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**Datasheet for the decision
of 21 January 2015**

Case Number: T 2077/11 - 3.2.03

Application Number: 01119715.9

Publication Number: 1228818

IPC: B21B37/40

Language of the proceedings: EN

Title of invention:

Rolling method for strip rolling mill and strip rolling equipment

Patent Proprietor:

Hitachi Ltd.

Opponents:

SMS Siemag AG
Siemens VAI Metals Technologies SAS

Headword:

Relevant legal provisions:

EPC Art. 108
EPC R. 99(1), 99(2)
RPBA Art. 12(2)

Keyword:

Admissibility of appeal -
appeal sufficiently substantiated (no)

Decisions cited:

T 0165/00, T 0003/95, T 0065/96, T 0922/05

Catchword:



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Case Number: T 2077/11 - 3.2.03

D E C I S I O N
of Technical Board of Appeal 3.2.03
of 21 January 2015

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(Opponent 1)

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted on
28 July 2011 concerning maintenance of the
European Patent No. 1228818 in amended form.**

Composition of the Board:

Chairman	G. Ashley
Members:	C. Donnelly
	E. Kossonakou

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the opposition division dated 28 July 2011, which concluded that the patent could be maintained in amended form according to the first auxiliary request filed during oral proceedings before the opposition division on 8 July 2011.
- II. Opponent 1 (appellant I) and opponent 2 (appellant II) both filed notices of appeal against this decision and paid the appropriate fees in due time. Both appellants also filed their respective grounds of appeal within the specified time limit.
- III. In its reply of 26 April 2012 to the grounds of appeal the patent proprietor (respondent) questioned the admissibility of both appeals arguing that both failed to fulfil all the formal requirements of Rule 99(1) EPC. Furthermore, it pointed out that the statement of grounds filed by appellant I failed to meet the requirements of Article 108 EPC in combination with Rule 99(2) EPC, since it was essentially a copy of the notice of opposition.
- IV. In a communication dated 28 October 2014, pursuant to Article 15(1) RPBA annexed to the summons to oral proceedings, the Board informed the parties of its provisional opinion. In particular, the Board indicated that the formal deficiencies under Rule 99(1)(a) EPC in the notices of appeal could still be rectified.

In its letter of 7 November 2014, appellant I responded by confirming its address. By letter of 12 January 2015 appellant II withdrew its appeal.

- V. Oral proceedings before the Board were held on 21 January 2015.

Requests

- VI. At the beginning of oral proceedings, appellant II (hereinafter: "the appellant") requested that the decision under appeal be set aside and that the European patent N° 1228818 be revoked.

The respondent requested that the appeal be rejected as inadmissible or that it be dismissed, subsidiarily that the patent be maintained according to Auxiliary Requests II and III filed with the reply to the grounds of appeal dated 26 April 2012.

At the conclusion of the debate, the appellant requested that the appeal be admitted. The respondent requested that the sole remaining appeal be declared inadmissible.

- VII. The arguments of the parties can be summarised as follows:

Admissibility of the appeal

Respondent

The sole remaining appeal is not admissible since the grounds filed by the appellant are simply an exact copy of the opposition brief, so that they cannot, as a matter of principle, address the reasons given in the impugned decision. The mere resubmission of the appellant's first instance submissions cannot replace an explicit account of the legal and factual reasons for the appeal. In this case, the Board and the

respondent cannot consider the merits of the appeal without making further investigations as to which grounds of the decision were regarded as mistaken and why (see T349/00 and T165/00).

Appellant

The grounds of appeal are not simply a copy of the grounds of opposition. Section 1 of the grounds of appeal ("Anträge") details a clear request that the impugned decision be set aside and the patent revoked. Section 2 ("Die angegriffene Zwischenentscheidung"), as its title suggests, relates expressly to the contested interlocutory decision. Here it is clearly stated that the opposition division's position that the granted claims 1 to 17 infringed Article 123(2) was correct, but that its finding that claims 1 to 16 of the first auxiliary request met the requirements of the EPC was wrong. Section 5 ("Mangelnde Ausführbarkeit der Erfindung gemäß Streitpatent - Artikel 100(b) EPÜ") concludes that granted claim 1 does not meet the requirements of Article 100(b) EPC. There is nothing in the EPC or in the case-law that prohibits a party from repeating arguments presented during the first instance proceedings.

Section 6 ("Mangelnde Erfindungshöhe des Anspruchs 1 des Streitpatents - Art. 100(a) EPÜ in Verbindung mit Art. 56 EPÜ") sets out in sub-sections 6.1 and 6.2 detailed arguments as to why claim 1 as granted does not involve an inventive step. The first line of the final paragraph of section 6.2 specifically states that this conclusion goes against the opinion of the opposition division. The final sentence of section 9, comprising the summary of the case ("Zusammenfassung"), explicitly repeats the request to set aside the contested decision.

Therefore, the respondent's assertion that it and the Board cannot consider the merits of the appeal without making further investigations is wrong, since it is clear that the grounds of the decision which are mistaken are those relating to insufficiency of disclosure and lack of inventive step. Further, since the opposition division did not accept the arguments of the appellant in the opposition proceedings, it is obvious why the decision is considered to be incorrect without the Board or the respondent having to do any further investigations.

The case-law cited by the respondent does not represent the whole picture, since other decisions do not follow the same line, see for example T003/95, T65/96 and T922/05.

Also, in the present case the appellant is the opponent and only needs to present one reason for the contested patent being invalid and thus having to be revoked. In particular, it is not necessary for the appellant to comment on the reasoning regarding novelty in the contested decision, nor for it to deal with the other documents relied upon by opponent 2. Article 12(2) RPBA requires that the statement of the grounds of appeal contains a party's complete case; there is no requirement to include or to refer to that of other parties as well.

Since the case-law appears to be divergent, it is requested that the procedure be continued in writing in order to give all parties time to study the relevant decisions. However, should the board, against the party's expectations, decide not to admit the appeal,

it is requested that the following question be submitted to the Enlarged Board of Appeal:

"Genügt eine Beschwerdebeurteilung allen Erfordernisse des EPÜ hinsichtlich der Zulässigkeit, wenn in der Beschwerdebeurteilung nicht sämtliche Entscheidungsgründe der angegriffene Entscheidung angesprochen sind?"

Falls ja, genügt eine Beschwerdebeurteilung allen Erfordernissen des EPÜ hinsichtlich der Zulässigkeit, wenn sie nur generell auf die angegriffene Entscheidung verweist und im Wesentlichen eine Wiederholung der in erstinstanzlichen Verfahren vorgetragene Argumente darstellt?"

Reasons for the Decision

1. Admissibility of the appeal.

1.1 The appeal complies with Articles 106 and 107 EPC.

The notice of appeal was filed and the appeal fee was paid within the time period set out in Article 108 EPC, first and second sentences.

As pointed out by the respondent, the notice of appeal failed to indicate the appellant's address as required by Rule 99(1)(a) EPC and did not explicitly state any requests (Rule 99(1)(c) EPC). However, following a communication from the board, the appellant remedied the deficiency under Rule 99(1)(a) EPC by letter of 7 November 2014, as is permitted under Rule 101(2) EPC. Furthermore, the board accepts the established case law that, when an appellant is the opponent, its notice of

appeal can be taken in itself as an implicit request for the contested decision to be set aside and the patent revoked.

- 1.2 Article 108 EPC, third sentence additionally requires that, within four months of notification of the decision, a statement setting out the grounds of appeal shall be filed in accordance with the Implementing Regulations.
- 1.3 Since a submission from the appellant indicating that it was a statement of grounds was received in due time on 7 December 2011, the admissibility of the appeal turns on whether this statement meets the requirements of the Implementing Regulations as laid out in Rule 99(2) EPC and also Article 12(2) of Rules of Procedure of the Boards of Appeal (RPBA).
- 1.4 Rule 99(2) EPC requires that: "In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based."
- 1.5 Article 12(2) RPBA specifies that "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on."
- 1.6 In the present case, the substance of the appellant's statement of grounds of appeal is identical to its grounds of opposition dated 24 August 2009, since the differences between the two documents identified by the

- appellant do not go beyond general statements and the request that the contested decision be set aside.
- 1.7 Section 1 of the grounds ("Anträge") and the final sentence of section 9 ("Zusammenfassung") set out the requests that had been accepted by the board as implicitly present in the notice of appeal. Section 2 ("Die angegriffene Zwischenentscheidung"), is a mere summary of the conclusions reached in the contested decision accompanied by the vague statement that said decision cannot withstand closer scrutiny.
- 1.8 Section 5 ("Mangelnde Ausführbarkeit der Erfindung gemäß Streitpatent - Artikel 100(b) EPÜ") is identical to the wording of the equivalent part of the grounds of opposition. No attempt has been made to address, let alone counter, the reasoning of the opposition division made at section 2.1.4 of the contested decision.
- 1.9 Similarly, sub-sections 6.1 and 6.2 of section 6 (Mangelnde Erfindungshöhe des Anspruchs 1 des Streitpatents - Art. 100(a) EPÜ in Verbindung mit Art. 56 EPÜ) are an exact copy of the corresponding parts of the grounds of opposition. Although the first line of the final paragraph of section 6.2 remarks that the conclusion goes against the opinion of the opposition division, any explanation as to why this is so is not given. The arguments raised in these sections have been answered by the opposition division in paragraphs 4.3, 4.3.3 and 4.3.4 of the contested decision, but the statement of grounds does not address the reasons contained in those paragraphs.
- 1.10 In fact, the appellant's statement of grounds can be summarised as follows: "We disagree with the contested decision. Contrary to the opinion of the opposition

division the subject-matter of claim 1 according to the first auxiliary request fails to meet the requirements of sufficiency of disclosure (Article 100(b) EPC) and does not involve an inventive step (Article 56 EPC) for the reasons given in our grounds of opposition (reproduced here)."

1.11 The appellant is of course correct in stating that there is nothing in the EPC or in the case-law that prohibits a party from repeating arguments presented during the previous proceedings. This approach ignores however the fundamental function of appeal proceedings, whether *ex parte* or *inter partes*, which is the judicial review of a contested decision. To this end it is foreseen that all decisions subject to appeal must set out the reasons supporting the conclusion reached having duly considered all the facts and arguments of the parties (Article 111(2) EPC). By the same token, the party contesting the reasoned decision is expected to consider and rebut at least one of those reasons in its effort to prove that the impugned decision is wrong and should be set aside.

1.12 In conclusion, with the exception of a few insubstantial minor amendments, the statement of grounds of appeal under consideration is essentially identical to that of the grounds of opposition. As such it is effectively equivalent to a simple reference to the grounds of opposition. Thus, as argued by the respondent, by its very nature of having been drafted before the impugned decision was issued, it does not contain any reasons *why* the said decision should be set aside.

- 1.13 It follows that the statement of the grounds of appeal does not meet the requirements of both Rule 99(2) EPC and Article 12(2) RPBA.
- 1.14 This conclusion is entirely in accordance with the established case law, which confirms that merely referring to one's own submissions in the earlier proceedings (or reproducing them *verbatim*, as is here the case) cannot normally replace an explicit account of the legal and factual reasons for the appeal. It is not enough to seek fresh examination of the case for revocation by just indicating disagreement with the finding of the previous instance (see "Case Law of the Boards of Appeal of the EPO", 7th Edition, 2013, C-IV.E.2.6.4).
- 1.15 In the present case, the opposition division gave extensive reasons in paragraph 2.1.4 as to why the appellant's case under Article 100(b) EPC was not accepted. In particular, it referred to the Case Law of the Boards of Appeal of the EPO, 6th Edition, 2010, II.A.7 "Sufficiency of disclosure - Evidence", first two paragraphs, and cited decisions T19/90 and T182/90. It also noted that various examples are presented in the patent specification such that it was plausible that the person skilled in the art can carry out the invention making use of his common general knowledge.
- 1.16 Similarly, the opposition division gave complete reasons at sections 4.3, 4.3.3 and 4.3.4 for rejecting the appellant's case regarding lack of inventive step of claim 1 as granted. In particular, it reasoned that, since the apparatus of DE 3606 857 A1 (D1) and DE 198 11 633 A1 (D4) failed to exhibit certain essential features of the invention, the English translation of JP 61-126903 (D13T) constituted the most relevant

prior art. At section 4.4 of its decision, the opposition division also fully dealt with the inventive step of claims 12 and 13.

1.17 None of these reasons have been addressed by the appellant, who has thus, in effect, left it to the board to argue why the opposition division was not correct. As pointed out in T922/05, (see point 15 of the reasons): "It is highly questionable if it would be appropriate for the board to actively search for the arguments in support of the appellant's case in an inter-partes proceedings, even if the board is clearly entitled to do so by virtue of Article 114(1) EPC. In inter partes proceedings, any active contribution of board made for the benefit of one party without an explicit request of that party may be seen as an action to the detriment of the opposing party and would thus question the impartiality of the board."

1.18 The decisions referred to by the appellant during the oral proceedings do not change this picture. In T003/95, the board decided that the statement of grounds did in fact relate to the decision under appeal, since it discussed the problem to be solved by the invention (see reasons 2.3); the case does not deal with the situation where the statement of grounds is essentially a repeat of the grounds of opposition, but rather with the potential introduction of new grounds of opposition by means of the appeal. Also T65/96 does not concern a case where the statement of grounds is a repetition of the grounds of opposition, but rather a situation where the appeal was based on an apparent lack of comprehension of the reasoning in the decision under appeal. The board decided that the appeal was admissible, indicating that "irrelevancy and lack of cogency" of the "arguments

submitted in the Statement of Grounds of Appeal" may only lead to an unsuccessful outcome of the appeal (see reasons 1.1).

Also T922/05 does not concern a situation where there is merely a reference to or a repetition of the grounds of opposition. However, the board still rejected the appeal as inadmissible, since the statement of grounds was insufficient regarding the reasons of the contested decision. The review of relevant case law performed by the Board in that case is quite unequivocal in the conclusion that the requirement of Article 108 EPC is not merely formal, but envisages a statement setting out the substance of the appellant's case, i. e. the reasons why the decision under appeal should be set aside.

1.19 As laid out in points 2 and 3 of the reasons in decision T165/00 cited by the respondent, which contains references to numerous other decisions, the case law consistently follows the line that a statement of grounds which merely refers to the submissions in previous proceedings is not sufficient.

At the same time, the case law acknowledges the principle that each case should be considered individually and "the question whether a particular statement ... meets the minimum requirements of Article 108 EPC can only be decided in the context of that particular case" (see in particular J22/86 (OJ EPO 1987, 280).

In light of this, the existence of special circumstances has been established only in a very few, exceptional cases, e. g. in T216/10 where the contested decision was very poorly reasoned, thereby limiting the appellant's possibilities for the submission of a comprehensive statement of grounds of appeal.

No such circumstances can be identified in the present case. In particular, it is noted that the contested decision is quite detailed in its reasoning (supra, point 1.15 ff).

1.20 It follows that the case law of the boards of appeal is consistent in this matter and the foreseen exceptions cannot find application in the present case. There is therefore no reason either to continue the procedure in writing or to refer the appellant's question to the Enlarged Board of Appeal in order to reach a decision on the present case.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible

The Registrar:

The Chairman:



C. Spira

G. Ashley

Decision electronically authenticated