



Europäisches
Patentamt

Große
Beschwerdekammer

European
Patent Office

Enlarged
Board of Appeal

Office européen
des brevets

Grande
Chambre de recours

Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

**Datasheet for the decision
of the Enlarged Board of Appeal
of 30 January 2014**

Case Number: R 0003/13

Appeal Number: T 1397/09 - 3.2.04

Application Number: 01117622.9

Publication Number: 1197157

IPC: A43B 7/08, A43B 7/06

Language of the proceedings: EN

Title of invention:
Shoe

Patent Proprietor:
adidas International Marketing B.V.

Opponents:
Hendriks, Ralph
Nike Retail B.V.

Headword:
-

Relevant legal provisions:
EPC Art. 125, 112a (2) (c), 113(1)
EPC R. 106
ECHR Art. 6
Germany's Code of Civil Procedure §§ 139, 253

Keyword:

"Right to be heard infringed (no)"

"Awareness of objections raised against requests and possibility to comment on them (yes)"

"Petition for review clearly unallowable"

Decisions cited:

R 0001/13, R 0011/12, R 0022/11, R 0016/11, R 0006/11,
R 0015/10, R 0018/09, R 0015/09, R 0012/09, R 0002/08,
R 0004/08

German BGH GRUR 2009, 91 - Antennenhalter

-

Catchword:

-



Case Number: R 0003/13

DECISION
of the Enlarged Board of Appeal
of 30 January 2014

Petitioner: adidas International Marketing B.V.
(Patent Proprietor) Koningin Wilhelminaplein 30
NL-1062 KR Amsterdam (NL)

Representative: Hess, Peter K. G.
Bardehle Pagenberg Partnerschaft
Patentanwälte, Rechtsanwälte
Postfach 86 06 20
D-81663 München (DE)

Other party: Hendriks, Ralph
(Opponent 1) Via Gaeta, 16 (int. 12)
I-00185 Roma (IT)

Representative: Farago, Peter Andreas
Kanzlei Schieber - Farago
Patentanwälte
Thierschstraße 11
D-80538 München (DE)

Other party: Nike Retail B.V.
(Opponent 2) Colosseum 1
NL-1213 Hilversum (NL)

Representative: Eisenführ Speiser
Patentanwälte Rechtsanwälte PartGmbH
Postfach 10 60 78
D-28060 Bremen (DE)

Decision under review: **Decision of the Technical Board of Appeal
3.2.04 of the European Patent Office of
18 September 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: M. Vogel
J. Riolo

Summary of Facts and Submissions

I. This petition for review was filed by the patent proprietor against decision T 1397/09, taken by Technical Board of Appeal 3.2.04 on 18 September 2012, revoking European patent No. 1197157 (entitled "Shoe") inter alia on the grounds that auxiliary requests IV, V and VIII did not comply with Article 123(2) EPC. The decision was notified in writing on 11 December 2012, the reasoned petition was filed on 20 February 2013 and the fee for the petition was paid on the same day. The petition is based on Articles 112a(2)(c) and 113 EPC, and argues that the petitioner's right to be heard had been violated. The earlier proceedings, to the extent they are relevant for the purposes of the present petition proceedings, are summarised as follows:

II. The patent was granted on 22 September 2004. The claims relate to a shoe having a certain sole configuration, in particular composing three layers with openings which are arranged in a certain manner resulting in an at least partial overlap of the openings in the adjacent layers. According to the description, said sole configuration overcomes the disadvantages of the prior art on the one hand by meeting the mechanical properties required of shoes, and on the other by sufficiently transporting heat and humidity away from the foot. The patent was opposed by two opponents under Article 100(a) EPC on the grounds of lack of novelty (Article 54(1) to (4) EPC) and inventive step (Article 56 EPC) and under Article 100(b) EPC on the grounds of insufficiency of disclosure. The opposition division maintained the patent in amended

form in accordance with auxiliary request III, filed during oral proceedings.

III.

1. Both the patent proprietor and opponent II filed an appeal. The proprietor requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, in amended form according to one of auxiliary requests I, III, IV and V filed with the grounds of appeal. Opponent II requested that the decision under appeal be set aside and that the patent be revoked.

2. On 8 February 2012 the technical board summoned to oral proceedings, annexing a communication setting out its provisional non-binding opinion. Point 2.4 of this communication reads as follows:

The basis for the amendments according to auxiliary requests IV and V appears to be the as filed passages corresponding to specification paragraphs (0049), (0050). These passages mention features and functions not included in the claim: open frame construction, correspondence with the struts 14 as well as with openings 11, 12, determining resistance to foot movements and longitudinal stiffness. What is the original basis for such an intermediate generalization?

3. On 16 August 2012 the petitioner argued in response to the board's preliminary observations above that determining resistance to foot movement and longitudinal stiffness were not constructive features of the support element and therefore not mentioning these implicit properties in the claim did not

constitute an intermediate generalisation. It also submitted auxiliary request VIII, based on auxiliary request V with the addition that "the support element determines the resistance of the sole ensemble to foot movements and controls the longitudinal stiffness of the shoe", as mentioned in paragraph [0049] of the description.

4. During the oral proceedings before the board the petitioner withdrew auxiliary requests II, VI and VII. After discussion the board found auxiliary requests I and III to be novel, but to lack inventive step (Article 56 EPC). Thereafter auxiliary requests IV, V and VIII were discussed in connection with added subject-matter (Article 123(2) EPC). At the end of the oral proceedings the board announced that it had found that these requests contained added subject-matter, contrary to Article 123(2) EPC, and that therefore it was setting aside the contested decision and revoking the patent.

IV.

1. In the written decision the board noted inter alia that claim 1 of auxiliary requests IV, V and VIII incorporated, as feature (d), the feature of granted dependent claim 12 directed to an additional support element. But claim 12 as both granted and filed was dependent at least on claim 7, the features of which had not been included in claim 1 of any of these requests.

2. Apart from this omission, the versions of claim 1 of these auxiliary requests contained almost verbatim the formulation in paragraph [0049] of element openings

"corresponding to the openings and the struts of the support layer". However, "severed from the figures" this formulation no longer conveyed its specific meaning in the context of paragraph [0049], but acquired a much broader one. According to the established case law, this constituted an unallowable intermediate generalisation, unless the skilled person could recognise immediately that these features were not inextricably linked in terms of a functional or structural relationship.

V.

1. The petitioner alleges that the board violated its right to be heard under Article 113(1) EPC by finding that auxiliary requests IV, V and VIII contained added subject-matter, contrary to Article 123(2) EPC, without giving it any possibility to object to the reasons for the board's decision mentioned in Section IV above.

2. No such arguments had been put forward at any stage in the proceedings, either in the written submissions of opponent II or in the board's communication annexed to the summons. The only other conclusion to be drawn from the board's argumentation was that at least auxiliary request VIII complied with Article 123(2) EPC, as its claim 1 did repeat the wording of paragraph [0049].

3. During the oral proceedings on 18 September 2012, the board and opponent II had raised the question of added subject-matter only in very general terms. Neither the minutes of the oral proceedings nor the summary of facts and submissions in the written

decision showed any discussion of whether the features of claim 7 were missing from claim 1 of each of auxiliary requests IV, V and VIII, and of whether the feature at issue in paragraph [0049] acquired a different meaning in claim 1 of auxiliary requests IV, V and VIII if "severed of the figures". Nor did the petitioner's own minutes of the oral proceedings, as drawn up by its representatives on the same day.

5. As a matter of course, the petitioner would have reacted immediately by filing further auxiliary requests and/or rebutting the board's argumentation with respect to the formulation "severed from the figures" if the two added subject-matter issues had been explicitly discussed. Not knowing the crucial points of the board's decision, the petitioner had been prevented from presenting appropriate comments or evidence to refute the arguments on which the contested decision was based. Therefore, its right to be heard under Article 113(1) EPC had been infringed.

6. In addition, the petitioner submitted that it had been unable to raise objections under Rule 106 EPC during the oral proceedings because, as shown by the minutes, the board had closed the debate, deliberated, and then immediately given its decision.

7. The petitioner requested that

- the decision under review be set aside, that the proceedings be re-opened, and that the replacement of the board members who had participated in the decision under review be ordered;

- reimbursement of the fee for the petition for review be ordered;

- oral proceedings be appointed if the Enlarged Board were not minded to allow the first request above;

- in case of doubt as to the facts underlying the petition, to hear or procure declarations from the members of Board of Appeal 3.2.04 who had taken part in the oral proceedings, and to hear the representatives who had attended them on behalf of the proprietor.

VI.

1. In a communication annexed to a summons to oral proceedings, the Enlarged Board set out its provisional non-binding opinion and the issues which in its view might be relevant for the final decision. In particular, it expressed some doubt about the petitioner's allegation that the technical board's decision had taken it by surprise, as point 2.4 of the board's communication had queried the basis for the intermediate generalisation made in auxiliary requests IV and V.

2. Regardless of that, the Enlarged Board was not convinced, given the case law in review cases, that the petitioner's right to be heard had been infringed; there was no requirement in oral proceedings to draw the parties' attention to every single argument put forward in the final decision. It sufficed that the parties be given an adequate opportunity to comment in detail on all patentability requirements. As the parties had had the opportunity to consider and comment on all factual and legal aspects of the amendments in

auxiliary requests IV, V and VIII in the light of Article 123(2) EPC, the petitioner's right to be heard had not been infringed. It could not expect the board to give it further, more detailed indications. Lastly, the Enlarged Board observed that in inter partes cases boards had to avoid showing bias.

VII.

1. In a letter dated 20 December 2013 and during the oral proceedings on 30 January 2014, the petitioner strongly disagreed. The right to be heard under Article 113(1) EPC was a fundamental procedural right enshrined not only in the German constitution (Article 103 of the Grundgesetz, or Basic Law) but also in Article 6 of the European Convention on Human Rights (ECHR) - which also applied to proceedings before the boards of appeal - and in several EPC member states' codes of civil procedure. For example, under Article 139(2) of the German code, decisions could be based only on aspects on which a party had been given the opportunity to comment. Even if a party had clearly overlooked a decisive aspect, or the board assessed it differently from the parties, the board was obliged to give notice of this aspect. Otherwise the decision given was surprising and violated the fundamental right to be heard. This view was supported by the literature, such as the EPC commentaries by Schulte and Singer/Stauder, both of which stated that the right to be heard obliged a board to consider a party's arguments and to base its decision only on such factual and legal grounds as the party had been given the opportunity to comment on.

2. However, the petitioner had not been aware of the reasons on which the contested decision was based, in so far as the board had held that auxiliary requests IV, V and VIII constituted an intermediate generalisation because the formulation taken almost verbatim from paragraph [0049] of the description, when "severed from the figures", acquired a much broader meaning than in the original disclosure and therefore did not comply with Article 123(2) EPC (point 5.1 of the contested decision). As it had not been aware of these arguments during the oral proceedings but only when the decision was notified in writing, the board had taken it by surprise, violated its right to be heard, and prevented it from objecting to the procedural violation during the proceedings.

Reasons for the Decision

1. Admissibility

1.1 The petition was filed within two months of notification of the decision in question, the petitioner was adversely affected thereby, the prescribed fee was paid in time, and the petition identifies grounds under Article 112a(2) EPC and complies with Rule 107(1) and (2) EPC.

1.2 As regards the requirement in Rule 106 EPC that an objection to the procedural defect be raised during the appeal proceedings, since the petitioner's case is that it was not heard on matters which first appeared only in the board's written decision, it could be said that the exception clause under Rule 106 EPC applies. The

petitioner's case, as regards the alleged violations of its right to be heard relating to the board's decision to revoke the patent due to added subject-matter in auxiliary requests V and VIII, is that during the oral proceedings it was given no indication orally that the board would base its decision on an unallowable intermediate generalisation of claim 1 of the auxiliary requests then discussed.

1.3 On that basis, it can be accepted for the purpose of the present decision that the petitioner was not in a position to raise an objection under Rule 106 EPC during the appeal proceedings. The petition is therefore not regarded as clearly inadmissible.

2. Allowability

2.1 The petitioner maintains that it was given no opportunity - whether through appropriate information in the board's written communication, through the submissions of opponent II, or during the oral proceedings - to defend the amendments made to claim 1 of auxiliary requests IV, V and VIII, or to adjust them, after incorporating the features taken from the description's paragraph [0049], so as to overcome the objection underlying the decision, namely an intermediate generalisation not allowable under Article 123(2) EPC.

Furthermore the petitioner objected that the board should have pointed out that adding the features of dependent claim 12 to independent claim 1 of auxiliary requests IV, V and VIII would also have meant adding those of dependent claim 7 on which claim 12 was based.

In the absence of any such indications from the board - to which it was entitled under Article 6 of the European Convention on Human Rights (ECHR) protecting its right to a fair trial - the decision to revoke its patent took it completely by surprise, and was in breach of Article 113(1) EPC because it had been given no opportunity to comment on these revocation grounds beforehand.

2.2 The Enlarged Board agrees that the right to be heard may be infringed if a decision is based on grounds or evidence which surprise the adversely affected party because they were not discussed in the proceedings. This becomes undoubtedly clear from the wording of Article 113(1) EPC which requires that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This implies that a party may not be taken by surprise by the reasons of a decision, referring to unknown grounds or evidence. But in the circumstances of the present case it cannot share the petitioner's view that the contested decision was surprising in that sense.

2.2.1 In the view of the Enlarged Board, the petitioner's account of the proceedings before the technical board does not accurately reflect the course they actually took. Quite apart from the fact that the issue of an intermediate generalisation incompatible with Article 123(2) EPC had already featured in the earlier opposition proceedings, during examination of the amended claims, the technical board expressed clear doubts, in point 2.4 of its communication of 8 February

2012 annexed to the summons to oral proceedings, about the patentability of auxiliary requests IV and V due to an unallowable intermediate generalisation in their independent claim 1.

2.2.2 Thus, presented with the board's preliminary view, the petitioner was in a position by this specific revocation ground to reformulate its claims so as to take account of the board's reservations. It is also undisputed that it had enough opportunity, in both written and oral proceedings, to comment on the reservations expressed about its claims and to allay the board's doubts. If, in the ample time available, it did not succeed in doing so in its auxiliary request VIII, this was not because the board failed to draw its attention to the matter. The board had provided the necessary pointer in its communication of 8 February 2012.

2.3 Nor - contrary to the petitioner's view - did the board's decision contain any other reasons on that issue which could have surprised the parties, thereby infringing the petitioner's right to be heard under Article 113(1) EPC. The legal test concerning intermediate generalisation applied by the board, as indicated in § 5.1 of the Reasons of the decision, follows established case law of the Boards of Appeal. Also in that respect the petitioner could not be taken by surprise.

It is undisputed that the petitioner was entitled to be given an opportunity to comment on all aspects relevant for the decision, and thus also on intermediate generalisation, but it could not expect more than that.

That is in line with consistent Enlarged Board's case law, as shown also by the decisions in review cases discussed in the petitioner's submissions of 20 December 2013. Without exception, those decisions held that the petitioner's right to be heard under Article 113(1) EPC was not infringed if it was aware of an argument relevant for the decision and had an opportunity to comment on it (see R 6/11 and R 22/11, both citing R 2/08 of 11 September 2008, reasons point 8.2; and R 4/08 of 20 March 2009, reasons points 3.2 and 3.3). The technical board's communication of 8 February 2012 undoubtedly represented that opportunity, and the petitioner reacted by filing its auxiliary request VIII. The success or otherwise of its attempt to overcome known legal obstacles is irrelevant for the review proceedings.

2.4 The petitioner may have been surprised personally that its efforts to draft patentable requests did not overcome the technical board's objections, especially since it was subjectively convinced that its requests were legally sound. But objectively it cannot be said to have been surprised by a new ground not previously discussed. The petitioner's subjective feeling of surprise does not alter the fact that it was aware of the objections raised against its requests and had also been able to comment on them (see most recently R 1/13 of 17 June 2013, reasons point 21; R 12/09 of 15 January 2010, reasons point 13; R 15/10 of 25 November 2010, reasons point 11). For the question whether or not a party has been deprived of its right to be heard it is only relevant that it had got the opportunity to comment on all issues, which were decisive for the decision to be taken.

2.5 Contrary to the petitioner's submissions, even applying Article 125 EPC - under which the EPO, in the absence of procedural provisions in the EPC, takes into account the principles of procedural law generally recognised in the contracting states - did not require the board to provide it, with a view to the formulation of patentable claims, with help going beyond the annex to the summons of 8 February 2012. The petitioner cites § 139(2) of Germany's Code of Civil Procedure (CCP) as a special embodiment of the right to be heard, but that provision does not change anything here; it simply says that a court can base a decision on an aspect clearly overlooked or considered unimportant by a party only if it has drawn attention to it and given the parties the opportunity to comment. In the present case however the board has drawn attention to the relevant aspect.

2.5.1 There is no need to consider whether recourse to national law is even necessary in the present case, or whether § 139(2) CCP merely gives concrete form to the right to be heard under Article 113(1) EPC, so that there is no regulatory gap in the EPC requiring closure under its Article 125 EPC. For the annex to the board's summons drew the parties' attention to the issue at stake, and the petitioner reacted to it by filing auxiliary request VIII. It could not expect, even under § 139(2) CCP, additional information to prevent a "surprising" decision.

2.5.2 Apart from the fact that this, taken to extremes, would mean a never-ending sequence of indications from the board and amendments to the claims, boards are under no obligation to inform parties in advance of

every conceivable matter which ultimately, in the light of the facts and arguments put forward, they may consider relevant for the decision only during their deliberations (see e.g. R 12/09 of 15 January 2010, reasons point 11 and other references cited, and the following decisions based on the same principle: R 15/09 of 5 July 2010, reasons point 4; R 18/09 of 27 September 2010, reasons points 14 and 15; R 15/10 of 25 November 2010, reasons point 9; R 16/11 of 23 March 2012, reasons points 2.4 and 2.5; R 11/12 of 19 July 2013, reasons point 3.13).

2.6 The petitioner cites German law, which however sees things not differently. In its decision of 23 September 2008, for example, the Federal Court of Justice (BGH) ruled that the right to be heard did not create a general obligation to give parties pointers within the meaning of §§ 139 and 253 CCP; a court had such an obligation only if the parties, despite conducting the proceedings with all due care, could not foresee the legal considerations on which its decision might ultimately be based. In this decision (BGH GRUR 2009, 91/92 - Antennenhalter) the court held that the right to be heard did not give parties the right to learn, before it took its decision, how it would (or was likely to) assess the facts and arguments on which that decision would be based; they merely had to be given an opportunity to comment on them.

The technical board gave the petitioner this opportunity by pointing out, in its communication of 8 February 2012, that unallowable intermediate generalisation was an issue. It thus made clear what the likely basis of its decision would be. It was not

obliged to do more, and in particular to set out its definitive legal view of the case, because only at the deliberation stage does it finalise its argumentation. That is in line with practice of both the Enlarged Board of Appeal and the BGH on ensuring the right to be heard under Article 113(1) EPC and a fair trial under Article 6 ECHR.

2.7 Lastly, the Enlarged Board - unlike the petitioner - takes the view that consistent case law holds that a board would fail in its obligations of impartiality if one party were to be repeatedly advised that its requests were not patentable, until it managed to come up with a grantable claim.

2.8 The petitioner's objection in respect of a procedural defect therefore cannot succeed. There is no need to discuss its further objection, based on its belief that the board, to meet its obligations under Article 113(1) EPC, should have pointed out that adding the features of dependent claim 12 to independent claim 1 of auxiliary requests IV, V and VIII would also have meant adding those of dependent claim 7 on which claim 12 was based. Once its objection in respect of the oral proceedings has failed - because the board did not infringe its right to be heard in finding those auxiliary requests to be non-patentable due to an unallowable intermediate generalisation and therefore revoking the patent - there is no longer any need to discuss possible further infringements of the right to be heard, because they would lack the causal connection with the patent's revocation that is required for review proceedings under Article 112a EPC.

Order

For these reasons it is unanimously decided that:

The petition is dismissed as clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk