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**Datasheet for the decision  
of 6 November 2023**

**Case Number:** R 0006/22

**Appeal Number:** T 1891/20 - 3.5.03

**Application Number:** 14824813.1

**Publication Number:** 3087767

**IPC:** H04W8/18

**Language of the proceedings:** EN

**Title of invention:**

METHOD FOR ACCESSING A SERVICE AND A CORRESPONDING DEVICE

**Patent Proprietor:**

Thales Dis France SAS

**Opponents:**

IDEMIA France  
Giesecke+Devrient Mobile Security GmbH  
Giesecke & Devrient GmbH

**Headword:**

Petition clearly unallowable

**Relevant legal provisions:**

EPC Art. 56, 112a(2)(c), 112a(2)(d), 112a(5), 113, 113(1), 123(2)

EPC R. 100(2), 104(b), 106, 107(1), 107(2), 108(1), 109(2)(a), 109(3)

RPEBA Art. 12(1), 13, 14(2)

RPBA 2020 Art. 13(1), 13(2), 15(1)

**Keyword:**

Petition for review - grounds clearly inadmissible and clearly unallowable - obligation to raise objection - dismissal of objection by the Board (no) - relevant request within the meaning of Rule 104(b) EPC (no) - fundamental violation of Article 113 EPC (no)

**Decisions cited:**

R 0004/08, R 0014/11, R 0002/12, R 0018/12, R 0001/14

**Catchword:**

In a situation such as the present case - where the board does not react in a recognisable and explicit manner to an intended objection under Rule 106 EPC - a diligent party should normally insist on a discernible response from the board. Failure to do so will leave the party with an indication that weighs against its case (Reasons 16).



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Case Number: R 0006/22

**D E C I S I O N**  
**of the Enlarged Board of Appeal**  
**of 6 November 2023**

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**Decision under review:**      **Decision of the Technical Board of Appeal 3.5.03  
of the European Patent Office of  
15 November 2021.**

**Composition of the Board:**

**Chairman**                    C. Josefsson  
**Members:**                    T. Bokor  
                                      M. Pregetter

## **Summary of Facts and Submissions**

I. The patent proprietor in case T 1891/20 has filed a petition for review under Article 112a EPC against the decision of the Technical Board of Appeal 3.5.03 (hereinafter "Board") dated 15 November 2021, which allowed the appeal by the opponents and an intervention and revoked European patent No. 3087767. The Board's decision based the revocation essentially on the ground that the main request was not inventive and the only auxiliary request was not admitted into the proceedings.

### *Overview of the proceedings leading to the petition*

II. The patent was attacked by two opponents. The opposition division maintained the patent in amended form, and the division decided on all three grounds of opposition (Article 100(a)-(c) EPC), addressing both novelty and inventive step under Article 100(a) EPC. Inventive step and even novelty over E3 were examined. E3 was a central argument in practically all aspects on patentability.

III. Both opponents and also the proprietor appealed against the decision. The proprietor's appeal was withdrawn at an early stage and is irrelevant to the petition. A sister company of opponent 2 intervened, and in the relevant parts of the appeal proceedings the two opponents acted as the appellants and the intervener acted as a non-appealing opponent.

IV. For the purposes of the petition, the grounds of opposition of added subject-matter and lack of inventive step are relevant. Opponent 1 argued that

there had been an inadmissible intermediate generalisation. Both opponents argued that there was a lack of novelty and a lack of inventive step.

- V. The Board's communication under Article 15(1) RPBA dated 21 June 2021 took up a number of issues, stating that revocation of the patent was to be expected, for either added subject-matter or lack of inventive step.
- VI. The proprietor responded to these arguments by letter dated 6 July 2021, arguing extensively in support of the main request (as upheld), with respect to both added subject-matter and inventive step. It also filed an auxiliary request and argued in favour of its admittance, stating, *inter alia*, that it overcame alleged new objections under Article 123(2) EPC raised by the Board. The proprietor stated that it considered the new objections to be overcome and moot in the light of the auxiliary request.
- VII. The proprietor did not submit any particular arguments as to how this auxiliary request might change the Board's opinion on inventive step with respect to the main request. It merely stated the following: "*The inventive step of claim 1 of the auxiliary request finds basis in the same arguments as the inventive step of the main request, so, for the sake of procedural economy, these arguments will not be repeated again in this section.*".
- VIII. The appellant-opponent 2 and the intervener reacted to the Board's communication and the proprietor's new auxiliary request. They argued in their joint submission dated 15 October 2021 that the main request contravened Article 123(2) EPC, taking up an earlier argument (feature f4 and the "ordered steps") and

pointing out that the argument had already been on the table before the opposition division. They also argued that the auxiliary request should not be admitted *inter alia* for this reason, either under Article 13(2) RPBA (no exceptional circumstances) or Article 13(1) RPBA (no prima facie allowability). Furthermore, they argued in detail that the amendments made to the auxiliary request did not render the claim patentable over the prior art, in addition to other substantive objections against the auxiliary request.

- IX. Oral proceedings before the Board were held on 15 November 2021. The Board's contested decision was announced at the end. The minutes were posted on 19 November 2021 and do not contain any detail of the arguments relied on for the various discussed issues. For the purposes of the petition, the discussion of the main request and auxiliary request is relevant.
  
- X. From the minutes it transpires that the issues of added subject-matter, novelty and inventive step for the main request and of the admittance of the auxiliary request were discussed without interruption. After the Board's deliberation on these issues, the Chair announced that the main request was novel but did not involve an inventive step, and that the Board did not admit the auxiliary request into the proceedings. This was followed by a discussion on apportionment of costs. In addition to the substantive requests (dismissal or rejection of the appeals and/or the intervention, or maintenance of the patent on the basis of the auxiliary request), the minutes contain a request for costs to be apportioned, for the appeal fee to be reimbursed and for certain documents to be excluded from file inspection, as procedural requests made by the proprietor.

XI. The Board's decision with the written reasons was posted on 9 December 2021. The written reasons correspond to the decisions announced at the oral proceedings, in respect of both inventive step and the admittance. The reason for the refusal of the main request is given as a lack of inventive step. The reasons for the non-admittance of the auxiliary request are based on both Article 13(2) and 13(1) RPBA. It is not entirely clear whether the Board consciously based the non-admittance on both provisions, either independently or together. The formal statement of the non-admittance (Reasons 4.2) only cites Article 13(2) RPBA. The Board's reasons under Article 13(2) RPBA essentially boil down to the lack of exceptional circumstances, as the reasons given by the proprietor for the late filing of the request were not found convincing. The reasons under Article 13(1) RPBA are based on the prima facie lack of inventive step, since no additional inventive step arguments were provided for the auxiliary request beyond those provided for the main request.

XII. The proprietor filed a request for correction of the minutes on 3 February 2022, submitting four items for correction. Only item 3 (the proprietor's statement that the Board's objection under Article 123(2) EPC was new; point 4 of the request for correction) has some limited relevance to the petition in that it confirms certain submissions made by the petitioner. Although the request for correction was refused by the Board's ancillary decision of 16 May 2022, it remains undisputed that the proprietor raised the issue of a possible violation of its right to be heard during the discussion on the admittance of the auxiliary request, even before the decision on non-admittance was



announced, and that no further comments were made after the non-admittance was announced. It is also undisputed that the proprietor did not explicitly mention Rule 106 EPC.

*Overview of the proceedings before the Enlarged Board of Appeal*

XIII. The reasoned petition was filed on 18 February 2022, and the prescribed fee was paid on the same day. The petitioner contends that a fundamental violation of Article 113 EPC occurred and the Board did not decide on a relevant request, so the petition relies on grounds under both Article 112a(2)(c) and (d) EPC. The petition is essentially based on the two grounds that (1) the non-admittance of the auxiliary request constituted a violation of the right to be heard since the auxiliary request had been submitted in response to a new argument raised by the Board, and (2) the Board's failure to carry out a full and proper examination of the inventive step of the auxiliary request (when deciding on its clear allowability for the purposes of its admittance) was tantamount to not taking a decision within the meaning of Rule 104(b) EPC. Moreover, this was another case where the proprietor's right to be heard had not been respected because its inventive step arguments had been ignored.

XIV. The Enlarged Board of Appeal (in its present composition hereinafter also referred to as "EBA") issued a communication under Articles 13 and 14(2) of the Rules of Procedure of the Enlarged Board of Appeal (RPEBA) and summoned the petitioner to oral proceedings. The communication set out that the petition appeared to be clearly inadmissible under Rule 106 EPC in respect of the first ground for

petition and clearly unallowable in respect of both grounds for petition. From the file it appeared that an objection under Rule 106 EPC had not been made when the Board announced that it would not be admitting the auxiliary request into the proceedings. Mere observations on the right to be heard did not qualify as an objection under Rule 106 EPC unless they were immediately and doubtlessly recognisable as such. The alleged failure to examine in detail all the arguments relating to inventive step could not be subsumed under a request that had not been decided on within the meaning of Rule 104(b) EPC (for brevity hereafter referred to as an "undecided request"). It was obvious that the petitioner had been able to comment on the admittance of the auxiliary request, including the issue of the prima facie lack of inventive step, so no violation of Article 113(1) EPC was apparent either. Moreover, inventive step did not need to be discussed in full detail for the Board's decision on admittance.

- XV. The petitioner submitted further arguments by letter of 6 October 2023. Concerning the admissibility of the first ground for petition, it argued that case law required the objection under Rule 106 EPC to be raised "in good time" in order to correct the violation, and explicit reference to Rule 106 EPC was not required in order to recognise an objection within the meaning of that rule. As to the second ground for petition, the auxiliary request was submitted to counter an objection under Article 123(2) EPC, so failing to examine this issue for the auxiliary request was another instance of an undecided request in the sense of Rule 104(b) EPC. The examination of the unexamined issues might have led to the auxiliary request being admitted, and possibly to a different outcome of the case, so the undecided

request was also relevant to the decision on the appeal within the meaning of Rule 104(b) EPC.

XVI. The oral proceedings before the EBA were held by videoconference on 6 November 2023. At the oral proceedings the petitioner argued that both grounds for petition were admissible and allowable.

As to the first ground, it maintained the earlier written argument that an explicit reference to Rule 106 EPC was not required for a valid objection under that rule. The right to be heard had been explicitly stated in connection with the admittance of the auxiliary request before the Board decided on the admittance. That ought to have been enough to recognise that an objection under Rule 106 EPC was being made. When asked by the Chair, the petitioner explained that the Board had not explicitly dismissed the objection, but the non-admittance of the request had to be regarded as the dismissal of the objection for the purposes of Rule 106 EPC.

In respect of the allowability of the second ground, the petitioner emphasised that the Board was obliged to examine whether the auxiliary request complied with the provisions of the EPC, so all aspects of the auxiliary request should have been examined. However, the Board did not decide on compliance with Article 123(2) EPC. Had it done so, the outcome of the case could have been different. The proprietor had not submitted any new arguments on inventive step for the auxiliary request as it had had the reasonable expectation that the auxiliary request would also be examined in depth by the Board. The result was that the strict provisions of the RPBA put the proprietor in an unfair situation, with a new issue coming from the Board and not the

other party. The situation had also been surprising for the petitioner because, contrary to expectations, no communication under Rule 100(2) EPC had been issued by the Board. This issue had been mentioned in the petitioner's letter of 6 November 2023 in connection with the first ground for petition, but it was the petitioner's natural understanding that it also applied to the second ground.

- XVII. The petitioner requested that:
- the decision under review be set aside
  - the proceedings before the Technical Board of Appeal be re-opened
  - the fee for the petition for review be reimbursed

The Enlarged Board issued the decision at the end of the oral proceedings.

## **Reasons for the Decision**

### *Admissibility*

1. The petition is reasoned, it was filed in a timely manner and the fee was paid (Rule 107(1) and (2) EPC). The petitioner is adversely affected by the decision.

### *First ground, requirement to raise an objection (Rule 106 EPC)*

2. Pursuant to Rule 106 EPC, a petition for review based on a ground for petition under any of Articles 112a(2) (a) to (d) EPC is admissible only where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board of appeal, except where such objection could not be raised during the appeal proceedings.

3. The Enlarged Board recognises that a valid objection under Rule 106 EPC need not contain a direct and explicit reference to that rule. As stated in decision R 18/12, Reasons 19, in determining whether the petitioner has complied with Rule 106 EPC, what matters is not the formal wording of the objection but its substance as it could be understood by the board. The question is not what the party may have intended subjectively, but how the party's statement could be understood objectively. In this respect the EBA points to the settled case law of the Enlarged Board of Appeal, namely that an objection under Rule 106 EPC must be expressed by a party in such a form that a board is able to recognise immediately and without doubt that an objection under Rule 106 EPC is intended. An objection under Rule 106 EPC is in addition to and distinct from other statements, such as arguing or even protesting against the conduct of the proceedings or against an individual procedural finding. See CLBA (10th edition, 2022), chapter V.B.3.6.2(a).
4. The Enlarged Board notes, in accordance with the case law, that the purpose of Rule 106 EPC is to give boards a chance to react immediately and appropriately by either removing the cause of the objection or dismissing it (R 04/08, Reasons 2.1). By ensuring that a board can correct errors before a final decision is taken, Rule 106 EPC also ensures that unnecessary petitions for review are avoided (R 18/12, Reasons 19). See also CLBA, *supra*, chapter V.B.3.6.1.
5. It is undisputed that the non-admittance as such was already known to the petitioner during the oral proceedings. It is also apparent from the minutes that the petitioner already had multiple opportunities to formulate a proper objection under Rule 106 EPC during

the oral proceedings. Following the decision on the admittance, other issues were still under discussion. The parties were also invited to comment before the Board announced its final decision, before the closure of the oral proceedings.

6. Under the circumstances, the petitioner could and should have made an explicit objection under Rule 106 EPC, either by a direct reference to this rule or at least to Article 112a EPC, or by making a similar explicit statement from which the Board would have been able to recognise that the objection was not just any argument from the party but indeed one under Rule 106 EPC, expressly for the purposes of a petition for review. No such objection is apparent from the file.
7. The petitioner submits that the required objection was raised. According to its own submissions, during the discussion of the admittance of the auxiliary request, it made an unequivocal statement that failure to admit the request would be a violation of its right to be heard. This alone had to have been sufficient for the Board to recognise the objection as one under Rule 106 EPC.
8. The EBA disagrees. As set out above, the decisive criterion is whether the objection was made in such a way that the Board could immediately and without doubt recognise that the party intended to raise an objection under Rule 106 EPC. Even if the Board may have subjectively perceived that the proprietor's argument during the discussion on admittance was intended as an objection under Rule 106 EPC, the Board apparently did not consider the objection to have been effectively raised. It was certainly not recorded as such in the

minutes, and it is also undisputed that Rule 106 EPC was not explicitly mentioned during the oral proceedings, either before or after the decision on the admittance.

9. Under the circumstances as apparent from the file, the Board had no reason to assume that the petitioner's argument on the right to be heard was already a formal objection pursuant to Rule 106 EPC. A mere reference to the right to be heard does not immediately become an objection under Rule 106 EPC. It normally needs to be formulated after the alleged procedural irregularity and cannot be formulated prematurely; see R 14/11, Reasons 2.7, also cited in the CLBA, chapter V.B. 3.6.2(b). For this reason alone, the Board did not have to assume in the course of the oral proceedings that the proprietor intended to make an objection under Rule 106 EPC, even if it did take note of the remark on the right to be heard during the discussion on the admittance.
  
10. The EBA notes the petitioner's argument that the case law of the Enlarged Board requires the objection under Rule 106 EPC to be raised "in good time" in order to rectify the procedural defect. The EBA also acknowledges that decision R 1/14 cited by the petitioner allows for the conclusion that objections can and should be raised in certain cases where the procedural defect has not yet occurred but is foreseeable. However, decision R 1/14 concerned an objection where the procedural defect was the refusal to postpone oral proceedings and the objection had not been raised until the end of the oral proceedings. This meant that the oral proceedings could not be undone retroactively, in contrast to procedural decisions and conclusions by a board during oral proceedings, which

can normally be reversed or otherwise corrected. Therefore, R 1/14 does not negate the case law according to which objections must normally be raised after the procedural defect. It is emphasised that the question in the present case is not whether there was the theoretical possibility of a premature objection as a matter of law, but whether the Board could have been expected to recognise the petitioner's argument as an objection under Rule 106 EPC, on the basis of the facts in their entirety.

*No explicit reaction from the Board to the alleged objection*

11. Under Rule 106 EPC, not only does the objection in respect of the procedural defect have to be raised during the appeal proceedings. The rule also foresees that the objection has to be dismissed by the board of appeal. If the board does not dismiss the objection, but corrects the procedural defect, the objection becomes moot and a petition can be avoided. Either way, in dismissing or allowing the objection, a board also demonstrates towards the party raising the objection that it also understood the objection as one under Rule 106 EPC.
12. The rule thus makes it clear that the board has an obligation to examine and decide on the objection, and still in the oral proceedings, once it recognised the objection as one under Rule 106 EPC. The EBA has no reason to believe that in the present case the Board was unaware of this obligation, nor has this been argued by the petitioner.
13. It is undisputed that there is no trace of any explicit dismissal of an objection in the file. This was also confirmed by the petitioner's statements made during



the oral proceedings before the EBA, at which the petitioner stated in response to a question that the Board had not explicitly dismissed the objection. In the petitioner's view, the non-admittance of the auxiliary request had to be regarded as the dismissal of the objection for the purposes of Rule 106 EPC. It is also clear that the petitioner considered its single statement about the right to be heard as a recognisable objection, so that repeating or confirming it once more at the end of the oral proceedings was not necessary. In its letter of 5 May 2022 the petitioner stated the following (page 5, last lines): *"However, the Board indicates that the Respondent did not raise any further objection after the deliberation of the Board. The Respondent considered it useless to repeat the objection after a decision was taken, but this should not be considered as a withdrawal of the objection"*. In short, the petitioner assumed that the Board took note of the objection and implicitly dismissed it.

14. The EBA finds this explanation of the events during the oral proceedings unconvincing. The circumstances of the case do not lead to the conclusion that this is the plausible explanation for the Board's lack of reaction to the alleged objection, i.e. that the Board itself must have considered the decision on non-admittance to be at the same time the formal reaction to the objection as required by Rule 106 EPC. It seems very unlikely that the Board would leave a recognisable objection within the meaning of Rule 106 EPC entirely without comment, let alone an explicit and separate decision. Nor does the decision not to admit the auxiliary request prove that the Board was aware of a formal objection. Other theoretical possibilities, such as the Board forgetting or deliberately refraining from

reacting to the objection, would seem just as unlikely as the petitioner's version of events.

15. In the EBA's view, from the totality of the circumstances as presented by the petitioner - and even without taking into account the Board's observations and ancillary decision on the request for correction of the minutes - it seems much more likely that the Board did not take note of the objection and therefore did not react. In this way, the absence of any discernible reaction from the Board is a further indication that the Board could not perceive the right to be heard argument as a recognisable objection within the meaning of Rule 106 EPC.
16. The EBA holds that in a situation such as the present case, a diligent party should normally insist on a discernible response from the board. Failure to do so may leave the party with an indication that weighs against its case. This will normally corroborate the indication which may already arise from the lacking mentioning of the objection in the minutes. See also R 2/12 of 17 October 2012: "Not only when the chairperson confirms the final requests before closing the debate, but at any time when the Board is about to deliberate ... it is the duty of a party to check whether its objection to a fundamental procedural defect occurring during the oral proceedings has been recognised by the Board and will be dealt with" (Reasons 1.2.1).
17. In summary, the Enlarged Board concludes that the petitioner did not make a recognisable objection under Rule 106 EPC. The first ground must be rejected as clearly inadmissible under Rules 106 and 109(2)(a) EPC. Whether the non-admittance of the auxiliary request

itself could constitute a valid ground for petition under Article 112a(2)(c) EPC need not be decided.

*Second ground, ignored inventive step arguments and missing inventive step examination*

18. The EBA is satisfied that the second ground for petition is admissible under Rules 106 and 109(2)(a) EPC. The EBA accepts that the petitioner could only have realised upon receipt of the written decision that it did not contain the reasons which the petitioner expected to address the question of inventive step over E3. In other words, the objection could not have been raised in the appeal proceedings.

*Allowability of the petition*

*Lack of in-depth inventive step examination for the auxiliary request, undecided relevant request (Rule 104(b) EPC)*

19. The EBA explained in its communication that it was unable to discern an undecided request within the meaning of Rule 104(b) EPC. Explicit reference is made to point 24 of the communication, where the EBA set out in detail that ignored facts and arguments do not constitute a "request" within the meaning of this rule. The EBA also explained that the fact that an argument is decisive for the particular case does not make it a "relevant request" under Rule 104(b) EPC. It may be that the proprietor's arguments have been perceived as satisfying certain requirements developed in the case law on the application of Rule 104(b) EPC and on how a "request" must be decisive or relevant to a decision. However, it is not possible to draw the reverse conclusion that every argument that can be considered "decisive" or "relevant" must also constitute a request

within the meaning of Rule 104(b) EPC. The petitioner has not put forward any substantive arguments against this assessment by the EBA.

20. In its reply to the EBA's communication, the petitioner submitted that there had been a request for the purposes of Rule 104(b) EPC, namely a "request for a decision" about the assessment of Article 123(2) EPC (reply, page 7, second paragraph). As the EBA understands it, this "request" is now equated with the arguments presented in support of the admittance of the auxiliary request, i.e. that the amendments in the auxiliary request overcame the - allegedly new - **objections under Article 123(2) EPC**. This is different from the previously argued "undecided request", which had been identified on the basis of the inadequate consideration of the **inventive step arguments** (petition, page 5, third and fourth paragraphs). As such, it is a new submission as per Article 12(1) RPEBA.
21. The petitioner acknowledges that the auxiliary request was found prima facie not inventive (Article 56 EPC) and the non-admittance was a result of this finding. The core of the complaint is now that the non-admittance was **only reasoned with inventive step, without examining Article 123(2) EPC**. Moreover, this argument is different from the petition, in which the non-admittance was objected to because the Board had ignored the fact that the auxiliary request had been filed as a response to a new objection raised by the Board, the other issue being the lack of an in-depth inventive step examination. Now the argument seems to be that the Board ought to have examined (either full or at least prima facie) compliance with Article 123(2) EPC - more or less irrespective of the

procedural situation. The argument is no longer about whether or not there was **a new objection** from the Board, and whether or not the admittance decision was correct **in ignoring that fact**, or whether the inventive step **itself** was properly examined.

22. None of these arguments was raised in the petition, and the EBA sees no special reasons that could justify their admittance under Article 12(1) RPEBA. The arguments are not convincing either, irrespective of their admittance.
  
23. Similarly to ignored inventive step arguments, ignored added-matter arguments are not "requests" within the meaning of Rule 104(b) EPC either. This is not altered by the fact that a proprietor may of course legitimately expect such arguments to be examined if they become relevant; in this way, any argument submitted by a party always implies a request for the board to examine and ultimately decide on that argument. Nevertheless, such submissions do not become requests within the meaning of Rule 104(b) EPC, as explained in the communication from the EBA in point 24. A board's findings on various arguments put forward by a party do not become "decisions" within the meaning of Rule 104(b) EPC because such findings do not normally have any substantive or procedural legal effect. The relevant procedural request in the present case, which was directed to the legal effect sought, namely the admittance of the auxiliary request, was duly decided on by the Board. Ignored arguments, if relevant, may perhaps constitute a ground for petition within the meaning of Article 112a(2) (c) EPC, but even ignored relevant arguments are not apparent in the present case, as explained below in points 28-31.

24. Furthermore, Rule 104(b) EPC refers to requests that are "relevant to" the Board's decision. The petitioner apparently seeks to establish the relevance of the ignored inventive step arguments by arguing that the outcome of the case could have been different had the Board properly examined them.
25. Apart from the fact that this is nothing but speculation, the argument is not convincing either. It may well be that the auxiliary request would have been found inventive if it had been admitted. The question is whether the non-admittance decision was procedurally correct and whether the decision actually taken (the non-admittance decision as opposed to a hypothetical admittance) contributed causally to the adverse legal effect of the final decision. The EBA does not question that the non-admittance was also decisive for the revocation of the patent, but there is no convincing argument before the EBA that the admittance was procedurally flawed, as apparent from the overall assessment of the petition. While not decisive for the petition, the EBA noted in its communication that the first ground for petition also appeared to be unfounded, irrespective of its admissibility. The petitioner has not disputed the EBA's conclusions on the application of the prima facie admissibility criterion either, as set out in points 26 and 27 of the communication.

*Lack of inventive step analysis for the auxiliary request,  
violation of the right to be heard*

26. The EBA accepts that the factual basis of this objection, i.e. ignoring a core argument of a party, may well constitute a violation of the right to be heard, and specifically a violation of

Article 113(1) EPC, and thus may also constitute a ground for petition under Article 112a(2)(c) EPC. The EBA also accepts that under certain circumstances the mere absence of reasons in a decision addressing a relevant argument may demonstrate that a board ignored the core argument.

27. As set out in the EBA's communication, points 26-31, the facts in the present case do not support any violation of the right to be heard concerning the decisive issues for the admittance, for either Article 13(1) or Article 13(2) RPBA. The petitioner did not submit that it had been prevented from presenting its arguments for the admittance in respect of the requirements of Article 13(2) RPBA or that the Board's reasons under Article 13(2) RPBA had been based on unexpected facts or arguments. It merely argued that the non-admittance in itself represented a violation of the right to be heard.
  
28. Nor is it apparent that the proprietor had not had the opportunity to comment on the other relevant reason for non-admittance, namely the prima facie allowability of the auxiliary request under Article 56 EPC as a possible admittance criterion under Article 13(1) RPBA. The petitioner has not argued, nor is it apparent from other circumstances, that it was unaware of the issue of prima facie allowability and its significance for the Board's decision on the admittance. In the EBA's view, the Board addressed this issue to the extent necessary. The EBA sees no basis for the petitioner's argument that the Board should have examined the auxiliary request of its own motion in order to establish the relevant distinguishing features and their technical effects, the objective technical problem, etc. (see petition, page 5, first to third

paragraphs). Even in opposition, it seems questionable whether the opposition division would have had any duty to establish the patentability arguments if no such arguments were provided by the patent proprietor. The Board may have had the power to search for arguments in support of a request instead of the party submitting the request in question, but it was certainly not obliged to do so; indeed, this may have violated the Board's duty to remain impartial. It is the duty of a party to bring its case.

29. Moreover, the petitioner's argument that the same arguments presented in support of the main request should have been re-examined in depth when deciding on the admittance of the auxiliary request runs counter to the concept of "prima facie" allowability, which implies a relatively superficial examination as opposed to a full and thorough examination of a given issue. Notwithstanding the fact that it is not down to the Enlarged Board in petition proceedings to generally review the principles of the case law on admittance under Article 13(1) or (2) RPBA, the EBA finds no fault with the boards' established approach, namely that the prima facie allowability of a request may well constitute a relevant, and as such one possible admittance criterion, among other possible criteria as developed in the case law on the admittance of new requests; see CLBA, chapters V.A.4.4.5 and V.A.4.5.10, or V.A.5.12 on the case law under the RPBA 2007.
  
30. It was also not necessary for the Board to consider each and every argument raised by the parties in detail for the question of the admittance under Article 13(1) RPBA. In the present case, there was no apparent need for the Board to discuss the question of inventive step once more in depth, and even less to examine the



requirements of Article 123(2) EPC. The factual basis of its decision, namely that the proprietor did not provide any arguments as to why the amendments to the auxiliary request overcame the lack of inventive step as found for the main request, appears to be undisputed. The petitioner itself states that "*... the Respondent did not file new arguments in the Oral Proceedings ...*" (petition, page 5, third paragraph). This is consistent with its reply of 6 July 2021, in which it submitted that the inventive step arguments were the same as for the main request (see point VII. above).

31. The EBA's assessment set out in paragraphs 28-30 above is essentially identical to the reasons set out in paragraphs 26-29 of the EBA's communication. The petitioner did not comment further on these reasons, either in its reply to the communication or during the oral proceedings. The EBA therefore concludes that the petitioner has had the opportunity to comment on the Board's reasoning, namely the criterion of prima facie allowability with respect to inventive step, and that the requirements of Article 113(1) EPC have been met.
  
32. The EBA takes note of the argument put forward during the oral proceedings that the situation was surprising for the proprietor because, contrary to expectations, the Board had not issued a communication under Rule 100(2) EPC, and the absence of such a communication also meant that the proprietor was not granted a time limit under that rule to file observations on the Board's communication. This argument is also a new submission within the meaning of Article 12(1) RPEBA, and no special reason is apparent that could justify its admittance. At no point does the petition mention that the proprietor's surprise was in

any way based on, or merely enhanced by, an expected communication under Rule 100(2) EPC that failed to materialise, in addition to the Board's "new Article 123(2) objection".

33. Again, notwithstanding the consideration of this argument under Article 12(1) RPEBA, the EBA fails to see its relevance for the second ground for petition. Even in the absence of a time limit, the proprietor was not prevented from submitting the auxiliary request and the corresponding arguments in good time before the oral proceedings before the Board. Nor does the EBA see why the Board should have applied the provisions of Article 13(1) and (2) RPBA differently if the Board's communication had been formally sent under Rule 100(2) EPC instead of Article 15(1) RPBA. The perceived unfairness of the situation caused by the application of the RPBA and the absence of a formal communication under Rule 100(2) EPC could not have affected the second ground for petition - either the issue of the undecided request or the violation of Article 113(1) EPC resulting from the allegedly ignored inventive step arguments. Surprised or not, the proprietor had the opportunity to comment on the issue of inventive step and the prima facie allowability of the auxiliary request under Articles 56 and 123(2) EPC. The proprietor could not legitimately expect that the admittance of the auxiliary request would be decided solely on the question of added subject-matter, without any consideration of the other requirements of the Convention. The perceived unfairness of the procedural situation has no bearing on the question of what may constitute a "relevant request" within the meaning of Rule 104(b) EPC.

34. In summary, the first ground for petition is clearly inadmissible and the second ground for petition is clearly unallowable. The petition as a whole is thus clearly unallowable and is to be rejected as such under Article 112a(5), first sentence, and Rule 109(2) (a) EPC.

## **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