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**Datasheet for the decision
of 6 April 2022**

Case Number: R 0011/20

Appeal Number: T 0308/17 - 3.3.04

Application Number: 05811874.6

Publication Number: 1805320

IPC: C07K16/00, C07K1/113, C07K16/28

Language of the proceedings: EN

Title of invention:

METHODS FOR REFOLDING OF RECOMBINANT ANTIBODIES

Patent Proprietor:

Amgen Inc.

Opponents:

Hollatz, Christian
Cabinet Lavoix

Headword:

Petition for review - clearly unallowable

Relevant legal provisions:

EPC Art. 112a(2)(c), 112a(4), 113(1), 114(2), 123(1)
EPC R. 107(1), 109(2)(a)
RPBA Art. 12(2), 12(4), 13, 17(2)

Keyword:

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

Decisions cited:

R 0010/09, R 0003/10, R 0010/11, R 0017/11, R 0006/19



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Case Number: R 0011/20

D E C I S I O N
of the Enlarged Board of Appeal
of 6 April 2022

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Decision under review: **Decision of the Technical Board of Appeal 3.3.04
of the European Patent Office of
11 September 2019**

Composition of the Board:

Chair I. Beckedorf
Members: M. Blasi
P. Gryczka

Summary of Facts and Submissions

- I. The patent proprietor (hereinafter: the petitioner) duly filed a petition for review regarding decision T 308/17 of Technical Board of Appeal 3.3.04 (hereinafter: the board) revoking the patent in suit. The petition for review is based on the ground that fundamental violations of the right to be heard had occurred.
- II. The proceedings before the board concerned the appeal lodged by the two opponents against the opposition division's interlocutory decision finding that the patent as amended in the form of the main request, and the invention to which it related, met the requirements of the Convention. The board held that the subject-matter of claim 1 of each of the main request and auxiliary requests I to IX, XI and XII lacked novelty. Auxiliary requests X, XIa, XIIa and XIII to XIX were not admitted into the appeal proceedings. The petition for review concerns asserted procedural violations associated with the non-admission of auxiliary requests X and XIII to XVIII (in the following "the auxiliary requests") into the appeal proceedings.
- III. The Enlarged Board in its current composition pursuant to Rule 109(2) (a) EPC summoned the petitioner to oral proceedings and issued a communication setting out its preliminary view of the case.
- IV. Oral proceedings took place before the Enlarged Board on 6 April 2022, at which the petitioner made additional submissions in relation to the status of auxiliary request X in the appeal proceedings.

V. In the petitioner's opinion, the board had committed a first fundamental violation of Article 113(1) EPC by not admitting the auxiliary requests into the appeal proceedings, and a second by dismissing the petitioner's objection under Rule 106 EPC, raised by the petitioner during the oral proceedings.

The petitioner's submissions can be summarised as follows:

- The auxiliary requests submitted by the petitioner during the written appeal proceedings represented a legitimate reaction to address:
 - new objections raised during the oral proceedings before the opposition division or by the appellants for the first time on appeal and
 - the board's preliminary opinionIn the reply to the appeal (points 3.5 to 3.9), the petitioner had set out how the auxiliary requests submitted on appeal corresponded to those filed in the opposition proceedings. The petitioner had described the nature of the auxiliary requests and explained why they had been filed in a timely manner.
- At least auxiliary request X was part of the appeal proceedings; neither Article 12(4) nor Article 13 RPBA 2007 provided a basis for not taking it into consideration. The board therefore had no discretion not to consider this claim request.
 - Auxiliary request X was identical to auxiliary request IV, the claims of which had been submitted in the proceedings before the opposition division. Since this auxiliary request had been filed with the reply to the opposition,

it had become part of the opposition proceedings and automatically formed part of the subsequent appeal proceedings.

- This held true irrespective of the fact that the opposition division had not dealt with this claim request after having found the main request to meet the requirements of the Convention.
- For auxiliary request X to be part of the appeal proceedings, the opposition division merely had to have mentioned, in the section of its decision relating to the facts and submissions, the claim requests submitted during the opposition proceedings, which included auxiliary request IV, i.e. auxiliary request X on appeal.
- The petitioner had not needed to provide an explanation in writing during the appeal proceedings as to why the subject-matter of the claims of auxiliary request X was novel and involved an inventive step or overcame the objections raised by the appellants in their statements of grounds of appeal. The requirements of Article 12(2) RPBA 2007 did not apply to claim requests.
- Moreover, the board's written communication containing its preliminary opinion showed that the amendments were self-explanatory.
- Because auxiliary request X was already in the appeal proceedings, the explanations provided at the oral proceedings as to compliance with the EPC were not an amendment to the petitioner's case.
- The question of admittance being raised at the oral proceedings had come as a surprise to the petitioner. Furthermore, the board had not provided any legal basis for considering the

issue of admittance, so the petitioner had not been given adequate opportunity to address it.

- Auxiliary requests XIII to XVIII did not represent an amendment to the petitioner's case either, at least because they corresponded to auxiliary requests admitted by the opposition division (then pending auxiliary requests VI to VIII). In response to a new objection of added subject-matter raised for the first time on appeal by appellant II, these claim requests involved a partial or complete deletion of claims 20 to 22, so submitting them constituted a legitimate reaction to this objection.
- The board's considerations as set out in point 37 of the decision under review represented a *prima facie* assessment relating to patentability. This unilateral approach violated the petitioner's fundamental right to at least comment on all points at issue during the oral proceedings.
- Article 113(1) EPC, which provided a fundamental right to thoroughly discuss auxiliary requests filed in response to objections, prevailed over Article 13(1) RPBA 2007. Accordingly, the board had no power of discretion under the RPBA 2007 not to admit auxiliary requests X and XIII to XVIII into the proceedings.
- Even if it were accepted that the board did have discretionary power on the issue of admitting these requests, the board had exercised it in an unduly restrictive manner. The concept of procedural economy was essential and applied to all proceedings before the EPO, but it could not be the

sole driving force behind a board's exercise of discretion.

VI. The petitioner requested:

- that decision T 308/17 be set aside and the proceedings before Technical Board of Appeal 3.3.04 be re-opened;
- that, in the event of the proceedings being re-opened, the members of the board who participated in taking the set-aside decision be replaced with alternative members of this board; and
- that the fee for petition for review be reimbursed

Reasons for the Decision

Admissibility of the petition for review

1. The petition for review is not clearly inadmissible as the requirements under Article 112a(1) and (4) EPC in conjunction with Rule 107 EPC have been met and the petitioner had raised an objection pursuant to Rule 106 EPC in respect of the procedural defect on which the present petition for review is based.

Allowability of the petition for review

2. The petition for review is clearly unallowable.
3. The petition for review is based on the ground pursuant to Article 112a(2)(c) EPC, i.e. that fundamental violations of Article 113(1) EPC had occurred. It concerns asserted procedural violations associated

with the non-admission of the auxiliary requests into the proceedings.

4. Paragraph 2(a) to (d) of Article 112a EPC sets out, in conjunction with Rule 104 EPC, an exhaustive list of grounds for review ("... may only be filed on the grounds that ..."). Article 112a(2) EPC makes it clear that review proceedings are limited to procedural defects that are so fundamental as to be intolerable for the legal system, thereby overriding the principle that, in the interest of legal certainty, proceedings which have led to a final decision should not be re-opened. It follows from this that the Enlarged Board has no competence under Article 112a EPC to examine the merits of a decision and to go into the substance of a case, not even indirectly (see Case Law of the Boards of Appeal, 9th edition 2019, "CLBA", V.B.3.1 and V.B.3.4.3).
5. The exercise of discretion by a board is only subject to review if arbitrary or manifestly illegal, involving a fundamental violation of the right to be heard (see also R 10/09, point 2.3 of the Reasons; R 10/11, point 5.2 of the Reasons; R 17/11, point 10 of the Reasons; R 6/19, points 34 et seq. of the Reasons).
6. In the case in hand, the Enlarged Board cannot establish that the board's exercise of discretion involved any fundamental violation of Article 113(1) EPC, either in light of the petitioner's submissions or from the decision under review.
7. The issue of the admission of the auxiliary requests into the appeal proceedings pursuant to Article 12(4) RPBA 2007 or Article 13(1) RPBA 2007, including the lack of substantiation, had been raised

by appellant II in the written appeal proceedings (see letter dated 1 July 2019, point 1.a). This issue was then discussed at the oral proceedings before the board (see pages 3 and 4 of the minutes for auxiliary request X and pages 6 and 7 for auxiliary requests XIII to XVIII) and the parties were given the opportunity to present their points of view before the board decided whether to admit the auxiliary requests.

7.1 The petitioner claimed it had been taken by surprise when it was announced that the issue of the admittance of the auxiliary requests into the appeal proceedings would be discussed at the oral proceedings before the board. Yet this can only be regarded as subjective surprise in view of appellant II's explicit request, in the letter dated 1 July 2019, that the board hold "Auxiliary Requests I to XVIII as inadmissible for failing to be substantiated", and the associated reasoning covering two full pages in that letter. While it is true that the board's written communication had addressed substantive issues as regards auxiliary request X, it had been explicitly mentioned that the content of the communication was preliminary and as such not binding on the board, in line with Article 17(2) RPBA 2007.

7.2 The minutes of the oral proceedings before the board are silent as regards the legal provisions on the basis of which the issue of admittance was discussed, so the possibility that no legal basis was explicitly mentioned in the course of the discussion cannot be excluded. However, the Enlarged Board fails to see how, in the case in hand, this could have translated into a fundamental violation of the petitioner's right to be heard in view of the parties' written submissions (in particular, appellant II had explicitly quoted passages

of Articles 12 and 13 RPBA 2007 and cited related case law in the letter dated 1 July 2019), the content of the discussion as recorded in the minutes and the fact that the petitioner had been represented by a professional representative whose name appears on the list maintained for this purpose by the EPO.

Board's discretion to admit auxiliary request X into the appeal proceedings

8. The petitioner's arguments were substantially centred around the point of view that auxiliary request X somewhat automatically formed part of the appeal proceedings and that, therefore, the board had no discretion from the outset over whether or not to consider it. The board exercised its discretion nonetheless and did not admit the auxiliary request, which amounted to an incorrect exercise of discretion, violating the petitioner's right to be heard on this request.
9. When deciding whether to admit the auxiliary requests into the appeal proceedings, the board relied on Article 12(4) and Article 13(1) RPBA 2007. Under these provisions, a board has discretionary power as to whether certain parties' submissions are considered in the appeal proceedings or admitted into the proceedings. Accordingly, it is entirely in line with these provisions that a board, on that basis, may take a decision in exercise of its discretionary power.
10. In the decision under appeal, the opposition division had solely considered a main request, which it found to meet the requirements of the Convention; the claims of auxiliary request X (then auxiliary request IV) did not need to be considered by the division as this was a

lower-ranking claim request. The sole references to this auxiliary request in the written decision are in the "Facts and Submissions" section, indicating the date on which it was filed (page 1, fourth paragraph) and when it was renumbered (page 2, first paragraph).

11. The board took the stance that it had discretion over whether or not to hold inadmissible the auxiliary requests, including auxiliary request X, on the basis of Article 12(4) and (2) RPBA 2007 (see decision under review, points 17 to 24 with references to the CLBA) and considering that "the appeal procedure is not a continuation of the opposition procedure, but a distinct procedure in which any facts, evidence or arguments considered relevant must, if need be, be resubmitted (see G 10/91 ..., G 9/92 and G 4/93 ...)" (decision under review, point 19). In the context of the considerations concerning Article 12(4) RPBA 2007, the board assessed whether the requirements of Article 12(2) RPBA 2007 had been met in relation to auxiliary request X (see decision under review, points 20 to 22 of the Reasons; for similar considerations in relation to auxiliary requests XIII to XVIII, see point 37 of the Reasons). The board concluded that the claim request had not been substantiated when filed on appeal, that it was irrelevant whether or not the claim request had been substantiated in the proceedings before the opposition division and that the amendments to the claims were not self-explanatory. These issues had been previously raised by appellant II (see letter dated 1 July 2019, point 1.a, and minutes, page 4, first paragraph). For the board (see decision under review, in particular point 18, with reference to the case law as set out in CLBA, V.A.4.12.5, and points 20, 21 and 37 of the Reasons) and appellant II, the question of sufficient

substantiation was associated with the issue of whether the requirements under Article 12(2) RPBA 2007 had been met in relation to the auxiliary requests.

- 11.1 The Enlarged Board cannot find fault with the board's stance that it had discretion under Article 12(4) RPBA 2007 in relation to the question of the admittance of the auxiliary requests, including auxiliary request X, into the appeal proceedings. The board assessed the requirements of that provision and provided a logical chain of reasoning to arrive at its conclusion.
- 11.2 The board's assessment of the requirements of Article 12(4) RPBA 2007 includes considerations as to whether or not the explanation provided by the petitioner in relation to the auxiliary requests fulfilled the requirements of Article 12(2) RPBA 2007 - in other words had been substantiated as per this provision - and, if not, whether the amendments to the claims in auxiliary request X were self-explanatory. The Enlarged Board cannot review these findings because doing so would require a review of the case as to its substance and a reassessment of all the facts, arguments and evidence assessed by the board for the decision under review.
12. Likewise, the Enlarged Board cannot find fault with the board's stance in point 25 of the decision under review that the "substantiation of the auxiliary request for the first time at the oral proceedings constitutes an amendment of the case previously presented" and that, therefore, the board was of the view that it had discretion pursuant to Article 13(1) and (3) RPBA 2007 over whether or not to admit auxiliary request X into the appeal proceedings.

- 12.1 Against the background that, in a first step, the board had held that auxiliary request X had not been duly substantiated within the time limit for replying to the opponents' appeals and that the amendments to the claims were not self-explanatory, the board's finding that the subsequent substantiation represented an amendment to the petitioner's case constituted a logical second step.
- 12.2 As highlighted by the petitioner, the board had indeed considered the claims of several claim requests in substance in its communication dated 14 June 2019, even expressly acknowledging the novelty (but denying the inventive step) of the subject-matter of claim 1 of auxiliary request X. At the same time, however, the board had explicitly indicated in this communication, in accordance with Article 17(2) RPBA 2007, that it would give a preliminary assessment on some aspects but that this was not to be considered binding on the board (see point 1 of the communication dated 14 June 2019).
- 12.3 The petitioner did not deny, either in the written petition for review or at the oral proceedings before the Enlarged Board, that it had not substantiated auxiliary request X as regards patentability, for example on the issue of inventive step, during the written appeal proceedings. Accordingly, any submissions in this regard would have been made for the first time at the oral proceedings before the board - this was relevant for the board's considerations concerning an amendment to the petitioner's case under Article 13(1) RPBA 2007.

"Prima facie" considerations concerning auxiliary requests XIII to XVIII in the context of Article 13(1) RPBA 2007

13. The petitioner has criticised the board for drawing on *prima facie* considerations as a criterion when deciding whether to admit auxiliary requests XIII to XVIII into the proceedings under Article 13 RPBA 2007. The board's considerations in the decision under review (point 37 of the Reasons) that it was "not apparent how the amendments overcome the objections raised, since e.g. the subject-matter ... was also objected to by appellant II as lacking novelty" constituted a *prima facie* assessment which was not permitted and which violated the petitioner's fundamental right to comment on all points.

13.1 As set out above, the Enlarged Board only has limited powers to review a decision taken by a board pursuant to its discretionary powers. It should be noted, however, that it is long-standing practice and established case law of the boards of appeal that boards may make *prima facie* considerations - be it to consider whether an amendment is *prima facie* allowable (*prima facie* suitable to overcome one or all objections) or *prima facie* unallowable (*prima facie* raises new objections) - when exercising their discretionary power under Article 13(1) RPBA 2007 (see also CLBA, V.A.4.12). While *prima facie* considerations are indeed not among the criteria specified in this provision, the list is not exhaustive, as derivable from the use of the term "*inter alia*". The Enlarged Board therefore cannot establish any fundamental violation of Article 113(1) EPC within the meaning of Article 112a(2) (c) EPC on account of the board's *prima*

facie considerations in the context of applying Article 13(1) RPBA 2007.

- 13.2 Decision R 3/10 (referred to by the petitioner as R 31/10) does not support the petitioner's case. The situation underlying that decision was completely different and the particular passage in point 2.10 of the Reasons referred to by the petitioner cannot be taken out of context. In the case in hand, and as set out in the minutes of the oral proceedings before the board (see minutes, pages 6 to 7), the question of whether or not the claims of auxiliary request XIII would overcome the novelty objections had been addressed at the oral proceedings when discussing the admittance of this request into the proceedings. The petitioner did not make any additional comments regarding auxiliary request XIV. When the admittance of auxiliary requests XV to XVIII was discussed later, the issue of whether the novelty objections would be overcome or new issues would be raised was addressed again. Accordingly, the petitioner had had the opportunity to make submissions on any aspects associated with the issue of admission, including in particular any *prima facie* considerations.

Article 113 EPC vs Article 13(1) RPBA 2007

14. As to the petitioner's view that the board had no power of discretion not to admit auxiliary requests X and XIII to XVIII into the proceedings due to Article 113(1) EPC taking precedence over Article 13(1) RPBA 2007, the following is noted.

The provisions governing the admission or non-admission of new requests, documents, objections and the like (e.g. Article 13 RPBA 2007) are based on

Article 114(2) EPC and Article 123(1) EPC, which give the deciding body discretion to admit or not admit them. In exercising this discretion, the deciding body is duty-bound to take due account in particular of Article 113(1) EPC, under which the decision may only be based on grounds or evidence on which the party concerned has had an opportunity to present its comments. However, as set out above, the Enlarged Board cannot see any violation of Article 113(1) EPC, so the petitioner's argument fails.

Way in which the board exercised its discretion

15. According to the petitioner's submissions before the Enlarged Board, the petitioner also believes that the board should have balanced the relevant interests and aspects differently when exercising its discretion, namely that the board should have:
- given more weight in particular to the considerations that:
 - the auxiliary requests had been filed in a timely manner as a legitimate reaction to new objections
 - the auxiliary requests had been submitted as a *bona fide* attempt to overcome these objections, representing a reasonable number of requests and not an abuse of proceedings
 - the auxiliary requests had not created a completely new case or been burdensome to deal with
 - the petitioner had a right to present the case in substance and defend the patent while at the same time
 - giving less weight to considerations on procedural economy

According to the petitioner, if the board had given each aspect its proper weight, it would have had to

admit auxiliary requests X and XIII to XVIII into the proceedings.

- 15.1 However, giving one particular aspect a certain importance or preferring one aspect over others and striking a balance between them represents the core of exercising discretion. As such, this is not open to review by the Enlarged Board as it would require the Enlarged Board to put itself in the deciding board's position and evaluate all the facts and circumstances of the particular case.
- 15.2 As set out in point 5 above, the exercise of discretion is only subject to review if arbitrary or manifestly illegal, involving a fundamental violation of the right to be heard. This is clearly not the case here.

Remaining issues

16. Since no violation of Article 113(1) EPC - let alone a fundamental one - can be established in relation to the non-admission of auxiliary requests X and XIII to XVIII into the proceedings, the Enlarged Board also cannot find fault with the board's dismissal of the objection under Rule 106 EPC raised during the oral proceedings.

The second alleged fundamental violation of Article 112a(2)(c) EPC thus fails for this reason alone.

17. As a consequence of the Enlarged Board's finding, the remaining requests that
- the proceedings before Technical Board of Appeal 3.3.04 be re-opened
 - the members of the board who participated in the decision be replaced and

- the fee for the petition for review be reimbursed must equally be refused.

Order

For these reasons it is decided that:

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

The Registrar:

The Chair:



N. Michaleczek

I. Beckedorf

Decision electronically authenticated