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Datasheet for the decision of 5 February 2009

Case Number: R 0005/08

Appeal number T 0601/05 - 3.3.04

Application Number: 94102560.3

Publication Number: 0614984

Language of the proceedings: EN

Petitioner:
CENTOCOR, INC.

Respondent:
BAYER CORPORATION

Other party:
ABBOTT LABORATORIES

Headword:
-

Relevant legal provisions:
EPC Art. 112(2), 112a, 116, 125, 164(2)
EPC R. 76(2)(c), 99(2), 104, 107(1)(2), 108(3), 109, 115(1), 126(2)
RPEBA Art. 12(1)
Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000, Art. 1, point 4.

Relevant legal provisions (EPC 1973):
-

Keyword:
"Petition for review - transitional provisions - substantiation - inadmissible"
"Petition for review - two stage procedure"

Decisions cited:
G 0012/91, T 0390/86

Catchword:
-

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

Case Number: R 0005/08

D E C I S I O N
of the Enlarged Board of Appeal of 5 February 2009

Petitioner: (Opponent I)
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Decisions under review: **Interlocutory decisions of the Technical Board of Appeal 3.3.04 of the European Patent Office of 18 October 2007 and 24 April 2008.**

Composition of the Enlarged Board of Appeal:

Chairman: P. Messerli
Members: C. Rennie-Smith
S. Crane
B. Günzel
J.-P. Seitz

Summary of Facts and Submissions

I. The petition for review concerns the interlocutory decisions of 18 October 2007 and 24 April 2008 of Board of Appeal 3304 in the appeal proceedings T 0601/05 in which the petitioner (Centocor, Inc.) is the opponent 01 and first respondent. In those proceedings the proprietor of European Patent No. 0614984 ("the patent") and respondent to the petition (Bayer Corporation) has appealed against the decision of the Opposition Division of 16 February 2005 to revoke the patent. The other party in the petition proceedings (Abbott Laboratories) is opponent 02 and second respondent in the appeal proceedings. The patent concerns the production of human monoclonal antibodies against tumour necrosis factor alpha.

II. The petition, which was filed on 8 July 2008, relied on the grounds in Article 112a(2)(c) and (d) EPC and contended that the conduct of the appeal proceedings and the interlocutory decisions (which were both notified on 29 April 2008) constituted fundamental violations of Article 113 EPC and other fundamental procedural defects. The petition fee was also paid on 8 July 2008.

III. The facts referred to in the petition can be summarised as follows.

(a) The Opposition Division decided that the claims of the patent as granted (the main request in the opposition proceedings) lacked novelty (Article 54 EPC). Four auxiliary requests were also refused - the first under Article 123(2) EPC, the second for

lack of novelty, and the third and fourth for lack of inventive step (Article 56 EPC).

(b) The notice of appeal of 14 April 2005 requested that the patent be maintained as granted (with claims directed to a "composition"). The statement of grounds of appeal dated 14 June 2005, which requested only that and oral proceedings, was confined to submissions why the first instance finding of lack of novelty of the patent as granted was wrong. The petitioner and the other party filed replies on 2 and 11 November 2005 respectively. On 15 December 2006 the Board of Appeal summoned the parties to oral proceedings on 18 October 2007. In a letter dated 18 September 2007 the respondent filed new main and auxiliary requests - with claims directed to a "pharmaceutical composition", claim 1 of the main request being identical to that of the third auxiliary request refused by the Opposition Division - and submissions why the first instance finding that this claim lacked inventive step was wrong. The petitioner objected to this in a letter of 3 October 2007.

(c) Oral proceedings took place on 18 October 2007. The discussion covered admissibility of the appeal and of the new requests filed on 18 September 2007, and novelty and inventive step of the main request. A decision holding that the appeal was admissible, that the main request was novel, and that the debate on inventive step was closed was announced at the oral proceedings and was the subject of the

first interlocutory decision dated 18 October 2007 and notified on 29 April 2008.

(d) Although inventive step of the main request was discussed at the oral proceedings, the decision on that issue was not announced then and was only known when the second interlocutory decision, dated 24 April 2008, was notified to the parties, also on 29 April 2008. In that decision, the Board of Appeal found claim 1 of the main request involved an inventive step. As regards the inventive step discussion, the petition states (at paragraph 26) that during the oral proceedings the patentee advanced totally new points in relation to inventive step of the main request. It argued that the technique of making the claimed antibody was in itself different from previously well known methods. Despite objections by the petitioner and the other party, the Board allowed this new argument and adjourned for 25 minutes for them to consider it. Subsequently the Board only allowed the petitioner to file one of two documents relevant to the new argument.

(e) The remaining issues, including sufficiency of description and industrial application (Articles 83 and 57 EPC respectively), have still to be discussed and decided.

IV. It was submitted in the petition (paragraph 28) that the following were fundamental procedural defects in the conduct of the appeal proceedings.

(a) The statement of grounds of appeal did not set out the grounds relied on by the respondent (patentee) contrary to Article 108 EPC, Rule 99 EPC (which, at the time in question, was in part contained in Rule 64 EPC 1973) and Article 10a(2) RPBA (now Article 12(2) RPBA). The respondent's letter of 18 September 2007 shows that the statement of grounds of appeal did not contain its complete case but one which was abandoned and not proceeded with. If the grounds of appeal were as stated in the letter of 18 September 2007, then this was two years out of time.

(b) The Board should not have allowed new claims and new arguments on obviousness which were not raised in the statement of grounds of appeal to be put forward four weeks before the hearing and at the hearing itself. There is a discretion to allow amendments but this was not amendment but the abandonment of a case and replacement by a totally new case. The opportunity to comment required by Article 113 EPC must be an adequate opportunity and four weeks from the letter of 18 September 2007 was not adequate for the respondents to prepare, nor was the half hour adjournment adequate enough to prepare to answer the new arguments raised at the oral proceedings.

(c) As the respondent abandoned the whole of its case set out in the grounds of appeal, the Board should have dismissed the appeal or declared the appeal proceedings terminated.

(d) The Board should not have allowed new factual submissions. No reasons were given why this was acceptable, the respondents had no reason to expect it and it was contrary to Article 113 EPC. Even if the change of case were argued to be an amendment it would be contrary to Article 10b(3) RPBA (now Article 13(3) RPBA) to allow it. Regarding the matters raised in the oral proceedings, the petitioner had no reason to prepare for them, did its best in the 25 minutes allowed, and the refusal to allow the introduction of both documents to counter the new points was inequitable. The appellant was permitted to ambush the petitioner and the other party contrary to Article 113 EPC.

V. The petition concluded that, if there were a valid appeal in existence, the proper course would be to set aside the interlocutory decisions and remit the appeal to a differently constituted Board for rehearing. However, since the whole case set out in the grounds of appeal was abandoned, the appeal should be dismissed. The requests in the petition were that the Enlarged Board either set aside the interlocutory decisions and dismiss the appeal or direct the Board of Appeal to do so and, if not minded to grant either of those requests on the basis of written submissions, to hold oral proceedings.

VI. On 29 July 2008 the respondent filed a purported reply to the petition by a faxed letter of that date. The Enlarged Board issued a communication which drew the attention of all the parties to Rule 109(3) EPC and directed them not to file further written submissions

until it had decided whether or not the petition was clearly inadmissible or unallowable.

VII. On 26 August 2008 the Enlarged Board in its composition under Rule 109(2)(a) EPC issued a summons to the petitioner to oral proceedings on 1 October 2008. The summons was accompanied by a communication which raised a number of issues including whether Article 112a EPC could apply to the decisions complained of in view of Article 4 of the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000, the inappropriate nature of the petitioner's requests and comments on the substantive grounds in the petition including, with regard to the new argument on inventive step (see III(d) and IV(b) above), that this was apparently rejected by the Board whose positive conclusion on inventive step was based on other reasons.

VIII. At the oral proceedings held on 1 October 2008, the petitioner presented arguments which were substantially those set out in its subsequent written submissions of 18 November 2008 (see XIV below). It also filed amended requests substantially in the form finally requested (see XIII below). The Enlarged Board submitted the petition to the Enlarged Board in its composition under Rule 109(2)(b) EPC for decision. The Enlarged Board's communication of 8 October 2008 informing the parties thereof stated that any submission concerning the petition for review should be filed within a non-extendable period of one month from the notification of that communication.

IX. A summons to all parties to oral proceedings on 5 February 2009 was issued on 17 October 2008. The

parties all filed written submissions. On 7 November 2008 the respondent filed submissions responding to the petition and complaining about the conduct of the petition proceedings. Both the petitioner and the other party filed written submissions on 18 November 2008.

X. On 9 December 2008, the Enlarged Board sent a further communication to the parties indicating the matters it expected to be discussed at the oral proceedings. As regards admissibility of the petition, the communication mentioned whether Article 112a EPC applies to interlocutory decisions or to a decision given orally before and notified after 13 December 2007 (the date of entry into force of the revised EPC), and whether the petitioner could have complied and, if so, whether it did comply with Rule 106 EPC. As regards allowability of the petition, the communication mentioned whether the petitioner had an adequate opportunity to comment on the respondent's case as it stood after its letter of 18 September 2007 was filed, or on the respondent's arguments presented at the oral proceedings on 18 October 2007 and whether, in either of those events, a fundamental violation of Article 113 EPC occurred. The communication invited the petitioner to clarify whether it still relied on the grounds in Article 112a(2)(d) and Rule 104 EPC. The communication also expressed the provisional opinion that the respondent's complaints about the conduct of the petition proceedings were based on a misunderstanding of the two distinct stages provided by Article 112a and Rule 109 EPC for the treatment of petitions for review.

XI. Subsequent to that communication, the respondent filed further written submissions on 5 January 2009 and the

petitioner filed a short letter dated 5 January 2009 in response to the communication confirming that it did not rely on Article 112a(2)(d) and Rule 104 EPC. Under cover of a letter faxed on 28 January 2009 the respondent filed a written legal opinion of Prof. Joseph Straus. On 30 January 2009, the petitioner filed a fax letter requesting that the opinion be found inadmissible.

XII. Oral proceedings were held before the Enlarged Board on 5 February 2009. The decision was announced at the end of the oral proceedings.

XIII. The petitioner requested that the legal opinion by Prof. Straus filed by the respondent on 28 January 2009 be not admitted into the proceedings, that the Enlarged Board of Appeal admit the petition, set aside the decision of 18 October 2007 and the decision of 24 April 2008 the subject of the petition, re-open the proceedings before the Technical Board of Appeal and direct that the members who participated in taking the decisions complained of be substituted.

The respondent requested the Enlarged Board of Appeal to reject the petition as inadmissible and/or unallowable or, if that is not done, as auxiliary request, to refer the petition back to a different three member panel of the Enlarged Board.
The other party requested the Enlarged Board to admit the petition, to set aside the decisions the subject of the petition, and to re-open the proceedings before the Technical Board of Appeal.

XIV. The petitioner's arguments presented in writing and at the oral proceedings can be summarized as follows.

(a) *Prof. Straus' opinion*

The Enlarged Board should find the legal opinion of Prof. Straus inadmissible. The issues are for the Enlarged Board alone to resolve and not for a lawyer, however eminent, who is not even a representative of the respondent. The opinion was late filed - the Enlarged Board set a strict one month deadline for submissions concerning the petition in its communication of 8 October 2008 but the respondent filed the opinion only one week before the oral proceedings. The respondent had ignored the rules of procedure and the directions of the Enlarged Board. None of the references cited in the opinion were provided by the respondent, some of them were in German which is not the language of the proceedings and, to the extent the petitioner had been able to locate the references, they did not support the opinion.

(b) *Change of requests*

Article 112a(5) and Rule 108(3) EPC govern what the Enlarged Board may do if a petition is allowed. The petition included requests but did not have to - Rule 107 EPC does not even require requests. The change of requests therefore had no effect on the validity of the petition, it only concerned the relief sought.

(c) *Interlocutory decisions*

Article 106(2) EPC, relied on by the respondent by analogy, is concerned with appeals and has no bearing on petitions. If a similar provision had been intended for petitions that would have been stated in terms as have other relevant provisions - such as no suspensive effect (Article 112a(3) EPC). Rule 109(1) EPC provides that Board of Appeal procedure applies to petitions unless otherwise provided. Article 106(2) does not apply to petitions since Article 112a EPC itself is the provision "otherwise provided".

Further, there is no reason to exclude interlocutory decisions. Article 112a EPC is clear - any party adversely affected may file a petition. There is a whole body of decisions which, although called interlocutory, are final in that they end proceedings at a specific instance. In the present case, the decisions on admissibility of the appeal and inventive step are final decisions which cannot be the subject of further consideration in the appeal proceedings. The *travaux préparatoires* support this - see paragraph 4 of CA/PL 17/00. It is a fundamental principle of interpretation of legislation that exclusions are narrowly defined, and the exclusion of interlocutory decisions would need express words.

(d) *The transitional provisions*

Article 112a EPC applies to the decision of 18 October 2007 although dated earlier than the entry into force of EPC 2000. The word "taken" in Article 1, point 4 of the Decision of the Administrative Council on the

transitional provisions must mean the date when the decision was notified for the following reasons.

(1) There would be no purpose in having different dates for when a decision is taken and when time for lodging a petition begins to run.

(2) The reasons for setting aside a decision required by Rule 107(2) EPC can only be prepared when the reasons for the decision are known.

(3) Normal language and common sense suggest "taken" means the date of notification.

(4) The *travaux préparatoires* support this interpretation (see CA/PL 17/00, page 23, paragraph 6 and CA/100/00, page 137, paragraph 14).

(5) T 390/86 (OJ 1989, 30, points 2 and 8 of the Reasons) shows that, until the decision-making process is complete, a decision announced orally is of no legal effect.

(6) A party should not be denied the right to petition just because the oral proceedings took place before the entry into force of Article 112a EPC.

(7) If for example, a decision was "taken" when announced orally before 13 December 2007 after refusing to hear a party possibly contrary to Article 113 EPC but the decision was not subsequently notified with reasons until after that date, the decision might thereby be "petition-proof" because that party might not know until reading the reasons whether it was

adversely affected and thus be deprived of the opportunity to file a petition for review.

The respondent relied on G 12/91 (OJ 1994, 285). That decision was concerned with finding a point in time when no further submissions are allowed, was not considering the present situation (namely announcement of a decision at oral proceedings and written reasons later), and could not consider Article 112a EPC.

Of the two decisions the subject of the petition, the most critical was that of 24 April 2008 which clearly was taken after the entry into force of Article 112a EPC.

In answer to questions from the Enlarged Board, the petitioner submitted that, if the earlier decision should be found outside Article 112a EPC because of the transitional provisions, the petition was still sufficiently substantiated as regards the later decision. It is irrelevant when the procedural defect occurred if the date of the decision is after the date of entry into force. The content of the petition is at large and directed to both decisions. But the outcome could be different for the two decisions: if the petition should succeed only on the second decision, the petitioner would go back to the Board of Appeal and argue inventive step on the late-filed requests.

(e) *Rule 106 EPC*

The purpose of Rule 106 EPC is to put a Board of Appeal on notice of a possible procedural defect so that, if the Board agrees, it can put it right. In this case,

the Board was clearly put on notice. The petitioner complained in two stages - in the letter of 3 October 2007 and at the oral proceedings (see pages 6 and 12 of the first decision). At the oral proceedings the petitioner made clear, with reference to G 4/92 (OJ 1994, 149) and the RPBA, that it had not had an adequate opportunity to prepare to meet the respondent's new case and objected to the Board proceeding on the basis of that case. The respondent's argument that there must be a separate formal objection of a procedural defect cannot be correct; it is enough to object once.

In answer to a question from the Enlarged Board, the petitioner agreed that an objection to admissibility, such as its objection to the respondent's new case in its letter of 3 October 2007, would not automatically be the same thing as an objection that the right to be heard had been denied but, in the present case, when the petitioner had not been able to prepare properly to answer the new case, it led to one and the same objection and, in any event, the objection was elaborated at the oral proceedings. It is not enough to make any objection to comply with Rule 106 EPC but, if the basis of the original complaint and the Rule 106 EPC objection are the same, one objection must be sufficient.

(f) *Allowability of the petition*

The case-law is clear that the right to be heard is not simply the right to speak, there has to be an adequate opportunity. That was not the case here, where an entirely fresh case with new requests was introduced

one month before the oral proceedings. T 263/93 of 12 January 1994 (see point 2.2.2 of the Reasons), in which admittedly the facts were different, said there must be sufficient time to submit an adequate response and that, since Rule 84 EPC 1973 required any time limit to be no shorter than two months, an adequate time for presenting comments should not be shorter than that. In that case, one month was found insufficient.

In the present case, the sole issue in the grounds of appeal was novelty and turned on one word. That was a very straightforward case. The respondent had the four months from notification of the decision under appeal provided by Article 108 EPC to file the statement of grounds of appeal which under Rule 64 EPC 1973 had to contain the grounds, facts and evidence relied on. The whole premise of those provisions is that after four months the other party knows the full case of the appellant. In this case, the Board of Appeal judged admissibility solely on the grounds of appeal as filed, and held anything produced after that was admissible (see the first decision, point 2.2 of the Reasons). Article 12 RPBA provides that appeal proceedings shall be based on the grounds of appeal and the reply. In this case there was no reply because there was no time. Under both the former and present Rules (Rule 84 EPC 1973 and Rule 132 EPC), at least two and up to six months is considered the norm. T 669/90 (OJ 1992, 739, see Reasons, point 2.3) said compliance with Article 113(1) EPC did not in itself mean procedure was fair, and the need for fairness overlaps with the principle of good faith which governs the relationship between the EPO and its users. The petitioner had a

legitimate expectation that the procedure would be conducted fairly.

While the minimum adequate time under the Rules is two months, there were several reasons why there should have been more - the respondent had over two years to prepare its new case; no reason was given for the lateness of the change of case; and there was no communication to reply to (as to all those reasons see T 446/00 of 3 July 2003, Headnote 2 and points 4.1.1, 4.1.2 and 4.5.3 of the Reasons). Further, the respondent abandoned a case it had pursued for two years; under the RPBA the petitioner would normally have had four months; the present representative was not instructed in the opposition proceedings so was not familiar with any material previously referred to then; the petitioner itself is a United States company, its experts are abroad, the first opportunity for all concerned to meet was the day before the oral proceedings.

The Board of Appeal's approach was intolerable. The EPC and RPBA are not formalities, they require fairness. Then, after the previous case was abandoned in favour of a new case, yet another new case was introduced at the oral proceedings. The 18 September 2007 letter made clear that the respondent's case on inventive step would be made by reference to documents ID 8, 9, 12, 26, 29, 32 and 35. However, at the oral proceedings it focussed on paragraph 88 and table 10 of the patent, which were not even mentioned in the letter of 18 September 2007 (see the second decision, points 10.9 and 10.10 of the Reasons). The petitioner was

"ambushed"; it was a fundamental violation of Article 113 EPC.

In answer to questions from the Enlarged Board as to where the petition, as opposed to the petitioner's later letter of 18 November 2008, mentioned the new arguments based on paragraph 88 and table 10 of the patent raised at the oral proceedings and, if the letter of 18 November 2008 formed new submissions, whether Article 12(1) RPEBA had been complied with, the petitioner submitted that the 18 November 2008 letter gave more detail than the petition and explained documents already referred to and that no-one was taken by surprise by the additional detail which did not introduce new facts.

The respondent's argument that the purpose of appeals is to develop new arguments must be seen in context (see Article 12(2) RPBA). It cannot be used to support the respondent's complete change of case four weeks before the oral proceedings. The assertion that requesting maintenance of the patent as granted effectively allows it to introduce whatever arguments it thinks fit shows the respondent's attitude to procedure. In this case things were allowed to get out of control.

(g) *Conduct of the petition proceedings*

The respondent's complaint - that its right to be heard was denied during the petition proceedings - was pointless and frivolous and showed a misapprehension based on Rule 109(3) EPC. There is no requirement to summon someone to proceedings in which he is not

involved. Rule 109(1) EPC says Board of Appeal procedure applies unless otherwise provided and, as regards consideration of petitions by the three member Enlarged Board, Rule 109(3) EPC provides otherwise. There was no violation of the respondent's right to be heard because, if a party is not to be involved, it has no right to be heard.

XV. The respondent's arguments presented in writing and at the oral proceedings can be summarized as follows.

(a) *Prof. Straus' opinion*

The opinion was filed in response to the Enlarged Board's communication of 9 December 2008. The "agenda" in that communication suggested the opinion would be helpful. It was not late filed. Prof. Straus had not been available during the Christmas holiday season. The respondent's representative filed it on the same day he received it. It dealt with several interesting legal issues and should be admitted into the proceedings. The deliberate non-application of Rule 115(1) EPC, second sentence, showed that in petition proceedings all procedure is accelerated.

(b) *Change of requests*

Article 112a and Rule 109(3) EPC provide for a decision on the basis of the petition. Paragraph 32 of the petition made requests which are no longer pursued. The requests presently pursued were presented at the oral proceedings on 1 October 2008 which was more than two months after the notification of the decisions

complained of and formed a completely different petition which is clearly invalid.

(c) *Interlocutory decisions*

Article 112a(1) EPC explicitly states that any party to appeal proceedings adversely affected by **the** decision, not **a** decision, of the Board of Appeal may file a petition. This must mean that only a final decision, not an interlocutory decision, can be the subject of a petition. This also follows from Article 106(2) EPC which, while concerning appeals, shows by analogy that a fundamental tenet of the EPC is to prevent any party from filing an appeal until the proceedings before the particular instance are terminated. This ensures speed and legal certainty and must apply to petitions for review. If Article 112a EPC extended to interlocutory decisions, any decision on any point could be the subject of a petition which would lead to large numbers of petitions, disruption of oral proceedings, fragmentation of appeals and legal uncertainty. The result would be chaos and delay - "a swamp of procrastination".

(d) *The transitional provisions*

Article 112a EPC has no application to events arising before it entered into force. Only events after 13 December 2007 can be relevant. As regards everything else, there was no law in existence at the time to allow assessment of a procedural defect or not.

Rule 68(1) EPC 1973 provided that a decision may be given orally and subsequently notified to the parties.

Rule 102 EPC requires that a decision shall be authenticated and contain the date when the decision was taken. The petitioner ignores whether the decision of 18 October 2007 was in force or not before Article 112a EPC entered into force. G 12/91 (point 2 of the Reasons) is very clear that a decision pronounced in oral proceedings becomes effective then. So the earlier decision was made and took effect before Article 112a EPC entered into force.

The Board of Appeal decided three points - the admissibility of the appeal, that the main request complied with certain requirements of the EPC, and that the debate on inventive step was closed. The only thing that was not done before Article 112a EPC entered into force was the notification of the decision. The suggestion that it can apply to the 18 October 2007 decision is "a hollow bubble". T 390/86 relied on by the petitioner is irrelevant because it relates primarily to a written decision. If accepted, the petitioner's argument would lead to different interpretations of when a decision is taken for different purposes. It would be an injustice to apply a law not in force at the time of the events in question.

(e) *Rule 106 EPC*

The petitioner never raised an objection of a procedural defect *per se*. Its letter of 3 October 2007 objecting to the respondent's requests says those requests were inadmissible, not that the appeal was inadmissible, and makes no reference to a procedural defect. The minutes of the oral proceedings may be short but, if the petitioner had raised an objection,

it would be recorded either in the minutes or in the decision. The burden of proof is on the petitioner to show that it did object. The requirement to object to a procedural defect is a quite distinct and additional requirement. Apart from objecting to something because it does not agree with it, Rule 106 EPC places a further requirement on a party to object at the time to a procedural defect. That just did not happen in the present case. It is an established principle that a party is responsible for making its own case and the petitioner failed to do that as regards this requirement. If the petitioner's argument that a separate objection under Rule 106 EPC is not necessary were correct, then any standard form objection would satisfy Rule 106 EPC and make it effectively superfluous.

(f) *Allowability of the petition*

As R 1/08 of 15 July 2008 (see point 4 of the Reasons) shows, the fact that a petitioner does not agree with the reasons for a decision is not relevant in the context of a petition. But that is the petitioner's case - it does not agree with the decision. The *travaux préparatoires* stated petitions for review should not be a means to review the application of substantive law (see MR/2/00, page 137, paragraph 5). The function of the petition for review is to correct intolerable deficiencies, not to restrict argument. The change from claiming a composition to a pharmaceutical composition was obvious; the only use for the composition was as a pharmaceutical. The respondent simply developed new argument during the appeal proceedings. That is the function of appeal proceedings (see T 86/94 of

8 July 1997, point 2.2.2 of the Reasons). There is no such thing as late argument (see G 4/92, OJ 1994, 149 and T 432/94 of 19 June 1997, point 5.4.1 of the Reasons).

The petitioner's case-law citations are not applicable. T 263/93 of 12 June 1994 was completely different, it concerned comparative tests, not new arguments. In T 446/00 of 3 July 2003, the appellant abandoned part of its case and then re-introduced it. In this case, the respondent did not abandon anything (see points 5.1 to 5.8 of the Reasons of the second decision). It filed an appeal requesting maintenance of the patent as granted which opens up everything; it allows the use of any reasonable arguments in its defence. Nothing can be a new case; it is still the same patent. Paragraph 88 and table 10 were in the patent from the very beginning. If the petitioner was right, there would be no scope at all for making new auxiliary requests after the grounds of appeal had been filed.

(g) *Conduct of the petition proceedings*

Rule 109(3) EPC only provides that other parties shall not be involved in the decision of the Enlarged Board in its initial three member composition, not that they shall not be involved in the proceedings at all. In particular, the respondent should have been summoned to the oral proceedings on 1 October 2008 and given the minutes of those oral proceedings. Rule 109(1) EPC states that certain procedural provisions shall not apply to petition proceedings. These include the second sentence of Rule 115(1) EPC (which requires two months notice of oral proceedings) but not the first sentence

which provides that "the parties" shall be summoned to oral proceedings. "The parties" includes parties who are not involved in the decision. Under Article 116 EPC any party which requests oral proceedings is entitled to them - the respondent so requested in its written submission of 29 July 2008 but it was not summoned to the oral proceedings subsequently held on 1 October 2008.

Also by analogy with Article 112(2) EPC, the respondent should have been summoned to attend those oral proceedings. Rule 126 EPC which requires a summons to be sent by registered mail was also ignored. There has also been a breach of the principle of good faith contrary to Article 125 EPC. Rule 109(3) EPC, which allows a decision to be made without hearing other parties, is directly contrary to Article 113(1) EPC and, according to Article 164(2) EPC, the provisions of the Convention must prevail over provisions of the Implementing Regulations. By not being allowed to participate in the oral proceedings, the respondent did not know what took place in the "black box discussion" between the petitioner and the Enlarged Board and was therefore put to a considerable procedural disadvantage.

XVI. The other party agreed with the petitioner's arguments with the following additional submissions.

(a) *Interlocutory decisions*

Contrary to the respondent's suggestion of a flood of petitions if Article 112a EPC should apply to interlocutory decisions, the present case is very

exceptional. Only a very small number of interlocutory decisions of the type at issue have ever been made by the Boards of Appeal. Article 112a EPC places no limit on the type of decisions it covers. Any party adversely affected may file a petition for review. Interlocutory decisions are final decisions in that they are no longer open to discussion and Boards of Appeal cannot change them.

(b) *Allowability of the petition*

A pharmaceutical composition was not mentioned anywhere in the application as filed: there was an Article 123 EPC issue. There was an opportunity at the oral proceedings to comment on table 10 of the patent, but only from 7.10pm to 7.15pm. There was no opportunity to consult experts or to conduct experiments.

(c) *Conduct of the petition proceedings*

The meaning of "without the involvement of other parties" in Rule 109(3) EPC is perfectly clear.

Reasons for the Decision

Prof. Straus' opinion

1. The Enlarged Board decided that the legal opinion of Prof. Straus filed by the respondent on 28 January 2009 should not be admitted into the proceedings. The respondent's argument that the opinion was a response to the communication of 9 December 2009 is unconvincing. That communication, issued after the written

proceedings in preparation for the oral proceedings was clearly only a summary of the questions which had arisen thus far prepared for use as an agenda at the oral proceedings. It only called for a response from one party on one point - from the petitioner about its case under Article 112a(2)(d) and Rule 104 EPC. The earlier communication of 8 October 2008 contained the clear and unambiguous direction: "Any submission concerning the petition for review should be filed within 1 month from the notification of this communication. This time limit cannot be extended". That time limit therefore expired on 18 November 2008. As its earlier submissions show, the respondent was well aware of the issues: if it wanted to obtain and file an opinion thereon, it could and should have done so within the time-limit. In view of the non-extendable time limit, the non-availability of Prof. Straus over Christmas and the speed with which the opinion was filed once it was produced on 28 January 2009 are of no significance.

2. The respondent's further argument that in petition proceedings all procedure is accelerated is partly correct but of no help to it. Rule 109(1), second sentence, EPC provides that certain specific procedural time limits shall not apply to petition proceedings. This allows the Enlarged Board to shorten the time periods specified in those provisions referred to in the interest of procedural efficiency (See Revision of the European Patent Convention (EPC 2000), Synoptic presentation EPC 1973/2000 - Part II: The Implementing Regulations, page 166, Rule 109). However, it clearly provides no justification to parties to disregard time limits set by the Enlarged Board itself.

3. While, compared with the extreme lateness of the filing of the opinion, the other arguments raised by the petitioner may be of less weight, they support the Enlarged Board's conclusion. The failure to supply the other party with copies or, as necessary, translations of references in a very late-filed document must always reduce the chances of its admissibility. That failure together with the extreme lateness of filing meant that the Enlarged Board could only accept the petitioner's submission that it had not been able in the few days available to verify the accuracy of the opinion by reference to its cited materials. Furthermore, it must be borne in mind that the opinion was essentially legal argument for which a party (or its representative) is responsible from the outset of proceedings.

Admissibility of the petition - formal matters

4. The petition was filed on 8 July 2008 and thus within two months of the date of notification (29 April 2008 - see Article 112a(4) and Rule 126(2) EPC) of the decisions of the Board of Appeal complained of. The prescribed fee was also paid on 8 July 2008. The petition also met the requirements of Rule 107(1) EPC. The petitioner is adversely affected by the decisions in question (see Article 112a(1) EPC).

5. The petition as filed identified two of the grounds for petition mentioned in Article 112a(2) and Rule 104 EPC, namely a fundamental violation of Article 113 EPC and deciding on an appeal without deciding on a request relevant to that decision (Article 112a(2)(c) and (d) respectively). The Enlarged Board's communication of

26 August 2008 indicated that it considered the latter ground unallowable since it appeared that all relevant requests had in fact been considered. In response to the Board's later communication of 9 December 2008, the petitioner confirmed in its letter of 5 January 2009 that it did not rely on that ground. However, it remains the fact that on any view the petition identified one of the specified grounds for petition, namely that in Article 112a(2)(c) EPC.

6. The respondent argued the petition was inadmissible for another formal reason, namely that the requests in the petition were not pursued but were replaced by other requests presented at the oral proceedings on 1 October 2008 and that, being more than two months after the notification of the decisions complained of, a new and different petition was filed which was invalid because out of time. The Enlarged Board does not accept that argument and agrees with the petitioner that Rule 107 EPC (which specifies the necessary contents of a petition) does not specifically require requests. The only requirement which can be derived from the wording of Rule 107(2) EPC is that the petition must make clear that the petitioner wants the decision of the Board of Appeal to be set aside. In the present case that request was expressly made in the petition.

7. The relief which the Enlarged Board can grant if a petition is allowed is in any event specified precisely by the legislation: Article 112a(5) and Rule 108(3) EPC provide that, if a petition is allowable, the Enlarged Board shall set aside the impugned decision and "re-open" (Article 112a(5) EPC) or "order the re-opening" (Rule 108(3) EPC) of the proceedings before the Board

of Appeal. Rule 108(3) EPC also empowers the Enlarged Board to order replacement of members of the Board of Appeal who participated in the impugned decision.

8. With the exception of that last measure which is discretionary, the outcome of a successful petition is therefore prescribed by legislation. In those circumstances, the role of requests in petition proceedings is necessarily limited and the Enlarged Board cannot agree with the respondent that, by merely bringing requests it had not been obliged to specify into conformity with the legislative provisions, the petitioner has filed a new and invalid petition out of time.

Applicability of Article 112a EPC under the transitional provisions

9. The petition complains of two decisions of which the first is dated 18 October 2007 although, like the second decision dated 24 April 2008, it was notified on 29 April 2008. The date of entry into force of the revised EPC, including Article 112a, was 13 December 2007 (see the Notice dated 20 September 2007 at OJ EPO 2007, page 504). The present case thus raises the question whether Article 112a EPC can apply to the first decision. This requires consideration of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 (see OJ EPO 2007, Special edition No. 1, pages 197 to 198).

10. As regards Article 112a EPC, which was a totally new provision introduced by the Act revising the EPC, Article 1, point 4 of the Decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Act revising the EPC of 29 November 2000 says:

"4. Article 112a shall apply to decisions of the Boards of Appeal taken as from the date of its entry into force."

Thus the question to be decided is when the first decision complained of was "taken" for the purpose of the transitional provisions. Unsurprisingly, the petitioner argued that the date the decision was "taken" should be the date it was notified (see XIV(d) above), the respondent that it should be the date it was announced (see XV(d) above).

11. In its decision G 12/91 (OJ EPO 1994, 285) the Enlarged Board was, as the petitioner correctly submitted, concerned with establishing the final point after which no further submissions by parties are allowed (in order, it might be added, then to determine the point in time at which the internal decision-making process involving a decision pronounced following written proceedings is completed). However, in the process of doing so, the Enlarged Board first established when decisions become effective. Its opinion in this respect (see point 2 of the Reasons) was:

"To do so it is first necessary to distinguish between decisions taken after the closing of the debate in oral proceedings and decisions taken following written

proceedings. Where oral proceedings are held, the decision may be given orally. The decision becomes effective by virtue of its being pronounced. The equivalent of this moment in written proceedings is the moment the decision is notified. Once it has been pronounced and, in the case of written proceedings, notified, the decision enters into force and cannot be amended, even by the department that issued it."

That represents the position generally accepted in all EPO proceedings, namely that a decision given orally at oral proceedings becomes effective by virtue of its being pronounced and not, unlike a decision given after only written proceedings, when notified.

12. The respondent submitted that this was enough to show the first decision was taken for the purposes of the transitional provisions when it was pronounced at the oral proceedings on 18 October 2007. The petitioner argued that this should not be the case and that "taken" should mean the date of notification. However, the Board sees two alternative difficulties inherent in the petitioner's argument. First, if that argument were successful, the word "taken" in the transitional provisions would have a different meaning to "becomes effective" in G 12/91. That result would mean "taken" is almost deceptive since, without more, the objective person would consider a taken decision to be one which has effect (not least because "takes effect" is a common alternative phrase for "becomes effective"). In G 12/91 the Enlarged Board said once a decision has been pronounced, it enters into force and cannot be amended.

13. Alternatively, if "taken" (or "pronounced") on the one hand and "becomes effective" (or "takes effect") on the other were not to be equated in time for the purposes of the transitional provisions, then such few decisions as may have been pronounced before 13 December 2007, notified after that date and subsequently become the subject of petitions for review would have had their effective date postponed. Contrary to G 12/91, the effect would be to treat such decisions not as if they had been pronounced at oral proceedings but as if they had been issued after only written proceedings. Moreover, such postponement would seemingly arise only retrospectively and only if and when a party to the proceedings should decide to file a petition.

14. The petitioner sought to distinguish G 12/91 on three grounds. First, as already mentioned, it said that decision was concerned with finding a point in time when no further submissions are allowed. That is correct but, again as already mentioned, in doing so the Enlarged Board found as a necessary preliminary that decisions pronounced at oral proceedings become effective by virtue of being pronounced. Second, the petitioner observed that G 12/91 was not considering the present situation where a decision was announced at oral proceedings and written reasons were provided later. That is correct only to the extent it repeats the previous submission. In fact it is clear on the face of the decision that, as regards when decisions take effect, G 12/91 considered both decisions pronounced orally with subsequent written reasons and decisions given in writing after written proceedings. Third, the petitioner said G 12/91 could not have considered questions arising under Article 112a EPC.

That is true but also a truism. It is no justification for ignoring earlier case-law in interpreting later legislation: the fact that the present case concerns new provisions does not mean inconsistency with earlier decisions should be simply accepted, and certainly not in the absence of any indication that the legislator intended to give the word "taken" in the transitional provisions a different meaning to that supplied by the case law interpreting the EPC.

15. The petitioner also deployed a list of seven reasons why the date of notification should be the date a decision is "taken" (see XIV(d)(1)-(7) above). The Enlarged Board does not find that the passages in the *travaux préparatoires* prayed in aid by the petitioner (reason (4) in its list) throw any light on the possible legislative intent in the use or meaning of "taken". The petitioner relied upon two similar passages (in its written submissions of 18 November 2008, CA/PL 17/00, page 6, paragraph 23 and, in its submissions at the oral proceedings on 5 February 2009, CA/100/00, page 137, paragraph 14). Those passages are two "generations" (dated 27 March 2000 and 9 August 2000 respectively) of commentary on the text of what is now Article 112a(4) EPC which concerns the time limit for filing petitions. They both say that time limit should be short in the interests of certainty for third parties, and the earlier text concludes by saying the short time limit should be "no longer than two months after the decision of the board of appeal became final" (the provision which is now in force - see Article 112a(4) EPC).

16. However, the Enlarged Board cannot see how that commentary in the *travaux préparatoires* about the time limit for filing petitions offers guidance as to when a decision is "taken" for the purposes of the transitional provisions. The petitioner pointed to the expression "... after the decision of the board of appeal became final" to show that the drafters of Article 112a EPC considered that notification of a decision makes that decision final. The Enlarged Board observes that in doing so the drafters of Article 112a EPC were only concerned with fixing the beginning of the time limit for filing a petition for review with respect to decisions taken under the new provisions in a uniform manner for all decisions, irrespective of whether they would be given orally or in writing. In that context the drafters were not concerned with the legal definition of when a decision is taken in the sense of when it becomes final or takes effect. They were also not concerned with the question of the transitional provisions which were not under consideration at all in this passage which does not therefore contradict, let alone outweigh, the decision in G 12/91.

17. The Enlarged Board has reached a similar conclusion regarding the case-law relied on by the petitioner (reason (5) in its list) namely, the decision T 390/86 (OJ 1989, 30). The respondent claimed this case was irrelevant because it related primarily to written proceedings but that is an over-simplification. The petitioner relied on points 2 and 8 of the Reasons, which both referred to the completion of a substantive decision given orally during oral proceedings by formal notification to the parties in writing, and submitted

that this showed that, until the decision-making process is completed by the notification of a written decision, a decision given orally is of no legal effect.

18. Apart from the obvious contradiction between that submission and G 12/91, the Enlarged Board is not satisfied that, taken as a whole, T 390/86 supports the petitioner's proposition. Thus, point 3 of the Reasons shows that the Board first considered whether the Opposition Division had the power to give a final substantive oral decision at the conclusion of the oral proceedings, concluded in point 4 that such was indeed the case and that, as soon as it was issued at the oral proceedings on 8 October 1985, the oral decision was final in respect of the substantive issues in the opposition proceedings with which it dealt. The Board then turned to consider whether the decision was valid having regard to the complete change in composition of the Opposition Division between the oral proceedings and the reasoned written decision and concluded that, in those circumstances, not only the written decision had no legal effect but also, because the substantive oral decision had not subsequently been completed by a valid written decision, the substantive oral decision was also of no legal effect.

19. It appears thus that the broadest proposition supported by T 390/86 is that a procedural violation (such as a late change of composition) even in the conduct of completing formal steps will invalidate an otherwise valid decision already announced. It does not support the petitioner's yet broader proposition that a decision announced orally requires the completing step of the written reasons in order to have legal effect at

all. On the contrary, it suggests that in the absence of a procedural violation the position is as later stated in G 12/91.

20. The Enlarged Board finds none of the other reasons in the petitioner's list sufficiently persuasive to interpret "taken" as the date of notification. In answer to reason (1) - that there would be no purpose in having different dates for when a decision is taken and when time for lodging a petition begins to run - there would be a very obvious purpose, namely to provide certainty as to what has been settled by the decision as soon as possible. Reason (2) was that reasons for setting aside a decision required by Rule 107(2) EPC can only be prepared when the reasons for the decision are known: that is correct and is why time for filing a petition runs from notification, but that does not mean the date a decision is taken cannot be different. Reason (3) was that normal language and common sense suggest "taken" means the date of notification: but G 12/91 clearly suggests otherwise. Reason (6) was that a party should not be denied the right to petition just because the oral proceedings took place before the entry into force of Article 112a EPC. However, the transitional provisions had to set some point in time as a limit before which no petition would be possible and that is quite simply what was done here. The petitioner's last reason (7) was that some decisions, if "taken" when announced orally before 13 December 2007 but only notified after that date could be "petition-proof" and an adversely affected party might be deprived of the opportunity to file a petition for review. While that may be so, indeed it is much the situation in which the petitioner finds itself,

this reason again disregards both the requirement that the time limit for filing the petition starts to run from the date of its notification in writing and the fact that the transitional provisions had to select a particular point in time as a limit.

21. In summary, none of the petitioner's arguments outweigh the very clear direction pointed by decision G 12/91 to the interpretation of "taken" as the date a decision given orally is pronounced. Any other interpretation would lead either to a deceptive meaning of "taken" or the retrospective delay of a board's decision's irreversible effect by the later filing of a petition. Accordingly, the Enlarged Board finds that the first decision dated 18 October 2007 was taken on that date for the purposes of the transitional provisions and therefore Article 112a EPC cannot apply to it. Thus the petition is, as regards that decision, inadmissible.

Substantiation

22. Rule 107(2) EPC requires a petition to indicate the reasons for setting aside the decision of a Board of Appeal and the facts and evidence on which it is based. This corresponds to the similar provisions requiring substantiation of an opposition or an appeal (see Rules 76(2)(c) and 99(2) EPC). In view of the exceptional nature of the remedy offered by the petition procedure, the burden it imposes on a petitioner can be no less than the equivalent burden placed by those provisions on opponents and appellants. Thus the contents of a petition must be sufficient for the petitioner's case to be properly understood on an objective basis and must be so presented as to enable

the Enlarged Board (and any other parties) to understand immediately why the decision in question suffers from a fundamental procedural defect which can be the subject of an objection under the provisions on review (see "Case Law of the Boards of Appeal of the European Patent Office", 5th edition 2006, section VII.C.4.5 "Substantiation of the opposition", pages 556 to 562 and section VII.D.7.5 "Statement of grounds of appeal", pages 621 to 625). The petition must thus set out the reasons why it requests that the impugned decision be set aside, specify the facts, arguments and evidence relied on and must do so by the end of the time for filing the petition, namely two months after notification (Article 112a(4) EPC). As regards any further submissions made by the petitioner after that time, Article 12(1) RPEBA says the Enlarged Board may consider such submissions "if this is justified for special reasons". It is thus clear that, apart from any reasons accepted by the Enlarged Board as special enough to justify the submission of additional facts, arguments or evidence, the petition itself must be adequately substantiated.

23. Accordingly the question which the Enlarged Board must consider is: does the petition set out the reasons why the petitioner requests that the second decision be set aside and specify the facts, arguments and evidence relied on? Such a question does not arise in respect of the first decision since the petition is, as regards that decision, inadmissible for other reasons. However, the petitioner considered the content of its petition to be at large and directed to both decisions (see XIV(d) above). The Enlarged Board is not convinced that such was clear on the face of the petition; it appeared

from the petition that it relied on facts and arguments concerning almost entirely the new case presented by the respondent's letter of 18 September 2007 and the subsequent treatment of the petitioner's admissibility arguments, both as regards admissibility of the appeal (including the abandoned case argument) and admissibility of the respondent's new requests. Those matters were clearly dealt with in the first decision which held both the appeal and the new requests admissible and the Enlarged Board is not able to understand objectively from the petition that all those facts and arguments are to be considered as "recyclable" against the second decision. The submissions in the petition on those matters cannot substantiate the petitioner's objection that its right to be heard was violated as regards the discussion on inventive step. A question of admissibility is *a priori* entirely distinct from the question whether or not a party had an adequate opportunity to comment on the issues. The adequacy or not of the opportunity depends on the circumstances of the case and not on the procedural issue of the time allowed by rules of procedure for the introduction of new submissions.

24. The petition itself acknowledged that the two decisions dealt with separate issues and that the second decision was concerned only with the issue of inventive step of the respondent's main request held admissible in the first decision. Apart from matters decided in the first decision, the only group of facts on which the petition relied as regards the second decision was that totally new points in relation to inventive step of the main request were advanced at the oral proceedings and that the Board of Appeal dealt with this unfairly (see

petition, paragraph 26). It is clear that the petitioner considers this relates to the second decision because the next paragraph of the petition states that following the oral proceedings the Board of Appeal in the second decision reversed the decision under appeal and found the subject matter of the main request involved an inventive step (see petition, paragraph 27). Thus, the matters relied on in the petition as regards the first decision not being "recyclable", it is only that separate or additional new case alleged to have been introduced by the respondent during the oral proceedings on which the petition relies as regards the second decision.

25. The petition states (see paragraph 26) that this further new case arose through the respondent's argument that "the technique described by the Patentee to make the claimed antibody was in itself different from previously well known methods" and says this assertion raised completely new issues. That appeared to be a complaint about argument of the respondent employed in relation to the issue of whether, in the context of inventive step, the solution to the problem was obvious, more particularly the argument that the skilled person would not have attempted to generate the claimed human monoclonal antibodies. In point 6.3 of its communication of 26 August 2008 the Enlarged Board pointed out that if this understanding was correct then the Board had in any case rejected this line of argument in coming to its positive conclusion on inventive step which was based on other considerations. The Enlarged Board referred to point 8 of the Reasons in the second decision in this respect. The correctness of this assessment by the Enlarged Board has not been

disputed by the petitioner and this aspect of the allegedly new case put forward by the respondent at the oral proceedings before the Board has not been relied on since. Instead, at the oral proceedings before the Enlarged Board on 1 October 2008 reference was made for the first time by the petitioner to paragraph 88 and table 10 of the patent in suit which concern not a technique for making an antibody but (as the respondent argued before the Board of Appeal) an assay for testing the claimed antibodies, the results of which showed they have a therapeutic value. As the decision shows (see points 5 to 7 of the Reasons), that was an argument directed to whether the problem was solved and not to whether the solution was obvious.

26. As indicated above, the petition makes no reference to the argument based on paragraph 88 and table 10 of the patent. This was first mentioned at the oral proceedings on 1 October 2008 and first submitted in writing in the petitioner's letter of 18 November 2008. This was why the Enlarged Board asked the petitioner at the oral proceedings on 5 February 2009 whether, if the new argument based on paragraph 88 and table 10 of the patent letter was first mentioned in the letter of 18 November 2008 and if that formed new submissions, Article 12(1) RPEBA had been complied with. In answer the petitioner submitted that the 18 November 2008 letter gave more detail than the petition and explained documents already referred to and that no-one was taken by surprise by the additional detail which did not introduce new facts. However, while the 18 November 2008 letter certainly gave more detail and could indeed be said to explain a document (the petition) already referred to, it gave detail about and explained

relevant facts which had not been set out in the petition. The Enlarged Board cannot agree with the petitioner that the 18 November 2008 letter did not introduce new facts. No explanation was offered as to either why those facts were not specified in the petition nor were any special reasons offered to justify the late submission of those facts under Article 12(1) RPEBA. Indeed, the Enlarged Board cannot see what special reasons could be put forward which would justify the late submission in question. It is therefore apparent that the petition itself did not contain any facts, arguments or evidence which seen on an objective basis could substantiate the allegation that a fundamental violation of the petitioner's right to be heard under Article 113 EPC had occurred with respect to the evaluation of inventive step by the Board, this alone being the subject-matter of the second decision. Therefore, the petition is also inadmissible as regards the second decision.

Conclusion

27. Accordingly, the Enlarged Board concludes that the petition must be rejected as inadmissible. It is therefore unnecessary to reach any conclusion in this decision on any issue other than those referred to in the above reasons.

Conduct of the petition proceedings

28. Although the respondent's complaints about the conduct of the petition proceedings were couched in the framework of a now redundant auxiliary request, the Enlarged Board considers nevertheless that it should

comment on them in order to clarify the position for potential parties in other possible petition proceedings. In the judgment of the Enlarged Board, the respondent wholly misunderstood the two distinct stages provided by Article 112a and Rule 109 EPC for the treatment of petitions for review.

29. Rule 109(1) EPC, headed "Procedure in dealing with petitions for review", provides in its first sentence that:

"In proceedings under Article 112a, the provisions relating to proceedings before the Boards of Appeal shall apply, unless otherwise provided."

As regards the procedure for the first stage of petition proceedings, there are indeed such measures "otherwise provided", namely Rule 109(2) and (3) EPC.

30. Rule 109(2)(a) EPC provides that the Enlarged Board of Appeal composed of three members shall examine all petitions for review and reject those which are clearly inadmissible or unallowable. Rule 109(3) EPC states that the Enlarged Board in that composition shall decide "without the involvement of other parties and on the basis of the petition." The cumulative effect of those two provisions is that, in the first stage of petition proceedings, parties other than the petitioner are not to be involved in the proceedings. Such other parties are beyond doubt parties and are indeed called such in Rule 109(3) EPC itself, but they are not to be involved. So long as they are not involved, they have no right to be heard and thus no complaint, such as

that made by the respondent, of a denial of the right to be heard can arise.

31. The respondent's distinction between involvement in proceedings and involvement in a decision is a strained and artificial interpretation of Rule 109(3) EPC. That provision says quite clearly "The Enlarged Board of Appeal composed according to paragraph 2(a) shall decide...". As would only be expected of any judicial decision, the only persons involved in the decision are the appointed decision-makers who, under Article 112a and Rule 109(2)(a) and (3) EPC, are three members of the Enlarged Board. Accordingly, the expression "without involvement of the parties" means without the parties' involvement in the proceedings. That is the straightforward and common sense interpretation of Rule 109(3) EPC and the only interpretation it can bear.

32. It follows that all the respondent's other arguments in this respect (see XV(g) above) are redundant. Article 112(2) EPC does not apply, even by analogy, since Rule 109(3) EPC "otherwise provides". The provisions about oral proceedings (Article 116, Rule 115(1), first sentence, and Rule 126 EPC) do not apply to parties other than the petitioner because they are not involved - again, Rule 109(3) EPC has "provided otherwise". This is not contrary to Article 125 EPC as there is no breach of the principle of good faith because no duty of good faith lies towards those not involved. Nor is there a contravention of Article 164(2) EPC because Rule 109(3) EPC is not contrary to Article 113(1) EPC.

33. There is general support for the Enlarged Board's view in the *travaux préparatoires* which, at several stages of the legislative process, stressed the need for a quick screening process to be conducted by a three member panel of the Enlarged Board in order to reject petitions which clearly cannot succeed (see for example documents MR/2/00, page 143, paragraph 19; CA/PL 17/00, page 6, paragraph 23, and CA/100/00, page 139, paragraph 19). It is clear that, in advocating this fast, summary first stage of proceedings, the legislator was actually intending to benefit parties other than petitioners by not requiring them to take any steps in response to a petition until the Enlarged Board should be satisfied that it was not to be rejected as clearly inadmissible or unallowable. Thus, while the respondent argued that the first stage proceedings put it at a procedural disadvantage, the first stage is actually advantageous to parties other than petitioners.

34. For completeness it should also be observed that non-petitioner parties, although not summoned to oral proceedings in the first stage, may of course attend such proceedings which are public. Further if, as a result of the first stage proceedings, a petition is not found by unanimous decision to be clearly inadmissible or unallowable, it will then be considered by the Enlarged Board in the larger composition provided for in Rule 109(2)(b) EPC and, if and when that second stage is reached, the other parties are to be involved.

Order

For these reasons it is decided that:

The petition for review is rejected as inadmissible.

The Registrar: The Chairman:

W. Roepstorff

P. Messerli