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Datasheet for the decision of 14 October 2019

Case Number: R 0008/18

Appeal Number: T 1934/14 - 3.3.03

Application Number: 04746711.3

Publication Number: 1641883

IPC: C08L101/14, C08K3/10, A61F13/53, A61L15/60

Language of the proceedings: EN

Title of invention:
WATER ABSORBENT RESIN COMPOSITION AND PRODUCTION METHOD THEREOF

Patent Proprietor:
NIPPON SHOKUBAI CO., LTD.

Opponent:
Evonik Degussa GmbH

Headword:

Relevant legal provisions:
EPC Art. 112a(2)(c), 112a(2)(d), 113(1)
EPC R. 104(b), 106, 109(2)

Keyword:
Obligation to raise objections - objection raised (no)
Petition for review - fundamental violation of the right to be heard (no) - clearly unallowable

Decisions cited:
R 0001/08, R 0015/11, R 0015/12, R 0016/13

Catchword:

Europäisches Patentamt
European Patent Office
Office européen des brevets

Große Beschwerdekammer

Enlarged Board of Appeal

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Case Number: R 0008/18

D E C I S I O N
of the Enlarged Board of Appeal
of 14 October 2019

Petitioner: (Patent Proprietor)	NIPPON SHOKUBAI CO., LTD. 1-1, Koraibashi 4-chome Chuo-ku Osaka-shi, Osaka 541-0043 (JP)
Representative:	Müller Hoffmann & Partner Patentanwälte mbB St.-Martin-Strasse 58 81541 München (DE)
Other party: (Opponent)	Evonik Degussa GmbH Rellinghauserstrasse 1-11 45128 Essen (DE)
Representative:	Herzog IP Patentanwalts GmbH Immermannstraße 40 40210 Düsseldorf (DE)
Decision under review:	**Decision of the Technical Board of Appeal 3.3.03 of the European Patent Office of 15 March 2018.**

Composition of the Board:

Chairman	C. Josefsson
Members:	T. Bokor
	F. van der Voort

Summary of Facts and Submissions

I. The respondent-patent proprietor in case T 1934/14 filed a petition for review under Article 112a EPC against the decision of the Technical Board of Appeal 3.3.03 ("Board"), dated 15 March 2018, setting aside the contested decision of the Opposition Division and revoking European patent No. 1641883 for lack of novelty (Articles 100(a) and 54 EPC).

II. The reasoned petition was filed on 14 June 2018 and the prescribed fee was paid the same day. The petitioner contends that two fundamental violations of Article 113 EPC had occurred in the appeal proceedings within the meaning of Article 112a(2)(c) EPC and one fundamental procedural defect had occurred within the meaning of Article 112a(2)(d) EPC, as explained in more detail below.

III. In the appeal proceedings, the Board issued a communication on 12 October 2017, as a preparation for oral proceedings scheduled for 15 March 2018, in which, *inter alia*, the following points were raised:

- In the opinion of the Board, none of the priorities had been shown to be valid and, consequently, Example 4 of D1, which appeared to have been sufficiently disclosed, constituted valid prior art.

- D1 appeared to implicitly disclose the missing features of claim 1 of the patent in suit (i.e. D1 appeared to be novelty-destroying).

IV. The respondent filed with a letter dated 15 February 2018 auxiliary requests 1 to 7 in which claim 1 of auxiliary request 1 contained a disclaimer

for disclaiming Example 4 of D1. The disclaimer described a detailed process for obtaining a water absorbent resin composition. It added 27 lines of text to the original 11 lines of the claim. In addition, the respondent argued that the priority of the patent was "valid against Example 4 of D1".

V. Oral proceedings before the Board were held on 15 March 2018, at the end of which the decision of the Board was announced. The minutes were posted on 20 March 2018. The relevant events may be summarised as follows:

(a) At the start of the oral proceedings, the respondent requested that the appeal be dismissed and that the patent be maintained as granted (main request) or, alternatively, that the patent be maintained in amended form according to any of auxiliary requests 1 to 7 filed with the letter dated 15 February 2018. Additionally, non-admission of certain documents and a conditional remittal was requested.

(b) Among other issues, novelty of the subject-matter of claim 1 as granted was discussed, including the entitlement to priority. During this discussion, the Board decided not to admit a new line of arguments presented by the respondent regarding the validity of the claimed priority and held that the subject-matter of claim 1 was not novel over D1. After this finding, the auxiliary requests were discussed. The respondent filed amended auxiliary requests 1 and 2, replacing all auxiliary requests on file, each containing a disclaimer. One disclaimer consisted of the description of two processes for obtaining a water absorbent resin composition, the description of each process being

about 28 lines long. The other disclaimer consisted of two lists of parameters for defining two distinct distributions of the water absorbent resin particle size, each list containing 14 parameters. Thereafter, the admission of the newly filed auxiliary requests was discussed. The minutes do not contain any details on the arguments for or against the admission.

(c) After the discussion on the admission of the auxiliary requests, the "final requests" of the parties were stated. The respondent requested that "*the appeal be dismissed and that the patent be maintained as granted (main request), or, alternatively, that the patent be maintained in amended form according to either auxiliary request 1 or 2 both requests filed during the oral proceedings*".

(d) Subsequently, the Board deliberated and decided not to admit the auxiliary requests. The Chairman asked the parties if they had any further comments or requests. There were none and the debate was closed. After further deliberation, the Chairman announced the decision to revoke the patent.

VI. The Board's decision in writing was posted on 16 April 2018. It only mentions the respondent's final requests as referred to above in point (c). Furthermore, it contains two distinct findings which were decisive for the outcome of the appeal:

- The subject-matter of claim 1 as granted was not novel over D1 (the petitioner's new line of arguments regarding the validity of the claimed priority was not admitted, and the Board saw no reason to overturn the

conclusion of the Opposition Division that claim 1 did not benefit from any of the priorities).

- Auxiliary requests 1 and 2 were not admitted.

With respect to the non-admission, the decision of the Board contains the following statement (Reasons 3.3):

"*Besides, admitting any of auxiliary requests 1 or 2 to the proceedings would have raised new and complicated issues regarding e.g. the following points:*
- How should the disclaimer be formulated in order not to remove more than is necessary to restore novelty over D1 (see headnote of G 1/03: section 2.2)?
- Considering the length of the disclaimer in both auxiliary requests, does it satisfy the requirements of clarity and conciseness indicated in section 2.4 of the headnote of G 1/03?"

The Board found that the appellant would not have had sufficient time to prepare its own arguments and that an adjournment of the oral proceedings would have been necessary, which, however, would have gone against Article 13(3) RPBA (Reasons 3.3, last paragraph).

VII. The petitioner filed a request for correction of the minutes on the same day when filing the petition. The request for correction was directed to the Board, and it requested that the following statements be included in the minutes:

(a) "*Furthermore, the respondent requested that a further request may be filed in the course of the proceedings in case the Board of Appeal would depart from the decision of the Opposition Division and would come to the result that the requests on file do not*

meet the requirements of the EPC" ("first correction request").

(b) "*During the discussion of the priority documents the respondent has requested to interrupt the oral proceedings. The Board of Appeal has rejected this request at once. The respondent has not accepted this ruling and has brought forward an objection against this ruling. The Board of Appeal dismissed this objection immediately and argued that the respondent has had enough time during the whole proceedings*" ("second correction request").

Two declarations respectively signed by the respondent's representatives who attended the oral proceedings before the Board were annexed to the petition.

VIII. In the reasoned statement of the petition, the petitioner alleged a fundamental violation of its right to be heard (Article 113 EPC, Article 112a(2)(c) EPC) on two counts, and one fundamental procedural defect (Rule 104(b) and Article 112a(2)(d) EPC) as follows:

(1) According to the submissions of the petitioner, during the discussion on the priority issue, the Board raised a question which took the petitioner by surprise. The petitioner therefore requested an interruption, which was not allowed by the Board. The petitioner objected to the ruling (the refusal of the interruption), but the objection was dismissed by the Board. The petitioner states that the refusal of the interruption constitutes a violation of the right to be heard ("first violation"). The petitioner also submits that its objection to the refusal of the interruption qualified as an objection under Rule 106 EPC, even if

no explicit reference was made to this rule.

(2) The written reasons of the decision contain two questions concerning the disclaimers in the auxiliary requests, which had not been discussed at the oral proceedings, see Reasons 3.3 of the written decision and point VI above. Since the disclaimers were an essential basis of the auxiliary requests and an essential aspect of the impugned decision, not discussing these questions at the oral proceedings was a violation of the right to be heard within the meaning of Article 113 EPC ("second violation"). The petitioner, referring to Rule 106 EPC, also submitted that this objection could not have been raised in the appeal proceedings.

(3) The Board did not decide on the requests referred to in the first correction request (see point VII.(a) above). This falls under Rule 104(b) EPC and thus under Article 112(2)(d) EPC ("third violation").

IX. After a communication by the Board, in which it indicated that the request for correction of the minutes was to be refused, the appellant-opponent stated in a written response that the events sought to be recorded by the second correction request had not taken place.

X. With a letter dated 7 September 2018, the petitioner informed the Enlarged Board about the Board's position with respect to the request for correction and argued, referring to decision R 15/11, that it was not for a party to prove that it had not been heard.

XI. With an ancillary decision dated 8 October 2018, the Board refused the request for correction, essentially

stating that recording the contents of the first correction request was not necessary under Rule 124(1) EPC and that the second correction request had no factual basis.

XII. The Enlarged Board in its composition according to Rule 109(2)(a) EPC summoned the parties to oral proceedings and issued a communication on 25 July 2019 in which it expressed its preliminary opinion that the petition appeared clearly inadmissible with respect to the first and third violations and clearly unallowable with respect to the second violation. Thus the petition was likely to be rejected under Rule 109(2)(a) EPC. The communication also stated that the probative force of the various pieces of evidence on file may have to be discussed.

XIII. The petitioner responded to the communication of the Enlarged Board with a letter dated 12 September 2019 reiterating its position that a request for interruption was made and that the refusal of this request was objected to in a manner which must have been understood by the Board as an objection under Rule 106 EPC. The petitioner submitted that mentioning this rule explicitly was not required and that the ancillary decision of the Board (see point XI. above) confirmed that a request for interruption is an essential element of the oral proceedings. Moreover, refusing the request was a fundamental violation of the right to be heard. In its letter, the petitioner did not comment on the preliminary assessment of the Enlarged Board with respect to the second and third violations (see point XII. above).

XIV. Oral proceedings were held before the Enlarged Board on 14 October 2019 in the presence of the representative

of the petitioner. All petition grounds were maintained. The representative confirmed that the request for reimbursement of the fee for the petition for review was conditional on the success of the petition. As to the grounds, she referred to the written submissions and informed the Enlarged Board that no additional arguments or evidence would be relied on.

XV. The petitioner requested that the contested decision be set aside, that the proceedings before the Technical Board of Appeal be re-opened and that the fee for the petition for review be reimbursed, conditional on the success of the petition.

Reasons for the Decision

Admissibility of the petition

1. The petition fulfils the formal requirements with respect to the time limit and fee (Rule 107(1) and (2) EPC). The petitioner is adversely affected by the decision.

Second violation: questions not discussed - Rule 106 EPC

2. The Enlarged Board is satisfied that the petitioner could only have realised upon receipt of the written decision that it contained the questions which were allegedly not discussed before. The petition is therefore admissible to the extent that it is based on the second violation (Rules 106 and 109(2)(a) EPC).

First and third violation: refusing the interruption and requests not decided on

3. It is clear to the Enlarged Board from the totality of the submissions that the first and third violations are completely based on the facts presented in the second and first correction requests, respectively, as mentioned in point VII. above. None of the events sought to be taken up in the minutes is mentioned in or implicitly derivable from the decision of the Board. In this manner, not only the admissibility within the meaning of Rule 106 EPC and the allowability of the petition grounds, but the very existence of the underlying events rests on the two correction requests and the corresponding submissions of the petitioner. This might suggest that the issue of proof with respect to the events sought to be recorded has to be examined first.

4. However, after having analysed the totality of the petitioner's submissions, the Enlarged Board concludes that for the purposes of the present petition, it is not necessary for the Enlarged Board to examine in depth whether the request for correction of the minutes by the petitioner has a factual basis with respect to every detail, or whether the refusal of this request by the Board was correct. As is explained below, even if the Enlarged Board had found that the events took place as derivable from the request for correction of the minutes, the petition grounds based on the first and third violations must be rejected as inadmissible for lack of evidence that an objection under Rule 106 EPC was made.

5. The Enlarged Board finds that the case before it may even be treated as if the requested corrections had been an integral part of the minutes from the very beginning. The petitioner did not specify where the corrections should be inserted in the minutes, but the

Enlarged Board derives from the first correction request that this addition should complement the initial requests at the beginning of the oral proceedings. The preliminary opinion of the Enlarged Board (point XII.) explicitly stated this assumption, and it was not contested by the petitioner. As to the second correction request, it is assumed that its content was to be inserted before the mention of the interruption and deliberation of the Board on page 2, last paragraph of the minutes. As in case of the first correction request, the written preliminary opinion was based on this assumption as regards the second correction request, and this was not contested by the petitioner either.

6. The first violation is about the alleged refused interruption. The petitioner submits that it objected immediately, but there is no evidence on file that such an objection could without doubt be qualified as an objection under Rule 106 EPC, contrary to the assertion of the petitioner. The petitioner states the following:

"The respondent has not accepted this ruling and has brought forward an objection against this ruling".

The declarations of the representatives do not add any more detail to the substance of the objection. The petition states that the objection was expressed in such a form that the Board was able to recognise immediately and without doubt that an objection under Rule 106 was intended and that an explicit reference to Rule 106 EPC was not necessary (page 6 of the petition, first paragraph). The same argument was repeated in the petitioner's letter dated 12 September 2019 (see point XIII. above).

7. The Enlarged Board concludes on this basis that the petitioner made no explicit reference to Rule 106 EPC during the oral proceedings. This is confirmed by other submissions of the petitioner: "The objection raised was very specific, indicating clearly and unambiguously that we had not enough time to deal with the issue discussed during the oral proceedings because the oral proceedings was not interrupted - not even for a short period - in contrast to our request." (page 6 of the petition, second paragraph). Even if the Enlarged Board were to take the statements of the petitioner at face value, it is not apparent that an objection under Rule 106 EPC was made during the oral proceedings. The petitioner correctly cites the settled case law of the Enlarged Board of Appeal, namely, that an objection under Rule 106 EPC must be expressed by the party in such a form that the Board is able to recognise immediately and without doubt that an objection under Rule 1O6 EPC is intended. However, the submissions of the petitioner do not permit the conclusion that this was the case here. Neither the petition, nor the request for correction of the minutes, nor the declarations of the representatives state anywhere that Article 113 EPC or a violation of the right to be heard was mentioned by the petitioner in connection with the refused interruption, in which case the Board might have recognised the objection as a reference to Article 112a(2)(c) EPC. The Enlarged Board therefore concludes that the petitioner's own initial submissions do not suggest, let alone prove that a recognisable objection within the meaning of Rule 106 EPC was made. Only in its letter dated 12 September 2019 (see point XIII. above) did the petitioner submit that the representative "expressed concerns" with regard to the right to be heard, but no further details were given.

8. Other facts derivable from the file clearly do not support the petitioner's case. On the contrary, the totality of the evidence on file speaks against the petitioner. Even if the Enlarged Board were to assume that some sort of objection or discontent with the procedure were indeed voiced by the respondent, on the basis of the evidence on file and the procedure as a whole, it must be concluded that it was not recognisable as a Rule 106 EPC objection, for example, an objection which the representatives may have made at that time without intending it to be an objection under Rule 106 EPC. These following facts speak against the petitioner's submissions:

9. Firstly, the petitioner's own conduct concerning the handling of the request for correction of the minutes does not seem to support that a serious objection was made. As the Board already pointed out in its communication of 3 July 2018, the minutes were sent out within days. If such a serious objection was made by the petitioner as it claims, it must have been its obvious duty to immediately check the minutes to see if there was any trace of the objection. The petitioner argues in its letter dated 7 September 2018 to the Board that "*the minutes have to be analysed in the context of the written decision*" and that "*the request [for] correction ... must be carefully considered and requires a detailed discussion with the client which takes time*". The Enlarged Board does not consider this as a plausible explanation why the petitioner waited such a long time with the request for correction of the minutes. After all, the alleged violation concerned the refused request for interruption. It was not to be expected that the written reasons of the decision of the Technical Board would deal with a refused request for interruption. Taking up such an issue is of course

possible, and may even be expected where this is a contentious issue or where a party specifically requests that written reasons for the refusal be given by the Board in the written decision, but this was not the case here. The final decision of the Board to revoke the patent was also known to the petitioner and the decisive role of the priority issue was to be expected. It is not clear to the Enlarged Board what issues needed careful consideration, given the relative simple nature of the alleged statements by the petitioner and the Board. It is also not clear why the client had to be extensively consulted. They could not be expected to contribute to the correction given that only the European representatives were present at the oral proceedings. Furthermore, the filing of a request for correction does not involve any official fee. In short, the Enlarged Board sees no compelling reasons for postponing the filing of the request for correction until the written decision was issued.

10. In addition, both the Technical Board and the other party categorically deny that such a request for interruption, let alone a corresponding objection against its refusal was ever submitted. The petitioner argued against the position of the Technical Board and pointed to decision R 15/11 of 13 May 2013 of the Enlarged Board of Appeal. The petitioner referred to the principle of "*negativa non sunt probanda*" and argued that it was not for the party to prove that it has not been heard. However, the Enlarged Board points out that the findings of R 15/11 do not support the petitioner's position. The petitioner in R 15/11 could point to the **absence of facts** - the lack of previous discussion on decisive substantive issues - which led to a legal conclusion, namely, the finding that the party had not been heard. The findings of the Enlarged

Board in R 15/11 must be read in this light, i.e. meaning that in the absence of evidence ("any such indications", see Reasons 5) that the party has been heard - because there was no trace of the decisive issue on file - the party cannot be expected to prove the contrary. The present case is fundamentally different. The petitioner bases its claims on positive facts, namely, the events that were stated to have occurred: the request for interruption, the refusal of the request and the subsequent objection of the petitioner. Under these circumstances, the petitioner clearly carries the burden of proof that these events indeed occurred as stated. This is not changed by the fact that the Technical Board may have had a duty to record such events in the minutes.

11. In short, the Enlarged Board finds that the totality of the evidence against the petitioner's position is overwhelming and concludes that no objection under Rule 106 was made by the petitioner during the oral proceedings before the Board. The petition ground based on the first violation is therefore held inadmissible pursuant to Rule 106 EPC.

12. Concerning the third violation, the petitioner does not even state that any objection was made at all, whether under Rule 106 EPC or otherwise. The petitioner does not contest the minutes with respect to the closure of the oral proceedings. According to the minutes, the Chairman asked the parties if they had any further requests, and there were none. If the petitioner was of the opinion that there were still outstanding and undecided requests in the proceedings, this would have been the time to object. There is no trace of any such objection on file, neither in the minutes nor in the subsequent documents submitted by the petitioner. The

petition ground based on the third violation is therefore inadmissible pursuant to Rule 106 EPC.

Second violation: questions not discussed – allowability

13. Neither the minutes nor the written reasons of the impugned decision state that answers to the two questions mentioned in Reasons 3.3 of the Board's decision (see point VI.) were discussed in any depth at the oral proceedings. Thus the Enlarged Board has no reason to doubt that the two questions as such were not discussed at all as submitted by the petitioner. It is less clear if they were not mentioned at all or just not discussed, but the main argument of the petitioner remains that they were not discussed.

14. Concerning the absence of the discussion on these two questions, the Enlarged Board points to the settled case law on petitions, according to which "A violation of Art. 113 EPC can only be considered fundamental within the meaning of Art. 112a(2)(c) EPC if there is a causal link between the alleged violation and the final decision" (see CLBA Chapter V.B.4.3.2, 9th Edition 2019 and the decisions cited). The petitioner argues that a causal link exists in that the disclaimers were an essential basis of the auxiliary requests. This is not disputed by the Enlarged Board. But the petitioner does not state anywhere that the admission of the auxiliary requests depended on the in-depth discussion of the objected questions, and this is also not derivable from the decision itself. The petitioner stated that the questions were considered to be relevant "*if the auxiliary requests 1 or 2 filed during oral proceedings had been admitted to the procedure*" (point 2.3.1, second paragraph of the petition). Again, the Enlarged Board can accept this statement without reservations.

However, the non-admission of the auxiliary requests was not based on answers to these questions, but on the mere fact that these questions, which were given by the Board as examples ("e.g."), would have raised new and complicated issues, and as a result the appellant would not have been in a position to defend its case before the Board without an adjournment of the oral proceedings (Article 13(3) RPBA). The questions were thus merely provided as examples of what these complicated issues might have been. An in-depth discussion of the questions was therefore not necessary for the Board's decision.

15. The Enlarged Board points out that the first auxiliary request which included a disclaimer was filed after the issuance of the written preliminary opinion of the Board (see point IV. above). On the face of it, the not admitted later auxiliary requests contained even more or even completely different disclaimed subject-matter. The petitioner could therefore not have expected to receive any preliminary opinion of the Board on these requests before the oral proceedings. Even during the oral proceedings, a specific formulation of the questions as presented in the written decision could not have been expected. One of the core arguments on the admission under Articles 13(1) and (3) RPBA was that the disclaimers were complex, but not the exact nature and the details of the disclaimers which led to their complexity. The questions formulated by the Board are a mere illustration of the complexity of the auxiliary requests given that the unexpected complexity was caused by the disclaimers. This is clear from the reasons of the decision, stating that the questions are demonstrated merely as an example: "admitting any of auxiliary requests ... would have raised new and complicated issues regarding **e.g.** the following

points" (emphasis by the Enlarged Board). Under these circumstances, the Board did not have to specify the objected questions and communicate them to the parties in advance for the purposes of a discussion on the admission of the auxiliary requests. In the present case, it must have been foreseeable for the respondent-patent proprietor that complexity and the requirements of Article 13(3) RPBA would be an issue given that a simple glance at the disclaimers in the auxiliary requests in question would already have established that the disclaimers were anything but simple.

16. Even if it were assumed that the questions were not even mentioned at the oral proceedings, no violation of the right to be heard had occurred. The Enlarged Board points to the settled case law according to which the right to be heard does not go so far as to impose a legal obligation on a board to disclose in advance to the parties, how and why, on the basis of the decisive issues under discussion – or at least those foreseeable as the core of the discussion – it will come to its conclusion. This is part of the reasoning given in the written decision (R 1/08 of 15 July 2008, point 3.1; R 15/12 of 20 December 2012, point 5; R 16/13, *supra*, point 3). A board of appeal is not required to provide the parties in advance with all foreseeable arguments in favour of or against a request (see CLBA Chapter V.B.4.3.5, 9th Edition 2019 and the decisions cited). Therefore, not presenting the objected questions in advance to the parties was not a violation of the right to be heard in the circumstances of the present case.

17. For these reasons, the Enlarged Board concludes that the petition, to the extent that it is based on the second violation as a petition ground, is clearly unallowable.

18. In summary, given that the petition is found clearly unallowable with respect to all admissible petition grounds, the petition as a whole must be rejected as clearly unallowable (Rule 109(2)(a) EPC).

Order

For these reasons it is decided that:

The Enlarged Board of Appeal as composed under Rule 109(2)(a) EPC decides:

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

The Registrar: The Chairman:

N. Michaleczek C. Josefsson

Decision electronically authenticated