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D E C I S I O N
of 24 June 2004

Case Number: T 0068/02 - 3.2.7

Application Number: 96102642.4

Publication Number: 0728559

IPC: B25J 9/08

Language of the proceedings: EN

Title of invention:

Manipulator

Patentee:

ASEA BROWN BOVERI AB

Opponent:

KUKA Roboter GmbH

Siemens AG Zentralabteilung Technik Abtlg. ZT PA 1

Headword:

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Relevant legal provisions:

EPC Art. 54, 56, 114(2)

EPC R. 76

Keyword:

"Novelty - yes"

"Inventive step - yes"

"Return to the patent claims as granted after filing new main request - admissible"

"Late filed documents - some allowed"

"Partiabilty of Opposition Division - no"

"Correction of minutes of oral proceedings before Opposition Division - procedure adopted not transparent but not substantial procedural violation - correction by Board not possible"

"Referral of questions to the Enlarged Board of Appeal - not necessary for deciding appeals"

Decisions cited:

G 0005/91, G 0009/91, G 0001/99, T 0838/92, T 0231/99

Catchword:

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Case Number: T 0068/02 - 3.2.7

D E C I S I O N
of the Technical Board of Appeal 3.2.7
of 24 June 2004

Appellant I:
(Opponent)

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Appellant II:
(Opponent)

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Representative:

-

Respondent:
(Proprietor of the patent)

ASEA BROWN BOVERI AB
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Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted 14 November 2001
rejecting the opposition filed against European
patent No. 0728559 pursuant to Article 102(2)
EPC.**

Composition of the Board:

Chairman: A. Burkhardt
Members: P. A. O'Reilly
C. Holtz

Summary of Facts and Submissions

I. Appellants I (Opponent I) and II (Opponent II) filed appeals against the decision of the Opposition Division to reject their oppositions against the European Patent No. 0 728 559.

II. Opposition was filed against the patent as a whole and based on Article 100(a) EPC (lack of novelty and lack of inventive step) Article 100(b) (insufficiency) and Article 100(c) (content extended).

The Opposition Division held that the subject-matter of claim 1 of the main request was novel and involved an inventive step and that the content of the patent had not been extended.

The most relevant prior art documents for the present decision are:

D1: US-A-4 602 195

D3: ORCA: Optimized Robot for Chemical Analysis;
Hewlett Packard Journal, 1993, pages 6 to 12

D4: DE-A- 40 00 348

D5: Distributed control concept for modular robot
systems; Intelligent Motion; June 1994
Proceedings, pages 47 to 58

D8: US-A-4 4 825 133

D14: EP-A-0 722 811

D16: EP-A-0 612 591

D17: EP-A-0 237 577

D18: FR-A-2 657 807

D23: An Open Architecture Distributed Control System for Flexible assembly; IBEC'94; Body Assembly & Manufacturing; pages 95 to 102.

D25: Merriam-Webster's Collegiate Dictionary; Main entry: "**on**".

III. The appellants requested that the decision under appeal be set aside and the patent be revoked. Appellant I further made the following alternative requests in descending order: that the case be remitted to a different Opposition Division; that the Opposition Division be ordered to correct the minutes of the oral proceedings before the Opposition Division; that the Board itself correct those minutes; that questions be put to the Enlarged Board of Appeal.

The respondent requested that the appeal be dismissed, or alternatively that the patent be maintained in amended form in accordance with the first, second or third auxiliary request filed with letter of 17 May 2004.

IV. The independent claim of the patent as granted request reads as follows:

"1. Manipulator, for example an industrial robot, which manipulator comprises a plurality of drive means (1) for moving the manipulator in its plurality of degrees of freedom, each drive means (1) comprising at least one electric driving motor (2), which is supplied and controlled via a rectifier (6) and a drive device (7), characterized in that at least one of said drive devices (7) is arranged on the manipulator, preferably adjacent to its associated drive means (1)."

V. The appellants argued in written and oral submissions essentially as follows:

(i) The main request for maintenance of the patent as granted should not be admitted into the appeal proceedings. During the oral proceedings before the Opposition Division a new main request for maintenance in amended form was filed. In filing the new main request the proprietor abandoned his rights to the patent as granted. It was not therefore permissible for the proprietor to return to a request for maintenance of the patent as granted. This also applies to the appeal.

(ii) Claim 1 specifies that the drive device is provided on the manipulator. The term 'on' must be understood broadly. The term does not exclude that the drive device is in the manipulator. Dictionary extract D25 supports this view. The proof that 'on' can mean 'in' is found in the expression 'on-board' which may mean the inside of a ship. The

Opposition Division should have required a clarification of the term. The term "drive device" is undefined and may mean anything. On the basis of the meaning of the terms 'drive device' and 'on' claim 1 lacks novelty over each of documents D3, D5, D15 and D17. In the case of documents D3, D5 and D17 the novelty of the claim is taken away by the fact that there is clearly a drive device which is on the manipulator in the sense of the term 'on'. Also, in the case of document D3 there is a circuit assembly, i.e. a drive device, inside a torso casing which is located on the outside of the manipulator arms. In the case of document D5 there is a connecting box in the power supply which is on the outside of the manipulator and therefore must constitute a drive device. Document D15, in particular in Figure 10, shows a drive device which is on a surface of part of the manipulator. In the case of document D17 there is a control device on the outside of the manipulator. The control device is a drive device in the sense of claim 1. A rectifier is always provided even for AC motors so that a rectifier is implicitly disclosed.

- (iii) The motors of manipulators are normally external. It would therefore be obvious to provide the associated drive device externally.

Starting from document D5 the problem to be solved is to provide cooling for the drive device. The solution is found in document D17 wherein the drive device is provided on the exterior, whereby a control device as mentioned in D17 must be

considered to be a drive device. Also in document D8 the skilled person would find a drive device provided outside. Document D18 also provides the solution since there are drive devices within housings but these drive devices are on other parts of the manipulator.

- (iv) Documents D16 and D19(a) to D25 should be admitted into the proceedings. Document D16 is already in the proceedings. Documents D19(a) to 23 were presented during the opposition proceedings and are relevant to the proceedings. It is true that the publication date of document D23 is not exactly known. However, the document gives the text of a paper delivered at a conference in 1994 so that the content was already public in 1994. Documents D24 and D25 were filed in response to the decision of the Opposition Division and show the meaning of the term 'on'.

- (v) In the view of appellant I the Opposition Division did not act impartially and did not deal with the partiality request which was made during the oral proceedings before the Opposition Division. The Opposition Division showed partiality in going back to the patent as granted after a new main request had been filed, in refusing to admit the documents D19(a) to D23 without discussion and in their actions in not correcting the minutes of the oral proceedings. A decision on the partiality of the Opposition Division should have taken by an independent body during the first instance proceedings in accordance with Enlarged Board of Appeal Decision G 5/91. No decision on the

oppositions should have been taken by the Opposition Division until a decision on the question of partiality had been taken. The case should be returned to the first instance for the question of partiality to be decided.

- (vi) In the view of appellant I the minutes of the oral proceedings before the Opposition Division are not correct and the procedure adopted by the Opposition Division for refusing to correct the minutes was not acceptable. The Opposition Division should have heard the parties who were present at the oral proceedings as witnesses. The Opposition Division should itself have decided on the correction after having given the parties an opportunity to present comments. It is not acceptable that the Opposition Division merely sent a communication via a formalities officer. Such a procedure is not transparent.

The Board itself could take a decision to correct the minutes, possibly after having heard witnesses.

- (vii) The following questions should be put to the Enlarged Board of Appeal:

1. Ist die Sachentscheidung einer Einspruchsabteilung, die wegen Befangenheit abgelehnt wurde, nichtig, wenn sie nach Ablehnung aber ohne Entscheidung über die Befangenheit getroffen wurde (BPatG GRUR 85/373)?

2. Welche Person oder welcher Spruchkörper ist für eine erstinstanzliche Entscheidung über einen Befangenheitsantrag gegen eine Einspruchsabteilung berufen?
3. Darf ein Spruchkörper des EPA nach einem Befangenheitsantrag über diesen einfach hinweggehen und vor jeder Befassung mit diesem und vor Entscheidung über diesen in Besetzung mit (mindestens) einem Mitglied, dessen Befangenheit beanstandet wurde, das Verfahren sachlich weiterführen?
4. Ist Raum für eine Vorhabentscheidung über die „Zulässigkeit“ eines Befangenheitsantrags?
5. Darf ein Spruchkörper in der Besetzung mit (mindestens) einem Mitglied, dessen Befangenheit beanstandet wurde, über die Zulässigkeit des Befangenheitsantrags entscheiden?
6. Wie ist mit einem Berichtigungsantrag zum Protokoll zu verfahren?
7. Darf über einen Berichtigungsantrag hinweggegangen werden oder ist dieser zu bescheiden?

VI. The respondent argued in written and oral submissions essentially as follows:

- (i) The main request filed during the oral proceedings before the Opposition Division was only a procedural request which did not involve abandonment of subject-matter. Therefore it is

permissible to return to maintenance of the patent as granted as the main request.

(ii) The documents D3, D5, and D15 do not show a drive device which is on the manipulator. The device shown in document D3 is not a drive device. The inverter and motor controller disclosed in document D5 are inside the manipulator and not on the manipulator and the box visible in the figure is not a drive device. In document D15 the drive device is not on the manipulator. In document D17 the motor is not supplied via a rectifier and a drive device. The subject-matter of claim 1 is therefore new. Document D18 shows a device with a drive device on the outside.

(iii) It is not correct to state that motors are normally provided on the outside of rectifiers.

Document D17 does not deal with the problem of cooling and there is no indication of what is in the control unit.

(iv) Documents D19(a) to D23 are not relevant and should not be admitted into the proceedings. Document D23 is a report of a conference which apparently took place in 1994. There is no evidence of when this document was published. If the documents are admitted then the case should be remitted to the first instance.

(v) The respondent understands the objections of appellant I and would probably feel the same way in similar circumstances.

(vi) The representative of the respondent was not present at the oral proceedings before the Opposition Division and cannot therefore comment on the matter.

(vii) The answers to the proposed questions could be of interest.

Reasons for the Decision

1. Admissibility of main substantive request of respondent

Appellant I argued that it was not possible for the respondent to return to a version of the claims that was broader than a later version filed as a main request. In the present case this entails a return to the claims as granted from a narrower version presented at the start of the oral proceedings before the Opposition Division.

The Board cannot agree with the appellant. The version of the claims which is filed, even as a main request, must be considered as provisional at least until a decision is taken. Enlarged Board of Appeal decision G 1/99 dealt with the situation of whether a broadening of the scope of the claims in appeal proceedings may be permissible after a decision of the Opposition Division based on claims of narrower scope, i.e. at a procedurally more advanced point than in the present case. It follows from G 1/99 that a return from a narrower claim to a broader claim is not automatically excluded, in particular with respect to problems

connected with Article 123(2) EPC. Whilst the Enlarged Board of Appeal was considering the question of *reformatio in peius* it nevertheless implicitly considered the question of whether it is possible to go back to claims of wider scope after a main request of narrower scope has been filed. This question was implicitly answered in the affirmative since the Enlarged Board of Appeal considered that there were circumstances which would warrant this. Whilst the Enlarged Board of Appeal were concerned with the particular situation of an actual ground under Article 123(2) EPC, in the present case the opponents had objected to a new main request being filed at the start of the oral proceedings so that the only way to overcome such an objection was withdrawal of the newly filed main request. When a request is filed it is examined both by the opponents and the Opposition Division for compliance with Article 102(3) before a decision is taken. This article includes the provision that the patent as amended complies with the requirements of the Convention. It is clear that this examination may reveal problems, in particular under Articles 84 and 123(2) EPC, for which the only solution is to return to an earlier version of the claims. It is thus permissible within the framework of opposition proceedings for the proprietor to return to the patent as granted unless special circumstances, e.g. explicit abandonment of the subject-matter, might indicate otherwise.

No abuse of the procedure has occurred in the present case since each opponent, when confronted with the new request at the beginning of the oral proceedings before the Opposition Division, specifically requested that

the new request should not be admitted, i.e. that the patent as granted should be the only request. The Board considers therefore that it was permissible during the oral proceedings before the Opposition Division for the proprietor to return to the maintenance of the patent as granted as the main request. As a consequence it is permissible for maintenance of the patent as granted to be the main request also in the present appeal proceedings.

2. *Novelty*

- 2.1 The question of novelty concerned documents D3, D5, D15 and D17. The question essentially hinges on the meaning of the expression "drive means" and the term "on" as used in the claim 1.

The Board considers that the term "drive means" in the context of the claim indicates a drive device in the power line between the rectifier and the motor. The claim specifies that the driving motor is supplied and controlled via a rectifier and a drive device. The term "via" in this supply and control context indicates a path. This means that the drive device is in this path. The supply and control path leads via a rectifier and a drive device to the motor. Therefore, the drive device is in this supply path between the rectifier and the motor, i.e. it is in the electrical power line.

The Board further considers that the term "on" in the context of claim 1 means 'on the outside of'. This is the normal meaning of the term and is consistent with the description of the patent and with the solution to the problem which is disclosed in the description. The

appellants argued that the term should be considered more generally and include the inside of the manipulator as well as the outside. Appellant II in particular quoted the expression "on board" as used for ships and which could include the inside of the ship. The Board would note that in all languages prepositions tend to have a principle meaning and then a greater or smaller number of special usages. These special usages may be connected with an original usage in a particular context which then changes as the context develops. This is the case with the expression "on board" which has a long historical development and is now used in situations where there is no board, e.g. for aircraft. The dictionary extract D25 which was supplied by appellant I supports the above view since it indicates that 'on' means "in contact with and supported by the top surface of" or "in contact with an outer surface".

2.2 Document D3 discloses an elbow and wrist motor printed circuitry assembly. This assembly however is located inside the upper arm. There is also a torso printed circuitry assembly located inside a torso casing. Appellant I argued that this second assembly together with its surrounding casing formed a drive device on the manipulator. The Board cannot agree with the appellant. First of all, the nature of the circuitry is not disclosed so that it is not disclosed that it is a drive device. Secondly, it is the manipulator which is located on this torso casing rather than vice-versa.

2.3 Document D5 does not disclose that the drive means is on the manipulator since it is expressly stated that the motor controller R and inverter L, which constitute the drive device, are located inside the manipulator,

as is visible in Figure 1. Appellant II argues that a box visible in this figure and located in the power line constituted a connector and hence a drive device. This box however is not further described so that no conclusions may be drawn as to its nature. This document does not therefore disclose a drive device on a manipulator.

2.4 Appellant I referred to document D15 and in particular figures, 10, 28, 30, 35, 36 and 38. However, none of these figures show the position of any possible drive device. Figure 10 does show a voltage converter circuit. However the figure merely shows a small part of the device with no clear indication of the position of this part in the apparatus as a whole, i.e. whether or not it is within the apparatus. This document does not therefore disclose a drive device on a manipulator.

2.5 Document D17 shows a control device for controlling the drive motor located on the manipulator. However the nature of the control device is not disclosed. The device could just produce digital signals which are sent to a drive device which then uses the signals as instructions on how to control the electrical supply to the motor. Also, no rectifier is specifically disclosed. Whilst rectifiers are commonly used an electrical supply, also to AC motors, this is not imperatively the case such that this feature is implicitly disclosed in the document. This document therefore discloses neither a rectifier nor a drive device on a manipulator.

2.6 Therefore, the subject-matter of claims 1 is novel in the sense of Article 54 EPC.

3. *Inventive step*

3.1 Closest prior art

The closest prior art is represented by document D5 which discloses a manipulator comprising the features of the preamble of claim 1.

3.2 Problem to be solved

The objective problem to be solved by the distinguishing feature of claim 1 is to improve the cooling of the drive device.

The description of the patent also mentions the problem of the emission of electromagnetic radiation. The Board however does not consider that this problem is solved by the distinguishing feature of claim 1. The solution to this problem is already provided by the drive means disclosed in document D5 being provided inside the manipulator which reduces the number of long current carrying cables. The positioning of the drive means on the outside of the manipulator does however contribute to the solution of the cooling problem.

3.3 Solution to the problem

The solution to the problem is that at least one drive device is arranged on the manipulator. The positioning of the drive device on the outside of the manipulator improves the cooling.

- 3.4 The solution to the problem is not obvious for the following reasons:
- 3.4.1 Document D5 also addresses the problem of cooling the drive devices. The solution proposed in document D5 is to use the surface of the manipulator as a heat sink for the internally provided drive device, possibly using a special shape for the surface. The document thus already provides a solution to the problem. The skilled person would have no reason to go to the measures of moving the drive devices to the outside of the manipulator which would involve passing the power lines to the outside to reach the drive devices and then back to the interior of the manipulator where the drive motors are situated. Given the existence of a solution to the problem already in the document there is no reason for the skilled person to consider going to these cumbersome provisions.
- 3.4.2 Document D3 discusses the problem of providing cooling. The solution disclosed therein is to make the outer shells of aluminium so as to spread out the heat. Thus the solution chosen is different to that of the patent in suit. In document D3 it is also considered an advantage that there is a smooth structure for easy cleaning. If the drive devices were moved to the exterior then this would go against this teaching of the document regarding the desire for a smooth structure.
- 3.4.3 Document D8 mentions the problem of cooling an IC chip. The solution adopted therein is the provision of a heat sink. The heat sink however is provided within the manipulator. There is no indication to place the heat

- sink on the outside. This document therefore provides a different solution to the problem and hence could be considered to lead away from the claimed solution.
- 3.4.4 Document D17 does not provide the skilled person with the solution to the problem. This document does teach the provision of a control unit on the exterior of the manipulator. However, there is no indication of the function of the control unit. There is thus no indication that there could be a problem due to heat produced by the unit. There is also no indication that the control unit is positioned on the outside in order to solve such a problem. The skilled person thus receives no teaching from document D17 as to the solution of the objective problem.
- 3.4.5 Document D18 does not provide a solution to the problem. Each the features that might be considered to be a drive device are provided inside the manipulator and there is no indication that there is any cooling problem to be solved.
- 3.4.6 Appellant I made specific reference to decision T 967/97. The facts of the case on which that Board had to decide are different to those of the present case. In the decision the Board also made a number of general remarks. It is not however necessary for the present Board to discuss those general remarks when the facts of the case are different.
- 3.5 Therefore, the subject-matter of claim 1 of the main request involves an inventive step in the sense of Article 56 EPC.

4. *Late filed documents*

4.1 The Opposition Division did not admit documents D16, and D19(a) to 23 into the proceedings. The respondent objected to the admittance of documents D19(a) to 25 as late filed.

4.2 Document D16, which was filed with the letter of appellant I dated 15 December 1999, was discussed extensively by the respondent in his submission of 6 July 2000, without objecting to its admission into the proceedings. The document was further discussed by the Opposition Division in its opinion accompanying the invitation to oral proceedings dated 16 February 2001. At the start of the oral proceedings before the Opposition Division the respondent requested that the document not be admitted into the proceedings. The Opposition Division as a consequence did not admit the document. The Board cannot agree with the action of the Opposition Division in this respect. The discussion of the document by the respondent and the Opposition Division before the oral proceedings took place would lead to the normal expectation that the document was already in the proceedings and that the oral proceedings could be prepared on this basis. It goes against the principles of good faith for the Opposition Division to then accede at the start of the oral proceedings to a request not to admit the document. A late filed document which is already in the proceedings cannot later be declared not to be admitted without there being very exceptional circumstances, for example where the admittance had been based on an incomplete knowledge of the situation. The respondent has not objected before the Board to the document being in the

proceedings. The Board therefore confirms that the document is in the proceedings.

4.3 Documents D19(a) to D23 were filed with the submission of appellant I dated 5 September 2001. This was approximately one month before the oral proceedings before the Opposition Division and thus their admittance was clearly open to debate at the start of the oral proceedings. The Opposition Division did not admit these documents into the proceedings as they did not consider them to be relevant. During the oral proceedings before the Board appellant I withdrew document D21. The Board has considered the remaining documents for their relevance. The Board considered that documents D19, D19a, D20 and D22 are relevant and admitted them into the proceedings. Document D23 is apparently connected to an exhibition since it carries the designation "IBEC '94". There is no clear indication of its date of publication and the priority date of the opposed patent is in February 1995. The document could thus easily have only been accessible to the public after the priority date, e.g. during the course of 1995. Since the date of publication is not certain the document cannot be considered to be prima facie relevant and hence is disregarded pursuant to Article 114(2) EPC.

4.4 Documents D24 and D25 were filed with the grounds of appeal. These documents comprise an extract from a handbook and an abstract from a dictionary. Since they serve merely to explain the technological background and to interpret the claim the Board has decided to admit these documents into the proceedings.

4.5 A remittal to the first instance is not necessary as the first instance have already given their opinion on the documents in their decision, i.e. that the documents are not relevant.

5. *Partiality of the Opposition Division*

5.1 During the oral proceedings before the Opposition Division appellant I made a partiality objection against the Opposition Division. According to the minutes of the oral proceedings the Opposition Division stated that they could not take a decision in this matter. The minutes were expressly included as part of their decision, see point 6 on page 2 of their decision. They then carried on the oral proceedings. By their action in carrying on the oral proceedings at this point it may either be concluded that they implicitly took a decision on partiality to the effect that they were not partial or that their decision was indeed just as proclaimed, namely that they considered themselves incompetent to decide this point. The manner in which the Opposition Division acted is not considered by the Board to have been particularly logical. Following the motto that actions speak larger than words the Board weighs the actions of the Opposition Division higher and comes to the conclusion that a decision was indeed implicitly taken. This is confirmed by the fact that the Opposition Division went so far as to also reach a decision on the substantive matters which would not have been possible if the partiality objection was still unresolved.

The Board would note however that the actions of the Opposition Division in stating that they could not take a decision on partiality and then continuing the oral proceedings lead to a confused situation where the parties may become uncertain as to the legal situation in which they find themselves. The Opposition Division could have avoided this problem by announcing a clear decision on the matter during the oral proceedings.

The Board also does not see any procedural error by the Opposition Division in taking the decision on partiality themselves. In Enlarged Board of Appeal decision G 5/91 the Enlarged Board dealt with a case where the Director responsible for the Opposition Division took a decision on partiality. This was the prescribed practice in the first instance and could be implemented in that case since the partiality objection was made before the oral proceedings took place. The Enlarged Board clearly stated in their decision that this practice is not illegal (see point 4 of the Reasons). The Enlarged Board also considered, without coming to a final conclusion, that the Opposition Division might be able itself take the decision. Whilst the Enlarged Board did not come to a final conclusion the present Board nevertheless considers that such a procedure is also not an illegal procedure for deciding a partiality objection, particularly during oral proceedings when it may be impractical to institute the standard procedure. This view is also consistent with Enlarged Board of Appeal Decision G 9/91 wherein the administrative nature of the opposition proceedings was explained (see point 18 of the Reasons). In the case of an administrative instance it is clear that they are subject to the requirement of impartiality, in

particular when involved in inter-parties proceedings which concern a piece of property, i.e. a granted patent (cf. Decision G 5/91, point 3 of the reasons). It is also clear that any partiality objection must be dealt with in a correct manner. Nevertheless, this requirement does not go so far as to require the same procedure to be applied as is applied to the Boards themselves. The Boards are a judicial instance. They are also a last instance so that their actions are not subject to further review. In such circumstances particularly careful procedures are required to deal with partiality objections. The decisions of the Opposition Division are subject to judicial review. In the opinion of the Board it is not therefore imperative that a partiality objection to a member of an Opposition Division be dealt with by a separate independent body as was argued by appellant I.

- 5.2 The basis of the partiality objection was principally considered by appellant I in his view to be the fact that the Opposition Division encouraged the proprietor to withdraw his main request filed during the oral proceedings and to return to maintenance of the patent as granted. The Board cannot however see any indication of partiality in this action. The minutes of the oral proceedings indicate that when the request of the proprietor was filed both opponents objected to the request being admitted into the proceedings. It may be that opponent I changed his view during the oral proceedings. There is no indication however that opponent II changed his view. The actions of the Opposition Division appear to follow the requests of the opponents. Also, the Guidelines for Examination encourage the Opposition Division to make proposals for

amendment (D-VI, 4.2). If an Opposition Division is acting in accordance with the Guidelines, as indeed it normally should, then a basis for a partiality objection cannot be discerned by the Board.

5.3 Appellant I also considered that the action of the Opposition Division in not admitting late filed documents without further discussion was an indication of partiality. When the appellant filed the documents (see letter of 5 September 2001) he explained the relevance of the documents. The Opposition Division was thus in a position to decide whether to exercise their discretion under Article 114(2) EPC to disregard the documents. The Board cannot see therefore that the actions of the Opposition Division implied a partiality on their part.

5.4 Finally appellant I argued that the actions of the Opposition Division in dealing with the request for correction of the minutes were evidence of partiality. The appellant has argued that the fact that they did not deal with the request in a procedurally correct manner shows partiality. The Board would note that the mere fact that an Opposition Division may have committed a procedural violation does not automatically imply partiality. Procedural violations may occur for many reasons, in particular due to lack of knowledge of the correct procedure. There is no general reason to assume that partiality is the reason for the violation. This is not to say that the Board considers that the Opposition Division did commit a procedural violation in this respect. That matter is dealt with below. Hence the allegation of a procedural violation cannot alone be considered as an indication of partiality.

5.5 The Board therefore cannot see any objective evidence which would lead to the conclusion that any of the members of the Opposition Division was partial.

6. *Correction to the minutes of the oral proceedings before the Opposition Division*

6.1 Appellant I first requests in this respect that the case be remitted to the first instance for correction of the minutes of the oral proceedings before the Opposition Division.

In response to a request to correct the minutes of the oral proceedings the appellant received a communication from a formalities officer stating that the communication was on behalf of the Opposition Division. The communication stated that the Opposition Division was of the opinion that the minutes were correct. According to Rule 76(3) EPC the minutes shall be authenticated by the employee who drew them up and the chairman of the proceedings. There are no regulations in the EPC for correcting the minutes. In the absence of any regulation the Opposition Division should adopt a procedure for responding to a request to correct the minutes which may be considered fair. The procedure adopted by the Opposition Division in the present case is not particularly transparent, but this does not mean that it may be considered unfair. The communication by the formalities officer indicated that the decision not to correct the minutes was taken by the Opposition Division. The Opposition Division is the body entitled to take that decision since two of its members authenticated the minutes and the oral proceedings took

place before the Opposition Division. There remains the fact that it was the formalities officer who informed the parties of the decision of the Opposition Division. The Board considers that the procedure would be more transparent if at least the persons authenticating the minutes were to issue the communication dealing with the correction since they are the persons who can confirm whether or not the minutes are correct. A second-hand statement by a formalities officer could raise doubts as to whether the decision was really taken by the correct persons. Such doubts could not arise if the correct persons also issued the communication. Nevertheless, there is no objective reason in the present case to doubt that the Opposition Division, including the persons who authenticated the minutes, did indeed take the decision that was communicated by the formalities officer. The Board therefore does not see any procedural violation in the procedure that was used. In the absence of a procedural violation the Board sees no reason to remit the case for further consideration in this request.

- 6.2 Appellant I alternatively requests in this respect that the Board should itself correct the minutes of the oral proceedings, possibly after having heard as witnesses the parties which were present at the oral proceedings. It belongs to the jurisprudence of the Boards of Appeal as exemplified in T 838/92 and T 231/99 that the minutes of the oral proceedings do not form part of the decision of the Opposition Division. In the present case the part of the decision entitled "Facts and Submissions" the Opposition Division contains the statement that the minutes of the oral proceedings form part of the decision. The Board understands this

statement to mean that the statements made in the minutes of the oral proceedings form part of the facts relating to the decision. As already explained above the content of minutes is the responsibility of the persons who authenticated them. This means that the responsibility for correcting them can only rest with those persons. Since the responsibility for the minutes cannot be transferred from the authenticating persons, the resolution of a dispute concerning what took place could not lead to a correction of the minutes by the Board, but only to a conclusion that the minutes were either right or wrong regarding the disputed aspects. In the present case none of the disputed statements, or lack of statements, in the minutes affects the outcome of the appeal so there is no need to consider whether the minutes truly reflect what took place in the oral proceedings.

7. *Referral of questions to the Enlarged Board of Appeal*

7.1 Appellant I has proposed referring a number of questions to the Enlarged Board. The first five questions concern the actions to be taken with respect to a partiality objection to a member of an Opposition Division. Questions 1 and 3 do not have a bearing on the present case as the Board has concluded as indicated above that the Opposition Division did make an implicit decision concerning partiality. Further the Board has concluded that the actions of the Opposition Division do not indicate any partiality (point 5. above). With respect to questions 2 and 5 the Enlarged Board has already indicated views in this matter in its decision G 5/91 and the present Board has come to the conclusion that the actions of the Opposition Division

were in line with that decision. An answer to question 4 is not required for the Board to reach a decision in the present case so that there is no basis for a referral of this question to the Enlarged Board of Appeal. Questions 6 and 7 concern the procedure for correcting the minutes of the oral proceedings before the Opposition Division. Jurisprudence in the form of for instance T 838/92 and T 231/99 already exists. This Board agrees with those decisions so that there is no need for these questions to be put to the Enlarged Board of Appeal.

- 7.2 The Board concludes therefore that it does not need to refer any of the proposed questions to the Enlarged Board of Appeal in order to reach its decision.

Order

For these reasons it is decided that:

1. The request for referral of questions to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Nachtigall

A. Burkhardt