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**Datasheet for the decision
of 5 March 2021**

Case Number: R 0007/19

Appeal Number: T 0799/17 - 3.3.05

Application Number: 02710558.4

Publication Number: 1357999

IPC: B01D53/64, B01D53/02,
B01J20/04, B01J20/16, B01J20/12

Language of the proceedings: EN

Title of invention:

A METHOD FOR THE REMOVAL OF MERCURY FROM A GAS STREAM

Patent Proprietor:

CDEM Holland B.V.

Opponent:

NOx II International, Ltd.

Headword:

petition admissible, but clearly unallowable

Relevant legal provisions:

EPC Art. 112a(2), 113(1)
EPC R. 104(b), 106

Keyword:

obligation to raise objections- no objection raised, but
excusable under the circumstances
no requests relevant for the decision ignored

Decisions cited:

R 0006/14, R 0008/16, T 0162/09

Catchword:



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Case Number: R 0007/19

D E C I S I O N
of the Enlarged Board of Appeal
of 5 March 2021

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Decision under review: **Decision of the Technical Board of Appeal 3.3.05
of the European Patent Office of 7 June 2019.**

Composition of the Board:

Chairman C. Josefsson
Members: W. Van der Eijk
B. Stolz

Summary of Facts and Submissions

- I. On 7 June 2019 the petitioner filed a petition for review in respect of appeal case T 0799/17 before Board of Appeal 3305 (further: the Board). The petition was thus delivered on the day on which the oral proceedings in this appeal had taken place. It was however delivered after the oral proceedings had been closed. On 18 September 2019, by the time both the minutes of the oral proceedings and the reasoned, written decision had been issued, the petitioner filed a submission in which they substantiated their petition for review. The petition fee was paid on 18 September 2019.
- II. In the appeal proceedings both the petitioner (patent proprietor) and the opponent had filed an appeal against the interlocutory decision of the opposition division to maintain European patent Nr. 1357999 in amended form. In its decision the Board set the decision of the opposition division aside and revoked the patent.
- III. The petitioner alleged that the Board committed the following procedural violations:
 - A. not all relevant requests on file were discussed and decided upon (Rule 104, under b, EPC)
 - B. evidence was admitted without substantiation and without respecting the right to be heard of the petitioner (Article 112a, 2, under c, EPC).
- IV. With respect to violation A the petitioner argued that its auxiliary requests filed with a letter of 28 September 2017, in particular requests 9 and 10, had not been discussed in substance during the oral proceedings nor had they been decided upon by the

Board, although the petitioner never had withdrawn these requests. The petitioner had furthermore requested not to admit document D4, filed by the opponent, into the proceedings. This request was also not discussed and not decided upon.

With respect to violation B the petitioner argued that the way the Board dealt with D4, which was used by the opponent to challenge novelty of the main request, violated the rules on evidence. The Board should never have admitted D4 as evidence for proving that the main request was not novel, as the document was defective and contained mistakes. The petitioner was also not put in a position to deal with all the facts relevant for the evaluation of D4, whereby its right to be heard was violated.

The petitioner also raised a number of questions concerning the legal status of the minutes of oral proceedings. It argued that these minutes could not be used as evidence for evaluating whether or not a procedural violation happened. They were only published after a decision was taken and could therefore not form part of the proceedings underlying that decision.

- V. In a written communication dated 11 May 2020 the Enlarged Board commented on the petition. It provisionally found that the petition was not clearly inadmissible but seemed to be clearly unallowable.

- VI. With a letter dated 17 July 2020 the petitioner reacted to the provisional opinion of the Enlarged Board and requested oral proceedings.

VII. Oral proceedings were held by videoconference on 5 March 2021. The petitioner's requests were that the decision under review be set aside and the appeal proceedings be reopened before the Board.

Reasons for the Decision

1. Admissibility

1.1 The first question to be addressed is, whether the petition is admissible. The Enlarged Board notes that the petitioner did not file an objection under Rule 106 EPC during the oral proceedings, where the procedural violations have allegedly taken place. (The letter of 7 June 2019 might be interpreted as an objection, but was filed after the oral proceedings had been closed.) The petitioner has given the following reasons for not filing an objection under Rule 106 EPC: "It was not possible to raise these objections at the hearing as the Board did not formally close the debate. Indeed, given the sudden ending of the hearing we were unclear that the Board was in fact ending the hearing without formally closing the debate rather than interrupting to deliberate on the points discussed up to then. We thus were unable to give notice of a substantial procedural violation in accordance with Rule 106 EPC." (letter of 18 September 2019, last paragraph of p. 2).

1.2 The Enlarged Board notes that according to the minutes of the oral proceedings the following occurred. A discussion of the requests on file took place, including on the question of the procedural status of the requests filed with the letter of 28 September 2017. After this discussion the Chairman

asked the parties to confirm their requests, asked whether they had any further comments or requests (the minutes state "There were none.") and explained what the possible outcomes of the ensuing deliberation would be. He indicated that either the proceedings would continue on the basis of the requests filed on 28 September 2017 or the Board would come to a final decision to revoke the patent. Thereafter the Chairman declared the debate closed and the proceedings were interrupted for deliberation. After deliberation the decision to revoke the patent was announced.

1.3 The minutes of the oral proceedings thus do not support the allegation by the petitioner that the oral proceedings ended abruptly without a prior closure of the debate. It is true however that the alleged procedural violation A (no decision taken on requests) had not occurred yet at the time of the closure of the debate. At that point in time there was - depending on the outcome of the ensuing deliberation - still the option that the requests of 28 September 2017 would be further discussed, as apparently indicated by the Chairman. Under these circumstances the Enlarged Board is of the view that the petitioner can be excused for not understanding that this was actually the moment to raise an objection, even though the violation had not yet actually occurred and was still hypothetical.

1.4 The Enlarged Board finds therefore that the petition is not clearly inadmissible.

2. Allowability

2.1 Procedural status of the minutes of oral proceedings

2.1.1 Before discussing the violations as put forward by the petitioner, the Enlarged Board wishes to address comments made by the petitioner in its letter of 17 July 2020 concerning the use that can be made in petition for review proceedings of the minutes of oral proceedings in the appeal case under review. In summary the petitioner argues that the minutes as drafted by the Board, only present the view of the Board on what happened during the oral proceedings. It seems the petitioner is of the view that they do not form part of the proceedings and cannot be relied upon in petition for review proceedings as evidence. This is all the more so, as parties are not asked for their comments on (draft) minutes and there is no procedure for asking for corrections.

2.1.2 Minutes of oral proceedings are governed by Rule 124 EPC. According to that provision it is a duty of the competent division in first instance proceedings and a Board of Appeal in appeal proceedings to draw up minutes of oral proceedings, containing the essentials of the oral proceedings. They are therefore official documents of the proceedings and form part of the file. It follows from the case law of the Boards of Appeal and the Enlarged Board that, unless duly corrected, the minutes authenticate the facts which they relate to (see Case Law of the Boards of Appeal, 9th edition 2019, V.B.3.6.4, and in particular point 7 of the reasons of decision R 8/16, and point 7 of the reasons of decision R 6/14; see also III.C.7.10.3). It follows from the case law that parties and their representative should carefully check the minutes immediately on receipt and point to any deficiency or mistake promptly, since the minutes are the only means of ascertaining what had occurred during the oral proceedings (see e.g. decisions T 162/09 and R6/14).

- 2.1.3 The Enlarged Board notes that the petitioner has not requested a correction of the minutes, nor has the petitioner in its submissions before the Enlarged Board indicated specifically on which point the minutes would not be accurate. Actually, the petitioner has relied on the minutes to support their allegation that procedural violations took place. The Enlarged Board therefore sees no need to further elaborate on the general and theoretical questions raised by the petitioner in their letter of 17 July 2020. The minutes as issued by the competent Board will thus be taken by the Enlarged Board as a record of the essentials of the oral proceedings.
- 2.2 Fundamental procedural defect according to Rule 104, under b, EPC: No decision on auxiliary requests from 28 September 2017.
 - 2.2.1 The petitioner complains that auxiliary requests 9 and 10 as filed on 28 September 2017 were not dealt with, the petitioner was not heard on them and no decision was explicitly taken on them. The petitioner refers to the comments made by the Board on these requests in items 10 to 12 of the communication sent on 28 February 2019, which according to the petitioner show that the Board found these requests not to be without merit.
 - 2.2.2 However, on 3 April 2019 the petitioner had filed a new set of auxiliary requests. The Board was apparently of the opinion that these latter requests replaced the requests from 28 September 2017. According to the minutes, the requests of the petitioner were recited by the Chairman at the beginning of the oral proceedings as follows "The appellant I (patent proprietor) requested that the decision under appeal be set aside

and that the patent be maintained as granted (main request). In the alternative it requested to maintain the patent on the basis of one of the first to tenth auxiliary requests, filed with the submission of 3 April 2019." The minutes further state: "Both appellants confirmed these requests."

- 2.2.3 The minutes of the oral proceedings also state, that the admissibility of the requests of 3 April 2019 (which were filed after the statement of grounds appeal) was discussed. After they were found not to be admissible by the Board, the petitioner argued that their requests from 28 September 2017 were still in the proceedings. According to the minutes, this issue (that is: whether these requests were still in the proceedings) was discussed with the parties. In its decision the Board concluded that the auxiliary requests from 28 September 2017 were not part of the proceedings (Reasons for the Decision, point 5).
- 2.2.4 It thus cannot be established that the Board overlooked or ignored these requests and that they were not discussed and decided upon. To the contrary, the first issue dealt with was their procedural status. It has been discussed with the parties, the Board has taken a decision on it and gave its reasons in the written decision. The Enlarged Board therefore cannot see a procedural violation committed by the Board. The consequence of the decision that the requests of 28 September 2017 were not in the proceedings, is that their substance was not discussed and decided upon. However, this is, given that these requests were not in the proceedings, not a violation according to Rule 104, under b, EPC.

2.2.5 The petitioner has argued that it was never their intention to withdraw the requests of 28 September 2017. They allege that the Board mistakenly interpreted their letter of 3 April 2019 to mean that the requests filed with that letter replaced the earlier ones.

The submissions of the petitioner in this respect invite the Enlarged Board to review whether the Board came to the right conclusion. It is however not within the competence of the Enlarged Board to review the findings of the Board as to their merits. It appears to the Enlarged Board that the decision was taken after the petitioner was heard and has been properly reasoned. The right to be heard was thereby respected. The Enlarged Board is furthermore of the view that the Board did not act unreasonably or arbitrarily in coming to its conclusion. The letter of 3 April 2019 was indeed silent on the fate of the earlier requests, but the fact that the new auxiliary requests were numbered 1 to 10 and an indication was given in which order they were to be dealt with ("..., or in the alternative, to deal with the requests in the order as presented."), could reasonably be understood by the Board and the opponent to mean that these new requests were now the valid ones. Even the petitioner confirmed at the beginning of the oral proceedings before the Board that these were their requests.

2.3 Fundamental procedural defect according to Rule 104, under b, EPC: No decision on request not to admit D4

2.3.1 The petitioner further complains that their request not to admit D4 in the proceedings was not discussed and not decided upon.

It appears from the minutes of the oral proceedings that after the discussion of the main request, where novelty over D4 had been an issue, and the Board had reached the conclusion that the main request lacked novelty over D4, the petitioner expressed the view that the admissibility of D4 had not been sufficiently discussed. The minutes state that this issue was then discussed with the parties. From there it follows that this issue must have been discussed.

2.3.2 It is true that the minutes do not mention an explicit decision on the admission of D4. However, the term "admission of D4" as used by the petitioner is not entirely accurate. Document D4 was already filed during the opposition proceedings, was admitted and had been considered by the opposition division in its decision. The document therefore was already part of the opposition proceedings and did not need to be admitted in the appeal proceedings. It seems that the issue with document D4 was rather whether or not it disclosed in an enabling manner subject matter that could be used for arguing lack of novelty. The petitioner argued that D4 was deficient and full of mistakes, in particular by a defective reference to an article of Zygarlicke and Galbreath of 1998, and for that reason could not be regarded as prior art. The Board has recognized this line of argumentation and has dealt with it in the reasons of the written decision (see p.10).

2.3.3 The Enlarged Board thus comes to the conclusion that in fact there was no procedural decision to be taken on the request not to "admit" D4 into the proceedings and that the substance of the point made by the petitioner with respect to D4 was understood and dealt with. Therefore, also with regard to D4 the Enlarged Board

finds that no violation according to Rule 104, under b, EPC has occurred.

2.4 Violation of the rules of evidence in dealing with D4

2.4.1 The petitioner complains that the way D4 was used in the discussion on novelty of the main request violated the rule of evidence. To the extent that the complaint is based on alleged errors in the substantive evaluation of D4 by the Board, the Enlarged Board refrains from commenting. It has no competence to evaluate the merits of the substantial findings of a Board. From a formal point it is to be noted that violation of the rules of evidence is not a ground for review, see Article 112(a)(2), under d, EPC and its implementing Rule 104.

2.4.2 The petitioner further alleged that their right to be heard was violated in that the Board did not provide them with a copy of the article of Zygarlicke and Galbreath of 1998 and they were therefore not in a position to verify the relevance of that document and whether the short summary of that document in D4 was correct. However, apart from the question whether the Board was obliged to provide the petitioner with a copy of the article and whether the petitioner actually asked to be provided with a copy, the allegation cannot succeed as the decision is based on the content of D4 and not on an article that was referenced in it. The decision cannot therefore be said to be based on evidence that the petitioner was not aware of and could not comment upon and there is therefore no violation of the right to be heard.

2.5 It follows from the above that the alleged procedural violations on which the petition is based did either

actually not occur in the appeal proceedings under review or are not open to review.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



N. Michaleczek

C. Josefsson

Decision electronically authenticated