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**Datasheet for the decision  
of the Enlarged Board of Appeal  
of 10 December 2013**

**Case Number:** R 0018/12  
**Appeal Number:** T 0059/09 - 3.2.06  
**Application Number:** 01302277.7  
**Publication Number:** 1134158  
**IPC:** B62M 25/04  
**Language of the proceedings:** EN

**Title of invention:**  
Bicycle shift device

**Patent Proprietor:**  
SHIMANO INC.

**Opponent:**  
SRAM Deutschland GmbH

**Headword:**  
Petition for review/Shimano

**Relevant legal provisions:**  
EPC Art. 84, 112a(2) (a) (b) (c) (d), (4), 113, 116, 123(2)  
EPC R. 106, 108(3), 110  
RPBA Art. 13(1), (3)

**Keyword:**  
Petition clearly inadmissible (partly) - objections within the  
meaning of Rule 106 (no) - or clearly inallowable

**Decisions cited:**  
R 0002/08, R 0004/11

**Catchword:**

Requirements for an objection to be an objection within the meaning of Rule 106 EPC - see point 19 of the Reasons



Case Number: R 0018/12

**DECISION**  
of the Enlarged Board of Appeal  
of 10 December 2013

**Petitioner:** SHIMANO INC.  
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**Decision under review:** Decision of the Technical Board of Appeal  
3.2.06 of the European Patent Office of  
28 June 2012.

**Composition of the Board:**

**Chairman:** W. van der Eijk  
**Members:** B. Günzel  
S. Wibergh

## Summary of Facts and Submissions

- I. This petition for review concerns decision T 59/09 of Technical Board of Appeal 3.2.06 of 28 June 2012, by which the decision of the opposition division was set aside and European patent No. 1134158, application No. 01302277.7, was revoked. The opposition division had maintained the patent in amended form. Petitioner is the patent proprietor (hereafter: petitioner).
- II. Claim 1 of the patent in suit was found allowable by the opposition division in the amended form of the petitioner's second auxiliary request, filed during the oral proceedings before the opposition division. That claim read (amendments as compared with the claim as granted in bold):

*"A bicycle shift control device (105) ... comprising:*

*...*

*a control body (170) ...*

*a **linearly** operating body (220) having an abutment in a position spaced apart from the control body (170) and which is coupled to the shift control device (105) for **linear** displacement between a home position and a shift position;*

*...*

*an interface member (202) movably mounted relative to the **linearly** operating body (220) and having an operating force receiving surface (203) and an operating force applying surface (204), wherein the operating force receiving surface (203) is adapted to receive an operating force from a rider, and wherein the operating force applying surface (204) applies the operating force to the abutment of the **linearly***

*operating body (220) for moving the **linearly** operating body (220) from the home position to the shift position."*

III. The opponent appealed the decision. In reply to the statement setting out the grounds of appeal the petitioner submitted as its main request the claims which corresponded to the claims found allowable by the opposition division. Three sets of amended claims were filed as auxiliary requests 1 to 3.

IV. In its communication of 17 April 2012 in preparation for oral proceedings the Board *inter alia* pointed out the following with regard to the petitioner's main request:

"2. The appellant further disputes inventive step of the subject-matter of claims 1 and 2 starting from E3B, E5 or E3A.

2.1 With respect to the shift control device known from E3B it seems that the differences to those defined in claims 1 and 2 essentially concern a construction in which the linearly operating body and the interface member are formed as separate, relatively movably mounted and mutually abutting parts. ... It may also have to be discussed whether there are further distinguishing features between E3B and claims 1 and 2, but the Board presently cannot recognise any such feature.

2.2 If the differences perceived by the Board above should be maintained, it may have to be discussed whether the problem given in the patent (see end of

[0003] of the patent specification) is actually solved by the features of claim 1 and thus whether it is an objective problem. It seems that the above-identified differences do not solve this problem because additional features would appear to be necessary (see e.g. [0017] of the patent). It may thus be an important matter of discussion as to which objective problem is solved when starting from E3B. Whether the problem is to improve the handling or operability of the operating body, as suggested by the appellant in the statement of the grounds of appeal under item 3.c) (pages 10, 11), may therefore also be a matter of discussion.

2.3 It appears that structures comprising an interface member relatively movable to an operating body are known from e.g. E5 or E7. The latter appears further to disclose a configuration where the force applied to the interface member (lever 34) is transmitted via an operating force applying surface (one end of lever 34) to an abutment on the operating body (36). If the problem formulated above is found to be an objective problem when starting from E3B, the question needs to be answered whether it would have been obvious to the skilled person in view of his general knowledge and/or in view of the prior art on file to provide the interface member and the linearly operating body as separate elements which are relatively movable with respect to each other and which transmit the operating force by an abutment and a corresponding operating force applying surface."

V. In reply, with a letter received on 25 May 2012, the petitioner submitted auxiliary requests 1 to 11.

VI. During the oral proceedings held before the Board on 28 June 2012, the appellant requested that the decision under appeal be set aside and that the European patent be revoked. The petitioner requested that the patent be maintained according to its main request, or according to the first auxiliary request, which was identical to the tenth auxiliary request filed on 25 May 2012, or according to the second auxiliary request filed during the oral proceedings, or according to the third auxiliary request, which was identical to the fifth auxiliary request filed on 25 May 2012, or according to the fourth auxiliary request, which was identical to the fourth auxiliary request filed on 25 May 2012, or according to the fifth auxiliary request, which was identical to the eleventh auxiliary request filed on 25 May 2012, or according to the sixth auxiliary request, filed during the oral proceedings.

VII. During these oral proceedings the petitioner also filed a "complaint in the sense of Rule 106 referring to Article 112a(2)c EPC", which was annexed to the minutes of the oral proceedings.

VIII. This "complaint", signed by the petitioner's professional representative, reads:

"Herewith the patentee files a complaint in the sense of Rule 106 referring to Art 112a(2)c).

The board chose not to admit auxiliary requests 2 and 6 as filed during oral proceedings on 28 June 2012.

Aux. request 2 was composed of claim 1 as maintained combined with features of claims 5 and 7 as originally filed and granted with the sole difference of having

deleted reference numbers. The alleged lack of prima facie clarity is not justified

Aux. request 6 was based on aux. request 11 as filed on 25 May 2012 admitted by the board and included further features from the description to overcome an objection based on intermediate generalisation. The alleged need for a substantive new examination with respect to inventive step was not justified because the patentee acknowledged that the features not present in earlier filed aux. request 11 would not form the basis of any inventive step arguments to made (sic) by the patentee.

These decisions of the board with respect to these aux. requests are a clear violation of the right to be heard in the sense of Art 113."

IX. At the end of the oral proceedings the Board announced its decision to dismiss the petitioner's objection under Rule 106 EPC and to revoke the patent.

1. According to the written reasons for the decision, the petitioner's main request was regarded as not allowable because the subject-matter of claim 1 did not involve an inventive step.

The Board considered that the shift control device defined in claim 1 differed from E3B in that it concerned a construction in which the LOB (linearly operating body) and the interface member were formed as separate parts, which were movably mounted relative to each other so that the interface member could be brought in abutment with the LOB for transmitting a



force applied on the interface member to the LOB (point 2.1 of the Reasons).

The objective technical problem, as formulated in paragraph [0003] of the patent in suit and as defined by the petitioner, had not been solved by the features of claim 1. That claim did indeed cover embodiments in which the thumb of the rider would have to be placed with the same amount of precision on the interface member as in E3B. The Board then concluded that, in the absence of any other particular technical effect, the technical effect achieved by an interface member which was separated from and movably mounted relative to the LOB and wherein the operating forces were transmitted through an abutment and a corresponding surface on the respective element was just an alternative way of operating the LOB (points 2.2 to 2.5 of the Reasons).

The objective technical problem to be solved by the above distinguishing features was hence to provide an alternative way to operate an LOB within a shift control device. According to the Board it belonged to the common general knowledge of the skilled person, who in the present case had knowledge of mechanical engineering and expertise in the development of bicycle components, to replace a unitary element by two (or, if necessary, more) structurally separate elements, movably relative to each other. It also belonged to the common general knowledge to transmit forces between such separate elements by an abutment and a cooperating surface on the respective element. That the provision of separate operating bodies and interface members was generally known in the field of bicycle components was also exemplified by documents E5 and E7. These shift

control devices used well-known alternatives to an integral interface member and operating body: either a pivot joint (E5) or an abutment and cooperating surface (E7). It did not require any inventive skill to select one of several alternatives to well-known features and use it for its well-known purpose in place of the structure of the combined interface member/LOB of E3B (points 2.6 and 2.7 of the Reasons).

The petitioner did not dispute that these features belonged to the common general knowledge. Rather, the petitioner considered that the use of this knowledge in order to solve the technical problem could only be guided by hindsight. The Board stated that it could not accept this argument because the skilled person faced with the objective technical problem of providing an alternative did not need any incentive to provide a particular solution which belonged entirely to the common general knowledge, at least as long as there were no reasons which would prevent the skilled person from applying a well-known solution in the particular circumstances.

The argument that particular considerations for the force transmission between interface member and operating body would be necessary in the case of linearly operating bodies in trigger shift control devices, e.g. due to required tolerances in the movement of the LOB, which would exclude the application of solutions known to be applied with non-linearly operating bodies in different types of shift control devices, such as in E5 or E7, was not convincing. Neither the description of the application as filed, nor the subject-matter of original or present

claim 1, nor E5 or E7 took into account any such particular difficulties. Claim 1 of the main request stated only broadly that the interface member was to be movably mounted relative to the LOB, without specifying a direction of movement of the interface member or a relative location of the two elements. The only requirement was that the forces must be transmitted from the operator's thumb through the interface member to the LOB, but it had not been convincingly shown that this would be fundamentally different from a force transmission to a non-linearly operating body, nor could the Board see any reason why that should be so.

It would thus have been obvious to the skilled person faced with the objective technical problem of providing for an alternative way to operate an LOB in a shift control device to provide an LOB with an abutment and an interface member movable relatively thereto with a corresponding force transmission surface (points 2.8 and 2.9 of the Reasons).

2. Petitioner's auxiliary request 1 was found not to be allowable because it extended beyond the content of the application as filed (Article 123(2) EPC).

3. Auxiliary request 2, submitted during the oral proceedings before the Board, was not admitted into the proceedings under Article 13(1) RPBA. The Board had serious doubts about the clarity of claim 1 (Article 84 EPC), so that the amendments were not *prima facie* allowable. Claim 1 of auxiliary request 2 was not a mere combination of granted claims. In claim 1 of auxiliary request 2 the relation between some of the inserted features was unclear, as the Board set out in

more technical detail in points 4.1 and 4.2 of the Reasons, point 4.2 specifically referring to arguments submitted by the petitioner.

4. Auxiliary requests 3, 4 and 5 were rejected for the reason that the subject-matter of their respective claims 1 extended beyond the content of the application as filed (Article 123(2) EPC).

5. Auxiliary request 6, also submitted during the oral proceedings, was likewise not admitted. According to the Board it raised issues which the Board and the appellant could not reasonably be expected to deal with without adjournment of the oral proceedings (Article 13(3) RPBA).

Apart from the fact that the Board again had serious doubts whether the amendments to claim 1 satisfied the requirement of Article 123(2) EPC, the resulting subject-matter still did not appear to comprise all the features essential to solve the problem indicated in the patent. The objective technical problem solved by this particular combination of features would therefore have had to be redefined again. It would then have had to be considered whether this entirely new combination of features was obvious in view of the prior art, which might possibly have required a search for additional prior art. Deciding whether or not the subject-matter of this substantially amended claim involved an inventive step would consequently have required the Board and the appellant to consider complex issues which had never been addressed before in the proceedings (point 7.1 of the Reasons). In point 7.2 of

the Reasons the Board then dealt with the arguments raised by the petitioner in this respect.

6. With respect to the complaints which the petitioner made at the oral proceedings, the Board considered that the objections which it raised under Rule 106 EPC did not relate to a violation of its right to be heard. Rather, they expressed the view that the conclusions drawn by the Board in the exercise of its discretion to admit amendments to the petitioner's case under Article 13(1) and (3) RPBA were wrong (point 8. of the Reasons).

- X. The written reasoned decision was notified to the appellant by a notification dated 17 September 2012.
- XI. On 26 November 2012 the petitioner filed a reasoned petition for review. The fee for the petition was paid on the same day.
- XII. The petition for review was based on the grounds that three separate fundamental violations of Article 113 EPC, identified as grounds A, B and C, had occurred. The petitioner argued as follows:

Ground A

The fundamental violations referred to as Ground A were not apparent at the time of the oral proceedings but became apparent only with the issue of the decision of the Board of Appeal. Therefore, in respect of this ground, an objection within the meaning of Rule 106 EPC could not have been raised during the appeal proceedings.

As regards the discussion of the inventive step of the main request, at the oral proceedings, after giving an introduction, the Board had for the first time introduced a new objective technical problem, i.e. to find an alternative way to operate an LOB within a shift control device. This definition of the technical problem had not been raised in the written proceedings, nor had the reasons for its adoption been discussed at any time during the proceedings before the Board, either in the written or in the oral proceedings. Neither the opponent nor the Board gave any reason at the oral proceedings why the newly formulated problem was more appropriate than the petitioner's own problem, which incorporated the problem described in the patent itself. Thus, the petitioner had not had an opportunity to present arguments why the newly formulated problem was wrong.

Furthermore, the Board had refused the main request for lack of inventive step over E3B and "common general knowledge" without citing any evidence of the common general knowledge, and had thereby denied the petitioner the opportunity to be heard in relation to such evidence. The Board gave no reasons for its decision at the oral proceedings other than to respond with a simple "yes" to a question from the petitioner's representative, after the decision had been announced, as to whether the Board considered the subject-matter of claim 1 to lack inventive step over E3B and the common general knowledge of the skilled person. It became apparent only in the written decision that the Board considered it common general knowledge for the skilled person "to replace a unitary element by two

(or, if necessary, more) structurally separate elements, movably relative to each other" (see point 2.7 of the written decision). At no time in the proceedings had there been any evidence of the common general knowledge of the skilled person other than that set out in prior art documents E4, E5 and E7. The petitioner had understood the Board's comments and the appellant's submissions to mean that E5 and E7 were regarded as evidence of the common general knowledge so that, having successfully argued why the skilled person would not combine the particular teaching of E5 and E7 with E3B, it believed that it had also dealt with the issue of the common general knowledge. Hence, the petitioner had not had an opportunity to respond to an argument that claim 1 lacked an inventive step in relation to a combination of E3B and the common general knowledge of the skilled person.

#### Ground B

The Board had chosen not to admit the claims according to auxiliary request 2 because it had "serious doubts about the clarity of claim 1", thus depriving the petitioner of the opportunity to argue for inventive step of the claims. The Board had done so despite the amendment being the inclusion of the features of two dependent claims as granted, such an amendment being normally *prima facie* clear. Because the Board did not already disclose the reasoning given in points 4.1 to 4.3 of the written decision at the oral proceedings, the petitioner was not given the right to reply to this reasoning and to point out the major inconsistency between it and the reasoning at points 3.1 to 3.5 of the written decision.

Ground C

The Board had chosen not to admit the claims according to auxiliary request 6 because it found the "issues arising from these amendments were ... far too complex to be dealt with during the oral proceedings without adjournment". By doing so, the Board had denied the petitioner the opportunity to be heard with respect to inventive step, despite its undertaking that any features not present in earlier filed auxiliary request 5 would not be taken into account in its consideration of inventive step. Furthermore, by its actions, the Board had deprived the petitioner of the opportunity to overcome added subject-matter objections raised by the Board with respect to earlier requests. The amendments to auxiliary request 6 had been made in good faith by the petitioner in direct response to the decisions of the Board in relation to earlier requests.

XIII. Declarations by the petitioner's professional representative and six other persons having attended the oral proceedings on the petitioner's behalf were annexed to the petition. In identical formulations the declarations deal with the discussion which took place at the oral proceedings with respect to the correct formulation of the objective problem. Furthermore, it is declared that the only evidence of the common general knowledge which members of the Board referred to during the oral proceedings, although in an unsubstantiated manner, was the evidence of documents E5 and E7.

XIV. The petitioner requested that:



- (a) the decision of the Board of Appeal in appeal no. T 59/09 be set aside and the proceedings re-opened in accordance with Rule 108(3) EPC;
- (b) the fee for the petition for review be reimbursed in accordance with Rule 110 EPC; and
- (c) in the event that the Enlarged Board of Appeal intended to issue a decision not to re-open the proceedings in accordance with Rule 108(3) EPC, oral proceedings be held in accordance with Article 116 EPC.

XV. In a communication accompanying the summons to oral proceedings, the Enlarged Board set out its preliminary view of the matter. With respect to both complaints raised under Ground A, the requirement of Rule 106 EPC that an objection in respect of the alleged violation of the petitioner's right to be heard could not be raised during the appeal proceedings appeared not to be fulfilled. Furthermore, the petitioner's allegations that its right to be heard was violated during the oral proceedings were clearly unfounded. Concerning Grounds B and C, it could be regarded at least as doubtful whether, by objecting to the Board's conclusions as to substance, the petitioner had raised an objection within the meaning of Rule 106 EPC. Furthermore, since the Board's conclusion that claim 1 of auxiliary request 2 lacked *prima facie* clarity, its allegedly wrong assessment of the patentability issues raised by new claim 1 of auxiliary request 6 and the exercise of its discretion not to admit these requests were not subject to scrutiny by the Enlarged Board, the

petitioner's complaints in these respects appeared at least clearly unallowable.

XVI. Oral proceedings were held before the Enlarged Board on 10 December 2013. In these the petitioner declared that it only wished to comment orally on the second complaint of its petition ground A, i.e. that the Board had refused the main request for lack of inventive step by newly relying on common general knowledge without any evidence of that common general knowledge. Common general knowledge had only been referred to in connection with E4, E5 or E7. These documents, however, related to different structural forms from that of the patent in suit. The definition of the common general knowledge given by the Board in its decision related to a broader concept of the common general knowledge than was derivable from said documents. Respecting the party's right to be heard required that the grounds on which the decision was to be based were communicated in advance to the party. Such right was not satisfied by a mere general consultation. This followed from the procedural principles generally recognised in the contracting states. It was also to be derived from the right to a fair trial as enshrined in the European Convention on Human Rights and the European Charter of Human Rights and as confirmed by various decisions at national and international level. At the end of the oral proceedings, the Enlarged Board announced its decision that to the extent that the petition was not rejected as clearly inadmissible, it was rejected as clearly unallowable.

## **Reasons for the Decision**

1. The written decision was notified to the petitioner with date of 17 September 2012. The reasoned petition having been filed on 26 November 2012 and the fee for the petition having been paid on the same day, these acts were performed within the time limit of Article 112a(4) EPC. Since the patent was revoked, the petitioner is also adversely affected by the impugned decision. The petition has also been sufficiently reasoned.

*Ground A*

2. Under Ground A the petitioner has raised two complaints regarding an alleged violation of its right to be heard. These will be dealt with separately below.

*Definition of the problem to be solved*

*Rule 106 EPC*

3. The petitioner submits that it could not raise an objection during the appeal proceedings, since it became aware of the violation of its right to be heard only from the reasons of the impugned decision, in which the problem to be solved was defined as an alternative.
4. The petitioner itself acknowledges in the petition that the definition of the objective technical problem "to provide an alternative way to operate a linear operating body (LOB) within a shift control device" was presented by the Board at the oral proceedings (see point 1.6.9 of the petition). The petitioner

furthermore sets out that at the oral proceedings it had argued that this was an inappropriate technical problem. However, there is nothing on file to indicate - nor has the petitioner itself said - that at the oral proceedings the petitioner could not have raised an objection to the Board's suggesting an allegedly new and surprising redefinition of the problem. Nor is there any indication that the petitioner was not in a position to argue its case in the appropriate manner either because it was taken by surprise or because it did not know the reasons for the redefinition. The petitioner could, for instance, have asked for more time or for an adjournment, but it undertook no action of that kind. Hence, the requirement of Rule 106 EPC, that an objection in respect of the alleged violation of its right to be heard could not be raised during the appeal proceedings, is not fulfilled.

*Substance*

5. Furthermore, the Enlarged Board notes that point 2.2 of the Board's communication (see IV. above), although expressed in cautious terms, made it crystal clear that the Board might not be minded to acknowledge the existence of an improvement or a beneficial technical effect over E3B. The reasons for this were also briefly indicated. It is plain, because established by case law and practice, that, if it has not been shown that an improvement or a beneficial effect has been achieved, the objectively solved problem has to be redefined in a less ambitious way. This most commonly means that the problem objectively solved is defined as the provision of an alternative, which may be obvious or not (see e.g. the decisions cited in Case Law of the Boards of Appeal

of the European Patent Office, 7th edition 2013, I.D.4., page 174). Therefore, given the content of the Board's communication, it cannot, objectively speaking, have come as a surprise to the petitioner, for which it could claim to have been unprepared, that during the oral proceedings the Board presented the definition of the objective technical problem as being an alternative. It is also undisputed that the questions of the correct definition of the problem objectively solved and of inventive step were discussed during the oral proceedings. The petitioner has not submitted that it was not given a full opportunity to present its arguments as to why the claimed invention constituted an improvement, or why it was a non-obvious alternative solution. According to the petitioner, it defended its position by referring to the problem mentioned in the patent specification. That was its own choice. As a result, the Enlarged Board would also be unable to recognise that the petitioner's right to be heard was violated in this respect.

*Definition of common general knowledge*

*Rule 106 EPC*

6. The petitioner submits that it only learned from the reasons of the decision that the Board denied inventive step on the basis of E3B in combination with the common general knowledge only, without, however, having presented any written evidence of that knowledge. At the oral proceedings before the Enlarged Board, the petitioner clarified that it did not deny that common general knowledge had been discussed at the oral proceedings before the Technical Board. However, this

concept had only been discussed on the basis of documents E4, E5 and E7. These documents related to different structural forms from that of the patent in suit, and the definition of the common general knowledge given by the Board in its decision related to a broader concept of the common general knowledge than was derivable from said documents. Therefore, having successfully argued why the skilled person would not combine the particular teaching of E5 and E7 with E3B, the petitioner believed that it had also dealt with the issue of the common general knowledge.

7. Whether that belief was justified and whether it is correct to interpret the Board's decision as denying inventive step on the basis of common general knowledge alone, without the support of any documentary evidence, are issues which relate to the potential allowability of the petition. For the purpose of Rule 106 EPC and on the basis of the petitioner's understanding of the situation, the Enlarged Board accepts that in this respect the petitioner could not have raised an objection within the meaning of Rule 106 EPC during the oral proceedings.

#### *Allowability*

8. However, when it comes to the substance, the petitioner's objection that its right to be heard was violated by the Board's reasoning in point 2.7 of the decision with respect to its definition of the common general knowledge is clearly unfounded.
9. First, the Enlarged Board is not convinced that point 2.7 of the Reasons is to be read as meaning that

the concept of the common general knowledge defined there was adopted by the Board independently of the teaching derivable from documents E5 and E7. On the contrary, in the third sentence of point 2.7 of the Reasons, the Board first defined the common general knowledge and then went on to say that this was also exemplified by documents E5 and E7. The use of the term "exemplified" indicates that the Board did indeed rely on these documents as support for its finding as to what the common general knowledge was. Therefore, the use of the word "also" in this context is an insufficient basis for the petitioner's conclusion that the Board had defined the common general knowledge without giving any evidence to support its finding.

10. Furthermore, in point 2.3 of its communication the Board had actually made a reference to the knowledge of the skilled person which, as the use of the words "and/or" show, was clearly additional to and separate from its reference to the prior art on file. Moreover, as the petitioner's reference (in point 3.10 of the petition) to the appellant's grounds of appeal shows - see in particular the last-cited paragraph thereof - the appellant too had made a corresponding submission in its grounds of appeal. The appellant's reference to the knowledge of the skilled person is also clearly additional to and separate from the reference to the prior art on file. Hence, considering the written file as it then stood, the petitioner should have anticipated that at the oral proceedings inventive step could be discussed and potentially be denied on the basis of E3B in conjunction with common general knowledge, without any written evidence of that

- knowledge. Accordingly, it could and should have raised this issue itself during the oral proceedings.
11. The same applies as regards the breadth of the concept of common general knowledge adopted in the decision, which, the petitioner submits, came as a surprise to it. The Enlarged Board notes that this concept had already been addressed as to its substance, albeit in a slightly different wording, in the Board's communication. Point 2.3 of the Board's communication clearly defined the aspect for which the general knowledge of the skilled person could be decisive, namely "whether it would have been obvious to the skilled person in view of his general knowledge and/or in view of the prior art on file to provide the interface member and the linearly operating body as separate elements which are relatively movable with respect to each other and which transmit the operating force by an abutment and a corresponding operating force applying surface.". Furthermore, in that very same point of the communication the Board also referred to documents E5 and E7. Thus, the point that these documents could potentially be significant for the broad - as the petitioner terms it - definition of the concept of common general knowledge was also addressed. The petitioner submitted that, having successfully argued why the skilled person would not combine the particular teaching of E5 and E7 with E3B, it believed that it had also dealt with the issue of common general knowledge. However, the petitioner did not present anything which would corroborate its contention that it had good reasons for making such an assumption. Accordingly, that argument must fail.



12. At the oral proceedings before the Enlarged Board, the petitioner also argued that, in the Technical Board's communication, its view on these issues, as subsequently formulated in the reasons for the decision, had not been set out clearly, or at least not clearly enough to allow the petitioner to respond appropriately.
13. The Enlarged Board disagrees. As already set out above, the decisive aspects addressed in the decision with respect to the Board's definition of the common general knowledge were already addressed in the Board's communication, even if not in the same breadth as later in the reasons for the decision. Hence, on the basis of the communication, the petitioner was in a position to prepare for the discussion of the issue at the oral proceedings and to present all its reasons as to why such a broad definition of the common general knowledge was not correct and could not be derived from documents E5 and E7.
14. There appears to be a more general complaint underlying this issue, which is the petitioner's perception that its right to be heard was violated because the Board did not communicate to it beforehand the exact reasons for the decision that it would subsequently take.
15. Pursuant to the established case law of the Enlarged Board of Appeal, a party has no right to be told in advance how and for precisely what reasons the Board of Appeal will decide on the arguments advanced by the party. In order for the decision to comply with Article 113 EPC it is sufficient that the party concerned had an adequate opportunity to present its point of view to the Board before a decision is taken,

that the Board considers the arguments presented by the party and that the decision is based on a line of reasoning that can be said to have been in the proceedings, either as a result of having been submitted by a party or raised by the Board (R 4/11 of 16 April 2012, point 2.5 of the Reasons, making reference to further decisions of the Enlarged Board). That this was the case in the proceedings before the Technical Board with respect to the points referred to by the petitioner, which were all addressed in the communication, cannot be denied. On the contrary, it appears to the Enlarged Board that the issues on which the impugned decision is based were discussed at length in the course of the appeal proceedings. Therefore, although not a ground for review in itself, there is nothing on file to indicate that the petitioner's right to a fair trial was violated.

*Ground B*

*Objection within the meaning of Rule 106 EPC*

16. At the oral proceedings before the Board, the petitioner raised the objection that the alleged lack of *prima facie* clarity was not justified. According to the petitioner, the Board's decision was a clear violation of its right to be heard according to Article 113 EPC (see VIII above).
  
17. According to the explicit wording of Rule 106 EPC, an objection under that rule must concern a procedural defect. It is also to be derived from Rule 106 EPC that the objection must concern a procedural defect which can be the subject of a petition for review under

Article 112a(2) (a) to (d) EPC. The objection raised must further identify what constitutes the alleged procedural violation. This is to enable the Board to assess whether a procedural defect within the meaning of Rule 106 EPC has been raised and, if it finds the objection justified, to remedy the defect, so that unnecessary review proceedings may be avoided.

18. In its complaint filed during the oral proceedings before the Board, the only reason which the petitioner gave as to why the non-admittance of auxiliary request 2 violated its right to be heard was that the alleged lack of *prima facie* clarity on which the Board's decision was based was not justified. Whether or not claims lack *prima facie* clarity is, however, a matter of substantive patent law and not a procedural question. The petitioner did not object to the exercise of the Board's discretion under Article 13 RPBA as such, or in particular to the applicability of the criterion of *prima facie* clarity, but only to the Board's substantive conclusion on the lack of *prima facie* clarity.
  
19. Since the drafting of an objection under Rule 106 EPC during oral proceedings normally has to be made under time constraints, parties certainly cannot be required to draft their objections in legally precise terms. These must, however, at least be drafted in such a way that the Board is able to discern that they are directed at a procedural defect within the meaning of Rule 106 EPC and not at an allegedly wrong assessment of substantive issues by the Board. This is so because any errors in the substantive assessment of a case fall completely outside the legal scope of review

proceedings. Therefore, only an objection which, in substance, raises a procedural defect of a kind that can be the subject of review proceedings according to Article 112a(2) (a) to (d) EPC can be regarded as an objection within the meaning of Rule 106 EPC. Rule 106 EPC is not a formality. Its essential purpose is to avoid unnecessary petitions for review by giving the Technical Board the possibility to correct a defect which could otherwise lead to review proceedings being initiated. As a consequence, when it comes to determining whether the petitioner has observed Rule 106 EPC, what matters is not the formal wording of the objection but its substance as it could be understood by the Board.

20. In the present case, even though the petitioner mentioned Article 113 EPC in its objection, by only objecting to the Board's conclusion on lack of *prima facie* clarity, it did not raise an objection within the meaning of Rule 106 EPC.
21. In the petition, the petitioner submitted that the Board's decision not to admit the claims of auxiliary request 2 had deprived it of the possibility of arguing in favour of inventive step in respect of these claims. If the petitioner means that this is what constituted the alleged violation of its right to be heard, it must be stated that, on an objective basis, there is nothing in the actual formulation of the objection that could have allowed the Board to understand it in this way.
22. In its jurisprudence the Enlarged Board has acknowledged that the erroneous application of a procedural rule, which does not in itself belong to the

grounds for review enumerated in the EPC, can be considered by the Enlarged Board if such erroneous application of a procedural rule results in the petitioner not having been heard on a relevant issue (see e.g. R 2/08 of 11 September 2008, Headnote 1.).

23. This is, however, not the situation in the present case. That the petitioner was not heard on the inventive step of auxiliary request 2 is the result of claim 1 having been found *prima facie* unclear by the Board.

Hence, as regards Ground B the petition has to be rejected as clearly inadmissible.

#### *Ground C*

#### *Rule 106 EPC*

24. Regarding the question whether an objection within the meaning of Rule 106 EPC was raised during the appeal proceedings with respect to Ground C, the same considerations apply as set out above with respect to Ground B. In the statement which it filed at the oral proceedings, the petitioner only objected that "the alleged need for a substantive new examination with respect to inventive step was not justified". Again, whether or not the amendments made by the petitioner in auxiliary request 6 needed a substantive new examination with regard to inventive step is a matter of substantive law. Hence, the objection did not raise a procedural defect within the meaning of Rule 106 EPC.

Therefore, as regards Ground C the petition also has to be rejected as clearly inadmissible.

**Order**

**For these reasons it is unanimously decided that:**

To the extent that the petition for review is not rejected as clearly inadmissible, it is rejected as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk