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**Datasheet for the decision  
of 1 June 2022**

**Case Number:** T 0990/16 - 3.3.01

**Application Number:** 10748195.4

**Publication Number:** 2430454

**IPC:** G01N33/68, G06T7/00, G06T7/20,  
G06K9/00, C12N5/073

**Language of the proceedings:** EN

**Title of invention:**

IMAGING AND EVALUATING EMBRYOS, OOCYTES, AND STEM CELLS

**Patent Proprietor:**

The Board of Trustees of the Leland Stanford  
Junior University

**Opponents:**

Unisense FertiliTech A/S  
European Society of Human Reproduction & Embryo-  
logy(BE)/Sterckx, Sigrid(BE)/Cockbain, Julian  
Roderick Michaelson(BE)/Pennings, Guido (BE)

**Headword:**

**Relevant legal provisions:**

EPC Art. 112(1)(a), 113(2), 116(1)

**Keyword:**

Basis of decision - text or agreement to text withdrawn by  
patent proprietor - patent revoked  
Oral proceedings - obligation to hold oral proceedings (no)

**Decisions cited:**

G 0002/97, G 0001/14, T 2136/16, T 0186/84, T 0655/01,  
T 0646/08, T 2434/18

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 0990/16 - 3.3.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.3.01**  
**of 1 June 2022**

**Appellant:** Unisense FertiliTech A/S  
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**Representative:** D Young & Co LLP  
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**Appellants:** European Society of Human Reproduction & Embryo-  
(Opponents 2) logy(BE)/Sterckx, Sigrid(BE)/Cockbain, Julian  
Roderick Michaelson(BE)/Pennings, Guido (BE)  
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**Representative:** Cockbain, Julian  
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**Respondent:** The Board of Trustees of the Leland Stanford  
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**Representative:** Bird & Bird LLP  
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**Decision under appeal:**      **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
26 February 2016 concerning maintenance of the  
European Patent No. 2430454 in amended form**

**Composition of the Board:**

**Chairman**                    A. Lindner  
**Members:**                    T. Sommerfeld  
                                  L. Bühler  
                                  J. Molina de Alba  
                                  R. Romandini

## **Summary of Facts and Submissions**

- I. The appeals of the opponents lie from the interlocutory decision of the opposition division according to which the patent could be maintained in amended form on the basis of the main request filed by letter dated 30 September 2015.
- II. The board summoned the parties to oral proceedings to be held on 4 and 5 June 2020. Due to the COVID-19 pandemic, oral proceedings were re-scheduled to take place on 19 and 20 May 2021. Following a request of joint appellants (opponents) 2 for postponement and in view of their disagreement to hold oral proceedings by videoconference, oral proceedings were cancelled. The parties were subsequently summoned to oral proceedings to be held on 27 April 2022.
- III. By letters dated 25 March 2022 and 8 April 2022, the patent proprietor (respondent) informed the board and the parties that it no longer approved of the text in which the patent was granted. Furthermore, it withdrew all its pending requests and indicated that it would not be filing any replacement text.
- IV. In their letter dated 29 March 2022, joint appellants 2 stated that they did not withdraw their appeal and that they maintained their request for "the Technical Board of Appeal to reach a decision on its Art. 53 EPC objection and its request for a referral to the Enlarged Board".
- V. By communication dated 12 April 2022, the board informed the parties that, in the absence of a text for the maintenance of the patent approved by the

respondent, the appeal proceedings had to be terminated by a decision ordering revocation of the patent without dealing in substance with the appeals. The board furthermore noted that, in the given circumstances, holding oral proceedings would serve no legitimate aim and that oral proceedings could be cancelled.

- VI. Joint appellants 2 filed further submissions by letters dated 11 April 2022 and 17 April 2022.
- VII. On 22 April 2022, the board cancelled oral proceedings.

### **Reasons for the Decision**

#### *Revocation of the patent*

- 1. Pursuant to Article 113(2) EPC, the European Patent Office is to examine and decide upon a European patent application or patent only in the text submitted to it or agreed by the applicant or the proprietor of the patent. The text of the patent is thus at the disposition of the applicant or patent proprietor.
- 2. In the current case, the respondent no longer approves of the text in which the patent was granted. Furthermore, it has withdrawn all its pending requests and has indicated that it would not be filing any replacement text (see letters dated 25 March 2022 and 8 April 2022). There is thus no approved text on the basis of which the board could consider the appeals of the opponents and examine whether a ground for opposition prejudices the maintenance of the patent. It is also no longer possible to take a decision as to substance because the absence of an approved text precludes any substantive examination of the alleged

impediments to patentability (T 186/84, OJ 1986, 79, point 5 of the Reasons; T 646/08, point 4 of the Reasons and T 2434/18, point 4 of the Reasons).

3. In these circumstances, it is established case law that the appeal proceedings must be terminated by a decision ordering revocation of the patent since the patent proprietor no longer challenges the request for revocation of the opposed patent, and the patent cannot be maintained against the proprietor's will. Consequently, appeal proceedings have to be terminated by a decision revoking the patent without dealing in substance with the appeals (see, *inter alia*, T 186/84 cited above and T 655/01, point 5 of the Reasons).

*Cancellation of oral proceedings*

4. In their letter dated 11 April 2022, joint opponents 2 (appellants 2) took issue with the board's statement in its communication dated 12 April 2022 that oral proceedings had no legitimate aim and could be cancelled. They argued that "*Article 116(1) EPC states incontrovertibly that 'Oral proceedings shall take place ... at the request of any party to the proceedings.'* OPP002 has made and maintained a request for oral proceedings and to ignore that and cancel the oral proceedings would be a fundamental violation of OPP002's right to such proceedings".
5. The board notes that in their statement of grounds of appeal, joint appellants 2 requested oral proceedings on an auxiliary basis only, i.e. if the board did not accede to their request that the contested patent be revoked. Their request reads as follows (point 5 of the statement of grounds of appeal dated 21 June 2016):  
"Appellant I requests Oral Proceedings should its

request for revocation of the Opposed Patent not be accepted beforehand."

6. Since the contested patent has to be revoked (albeit without a decision as to substance), the auxiliary request for oral proceedings is moot. Cancelling oral proceedings cannot therefore be regarded as contravening joint appellants 2's right under Article 116(1) EPC.
7. But even assuming - for the sake of discussion - that their letter dated 11 April 2022 was intended and should be considered as an unconditional request for oral proceedings, the board still does not share appellants 2's opinion that taking a decision without holding oral proceedings infringes appellants 2's rights under Article 116(1) EPC. As the board explained in its communication of 12 April 2022, there is no obligation to hold oral proceedings in the current circumstances despite the absolute nature of the right to oral proceedings under Article 116(1) EPC.
8. As is abundantly clear from appellants 2's letters dated 29 March 2022, 11 April 2022 and 17 April 2022, the only issue they intended to discuss at oral proceedings is a referral under Article 112(1)(a) EPC of a question on Article 53 EPC to the Enlarged Board of Appeal. However, there is no text of the contested patent on the basis of which the board could consider either Article 53 EPC or the need for a referral. Any question raised under Article 53 EPC would be merely academic, i.e. hypothetical and without any relevance for the appeal case. In the absence of an agreed text, consideration of a referral of a question on Article 53 EPC to the Enlarged Board of Appeal would not only be superfluous but also precluded by Article 113(2) EPC



since the absence of a valid text is an impediment to any examination as to substance (T 186/84, OJ 1986, 79, point 5 of the Reasons; T 646/08, point 4 of the Reasons and T 2434/18, point 4 of the Reasons). Joint appellants 2's contention that Article 113(2) EPC does not prevent the board from referring a question of fundamental legal importance to the Enlarged Board of Appeal is unfounded. In view of the established case law, the board would, on the contrary, be misapplying Article 113(2) EPC and overstepping the boundaries of its powers if it were to consider and refer a question on Article 53 EPC to the Enlarged Board of Appeal in the absence of an agreed text of the contested patent. Such a referral would be a breach of the board's duty to examine whether the referral fulfils the criteria set out in Article 112(1)(a) EPC (G 1/14, OJ 2016, A95, headnotes 1 to 3; and T 2136/16, point 8.2 and 8.3 of the Reasons) and clearly inadmissible.

9. Joint appellants 2 argued that Article 53 EPC is a legal norm of higher rank which must take precedence over lesser considerations. The board disagrees. The case law is uniform on the interpretation of Article 113(2) EPC. The text of a patent is at the disposition of the patent proprietor. A board has no power to examine and decide on a patent in a form other than that agreed by the proprietor, whatever ground for opposition is raised. Thus, Article 53 EPC cannot take precedence over Article 113(2) EPC. Likewise, it is clear from the case law of the Enlarged Board of Appeal (in particular G 1/14, OJ 2016, A95) that Article 112(1)(a) EPC does not take precedence over Article 113(2) EPC either.
  
10. Oral proceedings serve the purpose of giving a party to the proceedings the opportunity to present its case

orally and discuss any outstanding issues. As there is no matter as to substance on which the board has the power to hear the parties in this case, holding oral proceedings would serve no purpose other than to confirm that the board had no power to discuss the requested referral under Article 112(1)(a) EPC on Article 53 EPC. Under these circumstances, and irrespective of whether joint appellants 2 have filed and maintained an unconditional request for oral proceedings, the scheduled oral proceedings can be cancelled. It cannot be the purpose of Article 116 EPC and Rule 115(2) EPC that a party may oblige a board to hold oral proceedings in which the matter raised by that party cannot be discussed at all. Such oral proceedings are pointless and thus a waste of time and resources. In such a case, a party has no legitimate interest in pursuing its request for oral proceedings. Insisting on them amounts to a breach of that party's duty to act in good faith (G 2/97, OJ 1999, 123, point 4.2 of the Reasons), and could be regarded as an abuse of right. Indeed, no serious or legitimate interest exists in the current circumstances for holding oral proceedings, and the procedural right to oral proceedings under Article 116(1) EPC would thus be exercised for a purpose other than its intended legal aim. Since an abuse of right under Article 116(1) EPC deserves no protection, a board is under no obligation to accede to a request for oral proceedings which constitutes such an abuse.

11. In the absence of an obligation to hold oral proceedings, the board was able to cancel the oral proceedings scheduled for 27 April 2021 and take a decision in written proceedings without committing a fundamental procedural violation.

**Order**

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

1. The decision under appeal is set aside.
2. The patent is revoked.

The Registrar:

The Chairman:



M. Schalow

A. Lindner

Decision electronically authenticated