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**Datasheet for the decision  
of 1 March 2012**

**Case Number:** T 0936/09 - 3.2.01

**Application Number:** 00916741.2

**Publication Number:** 1169188

**IPC:** B60J 5/04

**Language of the proceedings:** EN

**Title of invention:**  
Door module

**Patentee:**  
Magna Closures Inc.

**Opponent:**  
Brose Fahrzeugteile GmbH & Co. KG, Coburg

**Headword:**  
-

**Relevant legal provisions:**  
RPBA Art. 12(4)

**Relevant legal provisions (EPC 1973):**  
EPC Art. 111(1)

**Keyword:**  
"Admission of request filed with statement of grounds of  
appeal - (no)"  
"Remittal - (no)"

**Decisions cited:**  
G 0007/93, G 0008/91, G 0009/91, G 0010/91, G 0001/99,  
R 0010/09, R 0011/11, T 0034/90, T 0931/06, T 1685/07,  
T 1705/07, T 0356/08, T 1067/08, T 0144/09, T 0848/09,  
T 0023/10

**Headnote:**

Under the EPC, there is no legal obligation for the patent proprietor to take an active part in opposition proceedings. However, the patent proprietor is not free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings, depending, for example, on his procedural strategy or his financial situation. In view of the judicial nature and purpose of *inter partes* appeal proceedings (see point 2 of the Reasons) and in the interests of an efficient and fair procedure, the board considers it necessary that all parties to opposition proceedings complete their submissions during the first-instance proceedings in so far as this is possible. If a patent proprietor chooses not to respond in substance at all to the opposition, for example by filing arguments or amended claims, or chooses not to complete his submissions at the stage of the first-instance proceedings, but rather presents or completes his case only in the notice of appeal or the statement setting out the grounds of appeal, then he will need to face the prospect of being held to account for such conduct by the board when, for example, exercising its discretion under Article 12(4) RPBA. (See point 9 of the Reasons). This applies in particular if, as in the present case, all the reasons for revocation of the opposed patent were known to the patent proprietor before it received the impugned decision (see point 10 of the Reasons).



Case Number: T 0936/09 - 3.2.01

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.01  
of 1 March 2012

**Appellant:** Magna Closures Inc.  
(Patent Proprietor) 521 Newpark Boulevard  
Newmarket, ON L3Y 4X7 (CA)

**Representative:** Hössle, Markus  
Hössle Patentanwälte Partnerschaft  
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**Respondent:** Brose Fahrzeugteile GmbH & Co. KG, Coburg  
(Opponent) Ketschendorfer Str. 38-50  
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**Representative:** Ninnemann, Detlef  
Patentanwälte  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 17 February 2009  
revoking European patent No. 1169188 pursuant  
to Article 101(2) EPC.

**Composition of the Board:**

**Chairman:** G. Pricolo  
**Members:** T. Karamanli  
W. Marx

## Summary of Facts and Submissions

I. European patent No. EP 1 169 188 with the title "DOOR MODULE" is based on European patent application No. 00 916 741.2. The mention of the grant of the patent was published in the European Patent Bulletin on 14 June 2006.

II. Claim 1 of the granted patent reads as follows:

"A carrier plate assembly (26, 126) adapted to be secured to an inner panel (22, 122) of a vehicle door (20, 120), said assembly (26, 126) comprising; a main section (46, 146) having at least one mounting area where door hardware is mountable thereon, and at least one flap section (54, 154); characterized in that said flap section (54, 154) extends from said main section (46, 146) and is pivotally connected to the main section (46, 146) for providing access behind the inner panel (22, 122) of the door (20, 120)."

III. On 13 March 2007 the company Brose Fahrzeugteile GmbH & Co. KG filed an opposition against the patent with the EPO. The opposition was based on the grounds for opposition under Articles 100(a), 52(1) and 54 EPC 1973 (lack of novelty) and Articles 100(a), 52(1) and 56 EPC 1973 (lack of inventive step).

As far as novelty was concerned, the opponent submitted that all features of granted claim 1 were disclosed *inter alia* in documents D5 (DE 44 07 114 A1) and D6 (EP 1 024 972 B1).

- The opponent requested revocation of the patent in its entirety and, as an auxiliary measure, oral proceedings.
- IV. By communication (EPO Form 2317A) dated 23 April 2007 pursuant to Rule 57(1) EPC 1973, the EPO invited the patent proprietor to file its observations within a period of four months from notification of the communication.
- V. By fax letter dated 18 July 2007 the patent proprietor requested an extension of two months of the four-month period set by the EPO. By communication (EPO Form 2944C) dated 24 July 2007 the time limit for replying to the communication dated 23 April 2007 was extended as requested.
- VI. Since the patent proprietor failed to respond to the communication dated 23 April 2007, the EPO issued to the patent proprietor a communication (EPO Form 2344A) dated 13 December 2007, which set a two-month period for further action on the part of the patent proprietor.
- VII. On 10 March 2008 the patent proprietor's representative sent a letter by fax to the EPO which reads as follows:

*"For the attention of the Opposition Division*

*Dear Sirs,*

*Re: European Patent Application No. 00 916 741.2-2423  
in the name of INTIER AUTOMOTIVE CLOSURES INC.*

*Reference is made to your Communication dated December 13, 2007.*

*Please be informed that the Applicant [sic] is interested in maintaining the Patent, but will not reply to the Notice of Opposition filed by Brose on April 23, 2007."*

VIII. The patent proprietor did not request oral proceedings in the first-instance proceedings. Nor did it file any amended claims or further submissions on matters of substance.

IX. By a decision of the opposition division posted on 17 February 2009 the patent was revoked under Article 101(2) EPC. This decision was issued without prior oral proceedings or a prior communication to the parties from the opposition division.

The opposition division, in essence following the opponent's arguments, found that the subject-matter of granted claim 1 was not new in view of documents D5 and D6. The opposition division took no decision on inventive step.

X. On 22 April 2009 the patent proprietor (appellant) filed a notice of appeal with the EPO and paid the appeal fee.

XI. On 22 June 2009, the appellant filed a statement setting out the grounds of appeal, which was accompanied by a set of amended claims 1 to 17, replacing the granted claims. In its statement, the appellant stated that the decision under appeal had

been carefully considered and that an amended independent claim 1 was submitted. According to the further submissions, which only related to the set of amended claims, the appellant argued that the amendments to claims 1 to 17 fulfilled the requirements of Article 123(2) EPC and that the subject-matter of amended claim 1 was novel over documents D5 and D6 and inventive over the prior-art document D5 and the other documents cited by the opponent. The appellant requested that the patent be maintained in amended form.

XII. In its reply to the grounds of appeal, the opponent (respondent) argued that amended claim 1 did not fulfil the requirements of Article 123(2) EPC, nor was the subject-matter of amended claims 1 to 17 new and inventive. The respondent requested that the appeal be dismissed.

XIII. In a communication under Article 15(1) RPBA (Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536), annexed to the summons to oral proceedings, the board expressed its provisional and non-binding opinion.

The board referred *inter alia* to the course of the first-instance proceedings and to Article 12(4) RPBA, and expressed the view that the appeal proceedings were not merely an alternative way of dealing with and deciding upon an opposition and that parties to first-instance proceedings were not at liberty to bring about the shifting of their case to the second instance as they pleased (see also decision T 1067/08, point 7.2 of the Reasons). Consequently, the board would have to decide first whether the appellant's sole request, filed for the first time with the statement setting out

the grounds of appeal, was inadmissible in accordance with Article 12(4) RPBA.

- XIV. By a letter of 26 January 2012, the respondent, in addition to its requests on file, requested that the appellant's request filed with the statement of grounds of appeal be held inadmissible in accordance with Article 12(4) RPBA and submitted arguments in support of this request.
- XV. By fax letter of 1 February 2012, the EPO was informed of a change of representative for the appellant and further submissions were filed in reply to the board's communication under Article 15(1) RPBA.
- XVI. Oral proceedings took place on 1 March 2012. The oral proceedings were interrupted from 10.00 to 10.35 hours to give the appellant the opportunity to consider whether the decision under appeal indicated anything which went beyond the notice of opposition. After the interruption the appellant stated it had nothing to say thereon.
- XVII. The appellant's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

The main request filed with the grounds of appeal should be admitted into the appeal proceedings. Otherwise the appellant would have no possibility to defend its patent in appeal proceedings.

It was true that, in the first-instance proceedings, the patent proprietor had neither responded in



substance to the opposition, nor had it requested oral proceedings. However, there was no obligation for the patent proprietor to file submissions as there was for example in German civil proceedings. Furthermore, not requesting oral proceedings was not a waiver of the right to file submissions.

However, why the patent proprietor had reacted in that way in the first-instance proceedings could not be explained by hindsight, but the financial crisis in 2008 could possibly have been a reason for the patent proprietor's reaction.

In the first-instance proceedings, on the one hand, the patent proprietor had made a considered and deliberate choice not to respond to the notice of opposition, but on the other hand - and this was an important difference from case T 144/09 - the patent proprietor had not explicitly stated that it would not file any new and/or auxiliary requests. Thus there was no indication that the patent proprietor had made "a considered and deliberate choice" not to file any further requests.

Since oral proceedings had not taken place before the opposition division and the opposition division had given no preliminary opinion before the decision under appeal was issued, possible objections and views of the opposition division were not known to the patent proprietor. Therefore, the reasoning of decision T 848/09 "that the reasons for the revocation of the patent were not so explicitly known as in case T 144/09 and plausibly the formulation of a suitable new request overcoming the objection was not immediately evident"

also applied to the present case. Besides, the patent proprietor had responded to the EPO communications by its letter of 10 March 2008. After that there was no indication at all that the opposition division would issue its decision.

During the first-instance proceedings the patent proprietor had thought that objections raised in the notice of opposition would not be that relevant to the granted patent. Hence it was not arbitrary on the part of the patent proprietor not to file amended claims in the proceedings before the opposition division but to do so only with its statement of grounds of appeal.

Since the reasons for revocation of the patent had not been known to the appellant before the appealed decision, the appeal proceedings were the first possibility to submit, as a normal development of the proceedings, amended claims which were suitable to overcome the reasons given in the appealed decision for revocation of the patent. Filing new claims as a main request together with the appeal was thus a normal and legitimate reaction to the decision of the opposition division. Such a course of action was also very pragmatic and did not overload the first-instance proceedings.

Particularly the main request on file did not raise any new issue as it was a straightforward limitation of the granted claims which took into consideration the reasons given by the opposition division.

In case T 1067/08, cited by the board, and in case T 2102/08, the patent proprietor had filed requests

directed to amended claims during the first-instance opposition proceedings in such a manner or at such a late stage that these requests were not admitted into the first-instance proceedings. Consequently, in both cases, these requests were also rejected as inadmissible under Article 12(4) RPBA by the competent board of appeal.

In the present case, however, there was no rejection of a new request as being inadmissible in first-instance proceedings. In fact, there had been no further opportunity for the patent proprietor to react to any opinion of the opposition division by filing amended claims in the first-instance proceedings.

The provisions of Article 12(4) RPBA were not pertinent for the present case since the main request was not a request which had not been admitted into proceedings by the opposition division or which could have been presented in the first-instance proceedings. The main request was rather a direct reaction to the reasons for the revocation of the patent given by the opposition division in its decision.

Remittal of the case to the opposition division would overcome the respondent's concerns that it would be deprived of having the amended claims examined before two instances if the amended claims, which had never been discussed in substance in first-instance proceedings, were admitted into the appeal proceedings. In the event of remittal, the board could order a different apportionment of costs in the respondent's favour if the board was of the opinion that due to culpable conduct on the part of the appellant the

respondent would be burdened with unreasonable additional costs.

XVIII. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows.

The main request could have been filed in the proceedings before the opposition division and should therefore not be admitted into the appeal proceedings in accordance with Article 12(4) RPBA.

In the first-instance proceedings the patent proprietor had in no way been hindered from filing the request, which was in fact only filed with the statement of grounds of appeal. However the patent proprietor had made a considered and deliberate choice not to do so. By not filing any substantive submissions, any amended claims or a request for oral proceedings the patent proprietor had clearly indicated that it had no interest in defending the patent on its merits. Thus decision T 144/09 applied to the present case.

In the EPO communication dated 13 December 2007 the patent proprietor was informed that it was likely that, if the patent proprietor did not react within the period specified in that communication, the opposition proceedings would be continued pursuant to Article 101 EPC. In its reply to that communication, the patent proprietor clearly indicated that it would not reply to the notice of opposition. Therefore, it should not have come as a surprise for the patent proprietor that the opposition division issued a decision by way of the written procedure.

In addition, there was a period of almost two years between the filing of the notice of opposition and the notification of the decision under appeal as well as a period of about one year between the patent proprietor's reply to the EPO communication and the notification of the decision under appeal. This meant that, also in view of the course of events of the first-instance proceedings, the decision of the opposition division could not have been considered as unexpected by the patent proprietor.

In the present case, there was nothing in the decision under appeal which went beyond the content of the notice of opposition. Thus all the reasons for revoking the opposed patent were explicitly known to the patent proprietor. Therefore, decision T 848/09, cited by the appellant, did not apply to the present case. In case T 848/09 the reasons for revocation had not been explicitly made known and it was therefore understandable that, during the oral proceedings before the opposition division, the patent proprietor could not immediately identify the crucial issues in the heat of the moment.

Hence, in view of the content of the notice of opposition and the course of the first-instance proceedings, the opposition division's decision to revoke the patent should not have come as a surprise for the patent proprietor.

In fact, it came as a surprise for the opponent when the patent proprietor filed an appeal, which was based on a sole request, comprising a set of new claims. By

filing such an appeal the appellant was aiming at defending its patent exclusively in appeal proceedings, thereby circumventing the first instance. However, according to the provisions of the RPBA and the jurisprudence of the boards of appeal (for example the decisions cited in the board's communication), parties to first-instance proceedings were not at liberty to bring about the shifting of their case to the second instance as they pleased. Besides, the appellant had not given any explanation as to why the present request had not been submitted in the first-instance proceedings.

Allowing such a shifting of the case and admitting the new main request into the appeal proceedings would jeopardise the procedural principles of a two-instance opposition procedure and would also put the respondent at a serious disadvantage in any event.

If the board decided on the patentability of the subject-matter of the amended claims the respondent would be deprived of an examination of the claims before two instances.

If the board remitted the case to the opposition division the respondent would be faced with a prolongation of the proceedings by several years because there would not only be a new first-instance decision but possibly also second appeal proceedings.

In view of this possible time scale, a remittal of the case together with a decision on a different apportionment of costs in the respondent's favour would not be helpful. The respondent would have to live with

a provisionally valid patent for a considerable time until the issue of a final decision and, therefore, would have to be careful as far as possible infringements of the present patent were concerned.

- XIX. The appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of the claims according to the main request, filed with the statement of the grounds of appeal of 22 June 2009, or, as an auxiliary measure, that the case be remitted to the opposition division on the basis of the amended set of claims as filed on 22 June 2009.

The respondent (opponent) requested that the appeal be dismissed.

- XX. Claim 1 of the appellant's main request reads as follows:

"A vehicle door (20), comprising:  
an inner panel (22, 122) and an outer panel (24, 124) connected together and defining a cavity therebetween;  
a carrier plate assembly (26, 126) adapted to be secured to an inner panel (22, 122) of a vehicle door (20, 120),  
said assembly (26, 126) comprising a main section (46, 146) having at least one mounting area where door hardware is mountable thereon, and at least one flap section (54, 154);  
said flap section (54, 154) extending from said main section (46, 146) and being pivotally connected to the main section (46, 146) for providing access behind the inner panel (22, 122) of the door (20, 120);

characterized in that main section (46, 146) of said assembly (26, 126) is secured to said inner panel (22) on the side opposite to said cavity; and in that said flap section (54, 64) is movable between a closed position in which it lies on the same plane of said main section (46, 146), and an open position in which it is outside said cavity."

XXI. At the end of the oral proceedings the chairman announced the board's decision.

### **Reasons for the Decision**

1. The appeal is admissible.

*Non-admittance of the appellant's main request (filed as a sole request with the statement setting out the grounds of appeal) into the appeal proceedings*

2. According to the principles developed by the Enlarged Board of Appeal, the appeal procedure is to be considered as a judicial procedure (G 1/99, OJ EPO 2001, 381, point 6.6 of the Reasons, G 8/91, OJ EPO 1993, 346, point 7 of the Reasons). Appeal proceedings are wholly separate and independent from the preceding, purely administrative, first-instance proceedings and not a mere continuation of those first-instance proceedings (see e.g. T 34/90, OJ EPO 1992, 454, point 2 of the Reasons). The function of appeal proceedings is to give a judicial decision upon the correctness of a separate earlier decision taken by a first-instance department (see e.g. T 34/90, loc. cit., and G 9/91 and G 10/91, OJ EPO 1993, 408, 420). It



follows that the purpose of the *inter partes* appeal procedure is mainly to give the losing party a possibility to challenge the decision of the opposition division on its merits and to obtain a judicial ruling on whether the decision of the opposition division is correct (G 9/91 and G 10/91, loc. cit., point 18 of the Reasons). The appeal proceedings are thus largely determined by the factual and legal scope of the preceding opposition proceedings and the parties have only limited scope to amend the subject of the dispute in second-instance proceedings (T 1705/07, point 8.4 of the Reasons). It is not the purpose of the appeal to conduct the case anew and, therefore, the issues to be dealt with in appeal proceedings are determined by the dispute underlying the opposition proceedings (see e.g. T 356/08, point 2.1.1 of the Reasons). Thus the appeal proceedings are not just an alternative way of dealing with and deciding upon an opposition. Parties to first-instance proceedings are therefore not at liberty to shift their case to the second instance as they please, thereby compelling the board of appeal either to give a first ruling on the critical issues or to remit the case to the department of first instance (see also T 1067/08, point 7.2 of the Reasons). The filing of new submissions (requests, facts or evidence) by a party are not precluded in appeal proceedings, but their admission is restricted, depending *inter alia* on the procedural stage at which the submissions are made (see e.g. T 356/08, point 2.1.1 of the Reasons, T 1685/07, point 6.4 of the Reasons; Brigitte Günzel, "The treatment of late submissions in proceedings before the boards of appeal of the European Patent Office", Special edition OJ EPO 2/2007, 30).

3. The afore-mentioned principles are reflected in the provisions of Articles 12(4) and 13 RPBA. Since the appellant filed its main request with its statement of grounds of appeal, Article 12(4) RPBA is the relevant provision to be applied in the present case.
  
4. Article 12(4) RPBA requires the board to take into account everything presented by the parties under Article 12(1) RPBA if and to the extent that it relates to the case under appeal and meets the requirements in Article 12(2) RPBA. However, according to Article 12(4) RPBA, the board has the discretionary power to hold inadmissible facts, evidence or requests which could have been presented or were not admitted in the first-instance proceedings. This discretionary power serves the purpose of ensuring a fair and reliable conduct of judicial proceedings (T 23/10, point 2.4 of the Reasons).
  
5. It follows from the above that a party to appeal proceedings has no right to have a request which could have been filed in first-instance proceedings but was only filed with the statement setting out the grounds of appeal admitted into appeal proceedings (see also e.g. R 10/09, point 3.2 of the Reasons; R 11/11, point 9 of the Reasons; T 144/09, point 1.14 of the Reasons). Consequently, a patent proprietor who files such a request cannot defend its patent on the basis of that request in appeal proceedings if the board, exercising its discretion under Article 12(4) RPBA, holds it inadmissible.
  
6. According to established jurisprudence, discretion has to be exercised equitably, i.e. all relevant factors

which arise in a case have to be considered, taking into account the particular circumstances of the case (G 7/93, OJ EPO 1994, 775, point 2.5 of the Reasons; R 11/11, point 9 of the Reasons; T 931/06, point 3.5 of the Reasons; T 23/10, point 2.3 of the Reasons).

7. In the first-instance proceedings of the present case the patent proprietor reacted to the opposition filed against its patent only after receipt of several EPO communications (see points IV. to VI. above) and in a very restricted manner. The patent proprietor merely stated that it was interested in maintaining the patent as granted and that it would not reply to the notice of opposition (see point VII. above). In fact the patent proprietor did not file any further submissions, such as arguments or requests, in the course of the first-instance proceedings, despite being given several opportunities to do so (see points IV. and VI. above). Indeed, in the whole course of the first-instance proceedings, the patent proprietor did not take the opportunity to defend its patent as granted or in amended form in writing. Nor did the patent proprietor file a request for oral proceedings, with the result that the opposition division was not obliged to hold oral proceedings in case of a revocation of the patent. Although it is true that not requesting oral proceedings is not a waiver of the right to file submissions, it does, however, amount to dispensing with presenting the case orally during oral proceedings. In the board's view, by its conduct in the first-instance proceedings the patent proprietor thus made a "considered and deliberate choice" not to submit any arguments or amended claims, or any further requests in the first-instance proceedings in writing

or orally, despite being given the opportunity to do so. In this respect the present case is indeed comparable to case T 144/09, in which the patent proprietor did not avail himself of the opportunity to file any request which could have overcome one of the grounds for opposition, despite being given the opportunity to do so in oral proceedings before the opposition division (see T 144/09, point IV. of the Summary of Facts and Submissions and points 1.4 to 1.18 of the Reasons), and therefore made a "considered and deliberate choice" not to file an amended request in those proceedings (see T 144/09, point 1.14 of the Reasons). The board notes that, according to the facts of T 144/09, the patent proprietor had not explicitly stated in that case that he would not file any further request. However, the present board does not consider it necessary that such a choice is explicitly stated.

8. The board considers the patent proprietor's conduct in the first-instance opposition proceedings particularly significant since a patent proprietor usually files at least arguments as to why the grounds for opposition raised do not prejudice the maintenance of the granted patent if he wants to maintain his patent in that form, and/or he amends his patent if he (also) wants to defend a limited version of his patent.
  
9. However, under the EPC, there is no legal obligation for the patent proprietor to take an active part in opposition proceedings. To that extent, the board agrees with the appellant. But the board does not accept that the patent proprietor is free to present or complete his case at any time that he wishes during the opposition or opposition appeal proceedings, depending,

for example, on his procedural strategy or his financial situation. This view is in line with the provisions of Article 114(2) EPC (and Article 114(2) EPC 1973) and of Articles 12(4) and 13 RPBA, which give a discretion to the deciding body not to admit a party's submissions filed at a late stage of proceedings. In particular, in view of the judicial nature and purpose of *inter partes* appeal proceedings (see point 2 above) and in the interests of an efficient and fair procedure, the board considers it necessary that all parties to opposition proceedings complete their submissions during the first-instance proceedings in so far as this is possible. If a patent proprietor chooses not to respond in substance at all to the opposition, for example by filing arguments or amended claims, or chooses not to complete his submissions at the stage of the first-instance proceedings, but rather presents or completes his case only in the notice of appeal or the statement setting out the grounds of appeal, then he will need to face the prospect of being held to account for such conduct by the board when, for example, exercising its discretion under Article 12(4) RPBA.

10. The board turns now to the appellant's argument that, as in case T 848/09, the reasons for the patent being revoked were not known to the patent proprietor until the decision under appeal was notified to the parties, because the opposition division had not held oral proceedings or issued a preliminary opinion before notifying its decision. This argument does not convince the board. First, the notice of opposition clearly indicated the grounds for opposition, together with the supporting evidence and submissions, and the patent

proprietor should have expected that the ground(s) for opposition raised in the notice of opposition would most probably be dealt with in the decision of the opposition division. Second, the board agrees with the respondent that there is nothing in the decision under appeal which goes beyond the content of the notice of opposition. This has also not been contested by the appellant (see point XVI. above). Thus all the reasons for revocation of the opposed patent were known to the patent proprietor before it received the impugned decision. Consequently, the facts of the present case differ from those in case T 848/09, in which the competent board concluded that the reasons for revocation had not been explicitly made known to the patent proprietor and therefore that it was plausible that the formulation of a suitable new request overcoming the objection was not immediately evident to the patent proprietor at oral proceedings before the opposition division.

11. Since the reasons for revocation of the patent were known to the patent proprietor before the opposition division notified its decision, the board does not accept the appellant's argument that the appeal proceedings were the first possibility to file amended claims suitable to overcome the reasons for revocation of the opposed patent. Moreover, the patent proprietor was given several opportunities to meet the grounds for opposition (see points IV. and VI. above). Instead of not taking the opportunity to defend its patent in the first-instance proceedings, the patent proprietor could at that stage have filed a request in the form of that filed with the statement setting out the grounds of appeal. That this could have been done is also

supported by the appellant's submission that the present main request is a straightforward limitation of the granted claims which took into consideration the reasons for revocation of the patent given by the opposition division. The appellant's argument that the present main request was "a direct reaction to the reasons for revocation given by the opposition division" does not alter the board's view since, as explained above, these reasons were essentially the same as the objections raised in the notice of opposition. Furthermore, the appellant's motives for not limiting its patent in the first-instance proceedings in view of the objections raised in the notice of opposition are not a valid reason for accepting that the appellant could not have filed the present main request in the proceedings before the opposition division. Even if the patent proprietor did think that these objections would not be relevant to the granted patent and for that reason did not file amended claims in the first-instance proceedings, this does not mean that it could not have done so.

12. The appellant's further argument that after the patent proprietor's reply of 10 March 2008 to the EPO communications there was no indication at all that the opposition division would issue the impugned decision is not convincing either. As the respondent pointed out, the EPO communication dated 13 December 2007 contained the information that it was likely that, if the patent proprietor did not react within the period specified in that communication, the opposition proceedings would be continued pursuant to Article 101 EPC. Since, in its reply to that communication, the patent proprietor clearly indicated that it would not

reply to the notice of opposition and did not request oral proceedings, it should not have come as a surprise to the patent proprietor that the opposition division continued the examination of the opposition and proceeded directly to issue the written decision. The board also agrees with the respondent that there was no surprising element as far as the time of notification of the impugned decision is concerned because there was indeed a period of almost two years between the filing of the notice of opposition and the notification of the decision under appeal as well as a period of about one year between the patent proprietor's reply to the EPO communication and the notification of the decision under appeal.

13. Finally, the board turns to the appellant's argument that in fact there had been no further opportunity for the patent proprietor to react to any opinion of the opposition division by filing amended claims in the first-instance proceedings. The board does not find this argument persuasive, since there was no reason for the opposition division to give an opinion on the opposition before taking its decision in view of the course of the first-instance proceedings as set out above (see point 7 above).
  
14. In view of the foregoing, the board concludes that the present main request could already have been filed in the first-instance proceedings in response to the objections raised in the notice of opposition. Hence the board does not accept the appellant's argument that the provisions of Article 12(4) RPBA were not pertinent in the present case.



15. Taking into account the course of the first-instance proceedings, it is the board's view that an admission of the main request into the appeal proceedings would be incompatible with the judicial nature of the appeal procedure (see point 2 above). As set out above (points 7 to 9), the appellant patent proprietor made a considered and deliberate choice not to respond in substance to the opposition at all in the first-instance proceedings but to defend its patent for the first time in appeal proceedings, by filing amended claims and corresponding arguments. In fact, it was only in the appeal proceedings that the appellant for the first time took an active part after receipt of the opposition. As argued by the respondent, the appellant effectively circumvented the first instance and defended its patent exclusively in the appeal proceedings. By this conduct, the appellant tried to shift its case entirely to the second instance, thereby compelling the board either to give a first ruling on the appellant's case or to remit the case to the opposition division. Such a shifting of the case would also put the respondent at an unjustified disadvantage because if the main request were admitted and decided upon by the board, the subject-matter of that request would have been dealt with only by the board and the respondent would be deprived of an examination of the claims before two instances.
  
16. For the above reasons, the board, exercising its power under Article 12(4) RPBA, decided not to admit the appellant's main request into the appeal proceedings.

*The appellant's auxiliary request for remittal*

17. At the oral proceedings before the board the appellant's new representative requested, as an auxiliary measure, that the case be remitted to the opposition division on the basis of the amended set of claims which were filed with the statement of grounds of appeal and which form the basis for the appellant's main request.
  
18. Although it is true that a remittal pursuant to Article 111(1) EPC 1973 would avoid the loss of two instances, it would clearly be in contradiction to the board's discretionary decision not to admit the main request into the appeal proceedings. In particular, it would go against the reasons which the board had for not admitting the appellant's main request into the appeal proceedings.
  
19. As pointed out by the respondent, a remittal would also be disadvantageous for the respondent since it would involve higher costs and a prolongation of the proceedings by several years before the present case would finally be settled. Moreover, the prospect of second appeal proceedings would not be excluded. Hence a remittal would go against the principles of procedural economy without any justification. Further a remittal would cause legal uncertainty for a long period for the respondent, as well as for the public, regarding the validity of the opposed patent. The board accepts the argument of the respondent, namely that, in the case of a remittal, the respondent and the public would be left with a provisionally valid patent for a considerable time until the issue of a final decision

and, therefore, would have to be careful as far as possible infringements of the present patent were concerned.

20. It is the board's conviction that, even if it decided to remit the case to the opposition division, an order for a different apportionment of costs in the respondent's favour would not offset the above disadvantages of a remittal.
21. For the above reasons the appellant's auxiliary request is not allowable.
22. Since none of the appellant's requests is allowable, the appeal must be dismissed.

## **Order**

### **For these reasons it is decided that:**

The appeal is dismissed.

The Registrar:

The Chairman:

A. Vottner

G. Pricolo