests of the petitioner. The

first question to be considered is whether this position was justified by the circumstances of the case.

- 5.1 It is not contested by the petitioner that the Chairman of the Board of Appeal, before he declared the debate closed, read out the requests as recorded in the minutes (cf. point III(e) above). As the petitioner pointed out, this did not mean that the claims in each request were thoroughly read one by one. Nevertheless, it is clear from the text as read out by the Chairman, that the requests contained a first, a second and a third auxiliary request filed with letter of 23 April 2010, each requesting the maintenance of the patent on the basis of a claim 1 and a claim 20, and a fourth auxiliary request concerning a further amended claim 20 filed at the oral proceedings. As clearly follows from this text the Board of Appeal was not aware of a still further "first" auxiliary request limited to (process) claims 1 to 19 without (product) claim 20.
- 5.2 The Enlarged Board cannot find fault with this view of the Board of Appeal. The petitioner's arguments based on the letter of 23 April 2010 are not convincing in this respect. The auxiliary requests submitted with this letter were clearly marked as 1⁰, 2⁰ and 3⁰ auxiliary request, wherein the 1⁰ auxiliary request contained a (process) claim 1 and a (product) claim 20. The established system of main and auxiliary requests in the proceedings before the EPO provides that parties, when filing alternative sets of claims must indicate the order of preference for each set of claims (see e.g. Legal advice from the EPO No 15/05 (rev. 2), OJ EPO 2005, 357). Contrary to the submissions of the petitioner, this normally rules out the understanding

that a request of a certain order of preference could comprise alternative sets of claims. The latter is only possible in exceptional cases, as e.g. provided for in Rule 138 EPC. Against this background, it would not have been reasonable for the Board of Appeal to conclude that claim 1 of the 1⁰ auxiliary request and claim 20 of the 1⁰ auxiliary request could belong to separate requests even if these claims were independent and filed on separate sheets.

5.3 On the other hand, the indications in the letter of 23 April 2010 invoked by the petitioner (cf. point IV, supra) were not sufficient to express the petitioner's intention to present claim 1 of the 1⁰ auxiliary request alone and in isolation from claim 20 of the 1⁰ auxiliary request. In any case, the fact that the requests were read out at the end of the oral proceedings for confirmation by the parties means that any previous requests were superseded (cf. point 6.1 below). It is to be emphasized in this respect that, according to the principle of party disposition (Article 113(2) EPC), it is the applicant's or patentee's responsibility to define the subject-matter of the application or the patent. This responsibility cannot be shifted to the EPO or other parties to the proceedings (see e.g. T 382/96, point 5.2).

5.4 The Enlarged Board of Appeal therefore finds that, in the circumstances of the present case, the Board of Appeal correctly decided on the basis of the requests as read out at the end of the oral proceedings.

6. The petitioner further submitted that the Board of Appeal, if it had found anything in the requests to be

unclear, would have had the duty to ask for clarification. Failing to do so in the case in suit was, in the petitioner's eyes, a violation of Rule 104(b) EPC and misinterpreting a request constituted a substantial violation of Article 113(2) EPC.

- 6.1 The Enlarged Board of Appeal agrees with the petitioner that in cases where a request of a party is considered unclear, it is the duty of the deciding body to ask for clarification before deliberation. It is therefore not necessary to have this principle confirmed by a legal opinion as requested by the petitioner. However, as already set out, the Chairman of the Board of Appeal read out the requests of the parties, before declaring the debate closed (cf. point III(e) above). He thereby acted in conformity with Article 15(5) of the Rules of Procedure of the Boards of Appeal, the aim of which is to avoid ambiguities in the parties' request. According to the established practice, the closing of the debate then marks the last moment in the oral proceedings at which parties can still make submissions (see decision G 12/91, OJ EPO 1994, 285, point 3). Thus, if the requests as read out by the Chairman did not correspond to the petitioner's intention, it was his duty to intervene at that point in the proceedings in order for the Board of Appeal to continue the debate on a subject-matter restricted to independent claim 1 as a further auxiliary request. From the fact that the petitioner did not do so, the Board of Appeal could conclude that the requests as read out corresponded to the intention of the petitioner. Any violation of Article 113(2) or Rule 104(b) EPC by the Board of Appeal cannot be acknowledged in this connection.

6.2 The petitioner further argued that he could not know, and was therefore surprised, that the requests as read out would be interpreted as his final requests. However, the fact that the Chairman also read out the opponent's request "that the decision under appeal be set aside and that the European patent No. 1 307 115 be revoked" (cf. point III(e) above) indicated beyond any reasonable doubt that, after the closure of the debate, the Board intended to deliberate on the patentability of independent claims 20 as discussed before and that, depending on the outcome of said deliberation, it could pronounce the revocation of the patent as a whole.

6.3 Hence, for this very reason, the fact that after deliberation the Board of Appeal did not continue the oral proceedings with a discussion of claim 1 of the first auxiliary request alone cannot be considered as a violation of Article 113(1) or (2) EPC. There is no obligation under the EPC to carry out the examination of a European patent application or patent in its entirety, i.e. in respect of all pending claims if a claim considered unallowable was maintained and no auxiliary request relating to a set of claims not comprising this unallowable claim was submitted. In such a case the application or patent fails to meet a requirement of the EPC and is open to refusal or revocation (cf. T 228/89, point 4.2 referring to T 5/81, OJ 1982, 249, point 3).

6.4 From these reasons it follows that the Board of Appeal has not decided "infra petita" and that the condition set out in Rule 104(b) EPC is not met. The petition for review is therefore clearly unallowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

J.-P. Seitz