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Datasheet for the decision of the Enlarged Board of Appeal of 20 March 2009

Case Number: R 0004/08

Appeal Number: T 1094/05 - 3.2.05

Application Number: 98116534.3

Publication Number: 0879703

IPC: B41J 2/175

Language of the proceedings: EN

Title of invention:
Ink container for ink jet printer, holder for the container, carriage for the holder and ink jet printer

Patentee:
CANON KABUSHIKI KAISHA

Opponent:
Pelikan Hardcopy Deutschland GmbH

Headword:
Fundamental violation of Article 113 EPC/CANON

Relevant legal provisions:
EPC Art. 112a, 113(1)
EPC R. 104, 106, 107, 109(3), 124(1)
RPBA Art. 13

Keyword:
"Petition for review - as far as not clearly inadmissible - clearly unallowable"

Decisions cited:
R 0002/08, R 0003/08

Catchword:
-

Europäisches Patentamt | European Patent Office | Office européen des brevets

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

Case Number: R 0004/08

D E C I S I O N
of the Enlarged Board of Appeal of 20 March 2009

Petitioner: (Opponent)
Pelikan Hardcopy Deutschland GmbH
Pelikanstrasse 15
D-30177 Hannover (DE)

Representative:
Popp, Eugen
MEISSNER, BOLTE & PARTNER
Postfach 86 06 24
D-81633 München (DE)

Other Party: (Patent Proprietor)
CANON KABUSHIKI KAISHA
30-2, 3-chome, Shimomaruko
Ohta-ku
Tokyo (JP)

Representative:
TBK-Patent
Bavariaring 4-6
D-80336 München (DE)

Decision under review:
Decision of the Technical Board of Appeal 3.2.05 of the European Patent Office of 29 February 2008.

Composition of the Board:

Chairman: P. Messerli
Members: R. Menapace
S. Steinbrener

Summary of Facts and Submissions

I. The petition for review concerns decision T 1094/05 of Board of Appeal 3.2.05, remitting the case to the department of first instance with the order to maintain European patent No. 0879703 *inter alia* with claims 1-25, which were filed as a fourth auxiliary request during the oral proceedings before the Board of Appeal.

II. The proceedings leading to said decision can be summarised as follows:

(i) On 30 November 2007 the Board of Appeal issued a summons to attend oral proceedings on 29 February 2008, together with a communication pursuant to Article 11(1) of the Rules of Procedure of the Boards of Appeal.

(ii) In response, on 29 January 2008 the Appellant-Proprietor filed, *inter alia*, seven sets of claims as his main and first to sixth auxiliary requests.

(iii) In the oral proceedings on 29 February 2008 the Appellant-Opponent objected to the admission of the second and subsequent auxiliary requests into the proceedings because claim 1 of these requests comprised a feature which was not contained in any of the claims of the patent as granted, but was taken from the description. As this could not have been expected, these requests should be considered as late filed. They were filed only one month before the oral proceedings, a period too short to perform a comprehensive search of the additional feature. The admission of these requests would

amount to an unfair treatment of the Appellant-Opponent. As claim 1 of the fourth auxiliary request (as amended during the oral proceedings) comprised features which were taken from the description, no analysis of inventive step could be made with respect to this claim. The case should be remitted to the first instance for consideration of the question of inventive step (see Point VII, first and third subparagraphs of the Board's decision, cf. point 4, first to fifth subparagraphs of the petition).

(iv) As recorded in the minutes, the Appellant-Opponent's (final) requests were

- that the decision under appeal be set aside and that European patent No. 879703 be revoked;

- as a first auxiliary request, that the Proprietor's second and subsequent auxiliary requests should not be admitted into the proceedings,

- as a second auxiliary request, that the case be remitted to the first instance for further prosecution on the basis of the amended fourth auxiliary request,

and the Chairman, before closing the debate and announcing the decision of remittal with the order to maintain the patent on the basis of the claims filed as the fourth auxiliary request during the oral proceedings, an amended description and the drawings as granted, asked the parties if they had

any other requests or observations. There were none.

III. A clean copy of the minutes of the oral proceedings was sent to each party by registered letter dated 19 March 2008.

IV. The reasons for the decision were notified to the parties by registered letter dated 29 April 2008 and received by the Appellant-Opponent on the following day. Under Point VIII, first and second subparagraph, it is stated:

"The arguments of appellant II [the patent Proprietor] *can be summarized as follows*:

The amendment to claim 1 of the second auxiliary request was a reaction to the communication of the Board of Appeal concerning the supporting function of the latch lever. Thus, this request and the subsequent auxiliary requests should be admitted."

and under Point 1, first and second subparagraph of the Reasons for the Decision:

"The Board considers the requests submitted by appellant II on 29 January 2008 as being a response to the communication of the Board of 30 November 2007, and also notes that they were submitted within the time limit set in that communication. The feature [...] which is comprised in claim 1 of the second and subsequent auxiliary requests, is considered to be an attempt to define that the supporting member in the form of a latching lever has a supporting function.

This function was called into question in the communication.

The second and subsequent auxiliary requests are therefore admitted into the proceedings."

V. The Appellant-Opponent (in the following referred to as "the Petitioner") filed a "Petition for review of the aforementioned decision by the Enlarged Board of Appeal pursuant to Article 112a(2)(c) in conjunction with Article 113(1) EPC" on 23 June 2008 on the ground that a fundamental violation of Article 113 EPC had occurred.

VI. In support of his petition the Petitioner argues in essence as follows:

Despite the opposition proceedings having continued several years he had been confronted, shortly before the oral proceedings before the Board of Appeal, with claims containing additional features which were taken exclusively from the description. In contrast to features taken from granted sub-claims, the incorporation of features disclosed exclusively in the description was surprising for any opponent, because purely speculative. Given this, during the oral proceedings he had submitted that he did not feel himself in a position to deal with the questions of novelty and inventive step, and that the same criteria had to be applied to the proprietor as those which are valid for an opponent who cites new state of the art after expiration of the opposition period. In particular, he had, pursuant to Rule 106 EPC, raised the objection that, as far as the critical feature contained in the second to sixth auxiliary request was

concerned, the requirements of fair proceedings for the Petitioner had not been met. The right to be heard demanded that the case be remitted to the department of first instance in respect of the second to sixth auxiliary requests.

Furthermore, as could be seen from the decision of the Board of Appeal, Point 1 of the Reasons, the corresponding request of the Petitioner had not been allowed on the grounds that the incorporation of the additional functional feature in question had been prompted by the comments in the annex to the summons to the oral proceedings. This reason for admitting the auxiliary requests concerned had not been discussed during the oral proceedings.

Finally, the case also concerned the fundamental question of to what extent and the point in time until which the proprietor of a European patent may, in defence of the patent in opposition-appeal proceedings, rely on features which are exclusively disclosed in the description.

Reasons for the Decision

Admissibility of the petition for review

1. In accordance with the provision of Article 112a(4) EPC, the petition was filed and the prescribed fee was duly paid on 23 June 2008, that is within two months of notification of the decision of the Board of Appeal, which was deemed to have been effected on 9 May 2008.

The requirements of Rule 107 EPC in respect of the contents of the petition for review have been fulfilled.

The requirement pursuant to Rule 106 EPC is fulfilled in so far as the Petitioner may be understood as implicitly asserting a fundamental violation of Article 113(1) EPC by alleging that the reason given in the written decision for the admission of the Proprietor's auxiliary requests had not been discussed during the oral proceedings.

2. However, this is not the case for the Petitioner's contention that during the oral proceedings he raised an objection under Rule 106 EPC against the admission of the Proprietor's late auxiliary requests without consequent remittal of the case to the department of first instance.

2.1 Raising an objection pursuant to Rule 106 EPC is a procedural act and, except where such objection could not be raised during the appeal proceedings, a precondition for access to an extraordinary legal remedy against final decisions of the Boards of Appeal. Given the nature and purpose of such an objection, its validity depends on the compliance with the following two criteria:

Firstly, the objection must be expressed by the party in such a form that the Board of Appeal is able to recognize immediately and without doubt that an objection pursuant to Rule 106 EPC - that is one which is additional to and distinct from other statements, in particular arguing or even protesting against the

conduct of the proceedings or against an individual procedural finding (here: the admission of amended claims into the proceedings) - is intended by the party concerned. This is a precondition for the Board to have been able to react immediately and appropriately by either removing the cause of the objection or, as provided in Rule 106 EPC, by dismissing it. It therefore ensures for the parties and the public at large, legal certainty as to whether the substantive decision of the Board of Appeal is open to review pursuant to Article 112a EPC. This is one of the evident purposes of the obligation to raise objections under Rule 106 EPC.

Secondly, for the same reason the objection must be specific, that is the party must indicate unambiguously which particular defect of those listed in paragraph 2(a) to (c) of Article 112a and Rule 104 EPC it intends to rely on. This also follows from the wording of Rule 106 EPC itself: "A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised ...". A party who objects for instance to a board member allegedly having taken part in the decision under appeal (Article 112a(2)(a) EPC) cannot thereby acquire the right to a review in respect of e.g. a purported violation of Article 113(1) EPC (Article 112a(2)(c) EPC) or any ground under Article 112a(2)(e)/Rule 104 EPC.

2.2 Hence, only if a party's statement complies, both as to form and content, with the aforementioned criteria, does it qualify as objection pursuant to Rule 106 EPC. The consequence of - and test for - an objection having

been validly raised during oral proceedings is then normally that it is taken to the minutes, which, as prescribed by Rule 124(1) EPC, must contain the essentials of the oral proceedings and the relevant statements of the parties.

2.3 Pursuant to Rule 109(3) EPC the Enlarged Board of Appeal composed of three members decides **on the basis of the petition** whether it is clearly inadmissible or unallowable. In the present case

- the minutes of the oral proceedings before the board do not contain any statement of the Petitioner that meets the criteria set out above under 2.1,

- the minutes, which had been sent to the Petitioner more than one month before the written grounds for the decision under review, were never objected to by the Petitioner, either by way of a request for correction or in the statement setting out the grounds for the petition for review,

- in the decision under review it is reported (Point VII, second paragraph) that [during the oral proceedings] the Petitioner had [only] argued that the second and subsequent auxiliary requests should not be admitted into the proceedings as the "admission of these requests would be an unfair treatment of appellant I" (the Petitioner),

- the Petitioner has not (in contrast to decision R 0003/08 dated 25 September 2008) adduced any evidence for his allegation in the statement of

the reasons for the petition that he raised an objection under Rule 106 EPC during the oral proceedings before the Board of Appeal.

In the light of the available evidence, freely evaluated as a whole, it has not been shown, let alone proven, that during the appeal proceedings under review the Petitioner made any statement which qualified, in both its form and content, as an objection within the meaning of Rule 106 EPC.

2.4 Since the petitioner did not fulfil his obligation to raise objections under said Rule, the petition for review is not admissible in so far as it is directed against the admission of the Proprietor's auxiliary requests during the oral proceedings on 29 February 2008.

Allowability of the petition for review

3. The Petitioner is understood to be relying on a second violation of Article 113(1) EPC, in that allegedly the reason for admitting the second and the subsequent auxiliary request(s) into the proceedings as given in the written decision - they were a reaction to the communication of the Board of Appeal (see Point IV above) - had not been discussed in the oral proceedings.

3.1 Since an alleged procedural defect of this kind becomes apparent to the parties only through the written reasons for the decision, the admissibility of the petition, as far at it relies on such a defect, is not conditional upon a corresponding objection having been raised during the oral proceedings.

3.2 However, according to Point 1 of the decision of the Board of Appeal (see Point IV above) the Proprietor had argued in support of the admissibility of the requests in question (including the fourth auxiliary request) that they were a reaction to the communication of the Board of Appeal concerning a particular issue. This has not been contested by the Petitioner, neither explicitly, nor implicitly, and his assertion that this argument was not discussed during the oral proceedings is not in contradiction to the relevant statements in the decision under review.

3.3 The reason given in the decision under review corresponds to the above argument put forward by the Proprietor, so that the Petitioner was aware of it and thus not taken by surprise by the reasoning of the Board of Appeal, which followed the other party's argument. That is sufficient for the purposes of Article 113(1) EPC (see for example decision of the Enlarged Board R 0002/08 dated 11 September 2008, Point 8.2 of the Reasons). Under these circumstances and in the absence of any contention or any indication that during the oral proceedings the Board of Appeal had refused to hear the Petitioner on the admissibility of the Proprietor's requests which had been filed a month earlier, it cannot be established that the Petitioner had no opportunity to comment within the meaning of Article 113(1) EPC on the reason for admitting those requests into the proceedings.

3.4 That being so, there is no need, for the purposes of the present petition, to deal with the question whether the admission of late amendments to the text of a

patent qualifies as "decision" under Article 113(1) EPC and, if it does, whether it would amount to a "fundamental violation of Article 113" as required by Article 112a(2)(c) EPC, if the reasons for the admission were not made explicit or a party was otherwise not given the opportunity to comment on them.

Order

For these reasons it is decided unanimously that:

To the extent that the petition is not rejected as clearly inadmissible, it is dismissed as clearly unallowable.

The Registrar: The Chairman:

W. Roepstorff P. Messerli