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**Datasheet for the decision
of 5 July 2022**

Case Number: T 0809/21 - 3.4.03

Application Number: 07831774.0

Publication Number: 2054778

IPC: G03G21/16, G03G21/18, H04L25/49

Language of the proceedings: EN

Title of invention:

COMMUNICATION DEVICE, IMAGE FORMING APPARATUS AND CARTRIDGE

Patent Proprietor:

Canon Kabushiki Kaisha

Opponent:

Nickel, André

Headword:

Relevant legal provisions:

EPC Art. 99(1), 101(3)(a), 106(2)
EPC R. 76(2)(c), 82(1), 103(1)(a)
EPC 1973 Art. 111(1)

Keyword:

Extent of opposition

Reimbursement of appeal fee - substantial procedural violation
(yes)

Decisions cited:

G 0001/88, G 0009/91, T 0580/89

Catchword:

In a case where the patent is not opposed in its entirety, the opposition being directed at certain claims only, and where the Opposition Division decides that all of the proprietor's requests in relation to the opposed claims must fail, only the unopposed claims, which are not part of any opposition proceedings, are left standing.

Hence, provided the requirements of Rule 82(1) EPC are met (either during oral proceedings or, in a written procedure, by means of a separate communication), the patent may be maintained on the basis of the unopposed claims, irrespective of whether the proprietor has filed an explicit request for this during the proceedings. Such a request would, in fact, be superfluous, since the unopposed claims have been granted and are not the subject of any opposition. The unopposed claims of the granted patent are therefore always available to the proprietor as the minimum basis on which the patent may be maintained (Reasons, point 5.2).



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Case Number: T 0809/21 - 3.4.03

D E C I S I O N
of Technical Board of Appeal 3.4.03
of 5 July 2022

Appellant: Canon Kabushiki Kaisha
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 9 April 2021
revoking European patent No. 2054778 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman T. Häusser
Members: S. Ward
E. Mille

Summary of Facts and Submissions

I. This is an appeal by the patent proprietor against the decision of the Opposition Division to revoke the European patent EP 2 054 778 on the grounds that the subject-matter of the main request, and the first to eleventh auxiliary requests, extended beyond the content of the application as filed (Article 100(c) EPC 1973); the twelfth auxiliary request was not admitted into the proceedings.

II. In the statement of grounds of appeal the appellant-proprietor (hereinafter, the proprietor) requested that the impugned decision be set aside and that the patent be maintained as granted (main request), or according to one of first to fourth auxiliary requests filed with the statement of grounds of appeal. Reimbursement of the appeal fee was also requested.

In its letter of reply dated 30 December 2021 the respondent-opponent (hereinafter, the opponent) requested that the appeal be dismissed.

Both parties requested oral proceedings as an auxiliary measure.

III. The following facts are relevant for the present decision:

(i) The granted patent comprises nine claims forming two groups:

- independent claim 1, and claims 2 to 7 which are dependent (directly or indirectly) on claim 1; and

- independent claim 8, and claim 9 which is dependent on claim 8.

(ii) A notice of opposition was filed pursuant to Article 99(1) EPC comprising two submissions: EPO form 2300 ("Notice of opposition to a European patent") and an accompanying letter dated 29 May 2019 bearing the title "Annex to Notice of Opposition - FACTS AND ARGUMENTS".

(iii) The text of section V of EPO form 2300 commences with "Opposition is filed against", followed by a first box with accompanying text "the patent as a whole", and a second box with accompanying text "claim(s) No(s)". In the present case the first box was not crossed, and the claim numbers "8, 9" were entered in the second box.

(iv) In the accompanying letter, the section entitled "SUBJECT MATTER OF THE PATENT AS OPPOSED" on page 2 commences as follows:

"This opposition concerns independent apparatus claim 8 and dependent apparatus claim 9, without prejudice to allowability of the other claims as granted."

The arguments brought forward in the letter relate to claims 8 and 9 only, and the letter concludes with the following statement:

"The above facts and arguments show that the opposition is to be granted as requested."

(v) No other submissions were made by the opponent during the nine month period mentioned in Article 99(1) EPC.

(vi) In its letter of response dated 25 October 2019 the proprietor's main request was "to maintain the patent as granted" (hence, to dismiss the opposition). First to third auxiliary requests were annexed, each comprising claims 1 to 7 as granted and an amended version of claim 8 (with claim 9 deleted).

(vii) The Opposition Division issued a summons to oral proceedings and an accompanying communication, both dated 7 July 2020. In point 4 on page 1 of the communication the Opposition Division stated the following:

"The opponent OI requests that the contested patent be revoked in its entirety on the grounds of ... In case the opposition division would not revoke the contested patent, Oral Proceedings are requested".

(viii) In response to the summons to oral proceedings the opponent filed a further submission dated 16 December 2020. The final paragraph ("Conclusion") reads as follows:

"The above arguments and facts on which the opposition is based in conjunction with our arguments and facts in the Notice of Opposition show that the Opposition is to be granted as requested, regarding claims 8 and 9 of the patent as granted."

(ix) The proprietor filed a further submission also dated 16 December 2020. The existing requests were maintained, and new fourth to eleventh auxiliary requests were added. Each of the new auxiliary requests comprised claims 1 to 7 as granted and a modified version of claim 8 (with or without dependent claim 9).

(x) Oral proceedings were held before the Opposition Division. Point 3 of the minutes reads as follows:

"At 09:10 the Chairman declared the proceedings opened and asked the parties to confirm their requests.

"The Opponent confirmed his request for revocation of the patent in its entirety on the grounds of Article 100(a), 100(b), 100(c) EPC.

"The Proprietor confirmed his request for rejection of the opposition and maintenance of the patent as granted and auxiliarily maintenance of the patent in amended form according to one of the auxiliary requests 1 to 11. He also added that the extent of the opposition was directed to claim 8 and 9 and not to claims 1-7.

"The Opponent replied that it was sufficient to substantiate the grounds for opposition for one claim in order to request revocation of a patent on its entirety."

(xi) During the oral proceedings the proprietor filed a further auxiliary request 12 comprising a new version of claim 8 (it being implicit that claims 1 to 7 of this request correspond to granted claims 1 to 7).

(xii) Under point 4 of the "Facts and submissions" of the contested decision, it is stated that the opponent "requests that the contested patent be revoked in its entirety ...".

(xiii) The Opposition Division found that the "subject matter of claim 8 of the main request does ... not fulfill the requirements of article 123(2)

EPC" (Reasons, point 12.1.6). The same applied for all versions of claim 8 of the first to eleventh auxiliary requests. The twelfth auxiliary request was not admitted into the proceedings. The decision of the Opposition Division was to revoke the patent (Reasons, point 15.2).

- IV. The proprietor's arguments, in so far as they are relevant to the present decision, are as follows:

"With the impugned decision, claims 1 to 7 as granted were revoked, even though the opposition was neither formally directed to a revocation of these claims, nor was the opposition substantiated in this regard. However, as e.g. laid down in decisions G 9/91 of the enlarged Board of Appeal and T1066/92 of the Technical Boards of Appeal, the Opposition Division had no power to extent [sic] the opposition to claims 1 to 7 for which reason the impugned decisions [sic] was issued ultra vires and represents a substantial procedural violation. Already for this reason, the impugned decision is to be set aside, and reimbursement of the appeal fee is due" (page 5 of the statement of grounds of appeal, point III.A).1).

- V. The opponent's arguments, in so far as they are relevant to the present decision, are essentially as follows.

*"We observe that whether examination of granted claims lying outside the extent to which the patent was opposed according to the statement made by the opponent in fulfillment of Rule 76 (2) (c) EPC needs to be carried out, and if it can be carried out, is a **question of exercise of discretion by the Opposition Division**, and that this discretion has to be exercised*

dutifully having regard to fairly balancing the interests of the parties in interest, i.e., the parties to the proceedings and the public, and having regard to procedural fairness and procedural economy. One or more of claims 1 to 7 may be examined provided their validity is prima facie in doubt on the basis of already available information, for instance based on an inadmissible extension finding which may analogously apply to one of those claims" (reply to the appeal, dated 30 December 2021, passage bridging pages 16 and 17).

The fourth auxiliary request filed in appeal was for maintenance of the patent in amended form according to claims 1 to 7 as granted. Where maintenance on basis of only claims 1 to 7 as granted was desired, a respective request should have been made before the department of first instance. The current fourth auxiliary request had to be seen as a change of mind and should not be admitted.

- VI. Following the summons to oral proceedings, the Board sent the parties a communication under Article 15(1) RPBA setting out its preliminary views. In the light of the conclusions of G 9/91, the Board's view was that the Opposition Division had no power to decide on the revocation of the patent in suit beyond the extent to which it was opposed in the notice of opposition, and that the decision to directly revoke the patent in its entirety, including unopposed claims 1-7, could not stand and had to be considered a substantial procedural violation within the meaning of Rule 103(1) (a) EPC.

The Board expressed the view that the case should be remitted to the Opposition Division for further prosecution, and invited the parties, if they could

accept that conclusion, to withdraw their requests for oral proceedings before the Board. A refund of the appeal fee under Rule 103(1) (a) EPC would be ordered.

VII. In submissions dated 14 March 2022 and 31 March 2022 the opponent and the proprietor respectively withdrew their requests for oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. *Extent of the opposition: Question to be decided*
 - 2.1 In the notice of opposition the extent of the opposition was explicitly defined to be claims 8 and 9 of the granted patent, and it is not disputed that independent claim 1, and dependent claims 2 to 7, were not explicitly opposed during the nine month opposition period prescribed by Article 99(1) EPC.
 - 2.2 The proprietor therefore argues that the Opposition Division acted beyond its powers under the EPC in revoking the patent in its entirety (see above, point IV.). The opponent argues that it lies within the discretion of the Opposition Division to examine granted claims falling outside the extent to which the patent was opposed (see above, point V.).
3. *Extent of the opposition: Legal framework*
 - 3.1 Rule 76(2) (c) EPC (which corresponds to Rule 55(c) EPC 1973) requires that the notice of opposition shall contain *inter alia* a statement of the extent to which

the European patent is opposed. Accordingly, EPO form 2300 ("Notice of opposition to a European patent") provides in section V the option of ticking a box indicating that the opposition is filed against "the patent as a whole", or alternatively entering the specific claims opposed in a second box. In most cases oppositions are filed against the patent as a whole; the present case is one of those relatively rare cases where the patent is opposed only to a limited extent.

- 3.2 In the case T 580/89 the patent had been opposed only in part, but in the subsequent appeal the opponent requested the complete revocation of the patent. As a result, the deciding Board referred the following questions to the Enlarged Board of Appeal:

"1. Is the power of an Opposition Division or, by reason of Rule 66(1) EPC [1973], of a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC [1973] dependent upon the extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC [1973]?"

"2. If the answer to the first question should be affirmative, are there any exceptions to such dependence?"

- 3.3 The Enlarged Board decided the matter in G 9/91, answering the questions as follows in the Headnote:

"The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC [1973] depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC [1973]. However, subject-matters of claims depending on

an independent claim, which falls in opposition or appeal proceedings, may be examined as to their patentability even if they have not been explicitly opposed, provided their validity is prima facie in doubt on the basis of already available information."

- 3.4 This conclusion was explained as follows under point 10 of the Reasons:

"The requirement of Rule 55(c) EPC [1973] to specify the extent to which the patent is opposed within the time limit prescribed by Article 99(1) EPC [1973] would obviously be pointless, if later on other parts of the patent than those so opposed could freely be drawn into the proceedings. This would also be contrary to the basic concept of post-grant opposition under the EPC [1973] as outlined above. By limiting the extent to which the patent is opposed to only certain subject-matters, the opponent deliberately refrains from making use of his right under the EPC to oppose remaining subject-matters covered by the patent. Such subject-matters are therefore, strictly speaking, not subject to any 'opposition' in the sense of Articles 101 and 102 EPC [1973], nor are there any 'proceedings' in the sense of Articles 114 and 115 EPC [1973] in existence concerning such non-opposed subject-matters. Consequently, the EPO has no competence to deal with them at all."

4. *Application of the principles established in G 9/91 to the present case*

- 4.1 In the light of the Enlarged Board's conclusions set out in G 9/91, the opponent's view (see above, point V.) that the Opposition Division has a general discretion to examine granted claims lying outside the

extent to which the patent is opposed is incorrect. According to G 9/91, the Opposition Division's discretion to extend the opposition to unopposed claims is limited to claims which, while not explicitly opposed, are dependent upon an opposed independent claim "which falls in opposition or appeal proceedings". This does not apply in the present case as claims 1 to 7 are not dependent on opposed independent claim 8. Hence, the Opposition Division had no discretion whatsoever to extend the opposition to the unopposed claims 1 to 7.

Claims 1 to 7 were part of the granted patent and the opponent was free to file an opposition against them, but did not. As noted in G 9/91 (see above, point 3.4), in choosing to limit the extent of the opposition (here, to claims 8 and 9 only), the opponent deliberately refrained from making use of its right under the EPC to oppose the remaining subject-matter covered by the patent. Claims 1 to 7 are not, therefore, subject to any opposition in the sense of Articles 99 to 105 EPC, nor are they the subject of any current proceedings before the EPO.

- 4.2 The Opposition Division reports a number of statements purportedly made by the opponent after the nine month opposition period, to the effect that the opposition was directed at the patent as a whole (see above, points III(vii), III(x) and III(xii)). It seems doubtful that these reports are wholly accurate. In particular, the statement by the Opposition Division in the communication accompanying the summons to oral proceedings that the opponent requested revocation of the patent in its entirety (point III(vii)) does not seem to be reflected in any prior submission of the

opponent, or indeed in its subsequent submission (point III(viii)).

More importantly, such statements could have no bearing whatsoever on the determination of the extent of the opposition. It is clear from the passage from G 9/91 cited above (point 3.4) that the extent of the opposition cannot be enlarged retrospectively after the expiry of the period prescribed in Article 99(1) EPC.

- 4.3 According to the minutes of the oral proceedings (see point III(x), above), the opponent argued that if one claim falls (claim 8, for example) the request in which it is comprised falls. The Board agrees, but the meaning of a "request" in a case where only certain claims are opposed must be clearly understood. An admissible request to the EPO can only be made in the context of ongoing proceedings before the EPO; if there are no proceedings there can be no requests. In the present case claims 1 to 7 are not the subject of any proceedings before the EPO, and cannot therefore be the subject of any admissible request. Hence, the requests of the proprietor are to be understood as being directed at the opposed claims 8 and 9 only.

- 4.4 The proprietor's main request for maintenance of the patent as granted is a request that the opposition to granted claims 8 and 9 be rejected, and that these claims should remain part of the patent, along with claims 1 to 7, which were unopposed. In rejecting the main request, the Opposition Division decided that the patent could not be maintained in a form comprising claims 8 and 9 as granted.

Similarly, in rejecting the first to twelfth auxiliary requests, the Opposition Division decided that the

patent could not be maintained in a form comprising any version of claim 8 according to these requests.

4.5 The result was that the opposition against claims 8 and 9 was successful, in that the Opposition Division decided that the patent could not be maintained in a form which included any version of claims 8 and 9 submitted by the proprietor. But this still left claims 1 to 7, which had been granted by the Examining Division, and which were not opposed, nor the subject of any other ongoing proceedings before the EPO. There was, therefore, no legal basis for the EPO to deprive the proprietor of a patent comprising these claims only.

5. *The proprietor's requests and the admission of the fourth auxiliary request*

5.1 The opponent argues that in the proceedings before the Opposition Division there was no request from the proprietor for maintenance of the patent on the basis of only the unopposed claims, and the current request for this (the fourth auxiliary request) was late-filed and should not be admitted into the proceedings. The Board understands the position of the opponent to be that maintenance of the patent on the basis only of the unopposed claims requires the proprietor to file a request for such an outcome in good time during the proceedings. The Board does not agree.

5.2 In a case where the patent is not opposed in its entirety, the opposition being directed at certain claims only, and where the Opposition Division decides that all of the proprietor's requests in relation to the opposed claims must fail, only the unopposed

claims, which are not part of any opposition proceedings, are left standing.

Hence, provided the requirements of Rule 82(1) EPC are met (either during oral proceedings or, in a written procedure, by means of a separate communication, see below, point 5.4), the patent may be maintained on the basis of the unopposed claims, irrespective of whether the proprietor has filed an explicit request for this during the proceedings. Such a request would, in fact, be superfluous, since the unopposed claims have been granted and are not the subject of any opposition. The unopposed claims of the granted patent are therefore always available to the proprietor as the minimum basis on which the patent may be maintained.

5.3 For this reason the opponent's request not to admit the proprietor's fourth auxiliary request (maintenance according to the unopposed claims only) is moot.

5.4 The procedure to be followed in such a case is essentially the same as that for a standard case where the Opposition Division decides that the patent can be maintained in amended form, as set out in the Guidelines D-VI, 7.2.1 (March 2022 ed.).

In other words, the Opposition Division should inform the parties that it intends to maintain the patent on the basis of the unopposed claims only, possibly with an amended description, and should ensure that the proprietor approves the text and that the opponent has had an opportunity to comment upon it. According to standard procedure, these requirements can all be fulfilled during oral proceedings, in which case a separate communication under Rule 82(1) EPC is neither necessary nor appropriate (see G 1/88, Reasons, point

5.1.3 and point 5.2.3, final two sentences). Guidelines D-VI, 7.2.1 also sets out the procedure whereby the requirements of Rule 82(1) EPC may be most conveniently met in a purely written procedure. The subsequent procedure for issuing an interlocutory decision according to Article 101(3) (a) and 106(2) EPC is set out in Guidelines D-VI, 7.2.2 (March 2022 ed.).

6. *Further Procedure*

6.1 For the reasons set out above, the decision of the Opposition Division was not in accordance with the EPC as interpreted in decision G 9/91, and therefore cannot stand.

6.2 In the Board's view, not only the decision itself, but also the procedure leading up to the decision, was flawed. For example, even if, at the oral proceedings, the opponent "confirmed" its request for revocation of the patent in its entirety (see above, point III(x)), the Opposition Division should have made it clear that such a request was inadmissible in a case where only some of the granted claims were opposed. Instead, the oral proceedings were carried out on the basis of an inadmissible request from the opponent.

6.3 The Board therefore judges that the case should, according to Article 111(1) EPC 1973, be remitted to the Opposition Division for further prosecution, during which the Opposition Division shall take into account the conclusions set out in the present decision.

7. *Request for reimbursement of the appeal fee*

7.1 According to Rule 103(1) (a) EPC, the appeal fee shall be reimbursed in full:

"... where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation".

- 7.2 In the present case, since the impugned decision is to be overturned and the case remitted to the Opposition Division, the first condition of reimbursement (the appeal being allowable) is met.
- 7.3 Moreover, since the Opposition Division had no power to decide on the revocation of the patent in suit beyond the extent to which it was opposed in the notice of opposition, the decision to directly revoke the patent in its entirety, including unopposed claims 1-7, must be considered a substantial procedural violation within the meaning of Rule 103(1) (a) EPC.
- 7.4 Faced with a procedurally incorrect decision to revoke the patent in its entirety, the proprietor had no choice but to file an appeal if it wished to preserve any rights in the matter whatsoever, even to the granted and unopposed claims. Under these circumstances, the Board deems it equitable to reimburse the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appeal fee is to be reimbursed in full.

The Registrar:

The Chairman:



B. Atienza Vivancos

T. Häusser

Decision electronically authenticated