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**Datasheet for the decision
of 25 August 2023**

Case Number: R 0013/22

Appeal Number: T 0990/16 - 3.3.01

Application Number: 10748195.4

Publication Number: 2430454

IPC: G01N33/68, G06T7/00, G06T7/20,
G06K9/00, C12N5/073

Language of the proceedings: EN

Title of invention:

IMAGING AND EVALUATING EMBRYOS, OOCYTES, AND STEM CELLS

Patent Proprietor:

The Board of Trustees of the Leland Stanford
Junior University

Opponents:

Unisense FertiliTech A/S
European Society of Human Reproduction & Embryo-
logy(BE)/Sterckx, Sigrid(BE)/Cockbain, Julian
Roderick Michaelson(BE)/Pennings, Guido (BE)

Headword:

Petition for review

Relevant legal provisions:

EPC Art. 53, 107, 112a(1), 112(1)(a), 112a(2)(c), 112a(2)(d),
113(2)

EPC R. 106, 115(2)

Keyword:

Petition for review - clearly inadmissible (yes)

Adversely affected by revocation of patent (no)

Oral proceedings - Violation of right to be heard by
cancellation of oral proceedings (no)

Referral to the Enlarged Board of Appeal - Violation of right
to be heard by refusal to refer question to Enlarged Board of
Appeal (no)

Decisions cited:

G 0003/98, T 0186/84, T 0520/01, T 0154/04, T 0193/07,

T 0547/08, T 1569/11, T 2136/16, T 2434/18

Catchword:



Große Beschwerdekammer
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Grande Chambre de recours

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Case Number: R 0013/22

D E C I S I O N
of the Enlarged Board of Appeal
of 25 August 2023

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Decision under review: **Decision of the Technical Board of Appeal 3.3.01
of the European Patent Office of 1 June 2022.**

Composition of the Board:

Chairman I. Beckedorf
Members: D. Rogers
 R. Lord

Summary of Facts and Submissions

- I. The petition for review ("Petition") concerns appeal proceedings T 0990/16 of Board of Appeal 3.3.01 ("the Board"). Appeals were lodged by opponent 2 (hereafter "Petitioner") and opponent 1 against the decision of the opposition division to maintain the patent in amended form. Although opponent 2/the Petitioner is more than one entity, they will be referred to in the singular in this decision.
- II. On 6 October 2021 the Board summoned the parties to oral proceedings on 27 April 2022. On 25 March 2022, the respondent-proprietor stated that it no longer approved the text of the patent and would not be submitting an amended text.
- III. In a letter dated 29 March 2022, the Petitioner stated that it did not withdraw its appeal, and that it maintained its request for a decision on its objections under Article 53 EPC and the referral of some questions to the Enlarged Board of Appeal.
- IV. In a communication dated 12 April 2022, the Board referred to the Petitioner's letter of 29 March 2022. The Board stated that holding oral proceedings would have no legitimate aim, and that they could be cancelled. Despite the absolute nature of the right to oral proceedings set out in Article 116 EPC, there was no need to hold oral proceedings in the circumstances of the case. The Board stated that as there was no agreed patent text, the decision of the Board would be to revoke the patent without consideration of substance. In such a case, there was no need to refer questions to the Enlarged Board of Appeal.

V. The Petitioner replied to the 12 April 2022 communication in a letter dated 11 April 2022. This mismatch of dates is explained by the fact that the communication was sent in advance by email on 11 April 2022 and the Petitioner responded immediately. The Petitioner stated that it maintained its request for oral proceedings and referred to the wording of Article 116 EPC, which requires that oral proceedings "shall" take place if a party so requests. The Petitioner stated that cancelling the oral proceedings would be a fundamental violation of its right to such proceedings - see para 3 of 11 April 2022 letter.

VI. The requests the opponent-appellants (including the Petitioner) made before the Board as regards oral proceedings are as follows:

In its notice of appeal dated 22 April 2016 the Petitioner (then OPP002-appellant) requested "... revocation of the European Patent...".

At point 5 of its grounds of appeal dated 21 June 2016, the Petitioner stated that oral proceedings were requested:

"... should its request for revocation of the Opposed Patent not be accepted beforehand".

In its notice of appeal, opponent 1, the other appellant before the Board stated:

"We hereby request oral proceedings should the Board of Appeal intend to maintain the patent in its current form or any other form."

In its grounds of appeal, opponent 1 stated:

" We request that the patent is revoked in its entirety. We hereby request oral proceedings should

the Board of Appeal intend to maintain the patent in any form".

VII. The Petitioner filed another letter dated 17 April 2022. This concerned the referral of questions to the Enlarged Board of Appeal.

VIII. On 22 April 2022, the Board informed the parties that the oral proceedings, scheduled for 27 April 2022, had been cancelled.

IX. The decision in case T 0990/16 ("the Decision") was issued under cover of a letter dated 8 June 2022. In the absence of a text for the maintenance of the patent approved by the respondent-proprietor, the Decision ordered the revocation of the patent.

X. The Board's decision sets out in paras 1 to 3 the standard decision for revoking a patent when there is no agreed text. The rest of the decision, paras 4 to 11 deals with the cancellation of the oral proceedings. The Board first notes, para 5, that the Petitioner's request for oral proceedings was conditional on its request for revoking the patent not being accepted. Given that the Board's decision was to revoke the patent, there was therefore no need to hold oral proceedings, see para 6 of the Decision.

XI. The Board then goes on to consider the possibility that the Petitioner's 11 April 2022 letter constitutes an unconditional request for oral proceedings. Even in such a case the Board considered that "...there is no obligation to hold oral proceedings in the current circumstances despite the absolute nature of the right to oral proceedings under Article 116(1) EPC" - see para 7 of the Decision.

XII. The Board went on in para 8 of the Decision to justify the above statement. The only issue that the Petitioner wished to discuss at the oral proceedings before the Board was a referral of a question on Article 53 EPC to the Enlarged Board. However, as there was no agreed text, there was no basis upon which the Board could consider either Article 53 EPC, or the need for a referral. Any question on Article 53 EPC would be hypothetical and without relevance to the case. Article 113(2) EPC does not permit a board to refer questions of fundamental legal importance in the absence of a valid text. To do so would be against the requirements of Article 112(1)(a) EPC.

XIII. The Board goes on to dismiss the Petitioner's argument that Article 53 EPC is a higher norm that takes precedence over the other articles of the EPC - see para 9 of the Decision.

XIV. The Board further sets out that it considers the Petitioner's request for oral proceedings to be a misuse of Article 116(1) EPC:

"...It cannot be the purpose of Article 116 EPC and Rule 115(2) EPC that a party may oblige a board to hold oral proceedings in which the matter raised by that party cannot be discussed at all... In such a case, a party has no legitimate interest in pursuing its request for oral proceedings. Insisting on them amounts to a breach of that party's duty to act in good faith... Indeed, no serious or legitimate interest exists in the current circumstances for holding oral proceedings, and the procedural right to oral proceedings under Article 116(1) EPC would thus be exercised for a purpose other than its intended legal aim. Such an abuse of right under Article 116(1) EPC deserves no

protection, a board is under no obligation to accede to a request for oral proceedings which constitutes such an abuse" - (see para 10 of the Decision).

XV. On 20 June 2022, the Petitioner filed a petition for review. The Petition is based on Article 112a(2)(c) and (d) EPC.

XVI. The Petitioner argues that it was adversely affected by the Decision. Although the Decision resulted in the revocation of the patent, the oral proceedings requested by the Petitioner did not take place, the Board's decision did not address the Petitioner's Article 53 EPC objection to the patent, and the Board did not refer questions to the Enlarged Board - (see para 3 of the Petition). In paras 12 to 21 of its Petition, the Petitioner sets out why the referral of its questions to the Enlarged Board is important, and how the tactic of a patent proprietor withdrawing consent to a text should not be used to prevent important questions being considered by the Enlarged Board.

XVII. The Petitioner indicates that it raised an objection under Rule 106 EPC, see para 5 of the Petition, where it is stated:

"The case laws of the Enlarged Board indicates that a petitioner should have indicated that the behaviour of the Technical Board is such that a petition might need to be filed if a decision is given. This was done in the letters to the Board in 2022 when the possibility of oral proceedings being cancelled was first raised by the Board after the Patentee had withdrawn its consent to the patent text".

XVIII. The Petitioner filed three letters after the proprietor withdrew its consent to the text of the patent. These are the letters dated 29 March 2022, 11 April 2022 and 17 April 2022.

XIX. The 29 March 2022 letter states that the Petitioner does not withdraw its appeal and maintains its request for a decision on its Article 53 EPC objection and its request for the referral of questions to the Enlarged Board. The Petitioner stated in the last paragraph that it "...will attend the oral proceedings as arranged..".

XX. In its 11 April 2022 letter the Petitioner points out that Article 116(1) EPC gives an absolute right to requested oral proceedings, and that cancelling such oral procedures is a violation of this right. The Petitioner stated at paragraph 3 that:

"With utmost respect, Article 116(1) EPC states incontrovertibly that "Oral proceedings shall take place...at the request of any party to the proceedings." OPPO02 has made and maintained a request for oral proceedings and to ignore that and cancel the oral proceedings would be a fundamental violation of OPPO02's right to such proceedings."

XXI. The Petitioner also pointed out that, as of 11 April 2022, the appeal proceedings were still continuing and that:

"...under Article 112(1)(a) EPC, the Board *shall* refer questions to the Enlarged Board (following the request already made and maintained by OPPO02) 'if it considers a decision is required' and if it 'rejects the request, it shall give the reasons in its final decision'".

The Petitioner then went on to discuss the importance of the questions it wished to refer to the Enlarged Board.

XXII. In its letter of 17 April 2022, the Petitioner argues that a referral of a question under Article 112(1)(a) EPC is not restricted to the reaching of a final decision in the appeal itself. The Petitioner further argues that the requirement under Article 113(2) EPC, that the EPO shall only decide upon a text submitted to it or agreed by the proprietor of a patent, does not prevent a board from referring a question of fundamental legal importance to the Enlarged Board before reaching its final decision.

XXIII. The Enlarged Board sent a communication dated 7 December 2022 setting out its preliminary views on the case. The Petitioner replied to this communication in a letter dated 21 March 2023 (the "Reply").

XXIV. In its Reply, the Petitioner argues that its objections to the cancellation of the oral proceedings can be considered as Rule 106 EPC objections, there is no requirement to make a literal reference to Article 112a EPC and/or Rule 106 EPC (para 14 of the Reply).

XXV. In its Reply, the Petitioner further argues that it was adversely affected by the Decision as it did not simply want to argue that the patent be revoked, but that the patent be revoked under Article 53 EPC.

XXVI. At para 27 of the Reply, the Petitioner withdrew "...any request for oral proceedings in relation to the admissibility and allowability of the Petition but

maintains the request in relation to the substantive matters raised in the Petition".

XXVII. In the light of the Petitioner's withdrawal of its request for oral proceedings, the Enlarged Board cancelled the oral proceedings.

XXVIII. In an email dated 26 April 2023, the Petitioner stated:

"The recent letter from you confirming the cancellation of the oral proceedings has been received. Please note that I DID NOT WITHDRAW MY REQUEST FOR ORAL PROCEEDINGS. I only withdrew the request as it related to the current stage of the petition proceedings."

XXIX. In the light of the Petitioner's email of 26 April 2023, the Enlarged Board re-instated the oral proceedings. Oral proceedings were held on 25 August 2023.

XXX. At the oral proceedings before the Enlarged Board, the Petitioner, for the first time, advanced an argument that Article 113(2) EPC did not provide a basis for the revocation of a patent in the absence of an agreed text. This argument was advanced to support the Petitioner's position that it was adversely affected by the Board's decision to revoke the patent. The text of Article 113(2) EPC states that:

"The European Patent Office shall examine, and decide upon, the European patent application, or the European patent, only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent".

XXXI. The Petitioner argued that the second "or" in the above text meant that because there was a "text submitted [to

the EPO]", that of the patent as granted, the Board had to make a decision on whether this text complied with the EPC, the "or" meant that it was irrelevant whether the proprietor still agreed to this text, so that the Board should have decided on the patent as granted even if the proprietor no longer agreed to it.

XXXII. The Petitioner was adversely affected by the Board simply revoking the patent, rather than doing so after checking for compliance with the provisions of the EPC. The adverse effect arose because the Petitioner was deprived of the chance to have a decision on its Article 53 EPC objections to the patent, and to have questions referred to the Enlarged Board.

XXXIII. The requests of the Petitioner as indicated in para 11 of the Petition are set out verbatim below:

"Accordingly, we petition you to do the following:

- (i) Refund the petition fee;
- (ii) Appoint oral proceedings where we will present our case to you in English;
- (iii) Return the case to the Technical Board of Appeal to be re-decided (after oral proceedings);
- (iv) Set out in your decision the questions that we asked to be referred to the Enlarged Board so that they find mention in the case law of the EPO;
- (v) Condemn the procedure used by Boards of Appeal to shut down discussion on important points of law if the Patentee so desires it;
- (vi) Require the Board of Appeal to be reconstituted with entirely different members to reconsider the case; and
- (vii) Suggest to the newly reconstituted Board that the questions that we asked to be put to the Enlarged Board indeed be put."

Reasons for the Decision

1. Article 112a(1) EPC states that:

“Any party to appeal proceedings adversely affected by the decision of the Board of Appeal may file a petition for review...”

Article 107 EPC states:

“Any party to proceedings adversely affected by a decision may appeal...”

The Enlarged Board sees no reason to give “adversely affected” in Article 112a(1) EPC a different meaning from that given to it in Article 107 EPC. The case law on “adversely affected” and Article 107 EPC is thus of relevance to the interpretation of this term in Article 112a(1) EPC.

2. The Petitioner argues that it was adversely affected by the non-consideration in the Decision of its Article 53 EPC objection and the non-referral of questions to the Enlarged Board - see para 3 of the Petition.
3. Articles 112a(1) and 107 EPC both refer to the adverse effect being from a/the decision, not the reasoning set out in the decision. The Decision was to revoke the patent.
4. The Board's decision to revoke the patent was thus fully in line with the requests of the Petitioner during the appeal proceedings.

5. The patent has been revoked due to the patentee withdrawing its approval of the patent text. As stated in T 2434/18 at point 4 of the reasons:

“Furthermore, as clarified in decision T 186/84, the examination as to whether the grounds for opposition laid down in Article 100 EPC prejudice the maintenance of the patent becomes not merely superfluous but impossible since the absence of a valid text of the patent precludes any substantive examination of the alleged impediments to patentability.”

The Enlarged Board considers this to be a correct statement of the law on this subject. The Board was no longer in a position to consider the Petitioner's Article 53 EPC objections in the absence of a valid text.

6. For a board to refer questions to the Enlarged Board of Appeal under Article 112a EPC certain conditions need to be fulfilled. Amongst these conditions is that the referral questions must not have merely theoretical significance. An example of such theoretical questions would be if the board could reach the same decision regardless of the answer (see G 3/98, para 1, and T 547/08, para 4, last para). Some further conditions are that the questions must be relevant for deciding the case in question (see T 2136/16, para 8.1 to 8.3); and that the answer to the referred questions must be essential for the board to reach a decision on the appeal in question (see T 154/04, para 2).
7. None of these conditions apply in the present case. The Board was able to revoke the patent without needing an

answer to the referral questions submitted by the Petitioner.

8. Also pertinent to the present case are T 520/01, T 193/07 and T 1569/11. In T 520/01, para 4.1, the board, referring to G 3/98, para 1, did not maintain the patent on grounds other than those to which the question related, and thus refused the party's referral request.
9. In T 193/07, an issue was whether the opponent 2-appellant II could be an appellant when the decision it was appealing against had revoked the patent. The opponent 2-appellant II objected to the non-treatment of its novelty objection by the opposition division, which had revoked the patent on other grounds. Opponent 2-appellant II sought a wide interpretation of the term "adversely affected" in Article 107 EPC, one that was not limited to a loss of rights but "open for case law to take care of the specific circumstances of each case" - see para XIV of T 193/07.
10. In T 193/07, the board noted that the opposition division had revoked the patent, which fully complied with the request of opponent 2. The board considered that a party is only adversely affected if the order of the appealed decision does not comply with its request. Hence, in T 193/07, the opponent 2-appellant II was not adversely affected - see para 2.1.2. In reaching this conclusion, the board was following the case law of the boards, according to which, in cases where the order of the decision of the opposition division is the revocation of the patent, an opponent who requested revocation of the patent in its entirety is not "adversely affected by" said decision within the meaning of Article 107 EPC, irrespective of the reasons given in the decision - see para 2.3 of T 193/07.

11. In T 1569/11, the opposition division revoked the patent. This was fully consistent with the request of the opponents in the opposition procedure that the patent be revoked in its entirety. Opponents I and III were thus not adversely affected, and their appeals were inadmissible - see T 1569/11, para 1.1. The patent was revoked under the ground of opposition of Article 100(b) EPC, whereas the opponents wished to see it revoked under the ground of opposition of Article 100(c) EPC, a ground of opposition that the opposition division found not to prejudice the maintenance of the patent. The board in T 1569/11 considered that the opponents' appeals demonstrated a misunderstanding of the nature and purpose of opposition appeal proceedings, which are not to re-examine a patent but to decide whether or not a first instance decision is correct - see T 1569/11, para 1.2.

12. Therefore even if the oral proceedings had been held, there would have been no possibility of discussing the Article 53 EPC objections, or a need to refer questions to the Enlarged Board of Appeal.

13. Turning now to the Petitioner's adversely affected argument based upon Article 113(2) EPC, that was presented for the first time at the oral proceedings before the Enlarged Board. This is a further refinement of the Petitioner's arguments that an opponent can be adversely affected by the revocation of a patent if the revocation decision does not deal with its actual objections to the patent. This argument has already been dealt with above. Even if the Enlarged Board were to accept the Petitioner's interpretation of Article 113(2) EPC, the Petitioner would be suggesting that an opponent can be adversely affected by an erroneous interpretation of the EPC that leads to the revocation of the patent. The Enlarged Board

disagrees, such a situation would not adversely affect an opponent, if the consistent approach to "adversely affected", set out in the case law discussed above, is followed. The Enlarged Board thus finds this new argument of the Petitioner unconvincing.

14. The Enlarged Board is thus of the view that the non-holding of the oral proceedings, the non-consideration of the Article 53 EPC objection, and the non-referral of questions to the Enlarged Board of Appeal cannot be considered to have resulted in any prejudice to the Petitioner that would lead to the Petitioner being adversely affected by the decision to revoke the patent within the meaning of Article 112a(1) EPC.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:



N. Michaleczek

I. Beckedorf

Decision electronically authenticated