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**Datasheet for the decision  
of 10 July 2023**

**Case Number:** R 0006/20

**Appeal Number:** T 2227/15 - 3.2.07

**Application Number:** 09251666.5

**Publication Number:** 2140987

**IPC:** B26B19/06, B26B19/20, B26B19/38

**Language of the proceedings:** EN

**Title of invention:**  
Blade assembly

**Patent Proprietor:**  
Andis Company

**Opponent:**  
Wahl GmbH

**Headword:**  
Fundamental violation of the right to be heard

**Relevant legal provisions:**  
EPC Art. 112a(2)(c), 113(1), 114(1)  
RPBA Art. 12(4)

**Keyword:**

Compliance of Art. 12(4) RPBA 2007 with Art. 114(1) and 113(1) EPC (yes)  
Petition allowable (no) no violation of petitioner's right to be heard

**Decisions cited:**

R 0008/15, R 0010/18

**Catchword:**

1. The Enlarged Board of Appeal affirms its previous decisions R 8/15 and R 10/18.
2. Catchword 1, second paragraph, of R 10/18 reading: "Article 113(1) EPC is infringed if the board does not address submissions that, in its view, are relevant for the decision in a manner adequate to show that the parties were heard on them, i.e. that the board substantively considered those submissions..." is complemented as follows:  
the requirement that "the Board substantively considered those submissions" should be given the meaning that "the Board considered the contents of those submissions", with this consideration comprising matters
  - pertaining to admittance of facts, evidence and requests, and/or
  - relating to substantive law, i.e. the merits of a case.(See Reasons, point 2).
3. Article 12(4) RPBA 2007 is in line with Articles 114(1) and 113(1) EPC. (See Reasons, point 3.2.2(a) *in fine*.)



**Große Beschwerdekammer**  
**Enlarged Board of Appeal**  
**Grande Chambre de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: R 0006/20

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 10 July 2023**

**Petitioner:** Wahl GmbH  
(Opponent) Villinger Straße 4  
78112 St. Georgen (DE)

**Representative:** Stolmár & Partner  
Patentanwälte PartG mbB  
Blumenstraße 17  
80331 München (DE)

**Other party:** Andis Company  
(Patent Proprietor) 1800 Renaissance Boulevard  
Sturtevant, WI 53177 (US)

**Representative:** Pinnington, Giles Oliver  
Marks & Clerk LLP  
1 New York Street  
Manchester M1 4HD (GB)

**Decision under review:** **Decision of the Technical Board of Appeal 3.2.07  
of the European Patent Office of  
29 January 2020.**

**Composition of the Board:**

**Chairman** C. Josefsson  
**Members:** B. Müller  
A. Usuelli

## Summary of Facts and Submissions

### I. The subject of the petition

The opponent's petition for review filed on 27 May 2020 is directed against the decision of Technical Board 3.2.07 (hereinafter: "the Board") in appeal case T 2227/15. By that decision, the Board dismissed the opponent's appeal against the decision of the Opposition Division rejecting the opposition filed against European patent number 2 140 987. The decision was pronounced in the oral proceedings of 29 January 2020 and the reasoned written decision was posted on 11 February 2020. The title of the invention is: Blade assembly.

The petition for review is based on Article 112a(2) (c) EPC, more precisely on the grounds that a fundamental violation of the right to be heard, Article 113(1) EPC, occurred. This was because, in the decision under review, the Board disregarded essential facts and arguments that the petitioner had put forward. The Board was, in particular, required to expressly deal with all of the petitioner's essential submissions.

In the petition it is stated that, both in the written and the oral proceedings, the petitioner raised an objection within the meaning of Rule 106 EPC. The objection was directed against the fact that the Board had not substantively examined the *prima facie* novelty-destroying submissions in respect of claim 1 of the patent as granted relating to public prior use and not admitted these submissions to the proceedings. The

assertion of public prior use was made (for the first time) together with the statement of grounds of appeal of 4 February 2016. In support, documentary evidence labelled D7 (documents D7.1 to D7.10) was filed and a witness was called (for providing testimony on the reasons for the filing of this evidence on appeal only). In the Board's communication annexed to the summons to oral proceedings the bundle of documents D7 was not formally taken notice of and the call of the witness was not addressed. In a reply of 30 December 2019 and in the oral proceedings, the petitioner provided a reasoned statement on the expected refusal of the submissions relating to documents D7 and submitted a bundle of documents D8 as further evidence of public prior use. The Board saw no reason to deal with the petitioner's submissions in substance; the petitioner addressed this fact in the oral proceedings. The patent proprietor did not take position on the case in the written proceedings, nor did it take part in the oral proceedings before the Board.

## II. Admissibility of the petition

According to the petitioner, had the Board taken into account the submissions on public prior use and summoned the witness, it could and would have had to arrive at a contrary decision. The petitioner was therefore adversely affected by the decision under review. The petition was filed in time in view of the "Notice from the European Patent Office dated 1 May 2020 concerning the disruptions due to the COVID-19 outbreak". The petitioner also provided details in support of its assertion that it had raised an objection in the meaning of Rule 106 EPC.

III. The petitioner's allegations

(a) Principle

The petitioner asserts that, to comply with the right to be heard, the Board would have had to deal with all the facts and arguments that the petitioner had put forward in the appeal proceedings. This fundamental right would be completely stripped of its essence if a party were formally allowed to make statements, but had no right to an assessment of its submissions in substance and not in a mere formal and procedural manner.

The Enlarged Board of Appeal (hereinafter also referred to as "EBA") notes that the Board, in the decision under review (in point 4) relied on the procedural provision of Article 12(4) RPBA 2007 in not admitting the attack on novelty based on the alleged public prior use, in particular, on the bundle of documents D7. This provision reads (emphasis added):

Without prejudice to the **power** of the Board **to hold inadmissible facts, evidence or requests which could have been presented** or were not admitted in the **first instance proceedings**, everything presented by the parties under (1) shall be taken into account by the Board if and to the extent it relates to the case under appeal and meets the requirements in (2).

The Board held that "submitting the public prior use novelty attack for the first time in appeal proceedings is not justified." (See point 4.4, second paragraph, of the decision, reproduced below, in point VIa)).

(b) The Board's failure to comply with its responsibilities under Articles 114(1) and 113(1) EPC

(i) Article 114(1) EPC

According to the petitioner, its assertion of novelty-destroying public prior use in the statement of grounds of appeal and the reply to the Board's communication would have required the Board to examine the facts pursuant to Article 114(1) EPC. The Board however remained completely inactive in this regard.

(ii) Article 113(1) EPC

According to the petitioner, the Board did not, as required in R 8/15, "substantively consider" the petitioner's submissions relating to the public prior use made with the statement of grounds of appeal and the reply to the Board's summons. The Board heard, i.e. took notice of, the submissions regarding public prior use, but failed to provide an assessment of the substance of their contents ("inhaltliche Würdigung"). Such an, at least brief, assessment, however, would have been required before refusing admittance of those submissions in order to determine the relevance of the public prior use. This is because the public prior use had neither been withheld by abuse of process nor would a delay in the proceedings have been caused had the Board considered it. The patent proprietor had taken position on the case neither in the proceedings before the Opposition Division nor in those before the Board. Consequently, the Board would have been in a position to decide on the validity of the patent in suit without remitting the case to the Opposition Division.

(c) Details on the Board's failure to assess, or assess correctly, facts and evidence

(i) Assessment of evidence and the boards' case law

According to the petitioner, the provisions of Articles 12 and 13 of the applicable version of the RPBA notwithstanding, in assessing possibly late-filed facts, evidence and grounds for opposition, the following three criteria must be examined:

- *prima facie* relevance,
- state of the proceedings (procedural economy),
- reasons for filing late (potential abuse of process).

The Board incorrectly held that the boards' case law on admittance of late-filed evidence of public prior use adopted before the entry into force of the RPBA 2003 (the provisions of which were merely re-labelled in the RPBA 2007) was not pertinent. Applying that case law to the case in hand showed that non-admittance of the evidence of public prior use constituted a violation of the right to be heard.

(ii) Impossibility of earlier filing of D7

According to the petitioner, finding the evidence of public prior use was impossible at the point in time when the opposition was filed. This is due, first, to the departure of employees involved in the confidential project forming the basis of the prior use and, second, to obsolete, illegible software. It was only by coincidence, when registering old inventory on the petitioner's premises at about the time when the appeal was lodged, that a stand-alone computer was found on



which the old programme version was installed. In addition, a set of old folders was discovered only in the course of this registration process. These folders contained contracts and documents of the project that was subject to strict secrecy; documents D7 and D8 were associated with that project.

- (iii) No violation of the principle of procedural economy

According to the petitioner, the respondent not having made any submissions before the Opposition Division or the Board, non-admittance of the prior use documents could not be based on the need for procedural economy.

IV. The EBA's communication pursuant to Articles 13 and 14(2) of the Rules of Procedure of the Enlarged Board of Appeal

The EBA set forth that the petitioner asserted a fundamental violation of its right to be heard (Article 113(1) EPC) on the basis of two procedural defects:

- non-admittance to the appeal proceedings of the submissions relating to public prior use, in particular documents D7 (first defect),
- not dealing with all the facts and arguments that the petitioner had put forward in the appeal proceedings in the written decision (second defect).

In the EBA's preliminary opinion, the petition was clearly inadmissible for failure to raise an objection pursuant to Rule 106 EPC against the Board's intended non-admittance of the evidence of public prior use (first defect). The EBA considered the petitioner's assertions in respect of its raising of an objection

regarding the first defect under Rule 106 EPC clearly insufficient. The first asserted defect extended to the second one, the allegedly incomplete reasons for the decision, meaning that an objection under Rule 106 EPC in respect of the former would also have extended to the latter. The second defect was the logical consequence of non-admittance of the submissions on public prior use for procedural reasons pursuant to Article 12(4) RPBA 2007, which made a discussion in the decision of facts and arguments unrelated to the application of this provision redundant.

V. The oral proceedings before the EBA

In the oral proceedings the Chairman invited the petitioner to present its case, and in particular, to focus on the grounds for the petition for review and on the duty to raise an objection according to Rule 106 EPC in respect of each asserted procedural defect.

The petitioner put forward that, during the oral proceedings before the Board of Appeal, it was heard on its submissions regarding both admittance of the evidence of prior use, in particular documents D7, and on whether the prior use was novelty-destroying regarding various features of claim 1 of the patent as granted. It was therefore impossible for the petitioner to file the objection the EBA referred to.

The EBA notes that, according to the minutes, only admittance was discussed (see the extract below, in point VIb)).

According to the petitioner, it was surprised by the decision under review, which did not deal with the merits even though they were addressed during the oral

proceedings. The Board ought to have "softened" the application of procedural rules (Article 12(4) RPBA 2007) in favour of substantive law (Articles 114(1) and 113(1) EPC). The petitioner had committed no mistake and consequently did not have to justify the late filing of prior use as held in point 4.4 of the decision (reproduced below, in point VI(a): it was due to the circumstances that the public prior use had not been discovered. The Board did not understand that medium-sized enterprises, such as the petitioner, could not be expected to archive 10-year-old software.

The petitioner requested in the oral proceedings that the order of the two procedural defects mentioned in the EBA's communication had to be reversed.

VI. The pertinent sections of the decision under review and of the minutes of the corresponding oral proceedings

(a) The decision under review

4. Public prior use novelty attack - admittance

4.1 As the novelty attack based on the alleged public prior use, for which the appellant relies upon D7 to D10, was filed for the first time in appeal proceedings, its **admittance is subject to** the criteria pursuant to **Article 12(4) RPBA 2007. Decisive** for the Board is whether there are **reasons justifying filing** the new line of attack **for the first time in appeal.**

4.2 The appellant argues that the novelty attack based on the alleged public prior use, which stemmed from the appellant itself, could not have been filed earlier due to exceptional computer and operational related problems at Wahl GmbH and Wella GmbH in archiving and retrieving the evidence supporting it.

The Board **cannot accept** the appellant's argumentation, since the **archiving** of evidence supporting the alleged public prior use lay **completely within the sphere of the appellant.** Hence, the Board is not convinced that the asserted problems arising only from the appellant itself justify the late filing.

4.3 The appellant further relied upon T 560/89 (OJ EPO 1992, 725) and T 258/84 (OJ EPO 1987, 119) arguing that its late-filed submissions should be admitted.

The Board cannot share the appellant's view. As the aforementioned decisions were issued several years before entry into force of the Rules of Procedure of the Boards of Appeal 2003 by which the provision equivalent to Article 12(4) RPBA 2007 was first introduced (Article 10a(4) RPBA 2003, OJ EPO 2003, 61), the Board notes that both decisions are not pertinent in the present case for evaluating admittance of the novelty attack pursuant to Article 12(4) RPBA 2007.

4.4 As explained in the Board's communication (point 5), the Board is not able to identify any new surprising element in the minutes of the oral proceedings before the opposition division or in the impugned decision that could **justify submitting** the alleged public prior use after opposition proceedings, since the patentability of the subject-matter of claim 1 as granted was already discussed in the written phase of the opposition proceedings (see notice of opposition dated 30 January 2014, points II., IV. and V.; annex to the summons to attend oral proceedings before the opposition division dated 9 December 2014, point 5.2). As a consequence of that, submitting the public prior use novelty attack for the first time in appeal proceedings is **not justified**. For these reasons, the **new novelty attack is not admitted into the appeal proceedings** pursuant to Article 12(4) RPBA 2007.

(Emphasis added.)

(b) The minutes of the oral proceedings before the Board of Appeal

The matter was then discussed with the attending party, in particular concerning the following issues:

- admittance into the proceedings of the novelty attack based on the alleged public prior use in respect of which the appellant relied upon the documents D7 to D10

...

(See page 3.)

## VII. Requests

The petitioner requests that

- the decision under review be set aside and that appeal proceedings be re-opened;

- in the event that the proceedings are re-opened, that they be entrusted to another Board of Appeal;
- the fee for the petition be reimbursed.

## **Reasons for the Decision**

### *Admissibility of the petition*

Favourably for the petitioner, the EBA no longer considers that the petitioner had to raise an objection under Rule 106 EPC. This is because the petitioner, in the oral proceedings before the EBA, clarified its petition to the effect that it was heard during the oral proceedings before the Board on both admittance and merits of its submissions on public prior use. The petitioner thus became aware of its two asserted procedural defects from the written decision only. The minutes of the oral proceedings before the Board do not run counter to the petitioner's assertions, since they are silent on any announcement of the Board's position before handing down the decision.

As the EBA finds the petition to be clearly unallowable, there is no need to address the remaining admissibility requirements. Given that they appear to have been met, the petition for review is considered not to be clearly inadmissible.

*The merits of the petition*

1. The two asserted procedural defects

In the oral proceedings before the EBA the petitioner declared that it relied on the following procedural defects, in this order:

- not dealing with all the facts and arguments that the petitioner had put forward in the appeal proceedings in the written decision (first defect)
- non-admittance to the appeal proceedings of the submissions relating to public prior use, in particular documents D7 (second defect)

These defects amounted to a fundamental violation of the right to be heard (Article 113(1) EPC).

In its analysis below, the EPA will assess whether the decision under review is tainted by a fundamental violation of the right to be heard for

- not addressing all the facts and arguments (first defect) and/or
- the way in which the facts and arguments relating to non-admittance of the submissions on public prior use were addressed (second defect).

2. The first asserted procedural defect

According to the petitioner, not dealing with all the facts and arguments that the petitioner had put forward in the appeal proceedings in the written decision constitutes a fundamental violation of its right to be heard (Article 112a(2)(c) in conjunction with Article 113(1) EPC). The Board only addressed admittance of the submissions on public prior use, in particular of the bundle of documents D7, based on Article 12(4) RPBA 2007, without even discussing whether these submissions

were *prima facie* relevant for assessing the question of novelty of the subject-matter of claim 1 of the patent as granted. In order to comply with the right to be heard, the decision would have had to make it possible to conclude that the Board "substantively considered" the aforementioned submissions on public prior use. The requirement embodied in the term "substantively considered" was set out in the EBA's decision in case R 8/15 dealing with the possible violation of the right to be heard having become apparent from the written decision only.

The EBA notes that it laid out criteria for assessing the assertion of certain aspects of a violation of the right to be heard stemming only from the written decision in R 8/15 and affirmed and complemented those criteria in R 10/18. They are summarised in the catchword of that latter decision (emphasis added):

1. One aspect of the right to be heard as covered by Article 113(1) EPC requires a board to consider a party's submissions, i.e. assess the facts, evidence and arguments submitted as to their relevance and correctness.

Article 113(1) EPC is infringed if the board does not address submissions that, **in its view**, are relevant for the decision in a manner adequate to show that the parties were heard on them, i.e. that the board **substantively considered** those submissions. (See Reasons, point 2.1.1, affirming the relevant part of catchword 1 of R 8/15).

2. A board is presumed to have taken into account a party's submissions that it did not address in the reasons for its decision, meaning that it, first, took note of them and, second, considered them, i.e. assessed whether they were relevant and, if so, whether they were correct.

An exception may apply if there are indications to the contrary, e.g. if a board does not address in the reasons for its decision submissions by a party that, on an **objective** basis, are decisive for the outcome of the case, or dismisses such submissions without first assessing them as to their correctness. (See Reasons, point 2.1.1.2).

In the EBA's understanding the petitioner is of the view that the "substantively considered" requirement implies that a board must deal with the all the essential formal and/or procedural criteria as well as the substantive ones. This would mean in the case in hand that the board would have been required to not merely examine admittance of the submissions made on prior public use on the basis of the procedural provision of Article 12(4) RPBA 2007, i.e. whether those submissions (facts and evidence) "could have been presented.. in the first instance proceedings". Rather, the Board, in assessing admittance, would have had to apply the three criteria it considered pertinent as mentioned above, in point III.a), i.e.

- *prima facie* relevance,
- state of the proceedings (procedural economy),
- reasons for filing late (potential abuse of process), especially whether the evidence on public prior use was *prima facie* novelty-destroying.

If admitted, the submissions on public prior use would have to be examined on their merits, i.e. whether they were indeed novelty-destroying.

The EBA does not share this view. Rather, the requirement that "the Board substantively considered those submissions" (catchword of R 10/18, point 1, second paragraph) should be given the meaning that "the Board considered the contents of those submissions", with this consideration comprising matters

- pertaining to admittance of facts, evidence and requests, and/or
- relating to substantive law, i.e. the merits of a case



The EBA finds that the Board complied with the "substantively considered" requirement interpreted this way for the following reasons:

The Board applying the language of Article 12(4) RPBA 2007 arrived at the conclusion that, having been in the petitioner's sphere at the point in time when the opposition period had expired, the submissions on public prior use ("the new novelty attack") should have been filed in the proceedings before the Opposition Division.

The petitioner did not question the formal applicability of Article 12(4) RPBA 2007, but was of the opinion that the provision should have been "softened" in favour of Articles 114(1) and 113(1) EPC by applying the three above criteria for admittance, which were based on case law handed down before the entry into force of the RPBA 2003. In the proceedings before the Board it had cited T 560/89 and T 258/84, in the proceedings before the EBA further decisions with case numbers of the 1980s and 1990s (see point 2.4.2.2 of the petition). The Board having mentioned (in point 4.3) decisions T 560/89 and T 258/84 is presumed to have taken note of their contents. However, it dismissed them outright without considering them, because it found them to not be pertinent having been handed down several years before the entry into force of the RPBA 2003.

Against this backdrop there is no basis for the petitioner's opinion that, in discussing none of the three conditions that, in its view are relevant for admittance, but applying the one condition of Article 12(4) RPBA 2007, the Board did not substantively consider its submissions on admittance.

Given that the submissions on public prior use were not admitted, there was no point in discussing their merits, i.e. whether the respective evidence was novelty-destroying.

The petitioner asserted in the oral proceedings before the EBA that the question whether D7 was novelty-destroying was discussed in the oral proceedings. Assuming this to have been the case the Board would not have been required to discuss the question in the decision as well, neither in the framework of *prima facie* relevance of the submissions on public prior use nor, and even less so (because those submissions were not admitted), on the merits. There is no legal basis for the view to the contrary; discussions during oral proceedings do not by themselves create legitimate expectations that the board will address the issues discussed in the written decision.

As a consequence of the above, the Board complied with the "substantive consideration" requirement of R 8/15 as affirmed in R 10/18, both in respect of admittance and merits.

The first asserted defect has therefore not been established, reason why the asserted fundamental violation of the right to be heard based thereon is clearly unfounded.

Having given "substantive consideration" to the topic in issue, and insofar complied with the right to be heard, does not rule out a violation of that right that may be derived from the **way** this consideration was given in the respective part of the decision. More specifically, whether the Board, in discussing admittance would have had to address the *prima facie*

relevance criterion and the two other criteria on which the petitioner relied (procedural economy, potential abuse of process) instead of, or in conjunction with, the criterion of Article 12(4) 2007 to comply with the right to be heard is addressed below, under the second asserted procedural defect.

3. The second asserted procedural defect

The petitioner asserts that the non-admittance to the appeal proceedings of the submissions relating to public prior use, in particular documents D7, constitutes a fundamental violation of its right to be heard (Article 112a(2)(c) in conjunction with Article 113(1) EPC). This assertion touches upon both procedural and substantive law.

3.1 The EBA's case law on the review of substantive law under Article 112a EPC

3.1.1 The principle

In the "Case Law of the Boards of Appeal of the EPO", 10<sup>th</sup> edition 2022 (hereinafter: "Case Law") under the heading: "[V.B.]3.4.3 No suspensory effect - review of substantive law excluded" the following principle is set out *inter alia*:

Under no circumstances may the petition for review be a means to review the application of substantive law. ... The Enlarged Board has no competence under Art. 112a EPC to examine the merits of the decision and to go into the substance of a case... It is not the purpose of petition for review proceedings to evaluate whether or not the reasons selected by the board are appropriate... ; the Enlarged Board cannot replace a board's substantive assessment with its own... The Enlarged Board cannot act as a third instance or second-tier appellate tribunal in petition proceedings...

3.1.2 Conclusions from the principle on the review of the exercise of discretion in the context of (non-) admittance

(a) Exercise of discretion **not** subject to review

In section V.B.3.4.3 of the Case Law it is said:  
The following issues cannot be considered in review proceedings: ...

- whether to admit a new request (R 10/11, R 11/11, R 13/11, R 4/13) or a new document (R 10/09, R 17/11) under Art. 12 RPBA 2007; or under Art. 13(1) RPBA 2007 (R 1/13, R 4/14, R 6/17) ...

In addition, in R 17/10 (in point 2.4 *in fine*) it was held:

The admission of late-filed documents and/or other evidence is a matter for the board's discretion and, therefore, as such not subject to review under Article 112a EPC.

These decisions generally regard the right to be heard as complied with if the party concerned has had the opportunity to express itself sufficiently as to the exercise of discretion in balancing the criteria for admittance of late-filed submissions. Reviewing the exercise of discretion would amount to the reviewing of the application of substantive law, which was excluded under Article 112a EPC.

(b) Exercise of discretion subject to review if arbitrary or manifestly illegal

In the Case Law (*idem*) it is said:

Not being competent [**not having jurisdiction**] to decide **on the merits** of a case necessarily implies that the Enlarged Board has **no power to control** [**review**] the normal exercise a board makes of its **discretion**

(R 10/09, see also R 6/17). **The exercise of discretion is only subject to review if arbitrary or manifestly illegal (R 10/11 [point 5.2]), thereby involving a fundamental violation of the right to be heard (R 9/11 [point 3.2.3]; see also R 17/11 [point 10]).** (Emphasis added.)

In R 6/17 it was held:

3.5 ...the exercise of discretion by a board of appeal is subject to only limited review. Thus, it is the task of the Enlarged Board to review whether the Board did not abuse its discretion in an arbitrary or manifestly illegal manner whilst respecting the petitioner's rights under Article 113(1) EPC.

R 9/11 reads:

3.2.1 ...Since both the decision to admit or not to admit a late-filed document and the decision to admit or not to admit a late-filed request are primarily discretionary decisions of the competent Board, they can only be reviewed to the extent that the way in which a Board exercised its discretion constituted a fundamental violation of Article 113 EPC. ...

3.2.3 Hence, the petitioner can succeed only if it can be demonstrated that the Board declined to admit auxiliary requests A and B into the proceedings arbitrarily or on grounds that were not relevant to the exercise of its discretion, thereby unlawfully depriving the petitioner of its right to have these requests admitted and discussed in full. ...

R 17/11, in point 10, the board held that the exercise of the discretion to admit a late filed document was, as a rule, subject to review only under the aspect of whether the board, in exercising its discretion, committed a fundamental violation of Article 113(1) (citing R 17/10, point 2.4 and R 10/09, point 2.3).

3.2 Application of the case law

3.2.1 Case law holding the exercise of discretion **not** to be subject to review (see 3.1.2(a) above)

The petitioner itself stated that it was heard on the admittance and the merits regarding its submissions on public prior use making it impossible for it to file an objection under Rule 106 EPC (see above, point V). Thus, applying this case law, which merely requires hearing the party on admittance, the right to be heard would be complied with and the EBA's scrutiny would stop here.

3.2.2 Case law holding the exercise of discretion to be subject to review (see 3.1.2(b) above)

Under the essence of this case law, merely hearing a party on admittance does not suffice: the decision to not admit must be neither arbitrary nor **manifestly illegal**.

These criteria are met in the case in hand: first, the applicable legal provision of Article 12(4) 2007 complies with both the principle of *ex officio* examination (Article 114(1)) and the right to be heard (Article 113(1) (see point 3.2.2(a) below), and, second, so does its application in the case in hand (point 3.2.2(b)).

- (a) Compliance of Article 12(4) RPBA 2007  
(Article 10a(4) RPBA 2003) with Articles 114(1) and  
113(1) EPC

*The issue*

The decision to not admit the evidence of public prior use, in particular documents D7, was based on Article 12(4) RPBA 2007, whose language does not require an assessment of the three criteria, which, according to the petitioner, govern admittance of prior art filed for the first time in the appeal proceedings:

- *prima facie* relevance
- state of the proceedings (procedural economy),
- reasons for filing late (potential abuse of process).

The EBA understands the petitioner's view in the sense that the Article 12(4) RPBA 2007 criterion "could have been presented in first instance" should be applied in interpreting it in the more concrete terms of, or, rather, effectively replacing it by, these three criteria in view of Articles 114(1) and 113(1) EPC. Before scrutinising this view below, the EBA notes that lawmakers have a wide-ranging scope of appreciation when adopting laws implementing provisions of the EPC, such as the RPBA on the basis of Article 23(4) EPC.

The aforementioned criteria of Article 12(4) RPBA 2007 provide for a restriction of the principle of *ex officio* examination enshrined in Article 114(1) EPC. This restriction can be seen as putting Article 114(2) EPC into more concrete terms; pursuant to that provision the EPO "may disregard facts or evidence which are not submitted in due time by the parties concerned."

*Lawmakers' intent*

The "Decision of the Administrative Council of 25 October 2007 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office" (OJ EPO 2007, 536), generally referred to as RPBA 2007, renumbered the provisions of the RPBA 2003. Article 12 RPBA 2007 is the renumbered Article 10a RPBA 2003. That provision had been approved by the "Decision of the Administrative Council of 12 December 2002 approving amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office" (OJ EPO 2003, 61) and adopted by the authority referred to in Rule 10(1) EPC (the "Presidium" of the Boards of Appeal) on 28 October 2002 (CA/133/02 of 12 November 2002). In the following, pertinent excerpts of the explanatory notes to the amendments are reproduced (emphasis added).

*Point I.A.3 entitled "Introduction"*

The measures aim at achieving the goal of **more efficient and shorter appeal proceedings** include a more defined and controlled initial phase of proceedings; a more pragmatic exercise of discretion under Article 114 (2) EPC thereafter [see the notes on Article 10b] ;

*Point I.B.2, entitled "Written Proceedings"*

The **intended overall effect** of the amendments in Articles **10a** and 10b [renumbered to Articles 12 and 13 RPBA 2007] is to prevent "ping pong" submissions and "salami" tactics in written proceedings..

*On the adoption of Article 10a RPBA 2003*

While Article 10a... provides a cut-off point [after which any further material submitted is ipso facto late], it does not change the present position as regards any material filed after the nine-month opposition period. As at present, parties can have no expectation that anything filed after the end of that period will be automatically admissible and the boards will **retain their discretion**, as a review instance, **to**



**refuse material** excluded at first instance or **not submitted during first instance proceedings**.

Thus the moment in time when a party's case is considered to be complete (so that the board is able to assess a case in its entirety and, subject to oral proceedings, take a decision) is fixed objectively by the rules and no longer subject to the procedural strategy of the parties.

*Compliance of Article 12(4) RPBA 2007 with Article 114(1) EPC*

It follows from these excerpts of the explanatory notes that, with the amended rules, lawmakers intended to streamline the appeal proceedings. As to Article 10a RPBA 2003, the intention was *inter alia* to retain, and not to introduce as something new, the boards' discretion to not admit material not submitted during first instance proceedings. The EBA nevertheless notes that Article 10a(4) RPBA 2003 did not include the three above criteria that the petitioner derived from the case law. Only the criterion "no abuse of process" relating to a party's conduct in the prosecution has a corresponding, but less strict, and consequently more encompassing, criterion, i.e. a board's power to not admit submissions that "could have been submitted [or were not admitted] in the first instance". If a board exercises the power in not admitting, then in so doing it holds that a mistake occurred in the conduct of the prosecution.

However, boards are not precluded from adopting over time stricter criteria as to the taking into account of material not submitted during first instance proceedings than those that the petitioner derived from the case law of the 1980s and 1990s cited in the appeal

proceedings, in particular T 560/89 and T 258/84 and which are addressed in the decision under review in point 4.3. Such a stricter approach may include, in particular, no longer considering *prima facie* relevance as an important criterion or as a criterion at all (on the development of the case law over time cf. the opinion in case G 3/08, OJ EPO 2011, 10, headnote 4).

In any case, as for the opposition appeal procedure, the EBA considers the restriction under the aforementioned Articles 10a(4)/12(4) RPBA to be squarely in line with the **purpose and legal nature of this procedure** as defined by the EBA in G 9/91 and 10/91 (OJ EPO 1993, 408 and 420).

In those decisions (whose reasons are identical in essential part), the EBA held:

18. The purpose of the appeal procedure *inter partes* is mainly to give the losing party a possibility to challenge the decision of the Opposition Division on its merits. It is not in conformity with this purpose to consider grounds for opposition on which the decision of the Opposition Division have not been based. Furthermore, in contrast to the merely administrative character of the opposition procedure, the appeal procedure is to be considered as a judicial procedure, as explained by the Enlarged Board in its recently issued decisions in the cases G 7/91 and G 8/91 (see point 7 of the reasons). Such procedure is by its very nature less investigative than an administrative procedure.

The restriction under Article 10a/12(4) RPBA is also justified in the light of the purpose following from the above mentioned explanatory notes of being to **streamline the appeal proceedings.**

*Compliance of Article 12(4) RPBA 2007 with Article 113(1) EPC*

Article 12(4) 2007 empowering the Board to hold inadmissible facts, evidence or requests which could

have been presented in the first instance proceedings restricts not only the principle of *ex officio* examination, but also the **right to be heard**. The restriction of this right is justified for the same reasons as those justifying the restriction of Article 114(1) EPC. The EBA holds that an application of Article 12(4) RPBA 2007 can be made in each specific case that will respect the right to be heard. Whether the application in the case in hand did so will be discussed below.

### *Conclusion*

Article 12(4) RPBA 2007 setting a lower threshold for non-admittance regarding a party's conduct in the prosecution than **abuse of process** that the petitioner suggested is in line with Articles 114(1) and 113(1) EPC. Non-compliance with this admittance criterion of Article 12(4) 2007, correctly interpreted in a specific case, alone justifies not admitting submissions filed outside of a time limit, without the requirement to assess in addition *prima facie* relevance of the submissions or the state of the proceedings (procedural efficiency).

### (b) Application of Article 12(4) RPBA 2007

The application of this provision was not arbitrary or manifestly incorrect.

The Board declined to admit the submissions on public prior use on the basis of Article 12(4) RPBA 2007, because "submitting the public prior use novelty attack for the first time in appeal proceedings is **not justified**" (point 4.4, second paragraph). The "**archiving** of evidence supporting the alleged public prior use lay **completely within the sphere of the**

**appellant**" (point 4.2, second paragraph). Furthermore, the Board was "not able to identify any new surprising element in the minutes of the oral proceedings before the opposition division or in the impugned decision that could **justify submitting** the alleged public prior use after opposition proceedings, since the patentability of the subject-matter of claim 1 as granted was already discussed in the written phase of the opposition proceedings...".

In the oral proceedings before the EBA the petitioner argued that it had committed no mistake and consequently did not have to justify the late filing of prior use as held in point 4.4 of the decision: it was due to the circumstances that the public prior use had not been discovered.

The EBA notes that it is uncontested that all the evidence of public prior use in suit, in particular the bundle of documents D7 filed with the statement of grounds of appeal, originated from the petitioner itself. The petitioner being a medium-sized enterprise may have had lesser means than a large company to archive folders and safeguard access to digital files saved on a stand-alone computer, as the petitioner argued during the oral proceedings before the EBA. This however does not render the attribution of the lack of access to the opponent, this being the main reason for non-admittance, arbitrary or manifestly incorrect.

The second asserted defect has therefore not been established and the asserted fundamental violation of the right to be heard based thereupon is clearly unfounded.

4. Overall conclusion on the request that the decision under review be set aside

The petition must be rejected as clearly unallowable (Rule 109(2) (a) EPC) because the petitioner has not established that any of the two asserted procedural defects occurred and constituted a fundamental violation of the right to be heard under Article 112a(2) (c) EPC in conjunction with Article 113(1) EPC.

5. The remaining requests regarding the review of the Board's decision

The remaining requests that

- the appeal proceedings be re-opened;
- in the event that the proceedings are re-opened, that they be entrusted to another Board of Appeal;
- the fee for the petition be reimbursed.

must equally be refused. Since the petition is clearly unallowable, the Enlarged Board cannot order reopening of the appeal proceedings under Rule 108(3) EPC; the request to entrust the proceedings to another board consequently has no object. Reimbursement of the petition fee cannot be ordered because the condition of Rule 110 EPC that the proceedings before the Board are reopened has not been met.

**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