**Internal distribution code:**
(A) [ ] Publication in OJ
(B) [X] To Chairmen and Members
(C) [ ] To Chairmen
(D) [ ] No distribution

# Datasheet for the decision of the Enlarged Board of Appeal of 6 April 2009

**Case Number:** R 0011/08

**Appeal Number:** T 0221/06 - 3.4.02

**Application Number:** 94115175.5

**Publication Number:** 0636880

**IPC:** G01N 27/49

**Language of the proceedings:** EN

**Title of invention:**
Quantitative analyzing apparatus

**Patentee:**
Panasonic Corporation, et al

**Opponent:**
Roche Diagnostics Corporation

**Headword:**
Fundamental violation of Article 113 EPC and procedural defect under Rule 104(b) EPC/PANASONIC

**Relevant legal provisions:**
EPC Art. 112a, 113
EPC R. 104, 106, 107

**Keyword:**
"Petition for review - clearly unallowable"

**Decisions cited:**
R 0001/08, T 0506/91, T 0382/96, T 0446/00, T 0745/03

**Catchword:**
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

Große Beschwerdekammer | Enlarged Board of Appeal | Grande Chambre de recours

**Case Number:** R 0011/08

# D E C I S I O N
## of the Enlarged Board of Appeal
## of 6 April 2009

**Petitioners:** (Patent Proprietors)

Panasonic Corporation
1006, Oaza Kadoma
Kadoma-shi
Osaka 571-8501 (JP)

Kyoto Daiichi Kagaku Co., LTD.
57, Nishiaketa-cho
Higashikujo Minami-ku
Kyoto-shi
Kyoto-fu (JP)

**Representative:**

Schmidt, Josef Heinrich
Vossius & Partner
Postfach 86 07 67
D-81634 München (DE)

**Other Party:** (Opponent)

Roche Diagnostics Corporation
9115 Hague Road
P.O. Box 50457
Indianapolis
IN 46250-0457 (US)

**Representative:**

Pfeifer, Hans-Peter
Durm & Partner Patentanwälte
Moltkestrasse 45
D-76133 Karlsruhe (DE)

**Decision under review:**

**Decision of the Technical Board of Appeal 3.4.02 of the European Patent Office of 24 July 2008.**

**Composition of the Board:**

**Chairman:** P. Messerli
**Members:** C. Rennie-Smith
M. Ceyte

## Summary of Facts and Submissions

I. The petition for review concerns the decision T 221/06 of Board of Appeal 3.4.02, announced at the end of oral proceedings on 24 July 2008, to revoke European Patent No. 0636880 ("the patent") which concerned quantitative analysing apparatus. The petitioners (Panasonic Corporation and Kyoto Daiichi Kagaku Co., Ltd.) were the patent proprietors and appellants. The opponent (Roche Diagnostics Corporation) was also an appellant. Both appeals were against the decision of the Opposition Division of 16 December 2005 to maintain the patent in amended form on the basis of the petitioners' fourth auxiliary request filed during oral proceedings on 10 November 2005 which was considered to be novel and inventive by virtue of the feature "a buzzer for notifying that a sensor has been inserted into the apparatus" (hereafter "the buzzer feature").

II. The petitioners requested, in their statement of grounds of appeal filed on 25 April 2006, that the decision under appeal be set aside and that the patent be maintained as granted (main request) or on the basis of one of auxiliary requests 1 to 15 filed with the grounds of appeal. In addition to the usual sequential numbering of claims in each auxiliary request, the claims were also arranged in seven numbered groups and within each group each claim was given a letter such that the claims were annotated 1A to 1G, 2A to 2E, 3A to 3C, 4A, 5A, 5B, 6A and 7A. These annotations were used, in a table entitled "Annex A - Claim Combinations in Requests", to show which claims appeared in each of the fifteen auxiliary requests. A separate Annex B showed, again by reference to those annotations, the

additional features of each claim compared with the main request. All fifteen auxiliary requests contained a common claim with the buzzer feature annotated 4A (hereafter "the buzzer claim") and both the claims annotated 5A and 5B as alternatives. After referring to those fifteen auxiliary requests and Annexes A and B the petitioners' grounds of appeal stated:

"In case the Auxiliary Requests are not acceptable, the Patentee is ready to file further Auxiliary Requests to solve potential problems by, for example, deleting any claims or combining claims of different Auxiliary Requests, and as a precautionary measure the Patentee requests that the patent be maintained based on at least one of the independent claims of either of the Auxiliary Requests. This shall avoid numerous further Auxiliary Requests." (This is referred to hereafter as "the general request". Although the petitioners disagreed, the Enlarged Board considers the word "either" should, to make sense, read "any".)

III. The opponent and other appellant requested, in its statement of grounds of appeal dated 20 April 2006, that the decision under appeal be set aside and the patent be revoked. All the appellants requested oral proceedings. Both the petitioners and the opponent filed replies to the other's grounds of appeal. The opponent's reply of 12 September 2006 observed that all the petitioners' auxiliary requests were ambiguous as each contained the alternative claims annotated 5A and 5B and submitted that, as the patent proprietor had proposed no less than fifteen auxiliary requests, had indicated a willingness to amend the claims further and had requested maintenance of the patent on the basis of

at least one of the proposed independent claims, it would not be helpful to discuss each of the auxiliary requests in order with respect to each ground of opposition. The opponent then made a number of detailed objections to the petitioners' claims which the petitioners answered in further written submissions of 5 February 2007.

IV. In a communication of 27 March 2008 sent with the summons to oral proceedings, the Board of Appeal summarised the decision under appeal, the petitioners' appeal and opponent's appeal and then made *inter alia* the following comments:

"2. The parties seem to be structuring their cases along the lines set out in the letter of the opponent dated 5 February 2007 using the annexes A and B presented by the patent proprietor with the statement of appeal. Probably this is a reasonable way to work through the issues during the oral proceedings.

3. In view of the large number of objections (Art. 123(2), Art. 83 and Art. 84) against the requests filed, it is not clear whether any requests will even remain for consideration of patentability (Art. 54 and 56 EPC). If that stage is reached, the complex of requests submitted by the patent proprietor could give the impression of "fishing around" for patentable subject matter in a verbal way, rather than submissions in support of features of a clearly perceived invention.

4. It is intended, if possible, to decide the case at the end of the oral proceedings. The attention of the

parties in relation to amendments of a party's case is directed to Article 13(3) of the Rules of Procedure of the Boards of Appeal..."

(The reference in the communication to a letter from the opponent of 5 February 2007 was clearly erroneous, that being the date of a letter from the petitioners. The reference should have been to the opponent's letter of 12 September 2006.)

V. The petitioners responded to the communication in a letter of 18 June 2008 saying that they were "prepared to modify the respective wording as follows if the Board of Appeal considers it appropriate" and then setting out a number of possible amendments, including in one case alternative amendments, to certain claims identified by their annotations. The petitioners also filed a letter of 16 July 2008 stating that, as regards three features appearing in the claims of their requests, they were prepared to make further amendments, including in one case alternative amendments, if the Board of Appeal considered it appropriate.

VI. The pertinent passages in the Board of Appeal's decision can be summarised as follows. In the "Summary of Facts and Submissions" it said (sections VIII to XI):

At the start of the oral proceedings, the Chairman remarked that the Board's view on the auxiliary requests had not changed. The auxiliary and potential auxiliary requests involved some three hundred and eighty four possibilities. Regarding possible alternative auxiliary requests, only requests in an exact form could be considered; otherwise the order and

content of potential requests was not known. The Board could not indicate what might be appropriate or acceptable and would therefore decide on specific requests put on the table. The parties were asked for their requests.

The petitioners confirmed their auxiliary requests were the fifteen already submitted in writing, each of which comprised either claim 5A or 5B. Replying to the Chairman, they observed that the number of auxiliary requests did not amount to "fishing around" for an invention, but were intended to achieve a fair protection for the invention. They commented that there could nevertheless be a problem with the auxiliary requests on the table in that, if the buzzer claim should fall, then all the requests would fail. It might therefore be necessary to file further auxiliary requests without this feature. When asked if they were to file any further requests then, the petitioners replied that no further requests were to be filed at that point.

The opponent complained of difficulties in presenting its case should it not be clear which requests were on the table. There were simply too many too unclear requests.

Before the Board adjourned for deliberation, the Chairman asked the parties to confirm their requests and the petitioners in particular if they were now to file further auxiliary requests. The petitioners stated that no further requests were to be filed.

In the "Reasons for the Decision" the Board of Appeal said (points 2.2 and 2.3):

The petitioners pointed out that if the buzzer claim contained in all the auxiliary requests were to fall, then all the auxiliary requests would fail in consequence. The Board considered this analysis of the patent proprietor to be correct and referred to and quoted point 2.2 of the Reasons of T 745/03, a decision of the same Board in a different composition which observed that a party has to decide on presentation of its case and can be assumed to know upon what requests it requires a decision. When filing several sets of claims, a party usually lists them in order of preference with the least limited claims as a main request and more limited versions as auxiliary requests so that, if a higher order request fails, then a lower more limited request still has a chance of success. But in T 745/03 the approach could more aptly be designated as "pick and mix", as independent claims present in higher order requests were also found in lower order requests in differing permutations. This gave an impression of fishing around for something patentable. It also meant that a lower order request might fail simply because it repeated even just one independent claim from a higher order request which has not met the requirements of the EPC. Then no decision on other independent claims in the lower order request was necessary, whatever the Board might think of the merits of those other claims.

Just the situation, as envisaged by both the petitioners and those last observations cited from T 745/03, arose in the present case. Although the

petitioners attempted to avoid the situation with conditional requests to file separate requests to each independent claim or to sets of claims without the "buzzer" claim, this approach was doomed to failure because it tried to "flush out" a pre-decision of the Board in advance of defining its requests. If the Board had co-operated by more or less telling the petitioners to tailor the number and content of claims to the maximum permissible, it would not have acted impartially. In practice, the Board hears the case before it decides and cannot give a decision until the parties have had a chance to comment but co-operating with the petitioners would have prevented this, as was illustrated by the other party's justifiable protest that it had difficulties in presenting a case against unclearly presented requests.

VII. The petition for review was filed on 8 December 2008 and the petition fee was paid on the same date. The petition identified the grounds relied on as those in Article 112a(2)(c) and (d) EPC. The petitioners requested the Enlarged Board of Appeal to set aside the decision of 24 July 2008 and re-open the proceedings before the Board of Appeal and to order that the members of the Board of Appeal who participated in taking the decision be replaced. The petitioners also requested oral proceedings as an auxiliary measure if the Enlarged Board of Appeal should not allow the other requests.

VIII. On 17 February 2009 the Enlarged Board issued a summons to oral proceedings which was accompanied by a communication containing the Enlarged Board's provisional and non-binding opinion that, while the

petition was not clearly inadmissible, it did appear to be clearly unallowable and therefore oral proceedings had been appointed. The reasons for this opinion were substantially those set out in the Reasons below. The communication further indicated that the impugned decision appeared consistent with the case-law and referred to the decisions cited in the Reasons below. The petitioners replied to the communication by a letter dated 5 March 2009. Oral proceedings before the Enlarged Board were held on 6 April 2009. The petitioners' requests remained unchanged (see section VII above).

IX. The facts set out in the petition can be summarised as follows.

(a) The petition summarised the written appeal proceedings, in particular as regards the petitioners' requests and quoting paragraphs 2 and 3 of the Board of Appeal's communication of 27 March 2008 (see section IV above). Those requests were clear and no specific objections were raised either by the opponent or by the Board of Appeal's communication which "allowed the conclusion that the way the requests were formulated was not objectionable".

(b) The minutes of the oral proceedings on 24 July 2008 before the Board of Appeal did not mention the general request. The written decision of the Board of Appeal required additional comments in order to give a complete account of the oral proceedings before the Board of Appeal on 24 July 2008.

(c) At the beginning of the oral proceedings the chairman of the Board of Appeal said the petitioners' requests were not clear. Their representative explained each auxiliary request had both claims 5A and 5B as alternatives and that, as regards the general request, if for example the Board of Appeal considered the buzzer claim not patentable, that claim would be deleted from the claims of each of the auxiliary requests and similarly with any other claim. The chairman asked the petitioners to clarify their requests during the oral proceedings and, in particular, to reduce the total number of requests as too many auxiliary requests would result from the general request. The petitioners' representative replied that this type of request is perfectly clear because it simply amounts to the deletion of any independent claim and was necessary because the petitioners did not know how the Board of Appeal would decide individual questions.

(d) The parties then presented their arguments on the Main Request and, after deliberation, the chairman of the Board of Appeal announced that this was not patentable. The parties were then invited to present their arguments on the auxiliary requests under Articles 123(2), 84 and 83 EPC and the opponent for the first time objected that the requests were unclear and too numerous. After a further interruption, the discussion continued with arguments on novelty and inventive step of the auxiliary requests. When asked by the opponent, the Board of Appeal declined to give its opinion on the issues discussed previously.

(e) After hearing arguments on novelty and inventive step of auxiliary request 1, the parties were asked for their requests and the petitioners replied that nothing had changed and their requests were maintained. It was not clear that the Board of Appeal was asking for the parties' final requests and it was not said that the debate was closed. The petitioners were under the impression that the further auxiliary requests remained to be discussed. After deliberation the chairman announced that the decision under appeal was set aside and the patent revoked. He did not give any information about the basis of the decision and in particular did not indicate that all the auxiliary requests were considered unallowable because the buzzer claim was not inventive.

X. The petitioners' arguments in the petition, in their letter of 5 March 2009 and at the oral proceedings before the Enlarged Board can be summarised as follows.

(a) There was a fundamental procedural defect under Article 112a(2)(c) EPC in combination with Article 113 EPC as the petitioners were denied the right to be heard in that, at the oral proceedings on 24 July 2008, the Board of Appeal took the decision to revoke the patent in suit without giving the parties a chance to discuss either the auxiliary requests 2 to 15 or the general request.

(b) The whole problem arose from the refusal in the opposition proceedings of the petitioners' main request to maintain the patent as granted. The petitioners had to file requests claiming various aspects of the invention which lead to several independent claims and

several objections thereto by the opponent. The petitioners considered those objections to be of minor credibility but they modified each claim to meet them. That produced auxiliary requests 1 to 15 and the table in Annex A. The petitioners were aware of the case-law which established that one invalid claim leads to the end of a request but they made clear they were presenting different claims within their requests as alternatives. The case-law referred to in the Enlarged Board's communication was not applicable as the cases underlying the cited decisions were different from the present case.

(c) As regards auxiliary requests 2 to 15, the Board of Appeal's view (in its decision, point 2.2 of the Reasons), that a lower order request may fail simply because it repeats even just one independent claim from a higher order request which has not met the requirements of the EPC, does not mean that the request does not need to be discussed at all. That is not an established practice. Even if the Board of Appeal considered auxiliary requests 2 to 15 unallowable for the same reason as auxiliary request 1, it should have given the petitioners, who expected a long discussion on each independent claim, the opportunity to comment on those requests and not to allow that for reasons of procedural economy was a substantial procedural violation. The statement in section XI of the decision (see section VI above) was misleading: the Board of Appeal merely asked the parties to confirm their requests and not for their final requests.

(d) As regards the general request, the Board of Appeal did not examine any claims of auxiliary request 1 other

than the buzzer claim. The petitioners strongly disagree with the view of the Board of Appeal that the formulation of requests was unclear. The deletion of an independent claim did not require any reformulation of remaining claims. The request to maintain the patent on the basis of any auxiliary request without the buzzer claim was particularly clear. The Board of Appeal intentionally decided without deciding that request. The Board of Appeal did not provide information about different issues but just asked the parties to present their arguments, leaving the Board's views regarding particular objections completely open so the petitioners had to present so many variants to defend their position. The Board of Appeal would not have assisted the petitioners by telling them whether claims were allowable or not, it was just a matter of deleting claims. The general request would not have created additional work for the Board of Appeal and neither the opponent nor the Board of Appeal in its communication raised that issue. The case was clearly presented by the petitioners with Annexes A and B which the communication regarded as a reasonable way to work through the issues. The general request was the only way for the petitioners to obtain the broadest possible protection in the face of the opponent's numerous objections.

(e) The second fundamental procedural defect was under Article 112a(2)(d) and Rule 104(b) EPC in that the Board of Appeal decided the appeal without deciding on a request relevant to that decision, namely the general request. There was no discussion of the merits of this request at the oral proceedings, only a request for clarification at the beginning and the petitioners then

had the impression that the request was clear to the Board of Appeal. The request was not withdrawn and was not declared inadmissible. If that had happened, the petitioners would have immediately filed new requests. The petitioners were under the impression that the general request was their last chance to amend their requests during the oral proceedings. The petitioners believe that the statement in the third sentence of section VIII of the decision (Regarding possible alternative auxiliary requests, only requests in an exact form could be considered; otherwise the order and content of potential requests was not known. - see section VI above) was not made but, irrespective of that, the request was made and was a real not potential request. It was not filed in the form of written claims for procedural economy because that would require bothersome checking by the Board of Appeal as to which parts differed from the claims in the auxiliary requests which had been filed in writing.

## Reasons for the Decision

*Admissibility*

1. It appears to the Enlarged Board that the petition was filed within two months of notification of the decision in question, that the petitioners were adversely affected thereby, that the prescribed fee has been paid in time, and that the petition complies with Rule 107 EPC. It also appears, at least on the petitioners' account of events, that the exception in Rule 106 EPC could apply. Accordingly, the petition is not clearly inadmissible.

*Allowability*

2. The first alleged fundamental procedural defect is that the Board of Appeal allowed no chance to discuss auxiliary requests 2 to 15 or the general request, thus denying the petitioners the right to be heard contrary to Article 113 EPC. The Enlarged Board finds that this did not in fact happen.

3. As regards auxiliary requests 2 to 15, all of the auxiliary requests 1 to 15 contained the buzzer claim which, as both the Board of Appeal's decision (see sections XIII to XV and Reasons, point 4) and the petition (see page 6, end of first paragraph) confirm, was in fact discussed at the oral proceedings. It is established practice that if, as apparently happened in this case, a Board of Appeal considers that a claim common to two or more requests is unallowable, all those requests fail at that point: this appears to have been actually stated by the petitioners at the oral proceedings before the Board of Appeal (see the decision, section IX, fourth and fifth sentences; and the petition, page 4, last paragraph) with the agreement of the Board of Appeal (see Reasons, point 2.2).

4. However, the petitioners also argued before the Enlarged Board that there is no such established practice and that, notwithstanding the rejection of the buzzer claim, all their other auxiliary requests should have been discussed (see section X(c) above). That is contrary both to their earlier argument before the Board of Appeal (see point 3 above) and to their own

acknowledgment of the case-law that one invalid claim leads to the end of a request (see section X(b) above). If an invalid claim appears in two or more or all requests, it must mean the end of them all. Accordingly, it follows from the petitioners' own case that, if the buzzer claim was discussed, all the auxiliary requests were discussed. The petitioners therefore had an opportunity to be heard on all their auxiliary requests.

5. As regards the complaint that no discussion took place of the petitioners' general request, this appears to be contradicted not only by the decision (see section VIII and Reasons, point 2) but also by the petition itself which refers to such discussion (see again page 4, last paragraph and page 5, second and third paragraphs). Thus the petitioners also had an opportunity to be heard on their general request.

6. However, even if the petitioners had been able to persuade the Enlarged Board that an opportunity to discuss either Auxiliary Requests 2 to 15 or the general request was denied, this would not have amounted to a fundamental procedural defect. As regards auxiliary requests 2 to 15, the "buzzer" claim was present in all of those requests which would for that reason have failed in any event regardless of how much discussion of other claims might have taken place. As regards the general request, it is clear this would also have failed for the reasons given by the Board of Appeal (see point 8 below). Accordingly, any denial of opportunity to be heard would not have resulted in a fundamental procedural defect as there would have been no causal link between that denial and the final

decision (see decision of the Enlarged Board R 1/08 of 15 July 2008, point 3 of the Reasons).

7. The second alleged fundamental procedural defect was that no decision was taken on the general request. Again, the Enlarged Board finds that this did not in fact happen. It is clear (from both the undisputed passages of section VIII of the decision and the petition, page 4, point 1.3) that at the start of the oral proceedings the Board of Appeal stated that it had not changed its view on the filing of auxiliary requests (a clear reference to its critical communication - see point 15 below), that the general request was unclear, that it was not in a position to give an indication as to what might be appropriate or acceptable, that it would therefore decide on specific requests put on the table, and asked the petitioners whether they wished to file further requests.

8. That can only mean the Board of Appeal would not accept requests which were not specific and which were not on the table, which clearly included any possible requests the petitioners might have envisaged by the general request, and offered them a chance (which they declined) to file specific requests. The Enlarged Board does not understand how the petitioners can describe the Board of Appeal's opinion as merely a request for clarification and how they could thereafter have the impression the Board of Appeal thought the general request was clear (see section X(e) above). Nor can the Enlarged Board accept the petitioners' submission that the Board of Appeal did not find the general request inadmissible since that was the clear outcome of the discussion. It is quite apparent not only that the

general request was discussed but also that, after such discussion, it was rejected by the Board of Appeal both for lack of specific definition and for being conditional upon the Board assisting the petitioners (see Reasons, point 2, in particular at 2.2 and 2.3).

9. The Enlarged Board considers it to be abundantly clear that, instead of presenting the usual sequence of specific requests placed in descending order of preference, the petitioners presented the Board of Appeal with a large range of alternative requests and possible further requests covering many differing permutations of the same claims in the expectation that the Board would at least assist them to decide what form the requests should finally take. Whether such assistance is seen as merely deleting claims (see point 12 below), or offering views on individual issues (see point 14 below), or some other form of "pre-decision" (see Reasons, points 2.3 and 2.4), in adopting that approach the petitioners failed in their duty to make their own case, invited the Board of Appeal to compromise its neutrality, and (contrary to their own hopes) limited rather than increased the consideration of the claims they put forward. In the words of the Board of Appeal's decision (see Reasons, points 2.2 and 2.3), that "pick and mix" approach was "doomed to failure".

10. As the case-law demonstrates, such an approach runs the risks of inadmissible requests, abuse of procedure, and disadvantages for the party in question. In T 506/91 of 3 April 1992 (see Reasons, point 2.3) it was said that filing requests and deciding if several alternative requests are appropriate or not is a matter that in the

end can only be decided by the party concerned and it should be routine for representatives to decide independently how to pursue their cases, including what requests to submit. T 382/96 of 7 July 1999 (see Reasons, point 5.2) observed that it is a basic principle of European patent law that in opposition proceedings the patent proprietor is responsible for determining the content of the patent and cannot, by presenting a large number of requests, still less incomplete variants of requests, shift this responsibility *de facto* to the Board of Appeal. Decision T 446/00 of 3 July 2003 said (see Reasons, points 2.3, 4.3 and 4.5.4), of a large number of requests filed with an offer to amend the claims further if the Board so wished, that a party cannot in that manner abdicate its responsibility to present its case to the Board and that such requests are both inadmissible and an abuse of procedure. In its own previous decision T 745/03 of 22 September 2005 (see Reasons, point 2.2) referred to in the impugned decision (see Reasons, point 2.2; and section VI above), the Board of Appeal observed that the "pick and mix" approach can both give an impression of fishing around for something patentable and mean that some independent claims are not even the subject of a decision.

11. The petitioners argued that the case-law referred to above was not applicable to the present case because the underlying facts of the earlier cases were different (see section X(b) above). However, such differences are the norm and the usefulness of case-law is not confined to similar or identical facts; rather it lies in the principles or guidance which, whether the facts are similar or not, can be extracted from

earlier cases. The petitioners did not heed the warnings of the case-law but took the "pick and mix" approach to its ultimate extreme by filing not only thirty alternative permutations of claims as their auxiliary requests 1 to 15 but also, as a fall-back position, the general request which covered at the very least all possible further permutations of those claims ranging from any one of them on its own to any combination of any two or more of them. While the petitioners may not have deliberately intended to contravene procedural principles, they did take an approach which risked the disadvantages to them of requests embracing multiple permutations of claims. The various arguments they have now put forward demonstrate that those disadvantages duly materialised.

12. The petitioners argued that their form of auxiliary requests with annotated claims presented by reference to their Annex A was in fact clear because it called only for the deletion of one or more claims from any particular request (see section X(a) above). However, the very need for such deletion shows that the text and thus the meaning of each request were not immediately ascertainable and so unclear. The general request (if indeed it could be called a request at all) was even more unclear, as it could have embraced any possible text as long as one independent claim from the auxiliary requests was present. It was, as the petitioners themselves acknowledged, capable of covering "numerous further auxiliary requests" (see section II above). Their suggestion that they did not file the many possible versions of their requests as written claims to save bothersome checking by the Board of Appeal (see section X(e) above) simply underlines

the fact such possible requests were unclear. Unless in written form requests cannot be checked for their exact text so, without that possibility, they are not clearly ascertainable.

13. The petitioners claimed their approach was the only way they could obtain the broadest possible protection in the face of the opponent's numerous objections (see section X(d) above). However, they also acknowledged that those objections were to the several independent claims they themselves put forward after their main request to maintain the patent as granted was refused in opposition proceedings (see section X(b) above). To label the approach they adopted as the only one possible is simply an unsubstantiated assertion on their part. Neither the Enlarged Board nor (as appears from the file) the Board of Appeal was given any explanation why the conventional approach, of a sequence of specific requests in descending order of preference, was not possible.

14. The petitioners also argued that they had to present many variants of their requests because the Board of Appeal did not provide information about different issues and left its own views "completely open" (see again section X(d) above). However, it is inherent in this complaint that, if the Board of Appeal had provided any such information or views, it would thereby have assisted the petitioners to frame their requests. The petitioners deny that by arguing only deletion of unallowable claims was required but they do not explain how such deletion would not have amounted to assistance: indeed, it is again inherent in their argument that it would have helped them. In fact, the

Board of Appeal quite properly heard the parties and then made a decision: the petitioners' complaint is in effect that the Board of Appeal was impartial.

15. The Enlarged Board cannot accept the petitioners' submissions that no specific objections to the manner of presentation of their requests were raised by either the opponent or the Board of Appeal's communication (see section IX(a) above). The opponent's reactions were manifestly critical and included complaining of ambiguity and the inability, due to the petitioners' approach, of discussing their requests in order (see section III above). As regards the Board of Appeal's communication of 27 March 2008 (see section IV above), it warned the petitioners that all their specific requests might fail even before consideration of substantive patentability, expressed the opinion that the general request was a "complex of requests" which could give the impression of "fishing around" for patentable subject matter rather than submissions in support of features of a clearly perceived invention, and added a reminder that amendments to a party's case (which filing further and/or more specific requests would have entailed) after oral proceedings have been arranged (as was the case) might not be admitted under Article 13(3) RPBA. The Enlarged Board does not understand how that communication could be read as other than critical of the petitioners' requests or how it "allowed the conclusion that the way the requests were formulated was not objectionable" (see section IX(a) above).

16. The petitioners also complain that, after a debate on the buzzer claim (the claim common to all the auxiliary

requests) and after they declined a second invitation to file further specific requests, the Board of Appeal announced a final decision. The petitioners say that invitation was not a call for final requests but only for confirmation of requests. However, they offer no explanation why the Board of Appeal would ask for some form of provisional confirmation after stating it could only consider specific written requests and after debating an issue which, if found against the petitioners, would eliminate all their written requests, as the petitioners accepted at the time (see the decision, section IX and Reasons, point 2.2; and the petition, page 4, last paragraph). A further complaint is that the chairman of the Board of Appeal did not at this point say that the debate was closed (see section IX(e) above). However, it is stated in the minutes of the oral proceedings that he closed the debate and the petitioners did not, at any time after the minutes were sent on 13 July 2008 and before the present proceedings, question that statement. There can be no doubt that they read the minutes carefully since they do complain in the petition that the minutes do not mention the general request.

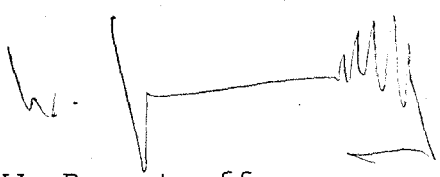
17. It follows from the foregoing that, in the judgment of the Enlarged Board of Appeal, there were no procedural defects, let alone fundamental defects, in the appeal proceedings. Accordingly, the petition has to be rejected as clearly unallowable.

**Order**

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

The petition for review is rejected as clearly unallowable.

The Registrar: The Chairman:



W. Roepstorff P. Messerli