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**Datasheet for the decision
of 8 November 2024**

Case Number: R 0004/23

Appeal Number: T 0088/21 - 3.3.05

Application Number: 16751065.0

Publication Number: 3325419

IPC: C03C3/091, C03C3/093,
C03C3/097, C03C21/00, B32B17/10

Language of the proceedings: EN

Title of invention:

GLASS ARTICLES EXHIBITING IMPROVED FRACTURE PERFORMANCE

Applicant:

Corning Incorporated

Headword:

Petition for review

Relevant legal provisions:

EPC Art. 54(2), 54(3), 87(1), 112a(1), 112a(2)(c), 112a(4),
113(1), 123(2)
EPC R. 106, 107, 109(2)(a)
RPEBA Art. 13, 14(2)

Keyword:

Petition for review - clearly unallowable
Fundamental violation of Article 113(1) EPC (no)

Decisions cited:

R 0001/08, R 0015/12, R 0008/13, R 0016/13, R 0008/17,
G 0001/03, G 0002/10, G 0001/15, G 0001/16, T 0248/88,
T 0015/01, T 1222/11, T 1872/14



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Case Number: R 0004/23

D E C I S I O N
of the Enlarged Board of Appeal
of 8 November 2024

Petitioner: Corning Incorporated
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Decision under review: **Decision T 88/21 of the Technical Board of
Appeal 3.3.05 of the European Patent Office of
15 November 2022**

Composition of the Board:

Chairman C. Josefsson
Members: M. Blasi
T. Häusser

Summary of Facts and Submissions

- I. The petition for review (petition) concerns decision T 88/21 of Technical Board of Appeal 3.3.05 (Board), which was pronounced at the oral proceedings of 15 November 2022 and dispatched as a written reasoned decision on 7 February 2023. In that decision, the Board dismissed the appeal against the examining division's decision refusing European patent application No. 16 751 065.0.

- II. The appellant-applicant (petitioner) filed the petition on 3 April 2023 and paid the required fee on the same date. The petition is based on Article 112a(2)(c) EPC. In the petitioner's opinion fundamental violations of its right to be heard under Article 113(1) EPC occurred since the decision's written reasoning was based on grounds on which the petitioner had had no opportunity to comment. The petitioner thus requested that decision T 88/21 be set aside and the proceedings before the Board be re-opened. As an auxiliary measure, oral proceedings were requested.

- III. The parts of the written reasoned decision criticised by the petitioner relate to the Board's reasoning concerning the allowability of a claim containing an undisclosed disclaimer and the rejection of a requested referral to the Enlarged Board of Appeal (Enlarged Board).
 - (a) The question of whether the claims of the main (and sole) request complied with Article 123(2) EPC in light of the undisclosed disclaimer in claim 1 "with the proviso that the glass article (300) is not a glass article according to Examples 4A, 4B,

4C, 4D or 5A of EP 3 204 338 A2" (D1, published as WO 2016/057787) had been the central point at issue in the appeal proceedings leading to the decision under review.

- (b) The same issue had been the sole matter considered in the decision under appeal. In that decision, the examining division had concluded that the main request did not meet the requirements of Article 123(2) EPC in view of the undisclosed disclaimer which had been introduced into claim 1 to exclude subject-matter disclosed in patent document D1 - another patent application filed by the petitioner. The earliest priority claimed was considered invalid because an even earlier application, from which D1 claimed priority, was considered the first application within the meaning of Article 87(1) EPC for some of the subject-matter disclaimed in claim 1. Consequently, earlier application D1, published before the filing date of the application in suit, was state of the art under Article 54(2) EPC and its disclosure could not be disclaimed in accordance with decisions G 1/03 and G 2/10 of the Enlarged Board without infringing Article 123(2) EPC. The examining division considered its view supported by decision T 1222/11 and saw no reason to come to a different opinion despite decision T 1872/14.
- (c) On appeal, the petitioner had disputed this finding and further pursued the set of claims as considered in the contested decision. Like before the examining division, the petitioner maintained the view that when assessing the amendment (in this case the introduction of the undisclosed disclaimer), the claims in hand should be looked

at, not the claims before the introduction of the disclaimer. In line with decision T 1872/14, the validity of the claimed priority should be assessed while taking the disclaimer into account. The examining division and the board in decision T 1222/11 had erred in their approaches. As the claimed priority was valid, D1 formed state of the art under Article 54(3) EPC only. The disclaimer in claim 1 fulfilled the requirements set out in Enlarged Board decision G 1/03 and was not in breach of Article 123(2) EPC. The petitioner was of the view that, due to the diverging case law, the Board should refer one or more questions to the Enlarged Board.

- (d) In its communication under Article 15(1) RPBA, issued in preparation for oral proceedings, the Board set out its preliminary opinion. The Board essentially concurred with the examining division as regards the validity of the claimed priority and as regards the finding that document D1 was state of the art under Article 54(2) EPC and that, due to the disclaimer, the claim at issue was not allowable in light of Article 123(2) EPC. It relied on Enlarged Board decisions G 1/03, G 1/15 and G 1/16 and considered various board of appeal decisions, including T 1222/11 and T 1872/14, finding that it was following the established case law and that there did not seem to be any contradicting decisions.
- (e) At oral proceedings before the Board, the appellant was heard on the requirements of Article 123(2) EPC with regard to the main request, with a focus on whether the claimed priority was valid and whether the introduction of the undisclosed disclaimer was

in line with said provision. The request for a referral to the Enlarged Board was also addressed.

(f) In the written reasoned decision, the Board set out its reasoning and explained why it did not agree with the petitioner's approach.

- IV. The Enlarged Board, in its composition pursuant to Rule 109(2)(a) EPC, summoned the petitioner to oral proceedings and issued a communication pursuant to Article 13 and Article 14(2) RPEBA.
- V. The petitioner made further submissions in writing in advance of the oral proceedings, essentially reiterating its position.
- VI. Oral proceedings before the Enlarged Board took place on 8 November 2024, during which the petitioner presented its point of view and requested that decision T 88/21 be set aside and the proceedings before the Board be re-opened. At the end of the oral proceedings, the present decision was announced.
- VII. The petitioner's case is summarised as follows.

The Board violated the petitioner's right to be heard by basing its decision on grounds that were not communicated to the petitioner and on which the petitioner had had no opportunity to comment.

(a) In point 1.6 of the Reasons of the decision, the Board based its considerations as to why the introduced undisclosed disclaimer was not allowable on a specific reading of the first part of point 2.1 of the order of decision G 1/03.

The Board interpreted the wording of this passage such that the term "restore" meant that the addition of the disclaimer occurred when a novelty objection actually applied, i.e. when the prior art document was prior art under Article 54(3) EPC against a notional claim without the disclaimer.

In addition, the Board presented for the first time in the written reasoned decision the argument that if decision G 1/03 were to support the petitioner's argument, it would have to read as follows:

"A disclaimer may be allowable ~~in order to~~:
- ~~restore~~ if it has restored novelty by delimiting a claim against state of the art which, following the addition of the disclaimer, has become state of the art under Article 54(3) EPC."

The petitioner had no opportunity to comment on either the Board's interpretation of the order of G 1/03 as set out above, or its line of argument.

- (b) In point 2 of the Reasons of the decision, the Board specified that a referral to the Enlarged Board was not necessary "*in view of an isolated non-uniform decision*" and referred in particular to decisions T 15/01 and T 248/88.

This was the first time the Board had put forward this line of reasoning, and the first time the two decisions had been cited. The petitioner had no opportunity to comment on the Board's interpretation as set out above.

Reasons for the Decision

Admissibility of the petition

1. The petition is not clearly inadmissible.
2. It meets the requirements of Article 112a(1) and (4) EPC in conjunction with Rule 107 EPC.
3. Pursuant to Rule 106 EPC, a petition for review is only admissible where the objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the board of appeal, except where this objection could not be raised during the appeal proceedings.
4. The Enlarged Board accepts that the petitioner, as submitted in the petition, did not become aware of the aspects constituting the cause of the asserted violations of the right to be heard until it received the written reasoned decision, meaning that an objection under Rule 106 EPC could not have been raised during the appeal proceedings.

Allowability of the petition

5. However, the petition is clearly unallowable. The Enlarged Board does not agree that the petitioner's right to be heard was violated by the Board as the petitioner contends.
6. Pursuant to Article 113(1) EPC, decisions of the European Patent Office, including the boards of appeal, may only be based on grounds or evidence on which the parties concerned have had an opportunity to present

their comments. This implies that a party must not be taken by surprise by the reasons for the decision, referring to unknown grounds or evidence. "Grounds or evidence" under Article 113(1) EPC ("Gründe" in the German text and "motifs" in the French text) is to be understood as the essential legal and factual reasoning on which a decision is based (see also R 8/17, Reasons 15; R 16/13, Reasons 3.3). A party has to have an opportunity to comment on the decisive aspects of the case.

7. On the other hand, the deciding board must be able to draw its own conclusions from the discussion of the grounds put forward (see also R 8/17, Reasons 16; R 16/13, Reasons 3.3 with further references). Thus, the right to be heard does not go so far as to impose an obligation on a board to disclose in advance to the parties how and why, on the basis of the decisive issues under discussion, or at least those foreseeable as the core of the discussion, it will come to its conclusion. This is part of the reasoning given in the written decision (see also R 8/17, Reasons 16; R 8/13 of 15 September 2015, Reasons 2; R 15/12, Reasons 5; R 1/08, Reasons 3.1).
8. In the case in hand, the Enlarged Board cannot establish that a fundamental violation of the petitioner's right to be heard occurred as asserted by the petitioner.
9. First alleged violation of the right to be heard

As to the asserted first violation of the right to be heard ("(a)" in section VII. above), the following is noted.

9.1 In its communication under Article 15(1) RPBA dated 2 May 2022, the Board had summarised the petitioner's line of argument in point 6.2, according to which the "*subject-matter remaining in the claim after taking the disclaimer into account*" was relevant and the introduction of the disclaimer was considered "*allowable according to G 1/03*". The Board then set out its own approach in point 6.3, focusing on the subject-matter "*before*" the disclaimer was introduced. This led to the finding that document D1 was prior art under Article 54(2) EPC and that, since this document was not an accidental disclosure, the criteria of decision G 1/16 in combination with decision G 1/03 were not fulfilled.

The Board's communication thus included considerations as to whether reference was to be made to the claim with the disclaimer, as argued by the petitioner, or without the disclaimer. The Board took the latter approach and deemed its view to be endorsed by the case law of the boards of appeal, as set out in point 6.4 of said communication under Article 15(1) RPBA.

9.2 In subsequent point 6.5 of the Board's communication under Article 15(1) RPBA, the Board addressed the Enlarged Board decisions G 1/16 and G 1/03. It made reference to the use of the word "*triggering*" in decision G 1/16 in support of its position that the allowability of the disclaimer was to be considered on the basis of the wording of the claim in the absence of the disclaimer.

In this point 6.5 the Board stated that:

"G 1/16 confirms the principles established in G 1/03 and clarifies that what is relevant is the prior art

triggering the introduction of the undisclosed disclaimer (reasons 46.3; emphasis added), and thus not the nature of this prior art subsequent to introducing the disclaimer. Furthermore, G 1/15 and T 282/12 support the above-mentioned conclusion in this case that D1 is prior art pursuant to Article 54(2) EPC before introducing the disclaimer, i.e. when triggering its introduction. This is in contrast with T 1872/14, which considers ... a document corresponding to D1 ... as prior art under Article 54(3) EPC ... G 1/15, T 282/12 and G 1/16 were all issued after T 1872/14, which therefore seems to be outdated in this respect."

Accordingly, in its communication under Article 15(1) RPBA dated 2 May 2022 the Board had informed the petitioner *inter alia* of its view that, according to its understanding of decisions G 1/03 and G 1/16, in order for the undisclosed disclaimer at issue to be allowable, the claim had to be considered without the disclaimer, and that the introduction of the undisclosed disclaimer was allowable if a relevant document was prior art pursuant to Article 54(3) EPC in the absence of that disclaimer.

9.3 The petitioner contends that the statements in point 1.6 of the Reasons of the decision as indicated above (i.e. the Board's interpretation of the first part of point 2 of the order of decision G 1/03 and the argument as to how this passage of the order would have to be construed if the petitioner's point of view were accepted) entail a violation of its right to be heard as it should have been given an opportunity to comment on those statements.

9.4 The Enlarged Board does not agree that, as a result of these statements having been made in the written reasoned decision, a violation of the petitioner's right to be heard had occurred, let alone a fundamental one.

9.5 These explanations form part of the reasoning provided in the written reasoned decision. While the Enlarged Board agrees with the petitioner that the Board used different formulations from the cited communication under Article 15(1) RPBA to express its view, the Enlarged Board does not see how the contested parts would represent surprising reasoning by the Board referring to unknown grounds or evidence. It does not matter that this reasoning surprised the petitioner. What is relevant is whether such reasoning was surprising when seen objectively in light of the circumstances of the specific case.

In the decision, and from the very outset of the appeal proceedings, the core issue was whether or not claim 1 under consideration, into which an undisclosed disclaimer had been introduced, was in conformity with Article 123(2) EPC, thereby taking into account the relevant Enlarged Board decisions, including G 1/03. The Enlarged Board finds that the contested reasoning in the decision is based on the legal and factual framework on which the petitioner had had the opportunity to provide its comments. Said reasoning is reasoning which is objectively foreseeable in light of the circumstances of the specific case.

9.6 As regards the Board's reasoning being surprising, it may also be noted that reference had been made to decision G 1/03 and its "criteria" in the communication under Article 15(1) RPBA (see points 6.2, 6.3(d),

6.4(1) and 6.5). Moreover, in point 6.5 of the communication, the Board made reference to decision G 1/16 and point 46.3 of its Reasons; in point 46, the Enlarged Board is describing - and endorsing - the concept of decision G 1/03.

The preceding point 45 of the Reasons of G 1/16 states that "*[w]hen examining the allowability of a claim amendment by the introduction of an undisclosed disclaimer for compliance with the requirements of Article 123(2) EPC, the following test based on decision G 1/03 is to be applied:*

Such an amendment may be considered allowable under Article 123(2) EPC if the undisclosed disclaimer is introduced in order to

(1) restore novelty by delimiting a claim against state of the art under Article 54(3) EPC within the meaning of G 1/03 (Order, point 2.1, first indent, Reasons, point 2.1 and sub-points); ..."

9.7 It may also be noted in this context that point (18) of the petitioner's submission dated 6 June 2022, submitted after receipt of the Board's communication under Article 15(1) RPBA, reads:

"Furthermore, it is noted that G 01/16 clearly specifies that an undisclosed disclaimer is allowable if it restores novelty over a document under Article 54(3) EPC (see reasons 45). In the present case, the subject matter of claim 1 of the Main Request clearly validly claims priority of D0 as outlined above ... Moreover, the subject matter of claim 1 of the Main Request (i.e. taking into account the disclaimer) has always validly claimed priority ..."

Consequently, D1 is prior art according to Article 54(3) EPC for the subject matter of claim 1 of the Main Request. In addition, it is clear that the disclaimer restores novelty of claim 1 of the Main Request over D1 ..."

- 9.8 In the decision, the Board then provided its reasoning including further details on the understanding of the case law of the Enlarged Board, thereby also addressing the submissions made by the petitioner subsequent to the communication under Article 15(1) RPBA.
- 9.9 Therefore, while acknowledging that there may be a difference from what had been communicated to the petitioner in the communication under Article 15(1) RPBA, the Enlarged Board fails to see that the reasoning provided in point 1.6 of the Reasons of the decision under review is based on grounds or evidence on which the petitioner had had no opportunity to provide comments.
- 9.10 The petitioner suggested that the reason why the Board did not repeat in the written reasoned decision the considerations relating to "*triggering*" as initially set out in point 6.5 of the communication under Article 15(1) RPBA was that the Board had found the petitioner's arguments in the letter dated 6 June 2022 convincing.

This is, however, speculation on the petitioner's part as there is no explicit acknowledgement by the Board to this effect in the decision. A board may, within the limits of Article 113(1) EPC, choose which reasoning it provides in the written reasoned decision and is not required to comprehensively provide all of its

considerations, or any parallel lines of reasoning, for its decision on one and the same issue.

- 9.11 In its submissions dated 13 October 2024, the petitioner expressed its view that the case in hand was analogous to that on which decision R 16/13 was based.

The Enlarged Board agrees with the approach expressed in that decision that the right to be heard is respected if a party had the opportunity to comment on the decisive considerations of the case and the relevant passages of the prior art on which a decision is based (see, for example, R 16/13, Reasons 3.3 and 5.2) and that the right to be heard is violated if a board of appeal bases its decision on grounds or evidence not presented during the proceedings, without giving the parties an opportunity to comment on them (see R 16/13, Catchword and Reasons 4.1).

However, the Enlarged Board refrains from attempting to draw analogies with other cases. Each case under consideration is to be assessed, and decided upon, in light of the specific circumstances of that case, and the Enlarged Board considers that drawing analogies in this case would be of no avail.

- 9.12 At oral proceedings, the petitioner also suggested that the case in hand should be considered in analogy with a situation concerning a technical document. In a similar vein, however, the Enlarged Board does not consider it useful to formulate considerations on theoretical situations, in particular when not all the details are known.

- 9.13 What the petitioner in this case in fact appeared to be complaining about is that it was not presented with the

draft of the written reasoned decision on which it could make further comments. However, as set out above, the Board was not obliged to disclose to the petitioner in advance how and why, on the basis of the decisive issues under discussion, it will come to its conclusion. For compliance with Article 113(1) EPC, it was required, but also sufficient, that the petitioner had had the opportunity to comment on the grounds and evidence on which the decision and the reasons are based. This opportunity had been provided as regards the issues addressed by the Board's considerations in point 1.6 of the Reasons of the decision, objected to by the petitioner.

10. Second alleged violation of the right to be heard

As to the asserted second violation of the right to be heard ("(b)" in section VII. above), the following is noted.

10.1 In the communication pursuant to Article 15(1) RPBA dated 2 May 2022, the Board had informed the petitioner as follows (see point 6.6 of the communication):

"As the board follows the established case law and as there seems to be no contradicting case law, there is no room for a referral to the Enlarged Board."

10.2 In the letter dated 6 June 2022, submitted after receipt of said communication, the petitioner highlighted in point (24) *"that, contrary to the opinion of the Board, there is no established case law"* on the question at issue. *"Rather, there are three decisions by the Board of Appeal with one being in favour of the admissibility and two against. Contrary to the opinion of the Board none of the decisions of*

the Enlarged Board of Appeal address this issue be it explicitly or implicitly."

- 10.3 In point 2 of the Reasons of the Board's decision, dealing with the petitioner's request to refer questions to the Enlarged Board, the Board then stated:

"However, as the board has followed G 1/15 and G 1/16 and the relevant case law (also) subsequent to these Enlarged Board of Appeal decisions, and as there was no subsequent contradicting case law under comparable circumstances, there is no room for a referral to the Enlarged Board of Appeal to ensure uniform application of the law, which in any case would not be necessary in view of an isolated non-uniform decision (see T 15/01, Reasons 40 and T 248/88, Reasons 3.3 holding that a single and isolated non-uniform decision does not qualify under Article 112(1)(a) EPC)."

- 10.4 The Enlarged Board cannot establish any violation of the right to be heard as asserted under point (b) in section VII. above associated with point 2 of the Reasons of the decision either.

- 10.5 In the written reasoned decision, the Board explained *inter alia* how it understood the relevant decisions of the Enlarged Board, concluding that the question at issue could be answered on the basis of those Enlarged Board decisions. It assessed the relevant board of appeal decisions and concluded that *"there was no subsequent contradicting case law under comparable circumstances"*.

- 10.6 Accordingly, the Board did not agree with the petitioner's opinion that there was conflicting case law on the point at issue. The passage in point 2 of

the Reasons of the decision, objected to by the petitioner, in which the Board made reference to "*an isolated non-uniform decision*" and the two decisions T 15/01 and T 248/88, is merely a subsidiary consideration since it is introduced by the wording "*which in any case would not be necessary*".

11. In sum, the Enlarged Board concludes that the petitioner's right to be heard was not violated as the reasoning in points 1.6 and 2 of the Reasons of the decision, objected to by the petitioner, is based on grounds or evidence on which the petitioner had had an opportunity to provide its comments.

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