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# Datasheet for the ancillary decision of 8 October 2018

**Case Number:** T 1934/14 - 3.3.03

**Application Number:** 04746711.3

**Publication Number:** 1641883

**IPC:** C08L101/14, C08K3/10, A61F13/53, A61L15/60

**Language of the proceedings:** EN

**Title of invention:**
WATER ABSORBENT RESIN COMPOSITION AND PRODUCTION METHOD THEREOF

**Patent Proprietor:**
NIPPON SHOKUBAI CO., LTD.

**Opponent:**
Evonik Degussa GmbH

**Relevant legal provisions:**
EPC R. 124(1)

**Keyword:**
Correction of minutes of oral proceedings

**Decisions cited:**
R 0002/12, T 0263/05

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**Case Number: T 1934/14 - 3.3.03**

# A N C I L L A R Y  D E C I S I O N
# of Technical Board of Appeal 3.3.03
# of 8 October 2018

| | |
|---|---|
| **Appellant:** (Opponent) | Evonik Degussa GmbH<br>Rellinghauserstrasse 1-11<br>45128 Essen (DE) |
| **Representative:** | Herzog, Fiesser & Partner Patentanwälte PartG mbB<br>Immermannstrasse 40<br>40210 Düsseldorf (DE) |
| **Respondent:** (Patent Proprietor) | NIPPON SHOKUBAI CO., LTD.<br>1-1, Koraibashi 4-chome<br>Chuo-ku<br>Osaka-shi, Osaka 541-0043 (JP) |
| **Representative:** | Müller Hoffmann & Partner<br>Patentanwälte mbB<br>St.-Martin-Strasse 58<br>81541 München (DE) |

**Composition of the Board:**

| | |
|---|---|
| **Chairman** | D. Semino |
| **Members:** | C. Brandt |
| | O. Dury |

## Summary of Facts and Submissions

I. With letter dated 14 June 2018 the representative of the respondent (patent proprietor) requested to supplement the minutes of the oral proceedings held on 15 March 2018 and provided with communication dated 20 March 2018, since the minutes did not reflect a part of the oral proceedings and did not disclose all relevant facts.

In detail the respondent requested that the minutes be corrected as follows:

1. *Request to file a further request*:

*"Furthermore, the respondent requested that a further request may be filed in the course of the proceedings in case the Board of Appeal would depart from the decision of the opposition division and would come to the result that the requests on file do not meet the requirements of the EPC."*

2. *Request to interrupt the oral proceedings*:

*"During the discussion of the priority documents the respondent has requested to interrupt the oral proceedings.*
*The Board of appeal has rejected this request at once.*
*The respondent has not accepted this ruling and has brought forward an objection against this ruling.*
*The Board of Appeal dismissed this objection immediately and argued that the respondent has had enough time during the whole proceedings."*

II. With communication dated 3 July 2018 pursuant to Rule 100(2) EPC the Board gave its preliminary opinion to the respondent's requests to supplement the minutes, which reads as follows:

"*Request to file a further request*:

According to Rule 124(1) EPC as relevant legal basis minutes of oral proceedings shall be drawn up containing inter alia the essentials of the oral proceedings and the relevant statements made by the parties. In T 263/05 (OJ 2008, 329, see headnote, point IV) the board held "that the minutes of oral proceedings before the boards of appeal should record the requests of the parties on which a decision of the board is required", such as the form in which the proprietor seeks maintenance of the patent.

The respondent's "request that a further request may be filed" at a later stage of the oral proceedings does not fulfil the requirements as set out by the cited case law of the boards of appeal (see II. above). Such a "request" at the beginning of the oral proceedings does not constitute "a request on which a decision of the board is required". A decision regarding the admissibility and/or the allowability of a claim request, e.g., an amended main or an (additional) auxiliary request can only be taken when a specific and concrete claim request is filed. Only then is the board in a position to decide upon such a request taking into account the procedural development during the oral proceedings, the parties' (new) arguments, facts and objections and the resulting current situation of the oral proceedings. This holds in particular true for the question to be answered by the board whether at that stage of the oral proceedings the requirements of

Articles 12 and 13 RPBA are met. Such a decision cannot be taken until a specific claim request has been submitted to the board, and surely not in advance of it on a mere hypothetical and theoretical basis.

A "request" that a further request may be filed later during the oral proceedings is procedurally not more than an announcement or the declared intention that a further request may be filed at a later point of time of the proceedings. However, such a "request" does not need to be decided upon by the board and hence is not to be taken into the minutes of the oral proceedings.

*Request to interrupt the oral proceedings*:

First of all the board points out that according to the board's written notes made during the oral proceedings the respondent has neither requested to interrupt the oral proceedings during the discussion of the priority documents, nor has the Board rejected such a request at once, nor has the respondent not accepted this ruling and brought forward an objection against this ruling nor had the board finally dismissed such an objection. In any case such a request for interruption of the oral proceedings had not been submitted explicitly, let alone was it requested to take such a request into the minutes of the oral proceedings. The respondent himself does not even allege that he had requested the board to take such a request for interruption of the oral proceedings into the minutes and that the board refused to do so.

In this respect the board points to the decision of the Enlarged Board of Appeal (EBA) of 17 October 2012 in case R 2/12 (point 1.2.1 of the reasons) where the EBA held that "not only when the chairperson confirms the

final requests before closing the debate, but at any time when the Board is about to deliberate, (the risk of a final decision after deliberation being always present), it is the duty of a party to check whether its objection to a fundamental procedural defect occurring during the oral proceedings has been recognised by the Board and will be dealt with." The EBA then continues stating that "if a party is really convinced that a violation of its right to be heard has occurred during the oral proceedings the subsequent objection must be clearly raised as such, and not as a mere aside, so that it will oblige the Board of Appeal to react, and require this to be recorded in the minutes in accordance with Rule 124 EPC, at least at a party's request" (EBA, l.c.).

In the present case the respondent did not comply with these requirements. He did not even argue that he clearly requested the board to take a request for interruption of the oral proceedings into the minutes before or after the board's deliberation on the priority issue or at least and at the latest when the Chairman confirmed the final requests and asked the parties whether they had further requests or remarks before closing the debate.

For these reasons the respondent's request to correct the minutes of the oral proceedings as brought forward with its letter dated 14 June 2018 has to be refused."

III. With letter of 12 July 2018 the appellant supported the position taken by the Board in the communication dated 3 July 2018.

IV. With letter dated 7 September 2018 the respondent objected to the Boards communication and provided additional observations (see Reasons for the Decision below). Declarations of Mr. Frischknecht Heller and Ms. Höfer, both representatives of the respondent in the oral proceedings, were attached.

## Reasons for the Decision

"*Request to file a further request*:

1. With regard to this request the Board notes that the respondent in its reply of 7 September 2018 did not comment or object to the Board's opinion in the communication of 3 July 2018 (see "ad I.1." as reported in point II, above). In their declarations annexed to the respondent's reply Mr. Frischknecht Heller and Ms. Höfer only confirmed that such a request (see above I. 1.) had been brought forward by the respondent at the beginning of the oral proceedings, what has not been denied by the Board.

2. Therefore, the Board has no reason to depart from its opinion as provided in its communication of 3 July 2018. Consequently, this request for supplementation of the minutes has to be rejected for the reasons referred to above (see II.).

*Request to interrupt the oral proceedings*:

3. The respondent has not brought forward any facts or arguments let alone evidence that may cause the Board to deviate from its finding set out in the communication dated 3 July 2018 (see above II).

4. The respondent contests that an interruption of the oral proceedings was not explicitly requested. Instead it is emphasised that "we have filed such a request, the Chairman of the Board of Appeal has rejected this request at once and we have brought forward an objection".

5. However, this contention is in variance with the Board's written notes and the recollection of the members of the Board. The Board's position is confirmed by the comment in the appellant's letter of 12 July 2018. There the appellant's representative submitted that he could not recall a concrete request for interruption of the oral proceedings, since otherwise he would have noted such a request in his papers. Accordingly he could not remember that such a request should have been rejected by the Board and an objection had been brought forward by the respondent.

6. The argument of the respondent that "it is expectable and understandable that the Opponent / Appellant is not interested to support our request to correct the minutes and has argued against our position" can be countered by the argument that it can be equally expected that the annexed declarations by the respondent's representatives confirm the respondent's position.

7. The respondent admits that it had not requested to take a request for interruption of the oral proceedings into the minutes presuming that this was an essential of the oral proceedings which certainly would be mentioned in the minutes.

First of all the Board again points to the decision of the Enlarged Board of Appeal (EBA) in R 2/12 reiterating the finding of the EBA that "it is the duty of a party to check whether its objection to a fundamental procedural defect occurring during the oral proceedings has been recognised by the Board and will be dealt with" and that ”if a party is really convinced that a violation of its right to be heard has occurred during the oral proceedings the subsequent objection must be clearly raised as such, and not as a mere aside, so that it will oblige the Board of Appeal to react, and require this to be recorded in the minutes in accordance with Rule 124 EPC, at least at a party's request”.

The Board agrees with the respondent's statements in the letter of 7 September 2018 that a request for interruption of the oral proceedings not only is an essential of the oral proceedings but as well a "clear procedural step" that is "closely related with the right to be heard". However, irrespective of the judicial requirement set out by the EBA in R 2/12 (see above) not being met by the respondent, according to the Board's knowledge and conviction such a request for interruption of the oral proceedings has in contrast to the respondent's submission not explicitly been brought forward by the respondent and just for this reason such a request is neither mentioned in the minutes, nor in the written decision. Under these circumstances there is thus neither basis to assume that the Board had rejected such a request for interruption, nor that the respondent objected to that rejection.

8. Even though not being essential for the present decision the Board makes the following final remarks:

In its communication dated 3 July 2018 the Board noted that the request for correction of the minutes was only filed nearly 3 months after notification of the minutes. Contrary to the respondent's submission in its letter dated 7 September 2018 in no way did the Board state or even suggest that a "time limit has been disregarded" or that "such a time limitation condition is ... a time limit within the meaning of Article 120 EPC." The respondent itself further points to the Guidelines according to which "the request shall be filed as soon as possible". One might argue whether the filing of the request for correction of the minutes nearly after 3 months after notification of the minutes fulfils that requirement. It appears also not quite understandable and clear why "the minutes have to be analysed in the context of the written decision" when a correction of the minutes is requested. Finally, the Board states that the written decision has been notified with letter dated 16 April 2018, so that it still took nearly 2 months before submitting the request for correction of the minutes.

9. The Board concludes that there is no reason for supplementing the minutes as requested by the respondent.

**Order**

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

The request for correction of the minutes of the oral proceedings is refused.

The Registrar: The Chairman:

S. Lichtenvort D. Semino

Decision electronically authenticated