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**Datasheet for the decision
of 21 July 2025**

Case Number: R 0018/24

Appeal Number: T 2401/19 - 3.5.04

Application Number: 10816798.2

Publication Number: 2478693

IPC: H04N5/228, A61B1/00, A61B1/05,
A61B17/29, G02B23/24,
H04N5/225, A61B1/005

Language of the proceedings: EN

Title of invention:
SMALL DIAMETER VIDEO CAMERA HEADS AND VISUALIZATION PROBES AND
MEDICAL DEVICES CONTAINING THEM

Patent Proprietor:
Odysight.AI Ltd

Opponent:
Keck, Stephan

Headword:
Petition for review

Relevant legal provisions:

EPC Art. 83, 84, 100(b), 109(2), 112a(1), 112a(4), 112a(2)(c),
113(1), 123(2)

EPC R. 106, 107(2)

RPBA 2020 Art. 12(4), 12(6), 13(1), 13(2)

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 0010/09, R 0006/11, R 0010/11, R 0017/11,

R 0019/11, R 0016/13, R 0006/17, R 0007/21, R 0017/24,

T 0989/15, T 0709/16, T 0752/16, T 0764/16, T 0584/17,

T 0954/17, T 2429/17, T 0995/18



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Case Number: R 0018/24

D E C I S I O N
of the Enlarged Board of Appeal
of 21 July 2025

Petitioner:
(Patent Proprietor)

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Decision under review:

Decision of the Technical Board of Appeal 3.5.04
of the European Patent Office of
5 February 2024.

Composition of the Board:

Chairman C. Josefsson
Members: E. Mille
E. Bendl

Summary of Facts and Submissions

I. The petition for review concerns decision T 2401/19 of Technical Board of Appeal 3.5.04 ("Board") of 5 February 2024. In this decision, the Board dismissed the appeal of the patent proprietor against the decision of the opposition division to revoke the European patent N° 10816798.2.

II. The appellant ("petitioner") filed a petition for review of the above decision in due time. The petition was based on the ground that fundamental violations of its right to be heard under Article 113(1) EPC (Article 112a(2)c) EPC) allegedly occurred during the appeal proceedings. The petitioner requested that decision T 2401/19 be set aside and that the proceedings before the Board be re-opened.

III. The Enlarged Board in its composition pursuant to Rule 109(2)(a) EPC summoned the petitioner upon their auxiliary request to oral proceedings and issued a communication pursuant to Article 13 and Article 14(2) RPEBA on 16 June 2025, to which the petitioner did not respond in substance.

IV. The petitioner's case may be summarised as follows:

In sections (1) and (3) of the petition, the petitioner complains that the Board in its preliminary opinion brought forward of its own motion a further Article 83 EPC objection according to which the subject-matter of claim 1 of the main request and of auxiliary requests 1 to 3 comprised a problematic open range of the maximum outer diameter of the claimed video camera head, started the oral proceedings with a discussion on

this issue and concluded that said subject-matter was insufficiently disclosed. This problematic open-ended range objection was raised in the grounds for opposition but not discussed during the first-instance proceedings, the resulting decision did not deal with any Article 100(b) EPC ground for opposition and in its reply to the statement of grounds of appeal of the patent proprietor, the respondent/opponent brought another Article 83 EPC objection. Further to the preliminary opinion of the Board, the patent proprietor filed auxiliary requests 4 to 6 and during the oral proceedings auxiliary requests 7 and 8, in response to the considered argument. Auxiliary requests 4 to 6 and 8 were regarded by the Board as meeting the provisions of Article 13(2) RPBA but not admitted into the appeal proceedings based on Article 13(1) RPBA. Auxiliary request 7 was admitted into the appeal proceedings under Article 13(2) RPBA alone.

The petitioner refers notably in section (2) of the petition to R 16/13, whose catchword reads "The right to be heard under Article 113(1) EPC is infringed if a Board of appeal uses, *ex-officio*, reasons not put forward in the proceedings to justify its decision, without giving the party disadvantaged thereby the opportunity to comment on those reasons and, as far as the patent proprietor is concerned, to file new requests accordingly, unless it is clear to the Board after the course of the proceedings that it was possible for the party to understand the Board's reasoning from its own specialist knowledge." (Translated from German by the Enlarged Board).

According to the petitioner, these conditions were not met in the case at hand so that its right to be heard was violated.

The petitioner further holds the view in section (3) of the petition that there was a deficiency (lack of consideration in an appropriate way) in the assessment by the Board of the (non) admittance of auxiliary request 8 into the appeal proceedings, allegedly without justification, based on Article 13(1) RPBA - considering that it *prima facie* gave rise to a new objection under Article 123(2) EPC - and not only based on Article 13(2) RPBA as for auxiliary request 7, so that the Board exercised its discretion in an arbitrary manner and therefore deprived the patent proprietor of the opportunity to enter into a substantive discussion on the amended subject-matter of said auxiliary request 8, thereby violating its right to be heard.

The petitioner considers, still in section (3) of the petition, that the discussion on Article 123(2) EPC with respect to claim 1 of auxiliary request 8 would not have been complex as alleged by the Board and the respondent during the oral proceedings based on the allegation that there was *prima facie* no clear and unambiguous disclosure of the claimed combination of features in the application as filed and that the amendment and the resulting subject-matter of auxiliary request 8 were technically straightforward and did not entail unexpected combinations.

Reasons for the Decision

Admissibility of the petition for review

1. The requirements under Article 112a(1) and (4) EPC in conjunction with Rule 107(2) EPC were met. Pursuant to Rule 106 EPC, a petition for review is only admissible where an objection against an alleged procedural defect was raised during the appeal proceedings and dismissed by the Board, except where this objection could not be raised during these appeal proceedings.
2. Meeting the requirements under Rule 106 EPC is a precondition for access to the review procedure, since it is an extraordinary legal remedy against otherwise final decisions of a Board.
3. In the case at hand, as it appears from the minutes of the oral proceedings and from the decision under review (p. 14 to 15 of the minutes, p. 6, 20 to 22 and 43 to 47 of the decision), the patent proprietor raised an objection under Rule 106 EPC during the oral proceedings regarding the same claimed violations of its right to be heard as those set out in the petition and its objection was dismissed by the Board.
4. The petition is thus not clearly inadmissible.

Allowability of the petition for review

5. As far as the *ex-officio* objection under Article 83 EPC raised by the Board in its preliminary opinion is concerned and referred to by the petitioner, the Enlarged Board underlines that in its response to this preliminary opinion, the patent proprietor did not challenge the right of the Board to raise such an ex-

officio objection but only responded to this objection on its merits by filing new auxiliary requests 1 and 2. Neither was a specific objection under Rule 106 EPC raised during the oral proceedings against this right of the Board to raise this *ex-officio* objection in its preliminary opinion.

6. Regarding the fact that, according to the petitioner, the conditions set out in R 16/13 for a Board to raise *ex-officio* objections were not met in the case at hand, this decision reads in Reasons 4.1 "The present case raises the question of whether it is compatible with Article 113(1) EPC if (...) a Board of Appeal bases its decision on grounds which were not introduced into the proceedings by any of the parties and were not raised for discussion by the Board itself" and in Reasons 6 "claim 1 as granted has thus been denied protection on grounds which the Board of Appeal invoked *ex officio* in support of the decision without giving the parties, in particular the patent proprietor who was disadvantaged by the decision, an opportunity to comment on those grounds and if necessary to file new requests" (Translated from German by the Enlarged Board).
7. Contrary to the situation described in the above reasons of R 16/13, in the case at hand, the patent proprietor could actually file auxiliary requests further to the new Article 83 EPC objection raised by the Board in its preliminary opinion, before the oral proceedings and during the latter as far as auxiliary requests 7 and 8 are concerned.
8. In addition, Reasons 13.6 of the decision reads "As is apparent from the minutes of the oral proceedings before the board, the parties had ample opportunity to

present their comments on the issues discussed, including the question of admittance of the appellant's auxiliary requests. At the oral proceedings before the board, the appellant also confirmed that the parties had always been asked whether they had further comments or requests before the board deliberated and that the appellant had been given sufficient time when it had asked for a break. Moreover, it is evident from the minutes of the oral proceedings before the board that the appellant did comment on the respondent's objection to the admission of auxiliary request 8 on the grounds that the discussion on Article 123(2) EPC with respect to claim 1 would *prima facie* be complex. Therefore, the board cannot accept the appellant's argument that the discussion on the admittance of auxiliary request 8 was cut short." This passage of the decision is not challenged by the petitioner in its petition. It is in addition confirmed by the minutes of the oral proceedings (pages 12 to 13) that this topic was discussed in depth with the parties. Indeed, they read: "After the resumption of the oral proceedings, the Chair referred to the criteria set out in Article 13(1) RPBA and asked the appellant to indicate where there was a basis in the application as filed for the combination of features defined in claim 1 of auxiliary request 8. (...) The respondent argued that the discussion on Article 123(2) EPC with respect to claim 1 of auxiliary request 8 would be complex since there was *prima facie* no clear and unambiguous disclosure of the claimed combination of the features of claim 1 in the application as filed. The appellant then referred to (...) the application as filed (...). After the resumption of the oral proceedings, the Chair informed the parties that the board had exercised its discretion under Article 13(2) RPBA, taking into account the criteria set out in Article 13(1) RPBA, and had decided

not to admit auxiliary request 8 into the appeal proceedings."

9. It thus appears to the Enlarged Board that the patent proprietor had the opportunity to comment on the new Article 83 EPC objections raised by the Board in its preliminary opinion and on new Article 123(2) EPC issues raised during the discussion of admittance into the appeal proceedings of its auxiliary request 8 filed during the oral proceedings. The petitioner's right to be heard does consequently not appear violated in this context according to the Enlarged Board.
10. Regarding the petitioner's view that the Board exercised its discretion in an arbitrary manner in taking into account not only Article 13(2) RPBA but also Article 13(1) RPBA for assessing the admittance into the appeal proceedings of auxiliary request 8 and deprived the patent proprietor of a substantive discussion on the merits of this request, the Case-Law of the Boards of Appeal, 10th edition July 2022 ("CLA") reads in its section V.A.4.5.9 "In numerous decisions, the boards have, in line with the principles set out in the explanatory remarks on Art. 13(2) RPBA 2020 in CA/3/19, pointed out that, at the third level of the convergent approach, the board may, in the exercise of its discretion under Art. 13(2) RPBA 2020, also rely on criteria applicable at the second level of the convergent approach, i.e. those set out in Art. 13(1) RPBA 2020 (see e.g. T 989/15, T 584/17, T 954/17, T 752/16, T 764/16, T 709/16, T 995/18). According to T 2429/17, at the third level of the convergent approach, the board may also rely on criteria applicable at the second and first levels of the convergent approach, i.e. those set out in Art. 13(1) and Art. 12(4) to 12(6) RPBA 2020.". These are thus

common case-law principles and the Board therefore does not have to explicitly justify its application of such principles in its decision when applying not only Article 13(2) RPBA criteria but also Article 13(1) RPBA criteria according to the Enlarged Board. The Board's exercise of discretion does consequently not appear arbitrary, contrary to the petitioner's point of view.

11. Moreover, in the case at hand, the Board did actually justify its decision to apply also Article 13(1) RPBA criteria to determine whether auxiliary request 8 should be admitted into the appeal proceedings and not only the criteria of Article 13(2) RPBA as regarding auxiliary request 7 (which was not allowed under Article 123(2) EPC).
12. Indeed, as far as the latter is concerned, the Board explains (Reasons 10.4 of the decision) that it took into account the sequence of events of the case and in particular new aspects of the objection of insufficiency of disclosure first put forward in the respondent's response to the preliminary opinion of the Board and further aspects first put forward and new objections raised during the oral proceedings under Article 123(2) EPC, to exercise its discretion by not applying the criteria of Article 13(1) RPBA. On the other hand, regarding auxiliary request 8, the Board explains (Reasons 12.2 and 12.4 to 12.6) that despite the fact that the patent proprietor filed an amendment of auxiliary request 7 in auxiliary request 8 with a view to overcoming the prima facie objection under Article 123(2) EPC raised against the refused auxiliary request 7, the assessment of this amendment would have required close scrutiny and a complex assessment of the disclosure of passages of the description which at first sight are not linked and that the patent

proprietor had not demonstrated that the considered amendment, *prima facie*, did not give rise to a new objection under Article 123(2) EPC, so that in these circumstances, the Board decided to exercise its discretion under Article 13(2) RPBA, taking into account the criteria of Article 13(1) EPC.

13. In the case at hand, Reasons 13.6, second and third paragraphs, of the decision reads "In addition, even if there are exceptional circumstances within the meaning of Article 13(2) RPBA, this does not mean that all new auxiliary requests filed by the appellant in response have to be admitted. The board has discretion under Article 13(2) RPBA and, in exercising that discretion, may also take into account the criteria of Article 13(1) RPBA and base its discretionary decision on the admittance of an auxiliary request on those criteria. (...) Therefore, the board finds that it was justified to discuss - on a *prima facie* level - whether the amendments to claim 1 of auxiliary request 8 overcame the issues raised by the respondent and whether these amendments gave rise to new objections, in particular a new objection of added subject-matter. The board agrees with the respondent that if amended claims give rise to new objections this is the sole responsibility of the party that filed those claims.".
14. Consequently, it does not appear to the Enlarged Board that the Board exercised its discretion under Article 13(2) RPBA with regard to both auxiliary requests 7 and 8, and taken into account the provisions of Article 13(1) RPBA for auxiliary request 8 and not for auxiliary request 7 in an arbitrary manner so that the right to be heard of the patent proprietor would have been violated.

15. During the oral proceedings before the Enlarged Board, the petitioner insisted on the fact that because Article 13(1) RPBA was used by the Board in the assessment of the admittance into the appeal proceedings of auxiliary request 8 because it raised according to the opponent a complex Article 123(2) EPC issue, a discussion on the merits of this objection was cut short because the Board in its application of Article 13(1) RPBA regarding auxiliary request 8 only *prima-facie* considered the relevance of this issue, whereas according to the petitioner, auxiliary request 8 solved the Article 123(2) EPC problem regarding auxiliary request 7, for which a discussion on the merits of the Article 123(2) objection took place.
16. However, as detailed above, the Board did not exercise its discretion arbitrarily in applying the criteria of Article 13(1) RPBA in the case at hand only regarding auxiliary request 8 and not auxiliary request 7, so that it was legitimate in the framework of this Article to consider only the *prima-facie* relevance of said Article 123(2) EPC issue and conclude that the provisions of Article 13(1) RPBA were not met regarding auxiliary request 8 for not admitting this request into the appeal proceedings without having a further discussion on the merits of said issue.
17. The Enlarged Board further underlines that the fact that in an *inter-partes* case, an *ex-officio* objection is raised by the Board does not justify that the application of Article 13(1) and (2) RPBA should be different than in an *ex-parte* case.
18. That according to the petitioner as set out in section (3) of the petition, the discussion on Article 123(2) EPC with respect to claim 1 of auxiliary request 8

would not have been complex as alleged by the Board and the respondent during the oral proceedings and that the amendment and the resulting subject-matter of auxiliary request 8 were technically straightforward and did not entail unexpected combinations, is irrelevant according to the Enlarged Board.

19. Indeed, auxiliary request 8 was not admitted into the appeal proceedings on the basis of the provisions of Article 13(1) RPBA and it was shown above that according to the Enlarged Board, the Board did not violate the patent proprietor's right to be heard by applying these provisions in the circumstances of the case at hand.
20. The petitioner criticises the merits on which the Board considered that these provisions were not met and holds the view that the auxiliary requests filed further to the preliminary opinion of the Board and during the oral proceedings actually overcame the Article 83 and 123(2) EPC issues, which according to the Board *prima-facie* affected said auxiliary requests.
21. However, the Enlarged Board has no competence to review the case as to its merits, including whether correct conclusions have been drawn by the Board. The grounds on which a petition for review can be based are enumerated in Article 112a(2) EPC. As derivable from the wording (...only...on the grounds...), the list of possible grounds for review is exhaustive (see also R 1/08, Reasons 2.1; R 6/11, Reasons 11.1).
22. Finally, that as set out by the petitioner under section (4) of the petition, the decision would have had a different outcome if the Board had admitted auxiliary request 8 into the appeal proceedings appears

irrelevant to the Enlarged Board for the same grounds as those set out under Reasons 21.

Conclusion

23. What the petitioner primarily complains about is that the Board arrived at conclusions different from the petitioner's. The Enlarged Board understands that a party may have a different view to the deciding Board on technical or legal considerations and may even be convinced that a decision is wrong from a technical or legal point of view and may, therefore, wish to have the case reviewed. However, the Enlarged Board has no competence to review the case as to its merits, including whether correct conclusions have been drawn by the Board. Under no circumstances may the petition for review be a means to review the application of substantive law, since a review of the correct application of substantive law would amount to the Enlarged Board being a third instance. This has been explicitly excluded by the legislator (see also explanatory remarks 1 to 5 on Article 112a EPC, OJ EPO 2007, Special edition no. 4, and established case law since decision R 1/08). Thus, the Enlarged Board has no competence under Article 112a EPC to examine the merits of a Board's decision and go into the substance of a case, not even indirectly (see also CLA, V.B.3.1 and V.B.3.4.3, and the decisions cited there, e.g. R 19/11, Reasons 2.2).
24. In light of the considerations set out above, the Enlarged Board concludes that the petitioner's arguments were duly considered by the Board, as can be derived from the Board's written reasoned decision. As far as the correctness of the decision as to its substance has been objected to by the petitioner, this

cannot be reviewed by the Enlarged Board.

25. Therefore, the petition for review is clearly unallowable under 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