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**Datasheet for the decision
of the Enlarged Board of Appeal
of 13 September 2013**

Case Number: R 0017/13

Appeal Number: T 0233/11 - 3.2.08

Application Number: 99956343.0

Publication Number: 1128788

IPC: A61F 2/30, A61F 2/46

Language of the proceedings: EN

Title of invention:
BONE PLUG

Patentee:
Spierings, Petrus Tarasius Josephus

Opponent:
Bradnock, Brian Robert Denis Peter

Headword:
-

Relevant legal provisions:
EPC Art. 112(a)

Keyword:
"Violation of right to be heard - no"
"Other fundamental procedural defect - no"
"Petition for review: clearly inadmissible - clearly
unallowable"

Decision cited:
R 0005/08

Catchword:
-



Case Number: R 0017/13

DECISION
of the Enlarged Board of Appeal
of 13 September 2013

Petitioner: Spierings, Petrus Tarasius Josephus
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Representative: Verhees, Godefridus Josephus Maria
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Other Party: Bradnock, Brian Robert Denis Peter
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Decision under review: **Decision of the Technical Board of Appeal
3.2.08 of the European Patent Office of
4 June 2013.**

Composition of the Board:

Chairman: W. van der Eijk
Members: K. Garnett
U. Krause

Summary of Facts and Submissions

- I. The patent proprietor (hereafter: the petitioner) petitions against the decision of Board of Appeal 3.2.08 dated 4 June 2013 dismissing its appeal against the decision of the Opposition Division revoking European patent No. 1 128 788.
- II. Claim 1 of the granted patent related to a bone plug comprising inter alia a solid body which would expand in the radial direction while "solely" being compressed in the axial direction.
- III. The Opposition Division had revoked the patent on the single ground that because of the addition during examination proceedings of the word "solely" to claim 1, the subject matter of this claim was not disclosed in the application as originally filed and thus extended beyond the content of this document (Article 100(c) EPC). Other grounds of opposition were not dealt with.
- IV. The petitioner filed an appeal against the decision, requesting remittal of the case to the Opposition Division and reimbursement of the appeal fee on the grounds of an alleged procedural violation, alternatively that the patent be maintained as granted. The opponent filed a reply requesting dismissal of the appeal. Both parties requested oral proceedings.
- V. On 24 January 2013 the Board sent a communication to the parties together with a summons to oral proceedings. With respect to the ground of opposition under Article 100(c) EPC, the Board noted that it seemed to be common ground that having regard to the word

"solely", the precise wording of granted claim 1 was not to be found in the application as filed and that the term "solely" appeared to be derived from specific embodiments described in the application as filed and the corresponding figures. The Board expressed the provisional view that according to the original disclosure the specified compression of the solid body was obtainable only when the claimed plug comprised particular features referred to in the description. The Board further expressed the view that no procedural violation appeared to have occurred before the Opposition Division.

The Board concluded by saying that it would therefore have to be discussed at the oral proceedings whether the claims as granted satisfied the requirements of Article 123(2) EPC and thus whether the ground of opposition under Article 100(c) EPC was justified. Also to be discussed would be whether a substantial procedural violation had occurred and whether the appeal fee should be reimbursed. The Board indicated that if it came to the conclusion that the patent met the requirements of Article 123(2) EPC, remittal of the case to the Opposition Division should be expected

VI. Neither the petitioner nor the opponent filed any observations in reply to the communication. By letter dated 17 April 2013 the opponent stated that it was not planning to attend the oral proceedings. By its letter dated 3 May 2013 the petitioner informed the Board that it also was not planning to attend.

VII. Oral proceedings duly took place on 4 June 2013 in the absence of both parties. The minutes of the oral

proceedings record the parties' requests as above. After deliberation the Board dismissed the appeal and refused the request for reimbursement of the appeal fee.

VIII. The reasons for the decision were dispatched to the parties on 14 June 2013. After reciting the facts and submissions, including the arguments of the parties, the Board explained why it had come to the conclusion that no procedural violation had occurred in the first instance proceedings and why it considered that the addition of the word "solely" to claim 1 meant that the subject matter of the patent extended beyond the application as filed. The Board referred to its communication in which it had given its provisional view that the specified compression of the solid body appeared to be obtainable only when the claimed plug comprised particular features referred to in the description. The Board then noted that:

"The [petitioner] has dispensed with discussing the matter at the oral proceedings and with submitting a revised set of claims comprising the features referred to above" (i.e., the particular features referred to in the description).

IX. The petition was filed on 5 August 2013 and the appropriate fee paid on the same day. Review of the Board's decision was requested "according to" Article 112a EPC; in particular it was requested that the decision be set aside and the proceedings be reopened before the Boards of Appeal. Four reasons were given as justification for these requests:

- (a) It could only have been correct for the Board to say, as it did, that "The [petitioner] has dispensed ... with submitting a revised set of claims comprising the features referred to above" if it had been clear to the petitioner that it should have filed revised claims. However, the petitioner only learnt on receipt of the written decision that the reason why the appeal had been dismissed was that the petitioner had not filed amended claims. The petitioner had agreed with the provisional view of the Board in its communication and once the opponent had said that it was not planning to attend the oral proceedings there was no reason for the petitioner to do so. In informing the Board that it would not be attending the oral proceedings it had been the petitioner's intention to inform the Board that it agreed with the provisional opinion. It was thus clear that the petitioner was not aware that amended claims had to be filed and it was clear that the petitioner's intention was that the patent be maintained in amended form.
- (b) The Board should have invited the petitioner to file amended claims. The Board should have known that it was the petitioner's intention to have the patent maintained in amended form and the Board could have expected that the petitioner was not aware that it was necessary to file amended claims at this stage of the proceedings to avoid the appeal being dismissed.
- (c) Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA) provides the only reason for

remittal of a case, namely if fundamental deficiencies are apparent in the first instance proceedings. Filing or not filing amended claims does not affect this question. Because of this the petitioner also did not get any indication that amended claims should be filed and the Board again should not have dismissed the appeal for failure to file amended claims.

- (d) It is not clear why the complete patent was revoked when only claim 1 was held not to meet the requirements of the EPC and when at least one of the sub-claims did meet the requirements. The Board had in effect indicated in its communication that claim 11 in combination with claims 1 and 2 would not be objectionable under Article 123(2) EPC. If indeed claim 1 alone was objectionable under Article 123(2) EPC then the petitioner would expect that this combination of claims would be upheld.

X. The petitioner has not requested oral proceedings.

Reasons for the decision

1. The provisions of Article 112a(4) EPC and Rule 107 EPC are satisfied.
2. The Enlarged Board in decision R 5/08 of 5 February 2009, point 22 of the Reasons said:

"... the contents of a petition must be sufficient for the petitioner's case to be properly

understood on an objective basis and must be so presented as to enable the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect which can be the subject of an objection under the provisions on review. The petition must thus set out the reasons why it requests that the impugned decision be set aside, specify the facts, arguments and evidence relied on and must do so by the end of the time for filing the petition, namely two months after notification (Article 112a(4) EPC)."

3. Article 112a EPC contains a limited and closed number of grounds on which a petition for review can be based. The petition in the present case does not identify which of the grounds under Article 112a EPC are said to justify the requests in the petition. Nor are the complaints in petition framed by reference, even implicitly, to such grounds or such that they can be understood to relate to such grounds. This alone would justify the rejection of the petition as clearly inadmissible or clearly unallowable.
4. In the petitioner's favour the Enlarged Board will nevertheless assume that the petition is based on the grounds either that:
 - (a) A fundamental violation of Article 113 EPC occurred (Article 112a(2)(c) EPC); or
 - (b) The Board decided on the appeal without deciding on a request relevant to that decision

(Article 112a(2) (d) EPC in combination with Rule 104(b) EPC).

The Board cannot see any other ground in Article 112a EPC that could be even remotely relevant.

5. *Fundamental violation of Article 113 EPC*

5.1 The decision to refuse the petitioner's requests was made by reference to the arguments in the petitioner's grounds of appeal, the opponent's reply and the Board's communication. In the petition it is not suggested otherwise. The petitioner, having originally requested oral proceedings if its requests were not to be granted, later informed the Board that it would not be attending the proceedings. In accordance with Article 15 RPBA, the Board then decided the case in the petitioner's absence, treating the petitioner as relying on its written case. In these circumstances no case that the petitioner's right to be heard under Article 113 EPC was infringed is made out.

5.2 To the extent that the petition could be regarded as raising a complaint under Article 112a(2) (c) EPC, the petition is therefore clearly inadmissible.

6. *Appeal decided without a decision on a relevant request*

6.1 The only requests which the petitioner made in the appeal proceedings were for remittal of the case coupled with reimbursement of the appeal fee on the grounds of a substantial procedural violation, alternatively for maintenance of the patent as granted and finally oral proceedings. The Board held oral

proceedings and in its decision decided to refuse the request for maintenance of the patent and for reimbursement of the appeal fee. The petitioner's request for remittal was only relevant in the event of there having been a substantial procedural violation, which was held not to be the case.

6.2 It is complained that the Board should have realised that the petitioner would have wanted to have the patent maintained at least on the basis of amended claims. However, no corresponding auxiliary request was filed and the Board decided the appeal on the basis of the requests which had been filed.

6.3 To the extent that the petition could be regarded as raising a complaint under Article 112a(2)(d) EPC in combination with Rule 104(b) EPC, the petition is therefore clearly inadmissible.

7. *Other considerations*

7.1 The petitioner's actual complaints are that petitioner had not appreciated that it needed to file amended claims if the patent was to be saved and the Board should have realised this and invited the petitioner to do so.

7.2 The Enlarged Board does not consider that the Technical Board was wrong not to have invited the petitioner to file amended claims, not least because the proceedings were *inter partes* and the Board was correct to remain strictly neutral. Nor does the Enlarged Board consider that the petitioner had any reasonable cause not to have been aware that it needed to file an auxiliary

request if it wanted the patent to be maintained in amended form in the event of its main request not being allowed. The Board in its communication had made clear what were the issues in the appeal and to an extent had expressed a view on them. The petitioner says that it did not appear at the oral proceedings because the opponent had said that it was not intending to appear and because the petitioner agreed with what was said in the communication. But the communication gave no indication that the petitioner's main request was likely to be allowed. To the extent that the communication can be read as indicating what could be considered to be disclosed in the application as filed it was for the petitioner to take this up if it chose to do so, not the Board. The appeal was not, as the petitioner suggests, dismissed because the petitioner had not filed amended requests but because none of the requests which the petitioner had filed were found to be allowable. The Board's statement that the petitioner had "dispensed" with submitting a revised set of claims simply reflects the fact that the petitioner had not done so.

- 7.3 The Enlarged Board does not have to go into these issues further, however, because these complaints do not in any event establish a basis for a petition under any of the grounds in Article 112a EPC.

Order

For these reasons it is unanimously decided that:

The petition is rejected as being clearly unallowable to the extent that it is not clearly inadmissible.

The Registrar:

The Chairman:

W. Crasborn

W. van der Eijk