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Datasheet for the decision of 22 June 2009

Case Number: R 0007/08

Appeal Number: T 1375/06 - 3.2.05

Application Number: 00300413.2

Publication Number: 1022115

IPC: B29C 70/64

Language of the proceedings: EN

Title of invention:
Polymeric articles having a textured surface and frosted appearance

Patentee:
ARKEMA FRANCE

Opponents:
Lucite International UK Limited
Evonik Röhm GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 21, 83, 112(1), 112a, 113
EPC R. 104(b), 106, 107, 109(2), 126(2)
RPBA Art. 10b(1) and (2)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Petition rejected as clearly inadmissible"
"Referral of a question to the Enlarged Board of Appeal under Article 112 EPC (no)"

Decisions cited:
R 0004/08, T 1375/06

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

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

Case Number: R 0007/08

D E C I S I O N
of the Enlarged Board of Appeal
of 22 June 2009

Petitioner: (Proprietor of the patent)
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Decision under review:
Decision of the Technical Board of Appeal 3.2.05 of the European Patent Office of 6 May 2008.

Composition of the Board:

Chairman: P. Messerli
Members: M. J. Vogel
U. Oswald

Summary of Facts and Submissions

I. This petition for review under Article 112a EPC concerns the decision of 6 May 2008 taken in case T 1375/06 by Board of Appeal 3.2.05, posted on 25 July 2008 and revoking European patent No. 1022115. The minutes of the oral proceedings of 6 May 2008 were posted on 20 May 2008. The petition was lodged together with its grounds by the patent proprietor on 2 October 2008 and the prescribed fee was paid on the same day. The petitioner alleges a fundamental violation of its right to be heard under Article 113 EPC, and a fundamental procedural defect within the meaning of Rule 104(b) EPC.

II. The proceedings before the Board of Appeal - as far as relevant for this petition - can be summarised as follows:

(i) Both oppositions against the patent in suit cited *inter alia* the ground of insufficient disclosure (Article 83 EPC). In its decision the opposition division disagreed with the opponents on that issue, but maintained the patent in amended form on the basis of the patentee's seventh auxiliary request due to lack of inventive step of all the preceding requests.

(ii) All parties lodged appeals, maintaining their requests and arguments made before the opposition division. In the annex to the summons to attend oral proceedings on 6 May 2008, the Board indicated its provisional opinion that the patent met the requirements of Article 83 EPC. In

response to this communication, the appellant-opponent 02 maintained by a letter dated 6 March 2008 its view that the patent was not in line with Article 83 EPC because the description did not enable the invention to be carried out by a person skilled in the art.

(iii) When the issue of sufficiency of disclosure was discussed during the oral proceedings before the Board, two related questions were discussed: what general knowledge the skilled person could be presumed to have, and what the patent had to disclose explicitly in order to comply with Article 83 EPC. In presenting its case, the representative of the appellant-proprietor referred to two documents mentioned under paragraph 0033 in the description of the patent in suit. In its view, these documents established the general knowledge of the skilled person. The Board rejected the new documents and, at the end of the oral proceedings, announced its decision that the patent was revoked.

III. In support of its petition, the petitioner argues that the contested decision was based on aspects of insufficiency of disclosure which were discussed for the first time during the oral proceedings. As the Board refused its request to admit into the proceedings the two documents in question, it did not decide on a request relevant for the decision under Rule 104(b) EPC and furthermore its decision was based on a fundamental procedural violation under Article 113 EPC, as these documents were disregarded. If the Board had taken these documents into consideration it would have

immediately realised the scope of the general knowledge of the skilled person and that the description disclosed the invention sufficiently within the meaning of Article 83 EPC.

IV. In a communication dated 14 January 2009 the Enlarged Board gave its preliminary opinion that the request for review was clearly inadmissible. Neither the grounds for the petition nor the minutes of the oral proceedings contain any indication that the requirements of Rule 106 EPC were fulfilled, i.e. an objection in respect of the alleged procedural defect had been raised during the oral proceedings and dismissed by the Board. Nor had the petitioner explained why, exceptionally, it had been unable to raise that objection.

V. The representative of the petitioner responded on 24 February 2009 that in the oral proceedings he had been taken by surprise when, in the context of sufficiency of disclosure, the question of the scope of the general knowledge of the person skilled in the art [production of polymer particles] had been raised for the first time and the Board had not considered his request to allow to provide documentary evidence about it. Ignoring this offer the Board had violated Rule 104(b) EPC as well as the petitioner's right to be heard under Article 113 EPC because it had negatively affected the Board's decision. The petitioner had become aware of that only when the decision was issued. In any case, the requirement of Rule 106 EPC - that the petition was only admissible where an objection in respect of the procedural defect was raised during the oral proceedings - was fulfilled, because it had

objected to the fact that this particular aspect of Article 83 EPC was raised for the first time at the oral proceedings and the representative had offered evidence (2 documents cited in the patent in suit) to corroborate its arguments, however the offer was refused. According to the wording of the French version of Rule 106 EPC, it was not necessary to raise a further objection in order to be able to file a petition under Article 112a EPC.

VI. Since the impact of Rule 106 EPC was a question of fundamental importance within the meaning of Article 112(1) EPC, the petitioner requests the present Board to refer the following question to the Enlarged Board of Appeal:

"Pour l'application des dispositions relatives à l'admissibilité selon la règle 109 (2) a, est-il nécessaire de soulever le vice de procédure pendant la procédure orale ou de soulever une objection à l'encontre d'un motif de révocation qui pourrait constituer un vice substantiel de procédure s'il était retenu".

Reasons for the Decision

Admissibility of the petition for review

1. Pursuant to Article 112a(4) EPC, the petition was filed, and the prescribed fee duly paid, on 2 October 2008, i.e. within two months after notification of the decision of Board of Appeal 3.2.05 in case T 1375/06,

which is deemed to have been effected ten days after its posting on 25 July 2008 (Rule 126(2) EPC).

Furthermore, the requirements of Rule 107 EPC in respect of the contents of the petition for review are met in that the petitioner is expressly alleging a fundamental procedural violation, namely that the Board breached Article 113(1) EPC by raising the particular reasons for insufficiency of disclosure for the first time at the oral proceedings and by preventing the petitioner from providing evidence for the scope of the general knowledge of the person skilled in the art, because it did not admit two documents already mentioned in the description of the patent in suit. In respect of the failure to admit the two documents, it also alleges a defect under Rule 104(b) EPC.

2. However, the petitioner has failed to meet the requirement of Rule 106 EPC that he raised a procedural objection to the introduction of allegedly new aspects of insufficiency of disclosure at the oral proceedings and to the Board's refusal to admit the two documents.

2.1 As the Enlarged Board held in case R 4/08, raising an objection under Rule 106 EPC is a procedural act and, except where such an objection could not be raised during the appeal proceedings, a precondition for access to the extraordinary legal remedy under Article 112a EPC against final decisions of the boards of appeal. In the same decision (point 2.1 of the Reasons), the Enlarged Board ruled that a valid objection must fulfil two criteria:

2.1.1 Firstly, it must have been expressed by the petitioner in such a form that the Board was able to recognise immediately and without any doubt that an objection under Rule 106 EPC - i.e. one which is additional to and distinct from other statements, in particular arguing or even protesting against the conduct of the proceedings or against a particular finding (in this case, the refusal to admit the two documents into the proceedings) - was intended by the party concerned. This is a precondition in that it enables the Board to react immediately by removing the cause of the objection or, as provided in Rule 106 EPC, to dismiss it.

2.1.2 Secondly, the objection must be specified. That means that according to the wording of Rule 106 EPC ("A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised ...") it must be clearly and unambiguously indicated on which procedural defect listed in Articles 112a(2)(a) to (d) EPC the petitioner intends to rely.

2.2 Only if the petition submitted meets these criteria it does fulfil the formal requirements of Rule 106 EPC. Evidence for the fact that an objection was raised during oral proceedings is normally that it appears in the minutes, which must contain the parties' essential statements and any requests submitted during the oral proceedings.

2.2.1 However, the minutes of the oral proceedings of 6 May 2008 contain no statement by the petitioner which meets the requirements of Rule 106 EPC as set out under 2.1

above. Nor did the petitioner object to the content of the minutes as notified to him 4 months before this petition was filed. The petitioner says that it objected as a fundamental procedural defect that a particular aspect of insufficiency of disclosure was raised during the oral proceedings by contesting insufficiency of disclosure and by asking that the two documents be introduced. However, contesting insufficiency of disclosure and offering new documents is not a qualified procedural objection as required by Article 106 EPC (see 2.1.1 above).

2.2.2 Insofar as the petitioner claims that Rule 106 last sentence EPC applies because it was not possible for the petitioner to raise objections before the decision was issued, the Enlarged Board cannot follow its arguments. The ground of opposition of Article 83 EPC was largely discussed with the parties during the oral proceedings, which means before the Board announced its decision. Nothing in the decision was new. If the petitioner was of the opinion that the Board violated its right to be heard by discussing an allegedly new aspect of insufficiency of disclosure and by refusing to take into consideration the two documents as belated, it was not hindered to raise immediately an objection pursuant to Rule 106 EPC. But the petitioner did not.

2.3 For these reasons, the petition is clearly inadmissible.

3. Regarding the allegation that the Board of Appeal decided on the appeal without deciding a request relevant to that decision (Rule 104(b) EPC), namely the request for admission of two documents cited in the patent in suit, this is contradicted by the petition

itself which states that the request for admission was refused (point III (a), see also the submission of the petitioner of 24 February 2009, point 2, 2nd paragraph).

4. As concerns the request to refer a question to the Enlarged Board of Appeal (point VI above) this can only mean a referral pursuant to Article 112(1)(a) EPC. However, the present Board is not a "Board of Appeal" within the meaning of this provision (see Article 21 EPC) and thus the request fails.

Order

For these reasons it is unanimously decided that:

The petition is rejected as clearly inadmissible.

The Registrar: The Chairman:

W. Roepstorff P. Messerli