



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Große
Beschwerdekammer

Enlarged
Board of Appeal

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 10 February 2014**

Case Number: R 0013/13
Appeal Number: T 1760/11 - 3.3.01
Application Number: 00108480.5
Publication Number: 1020461
IPC: C07D 401/12, A61K 31/44,
A61P 1/04
Language of the proceedings: EN

Title of invention:

Magnesium salt of the (-)-enantiomer of omeprazole and its use

Patent Proprietor:

AstraZeneca AB

Opponents:

Hexal AG
Teva Pharmaceutical Industries Ltd.
Mepha AG
STADA Arzneimittel AG
Pinewood Laboratories Limited
ETHYPHARM
Actavis Group hf.
Lupin Limited
Zentiva a.s.
Generics [UK] Limited
Ratiopharm GmbH
1A Pharma GmbH
Hexal Pharma GmbH
Hörnchen, Ulrich, Dr.

Headword:

Fundamental violation of Article 113 EPC

Relevant legal provisions:

EPC Art. 56, 112(1)(a), 112a(2), 112a(2)(c), 112a(4), 113(1)
EPC R. 106, 107, 109(2)(a)

Keyword:

"Fundamental violation of the right to be heard (no)"
"Clearly inadmissible"
"Clearly unallowable"
"List of grounds exhaustive"
"Obligation to raise objection"
"Sufficiently reasoned (yes)"

Decisions cited:

R 0001/08, R 0002/08, R 0009/08, R 0010/09, R 0003/10,
R 0009/10, R 0013/11, R 0019/11, T 0967/97, T 0778/98,
T 0401/04, T 1154/04, T 0021/08

Catchword:

-



Case Number: R 0013/13

DECISION
of the Enlarged Board of Appeal
of 10 February 2014

Petitioner: Generics [UK] Limited
(Opponent 10) Albany Gate
Darkes Lane
Potters Bar
Hertfordshire EN6 1AG (GB)

Representative: Jump, Timothy John Simon
Venner Shipley LLP
200 Aldersgate
London EC1A 4HD (GB)

Other party: AstraZeneca AB
(Patent Proprietor) SE-151 85 Södertälje (SE)

Representative: Potter Clarkson LLP
The Belgrave Centre
Talbot Street
Nottingham NG1 5GG (GB)

Other party: Hexal AG
(Opponent 01) Industriestrasse 25
D-83607 Holzkirchen (DE)

Representative: Breuer, Markus
Henkel, Breuer & Partner
Patentanwälte
Erika-Mann-Straße 23
D-80636 München (DE)

Other party: Teva Pharmaceutical Industries Ltd.
(Opponent 02) 5 Basel Street
P.O. Box 3190
49131 Petah Tiqva (IL)

Representative: Gallagher, Kirk James
D Young & Co LLP
120 Holborn
London EC1N 2DY (GB)

Other party: Mepha AG
(Opponent 03) Domacherstr. 114, Postfach 445
CH-4147 Aesch BL (CH)

Representative: Best, Michael
Lederer & Keller
Patentanwälte
Unsöldstrasse 2
D-80538 München (DE)

Other party: STADA Arzneimittel AG
(Opponent 04) Stadastrasse 2-18
D-61118 Bad Vilbel (DE)

Representative: von Seebach, Malte
Maiwald Patentanwalts GmbH
Jungfernstieg 38
D-20354 Hamburg (DE)

Other party: Pinewood Laboratories Limited
(Opponent 05) Ballymacarbry
Clonmel
County Tipperary (IE)

Representative: Walsh, Marie Goretti
MacLachlan & Donaldson,
2B Clonskeagh Square
Clonskeagh Road
Dublin 2 (IE)

Petitioner: ETHYPHARM
(Opponent 06) 194 Bureaux de la Colline
Bâtiment D
F-92213 St Cloud Cedex (FR)

Representative: Regimbeau
20, rue de Chazelles
F-75847 Paris Cedex 17 (FR)

Other party: Actavis Group hf.
(Opponent 07) Reykjavikurvegi 76-78
IS-220 Hafnarfjordur (IS)

Representative: Gillard, Richard Edward
Elkington and Fife LLP
Thavies Inn House
3-4 Holborn Circus
London EC1N 2HA (GB)

Other party:
(Opponent 08)

Lupin Limited
46A/47A Village Nande
Taluka Mulshi
PUNE 411042 (IN)

Representative:

Clarke, Lionel Paul
Gill Jennings & Every LLP
The Broadgate Tower
20 Primrose Street
London EC2A 2ES (GB)

Other party:
(Opponent 09)

Zentiva a.s.
U kabelovny 130
CZ-102 37 Praha 10 (CZ)

Representative:

Skødt, Henrik
Plougmann & Vingtoft A/S
Rued Langgaards Vej 8
DK-2300 Copenhagen S (DK)

Other party:
(Opponent 11)

Ratiopharm GmbH
Graf-Arco-Strasse 3
D-89079 Ulm (DE)

Representative:

Teipel, Stephan
Lederer & Keller
Patentanwälte
Unsöldstrasse 2
D-80538 München (DE)

Other party:
(Opponent 12)

1A Pharma GmbH
Hexal Pharma GmbH
Stella-Klein-Loew-Weg 17
AT-1020 Vienna (AT)

Representative:

Breuer, Markus
Henkel, Breuer & Partner
Patentanwälte
Erika-Mann-Straße 23
D-80636 München (DE)

Other party:
(Opponent 13)

Hörnchen, Ulrich, Dr.
Steinenkreuz 28
D-53773 Hennef (DE)

Representative:

Vossius & Partner
Siebertstrasse 4
D-81675 München (DE)

Decision under review: **Decision of the Technical Board of Appeal
3.3.01 of the European Patent Office of
13-16 November 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: I. Beckedorf
 B. ter Laan

Summary of Facts and Submissions

I. By decision of 26 July 2013 the Enlarged Board of Appeal decided to consider the petitions for review R 5/13, R 9/13, R 10/13, R 11/13, R 12/13 and R 13/13, all filed against decision T 1760/11 of Technical Board of Appeal 3.3.01 (hereinafter: the Board) dated 13 to 16 November 2012, in consolidated proceedings according to Article 8 of its Rules of Procedure (RPEBA). The mention of "petitioners" hereinafter refers to the respective petitioner in each of the aforementioned cases; the submissions and requests recapitulated in the following, if not further specified, are those of all the petitioners and, hence, of each individual petitioner.

II. The Board held in the decision under review:

1. *The decision under appeal is set aside.*
2. *The case is remitted to the department of first instance with the order to maintain the patent with the following claims and a description to be adapted if necessary:
Claim(s): No. 1 to 13 of the auxiliary request 1 filed with the letter dated 6 April 2011 and received on 7 April 2011.*
3. *The request for referral to the Enlarged Board of Appeal of 15 November 2012 is rejected.*
4. *The objection of 16 November 2012 under Article 24(3) EPC is rejected as inadmissible.*
5. *The objection of 15 November 2012 under Rule 106 EPC is dismissed.*

III. The patent proprietor had appealed against the decision of the Opposition Division dated 29 July 2011 revoking European patent No. 1 020 461 *inter alia* for lack of inventive step starting from document D1 (DE-A-40 35 455), chosen as the closest prior art, and in view of document D2 (EP-A-0 124 495).

IV. In the annex to the summons to oral proceedings pursuant to Article 15(1) RPBA, the Board expressed its preliminary opinion on the grounds of opposition (Article 100(a), (b) and (c) EPC). In respect of inventive step, the Board noted *inter alia* that the most controversial points were the aspect whether the issue of inventive step had been decided with *res judicata* effect in decision T 401/04 of 19 December 2006, issued by the same Board but in a different composition, and the choice of the closest prior art, in particular whether document D1, as argued by the opponents, or document D2 or D11, as argued by the patent proprietor, was to be considered as the closest prior art.

V. The Board held oral proceedings on 13 to 16 November 2012 and found that the first auxiliary request met the requirements of the EPC as regards all grounds of opposition. The course of the oral proceedings was recorded in the minutes in some detail.

With regard to the principle of *res judicata*, in view of previous decision T 401/01, the Board concluded that the issues of fact of the present appeal were not the same as those under consideration in decision T 401/04, and that, for that reason alone, the principle of *res judicata* did not apply, thus leaving it for the Board to evaluate and decide on the present appeal based on the merits of the case (Reasons, point 4; minutes, page 4).

As to the issue of inventive step, the Board chose document D2 as the closest prior art, rather than

document D1 or document D11 (minutes, pages 5 and 6; Reasons, points 10.1 to 10.3.8). The evaluation starting from document D2 led the Board to conclude that the subject-matter of claim 9 and all other claims of the first auxiliary request involved an inventive step. For the discussion of inventive step further documents were taken into account, including documents D1 and D11 (Reasons, point 10.6).

The Board (Reasons, point 12) rejected the petitioners' request to refer the following two questions to the Enlarged Board in relation to the aforementioned issues (Article 112(1) (a) EPC):

1. *In case where there is more than one feasible starting point, is it admissible, contrary to T 21/08, to find an inventive step by applying the problem solution approach starting from only one of these starting points without considering the others?*
2. *In particular, is it admissible in a case relating to a patent granted on a divisional application, to ignore the starting point identified by the Appeal Board in the technically closely related parent case (here: T 401/04)?*

The Board also dismissed the petitioners' objection under Rule 106 EPC regarding their submission that the issue of inventive step should be addressed starting from document D1 (Reasons, point 13).

VI. Petitions for review were filed in due time and form by:

- a) petitioner I (opponent 06), subject of R 5/13,
- b) petitioner II (opponent 04), subject of R 9/13,
- c) petitioner III (opponent 02), subject of R 10/13,
- d) petitioner IV (opponent 01), subject of R 11/13,
- e) petitioner V (opponent 07), subject of R 12/13,
and
- f) petitioner VI (opponent 10), subject of R 13/13.

VII. All petitioners essentially alleged a fundamental infringement of the right to be heard (Articles 112a(2)(c) and 113(1) EPC). In addition, petitioners II and IV claimed that there was a lack of reasoning as to why the Board rejected at least the request to refer the second question to the Enlarged Board.

VIII. The petitioners' reasoning can be summarised as follows:

1. In respect of the admissibility of the petition for review, all petitioners relied upon their formal objection under Rule 106 EPC.
2. With respect to the first complaint, all petitioners in essence argued that the Board not only "fundamentally erred" in denying that document D1 was a feasible starting point for the assessment of inventive step according to the problem-solution approach. In addition, choosing document D2 instead of document D1, the Board made a number of "basic errors in the evaluation of the technical information before it and the application of established EPO case law to that information".

The Board's choice came as a surprise because the significance of document D2 was only mentioned by the Chairman on the morning of the third day of the oral proceedings and the parties were then invited to comment on the second paragraph on page 8 of said document; until then the discussion had been focused almost entirely on documents D1 and D11 and it was not apparent that document D2 was to be the only document on the basis of which inventive step would be assessed.

After the debate on the issue of inventive step in the light of document D2 as the closest prior art, the Board concluded that the subject-matter claimed in the patent proprietor's first auxiliary request involved an inventive step. This conclusion should have led to the commencement of a debate on the ground of lack of inventive step starting from document D1, but this was refused by the Board. Thus, the Board took a decision without hearing the petitioners' complete case.

In addition, the Board applied the problem-solution approach wrongly in allowing only one document as the starting point for discussing inventive step, where the case law allowed for more than one document to be considered as the closest prior art and for a discussion of lack of inventive step starting from any of those documents. That denial implied an infringement of the right to be heard according to Article 113(1) EPC.

In addition, the Board based its decision not to consider document D1 as a starting point for inventive step merely on the parties' written submissions. Thus, it deprived the petitioners of their right fully to present their arguments against inventive step of the subject-matter of the set of claims according to the first auxiliary request in view of document D1. Since all petitioners had raised in writing objections against inventive step starting from document D1, the Board should at least have given them the opportunity to present oral submissions on this point, even if the Board had a different view.

In fact, the Board had been bound by its previous decision in case T 401/04, concerning the parent patent EP 0 652 872, because the facts on which the choice of the closest prior art in that case had been based, were the same. The Board at least should have referred the questions submitted by the petitioners to the Enlarged Board in accordance with Article 112(1)(a) EPC.

Additionally, petitioner I argued that in its written decision the Board dealt neither with the technical feature of the greater than 99.8% enantiomeric excess nor with the request for confirmation of the decision of the Opposition Division in respect of lack of inventive step in view of documents D1 and D2.

In so far as petitioner II raised doubts about the ability of the Chairman of the Board to put the petitioners' arguments and requests in the right context, this submission was later qualified as being not a complaint on its own but rather an "explanation" of the petitioner's view that its right to be heard had been infringed when the closest prior art document was selected.

3. In respect of the second complaint, it was argued that the Board's lack of reasoning for rejecting the petitioners' requests for referral to the Enlarged Board amounted to a substantial procedural violation because the petitioners were not in a position to evaluate whether the Board had correctly exercised its discretion in this respect.
4. The request for a replacement of the Board members was justified by the petitioners' doubts whether those

members who took the decision under review could be expected to approach the case again in an objective manner.

IX. The Enlarged Board appointed oral proceedings. Together with the summons to those oral proceedings, it sent a communication informing the petitioners of its provisional opinion that if, or to the extent that, each petition might be admissible, it appeared to be clearly unallowable.

X. In their written replies to the aforementioned communication and at the oral proceedings, which took place on 10 February 2014 and at the end of which the decision in each of the six R-cases was announced, the petitioners essentially reiterated their earlier submissions, with emphasis on the following issues:

1. Concerning the admissibility issue, it was submitted that the formal objection under Rule 106 EPC raised during the oral proceedings before the Board was to be understood as covering both the issue of the refusal to address inventive step starting from document D1 as the closest prior art during the oral proceedings as well as the issue of the referral of two questions to the Enlarged Board, which had been rejected by the Board. Since those questions concerned the same context, the objection was meant to cover also the Board's refusal to refer.

In the event that the objection was understood not to cover the latter, it was submitted - as an auxiliary line of argument - that it only became apparent from the written reasoning of the decision under review that

either no decision had been taken on the second question for referral or that this question had simply been ignored by the Board. Hence, no objection under Rule 106 EPC could have been raised.

2. In respect of the allowability of the petitions, the petitioners submitted that the Board, although being entitled to take the substantive decision on the selection of the closest prior art, was not entitled to do so without allowing the petitioners to complete their cases regarding the ground of lack of inventive step. It was intolerable to maintain the decision under review. In support of this submission, the petitioners relied upon the following lines of argument:

- a) With receipt of the written reasoning of the decision under review, it came as a surprise that document D1 was qualified as not being a realistic, feasible and legitimate starting point. As held in case T 21/08 (cf. T 967/97), "if the skilled person has a choice of several workable routes, *i.e.* routes starting from different documents, which might lead to the invention, the rationale of the problem-solution approach required that the invention be assessed relative to all these possible routes, before an inventive step could be acknowledged. Conversely this means that if the invention was obvious to the skilled person in respect of at least one of these routes, then an inventive step was lacking. For the Board this means that, in a situation as in the present case, there is no need to discuss which document is 'closer' or 'closest' to the invention, the only question is whether E13 is a feasible starting point." Since, in the present case, document D1 was a starting point at least as feasible

as document D2, a discussion starting from D1 should have been permitted.

- b) Even though D1 had not been selected as the closest prior art, the Board was obliged to consider it because all the petitioners had relied on it as their strongest attack on the patent in suit and there was at least some probability that a skilled person studying D1 would arrive at the claimed invention with only trivial modifications needed. As a general principle, if one party insisted on submitting arguments on a specific issue, it had a right to be heard on this point, in particular if the issue concerned that party's main argument. However, the debate at the oral proceedings concerning the selection of the closest prior art was terminated before the essential point had been discussed, *i.e.* whether any of the documents (D1, D2 and D11) rendered the claimed invention obvious.
- c) The Board had chosen as the closest prior art a document (D2) that had been mentioned by the parties only on a secondary basis and to which, at the oral proceedings, the patent proprietor itself attributed no relevance in this respect; hence the patent proprietor had withdrawn its earlier submissions based on document D2. Consequently, the Board should have informed the parties beforehand of its intention to use that document of its own motion and to exclude document D1 as the closest prior art from further discussion. Since the Board failed to do so, it infringed the petitioners' right to be heard (cf. T 778/98 and T 1154/04). The petitioners had never assumed D2 to be a realistic starting point.

d) The petitioners also referred to the issue of *res judicata*. Although the Board's position not to follow its decision in respect of the parent patent (T 401/04) was not open to a petition for review, the Board was bound by the principles of legal certainty and legitimate expectation and should have informed the parties of its intention to deviate from the earlier decision. At the very least, it should have referred the second question to the Enlarged Board.

e) The different stages of the problem-solution approach could not be applied strictly one after the other. Rather, a party had a fundamental right under Article 113(1) EPC to present completely its first and best case. Thus, the Board could have reached its decision on the closest prior art only after hearing the petitioners' entire case on inventive step starting from document D1 as well. Moreover, the Board did not even follow that approach but applied additional, inappropriate criteria when selecting the starting point for the evaluation of inventive step.

XI. At the oral proceedings, each petitioner requested that the decision under review be set aside, that the proceedings before the Board of Appeal be re-opened, and that the members of the Board of Appeal who participated in the decision under review be replaced.

Moreover, petitioners I, III, IV and VI requested

that reimbursement of the fee for petition for review be ordered.

Reasons for the Decision

1. All petitioners are adversely affected by the decision under review. The provisions of Article 112a(4) EPC and Rule 107 EPC are satisfied.

Scope of the petitions

2. The petitioners invoke multiple grounds for their respective petitions for review.
3. The petitions for review are founded mainly on the allegation that the appeal proceedings leading to the decision under review involved a fundamental infringement of the petitioners' right to be heard (Articles 112a(2)(c) and 113(1) EPC) in that the Board took its decision on the patent proprietor's first auxiliary request without allowing the petitioners to complete their submissions on the ground of lack of inventive step, in particular in view of document D1.
4. Additionally, the petitioners claim that the Board should have followed their requests to refer the questions submitted by them concerning the selection of the closest prior art and the concept of *res judicata* to the Enlarged Board of Appeal according to Article 112(1)(a) EPC, or that the Board either ignored the requested referral of the second question or failed to reason why it rejected the referral.

Admissibility

5. Article 112a EPC contains a limited and exhaustive list of grounds on which a petition for review can be based.

Rule 106 EPC provides:

"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 proceedings."

6. Annexed to the minutes of the oral proceedings before the Board, is a hand-written objection signed by all the petitioners. The petitioners stated that during the oral proceedings they had been denied the opportunity to address inventive step starting from D1 as the closest prior art. This objection was dismissed at the end of the oral proceedings.

Thus, Rule 106 EPC has been complied with in respect of the main ground for petition for review, and the Enlarged Board does not find that the petitions are clearly inadmissible in this respect.

7. However, with regard to the additional ground for petition for review the Enlarged Board notes that the Board's rejection of the petitioners' request to refer two questions to the Enlarged Board was not explicitly objected to during the oral proceedings before the Board.

The Enlarged Board is not convinced by the petitioners' submission that such an objection was implicitly contained in the objection filed during the oral proceedings. The wording of the latter is absolutely clear concerning its subject-matter and, hence, not open to any extensive interpretation: "We hereby raise an objection under R. 106 EPC since we were denied the opportunity to address inventive step starting from D1 as closest prior art the oral proceedings. This constitutes an infringement of the right to be heard."

The petitioners' auxiliary line of argument that it only became apparent from the written reasoning of the decision under review that either no decision was taken on the second question for referral or that this question had simply been ignored by the Board (see point (1) below), or the additional complaint of petitioners II and IV that the Board did not reason its rejection of the request to refer the second question to the Enlarged Board (see point (2) below), cannot be followed either.

(1) As to the first and second complaints, the Enlarged Board notes that the Board extensively dealt with the issue of *res judicata*, being the essence of the second question for which referral was requested during the oral proceedings (minutes, page 4). Hence, already at the oral proceedings the petitioners were - or at least could have been - aware of the Board's refusal to grant the petitioners' request to refer any of the two questions to the Enlarged Board. Thus, the petitioners could well have objected to that refusal during the oral proceedings in accordance with Rule 106 EPC.

(2) Regarding the third complaint, the Enlarged Board notes that a lack of reasoning in a decision of a Board is no ground for a petition for review, whether under Article 112a(2) EPC or otherwise (see R 1/08 of 15 July 2008, Reasons, point 4; R 19/11 of 2 October 2012, Reasons, point 2.4, regarding the specific issue of the adequacy of the reasoning of an appeal decision).

(3) Consequently, each of the petitions for review is clearly inadmissible in respect of the petitioners' additional ground for petition for review.

8. The same is true in respect of the supplementary complaint by petitioner I that the Board in its written decision dealt neither with the technical feature of the greater than 99.8% enantiomeric excess nor with the request to confirm the decision of the Opposition Division in respect of lack of inventive step in view of documents D1 and D2.

Allowability of the petitions for review

9. The petitions essentially invoke the ground of petition for review according to Articles 112a(2)(c) and 113(1) EPC.

Article 113(1) EPC provides:

"The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."

10. The petitioners submit that the Board decided on the appeal in infringement of Article 113(1) EPC in a manner that gave the petitioners no opportunity to present orally all their arguments on the issue of inventive step of the claims according to the patent proprietor's first auxiliary request.

As established in case R 3/10 of 29 September 2011 (Reasons, point 2.10), "the right to be heard is a fundamental right of the parties which has to be safeguarded, irrespective of the merits of the party's submissions. The necessity to respect it is absolute and therefore cannot be made dependent on a prior assessment of the merits of the party's submissions, which in the present case would involve an assessment of the degree of likelihood that the arguments of the petitioner would have convinced the Board to acknowledge inventive step. It is the very essence of the right to be heard that the party is given a full opportunity to defend its case and to persuade the deciding body that its position is the correct one. This right would be undermined if it were made dependent on an evaluation as to whether the party's standpoint is likely to be justified. In order to answer the question of whether a fundamental infringement of the petitioner's right to be heard occurred as a result of the petitioner's not having been heard on inventive step, it is therefore irrelevant whether the respondents are right in their assessment of the clear obviousness of the claimed solution."

11. The petitioners' key objection lies with the Board's decision to choose document D2 as the (only) closest

prior art, rather than documents D1 and D11, which had been proposed by the petitioners and the patent proprietor respectively, and to limit the discussion of the issue of inventive step of the claimed subject-matter according to the patent proprietor's first auxiliary request on document D2 as the (only) starting point in applying the problem-solution approach. According to the petitioners, had the Board allowed a continued discussion of the issue of inventive step starting from document D1, the petitioners would have demonstrated that the subject-matter of the claims according to the first auxiliary request was obvious to the skilled person. Since the Board refused that continued debate, it deprived the petitioners of the opportunity to present arguments on this matter.

12. In support of this, the petitioners in their concluding submissions during the oral proceedings put forward essentially three lines of argument:

- (1) that the closest prior art could only be determined at the end of a complete discussion of inventive step starting from all the documents that a party or the parties chose to rely on (point 15 below);
- (2) that the Board failed both to inform the parties of its intention to select of its own motion document D2 and to invite the parties to comment on this in order to convince the Board of the inaccuracy of its choice (point 16 below);

(3) that document D1 should also have been considered as a realistic starting point for the discussion of inventive step (point 17 below).

13. Before investigating the aforementioned arguments, the Enlarged Board notes that the examination whether or not the subject-matter of a patent claim involves an inventive step according to the well-established problem-solution approach is a matter of substantive law. That is equally true for the determination of the closest prior art as the first step in the multi-stage method of the problem-solution approach, whether one document alone or a plurality of documents was taken as the starting point or most promising springboard aiming at the invention.

14. In view of this, it has to be borne in mind that review proceedings based on Article 112a(2)(c) EPC are confined to procedural defects so fundamental as to be intolerable. It follows from the essential interest of legal certainty that appeal proceedings leading to a final decision shall be re-opened only if one of the grounds provided for in Article 112a EPC applies. The petition for review is no means to review the correct application of substantive law (consistent case law since R 1/08 of 15 July 2008, citing the *travaux préparatoires*, and R 2/08 of 11 September 2008).

15. In respect of the first line of argument, the Enlarged Board cannot follow the petitioners' view point that the closest prior art - at least in the present case - could have been chosen only after all stages of the problem-solution approach were completed.

According to the established case law of the boards of appeal, the problem-solution approach is the key element for the assessment of inventive step and is the one which is applied first and foremost. It follows a clear method consisting of three main stages, of which the determination of the closest prior state of the art is the first (see Case Law of the Boards of Appeal, 7th edition 2013, section I.D.2., p. 165 *et seq.*).

The petitioners put forward that the first stage of the problem-solution approach could and should have been concluded only after the other two stages had been gone through (*i.e.* after the "objective technical problem" to be solved had been established and after it had been considered whether or not the claimed invention, starting from the closest prior art and in view of the objective technical problem, was obvious to the skilled person). In other words, the petitioners argue that they should have been allowed to discuss all the issues of inventive step of any stage of the problem-solution approach in respect of all possible starting points they wished to rely on, despite the fact that the Board structured the discussion by first establishing which document or documents constituted the most promising starting point for an obvious development leading to the invention. In this, the Board not only followed the sequence for the debate announced in its communication annexed to the summons to oral proceedings (page 8, second paragraph; page 9, last paragraph), but by doing so it also systematically applied the standard method of the problem-solution approach.

In so far as the petitioners alleged that the Board deviated from the problem-solution approach by relying

on a criterion that was irrelevant for the determination of the closest prior art (*i.e.* the Board's opinion that "taking document D1 as a starting point for the analysis of inventive step relies on a hindsight knowledge of what is claimed and is therefore inappropriate for an objective assessment of inventive step"; Reasons page 56), this allegation concerns a substantive matter.

However, petition for review proceedings may not be used to review the exercise by a Board of its discretionary power if that would involve an impermissible consideration of substantive issues (see R 1/08 of 15 July 2008, Reasons, point 2.1; R 10/09 of 22 June 2010, Reasons, point 2.2; R 9/10 of 10 September 2010, Reasons, point 10; R 13/11 of 20 April 2012, Reasons, point 4).

In petition proceedings, the Enlarged Board cannot act as a third instance or second-tier appellate tribunal, nor can it examine whether or not the substantive conclusions arrived at by the Board were justified; under no circumstances may the petition for review be a means to review the correct application of substantive law (see Case Law, *supra*, section IV.E.9.2.4.b), p. 1066 *et seq.*; R 1/08 of 15 July 2008, Reasons, point 2.1; R 2/08 of 11 September 2008, Reasons, point 5; R 9/08 of 21 January 2009, Reasons, point 6.3), which includes issues falling within the discretion of the Board (R 10/09 of 22 June 2010, Reasons, point 2).

However, that is exactly what the petitioners seek by requesting the Enlarged Board to reconsider the appeal proceedings on its merits and thereby to put its

evaluation of the merits above that of the Board. A technical review of the Board's evaluation of inventive step in terms of whether it is objectively correct or appropriate, is outside the jurisdiction of the Enlarged Board.

Finally, the Enlarged Board cannot accept the petitioners' contention that a party, in principle, should be allowed to discuss any particular issue that it relies on or even forms the subject of a request.

Neither the EPC nor the Rules of Procedure of the Boards of Appeal provide any legal basis for such a general approach in appeal proceedings, in particular in *inter partes* appeal proceedings. Nor is the existence of any such entitlement supported by the principle of party disposition. That principle relates merely to the parties' right of disposal over their requests by advancing, withholding or withdrawing them as they see fit.

More relevant to the present case is another principle of appeal proceedings, the principle of procedural economy, which requires a board of appeal to focus on those points that are relevant for the decision. In the present case, the Board considered that the case could be decided in respect of the issue of inventive step by systematically applying the problem-solution approach stage by stage. Thus, it systematically limited its decision-making and accordingly the discussion with the parties to determining the closest prior art first, before discussing the other aspects of the inventive step of the subject-matter claimed according to the patent proprietor's first auxiliary request.

Consequently, the Enlarged Board does not follow the petitioners' argument that the Board was obliged to let them continue to argue on the alleged lack of inventive step starting from document D1 despite the Board's conclusion not to take that document as the closest prior art and starting point for the further discussion of inventive step.

Since the petitioners were given the opportunity to submit their arguments with regard to the issue of determining the closest prior art, their right to be heard has been observed. Once the Board had reached a substantive conclusion by already excluding one or more documents (here: documents D1 and D11) as starting points for the assessment of inventive step, it was logically consistent to exclude all other prior art not found to be the closest prior art as starting point for the further discussion of inventive step according to the second and third stages of the problem-solution approach. By following this methodology the Board did not infringe the right to be heard, because - as indicated above - a party is not entitled to be additionally heard on the application of the problem-solution approach starting from other pieces of prior art than the closest prior art.

Hence, no infringement of Article 113(1) EPC was committed by the Board.

16. With regard to the second line of argument, the Enlarged Board notes that there is no evidence to support the petitioners' allegation that the Board failed to inform the parties of its intention to select

document D2 as the closest prior art and to invite the parties to comment on this so that they might convince the Board of the inaccuracy of its choice.

Rather, there is evidence that the Board actually indicated the possible selection of document D2 as the closest prior art, at a point in time during the proceedings that still allowed the petitioners to react to it.

First, in its communication annexed to the summons to oral proceedings, the Board explicitly pointed to document D2 as one of the documents to be considered in the choice of the closest prior art.

Secondly, according to the minutes of the oral proceedings (pages 5 to 7) and the Board's communication dated 10 January 2013, the discussion concerning the determination of the closest prior art among all of documents D1, D2 and D11 started on 14 November 2012 and continued the next day. The parties were invited to present their arguments. During the debate, the Board first indicated its preliminary opinion in respect of the teaching of document D1 and continued the discussion regarding the choice of the closest prior art. After deliberation, the parties were informed that the Board considered document D2 to be the closest state of the art and subsequently they were invited to address the questions of what the objective problem starting from that document was and whether that problem had been solved.

For this reason, the Enlarged Board cannot find a basis for the petitioners' allegation submitted with its second line of argument.

17. Concerning the third line of argument, that document D1 should also have been considered as a realistic starting point for the discussion of inventive step, the Enlarged Board cannot identify any procedural defect.

The minutes of the oral proceedings show that the issue of whether or not the document preferred by the petitioners (D1) was to be determined as an additional starting point for the evaluation of inventive step was exhaustively discussed with the parties (minutes, pages 5 and 6).

Furthermore, in the decision under review, the Board recapitulated in detail the key arguments submitted by the parties, in particular the petitioners, in this respect during the written as well as the oral proceedings (Facts and Submissions points XII and XIII). The Board gave its reasons for not choosing document D1 (as well as document D11) as the closest prior art and for considering document D2 to be the starting point on the basis of which to apply the problem-solution approach in order to decide on the issue of inventive step (Reasons, points 4 and 10 *et seq.*).

The minutes further record an intervention by *inter alia* petitioner IV against the Board's approach of determining only one single document as the starting point for the discussion on inventive step, and also a

request to give the petitioners the opportunity to address inventive step of the subject-matter of the first auxiliary request starting from document D1, which the Board rejected (minutes, pages 6 and 7).

Thus, the Board was obviously aware of the petitioners' arguments in favour of document D1 as at least a second closest prior art document and gave reasons why it came to a different conclusion (Reasons, points 4 and 10 et seq.).

Hence, the petitions, again, concentrate on the substantive decision of the Board and on the petitioners' disagreement with the Board's determination of the closest prior art as the starting point for the problem-solution approach when assessing the issue of inventive step. The petitioners dispute neither the sequence of events during the oral proceedings (the request for correction of the minutes, although refused, confirms the petitioners' objection to the Board's refusal to discuss the issue of inventive step starting from document D1) nor the fact that the question of which document or documents were to be chosen as the closest prior art was discussed first.

Their ground for review rather lies with the Board's substantive decision not to take document D1 into consideration as a starting point in the subsequent discussion of whether or not the claims according to the patent proprietor's first auxiliary request involved an inventive step. It is this "refusal" that the petitioners find to imply an infringement of their right to be heard. Their argument is based on their

opinion that, on the one hand, the Board was *legally* bound by decision T 401/04 of 19 December 2006 regarding the choice of document D1 as the closest prior art or that, on the other hand, from a technical point of view document D1 should have been determined at least as a second starting point for the discussion of inventive step.

18. Consequently, none of the three lines of argument by the petitioners can lead to the conclusion that the petitioners did not have sufficient opportunity to comment on all aspects on which the decision was taken, so that no infringement of Article 113(1) EPC was committed by the Board.

19. To investigate any further would mean assessing whether the Board correctly understood the substantive arguments submitted by the parties and, above all, whether it gave the right answer to them. The (mere) fact that the petitioners do not share the view of the Board and do not accept the outcome of the decision under review would be a matter for a review of the merits of the decision, which is not a means of redress provided for in the EPC.

20. Consequently, to the extent that the petitions for review are not clearly inadmissible (see points 7 and 8 above), they are clearly unallowable.

21. In view of the aforementioned conclusion, there is no need to decide on the request of petitioners I, III, IV and VI that the reimbursement of the fee for petition for review be ordered; the appeal proceedings are not reopened as required in Rule 110 EPC.

Order

**The Enlarged Board of Appeal as composed under Rule 109(2) (a)
EPC unanimously decides:**

**"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