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**Datasheet for the decision
of 13 June 2019**

Case Number: R 0007/17
Appeal Number: T 0360/15 - 3.2.01
Application Number: 10164448.2
Publication Number: 2298640
IPC: B63H5/16
Language of the proceedings: EN

Title of invention:
Ducted pre-swirl stator assembly

Patent Proprietor:
Daewoo Shipbuilding&Marine Engineering Co., Ltd.

Opponent:
Becker Marine Systems GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 22(1)(a) and (b), 112, 112a(2)(c), 113(1)
EPC R. 106, 124
RPBA Art. 12(2), 12(4), 13(1)
European Convention on Human Rights, Art. 6(1)

Keyword:
"Petition for review - fundamental violation of Article 113
EPC (no) - clearly unallowable"

Decisions cited:
R 0010/08, R 0021/10, R 0006/12

Catchword:
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Case Number: R 0007/17

D E C I S I O N
of the **Enlarged Board of Appeal**
of 13 June 2019

Petitioner: Daewoo Shipbuilding&Marine Engineering Co., Ltd.
(Patent Proprietor) No 85 Da-dong, Jung-gu
Seoul-city (KR)

Representative: Prüfer & Partner mbB
Patentanwälte · Rechtsanwälte
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Other party: Becker Marine Systems GmbH & Co. KG
(Opponent) Neuländer Kamp 3
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Representative: RGTH
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Decision under review: **Decision of the Technical Board of Appeal
3.2.01 of the European Patent Office of
17 May 2017.**

Composition of the Board:

Chairman: C. Josefsson
Members: E. Dufrasne
D. Semino

Summary of Facts and Submissions

- I. The petition for review concerns decision T 0360/15 of Technical Board of Appeal 3.2.01 of 17 May 2017 and despatched on 5 July 2017, revoking European patent No. 2298640.
- II. The petition for review was filed by the patent proprietor (hereinafter "the petitioner") on 14 September 2017. The corresponding fee was paid on the same day.
- III. The petition is based on the grounds under Article 112a(2)(c) EPC that a fundamental violation of Article 113 EPC occurred in the appeal proceedings.
- IV. In a communication accompanying the summons to oral proceedings dated 8 March 2019, the Enlarged Board expressed its provisional and non-binding opinion that no fundamental violation of the right to be heard occurred and that it intended to consider the petition for review at least in part clearly inadmissible and in any case clearly unallowable.
- V. Oral proceedings were held on 13 June 2019.
- VI. The arguments of the petitioner relevant for the present decision can be summarised as follows:

First objection ("Ground A") - Auxiliary request 1

The first objection concerns the non-admission of auxiliary request 1, decided by the Board pursuant to Article 13(1) of the Rules of procedure of the Boards

of Appeal ("RPBA") (Reasons, point 3). The petitioner argued that this request had been presented as a main request and neither withdrawn nor abandoned in the first-instance proceedings and should consequently have been assessed by the Board under Article 12(4) RPBA. By not deciding on the allowability of this request, the Board deprived the patent proprietor of an opportunity of a substantive discussion regarding this request. This, the petitioner argued, amounted to a fundamental violation of its right to be heard.

Second objection ("Ground B") - Auxiliary requests 2 to 4

The second objection concerns the non-admission of auxiliary requests 2 to 4, also decided by the Board pursuant to Article 13(1) RPBA (Decision, Reasons, point 3.).

This objection is based on questions addressed to the Enlarged Board for clarification:

"1. In case the appellant and opponent requests in the appeal the revocation of the patent in its entirety, which has been maintained in an amended shape in the opposition, is it necessary for the appellant under Article 12(2) RPBA to substantiate grounds of appeal not only for the independent claim 1 but also for the dependent claims?

2. If opponent's inventive step objection does neither comply with Article 12(2) RPBA nor the provisions under G 9/91 and G 10/91, can this objection nevertheless be

admitted in a substantive discussion (and thus be a factor of the procedural economy)?

3. In view of the answer of questions 1 and 2, is the principle of equal opportunities for both parties satisfied if the appellant's inventive step objection and arguments related to the dependent claims, which are first submitted in the oral proceedings before the BoA, are admitted contrary to Article 12(2)RPBA, G 9/91 and G 10/91, whereas the patentee's requests based on the dependent claims, which have earlier been filed in the opposition proceedings and again in the appeal proceedings within the term set by the BoA, are not admitted by the BoA?"

The petitioner argued that the Board's exercise of its discretion was arbitrary by admitting inventive step objections against auxiliary requests 2 to 4 but not the requests themselves. The Board's exercise of discretion should be confined, *inter alia*, by the principle of equal opportunities for both parties and by Article 6(1) of the European Convention on Human Rights (ECHR). For the appeal proceedings to have been fair, if the Board has admitted the opponent's inventive step objection, patent proprietor's auxiliary requests 2 to 4 should also have been admitted.

Third objection ("Ground C") - Auxiliary requests 5 to 8

The patent proprietor requested that auxiliary requests 5 to 8 be filed at the beginning of the oral proceedings before the Board. These requests were not fresh matters since they were identical to the new

auxiliary requests in the oral proceedings at first instance. The chairman said that the requests on file should be discussed first, and the legal member said that the issue under Article 123(2) EPC should be fixed by an amendment. In the petitioner's view, this proves that the requests had been introduced into the proceedings. After consideration of the main and auxiliary requests 1 to 4, the chairman asked for any further comments and requests. The proprietor answered that the cited requests were correct but that on the other hand, there were amendments to be discussed later. This remark was not reflected in the minutes, which need to be corrected to reflect it. Then the debate and the oral proceedings were suddenly and abruptly closed, and auxiliary requests 5 to 8 were skipped over. This infringed the principles of prohibition of *venire contra factum proprium* and the protection of legitimate expectations.

VII. The petitioner requested that:

- the decision of the Board be set aside and that the proceedings be reopened;
- the fee for the petition for review be reimbursed;
- and
- the minutes of the oral proceedings before Board 3.2.01 be corrected by the Enlarged Board of Appeal.

Reasons for the Decision

Admissibility of the petition

1. Given the conclusion of the Enlarged Board upon the clear unallowability of the petition for review as a whole, whether the petition is admissible and in particular its compliance with the admissibility requirements laid down in Rule 106 EPC can be left open.

Allowability - First objection ("Ground A") - Auxiliary request 1

2. Concerning the first objection, the Enlarged Board wants to remind that under the specific scope and in view of the exceptional nature of the petition for review, it is not within its competence to reconsider the substance, i.e. the merits of the reasoning of the Board's decision (e.g. R 21/10, point 2.2 of the Reasons). In its assessment of a petition for review under Article 112a(2)(c) EPC, the Enlarged Board only has jurisdiction to establish whether a fundamental violation of Article 113 EPC occurred.
3. In the present case, even if auxiliary request 1 already formed part of the opposition proceedings in the appeal proceedings, the patent proprietor had not filed or defended it in its reply to the statement of grounds of appeal. It was only introduced later in the appeal proceedings, one month before the oral proceedings, with the letter dated 13 April 2017. Even at that time, no substantiation was submitted by the patent proprietor for this request.

4. Article 12 RPBA, cited by the petitioner, applies to the notice of appeal and the statement of grounds of appeal, any possible reply to these, and any answer filed to any communication sent by the Board pursuant to directions of the Board. Article 13 RPBA more specifically applies to any amendment to a party's case after it has filed its grounds of appeal or reply. It was therefore basically correct for the Board to assess the admissibility of auxiliary request 1 in the appeal proceedings pursuant to Article 13(1) RPBA and under the discretion granted by this provision. Furthermore, the Board's communication annexed to the summons to the oral proceedings already explicitly referred to Article 13(1) RPBA.

It is established case law that the review of a decision based on discretion does not encompass the decision itself but only whether the discretion was exercised in accordance with the right principles and in a reasonable way. In the specific frame of the petitions for review under Article 112a EPC, if and how the discretion exercised by the Board amounts to a fundamental violation of Article 113 EPC must also be determined.

In exercising its discretion, the Board noticed that claim 1 of auxiliary request 1 was identical to granted claim 1 ("provided" amended to "providable" and "fastening" to "for fastening"), its subject-matter being *prima facie* not clearly allowable given that the granted claim was considered by the appealed decision to violate Article 123(2) EPC. The Board also pointed out that the patent proprietor had not provided in its

written submissions any arguments as to why the appealed decision erred in this respect.

5. In the Enlarged Board's opinion, the Board duly exercised its discretion pursuant to Article 13(1) RPBA in not admitting auxiliary request 1 in the appeal proceedings.

Since auxiliary request 1 was not admitted in the appeal proceedings by the Board duly exercising its discretion, there was consequently and logically no need for the Board to consider its allowability. There is no right for a party to have this considered by the Board on a request not admitted, and there was no duty for the Board to do so.

Accordingly, the Board's decision does not amount to a fundamental violation of Article 113 EPC, and the Enlarged Board considers the petition for review clearly unallowable on this basis with regard to the first objection.

Allowability - Second objection ("Ground B") - Auxiliary requests 2 to 4

6. Firstly, the petitioner asked the Enlarged Board to clarify three questions raised in general and conditional terms ("In case...", "If...", "In view of the answer to questions 1 and 2", see above). These questions are similar to questions of law for which the Enlarged Board may be competent pursuant to Article 22(1)(a) and (b) EPC in conjunction with Article 112 EPC but go far beyond its exceptional competence in a petition for review pursuant to

Article 112a EPC. Hence, the Enlarged Board will not answer these questions as such.

7. On the elements specific to the present case, it is common ground that the Board correctly based its decision on Article 13(1) RPBA. This provision leaves the admission of any amendment to a party's case to the Board's discretion, to be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.
8. As mentioned above, the review of a decision based on discretion is strictly limited, particularly in the specific frame of the petition for review.
9. In its decision (Reasons, point 3.), the Board firstly indicated that the same difficulties as with claim 1 of auxiliary request 1, i.e. under Article 123(2) EPC, arose in connection with claim 1 of auxiliary requests 2 to 4 as claim 1 of any of these requests also included the same features giving rise to the objection. The Board further pointed out that no reasons (i.e. substantiation) were given by the patent proprietor in its written submissions (e.g. when filing said auxiliary requests during appeal proceedings) as to why the further amendments included in claim 1 of auxiliary requests 2 to 4 would contribute to inventive step. In particular on this basis, the Board concluded that having regard to procedural economy and the state of the proceedings, auxiliary requests 2 to 4 were not to be admitted to the appeal proceedings, pursuant to Article 13(1) RPBA.

10. In the Enlarged Board's opinion, the cited reasons confirm that the Board reasonably exercised its discretion in accordance with the right principles pursuant to Article 13(1) RPBA.
11. Furthermore, no unfair treatment or possible violation of Article 6(1) of the European Convention on Human Rights (ECHR) can be identified in this Board's reasoning.
12. On this basis, the additional elements raised by the petitioner do not appear decisive. For the sake of completeness, it is noted that the mere consideration of possible inventive step objections, at least *prima facie*, is not excluded at the early stage of the evaluation of the admissibility of auxiliary requests. This does not imply that the inventive step objections were already fully admitted.
13. Accordingly, the Board's decision does not amount to a fundamental violation of Article 113 EPC, and the Enlarged Board considers the petition for review as clearly unallowable on this basis with regard to the second objection.

Allowability - Third objection ("Ground C") - Auxiliary requests 5 to 8

14. Concerning the third objection, even if the patent proprietor had expressed its intention to file additional requests at some stage of the oral proceedings, these were never formally filed.

15. In any case, it was normal for the Board to first consider the higher-ranked pending requests.

16. A statement by a member of the Board during the oral proceedings is only a contribution to the discussion and does not necessarily amount to a decision of the Board. In the context and by its formulation, the declaration allegedly made by the legal member cannot be identified as a Board's decision on the introduction of new additional auxiliary requests *a fortiori* since these requests were not formally submitted.

17. When the chairman summarised the patent proprietor's requests, not including auxiliary requests 5 to 8, he made clear that these requests did not form part of the appeal proceedings. The chairman then asked the parties if they had any further comments or requests. According to the minutes of the oral proceedings, there were none. At least at that time, the patent proprietor could have answered this question by filing additional auxiliary requests. It did not submit any.

18. The petitioner's argument that its representative then referred to "the amendments (...) to be discussed later" cannot be established by the Board. On the contrary, the minutes of the oral proceedings indicate that there were no further comments or requests ("There were none"). Had the patent proprietor responded to the Board's question, this would support the Enlarged Board's opinion that the patent proprietor had the opportunity to respond but did not submit additional requests.

19. The petitioner further argued that the oral proceedings were suddenly closed by the Board. The minutes of the oral proceedings mention that the chairman declared the debate closed, that the decision was given and that only then, logically, the oral proceedings were closed. When the chairman declared the debate closed, the oral proceedings were not closed. At that time, it was still possible for the patent proprietor to request the reopening of the debate to consider the introduction of its auxiliary requests 5 to 8 (R 10/08, Reasons, point 8; R 6/12, Reasons, points 1.3.2 and 1.3.3). To have had its additional auxiliary requests considered, the patent proprietor would have had to file them formally at the latest at that time.

20. From the above, it appears that auxiliary requests 5 to 8 were never introduced into the appeal proceedings by the patent proprietor and that it was not deprived of its right to do so.

21. Accordingly, the Board's decision does not amount to a fundamental violation of Article 113 EPC, and the Enlarged Board considers the petition for review as clearly unallowable on this basis with regard to the third objection.

Correction of the minutes

22. The petitioner also requested correction by the Enlarged Board of the minutes of the oral proceedings before the Board. It requested that its representative's mention of "the amendments (...) to be discussed later" when asked for possible further

comments or requests before the closing of the debate be inserted into the minutes.

23. As to the absence of any indication in the minutes of the alleged statement by the patent proprietor's representative, it is reminded that the minutes only contain the essentials of the oral proceedings and are established by members of the Board (Rule 124 EPC).

It is then basically left to the authors of the minutes to determine whether statements made by a party during oral proceedings are essential and should form part of the minutes.

As a matter of fact, it is also impossible for the Enlarged Board to establish whether the alleged mention had been made by the patent proprietor's representative during the oral proceedings in front of the Board.

24. Moreover, it is established case law that the minutes are neither decisions nor part of decisions, and they cannot as such form the basis for an appeal. Therefore, *a fortiori*, it is in principle not within the specific scope of the petition for review under Article 112a EPC (having jurisdiction to establish whether a fundamental violation of Article 113 EPC occurred) to review and possibly correct the minutes established by the Board.

25. Finally and decisively, the absence of the alleged statement in the minutes is not essential. As established above, the key issue for the present decision is that the patent proprietor had the opportunity to formally submit auxiliary requests 5

to 8 in the appeal proceedings but did not effectively file them.

26. Therefore, the request for the Enlarged Board to correct the minutes of the oral proceedings in front of the Board is refused.

Conclusion

27. From the above, the Enlarged Board considers that no fundamental violation of the right to be heard occurred in the present case and unanimously concludes that the petition is clearly unallowable.

Order

For these reasons it is decided that:

The petition for review is unanimously rejected as clearly unallowable.

The Registrar:



N. Michaleczek



The Chairman:



C. Josefsson