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Datasheet for the decision of 29 June 2017

Case Number: T 0158/14 - 3.4.02

Application Number: 01970046.7

Publication Number: 1384058

IPC: G01N1/36

Language of the proceedings: EN

Title of invention:
METHOD AND DEVICE FOR MELTING EMBEDDING MEDIUM

Patent Proprietor:
Thermo Shandon Inc.

Opponent:
pfm medical ag

Headword:

Relevant legal provisions:
EPC 1973 Art. 56
EPC Art. 104(1), 112a(2), 123(2)
EPC R. 106
RPBA Art. 12(4), 13(1), 13(3), 16(1), 16(2)

Keyword:
Late-filed document - admitted (yes) - no abuse of procedure, document highly relevant
Inventive step - main request (no)
Late-filed auxiliary requests - admitted (no) - prima facie not inventive
Apportionment of costs - (no)

Decisions cited:
T 1019/92, T 0671/03, T 1029/05, R 0010/09

Catchword:

Europäisches Patentamt
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Case Number: T 0158/14 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 29 June 2017

Appellant: (Opponent)	pfm medical ag Wankelstrasse 60 50966 Köln (DE)
Representative:	Patent- und Rechtsanwälte Ullrich & Naumann PartG mbB Schneidmühlstrasse 21 69115 Heidelberg (DE)
Respondent: (Patent Proprietor)	Thermo Shandon Inc. 171 Industry Drive Pittsburgh, PA 15275 (US)
Representative:	De Anna, Pier Luigi DeAnna-Patent Schubertstraße 10 80336 München (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted on 11 December 2013 concerning maintenance of the European Patent No. 1384058 in amended form.**

Composition of the Board:

Chairman	R. Bekkering
Members:	A. Hornung
	G. Decker

Summary of Facts and Submissions

I. The opponent appealed against the interlocutory decision of the opposition division maintaining European patent No. 1384058 in amended form.

Opposition had been filed against the patent as a whole and based on the grounds of Article 100(a) EPC, together with Articles 54(1) and 56 EPC.

The opposition division had found that the patent as amended according to a new main request then on file and the invention to which it related met the requirements of the EPC.

II. With a communication dated 14 December 2016, setting out the board's observations, the board summoned the parties to attend oral proceedings.

III. With a letter dated 17 May 2017, received at the EPO on 26 May 2017, the patentee responded to the board's observations and filed sets of claims and corresponding descriptions according to a main request and an auxiliary request.

IV. With a letter dated 31 May 2017, the opponent responded to the board's observations and the patentee's new submissions.

V. With a further letter dated 21 June 2017, received at the EPO on 23 June 2017 (Friday), at 19:17, i.e. three working days before the scheduled oral proceedings on 29 June 2017, the patentee responded again to the board's observations and to the opponent's letter of 31 May 2017. This second letter of the patentee contained approximately 90 pages, including a new main request and new first and second auxiliary requests.

VI. Oral proceedings before the board were held on 29 June 2017.

VII. The opponent (appellant) requested that the decision under appeal be set aside and that the patent be revoked. Furthermore, it requested that the respondent's request for apportionment of costs be refused.

The opponent-appellant also requested that none of the claim requests on file be admitted into the proceedings.

VIII. The patentee (respondent) requested that the decision under appeal be set aside and that the patent be maintained in amended form on the basis of claims 1 to 7 of the main request, of claims 1 to 7 of the first auxiliary request, or of claims 1 to 7 of the second auxiliary request, all requests filed at the oral proceedings of 29 June 2017. Furthermore, the patentee requested apportionment of costs to the extent that its costs incurred be refunded in full.

IX. Independent claim 1 according to the patentee's main request reads as follows:

"A method for melting excess embedding medium formed on the exterior of the walls of a tissue cassette, using a device having:
- a plate (20) having a face (21) and a back side (24) opposite said face (21), said face (21) having a plurality of grooves (23) said grooves (23) extending diagonally across at least a portion of said face (21);

- a trench (22) adapted to receive said melted embedding medium from said plurality of grooves (23); a power module (40,50), adapted to receive power from a power source, for delivering said power from said power source;

- at least one heating element (25) adjacent to said backside (24) of said plate (20), said at least one heating element (25) adapted to receive said power from said power module (40,50); and,

- a stand (30) adapted to carry said plate (20) at an angle to allow gravitational flow of said melted embedding medium along said plurality of grooves (23);

- said method comprising the steps of:

- heating said plate (20) to a temperature sufficient to melt said excess embedding medium;

- contacting said excess embedding medium to said face (21) of said plate (20); and

- sliding said tissue cassette across said plate (20) to melt the excess embedding medium from the tissue cassette as the tissue cassette is moved across the face of said plate (20) so that the melted embedding medium will run through the plurality of grooves (23) to the trench (22) and down the trench (22) to a receptacle."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that it specifies that the plate is heated "to a temperature in the range of 60°C to 90°C" [the additional amendment is underlined].

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request in that it specifies that the plate is carried "at an angle of the plate relative to a horizontal surface in the range of 5° to 45°" and that the method comprises the step of "sliding down" the tissue cassette [the additional amendments are underlined].

X. The following documents will be referred to in the present decision:
D9: JP Hei 5-842 (Y2),
D10: JP 3067577 (U),

in combination with their respective German translation documents D9a and D10a, all documents filed by the opponent with its statement of grounds of appeal. In the following, for referring to concrete passages of D9 and D10, the corresponding page numbers of documents D9a and D10a will be mentioned, respectively.

Reasons for the Decision

1. Admissibility of the appeal and of the documents D9 and D10

1.1 The patentee argued that the appeal was inadmissible for the reason that the opponent's grounds of appeal were exclusively based on the newly cited documents D9 and D10, documents which should not be admitted into the proceedings because they were late-filed and not prima facie relevant for the subject-matter of claim 1 as maintained according to the interlocutory decision of the opposition division.

The patentee explained that it would have been easy for the opponent to find D9 and D10 in public databases, in particular for the reason that D9, D10 and the present patent had at least one of the IPC classes G01N1/36 or G01N1/28 in common. The mere fact that D9 and D10 were not written in an official EPO language was not a sufficient reason for allowing the opponent to introduce these documents into the proceedings after the nine-month period defined in Article 99(1) EPC. The opponent was supposed to have searched during the nine-month period all existing databases, including those of Japanese utility models,

either itself or by mandating a Japanese search company. Furthermore, none of the documents D9 and D10 was novelty destroying or rendered obvious the subject-matter of claim 1. The patentee concluded that D9 and D10 were late-filed, technically not relevant and, therefore, should not be admitted into the proceedings.

In response to a question from the board during oral proceedings, the patentee stated that the filing of D9 and D10 with the statement of grounds of appeal amounted to an abuse of procedure in the sense that these documents were late-filed and that no other objections than those based on D9 and D10 were raised by the appellant in its statement of grounds of appeal against the patent as maintained by the opposition division.

1.2 The opponent was of the view that its appeal fulfilled all the legal admissibility requirements foreseen by the EPC.

It further insisted that documents D9 and D10 were not withheld deliberately by the opponent but that they were retrieved by pure coincidence after the decision of the opposition division with the help of a Japanese client of the opponent, the client having given a hint of the existence of Japanese patent documents disclosing the same invention as the present patent. It was not realistic that the opponent was supposed to search all possible databases in all possible languages. The EPO had also not retrieved these patent documents. Finally, since D9 and D10 were highly relevant for the patentability issue of the claimed subject-matter, they had to be admitted.

1.3 The board notes that the sole reason provided by the patentee for rejecting the appeal as being inadmissible was based on the fact that the opponent's statement of grounds of appeal had exclusively been based on newly cited

documents D9 and D10 which should not be admitted into the proceedings.

Following the established case law of the boards of appeal, the board considers that late-filed documents, as long as there is no abuse of procedure by the opponent, may be admitted into the proceedings if they are prima facie sufficiently relevant for questioning the maintenance of the patent (see e.g. decisions T 1019/92, point 2.2 of the reasons; T 671/03, point 2.2 of the reasons; T 1029/05, point 2 of the reasons).

1.3.1 Abuse of procedure

The board acknowledges that D9 and D10 could in principle have been retrieved within the nine-month opposition period. This, however, is not the issue at stake, but rather whether the late filing of the documents constitutes an abuse of procedure. Concerning this aspect, the board is satisfied that the opponent provided a reasonable justification why D9 and D10 were not filed during the nine-month opposition period: these documents are Japanese utility models having no English abstract and were found by the opponent only by chance after discussing the appealed decision with one of its Japanese clients. Documents D9 and D10 were filed at the earliest possible point in time of the appeal proceedings, i.e. with the statement of grounds of appeal. The board sees no indication that the opponent deliberately withheld D9 and D10 for tactical reasons.

1.3.2 Relevance of D9 and D10

Both D9 and D10 relate to the same technical field as the present invention, i.e preparation of histological samples, deal with the same technical problem, i.e. how to clean tissue cassettes from excess embedding medium and even

disclose the same solution to the problem, i.e. sliding the cassette over a heated plate. Therefore, the board is convinced that D9 and D10 are highly relevant with regard to the patentability of the claimed subject-matter.

1.3.3 For the above reasons, the board decides to exercise its discretion pursuant to Article 12(4) RPBA to admit D9 and D10 into the proceedings.

Since the sole reason substantiating the patentee's request to hold the appeal to be inadmissible is not found convincing by the board, and since the board sees no other reason for holding the appeal inadmissible, the appeal is admissible.

2. Main request

2.1 Admissibility

2.1.1 The opponent stated that receiving from the patentee a letter of approximately 90 pages, including a new main request and new first and second auxiliary requests, just a few days before the oral proceedings represented an unfair behaviour of the patentee and justified a restrictive handling of the RPBA when deciding the admissibility of the claim requests. Moreover, the amended feature of claim 1 "... to melt the *excess* embedding medium ..." introduced a new problem since it contained added subject-matter. Therefore, the main request should not be admitted into the proceedings.

2.1.2 The patentee argued that present claim 1 was identical to claim 1 as filed with its letter of reply to the opponent's statement of grounds of appeal. The subject-matter of present claim 1 represented a limitation of the subject-matter of claim 1 underlying the appealed decision. The

basis for the amended feature could be found on page 4, line 28 to page 5, line 5 of the application as filed. Finally, the term "excess" did not represent added subject-matter since it had a basis in original claim 1.

2.1.3 Acknowledging that filing a submission with a large amount of pages and new claim requests shortly before the oral proceedings should in principle be avoided by any party, the board nevertheless decides that the main request is admitted into the proceedings for the reasons given by the patentee.

2.2 Added subject-matter

2.2.1 According to the opponent, the feature of claim 1 "...sliding said tissue cassette across said plate to melt the *excess* embedding medium from the tissue cassette ..." is an aliud of the feature disclosed in the application as originally filed, page 4, lines 30 to 33, reading "...the user will slide the cassette, having *extra* embedding medium *attached*, down the plate ...". First of all, the words "excess" and "extra" had a different meaning and, secondly, claim 1 omitted the word "attached". Therefore, present claim 1 comprised added subject-matter.

2.2.2 The board is not persuaded by this argument but rather shares the patentee's view according to which it is clear from the application as a whole that the word "excess", used exclusively throughout the original set of claims, and the word "extra", used exclusively throughout the original description, have the same meaning in the expression "excess/extra embedding medium".

Furthermore, the omission in claim 1 of the word "attached" does not add any information either. Claim 1 is a "method for melting excess embedding medium formed on the exterior of the walls of a tissue cassette", which makes it clear

that the excess embedding medium referred to throughout claim 1 is effectively embedding medium *attached* to the cassette.

Therefore, the amendments of claim 1 objected to by the opponent do not comprise added subject-matter (Article 123(2) EPC).

2.3 Inventive step

The subject-matter of claim 1 lacks an inventive step with respect to D9 (Article 56 EPC 1973).

2.3.1 It is undisputed that D9 represents the closest prior art. D9, with reference to figures 1 to 3, discloses a method for melting excess embedding medium formed on the exterior of the walls of a tissue cassette *[see page 3, line 15 to page 4, line 4]*, using a device having:

- a plate (9) having a face (10) and a back side opposite said face (10), said face (10) having a plurality of grooves (12) said grooves (12) extending across at least a portion of said face (10) *[see figure 1]*;

- a trench adapted to receive said melted embedding medium from said plurality of grooves (12) *[the trench is located at the periphery of the face (10), perpendicular to the grooves (12); see figures 1 to 3]*;

- a power module adapted to receive power from a power source for delivering said power from said power source *[implicit disclosure of a power module for supplying power to the heating elements (16)]*;

- a heating element (16) adjacent to said backside of said plate (9), said heating element (16) adapted to receive said

power from said power module *[see page 5, lines 1 and 2; figures 2 and 3]*; and,

- a stand (14) adapted to carry said plate (9) to allow flow of said melted embedding medium along said plurality of grooves (12) *[see page 5, lines 19 to 23: the melted embedding medium flows along the grooves and drops down into a receptacle (15); figure 1]*;

- said method comprising the steps of:

- heating said plate (9) to a temperature sufficient to melt said excess embedding medium *[see page 5, lines 19 to 23]*;

- contacting said excess embedding medium to said face (10) of said plate (9) *[see page 5, lines 9 to 14]*; and

- sliding said tissue cassette across said plate (9) to melt the excess embedding medium from the tissue cassette as the tissue cassette is moved across the face of said plate (9) so that the melted embedding medium will run through the plurality of grooves (12) to through-holes (13) located between adjacent grooves (12) and down to a receptacle (15) *[the grooves (12) are integrally formed with the plate (9) made of aluminium (see e.g. figure 3); aluminium is a thermally conductive material so that the heating elements (16) heat the aluminium plate (9) and the grooves (12) (see page 5, lines 1 and 2); the cassette is in contact with the heated grooves (12) and in close proximity with the heated plate (9), while it is slid across the plate (9) (see page 5, lines 9 to 23), so that the excess embedding medium formed on the exterior walls of the cassette is inherently heated and at least partially melted]*.

2.3.2 The claimed subject-matter differs from the method of D9 in that

- the grooves extend diagonally across the face,
- the stand carries the plate at an angle to allow gravitational flow and
- the melted embedding medium runs to the trench and down the trench to a receptacle.

Indeed, in spite of the ambiguity of the expression "grooves extending diagonally" in claim 1, the board notes that D9 does not disclose any direction with respect to which the grooves extend diagonally. On the contrary, according to figure 1 of D9, the grooves (12) extend in a perpendicular or parallel direction with respect to the periphery of the plate (9) or the stand (14). The expression "grooves extend diagonally across the face" is interpreted as suggested by the patentee in its letter of reply of 13 June 2014 as meaning that the grooves extend along a direction which is not parallel with respect to outer sides of the plate.

Furthermore, D9 is silent about the angle at which the plate (9) is maintained in the stand (14), whereas claim 1 requires that the angle allows gravitational flow, i.e. an angle different from zero.

Finally, apart from through-holes located in selected grooves, D9 does also not explicitly disclose through-holes in the trenches.

2.3.3 The technical effect of the differing features is to evacuate the melted embedding medium. Therefore, the objective technical problem consists in the provision of a device which optimizes the evacuation of the melted embedding medium from the heated plate.

2.3.4 D9 discloses a grooved plate which appears to lie in a horizontal plane. Therefore, depending on the viscosity of the melted embedding medium, not all the melted embedding medium will be evacuated or the evacuation may take some time. When a series of cassettes have to be cleaned from excess embedding medium, this might represent a problem for the user. Therefore, the skilled person, starting from D9, is naturally confronted with the problem of optimizing the evacuation of the melted embedding medium. The simplest and most obvious solution consists in inclining the grooved plate to have the viscid embedding medium flowing down quicker the natural slope of the grooved plate under gravitational force. In order to effectively evacuate the melted embedding medium, this mechanical construction requires, first of all, a diagonal inclination of the grooved plate with respect to the horizontal plane and, secondly, a through-hole positioned at the bottom of the trench having collected the flow of melted embedding medium, the through-hole letting the melted embedding medium dropping down in the receptacle. Diagonally inclining the grooved plate (9) by adjusting the interface of the stand (14) carrying the plate (9) and drilling an additional through-hole (13) at the bottom of the peripheric trench of the plate (9) represent straight-forward mechanical modifications of the device of D9.

In this way, the skilled person arrives at the claimed subject-matter without the exercise of any inventive skills.

2.3.5 Counter-arguments of the patentee

- The patentee argued that D9 did not disclose that the temperature of the grooved plate was sufficiently high for melting the embedding medium attached at the exterior of the walls of the cassette. In D9, the

grooves were tapered for scraping off the excess embedding medium. No melting of the embedding medium could occur before scraping it off from the cassette. In D9, the excess embedding medium dropped down in form of flakes between the raised ridges. Only after having been scraped off and having dropped down into the grooves was the embedding medium melted by touching the metal plate heated by the heating elements (16). In contrast to D9, "the invention disclosed that the excess embedding medium is primarily melted from the cassette as the cassette is moved across the face of the plate and not primarily scraped off therefrom and secondarily melted later as disclosed in D9".

The board acknowledges that D9 does not explicitly disclose that the excess embedding medium is primarily melted before being scraped off. From this, however, it cannot be inferred that the feature of claim 1 "sliding said tissue cassette across said plate to melt the excess embedding medium ..." is novel.

First of all, it is to be noted that the term "melted" with respect to typical embedding medium, such as paraffin, does not refer to a precise temperature point at which the medium switches completely from solid to liquid but to an extended range of temperatures at which the embedding medium converts gradually from a solid to a viscid liquid depending on the actual temperature. Secondly, since the grooved plate of D9 is heated at a temperature sufficiently high for melting the embedding medium (see D9, page 5, lines 1 and 2) and since the cassette is in contact with the grooved plate, it is inherent that the excess embedding medium of D9 is at least partially melted when the cassette is in contact with the heated plate and slid across the plate. A partial heating of the excess embedding medium, however, is not excluded by the

wording of claim 1. Therefore, the corresponding feature of claim 1 is not novel over the disclosure of D9.

The board further notes that, similar to the method of D9, the method of claim 1 comprises a combination of a mechanical and a thermal effect for removing the excess embedding medium: claim 1 requires sliding the cassette across the plate, instead of merely maintaining the cassette immobile in contact with the plate, the sliding of the cassette having a mechanical effect which facilitates the removal of the excess embedding medium from the cassette.

- The patentee further argued that the teaching of D9 consisted in maintaining horizontal the device of D9. The device of D9 could not be inclined at an angle because it comprised a receptacle (11, 15) containing melted embedding medium.

This argument is not found convincing by the board. There is no necessity taught in D9 to maintain the grooved plate horizontal. Moreover, inclining the grooved plate (9, 12) does not require to incline the whole device with the receptacle but merely adapting the mechanical interface between the grooved plate and the part of the device supporting the grooved plate.

- The patentee was of the view that due to the tapering of the grooves of the plate of D9, the temperature at the cassette was not sufficient to melt the excess embedding medium formed at the exterior walls of the cassette.

In view of the fact that the tapered grooves (12) are formed integrally with the plate (9), that the grooved plate is made of thermally highly conductive aluminium and that the cassette is in contact with the grooved plate heated at a temperature above the temperature required for melting the

embedding medium, the board cannot see how the excess embedding medium would not at least partially be melted during the sliding over the grooved plate.

3. Admissibility of the first auxiliary request

3.1 The first auxiliary request is not admitted into the proceedings pursuant to Article 13(1) and (3) RPBA.

Claim 1 of the first auxiliary request has been received by the EPO on 23 June 2017, i.e. shortly before the oral proceedings held on 29 June 2017, contrary to the requirement of Article 12(2) RPBA, according to which the patentee had to present its complete case with the reply to the opponent's statement of grounds of appeal. No valid reason, such as the filing of new evidence by the opponent, is apparent for the late filing of the first auxiliary request.

Claim 1 of the first auxiliary request comprises the additional feature, taken from the description, that the plate is heated in the range of 60°C to 90°C. D9 does not explicitly disclose this feature. However, the board is of the view that it lacks prima facie an inventive step (Article 56 EPC 1973). Indeed, D9 teaches to heat the plate at a temperature sufficient to melt the embedding medium. Therefore, depending on the actually used embedding medium, the skilled person would necessarily heat the plate at a temperature above the melting point of the actually used embedding medium. In particular, if the embedding medium had a melting temperature in the range of 60° to 90°C, the skilled person would adapt the heating elements of D9 so as to heat the plate in the range of 60°C to 90°C.

But even if the embedding medium had a melting point below 60°C, the board considers it obvious for the skilled person

to increase the temperature of the grooved plate above 60°C in order to solve the problem of rendering the removal of the excess embedding medium formed on the exterior walls of the cassette more efficient. It appears obvious, indeed, that the higher the temperature of the grooved plate, the more efficiently and the faster the excess embedding medium is melted away from the exterior walls of the cassette.

3.2 The patentee argued that the new feature was already implicitly present in the feature of claim 1 of the main request "... temperature sufficient to melt the excess embedding medium". The patentee further noted that the present oral proceedings were the last chance to obtain a patent for its invention. Moreover, the new feature was already present in claim 2 of the main request filed with the patentee's reply to the grounds of appeal. Concerning inventive step, the patentee argued along the lines of its argumentation for the main request.

In view of the discretion not to admit late-filed amendments given to the board under Article 13(1) and (3) RPBA, the board does not find these arguments convincing. As noted by the opponent, the amendment originates from the description and it was not foreseeable that the feature of claim 2 of the main request filed with the reply to the grounds of appeal would effectively be introduced in claim 1. Concerning inventive step, the patentee did not present new arguments additional to those already discussed with respect to claim 1 of the main request.

3.3 Since the subject-matter of claim 1 is late-filed and prima facie not inventive over D9, the board, in view of the current state of the proceedings and the need for procedural economy, exercises its discretion pursuant to Article 13(1) and (3) RPBA not to admit the first auxiliary request into the proceedings.

4. Admissibility of the second auxiliary request

4.1 The second auxiliary request is not admitted into the proceedings pursuant to Article 13(1) and (3) RPBA.

Similarly as for the first auxiliary request, claim 1 of the second auxiliary request has been received by the EPO on 23 June 2017, i.e. shortly before the oral proceedings held on 29 June 2017, contrary to the requirement of Article 12(2) RPBA, according to which the patentee had to present its complete case with the reply to the opponent's statement of grounds of appeal. No valid reason, such as the filing of new evidence by the opponent, is apparent for the late filing of the second auxiliary request. In comparison with the first auxiliary request, the late-filing of the second auxiliary request is even more critical since the amended feature of the second auxiliary request was never the object of a dependent claim of a previously filed set of claims.

The amendment of claim 1 comprises essentially the additional feature, taken from the description, that the angle at which the plate is positioned lies in the range of 5° to 45°. D9 does not disclose this feature. However, in view of the fact that the board already decided that inclining the plate at an angle to allow gravitational flow of the melted embedding medium did not comprise an inventive step (see point 2.3 above), the board is of the opinion that prima facie no inventive step can be based on the additional feature of specifying a numerical range for the inclination angle of the plate (Article 56 EPC 1973). Indeed, the range of 5° to 45° represents a conventional range of inclination angles for the grooved plate from which the skilled person would select an adequate angle depending on the circumstances, such as the viscosity of the embedding medium.

4.2 The patentee argued that the amended feature about the angle range was clearly novel over D9. The amended feature "sliding down" overcame a clarity objection from the opponent. The patentee repeated its argument that in no way the receptacle of D9 could be positioned at an angle different from 0°, since the receptacle contained melted embedding medium and had to stay in a horizontal position. Moreover, the patentee argued that D9 disclosed through-holes only in the grooves but not in the trenches of the plate. Therefore, if the plate in D9 would be inclined by an angle in the range of 5° to 45°, the melted embedding medium in D9 would simply accumulate at the bottom of the trenches. Therefore, the amended feature comprised an inventive step and should be admitted into the proceedings.

The board is not convinced by these arguments. Indeed, the patentee did neither provide arguments for the late-filing of the second auxiliary request, nor arguments relating specifically to the inventiveness of selecting an inclination angle of the plate between 5° to 45° (in addition to those already discussed in point 2.3 above).

4.3 Since the subject-matter of claim 1 is late-filed and prima facie not inventive over D9, the board, in view of the current state of the proceedings and the need for procedural economy, exercises its discretion pursuant to Article 13(1) and (3) RPBA not to admit the second auxiliary request into the proceedings.

5. Apportionment of costs

5.1 The patentee requested for the first time with letter of 21 June 2017 the full refund of its costs in accordance with Article 16(1) and (2) RPBA, submitting that the late introduction of documents D9 and D10 only in the appeal

proceedings constituted an abuse of procedure. The patentee reiterated its request during the oral proceedings without providing additional arguments.

5.2 Under Article 16(1) RPBA, it is at the discretion of the board to order, after request of a party, an apportionment of costs according to Article 16(2) RPBA and different from the principle that each party shall bear the costs it has incurred (see Article 104(1) EPC for the costs of opposition proceedings). Article 16, paragraph (1)(a) to (e), RPBA lists typical circumstances in which a divergent apportionment of costs is to be taken into account.

5.3 Circumstances according to Article 16, paragraph (1)(a) to (d), RPBA were not invoked by the patentee and are also not apparent. As to the alleged abuse of procedure pursuant to Article 16(1)(e) RPBA, the late filing of documents D9 and D10 by the appellant does not amount to such an abuse (see point 1.3.1above).

5.4 As a result, the board, by exercising its discretion and after having carefully considered the relevant circumstances of the case, for the above-mentioned reasons does not see any persuasive grounds which would justify a departure from the normal rule that each party bears its own costs, and accordingly refuses the request of the patentee for an apportionment of costs.

6. Petition for review

6.1 During oral proceedings, the patentee announced that it would file a petition for review of the decision of the board under Article 112a EPC on the ground that the late-filed documents D9 and D10 should not have been admitted into the appeal proceedings. The patentee gave no other reasons for an objection pursuant to Article 112a EPC.

6.2 While the patentee did not explicitly refer to Rule 106 EPC, it became sufficiently clear from its reference to a petition for review and to the alleged defect that it intended to raise an objection in respect of a procedural defect under said Rule.

6.3 The fulfilment of the criteria for the validity of this procedural act under Rule 106 EPC notwithstanding (in particular, the objection must be specific, indicating clearly and unambiguously on which procedural defect according to Article 112a(2)(a) to (d) EPC the petitioner intends to rely), the board could not identify any deficiency according to said Article.

(a) The reasons for admitting the documents D9 and D10 into the appeal proceedings have been discussed under point 1.above The patentee had the opportunity to comment on the admissibility issue during oral proceedings before the board (see minutes of the oral proceedings) and also addressed this issue at length in its submissions in writing. The board therefore considers that the right to be heard – whose violation was, by the way, not invoked by the patentee – has been respected (Article 113, Article 112a(2)(c) EPC).

(b) The patentee, in contrast, only objected to the fact that late-filed documents were admitted into the appeal proceedings, which in its view were not sufficiently relevant to prejudice the maintenance of the patent according to the main request. However, the petition for review is no means to review the application of substantive law, which is why the issue whether to admit a new document under Article 12 RPBA cannot be considered in review proceedings (see e.g. R 10/09, point 3.3 of the Reasons).

(c) Other grounds for a petition for review, which have been exhaustively defined by the legislator in Article 112a(2) EPC, were not brought forward by the patentee and are also not evident. In particular, "*any other fundamental procedural defect defined in the Implementing Regulations*" pursuant to Article 112a(2)(d) EPC encompasses only those two additional fundamental procedural defects which are expressly enumerated in Rule 104(a) and (b) EPC. However, none of them are pertinent in the case at hand.

6.4 As a result, the board dismisses the patentee's objection according to Rule 106 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The patent is revoked.

3. The request for apportionment of costs is refused.

The Registrar: The Chairman:

M. Kiehl R. Bekkering

Decision electronically authenticated