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**Datasheet for the decision
of the Enlarged Board of Appeal
of 24 February 2015**

Case Number: R 0009/14
Appeal Number: T 2044/09 - 3.3.02
Application Number: 00929313.5
Publication Number: 1183326
IPC: C12M 1/36
Language of the proceedings: EN

Title of invention:

U-shape and/or nozzle-U-loop fermentor and methods of carrying out a fermentation process

Patent Proprietor:

Larsen, Ebbe Busch

Opponent:

NORFERM AS

Headword:

Fundamental violation of Art. 113(1) EPC

Relevant legal provisions:

EPC Art. 4(3), 56, 112a(2)c), (4), 113(1)
EPC R. 104, 106, 126(2)
RPBA Art. 11, 15(4), 20(1), (2)
EHRC Art. 6

Keyword:

Obligation of the Board to give hints regarding the relevant issues in an inter partes case - no"
"Petition for review clearly not allowable"

Decisions cited:

R 0001/08, R 0002/08, R 0011/08, R 0004/09, R 0009/09,
R 0013/09, R 0017/09, R 0018/09, R 0021/09, R 0004/11

Catchword:

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Case Number: R 0009/14

DECISION
of the Enlarged Board of Appeal
of 24 February 2015

Petitioner:
(Patent Proprietor)

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Decision under review:

**Decision of the Technical Board of Appeal
3.3.02 of the European Patent Office of
11 February 2014.**

Composition of the Board:

Chairman: W. van der Eijk
Members: M. Vogel
B. ter Laan

Summary of Facts and Submissions

- I. The respondent (patent proprietor) in case T 2044/09 has filed a petition for review under Article 112a EPC against the decision of the Technical Board of Appeal 3.3.02 dated 11 February 2014 setting aside the contested opposition division's decision and revoking European patent No. 1183326 (entitled "U-shape and/or nozzle-U-loop fermentor and method of carrying out a fermentation process") for lack of inventive step (Article 56 EPC).
- II. The decision was notified in writing on 13 March 2014. It may be summarised as follows: Regarding inventive step, the respondent had argued that the difference between claim 1 and D1 (as closest prior art) resulted in an improved process in terms of reproducibility, yield and process control. However, it had accepted that there were no data in the patent or anywhere else on file to support the alleged effect. So whilst it was conceivable that the sensors improved the process, they might also be merely redundant. In the absence of any data confirming the alleged improvement, the technical problem had to be reformulated into: provision of an alternative U-loop fermentor.

The Board had concluded that the skilled person would arrive at this solution in an obvious way. It had agreed that D1 in combination with any other prior art document did not disclose the invention. But that did not render the claimed subject-matter inventive. In the absence of any proven effect over the prior art, it had to be considered as an arbitrary non-functional modification of that art. Even if there was no pointer

in the prior art towards the addition of a distinguishing feature, if said modification was not linked to a particular functionality then it could not per se constitute the basis for acknowledging an inventive step.

Lastly, the Board had noted that even had the alleged improvement of the process indeed been shown to be an effect of the modification of the closest prior art, if the skilled person expected some advantage from features in a claim and obtained no more than that advantage, then the claimed feature combination was obvious. In the present case, it had not even been confirmed that the advantage possibly expected was actually achieved - let alone unexpectedly.

III. The reasoned petition was filed on 19 May 2014, and the prescribed fee was paid on the same day. The petitioner contended that the appeal proceedings were flawed by a fundamental violation of its right to be heard (Article 112a(2)(c), Article 113 (1) EPC) and by other fundamental procedural defects under the Implementing Regulations.

IV. The petitioner requests that

the decision under review be set aside, the proceedings re-opened, and the board members who participated in the decision replaced;
the fee for petition for review be reimbursed;
oral proceedings be scheduled if the Enlarged Board was not minded to allow the request.

V. The petitioner's submissions can be summarised as follows:

1. The opposition division maintained the patent as granted. The opponent filed an appeal. The Board scheduled oral proceedings without issuing a preliminary opinion. They were held in the absence of the opponent-appellant, who had previously put forward numerous facts and arguments. The chairman opened the oral proceedings with a discussion as to whether the patent complied with Article 56 EPC. He began this discussion by giving the floor to the patentee with just the few words: "Please present your case."

2. However, with 43 documents on file, no opposing party present to elucidate its many written arguments and no indication from the Board as to the grounds or evidence it considered relevant, it was not clear to the petitioner "which arguments to present counter-arguments against". That was in breach of the chairman's obligation under Article 15(4) RPBA to conduct the proceedings fairly and efficiently.

The petitioner was thus forced to present the facts and arguments it thought were of interest to the Board for taking its decision, and began by arguing why D1 (as closest prior art) in combination with D4 would not lead the skilled person to the invention as claimed. The Board did not comment on whether that was an appropriate choice for the closest prior art. It merely asked whether any comparative data were on file to show the alleged technical advantage over the closest prior art. The petitioner answered no, but said that other evidence of a surprising technical advantage was on

file. It pointed out that the technical solution of claim 1 of the main request was in any case an alternative and a non-obvious solution to the teaching of D1, as was shown by the expert opinion in D6. The combination of D1 and D6 was then discussed. After discussing the auxiliary requests, the Board, without giving any reasons, announced its decision to revoke the patent.

3. The reasons subsequently provided in the contested decision were in breach of Articles 11 and 15(4) RPBA and Article 113(1) EPC. In their point 4.3 the Board seemed to be of the opinion that an improved technical effect was likely, but comparative data were required because on the balance of probability it could not be excluded that no improved effect was obtained. However, that issue had never been discussed during the oral proceedings. There was however ample other evidence on file to show that the patent's subject-matter was inventive. The Board's argument was therefore surprising. As the Board had given no indication that it would be taking this surprising position, the petitioner had not had any chance to counter it.

4. As regards the Board's conclusion that, in the absence of any data confirming the alleged improvement, such an effect could not be taken into account in the formulation of the technical problem, there was no case law requiring comparative data for the purposes of Article 56 EPC.

5. In view of the previous instance's decision and the lack of evidence for the Board's argument that the distinguishing features were potentially redundant,

when the Board then took a final decision based on an alleged lack of sufficient evidence for a technical effect it was acting in breach of Articles 11 and 15(4) RPBA and of Article 113(1) EPC. Furthermore, by failing to give reasons for its position that evidence in the form of comparative data was a requirement for acknowledging inventive step, it was also in breach of Article 20(1) and (2) RPBA.

6. In addition, the Board had infringed the petitioner's right to be heard by not providing any guidance on the matters it considered relevant for its decision on inventive step. Contrary to the requirements of fair proceedings, it had avoided any discussion of what it considered to be the decisive issue, i.e. the alleged technical effect. By focusing on other matters on file, it had misled the petitioner into believing that the decisive issue was its question about whether the skilled person, if he combined D1 and D4, would arrive at the claimed invention. To then take a decision based on a lack of comparative data, having made no prior enquiries or given any indication of their importance, was in breach of Article 4(3) as well as Article 113(1) EPC.

7. The appellant-opponent had never argued that the ion sensors in the fermentation liquid had no technical effect, for the reason that this was obviously incorrect. This argument had been produced by the Board; it appeared nowhere in the file, only in the written decision. Whereas the skilled person knew that sensors were indeed necessary it could be concluded that they improved process control. The petitioner had never had an opportunity to comment on the improvements

provided by the claimed subject-matter, making it clear that the Board was mistaken, and thereby to overcome the procedural defect - which was thus causal for the final decision.

VI. In an annex to the summons to oral proceedings the Enlarged Board expressed its provisional view of the petition. It had doubts as to whether the grounds based on infringement of the RPBA were admissible, whether the alleged procedural aspects were causal for the decision, and whether the technical Board, given its duty to show neutrality in inter partes proceedings, could have been expected to provide the petitioner with any detailed guidance about which aspects of the case were to be discussed.

VII. In its written answer dated 18 December 2014 and during the oral proceedings the petitioner reiterated the arguments it had submitted in the written proceedings, and expressed its view that the technical Board had not wanted to clarify the correct factual background for deciding the case or to engage in any discussion of the evidence on file showing the presence of a technical effect, apart from seeking the petitioner's acknowledgement that there were no data on file comparing the invention with the closest prior art. Nor had the technical Board accepted the petitioner's arguments and evidence that a prejudice in the prior art meant that the skilled person would not have expected the invention to give rise to a technical advantage.

Reasons for the decision

1. Admissibility

1.1 The present petition was received at the EPO on 19 May 2014, i.e. within two months as from notification of the decision for which review is requested. At the same time, the petitioner paid the prescribed fee and provided the information required under Rule 107 EPC. Its petition for review therefore fulfils the various formal requirements (Article 112a(4), second sentence, and Rule 126(2) EPC).

1.2 The possible grounds for a petition for review are listed exhaustively in Article 112a(2)(a) to (e) and Rule 104 EPC. The present petition cites the ground under Article 112a(2)(c) EPC, namely a fundamental violation of the right to be heard under Article 113(1) EPC. It is inadmissible as regards alleged breaches of Article 4 (3)EPC as well as Articles 11, 15(4) and 20 RPBA and other provisions not covered by Article 112a EPC.

1.3 For a petition under Article 112a(2)(a) to (d) EPC to be admissible, it is also necessary that the alleged procedural defect was objected to, without success, during the appeal proceedings, unless the objection could not be raised in those proceedings (Rule 106 EPC). The petitioner did not raise such an objection.

1.3.1 The petitioner submits that it did not become aware of the procedural defects now objected to until it read the decision, so that it could not have raised its objection during the appeal proceedings. It was

able to do so only in the present petition, once it was aware of the reasons for the decision.

1.3.2 The Enlarged Board understands the various objections of the petitioner to be expressions of one central issue: namely that the Board by not indicating to the petitioner that it considered the absence of comparative data to be an essential problem for upholding the contested claim, deprived the petitioner of the opportunity to comment on this issue. The Enlarged Board is satisfied that, as the petitioner became aware of the reasoning of the board only after reading the decision, it was not able to make an objection during the appeal proceedings. Therefore the Enlarged Board finds that the petition in this central issue is not clearly inadmissible.

1.4 The only issue in the present petition for review under Article 112a(2)(c) EPC is thus whether the Board deprived the petitioner of its right to be heard under Article 113(1) EPC by basing its written decision on reasons which the petitioner had not been able to comment on during the proceedings.

2. Merits

2.1 It is undisputed that after opening the oral proceedings the chairman of the technical Board asked the petitioner (saying "Please present your case") to provide a full explanation of why it thought its patent should be maintained, notwithstanding the appellant's arguments, and the appeal therefore dismissed. The petitioner submits that the chairman should have given it more specific procedural guidance about the aspects it needed to focus on. The Enlarged Board would comment on that as follows.

2.1.1 It is established board of appeal case law that inventive step is to be examined using the problem-solution approach. That means first determining the closest prior art. Then the technical problem vis-à-vis the closest prior art that has been effectively solved is determined. If it is established that the claimed subject-matter has a technical effect or improvement compared with the closest prior art - which is usually shown by means of comparative tests - the problem solved may be formulated in terms of the effect/improvement. If no effect is identifiable, the problem solved may be formulated in terms of an alternative to the closest prior art. Finally, it is examined whether the technical features claimed, which achieve the results, i.e. solve the technical problem, are an obvious solution given the information contained in the prior art.

2.1.2 The petitioner had appointed a qualified professional representative who the technical Board

was entitled to assume was familiar with the above analytical sequence and would present his client's case on that basis and in the light of the arguments put forward by the opposing party during the written proceedings. So no special guidance from the Board was necessary. Nor, given the Board's duty to remain neutral, would it have been appropriate.

2.2 Furthermore, in petition proceedings under Article 112a EPC the Enlarged Board has always held (since R 1/08 of 15 July 2008) that the parties' right to be heard under Article 113(1) EPC does not mean that Boards have to tell them about every conceivable reason for the decision. So in oral proceedings a Board is under no obligation to address all the factors that feature in its subsequent decision and to discuss them in detail with the parties. It suffices that their relevance at least becomes clear during the proceedings and that the parties can be assumed to know enough about technical and legal matters to be aware of their significance.

2.2.1 So the petitioner's right to be heard would have been infringed only if the Board had failed to give it an adequate opportunity during the appeal proceedings to comment - not on every aspect but at least on those of relevance for the decision. What is relevant, however, is up to the party itself to decide, on the basis of its knowledge of the file and the professional expertise it can be assumed to possess. The party must then play an active role in the proceedings and, on its own initiative, present arguments that support its position (R 2/08).

- 2.2.2 If a party to proceedings has a suitably qualified legal representative, the latter must present his case as he thinks best - and without support from the Board, which has to remain impartial (R 11/08, R 18/09 and R 21/09). A professional representative in oral proceedings cannot rely on the Board to warn, guide or otherwise help him in making his case (R 4/09, R 17/09). In inter partes cases in particular, courts have to be neutral. That means they must refrain from comments or guidance that might be helpful to a particular party - especially when, as in this case, the opposing party is not present.
- 2.3 A further point is that the Enlarged Board's powers of review do not extend to issues of whether the Technical Board applied the substantive law correctly (R 2/08, R 9/09, R 13/09 and R 4/11); it cannot replace that Board's substantive assessment with its own. Petition proceedings are limited to correcting, as an exceptional measure, final-instance decisions that have fundamental procedural defects and therefore should not be allowed to stand. Article 112a EPC thus expands on the right to a fair trial guaranteed by Article 6 EHRC.
- 2.4 Applying the above principles, developed by the Enlarged Board when considering alleged breaches of the right to be heard, the present petition is to be rejected as clearly unallowable. The petitioner is mistaken in believing that the deciding Board committed a serious procedural violation by not informing it of the correct sequence to be followed in the problem-solution approach and by the way it applied the substantive law.

2.4.1 The petitioner argues that the Board did not address its submissions about the invention's obviousness having regard to the combination of D1 and D4, and instead asked whether comparative experiments were available. The Enlarged Board regards this argument as a clear misunderstanding of the problem-solution approach. The first step of that approach is to identify the closest prior art and then the problem solved by the invention vis-à-vis that art, in the present case D1. This is normally done by presenting results of comparative tests showing that the invention has a technical effect or improvement. Only then will the Board consider obviousness, e.g. in the present case by combining documents D1 and D4. If no technical effect can be shown, the question is whether an inventive alternative to the closest prior art has been produced or the alternative is obvious.

So in the present case the combination of D1 and D4 was not to be discussed until the problem to be solved had been identified. There was no reason to take any other course of action. The petitioner's written and oral submissions have not shown why the Board should have departed from the standard sequence when applying the problem-solution approach.

2.4.2 However, in fact the Board did give the petitioner the possibility to comment on the claimed subject-matter's obviousness in terms of D1 and D4. The petitioner does not dispute that. It clearly saw the matter differently from the Board, but that is a matter of substance and therefore not an issue

for the Enlarged Board to decide in the present proceedings.

- 2.4.3 The same goes for the petitioner's objection that the comparative data's importance in the contested decision took it by surprise. That issue too was addressed in the oral proceedings. But the petitioner was unable to submit comparative tests vis-à-vis the closest prior art when asked by the chairman. And as patent proprietor, the petitioner - not the Board, as it seems to think - bore the burden of proof. Although the petitioner appears to be believe otherwise, the submission of comparative-test results to prove an effect or improvement is part of the problem-solution approach when establishing the problem over the closest prior art that is effectively solved by the claimed subject-matter. The petitioner's specialist knowledge of patent law should have told it that. There can thus be no question of a "surprise" together with infringement of the right to be heard. The petitioner was obliged to admit in the oral proceedings that no comparative tests vis-à-vis the closest prior art existed. Its argument that the documents on file otherwise contained evidence for an effect failed to convince the Board. Whether the Board was right to take that line is a matter of substantive law and as such not within the Enlarged Board's powers of review.

- 2.5 Consequently, in so far as the petition alleges a breach of the right to be heard, it is to be rejected as clearly unallowable.

Order

For these reasons it is decided as follows:

The petition for review is unanimously rejected as being clearly unallowable.

The Registrar:

The Chairman:

P. Martorana

W. van der Eijk