Internal distribution code:

(A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [X] To Chairmen
(D) [-] No distribution

Datasheet for the decision of 17 June 2016

Case Number: T 1088/11 - 3.4.03

Application Number: 01305966.2

Publication Number: 1174921

IPC: H01L23/495, H01L25/07

Language of the proceedings: EN

Title of invention:
Semiconductor device

Patent Proprietor:
Hitachi, Ltd.

Opponent:
Infineon Technologies AG

Headword:

Relevant legal provisions:
EPC Art. 18(2), 19(2), 21(4), 111(1)
EPC R. 103(1)(a), 113, 115(1)
RPBA Art. 11

Keyword:
Composition of the opposition division
Remittal to the department of first instance - (yes)
Fundamental procedural defect - (yes)
Reimbursement of appeal fee - (yes)
Competence of the boards of appeal - composition of the board of appeal

Decisions cited:
G 0005/83, G 0008/91, J 0002/08, T 0390/86, T 0433/93, T 0990/06, T 2106/09, T 0285/11, T 1254/11

Catchword:
In principle, an opposition division may set aside a decision to enlarge its composition pursuant to Article 19(2) EPC (Reasons, point 11.2).

Where an opposition division has been enlarged, but the case is nevertheless decided in a composition of three members, there should be clear evidence on the public file that a decision to set aside enlargement was taken by the opposition division in its four member composition prior to the final decision (Reasons, point 17.3).

Europäisches Patentamt
European Patent Office
Office européen des brevets

Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1088/11 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 17 June 2016

Appellant: (Opponent)	Infineon Technologies AG Am Campeon 1-12 85579 Neubiberg (DE)
Representative:	Westphal, Mussgnug & Partner Patentanwälte mbB Herzog-Wilhelm-Strasse 26 80331 München (DE)
Respondent: (Patent Proprietor)	Hitachi, Ltd. 6, Kanda Surugadai 4-chome Chiyoda-ku, Tokyo 101-8010 (JP)
Representative:	Gill, Stephen Charles Mewburn Ellis LLP City Tower 40 Basinghall Street London EC2V 5DE (GB)
Decision under appeal:	**Decision of the opposition division of the European Patent Office posted on 31 March 2011 rejecting the opposition filed against European patent No. 1174921 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman G. Eliasson
Members: S. Ward
C. Schmidt

Summary of Facts and Submissions

I. This is an appeal by the opponent against the decision of the opposition division rejecting the opposition against European patent EP 1 174 921.

II. In the letter dated 16 September 2015 the appellant-opponent (hereinafter, the opponent) requested that:
- the impugned decision be set aside and the case be remitted for a fresh decision to an opposition division in a composition of three new members;
- the appeal fee be reimbursed.

The board interprets these requests as replacing the request in the notice of appeal that the decision of the opposition division be set aside and the patent revoked.

The respondent-proprietor (hereinafter, the proprietor) requests that the appeal be dismissed so that the patent is maintained in unamended form.

III. In the notice of opposition the patent was opposed in its entirety on the grounds that its subject-matter was not new and did not involve an inventive step. In the letter of 7 March 2011 an unallowable extension of subject-matter contrary to Article 123(2) EPC was also alleged.

In the procedure before the opposition division, a summons to attend oral proceedings pursuant to Rule 115(1) EPC was sent, bearing the electronic signatures of the chairman, the 1st and 2nd examiners and a legally qualified member, and the seal of the EPO pursuant to Rule 113(2) EPC (Rule 70(2) EPC 1973). Three annexes were mentioned in the summons, including a "Communication (EPO Form 2906)". Under point 2 of this

communication it was stated: "The opposition division, which has been enlarged by a legally qualified examiner (Art. 19(2) EPC), gives the following preliminary opinion".

Both parties confirmed in writing that they would not be represented at the oral proceedings, and in a communication bearing the phrase "For the Opposition Division", but not referring to any individual members, the parties were informed that the oral proceedings were cancelled and that the procedure would be continued in writing.

A decision rejecting the opposition was issued, bearing the seal of the EPO and the electronic signatures of the same chairman, 1st examiner and 2nd examiner mentioned in the summons, but not that of the legally qualified examiner. In the enclosed reasons, the opposition division stated the following:

- *"The opposition division has been enlarged by a legally qualified examiner (Art. 19(2) EPC) in view of an offer to hear witnesses. Since the hearing of the witnesses will not take place, the enlargement of the division is no longer necessary and the decision for the enlargement is set aside."* (Reasons, point 3.2.)

IV. During the appeal, the board sent a summons to oral proceedings accompanied by a communication under Article 15(1) RPBA setting out its preliminary and non-binding opinion focusing mainly on the question of admittance into the proceedings of a ground of opposition (Article 100(c) EPC) and several documents (D9-D12) which the opponent had attempted to introduce into the proceedings

after the expiry of the 9 month period mentioned in Article 99(1) EPC.

Both parties confirmed in writing that they would not be represented at the oral proceedings before the board; the oral proceedings were cancelled.

In a communication pursuant to Rule 100(2) EPC the board informed the parties that in preparing the oral proceedings it had come to the preliminary opinion that it was doubtful whether the opposition division had taken the decision under appeal in the correct composition, and gave reasons for this provisional conclusion. The parties were invited to comment on this matter, if they so wished, particularly in relation to the enlargement and reduction of the opposition division.

In a response dated 16 September 2015 the opponent argued that the impugned decision had indeed been taken by the opposition division in a wrong composition, and made the requests set out under point II, above. The proprietor did not respond.

V. Claim 1 of the main request (granted patent) reads as follows:

"A semiconductor device in which a lead frame (13) fixedly adhered via an insulating layer (18) to one surface of a base substrate (15) serves as a circuit conductor and on which frame one or more power semiconductor elements (11) are mounted, an end portion (17) of said lead frame (13) being bent so as to stand up from the surface of said base substrate (15) as an outward guided terminal (17),

wherein, in a portion of the lead frame (13), there is a portion (130) of reduced thickness provided by recessing of the surface of the lead frame (13) adhered to the surface of the base substrate (15), and the lead frame (13) is bent at this portion (130) of reduced thickness."

VI. The arguments of the opponent, insofar as they are relevant to the present decision, may be summarised as follows:

The decision was taken in a wrong composition of the opposition division which represented a grave procedural error, so that the impugned decision was not lawful. Moreover, an appeal procedure required that the contested decision be taken by an opposition division which was correctly composed according to the EPC. As this was not the case, and as no special reasons in the sense of Article 11 RPBA were apparent, a remittal could not be dispensed with on grounds of procedural economy (T 990/06, Reasons, points 2.1, 2.2, 2.5, 3.2 and 4).

In the contested decision the opposition division was particularly and verifiably wrong to conclude that the ground of opposition according to Article 100(c) EPC and the documents D9-D12 were only introduced after the time limit of Rule 116(1) EPC. As the opposition division was demonstrably in error in this respect, in judging the question of admissibility of the ground of opposition according to Article 100(c) EPC and the documents D9-D12, it exercised its discretion on the wrong basis.

Following a remission for a fresh decision, the opposition division would have to exercise its discretion anew. If the opposition division were composed of members who had already taken part in the

impugned decision, there would be a corresponding danger that these members would be guided by their previous decision, since they would be unable to erase from their memories the result of their own earlier decision, which objectively was taken on a wrong basis (T 433/93, and Case Law of the boards of Appeal, 7th Edition, III.J. 8.4). It was irrelevant whether the members concerned had been partial in the previous procedure. What was decisive was whether a party could have a well-founded apprehension that he would not receive fair treatment if the remitted case were dealt with by the opposition division in the same composition.

These considerations applied all the more in the present case, since a decision involving discretion may normally no longer be reviewed in a subsequent appeal procedure. Consequently the opponent had a legitimate interest in a different composition for the opposition division.

An opposition division in a wrong composition represented a grave procedural error. Hence, a full refund of the appeal fee according to Rule 103(1)(a) EPC was appropriate.

VII. The proprietor did not respond to the invitation of the board to comment on the whether the impugned decision was taken by the opposition division in the correct composition. The arguments of the proprietor which are relevant to the present decision, may be summarised as follows:

The decision of the opposition division was correct and complete, as was the reasoning. In particular, the opposition division was correct to conclude that the allegations of prior use made by the opponent were insufficiently substantiated, and to decide not to

conduct a hearing of witnesses. It was also correct to conclude that independent claim 1 had novelty and inventive step over the content of the documents filed with the notice of opposition.

Furthermore the opposition division was correct to exercise its discretion to refuse to admit the new ground of opposition (Article 100(c)) and the proprietor did not consent to the introduction of this ground into the appeal proceedings.

The opposition division was also correct to exercise its discretion to refuse to admit the new documents sent to the EPO with the letter of 7 March 2011 as being "late-filed" and not relevant. These documents were "late-filed" in the opposition regardless of whether they were filed within a time limit set under Rule 116 or not. There was no explanation from the opponent why the sending of these documents was delayed until such a late stage of the proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *The procedural issues*

2.1 A decision taken in a wrong composition of the opposition division is not legally valid (T 390/86, Reasons, points 7 and 8), and according to Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. It

therefore falls to the board to determine whether the composition of the opposition division indicated in the contested decision was correct at the time the decision was taken.

3. The enlargement of the opposition division

3.1 According to Article 19(2) EPC, "An opposition division shall consist of three technically qualified examiners". However, "If the opposition division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner". Logically it is clear that the decision to enlarge must be taken before enlargement, and hence, according to Article 19(2) EPC, the decision to enlarge is to be taken by the opposition division in a composition of three technically qualified examiners.

3.2 In the present case, therefore, it may be regarded as procedurally odd that the parties were informed that the opposition division had been enlarged (a decision to be taken in a three person composition) in an annex to the summons to oral proceedings, the summons itself bearing the electronic signatures of a four person opposition division, including a legally qualified member (see point III, above).

3.3 The relevant question, however, is not whether there might have been a clearer or more logical way of proceeding, but whether the procedure actually followed was sufficient to meet the requirements of Article 19(2) EPC.

In the opinion of the board, the communication can only be reasonably read as meaning that the opposition division in its initial composition of three technically

qualified members decided to enlarge the division, that the opposition division was duly enlarged by the addition of a legally qualified member and that the provisional views on substantive matters were those of the enlarged division. The board can therefore accept that the opposition division was validly enlarged to a four member composition.

4. *The reduction of the opposition division*

4.1 Despite the opposition division having been enlarged, the impugned decision rejecting the opposition did not bear the electronic signature of the legally qualified examiner, but only those of the chairman, 1st examiner and 2nd examiner mentioned in the summons. In the enclosed reasons, the opposition division stated that:

- *"the enlargement of the division is no longer necessary and the decision for the enlargement is set aside."* (see point III, above).

4.2 The impugned decision, electronically signed by three examiners, can only be considered to have been taken in the correct composition if the decision to set aside the enlargement of the opposition division was valid and had legal effect.

4.3 Determining whether this was the case raises a number of questions. In particular, is it in principle possible to set aside a decision to enlarge the opposition division? If so, was it possible under the circumstances of this particular case? If the answer to both of these questions is yes, did the procedure followed by the opposition division have the legal effect of setting aside the decision to enlarge the opposition division?

5. *Is it possible in principle to set aside a decision to enlarge the opposition division?*

5.1 The patent in suit was granted before the entry into force of EPC 2000, and hence the provisions of Article 19(2) EPC 1973 apply. Article 19(2) EPC 1973 (which differs only in minor editorial details from Article 19(2) EPC 2000) reads as follows:

"An opposition division shall consist of three technical examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent shall not be the Chairman. Prior to the taking of a final decision on the opposition, the opposition division may entrust the examination of the opposition to one of its members. Oral proceedings shall be before the opposition division itself. If the opposition division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner who shall not have taken part in the proceedings for grant of the patent. In the event of parity of votes, the vote of the Chairman of the Division shall be decisive."

Article 19(2) EPC does not therefore contain any explicit indication whether a subsequent reduction of an enlarged division is permitted or not permitted; it is simply silent on the matter. In the following, the board sets out some of the views expressed on this matter which have been found in various sources.

5.2 Case law of the boards

5.2.1 To the board's knowledge, the earliest decision which is directly relevant to the present question is T 990/06. In this decision the possibility of reduction from four to three members was accepted, and the board went into considerable detail on the procedure to be followed (see point 14, below). However, the board did not explain why it concluded that such a reduction was possible - this seems to have been simply an assumption (see Reasons, points 2.1 and 2.4).

5.2.2 The case was remitted to the opposition division and was subject to a second appeal (T 2106/09) dealt with by the same board in a different composition. The question whether the setting aside of the decision to enlarge was done in a procedurally acceptable manner was again discussed (see point 15, below), but the possibility of reduction from four to three members was, again, accepted without question.

5.2.3 As far as the board is aware, the only other case dealing with reduction of the composition of an opposition division is T 1254/11, and this also appears to be the only case addressing the question (raised by the appellant-proprietor in that case) whether such a reduction is possible at all.

The deciding board in T 1254/11 concluded that an opposition division enlarged to four members can be reduced again to three members (Reasons, Point 1.4), the reasons being summarised as follows:

Reference was made to decisions T-251/00 of 20 November 2002 and T-488/09 of 12 May 2011 handed down by the General Court of the European Union (formerly referred to as Court of First Instance). The board cited the

following passage from point 130 of T-251/00, which was confirmed under point 106 of T-488/09:

- *"in accordance with a general principle of law that, in principle, a body which has power to adopt a particular legal measure also has power to abrogate or amend it by adopting an actus contrarius, unless such power is expressly conferred upon another body."*

The board held that this principle also applied in European patent law, and hence derived that an opposition division enlarged to four members pursuant to Article 19(2) EPC 1973 can be reduced again to three members.

In addition, the board considered that the cited principle is also a principle of procedural law generally recognised in the Contracting States to the EPC pursuant to Article 125 EPC 1973.

The possibility of a reduction was also justified on grounds of procedural efficiency.

Finally, in deciding whether to reduce an opposition division, the opposition division must use its discretion properly: there may be circumstances where such a reduction would be inappropriate (See reasons, point 1.4, last three paragraphs).

5.3 Commentaries on the EPC

5.3.1 References to the question under discussion (often in relation to an analogous reduction of an examining division, following enlargement under Article 18(2) EPC) occur in several well-known commentaries on the EPC.

5.3.2 In Singer: European Patent Convention, revised English Edition by Raph Lunzer, London 1995, point 18.09, the following view was taken:

- *"If the Examining Division avails itself of the option provided in Article 18(2) of including a legally qualified examiner, he then remains part of that Division for the rest of the procedure, until there is a decision to grant or refuse."*

A decision to enlarge was therefore seen as irrevocable.

5.3.3 In earlier editions of the corresponding German publication, a similar view was taken, albeit more tentatively:

"Die in Abs 2 Satz 4 vorgesehene Ergänzung der Prüfungsabteilung durch einen rechtskundigen Prüfer dürfte, wenn sie einmal vorgenommen ist, für das ganze Prüfungsverfahren gelten." (Singer/Stauder, "Europäisches Patentübereinkommen", 2nd edition, Köln: Heymanns, 2000, Art. 18, note 27.)

The board translates this as follows:

The enlargement of the examining division by a legally qualified member provided for in paragraph 2, sentence 4, once carried out would seem to apply for the entire examination procedure.

5.3.4 However, in the current version of this work (Singer/ Stauder, Europäisches Patentübereinkommen, 7. Auflage 2016, Carl Heymanns Verlag) under point 17 relating to Article 18(2) EPC, the view is taken that if the reason for enlargement no longer applies, then:

- *it appears for reasons of procedural economy* ["Verfahrensökonomie"] *not appropriate to retain the legally qualified member. It is not objectionable if the relationship of the legally qualified member is rescinded by a decision of the Division.* (Translation by the board.)

There is also a reference to a footnote which (again translated by the board) reads "c.f. T 990/06 from 8 June 2009, Reasons No. 2.1".

5.3.5 Hence, in the cited commentaries, prior to the issuance of T 990/06, enlargement of the division was seen as permanent and not capable of being set aside. Subsequently, under the influence of T 990/06, the contrary position was taken.

5.4 Guidelines

Although not binding on the boards, the board has nevertheless looked into the Guidelines to see what, if anything, is said there of relevance to the question. In the current (November 2015) version of the Guidelines for Examination the principal references to enlargement of a division appear to be C-VIII, 7 and D-II, 2.2, with mention also being made in C-VIII, 4; E-II, 5; E-III, 1.3 and E-III, 1.6.1. Although advice is given on when to enlarge a division and other general issues in relation to enlargement, the question of a possible reduction of a division back to a three person composition is nowhere mentioned.

6. The view of the board

6.1 As noted above, Article 19(2) EPC is absolutely silent on whether, following a decision to enlarge an opposition division to a four member composition, the division may subsequently be reduced to a three member composition.

The silence of Article 19(2) EPC on this matter does not, by itself, allow any definitive conclusion to be drawn either way.

On the one hand, the absence of any explicit prohibition is not sufficient to conclude that a reduction back to three members is permitted. While the principle that "everything which is not forbidden is allowed" may have application in certain legal systems in relation to the freedom of the individual before the law, the board is not aware of it having any application to public authorities such as the EPO, the actions of which should generally be grounded on a legal basis, not on the mere absence of a contrary provision.

On the other hand, the absence of any explicit provision for a reversal of enlargement does not necessarily mean that it is prohibited. Certain generally accepted procedural practices exist despite the lack of any explicit basis in the EPC, for example telephone calls or interviews between members of an examining division and the applicant, or the cancellation of oral proceedings when it is no longer expedient to hold them.

6.2 Moreover, the board does not believe that procedural economy or efficiency can be the sole, or even the main, consideration. It cannot be the case that any conceivable procedural act should be available to an opposition division merely because it simplifies or expedites the case, despite having no legal basis.

A similar conclusion was reached in J 2/08. While accepting that the principle of economy of procedure could be taken into account when interpreting procedural provisions, the deciding board went on to state the following:

"Even if a point of law which is qualified as being of fundamental importance should concern procedural issues only, economy of procedure could probably not be chosen as the decisive factor when deciding on the point." (J 2/08, Reasons, point 50.)

6.3 In contrast to proceedings before the boards of appeal, "the opposition procedure is a purely administrative procedure" (G 8/91, Reasons, point 7), and the board can accept that the opposition division should have a certain degree of procedural flexibility proper to an administrative body. In deciding whether reversing a decision to enlarge an opposition division goes beyond the proper limits of such flexibility, the board considers it pertinent to ask whether any reasonable objection could be raised against such a procedural act. In particular, the board will consider whether a reduction in the composition of the opposition division could be reasonably objected to on the grounds that:

a) it is implicitly prohibited by the EPC;

b) it is incompatible with the jurisprudence of the boards of appeal;

c) it is incompatible with generally acknowledged legal principles such as the principle of equal treatment or the principle of good faith, or with other accepted sources of interpretation of the

EPC such as those mentioned under point 5 of the Reasons of G 5/83; or

d) it adversely affects a party to the proceedings.

7. *Is a reduction of the opposition division implicitly prohibited by the EPC?*

7.1 Certain procedural acts, even if not mentioned in the EPC, might nevertheless be judged to be implicitly prohibited, in particular where the act would be clearly incompatible with provisions of the EPC.

7.2 However, the board cannot identify any provision of the EPC which would rule out setting aside a decision to enlarge an opposition division pursuant to Article 19(2) EPC, or any other reason to suppose that it is implicit in the EPC that such a measure is not permitted.

8. *Is a reduction of the opposition division compatible with the jurisprudence of the boards?*

8.1 In T 990/06, T 2106/09 and T 1254/11 the possibility, in principle, of reducing the opposition division from four to three examiners was either tacitly accepted or explicitly endorsed, which obviously speaks in favour of the practice.

8.2 On the other hand, the jurisprudence of the boards may place limitations on, for example, the point in the procedure at which such a reduction can take place.

In particular, the names of the members appearing on a written decision of an opposition division should correspond to those examiners who actually personally took the decision (see e.g. T 390/86, points 7 and 8),

and hence if a legally qualified examiner was involved in taking the decision on substantive matters (for example, at oral proceedings), the decision to enlarge clearly cannot be set aside subsequently.

8.3 This is not an issue in the present case, as it appears from the file that the legally qualified member was involved only in preparing the annex to the summons to oral proceedings, in which it was clearly stated that provisional opinions only were being offered (see points 2, 2.2.4 etc.), and not in drawing up the final decision.

9. *Is a reduction of the opposition division compatible with generally acknowledged legal principles?*

9.1 It is not necessary for the board to decide whether there could ever be circumstances in which a decision to set aside enlargement could be held to be incompatible with the principle of equal treatment of the parties (impartiality), the principle of good faith (protection of legitimate expectations) and similar generally accepted principles. It is sufficient to note that no such incompatibility can be seen in the present case.

9.2 The same is true in relation to other sources of interpretation generally used in the interpretation of the EPC, such as the *travaux préparatoires* (see G 5/83, Reasons, point 5).

10. *Did reducing the opposition division adversely affect a party to the proceedings?*

10.1 It would not be tolerable for a party to the proceedings to be adversely affected by a procedural act of the opposition division for which there is no basis in the

EPC. For example, it would not be acceptable if an additional administrative or financial burden were to be imposed on a party by an act of the opposition division lacking a legal basis.

10.2 Again, it is unnecessary for the board to decide the general case of whether a party could ever be adversely affected by a reduction of the opposition division. It is sufficient to note that in the present case, the setting aside of the decision to enlarge the opposition division did not impose any additional burden on the parties, nor can it be seen that it resulted in any infringement of the parties rights or had any other negative consequences for the parties.

It is true that the decision of the opposition division to reject the opposition adversely affected the opponent, but there is no causal link between this and the decision to reduce the composition of the opposition division.

11. *Conclusion*

11.1 No reasonable objection could be raised against the reduction of the opposition division based on the above considerations, nor on any other considerations which are apparent to the Board. Where no reasonable objection arises, it would be appear to be a somewhat perverse interpretation of the EPC to insist nevertheless on a senseless prohibition.

For example, it is common practice, as noted above, for duly appointed oral proceedings which are no longer necessary to be cancelled, even though no basis exists for such a procedure in the EPC. Procedural economy may be the *motivation*, but it does not provide the

justification, since many procedural acts could be envisaged which would shorten the procedure, but which would nevertheless be unacceptable. In the judgement of the board, the justification is that no reasonable objection could possibly be raised against cancelling oral proceedings that neither the EPO nor the parties considered necessary or desirable.

Similarly, other than in exceptional cases alluded to above, a reduction of the opposition division is justified by the fact that no reasonable objection can be raised against it.

11.2 The Board therefore answers the first two questions posed under point 4.3, above, as follows: In principle, an opposition division may set aside a decision to enlarge its composition pursuant to Article 19(2) EPC. While there may be particular cases where such a procedure would be inappropriate, no exceptional considerations are apparent in the present case which would limit the discretion of the opposition division in this regard.

11.3 The opposition division was therefore lawfully entitled to reduce the enlarged opposition division from four members back to three. The Board now turns to the questions of procedure.

12. *Competence to set aside enlargement*

12.1 According to Article 19(2) EPC it is the opposition division which decides on enlargement, and by analogy the board has no doubt that it must be the opposition division which decides on any subsequent reduction. Furthermore the term "opposition division" can only mean the opposition division in its correct composition at

the time of taking the decision. Hence a decision on enlargement must be taken by the opposition division in a three person composition, and a decision on reduction must be taken by the opposition division in a four person composition.

12.2 The same conclusion was reached in T 990/06 (Reasons, point 2.4), and explicitly confirmed in T 1254/11 (Reasons, point 1.4, page 16, second paragraph). In T 2106/09 it appears to have been tacitly assumed.

13. *T 990/06: Formal requirements for a valid reduction*

13.1 Among the three decisions mentioned above, the strictest view on the formal requirements was taken in T 990/06.

13.2 The board found that where an opposition division was enlarged by a legally qualified member, the file would have to include a respective decision signed by the three members of the opposition division, and where the enlargement had subsequently been set aside, then the file would also need to include a respective decision, signed by all four members (Reasons, point 2.4).

14. *T 2106/09: Formal requirements for a valid reduction*

14.1 Following remittal in T 990/06, the opposition division issued a second interlocutory decision dated 18 August 2009, which was subject to a second appeal (T 2106/09) dealt with by the same board in a different composition.

14.2 The interlocutory decision which was sent to the parties was signed by the three technical members only, while the version available in online file inspection carried the name of a fourth member.

Under point 8.1 of second interlocutory decision, the opposition division stated the following:

"It is to be noted that with an internal decision of 3 May 2005 the opposition division was enlarged, and with an internal decision of 15 November 2005 the enlargement of the opposition division by a legally qualified member was rescinded" (translation by the board).

It was further declared that that since 15 November 2005 the opposition division had been composed of three members.

14.3 The board judged that the appearance of four members on the version available in online file inspection was an obvious error, but it was not justified to regard it as a grave procedural error.

The procedure used to reduce the composition of the opposition division appears to fall short of the requirement of T 990/06 that a decision to set aside enlargement signed by all four members should be in the public file, but it was nevertheless apparently accepted by the board.

15. *T 1254/11: Formal requirements for a valid reduction*

15.1 In case T 1254/11, the summons to oral proceedings before the opposition division bore the names of three technically qualified examiners and a legally qualified examiner, and the accompanying communication included the statement: "The opposition division, which has been enlarged by a legally qualified examiner (Article 19(2) EPC)...".

15.2 The decision to revoke the patent dated 31 March 2011 bore the names of three technically qualified members only, and included at point 8 of the "Facts and Submissions" the following statement:

"The enlargement of the division by a legally qualified examiner has been set aside on 22.03.2011 since no witness need to be heard anymore."

15.3 The board noted that:

"different from the situation in T 990/06, it is possible to determine from the file that the division was lawfully enlarged and, at a later stage, lawfully reduced again" (Reasons, point 1.9).

Although it was accepted that there was no explicit indication who took the decision to reduce the composition, the board nevertheless concluded that:

"absent any indication to the contrary, it must be assumed that the decision was adopted in a lawful manner, i.e. that the whole of the panel comprising four persons took it" (Reasons, point 1.6).

16. *EPO practice*

16.1 It is certainly the case that opposition divisions from time to time set aside decisions to enlarge their compositions. However, it is doubtful whether any harmonised procedure exists for so doing, and - as mentioned above - the Guidelines are silent on the matter.

The formal procedure advocated in T 990/06, requiring a decision signed by all four members to be in the public file, was not followed by the opposition division in that case, nor in the cases leading to decisions T 2106/09 and T 1254/11, nor in the present case. In T 2106/09 there are explicit mentions of "internal" decisions (see point 14.2, above).

16.2 There is evidence, however, that at least some opposition divisions have adhered to the transparent procedure set out in T 990/06. For example, in the opposition to European patent EP 1 493 324 (application number 04 015 480) the opposition division sent a decision rejecting the opposition dated 5 January 2011 bearing the names of three members, and the public file also contains a separate decision of the opposition division signed by four members formally setting aside the enlargement (bearing an EPO date stamp of 5 January 2011 and apparently sent to the parties).

17. *The view of the board on procedural requirements*

17.1 Decisions of opposition divisions must not only be taken in the correct composition, but must be seen to have been taken in the correct composition, both by the parties and by the public (see T 390/86, point 7, fifth paragraph).

17.2 It follows that the legal validity of an enlargement or a reduction of an opposition division may only be established on the basis of the evidence in the publicly available file.

17.3 In particular, where an opposition division has been enlarged pursuant to Article 19(2) EPC, but the case is nevertheless decided in a composition of three members,

there should be clear evidence on the public file that a decision to set aside enlargement was taken by the opposition division in its four member composition prior to the final decision.

It is not for the board to lay down a specific procedure to be followed. Certainly, the procedure advocated in T 990/06 of including in the file a decision to set aside enlargement signed by all four members (according to Rule 113 (1) or (2) EPC) would be one way of providing such evidence. However, other possibilities might be envisaged.

18. *Procedure followed in the present case*

18.1 In the present case, the only indication on file that the decision to enlarge the opposition division had been set aside is the following statement in the reasoning of the final decision taken in a composition of three examiners:

"the enlargement of the division is no longer necessary and the decision for the enlargement is set aside" (Reasons, point 3.2).

18.2 There is therefore no evidence on the public file that the purported setting aside of enlargement had been decided in a four member composition, or any indication of a separate decision on this matter. Whether a prior "internal decision" on the reduction of the opposition division took place is irrelevant. The correctness of the composition of the opposition division which took the contested decision must be judged on the basis of the publicly available file.

18.3 The only publicly available reference to the reduction of the opposition division is found in the impugned decision itself. In contrast to cases T 2106/09 and T 1254/11 there is no hint that the decision to reduce took place at any other point in the procedure. The board therefore judges that the contested decision must be taken at face value, and that the part of it dealing with the reduction of the opposition division represents the decision to set aside enlargement, a decision taken by the opposition division in a composition of the three technically qualified examiners whose electronic signatures appear on it. The decision to set aside enlargement was therefore taken by the opposition division in the wrong composition.

19. *The requests of the opponent*

The requests of the opponent in the letter dated 16 September 2015 will be dealt with in the following order:

a) that the impugned decision be set aside and the case be remitted for a fresh decision to an opposition division;
b) that the appeal fee be reimbursed; and
c) that the opposition division be in a composition of three new members in the remitted procedure.

20. *Request to set aside the decision and remit the case*

20.1 The decision to set aside enlargement was taken by the opposition division in the wrong composition and therefore must be considered void and without legal effect. Consequently, at the time of issuing the impugned decision the correct composition *de jure* of the opposition division was one of four members, but the public file shows that the decision was taken by, and

bore the signatures of, only three members. The decision to reject the opposition must therefore be regarded as having been taken in the wrong composition.

20.2 Article 11 RPBA states the following:

- *"A board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise."*

One such fundamental deficiency is where a decision cannot be considered to be legally valid by virtue of a "wrong composition of the examiners who signed it" (see T 390/86, Reasons, point 8).

The board accepts that a remittal to the department of first instance would introduce considerable procedural delay, but this cannot be regarded as one of the "special reasons" referred to in Article 11 RPBA. Where there are good grounds for supposing that the impugned decision was taken in an incorrect composition, calling into question the legal validity of that decision, the case should be remitted to the department of first instance. The board concurs with the finding in T 990/06 (Reasons, point 3.2) that under these circumstances considerations of procedural economy can play no role.

20.3 This conclusion is not inconsistent with T 1254/11, as the factual situation in the present case is different. In T 1254/11 there was an indication at point 8 of the "Facts and Submissions" of the decision under appeal that the enlargement of the division by a legally qualified examiner had been set aside prior to the final decision, and the board decided that it was satisfied

that "it is possible to determine from the file that the division was lawfully enlarged and, at a later stage, lawfully reduced again". Furthermore, the board considered that "these circumstances constitute special reasons for not remitting the case within the meaning of Article 11 RPBA (Reasons, point 1.9).

Whether, confronted with the same facts, the present board would or would not have reached the same conclusion is irrelevant. What is important is that the facts in the present case are different, as there is no reference to or hint of any prior decision to reduce the division.

20.4 As the board sees no "special reasons" within the meaning Article 11 RPBA, the case is to be remitted to the department of first instance for further prosecution. Since no lawful reduction of the opposition division took place, the board considers the opposition division to be currently composed of four members. Hence, any decision of the opposition division in the remitted procedure should be taken in either its current four person composition, or in a three person composition following a lawful decision to set aside enlargement in accordance with the principles set out above.

20.5 Since the impugned decision has been found to have no legal effect, the board considers that it would be inappropriate in the present decision to comment on matters other than the formal issues dealt with above. A new formally correct decision must be issued, and it is entirely a matter for the opposition division to determine whether the substance of the new decision should be the same as, or different from, the impugned decision.

21. *Request for the appeal fee to be reimbursed*

21.1 According to Rule 103(1)(a) EPC, reimbursement of the appeal fee shall be ordered "if such reimbursement is equitable by reason of a substantial procedural violation."

21.2 A decision signed by the opposition division in a wrong composition is a substantial procedural violation (see point 20.2, above). Moreover, in the event that the opposition division, in the remitted procedure, were to issue a decision adversely affecting the opponent based essentially on the reasoning of the impugned decision, the opponent would have to pay a second appeal fee to challenge this decision. It would not be equitable for the opponent to be obliged to pay two appeal fees in relation to essentially the same issues as a result of a procedural error. Consequently, reimbursement of the appeal fee is appropriate.

22. *Request to change the composition of the opposition division*

22.1 According to Article 111(1) EPC, a board of appeal "may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution."

In remitting a case to the department of first instance, it is questionable whether a board of appeal has the power to order replacement of members of an examining or opposition division in the case of a substantial procedural violation (see e.g. T 285/11, Reasons, point 7). However, this is not a question which needs to be

considered in the present case, since the board sees no reasons which would warrant ordering or even suggesting such replacement.

22.2 Firstly, to the extent that the opponent's request concerns the refusal to admit the documents D9-D12 into the procedure, the board has already indicated above that the present decision will focus only on the question of the correctness of the composition of the opposition division at the time of issuing the decision. It is for the opposition division in the remitted procedure to decide on other matters.

22.3 Secondly, in relation to the taking of the decision in the wrong composition, although it is considered that a substantial procedural violation was committed, the present decision should not be interpreted as implying criticism of the members of the opposition division.

22.4 Decisions setting aside enlargement of opposition divisions are clearly part of opposition procedure at the EPO (see point 16, above), but the board is unable to identify any instructions either in the Guidelines for Examination (see point 5.4, above) or elsewhere setting out a procedure to be followed. The opposition division cannot be blamed for failing to follow instructions and official procedures which (apparently) do not exist.

23. *Composition of the board*

23.1 According to Article 21(4) EPC,

"For appeals from a decision of an opposition division, a board of Appeal shall consist of:

(a) two technically qualified members and one legally qualified member, when the decision was taken by an opposition division consisting of three members;
(b) three technically and two legally qualified members, when the decision was taken by an opposition division consisting of four members, or when the board of Appeal considers that the nature of the appeal so requires."

23.2 Although a point at issue in the present appeal is whether the impugned decision should have been taken by an opposition division in a composition of four examiners, it is a matter of fact that the decision was taken by an opposition division consisting of three members, and hence the deciding board consists of two technically qualified members and one legally qualified member pursuant to Article 21(4)(a) EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the department of first instance for further prosecution.

3. The appeal fee shall be reimbursed.

The Registrar: The Chairman:

S. Sánchez Chiquero G. Eliasson

Decision electronically authenticated