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**Datasheet for the decision
of the Enlarged Board of Appeal
of 21 October 2016**

Case Number: R 0016/14
Appeal Number: T 2122/12 - 3.2.05
Application Number: 06116943.9
Publication Number: 1747890
IPC: B41J2/175
Language of the proceedings: EN

Title of invention:

Method of determining the droplet size of ink droplets released by an ink jet printer

Applicant:

Océ-Technologies B.V.

Headword:

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Relevant legal provisions:

EPC Art. 112a(2)(c), 112a(2)(d), 112a(5)
EPC R. 104(b), 108(3)

Keyword:

"Petition for review only against an independent part of the decision under review (yes)"
"Objection raised after decision was given - Rule 106 EPC complied with (yes) - objection could not be raised earlier"
"Petition for review - admissible (yes)"
"Petition for review - allowable (no) - fundamental violation of Article 113 EPC (no) - failure to decide on relevant request (no)"

Decisions cited:

R 0003/10, R 0019/12, R 0008/15, J 0027/86, T 0740/93,
T 1557/07

Catchword:

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Case Number: R 0016/14

DECISION
of the Enlarged Board of Appeal
of 21 October 2016

Petitioner: Océ-Technologies B.V.
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Decision under review: **Decision of the Technical Board of Appeal
3.2.05 of the European Patent Office of
2 June 2014.**

Composition of the Board:

Chairman: W. van der Eijk
Members: F. Blumer
G. Ashley
G. Weiss
B. Müller

Summary of Facts and Submissions

- I. The petition for review concerns the ex-parte decision T 2122/12 of 2 June 2014 of Board of Appeal 3.2.05 (notified on 2 October 2014). The Board decided that a second auxiliary request was allowable, and the case was remitted to the examining division with the order to grant a patent on this basis. The then pending main request and the first auxiliary request were held not to be allowable since the subject-matter of claim 9 of the main request and claim 2 of the first auxiliary request did not involve an inventive step. On 9 September 2015, European patent no. 1 747 890 was granted on the basis of said allowable second auxiliary request.
- II. In the statement setting out the grounds of appeal, the appellant-petitioner submitted that various procedural violations had occurred in the examination proceedings and requested that the appeal fee be reimbursed. In particular, the appellant-petitioner argued that the examining division had not provided sufficient factual and legal reasoning (par. 3.3.1) and that the examining division had not commented on submitted arguments and had not considered submitted arguments (par. 3.3.2, 3.3.3). Finally, the appellant-petitioner argued that the appealed decision of the examining division was unclear with respect to the grounds of refusal since not all of the communications referred to in the decision referred to the same grounds of refusal. (The decision of the examining division consisted merely of a reference to three communications after the appellant-petitioner had requested "a decision based on

the file as it stands" in its letter of 26 January 2010.)

- III. In its communication accompanying the summons to oral proceedings sent on 14 March 2014, the Board addressed the above-mentioned alleged procedural violations individually (points 12.1 to 12.4). The Board came to the preliminary conclusion that no substantial procedural violation had taken place and that the request for reimbursement of the appeal fee was likely to be refused (point 12.5).
- IV. In its reply letter dated 1 May 2014, the petitioner addressed in detail all issues dealt with in the preliminary opinion of the Board of Appeal. Three conditional requests for referrals of questions to the Enlarged Board of Appeal were made, each based on a different condition and containing a set of questions. The conditions related to the Board's position on (i) the nature of a substantial procedural violation, (ii) the burden of proof in connection with the consideration of arguments and (iii) the possibility of the examining division of ignoring any arguments of the applicant.
- V. Oral proceedings before the Board of Appeal took place on 2 June 2014. The request for reimbursement of the appeal fee was discussed and refused.
- VI. The petition was filed on 10 November 2014, and the corresponding fee was paid on 11 November 2014. Oral proceedings were requested as a precaution in a separate letter filed on 13 November 2014. The petitioner requested

- 1) that the decision under review be set aside and the proceedings before the Board of Appeal be reopened;
- 2) that the Board of Appeal be ordered to put a question to the Enlarged Board of Appeal "in case the Board of Appeal intends to maintain the position that an examining division has the option to ignore any arguments advanced by an applicant"; and
- 3) that the members of the Board of Appeal be replaced if the Enlarged Board of Appeal did not intend to order the requested conditional referral to the Enlarged Board of Appeal.

VII. The petition was based on Article 112a(2)(d) in connection with Rule 104(b) EPC (failure to decide on a request relevant to the decision) and on Article 112a(2)(c) EPC (fundamental violation of Article 113 EPC). The petitioner's main argument was that its conditional procedural requests were "circumvented" in the oral proceedings before the Board of Appeal, and that the written reasons relied on an opinion of the Board of Appeal that should have led to a referral to the Enlarged Board of Appeal. This conduct of the appeal proceedings meant that the Board decided on the appeal without deciding on a request relevant to that decision and that the Board of Appeal prevented the petitioner from explaining and discussing at the oral proceedings in detail (I) the issue of the right to be heard in examination proceedings and (II) the relevance of the related questions for the Enlarged Board, thereby denying the right to be heard (page 4, first paragraph, of the petition).

- VIII. Oral proceedings in the three-member composition of the Enlarged Board were held on 4 July 2016. The requests 2) and 3) (see above under VI) were withdrawn during these oral proceedings. At the end of these oral proceedings, the Chairman announced the decision that the petition for review was submitted to the Enlarged Board of Appeal as composed under Rule 109(2)(b) EPC for decision.
- IX. The present five-member composition of the Enlarged Board was determined and the petitioner was summoned to new oral proceedings.
- X. Oral proceedings in the five-member composition of the Enlarged Board were held on 21 October 2016. During these oral proceedings, the petitioner confirmed its request, namely that the decision under review be set aside and the proceedings before the Board of Appeal 3.2.05 be reopened. The petitioner confirmed that the alleged procedural violations solely concerned the request for reimbursement of the appeal fee and the conditional requests for referrals to the Enlarged Board of Appeal related thereto. At the end of these oral proceedings, the decision of the Enlarged Board of Appeal was announced.
- XI. Taking into account the submissions made during the oral proceedings of 4 July 2016 and of 21 October 2016, the petitioner's lines of argument can be summarised as follows:
- The conditional requests filed in the appeal proceedings by letter of 1 May 2014 to refer certain questions to the Enlarged Board of Appeal

(in particular, the question whether an examining division may ignore an applicant's argument made in response to an outstanding objection; see item (iii) at point IV above) were not discussed during oral proceedings before the Board. The letter was only briefly discussed before the Chairman said that he was "putting the letter aside". The board prevented the petitioner from explaining and discussing at the oral proceedings in detail (I) the issue of the right to be heard in examination proceedings and (II) the relevance of the related questions for the Enlarged Board (see the first paragraph of page 4 of the petition). The petitioner had to conclude from this that the Board did not consider the conditional requests for referrals to be relevant any more. The conditional requests for referral were never withdrawn. The fact that they had not been addressed by the petitioner during oral proceedings could not be interpreted as a withdrawal. No formal decision was taken on these requests.

- The Board apparently based its written decision on the assumption that an examining division has the possibility of ignoring arguments of the applicant in a communication that is meant to respond to such arguments. Since such a position of the Board of Appeal was the condition for one of the conditional requests for a referral to the Enlarged Board (see above item (iii) at point IV), this conditional request for a referral was still relevant and should have been discussed during oral proceedings before the Board of Appeal. The petitioner was prevented from explaining and discussing at the

oral proceedings in detail (I) the issue of the right to be heard in examination proceedings and (II) the relevance of the related questions for the Enlarged Board. The petitioner had a legitimate expectation that the Board would indicate if it was considering maintaining its position concerning the points underlying one of the conditional requests for a referral (i.e., the position that the examining division could ignore arguments of the applicant).

- The decision under review did not provide sufficient reasons to allow the petitioner to understand why the Board had come to its conclusion (i.e., that there was no substantial procedural violation in the first instance proceedings). Not providing any arguments in the decision on the appellant's arguments concerning the first instance proceedings and the conditional request for referral constituted a violation of the right to be heard. Point 4 of the decision under review referred to the low "complexity" of the claimed subject-matter and to certain misunderstandings. Misunderstandings should have been avoided; they may have been one reason for the procedural violations. The "complexity" had never been discussed and appeared only in the written decision. Furthermore, "complexity" was not an argument in the context of the right to be heard.
- The request for reimbursement of the appeal fee was not really discussed during oral proceedings before the Board. The petitioner could present its arguments but was asked not to repeat its written

statements. The Board did not give any comment on these arguments.

Reasons for the Decision

1. The petitioner's objections
 - 1.1 The petitioner's objections are, on the one hand, based on Article 112a(2)(d) in connection with Rule 104(b) EPC (decision on the appeal without deciding on a request relevant to that decision). On the other hand, they concern an alleged fundamental violation of Article 113(1) EPC (right to be heard) committed by the Board of Appeal (Article 112a(2)(c) EPC). This is because the board had allegedly prevented the petitioner from explaining and discussing at the oral proceedings in detail (I) the issue of the right to be heard in examination proceedings and (II) the relevance of the related questions for the Enlarged Board (see the first paragraph of page 4 of the petition). Furthermore, not providing any arguments in the decision on the appellant's arguments concerning the first instance proceedings and the conditional request for referral constituted a violation of the right to be heard.
 - 1.2 Since the request for reimbursement of the appeal fee itself clearly led to a decision (point 3 of the order as announced in the oral proceedings and in the written decision), the only request that should have led but did not lead to a decision in the petitioner's view is the conditional request for referral to the Enlarged Board of Appeal concerning the possibility of the examining division to ignore any arguments of the

applicant (labelled condition (iii) above, at point IV). The question whether there should have been a decision on that conditional request is closely related to the right to be heard in connection with the discussion of that request and the relevance of the corresponding question to be referred under that request for the decision under review.

1.3 The question whether the conditional requests for referrals were sufficiently discussed and whether there should have been a decision on them can furthermore not be easily separated from the general issue of the right to be heard in examination proceedings. The petitioner's allegations that the examining division's reasoning was insufficient underlie both the objections (I) against the discussion of the right to be heard in the first instance proceedings and (II) against the discussion of the relevance of the referral question (iii) as well as the lack of a decision on the referral requests. It is recalled that referral question (iii) concerns the possibility of the examining division to ignore any arguments of the applicant.

1.4 The petitioner's position can be summarised as follows: The Board of Appeal should have given the petitioner the opportunity to discuss the right to be heard in examination proceedings. This would have enabled the petitioner to try to convince the Board that the examining division was not entitled to ignore arguments of the applicant. In the alternative, if the Board remained still unconvinced, the petitioner should have been allowed to try to convince the Board that the condition for conditional request (iii) was met and thereafter explain that request. Finally, it would have been for the Board to decide on that request.

2. Admissibility of the petition

2.1 The decision under review was posted to the petitioner on 2 October 2014. The petition was filed on 10 November 2014 and the corresponding fee was paid on 11 November 2014. The petition was thus filed and the prescribed fee was paid within the applicable two month time limit under Article 112a(4) EPC. The formal requirements of Rule 107 EPC were complied with and the petition was sufficiently reasoned.

2.2 The decision under review set aside the examining division's decision to refuse the application and it ordered the grant of a patent on the basis of the then pending second auxiliary request (points 1 and 2 of the order). Since the petitioner has not argued that any of the alleged procedural violations affected any requests made in the appeal proceedings other than the request for reimbursement of the appeal fee, the petitioner's request that the decision under review be set aside is understood by the Enlarged Board as a request to set aside only point 3 of the order concerning the reimbursement of the appeal fee (see point 6 of the Enlarged Board's communication of 22 April 2016 and point X above).

2.3 As far as said point 3 of the order is concerned, the petitioner is adversely affected by the decision under review (Article 112a(1) EPC). Even though the possibility of partially setting aside a decision and of filing corresponding requests is not foreseen in Article 112a(5) and Rule 108(3) EPC, the present request for partially setting aside the appeal decision is admissible since it is clear which part of the

decision is to be set aside (see R 19/12 of 12 April 2016, point 4; see also J 27/86 of 13 October 1987 where only a part of the examining division's decision was set aside).

2.4 The Enlarged Board agrees with the petitioner in that an objection under Rule 106 EPC could not have been raised during the appeal proceedings. While the petitioner could assume at the end of the oral proceedings that the conditional requests for a remittal to the Enlarged Board of Appeal were not relevant any more (page 2 of the petition, fourth paragraph from the bottom), only the written decision gave rise to the second objection underlying the petition for review.

2.5 The petition is therefore in compliance with Rules 106 and 107 EPC and admissible.

3. Allowability of the petition

3.1 The petitioner claimed that it was prevented from explaining and discussing at the oral proceedings in detail the issue of the right to be heard in examination proceedings (I, see above point VII) and the relevance of the related questions for the Enlarged Board embodied in three conditional requests made in its letter of 1 May 2014 (II, see above point VII). While the petitioner assumed at the end of the oral proceedings that none of the conditional requests for referrals to the Enlarged Board of Appeal were still relevant, it concludes from the written decision that the Board of Appeal was of the opinion that an examining division has the possibility of ignoring any arguments of the applicant in a communication

responding to such arguments. Since such a position of the Board of Appeal was the condition for one of the conditional requests for a referral to the Enlarged Board of Appeal (i.e. conditional request (iii) mentioned above, at point IV), this conditional request for a referral was still relevant and had never been withdrawn. Under these circumstances, the petitioner was prevented from explaining and discussing the related questions for the Enlarged Board. Apart from that, the decision on the appeal was adopted without deciding on a request relevant to that decision. This latter objection will be addressed first.

3.2 First objection: failure to decide on a request relevant to the decision (Article 112a(2)(d) in connection with Rule 104(b) EPC)

3.2.1 From the petitioner's statements in its written submissions and during both oral proceedings before the Enlarged Board of Appeal, the Enlarged Board takes that the petitioner, on the basis of what had been discussed at the oral proceedings in the appeal proceedings, assumed that there was no need any more to consider the procedural requests (page 3 of the petition, second paragraph). The petitioner had to conclude that the Board did not consider the conditional requests for referrals to be relevant any more, and, consequently, the petitioner did not expect a decision on these requests and had no reason to insist on such decision by raising an objection under Rule 106 EPC (see above point 2.4 in the context of the admissibility of the petition). It was only the written reasons that according to the petitioner let the conditional request (iii) again appear to have been relevant.

3.2.2 In the reasons of the decision under review, when addressing the alleged violations of the right to be heard, the Board of Appeal explained why in its view the examining division did not commit a substantial procedural violation within the meaning of Rule 103(1)(a) EPC. The Board of Appeal viewed the subject-matter of the claims as not particularly complex since the invention only involved measuring three parameters and calculating an average and the cited passages of the prior art were not extensive (Reasons point 4 of the decision under review). From this, it follows that the Board of Appeal viewed it as appropriate for the examining division in the particular case in question not to indicate in detail which features of the independent claims were disclosed in which passages of the prior art documents and not to address all arguments advanced on behalf of the applicant for the claimed subject-matter. It is not within the scope of the review proceedings to assess the correctness of these findings, as these relate purely to the assessment of the facts of the case by the Board of Appeal which is not the subject of review proceedings.

3.2.3 From the reasons given in the decision under review, the petitioner concluded that the Board of Appeal was of the opinion that an examining division may ignore submissions of an applicant (page 3 of the petition, third and fourth paragraph from the bottom). The Enlarged Board cannot agree to this conclusion, which the petitioner drew from its account of point 4 of the decision under review. In the view of the Enlarged Board, point 4 is to be interpreted in the sense that the Board of Appeal was of the opinion that in less

complex cases there was less need to address each and every argument presented by the parties. Such opinion is in line with the case law regarding the duty of a first-instance department to state reasons which clarified that the deciding organ is not obliged to address every single argument as long as the parties are enabled to understand whether the decision was justified or not (see, e.g. T 1557/07 of 9 July 2008, point 2.6). Decision T 740/93 of 10 January 1996, on which the petitioner relied, also stated that not all the arguments submitted should be dealt with in detail in a decision (point 5.4). Not explicitly addressing specific points which, in the deciding organ's view, do not have to be addressed in order to arrive at an understandable decision does not mean that such points are "ignored". The Enlarged Board does not see how the passages in point 4 of the decision under review may be read onto the condition used for its conditional request for referral in the petitioner's letter of 1 May 2014 ("If the Board actually believes and maintains the position *that the Examining Division has the possibility to ignore any arguments of the applicant in a Communication responsive to such arguments*, the Board is requested...", quoted on page 2 of the petition, second paragraph, emphasis added by the Enlarged Board). Nor has the Enlarged Board found any other indication according to which the Board of Appeal would have acknowledged a right of the first instance to "ignore" certain arguments.

- 3.2.4 Since the condition underlying the conditional request (iii) (namely, that the Board of Appeal took the position that an examining division had the option to ignore arguments advanced by an applicant) was not

met, the petitioner's allegation that conditional request (iii) had become relevant again for the written reasons of the decision under review and should have been decided upon does not hold. As a consequence, the claim of infringement of Rule 104(b) EPC must be dismissed.

3.3 Second objection: fundamental violation of Article 113(1) EPC (Article 112a(2)(c) EPC)

3.3.1 From the petitioner's summary of facts, the Enlarged Board takes that the alleged denial of the right to be heard in the examination proceedings was discussed extensively during oral proceedings before the Board of Appeal. The petitioner had the possibility to explain further all of its arguments relating to the alleged substantial procedural violation in the first instance proceedings, including its conditional request for a referral to the Enlarged Board of Appeal (page 2 of the petition, fourth paragraph from the bottom). However, as the petitioner confirmed during the second oral proceedings before the Enlarged Board, it did not specifically address the conditional requests during oral proceedings before the Board of Appeal. According to the petitioner, the Board of Appeal, in response to its arguments, did not express any opinion or provide any arguments except for a statement that the Board of Appeal believed the examining division had done enough (page 2 of the petition, fourth and third paragraph from the bottom).

3.3.2 Even though the conditional requests had not been explicitly referred to during the oral proceedings before the Board of Appeal (see above point 3.3.1), the

Enlarged Board takes from the petitioner's account of the oral proceedings that the petitioner's arguments concerning the alleged procedural violations as presented in the letter of 1 May 2014 were discussed. The chairman of the Board of Appeal referred to the petitioner's letter of 1 May 2014 ("written response of the Appellant") and to the petitioner's arguments therein (page 2 of the petition, fifth paragraph from the bottom). At the end of the oral proceedings, the petitioner had "no reason to assume that any of the conditional requests in the written response were still relevant" (page 2 of the petition, fourth paragraph from the bottom). The chairman of the Board of Appeal indicated that the content of the letter was no longer relevant and eventually "the letter was put aside" (page 2 of the petition, fifth paragraph from the bottom).

3.3.3 In the light of the foregoing, the Enlarged Board cannot identify a violation of the right to be heard on the basis of the conduct of the oral proceedings before the Board of Appeal.

3.3.4 Furthermore, it also follows from the contents of the decision under review, especially its point 4, that the question of whether there was a substantial procedural violation in the first-instance proceedings was substantively addressed by the Board of Appeal in the decision, as both required and also found sufficient by the case law (see R 8/15 of 18 July 2016, catchword 1). For these reasons, the petitioner's allegations that insufficient reasons given for the decision under review constitute a violation of the right to be heard cannot be accepted.

3.4 In the context of its assertion that only the written decision revealed that certain arguments had not been sufficiently discussed and a related request had not been decided upon, the petitioner relied, *inter alia*, on decision R 3/10 of 29 September 2011 which led to the re-opening of the proceedings before the Board of Appeal. In R 3/10, the petitioner's main request was not allowed for lack of inventive step while at the oral proceedings only novelty objections had been discussed. It was clearly derivable from the written decision (and already from the announcement during oral proceedings) on which argument (i.e., obviousness) that had not been discussed at oral proceedings the decision was based. In contrast, the arguments which in the view of the petitioner should have led to further discussions and a decision on conditional request (iii) were turning on an undisclosed opinion the Board of Appeal allegedly had (i.e., that an examining division could ignore arguments raised by the applicant). As explained above (point 3.2.3), it cannot be derived from the decision or any other behaviour of the Board of Appeal that the Board had such opinion.

3.5 In conclusion, the Enlarged Board finds neither of the petitioner's objections (failure to decide on a request and violation of the right to be heard) to be well-founded and, as a consequence, cannot allow the petition.

Order

For these reasons it is decided that:

The petition for review is rejected as being unallowable.

The Registrar

The Chairman

P. Martorana

W. van der Eijk