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**Datasheet for the decision
of 4 March 2019**

Case Number: R 0005/17

Appeal Number: T 0692/12 - 3.2.01

Application Number: 03763963.0

Publication Number: 1532065

IPC: B66F17/00, B66F9/065

Language of the proceedings: EN

Title of invention:
CONTROL SYSTEM FOR A LOAD HANDLING APPARATUS

Patent Proprietor:
J.C. BAMFORD EXCAVATORS LIMITED

Opponent:
MANITOU BF

Headword:

Relevant legal provisions:
EPC Art. 112a(2)(c), 112a(2)(d), 113(1)
EPC R. 104(b), 106

Keyword:

Obligation to raise objections - objections raised (no)
Violation of the right to be heard (no)
Petition for review - inadmissible

Decisions cited:

R 0003/10, R 0014/10, R 0017/11, R 0021/11

Catchword:



Große Beschwerdekammer
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Case Number: R 0005/17

D E C I S I O N
of the Enlarged Board of Appeal
of 4 March 2019

Petitioner:

(Opponent)

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Decision under review:

**Decision of the Technical Board of Appeal 3.2.01
of the European Patent Office of 30 March 2017.**

Composition of the Board:

Chairman

F. Blumer

Members:

W. Van der Eijk

E. Bendl

I. Beckedorf

G. Weiss

Summary of Facts and Submissions

- I. The petition for review concerns decision T- 0692/12 of 30 March 2017 of Board 3.2.01, setting aside the decision of the opposition division to reject the opposition against European patent No. 1532065 and ordering the maintenance of the patent in amended form.
- II. The petitioner (opponent) alleges that two procedural violations have taken place during the appeal proceedings:
1. failure to decide on the request by the petitioner to admit document D19, which was relevant in the sense that it could have led to the conclusion that auxiliary request 4 did not involve an inventive step, into the proceedings and thus to decide on the appeal without deciding on a request relevant to that decision (Article 112a(2)(d) in connection with Rule 104(b) EPC;
 2. violation of the petitioner's right to be heard by deciding on the appeal without hearing the petitioner's arguments concerning lack of inventive step starting from D19 (Article 112a(2)(c) and 113(1) EPC).
- III. The case as presented by the petitioner in the original petition and its subsequent letters can be summarized as follows:
- Following the Board's preliminary opinion communicated in preparation of oral proceedings, the petitioner submitted with letter of 17 February 2017 a certain amount of prior art, including document D19, which it argued was highly relevant for assessing novelty of claim 1 and for inventive step of claims 7 and 8 of the main

request on file. The request to admit these documents was restated in letters of 24 February and 3 March 2017.

- During oral proceedings on 30 March 2017 the request to admit D19 was restated. Novelty of claim 1 of the main request was however only discussed in light of D1/D2 and D5. On the basis of these documents the Board concluded that claim 1 of the main request lacked novelty, as can be seen from the minutes of the oral proceedings and the written decision. The petitioner inferred from this course of events that, although the Board had not reacted explicitly to the request to admit D19, it had been implicitly refused, as being not more relevant than D1/D2 and D5.
- The discussion then moved on to the auxiliary requests. The patentee withdrew auxiliary requests 1-3. The admission into the proceedings of auxiliary request 4, which was late filed, was discussed.
- Following a deliberation, the Board decided to admit this request into the proceedings. The petitioner then asked again to be allowed to introduce D19 into the proceedings. The chairman replied that the admission of auxiliary request 4 "n'entraîne pas l'admission des nouveaux documents" (petition p.5,§12). The petitioner drew the following conclusion from this statement: "Manitou comprend donc que la CR maintient son refus d'admettre D19 et qu'elle devra attendre de lire la Décision pour connaître les motifs de ce rejet" (petition p.5,§12).

- On the basis of this understanding the petitioner did not argue on the basis of D19 but limited itself to argue lack of inventive step on the basis of other documents that were already in the proceedings.
- At the end of the debate the Board reached the conclusion that auxiliary request 4 involved an inventive step and that the patent could be maintained on the basis of this request.
- The written decision did not mention document D19 at all, nor was it mentioned that its admission into the proceedings had been requested and that this request had been refused. It was only then that the petitioner realised that the Board's understanding of the situation was that it had not decided on the request to admit D19.
- This failure to decide was however a violation of Article 112a(2)(d) in combination with Rule 104(b) EPC. Furthermore, the course of the oral proceedings and the reaction of the chairman on its repeated requests to admit D19 gave the petitioner ground to believe its request was implicitly refused. On the basis of this belief the petitioner made no submissions on inventive step starting from D19 when discussing auxiliary request 4. It was thus deprived from an opportunity to present that line of argumentation by the inadequate reactions of the chairman to its requests.
- For this reason it was also not possible to formulate an objection under Rule 106 EPC during the oral proceedings, as the petitioner only found out when reading the written decision that the

Board had not decided on its repeated requests to admit D19 and the procedural violations thus only became apparent after the oral proceedings were finished.

The petitioner concluded that the petition was both admissible and allowable.

- IV. The Enlarged Board in its composition according to Rule 109(2)(a) EPC issued on 20 March 2018, together with the summons to oral proceedings, a communication in which it expressed its preliminary view that the petition was clearly inadmissible.
- V. The petitioner filed on 4 April 2018 a request for correction of the minutes of the oral proceedings before Board 3.2.01, requesting that it be mentioned in the minutes of the discussion of both the main request and auxiliary request 4 that the appellant requested admission of late filed document D19 in the proceedings and that on both occasions this request was not accepted by the Board. This request was refused by the Board in its communication dated 12 April 2018 as the requested corrections did not reflect the actual course of the oral proceedings according to the recollection of the Board members.
- VI. The petitioner reacted to the communication of the Enlarged Board in a letter dated 6 April 2018.
- VII. On 11 April 2018 oral proceedings took place at the end of which the Enlarged Board gave the interlocutory decision to submit the petition to the Enlarged Board as composed under Rule 109(2)(b) EPC. In a letter of 6 July 2018 the patent proprietor as the other party to

the proceedings, presented its comments on the petition and the subsequently filed documents.

VIII. The position of the patent proprietor can be summarized as follows:

The alleged violation of a failure to decide on the request to admit D19 can only be relevant in the context of the discussion of auxiliary request 4. Novelty of the main request was denied on the basis of other documents that were already in the proceedings and therefore there was no need to decide on the admission of D19 in that context. The admission of D19 was raised by the petitioner during the discussion on the admissibility of auxiliary request 4. The Board did not refuse the request during that discussion, but only indicated that the admission of auxiliary request 4 did not imply the admission of D19. During the substantive discussion of inventive step of auxiliary request 4 the petitioner had many opportunities to argue on the basis of D19. It chose however not to do so. Also when the chairman at the end of the proceedings asked the parties whether they had any further comments or request before closing the debate, the petitioner remained silent. The argument by the petitioner that it was led to believe by the chairman that its request was refused, cannot be a reason to conclude that its right to be heard was violated. The petitioner chose, without asking for clarification, to base its strategy during the oral proceedings on an assumed implicit refusal. Only the petitioner is responsible for this choice and cannot, when later on it becomes clear that its assumption was wrong, request the reopening of the proceedings. Anyway, the petitioner should have made an objection during the oral proceeding that no clear decision on its request was taken and that this was a

procedural violation. For that reason the petition is not only unallowable but also inadmissible.

- IX. The respective positions of the petitioner and the other party were further developed in subsequent letters and documents and during the oral proceedings before the Enlarged Board on 4 March 2019.
- X. The petitioner requests that the decision under review be set aside and the proceedings before Board 3.2.01 be re-opened and that the fee for the petition for review be reimbursed.
- XI. The patentee requests that the petition for review be rejected as both inadmissible and unallowable.

Reasons for the Decision

- 1. Admissibility
 - 1.1 The petition fulfils the formal requirements for admissibility. The time limits for filing and paying the relevant fee were respected and the requirements of Rule 107(1) and (2) EPC were complied with. The petitioner was adversely affected by the decision.
 - 1.2 It remains to be assessed whether Rule 106 EPC was complied with, requiring a petitioner to raise an objection during the appeal proceedings against the procedural violation that it subsequently invokes in a petition for review. It is uncontested that the petitioner did not raise an objection in the sense of Rule 106 EPC during the oral proceedings. The question is whether the final clause of this rule, namely

"except where such objection could not be raised during the appeal proceedings" applies.

1.2.1 The Enlarged Board notes first of all that the alleged procedural violations:

- the failure to decide on the request to admit D19 into the proceedings and
 - the violation of the right to be heard of the petitioner on its line of arguments for lack of inventive step of auxiliary request 4, based on D19 as starting point,
- occurred during oral proceedings.

The petitioner however argues that the final clause of Rule 106 EPC applies in this case, because the petitioner only realised that the violations had taken place when reading the decision. In particular it only became apparent in the written decision that the Board had not decided on the petitioner's request to admit D19.

1.2.2 In the Enlarged Board's understanding there is in this case a difference between what objectively occurred and what the petitioner subjectively believed had occurred. Neither the minutes of the oral proceedings nor the written decision mention D19, let alone a decision to refuse a request to admit that document. The petitioner requested correction of the minutes one year after they were issued (and also after it had filed its petition for review), but this correction was refused by the Board. On the basis of these official documents from the Board and in the absence of any indication in the file pointing in another direction, the Enlarged Board takes as a starting point for its reasoning that the Board has not taken a decision on the request to admit

D19. This is also what the petitioner initially alleged in the petition for review as filed.

- 1.2.3 On the other hand there is the perception of the petitioner that its request for admission was "implicitly refused" or "not accepted". The first implicit refusal allegedly took place when novelty of the main request was discussed. The petitioner stated: "Manitou comprend que D19 est implicitement rejeté comme n'étant plus pertinent que les documents D1/D2 et D5 déjà présents au dossier" (petition p. 4, §10).

The second implicit refusal allegedly took place in the context of the discussion of the admissibility of auxiliary request 4. "Manitou redemande alors l'autorisation d'admettre les documents nouvellement opposés le 17 février 2017 (dont D19, qui pour mémoire était opposé aux revendications 7 et 8 objet de RS4), mais la CR répond que l'admission de RS4 n'entraîne pas l'admission des nouveaux documents. Manitou comprend donc que la CR maintient son refus d'admettre D19 et qu'elle devra attendre de lire la Décision pour connaître les motifs de ce rejet" (petition p.5, §12).

The position of the petitioner seems to be that, based on its understanding that the request to admit D19 was already refused during the discussion of the main request, the petitioner understood the reaction to its repeated request when discussing the admissibility of auxiliary request 4, as a confirmation or maintenance of the refusal.

The petitioner admits that the Board did not explicitly refuse its request but it alleges that the Board used language that can be characterized as a "périphrase",

meaning it used indirect expressions to convey that it actually refused the request.

- 1.2.4 On the basis of the objective fact that the Board did not decide on the requests and that this occurred during the oral proceedings, it was objectively possible for the petitioner to raise an objection. On that basis the final clause of Rule 106 EPC does not apply and the petitioner should have raised objections.
- 1.2.5 As concerns the different understanding by the petitioner, the Enlarged Board is not convinced that this is a valid excuse for not raising objections. Even assuming, for the sake of argument, the Board did use language that could be interpreted to imply a refusal when reacting to the request for admission of D19, it is uncontested that the Board did not use the usual expressions for announcing a decision. The petitioner, apparently without asking further clarification from the Board on what it meant with certain expressions or what conclusion the petitioner should draw from the fact that the Board decided on novelty of the main request without consideration of D19, relied for its further strategy on its own interpretation of these expressions and that course of events. It did not further pursue the issue after the discussion on the admissibility of auxiliary request 4 and did not use D19 for its argumentation on lack of inventive step of auxiliary request 4 starting from D19.
- 1.2.6 This way of handling the situation is not in accordance with what can be expected from a party, who wants to convince a Board of its point of view. As has been considered by the Enlarged Board in R 17/11 (point 19 of the Reasons), it is for the parties to address any point they consider relevant and fear may be overlooked

and to insist, if necessary by way of a formal request, that it be discussed. It is not for the Boards to ensure, of their own motion, that all points raised at some point in the proceedings are discussed in the oral proceedings. Reference is also made to CLBA, 8th Edition, IV.F.3.13.7, citing various decisions of the Enlarged Board concerning parties' obligation to participate actively in appeal proceedings.

On the basis of the above it can firstly be expected from a professional representative to note when there has been no formal, explicit decision on its request and to ask for clarification about its status if it seemingly plays no role for the Board. Secondly, there is no indication in the file and the submissions made in the review proceedings, that prior to the two alleged "implicit refusals" a discussion on the merits of the request to admit D19 had taken place. Such a discussion is normally required and the petitioner should have noted its absence. Either it should have protested that it had not had the opportunity to bring its arguments for admission of D19 or it should have queried its own interpretation that the Board had decided. In particular because, as the petitioner has stressed both in writing and orally, it considered D19 to be an extremely relevant document.

The petitioner neither did the one nor the other, but remained passive and simply refrained from using D19 in its further submissions. For this strategy the petitioner cannot make the Board responsible. The responsibility lies with the petitioner and it must bear the consequences of this strategy, which as has become clear from the minutes and the written decision as well as the refusal by the Board to the request of

the petitioner to correct the minutes, was based on an incorrect assumption.

1.2.7 The petitioner has argued on the basis of R 14/10 that rather than the petitioner, the Board should have sought clarification in case the request of the petitioner or its status was considered to be unclear. This argument cannot be followed, as it does not appear from the file that the request or its status in the proceedings were unclear for the Board. The unclarity was on the side of the petitioner and resulted from its misunderstanding that the Board had decided on its request. In any case, according to the minutes the Chairman asked at the end of the oral proceedings after reciting the requests of the parties, whether there were any further comments or requests. The petitioner had the opportunity to raise requests or arguments that had not been addressed yet, but it did not use that opportunity.

1.2.8 The petitioner further cited two decisions of the Enlarged Board allowing a petition for review, R 3/10 and R 21/11, in support of its argument that the Board is to be held responsible for the misunderstanding on the side of the petitioner. These cases however deal with different factual constellations. In R 3/10 the Board, after a discussion on novelty, announced that it would deliberate on "patentability" and after deliberation concluded positively on novelty but negative on inventive step. Inventive step was however not discussed. The petitioner was excused for not raising an objection, as it had on the basis of the facts of the case no reason to assume that the Board's decision would address more than what been previously discussed, i.e. novelty. In other words, it could not reasonably be expected to understand that the Board was

about to make a mistake. In the case at hand however, it cannot be said that the Board made a mistake and that the petitioner had no reasons to assume that the Board would make this mistake. The petitioner misinterpreted the acts and words of the Board and without further questioning based its strategy on this interpretation. In this context it must be stressed, that it is not unusual for a Board to only address the question of admission of a late filed document, if and when this document becomes relevant. It is therefore not reasonable to interpret the way the Board handled the novelty objection against the main request, as an implicit refusal. It is also not reasonable to interpret the statement by the Board that the admission of auxiliary request 4 (which was the issue under discussion at that point in time) did not imply the admission of late filed documents, including D19, as an implicit refusal. At most it can be said that this statement was possibly ambiguous, in which case the petitioner should have asked for clarification.

In R 21/11 a confusion arose during oral proceedings concerning an expert opinion. Shortly before oral proceedings a second expert opinion from the same expert who had written the first expert opinion was filed. This opinion however did not reach the Board on time. During oral proceedings, confusion arose as the party argued on the basis of both expert opinions, whereas the Board members, who had not received the second opinion, understood the discussion to be about the first opinion. The issue of admission of the second opinion was therefore not decided upon. In that case the confusion or misunderstanding was thus caused by an administrative mishap on the side of the Board which was not visible to the parties, and the petitioner could thus reasonably assume that the Board was aware

of the second opinion. The malentendu and the failure to decide became only apparent in the written decision. The current case cannot be compared to this constellation. There was no misunderstanding on the side of the Board, based on circumstances for which the Board was responsible. There was a misunderstanding on the side of the petitioner that cannot be attributed to the Board.

- 1.2.9 Therefore, the Enlarged Board does not accept the argument of the petitioner that, although objectively an objection could have been raised, it could nevertheless not have been raised because the petitioner subjectively had no reason to raise an objection. As stated above only the petitioner is responsible for this misunderstanding, and thus has to bear the consequences thereof.

2. The Enlarged Board concludes that Rule 106 EPC has not been complied with and the petition has to be rejected as inadmissible.

Order

For these reasons it is decided that:

The petition for review is rejected as inadmissible.

The Registrar:

The Chairman:



N. Michaleczek

F. Blumer

Decision electronically authenticated