

Part 7 Chapter I: Common provisions governing procedure

Art.113

Art.113
(1) Right of parties to comment
(2) EPO considers/decides on text submitted or agreed



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Art.113 Right to be heard and basis of decisions

- (1) The decisions of the EPO may ONLY be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.
- (2) The EPO shall examine,
and decide upon, the EPA or the EP only in the text submitted to it,
or agreed, by the applicant or the proprietor of the patent.



R.111
(1) Decision given orally thereafter written
(2) Decision must be reasoned + possibility to appeal

R.111 Form of decisions

R.111 <=> R.68 EPC1973

- (1) Where oral proceedings are held before the EPO, the decision may be given orally.
The decision shall subsequently be put in writing and notified to the parties.
- (2) Decisions of the EPO which are open to appeal shall be reasoned
and shall be accompanied by a communication pointing out the possibility of appeal
and drawing the attention of the parties to Art.106 to 108,
the text of which shall be attached.
The parties may not invoke the omission of the communication.

Basic principles of decisions



E.X.1.1

- Decisions subject to appeal
are taken by the Receiving Section, the examining divisions, the opposition divisions and the Legal Division. Art. 106(1)
- Unless otherwise specified, principles described in this chapter apply to all such decisions.
- They also apply to decisions taken by formalities officers to whom this work is entrusted OJ2014, A6
OJ2015, A104
- According to Art.113(1) decisions of the EPO may only be based on grounds or evidence
on which the parties concerned have had an opportunity to present their comments
- Art.113(1) EPC is intended to ensure
that no party can be taken by surprise by grounds for a decision against his application
on which he did not have an opportunity to present his comments.

Part 7 Chapter I: Common provisions governing procedure

Art.113

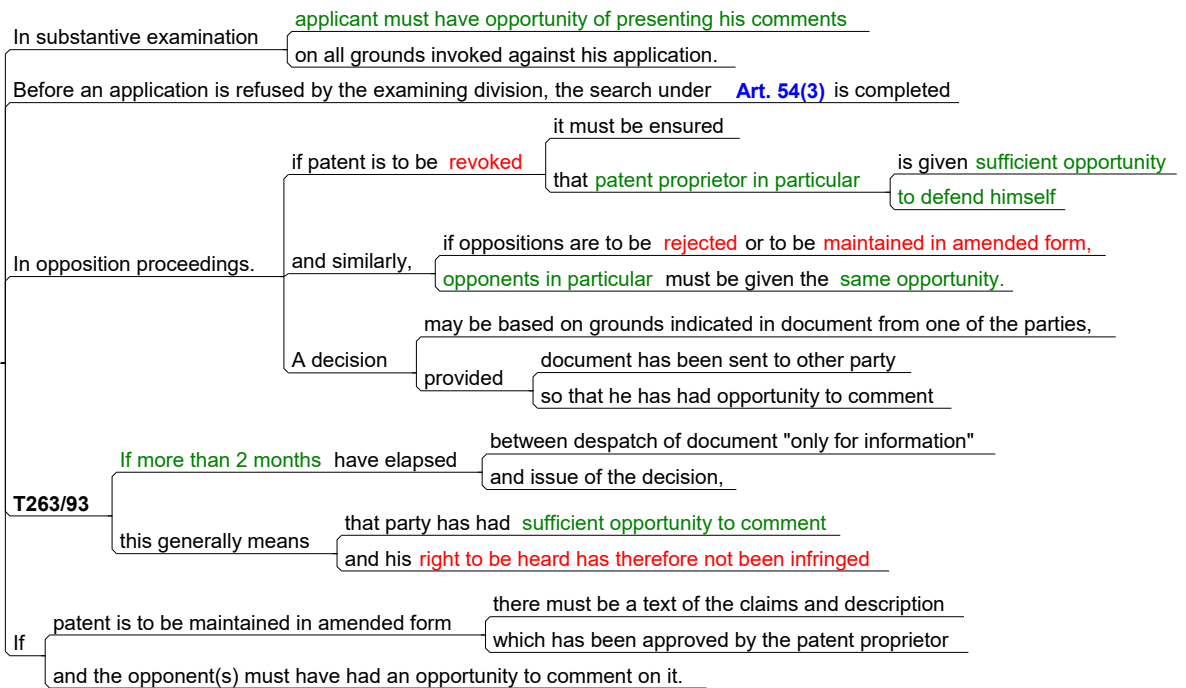


Basic principles of decisions
Right to be heard
Loss of rights
Signature

Decisions taken by Exam Div or Oppo Div



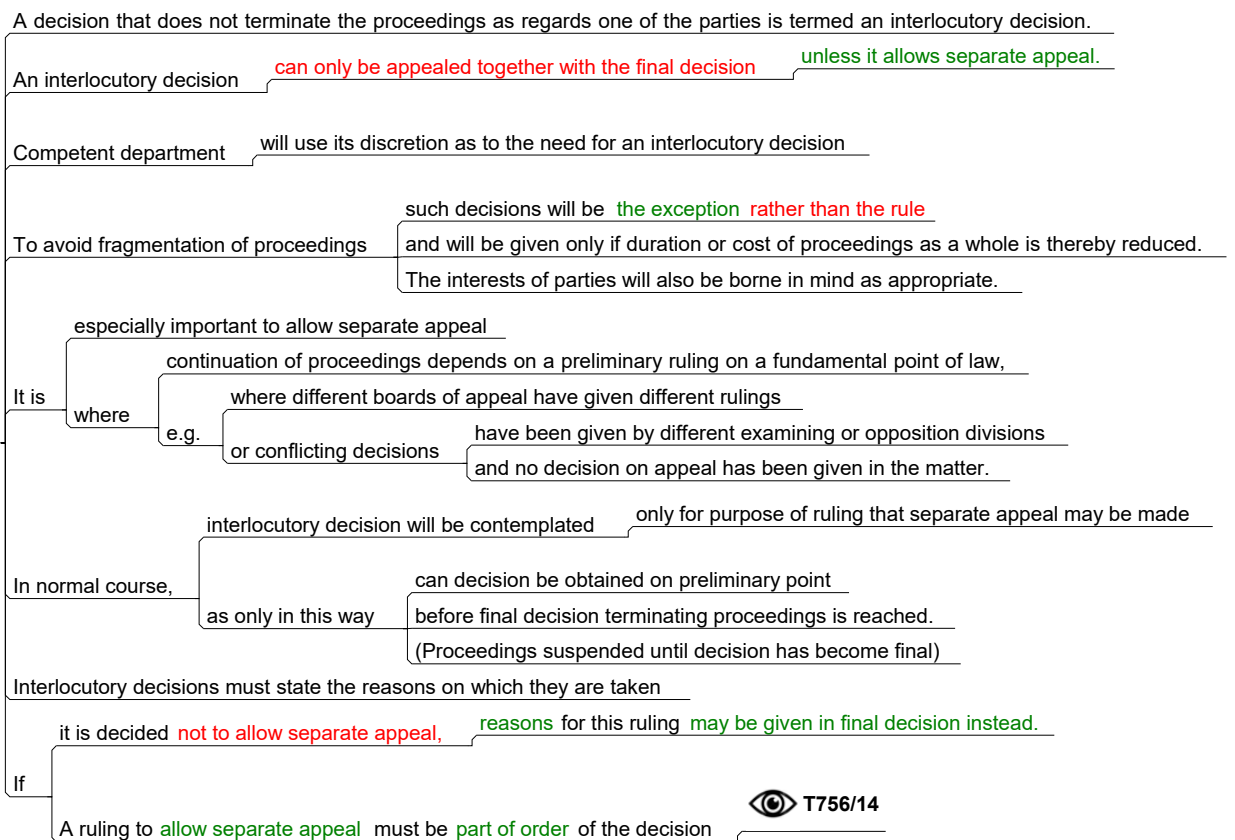
E.X.2



Decisions which do not terminate proceedings = interlocutory decisions



E.X.3



T756/14

Art.113

Basic principles of decisions

When is there a decision?



Basic principles of decisions
Right to be heard
Loss of rights
Signature



III.K.3.1

J8/81, J26/87, J43/92;
T222/85, T713/02;
J 14/07 and T165/07

Determining whether there is a decision

depends on

substance of the document content
and not its **form**

T713/02

The criterion of substance has to be **assessed in its procedural context**

contents of a "communication" never constituted a **"decision"**.

This distinction was important because only a "decision" could be the subject of an appeal **Art.106(1) EPC**

T222/85

communication only represented preliminary view **on an ex parte basis**
and was not binding upon EPO department which sent it.

In contrast, **contents of "decision"** were always final and binding in relation to department of EPO which issued it,
and could only be challenged by way of appeal.

annex to minutes of oral proceedings had been sent, but **not the decision itself**.

T999/93

The annex **although containing reasons**

did not validly fulfil function of decision in writing since it **did not bear any name or signature**.

Cases involving two decisions



III.K.3.1.1

T830/03

Oppo Div had issued second written decision **intended to supersede first written decision already sent**.

need for legal certainty required presumption of validity

in favour of written decision which was notified to parties by Oppo Div

All actions by Oppo Div **after notification of (first) decision,** and a fortiori after filing of first appeal

were ultra vires and thus **had no legal effect**.

T1257/08

first written decision notified constitute opposition division's **only** legally valid written decision.

Oppo Div was bound by it and **could not itself set it aside**

only first written decision as legally valid decision was **appealable**.

T1972/13

second **decision** issued by Exam Div **refusing applicant's request for refunding additional search fee**
was null and void

it is not relevant **whether or not** a separate appeal against second decision was filed,
given that appeal against legally void decision could logically have **no legal effect**.

Inconsistency between oral and written decisions



III.K.3.1.2

T425/97

sole ground of appeal **was the inconsistency existing between written decision**
and form of patent held to be patentable by Oppo Div at the oral proceedings.

R.68(1) EPC1973 **(R.111(1) EPC)** **decision** **announced at the oral proceedings and the written one**

had to be the same

=> so any discrepancy between the 2 was a procedural flaw



T318/01, T1590/06
T1698/06

T850/95

in examination proceedings, **where decision to grant patent** **referred to documents approved by applicant**
under **R.51(4) EPC1973 (R.71(3) EPC)**
these documents became an integral part of that decision.

T740/00

Differences between **decision pronounced at the oral proceedings and**
written decision

were **not mistakes** which could be corrected under **R.89 EPC1973,**
but amounted to **substantial procedural violation**
requiring immediate remittal to department of first instance.

Part 7 Chapter I: Common provisions governing procedure

Art.113



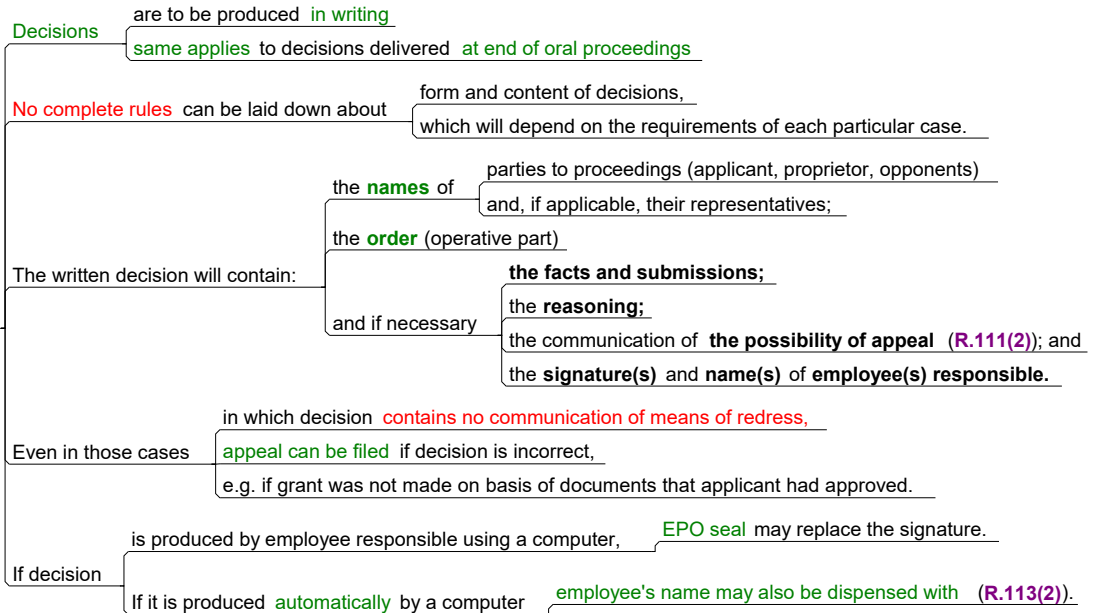
Basic principles of decisions
Right to be heard
Loss of rights
Signature

Basic principles of decisions

Form and content



E.X.1.3

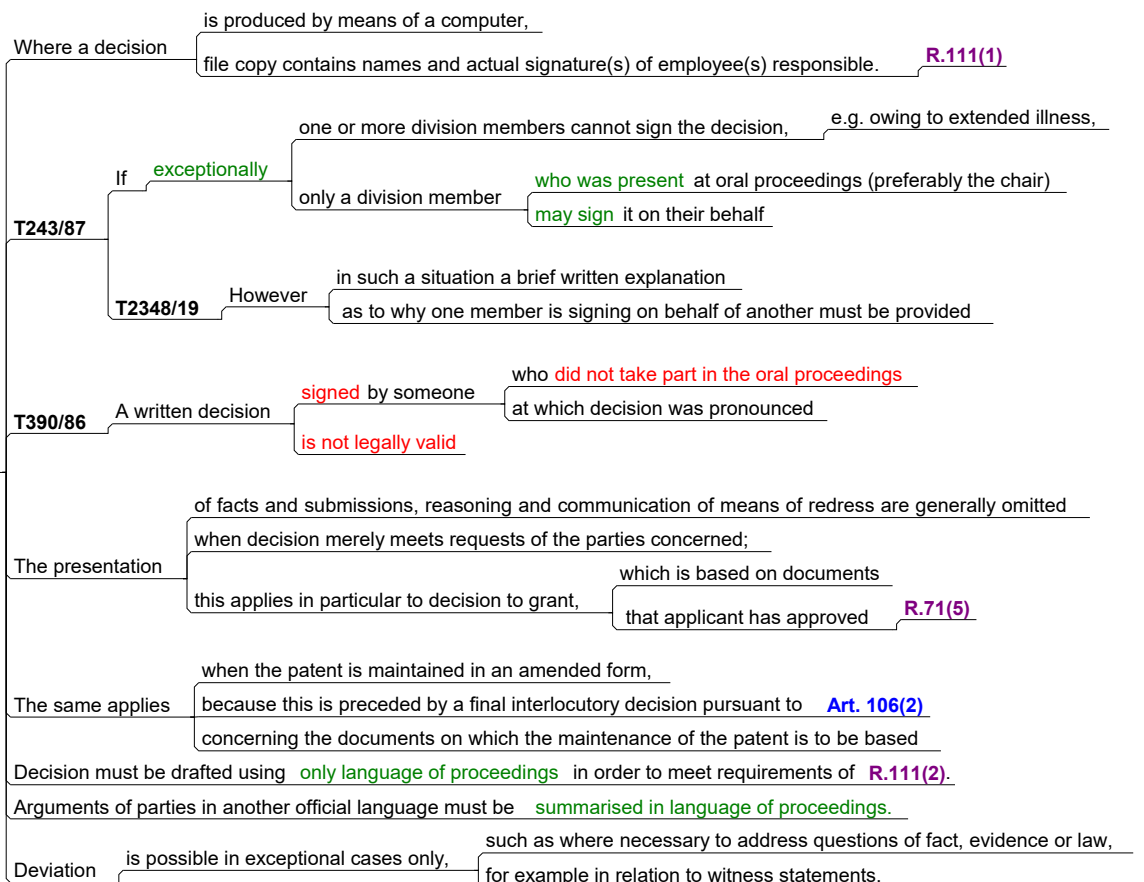


Form

Requirements as to form



E.X.2.3



Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Basic principles of decisions

Content



E.X.2.7

The decision normally deals with all independent claims of valid request(s) that were discussed during proceedings.

A single ground is enough to refuse application, so it is not always necessary to deal with all dependent claims.

If however a particular dependent claim has been discussed, decision includes relevant arguments

Any additional requests still outstanding must be dealt with in refusal decision.

If, e.g. new oral proceedings were requested in circumstances where Art.116(1), second sentence applies, decision must give reasons for rejecting that request.

Formulations implying doubt or uncertainty, such as "seems" or "apparently", must be avoided in decisions.

Order



E.X.1.3.1

The order (or "operative part") of decision

must clearly state request of parties

and extent to which this request is complied with



T756/14

It may be as follows:

"The European patent application ... is hereby refused pursuant to Art.97(2) EPC.";

"The opposition to the European patent ... is hereby rejected."; or

"The request for re-establishment of rights is hereby rejected".

Binding nature of decisions on appeals



E.X.4

If a department

has to give a decision in a case

which has already been remitted by BoA for further prosecution to that department,

that department

is bound by ratio decidendi of BoA

Art.111(2)

insofar as

facts, e.g. subject-matter of patent

and relevant state of the art, are the same.

is not bound by a decision of BoA

Oppo Div

on appeal against decision from Exam Div



T167/93

The exclusive phrasing of last sentence of Art.111(2)

only mentioning

Exam Div being bound by decision on appeal against a decision of the Receiving Section,

makes this clear.

Opposition proceedings

are entirely separate from the examination proceedings,

and the opposition division

is entitled to examine the facts, evidence and arguments anew, particularly since another party (the opponent) is now involved.

It, however takes due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the board of appeal.

Pointing out right to appeal in accordance with R.111(2) EPC



III.K.3.2

R.111(2) EPC =>

appealable EPO decisions must be accompanied by communication pointing out possibility of appeal

and drawing the attention of the parties to Art.106-108 EPC which specify how to file appeals.

parties cannot invoke any omission to communicate this possibility

R.111(2), second sentence, EPC

However

EPO's failure to enclose the text of Art.106-108 EPC with decision

neither invalidated decision

T42/84

nor amounted to substantial procedural violation



T231/99
T493/08

Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Basic principles of decisions

Content

Facts and submissions



E.X.1.3.2

Facts and submissions have to be given insofar as they are significant for the decision.

Under facts. a brief description of case
 and a summary of main reasons on which decision is based
 and of most important replies of parties is given.

These points, however, are to be covered in detail in the subsequent reasoning

Reasons for the decision



III.K.3.4

R.111(2) EPC expressly stipulates that appealable decisions are to be reasoned.

The statement of grounds must first set out and substantiate the reasons for the decision,
 citing the individual EPC articles and rules involved.

The deciding instance will draft decision based on one or more grounds forming basis of decision,

The statement of grounds must first set out and substantiate the reasons for the decision,
 citing the individual EPC articles and rules involved.

It is essential that parties have been given an opportunity to comment
 on all grounds on which the decision is based.

When several grounds are used in decision,
 it is imperative to link them in a logical way
 in particular avoiding having a subsequent ground contradict an earlier one.



E.X.1.3.3

Furthermore, chain of grounds must be structured
 so that it starts with the main ground.

All significant arguments advanced by party to proceedings
 are carefully examined and comprehensively discussed in decision.

In individual cases, consideration may also be given to the reasoning of those decisions
 which merely meet the requests of the parties.

If for example a number of reasons are invoked for a request for re-establishment,
 of which only one justifies re-establishment,
 => a reasoned decision on re-establishment may be appropriate,
 in order to clarify the official action.

Purpose of duty to provide reasons



III.K.3.4.1

T70/02 This principle is intended to ensure fairness between EPO and parties to proceedings
 and enable the decision to be reviewed on appeal

T652/97 EPO can only properly issue decision against party if that decision is adequately reasoned

Information as to means of redress



E.X.5

Decisions of the EPO which are open to appeal
 must be accompanied by a written communication of the possibility of appeal.

The communication must also draw the attention of the parties
 to the provisions laid down in Art. 106 to 108 and Rules 97 and 98,
 the text of which must be attached.

The parties may not invoke the omission of the communication. Rule 111(2)

Part 7 Chapter I: Common provisions governing procedure

Art.113



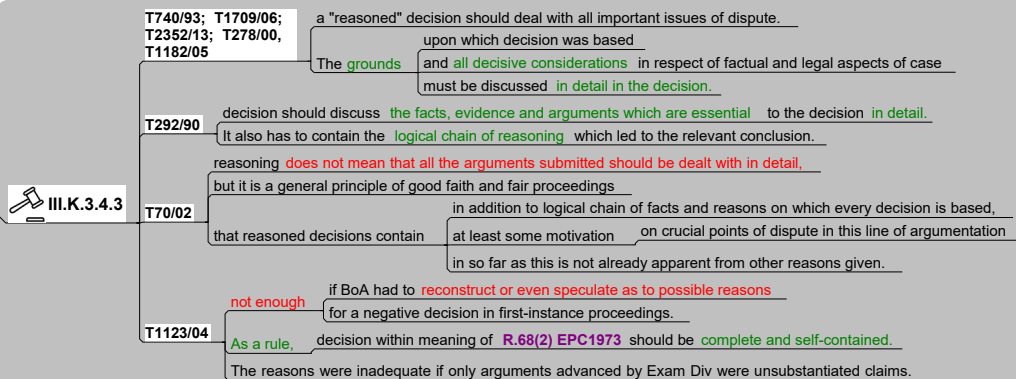
Basic principles of decisions
Right to be heard
Loss of rights
Signature

Basic principles of decisions

Content

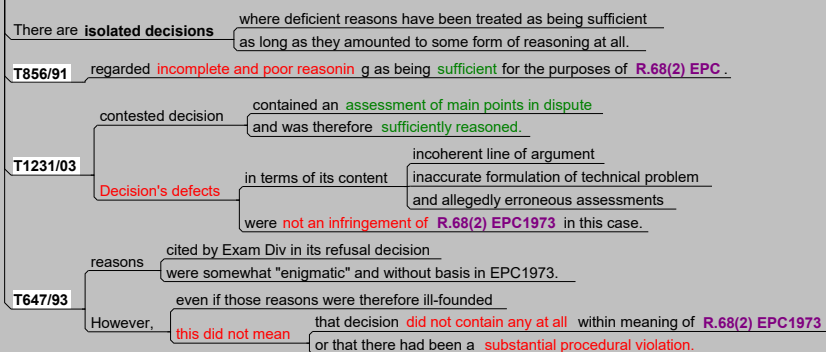
Reasons for the decision

Requirement of sufficient reasoning

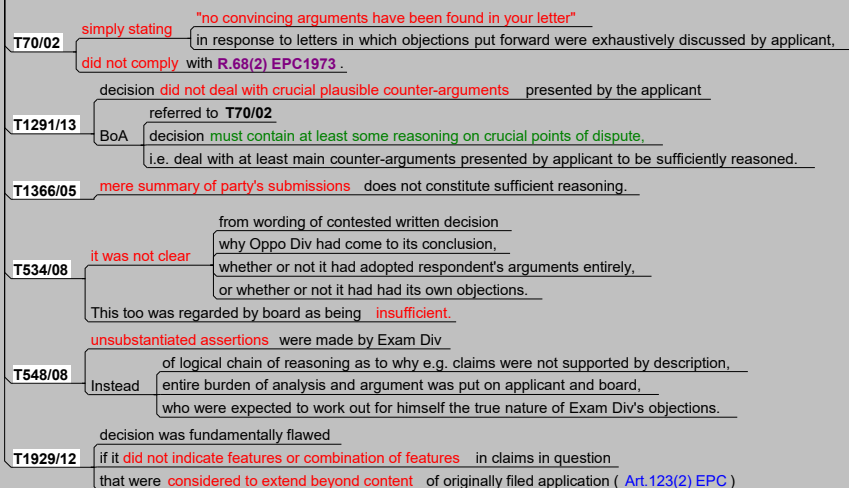


Deficient reasons

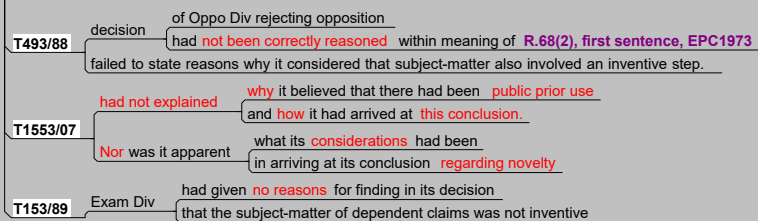
a) Deficient reasons sufficient for purposes of R.111(2) EPC



b) Deficient reasoning insufficient for purposes of R.111(2) EPC



c) No reasons for decision



Part 7 Chapter I: Common provisions governing procedure

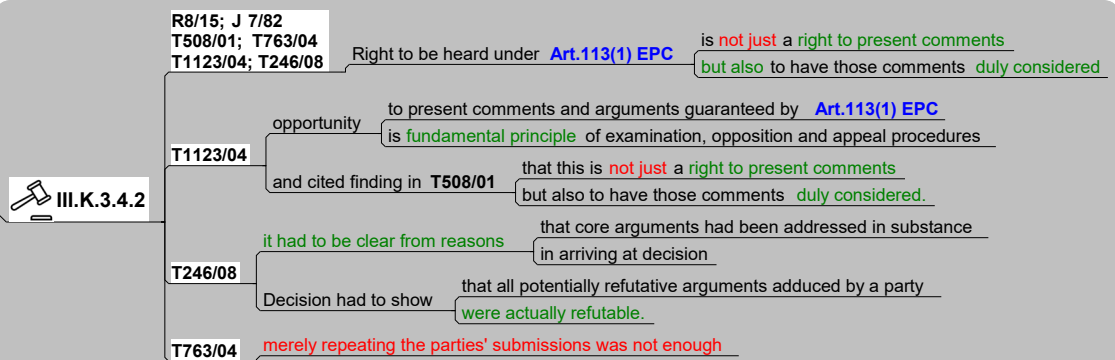
Art.113

Basic principles of decisions

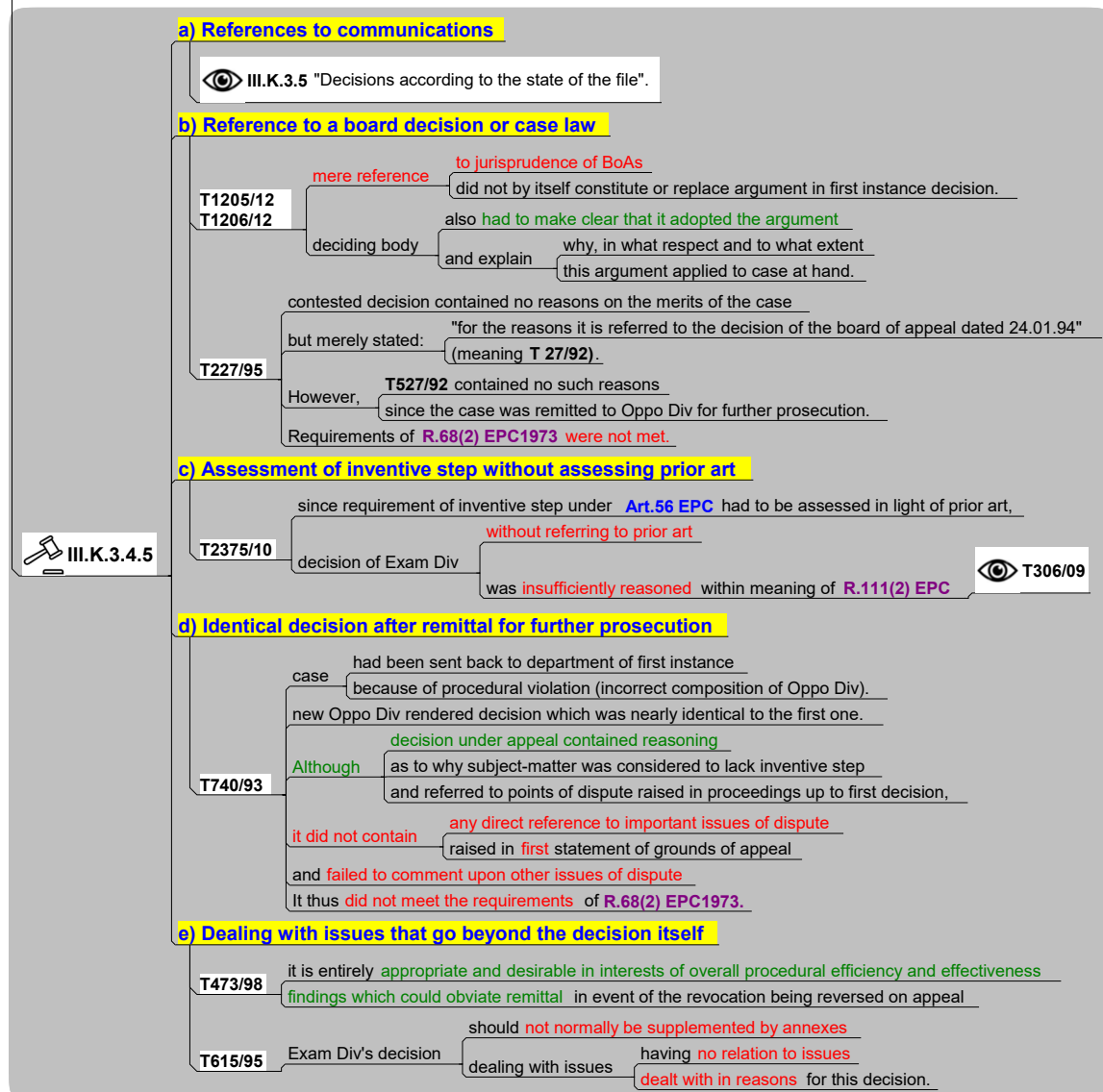
Content

Reasons for the decision

Right to be heard – right to have submissions taken into consideration



Special cases



Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Basic principles of decisions

Decisions according to the state of the file



E.X.2.5

Applicants may request decision

"on the file as it stands" or "according to the state of the file",

e.g. when all arguments have been sufficiently put forward in proceedings
and applicant is interested in speedy appealable decision

Request for decision "according to the state of the file"



III.K.3.5.1

Applicants may request a decision "according to the state of the file" or based "on the file as it stands"
during examination proceedings, e.g. when their arguments have already been sufficiently put forward
and they are interested in a speedy appealable decision.

=> decision can be issued by way of a standard form (EPO Form 2061) simply referring to a previous communication

standard form may be used to issue decision (EPO Form 2061)

T1093/13
T2364/09

only if all arguments put forward have already been sufficiently addressed
in one or more previous communications
and no new objections have been raised since those communications were transmitted

No absolute right to decision issued by way of EPO Form 2061



III.K.3.5.2

T62/13 decision to refuse based on file as it stands
could be issued either by EPO Form 2061 referring to earlier communication
or alternatively by way of a fully reasoned decision.

T1360/05 Exam Div is not obliged to restrict itself to decision by reference using standard form
when necessary reasons in relation to latest filed claims
have not been formulated in any document on file.

No waiver of right to reasoned decision



III.K.3.5.3

T265/03, T1182/05
T1356/05, T1360/05
T1309/05, T750/06 A request for decision on state of file cannot be construed
as waiver of right to a fully reasoned first instance decision

T952/07 made it clear that duty to provide reasons in administrative decisions
was a fundamental principle in all contracting states
R.68(2) EPC1973 simply being an expression of this principle.

The losing party must be in a position to understand the reasons for the negative decision taken against it
so that it can consider the option of filing an appeal.

Art.113

Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Basic principles of decisions

Decisions according to the state of the file

Reasons for decision by way of EPO Form 2061

a) Requirements

T278/00, T861/02, T897/03
 T276/04, T1182/05, T1309/05
 T1356/05, T1360/05, T1709/06
 T952/07, T1612/07, T1442/09
 T177/15, T180/10

a standard decision based "on the state of the file"
 which refers to one or several communications
 only meets the "reasoned" requirement of **R.68(2) EPC1973 (R.111(2) EPC)**
 if BoA is not left to reconstruct the applicable reasons
 by piecing together various arguments from the file
 and if it leaves no doubt as to which claim version the arguments relate to.

T963/02 decision issued by way of EPO Form 2061 and referring to one or more earlier communications
 only met criteria for a reasoned decision if cited communication itself met those criteria
 i.e. reasons for decision were clear

T353/11 decision under appeal referred solely to communication annexed to summons to attend oral proceedings
 communication did no more than to identify closest prior art and distinguishing feature of invention
 indicate that it was "not clear"
 whether examples of application illustrated distinguishing feature
 state it would be examined whether or not process was inventive,
 and invite appellant to file comparative example.

It neither gave explicit conclusion with respect to inventive step,
 nor any reasons as to why claimed process was not inventive.

Thus, Exam Div did not issue a reasoned decision within the meaning of **R.111(2) EPC**.

T177/15, T652/97
 T278/00

III.K.3.5.4

b) Reference to more than one communication

T897/03 decision that leaves it to appeal board and appellant
 to speculate as to which of reasons given by Exam Divin different communications
 might have been decisive for refusal of application
 could not be considered to meet requirements of **R.68(2) EPC1973**

T180/10 two communications had been referred to.
 However, contrary to what was stated in second communication
 ("the applicant's explanations ... have been carefully considered")
 it was apparent that Exam Div had ignored all appellant's arguments since this communication
 and, therefore, the decision were silent on them.
 The requirements of **R.68(2) EPC1973** were not fulfilled.

T1946/17 blanket statement like "arguments were carefully considered" but "no new evidence" was provided,
 in communications to which decision refers cannot be considered to address arguments raised
 and thus constitutes insufficient reasoning.

Documents included in the "state of the file"

The "state of the file" is not restricted to those documents on file which were issued by the EPO,
 but also includes all those documents and arguments
 which were filed by the applicant prior to (or even simultaneously with) his request
 for a decision "on the status of the file" (T 265/03, T 1360/05).

It does not include the note of a telephone conversation

This was the summary record of a conversation.

Whereas phone call note is a record of a dialogue,

T583/04 a communication under **Art.96(2) EPC1973** constitutes a unilateral legal notice to a party.

This does not exclude possibility of the statements made orally by phone
 in a formal communication from Exam Div

being confirmed and adopted in a formal communication from Exam Div
 inviting observations with a term set for reply.

T750/06

T1356/05 minutes of oral proceedings are most probably not meant to be included in the term "previous communications"
 and it is thus not appropriate to refer to them in the standard decision.

III.K.3.5.5

Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

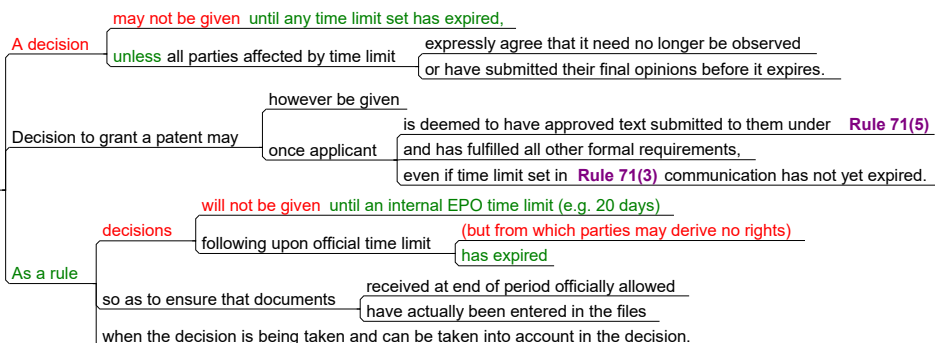
Basic principles of decisions

Timing

Consideration of time limits



E.X.1.2



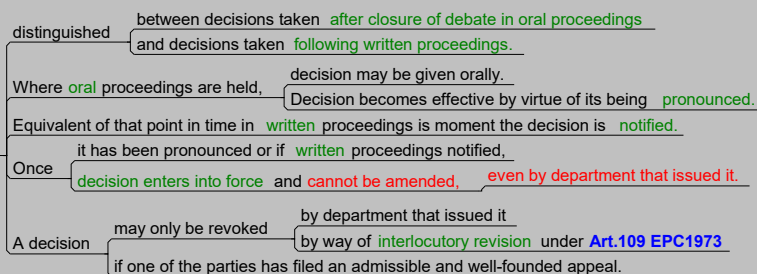
Date of decision

Entry into force of decisions



III.K.2.1

G12/91

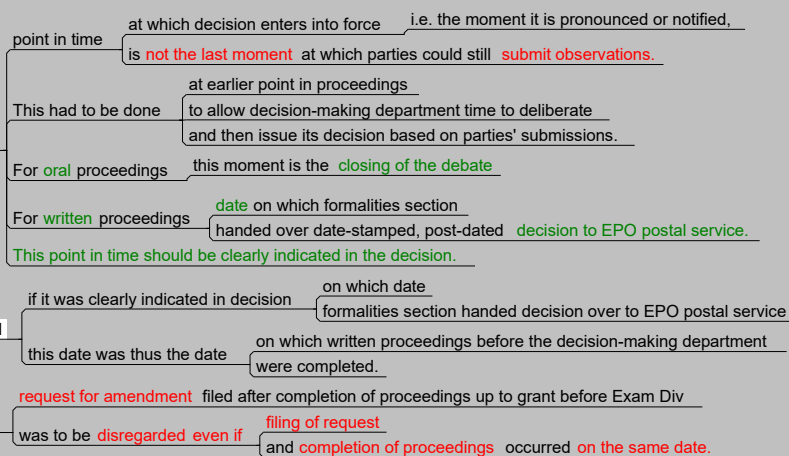


Completion of internal decision-making process



III.K.2.2

G12/91

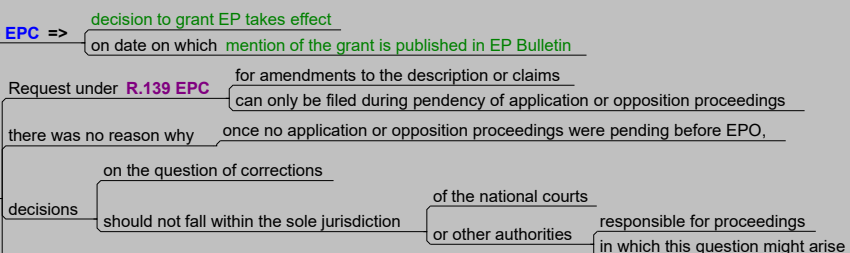


Date EP takes effect and jurisdiction after pendency



III.K.2.3

J42/92



T777/97

Part 7 Chapter I: Common provisions governing procedure

Art.113

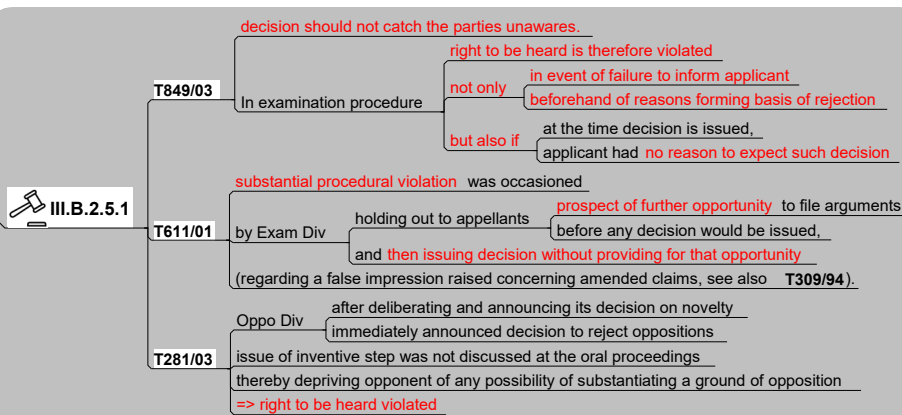


Basic principles of decisions
Right to be heard
Loss of rights
Signature

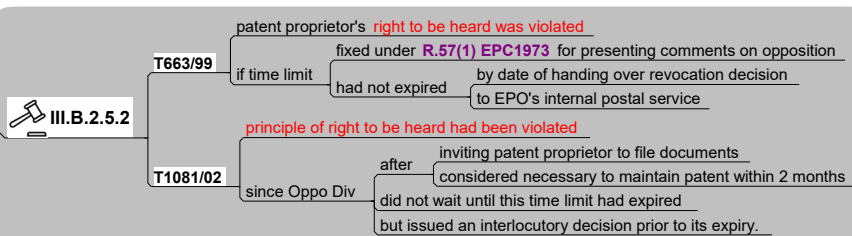
Basic principles of decisions

Right to be heard and timing of decisions

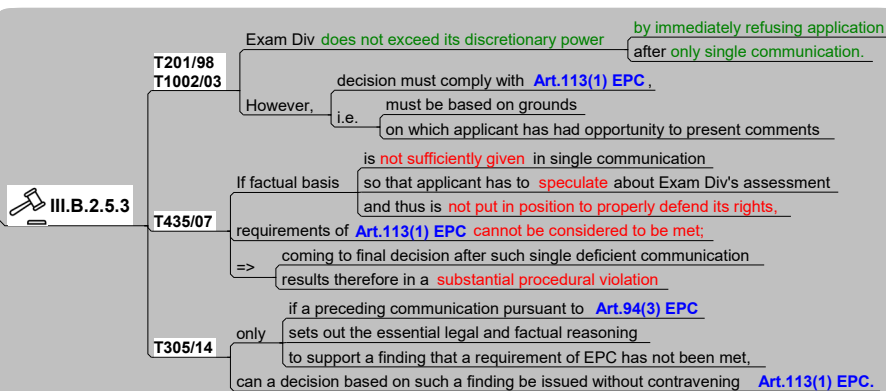
Decision could not be expected



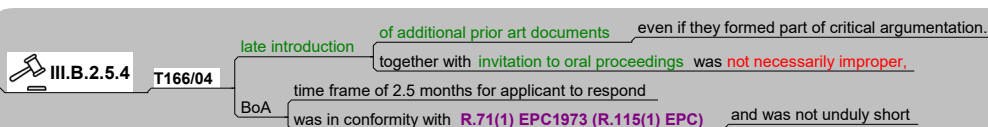
Issuing of decision before expiry of time limit to comment



Immediate refusal after communication



Invitation to oral proceedings at short notice



Notification



E.X.6 Decisions must be notified as a matter of course Art.119 EPC



III.K.5

Under R.111(1) EPC decision delivered during oral proceedings must be put in writing and notified to the parties.
The date of notification is relevant with regard to filing of appeal (Art.108 EPC and R.111 EPC).
The legal fiction of deemed notification set out in R.126(2) EPC applies whereby letter is deemed to be delivered on tenth day following its handover to the postal service provider.

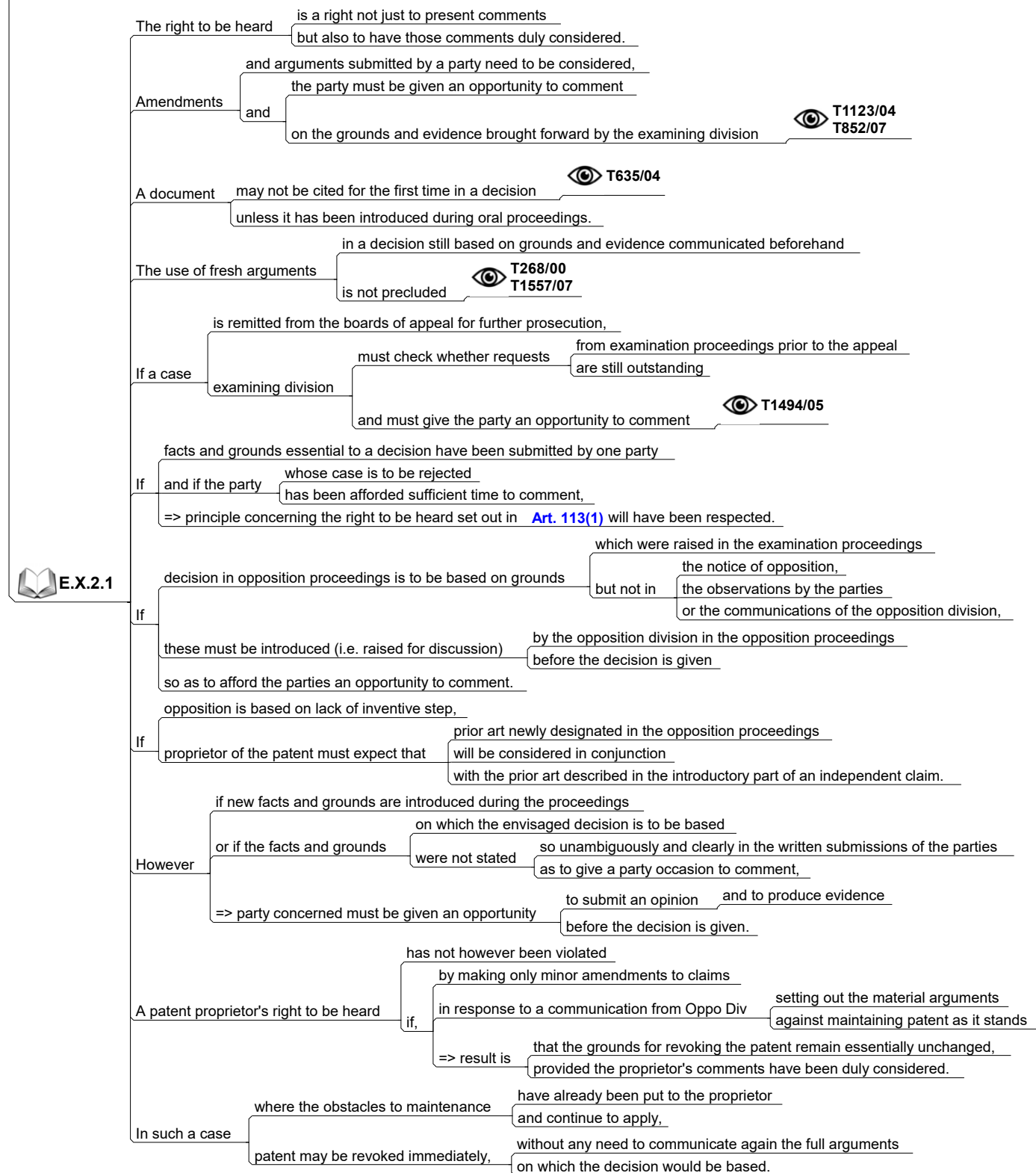
Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard



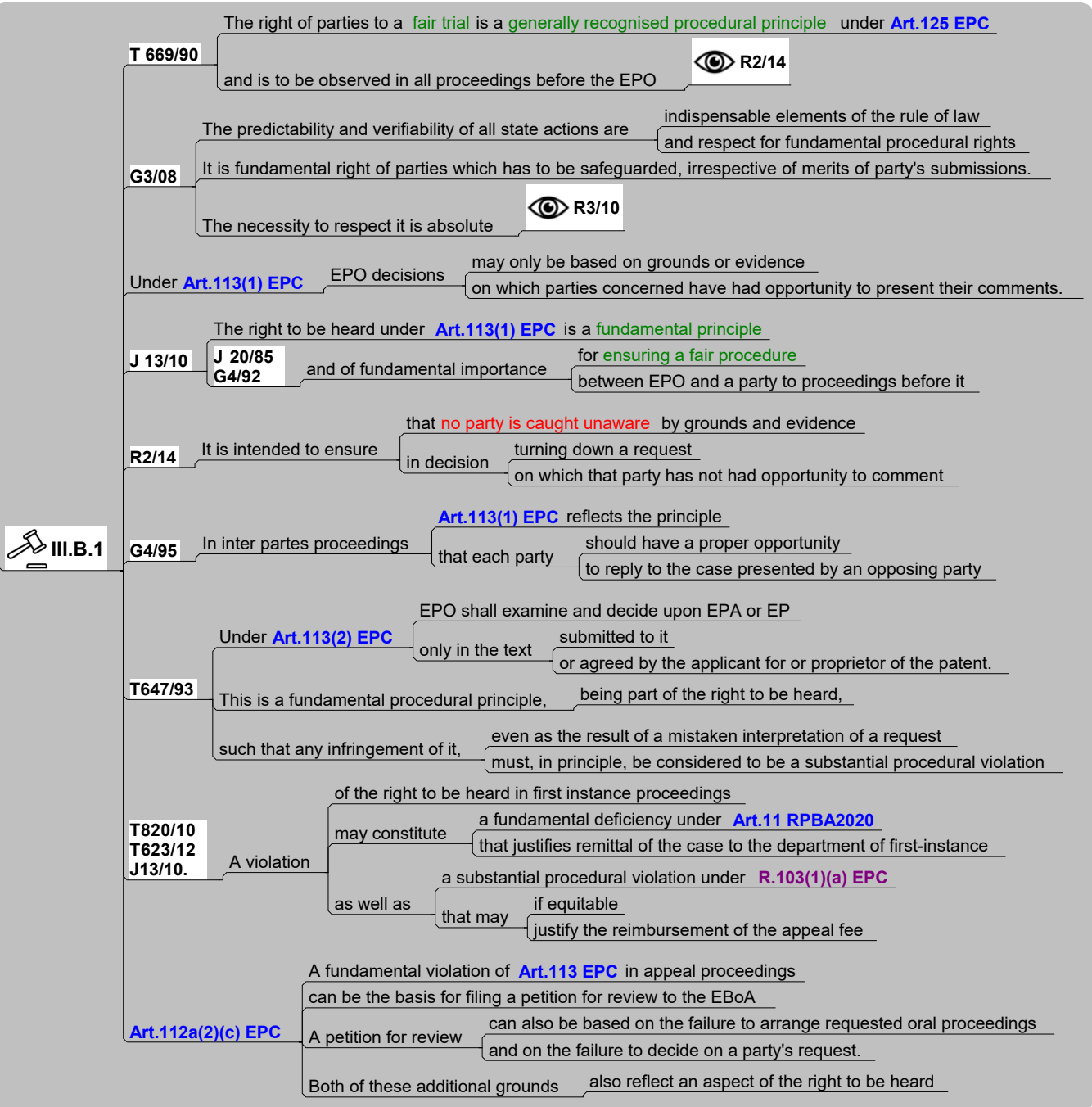
Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard

Introduction



Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard

Violation of right to be heard examined ex officio



III.B.2.1

T186/02

BoAs can

examine facts of case of their own motion pursuant to Art.114(1) EPC
and verify whether or not Art.113 EPC has been complied with by first instance department

Causal link between violation of right to be heard and final decision

Appeal proceedings



III.B.2.2.1

When reviewing appeal proceedings

EBoA's review is limited to "fundamental" violations of right to be heard.

This requires causal link between alleged violation and final decision.

Such causal link does not exist when

even if procedural violation can be demonstrated,
same decision would have been taken for other reasons

First instance proceedings



III.B.2.2.2

When reviewing first instance proceedings

boards' review is not limited
to fundamental violations of right to be heard

However

remitting case to department of first-instance under Art.11 RPBA

also requires a "fundamental" deficiency in first instance proceedings,

and under R.103(1)(a) EPC

appeal fee is only reimbursed
in case of a "substantial" procedural violation.

linked these concepts

T689/05

stating that "fundamental" deficiency

within meaning of Art.11 RPBA
is not caused by all procedural violations
but rather only by "substantial" procedural violation.

substantial procedural violation was defined

J7/83

as objective deficiency affecting entire proceedings

T682/91

as deficiency adversely affecting rights of parties

T990/91

since there had been no need for Exam Div

to put forward new argument

which was supererogatory and incidental
in order to refuse the application,

lack of opportunity to reply to it could not be considered to be a violation of right to be heard.

Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard

Grounds, Facts & Submissions

Facts and submissions



E.X.2.4

- Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted.
- It must be ensured that the facts and submissions are consistent with the contents of the minutes of oral proceedings
- Facts and submissions must clearly indicate what is subject of application and show on which documents the decision is based.
- In examination this requirement is achieved by including a detailed reference to the application documents which are subject to decision, including any amendments to claims or to description as well as maintained auxiliary requests.
- In addition, Exam Div may cite text of any important claim(s) or passages of description in decision.
- In opposition, the text of independent claim(s) and other especially important claims or passages of description on which decision is based must be cited verbatim in language of proceedings (R.3(2)) either by copying text into the decision or annexing a copy of claims.
- As regards the dependent claims, it may be sufficient to refer to the file content.

Main and auxiliary requests



E.X.2.9

- during examination proceedings main and auxiliary requests have been filed and none of these is allowable.
- If reasons for decision to refuse application pursuant to Art.97(2) must not be limited to main request, but must also comprise reasons for non-allowability of each auxiliary request.
- If one of requests is allowable, communication pursuant to R.71(3) is to be issued on basis of (first) allowable request and must be accompanied by brief indication of essential reasons why higher-ranking requests are not allowable or not admissible
- If applicant in response to communication pursuant to R.71(3), maintains higher-ranking requests which are not allowable or not admissible decision to refuse application pursuant to Art.97(2) will normally be issued reasons must set out grounds for non-allowability or non-admissibility of each request which ranks higher than allowable request.
- In respect of allowable request, decision to refuse must mention that applicant has failed to give his approval to it.
- Similarly if in opposition proceedings proprietor has submitted in addition to his main request one or more auxiliary requests, none of which is allowable, patent must be revoked and decision must set out in respect of each request submitted and maintained by proprietor, reasons for not allowing it.
- Where one of proprietor's requests directed to maintenance of patent in amended form is allowable, an interlocutory decision is to be issued on basis of (first) allowable request; it has to set out reasons why this request meets requirements of EPC and, additionally, reasons why higher-ranking requests do not.
- Insofar as decision includes rejection of any of multiple requests such decision may not be taken until applicant or proprietor has been informed with respect to each of these requests of reasons for not allowing them, so that the applicant or proprietor is not deprived of opportunity to present comments (Art.113(1) - right to be heard).
- Similarly, opportunity to comment must be granted to opponent(s) with respect to auxiliary request before it is held allowable by an interlocutory decision
- Practical considerations will determine at which point in the decision the auxiliary request is dealt with.

Late-filed submissions



E.X.2.10

- If Exam or Oppo Div has exercised its discretion under Art.114(2) or R.116 to refuse late-filed facts, evidence or requests, its decision must give the reasons for its refusal.
- T755/96 A mere reference to discretionary power given under Art.114(2) or R.116 is not sufficient

Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions

Right to be heard

Loss of rights

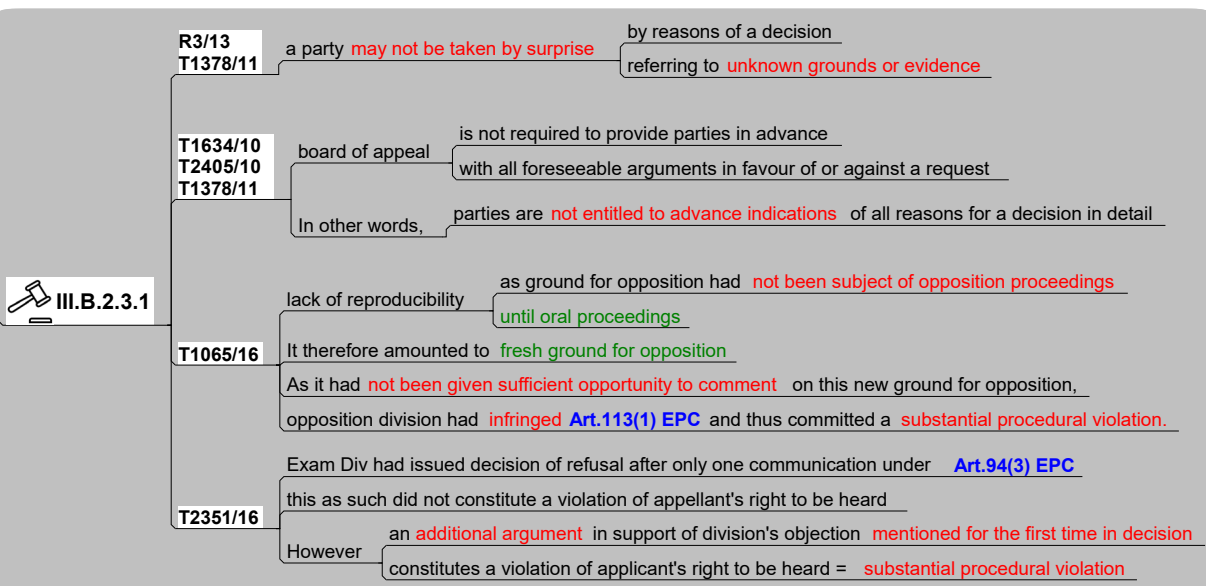
Signature

Right to be heard

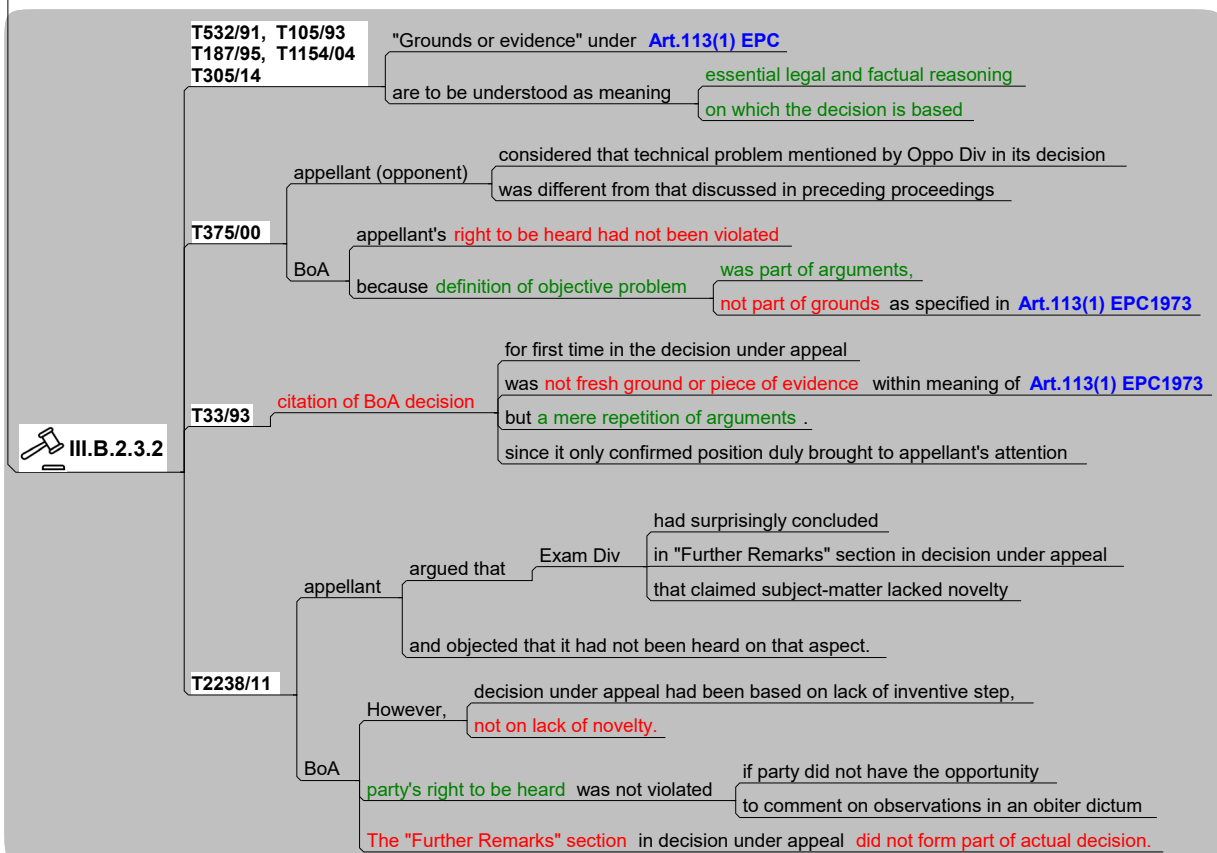
Grounds, Facts & Submissions

Surprising grounds or evidence

General principles



Meaning of "grounds or evidence"



Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Right to be heard

Surprising grounds or evidence

Opportunity to comment on evidence



III.B.2.3.3

J20/85

pointed out

that a decision on an issue of fact could only properly be made by EPO

after all the evidence

on which such decision was to be based had been identified
 and communicated to the party concerned

Exam Div

based its conclusions concerning critical issues

at least in part on two Wikipedia entries cited in the decision.

T1401/16

However

this evidence was never referred to during examination proceedings

and both entries were mentioned for very first time in appealed decision itself

=> applicant had no opportunity to present its comments in that respect

This constituted violation of provisions of Art.113(1) EPC.

Documents supplied by applicants but used against them



III.B.2.3.4

T18/81
T188/95

Right to be heard has not been observed

if decision to refuse application

is based essentially on documents

which though supplied by applicant in support of his case
are used against him to produce an effect

on which he has not had an opportunity to make observations

Document cited containing information already known



III.B.2.3.5

T643/96

Exam Div relied in its decision on document for which it gave only incomplete bibliographic data.

Exam Div's failure

to provide applicant with copy of document

did not amount to substantial procedural violation regarding right to be heard

because

document added nothing to case

and contained only information already known to applicant.

Reliance on the International Preliminary Examination Report (IPER)



III.B.2.3.6

T587/02

if only communication preceding decision to refuse application merely draws attention to an IPER,

requirements of Art.113(1) EPC are met provided

IPER

constitutes reasoned statement

as required by R.51(3) EPC 1973

using language corresponding to that of EPC

Change of provisional opinion



III.B.2.3.7

T68/94

appellant submitted

that Oppo Div had violated Art.113 EPC1973

by changing its provisional opinion after oral proceedings

without

giving appellants opportunity to comment on grounds

on which contested decision was based.

board

pointed out

that provisional opinions were never binding

purpose of oral proceedings was to summarise and discuss parties' arguments.

All arguments in case had been known to both parties.

T1824/15

members of Exam Div were free to change their minds at any point in procedure

including during oral proceedings as long as requirements of Art.113(1) EPC were fulfilled.

Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Right to be heard

Consideration of parties' arguments, submissions and evidence

Analysing parties' arguments



E.X.2.8

All significant arguments advanced by a losing party to proceedings are carefully examined and comprehensively refuted in the decision.
 The decision must substantiate division's view that none of submitted arguments overcome objections it has raised.
 However facts not in dispute need be mentioned only briefly.
 Arguments by parties which are clearly irrelevant to issues involved do not need to be discussed.

Refusal to admit amendments under R.137(3)



E.X.2.11

When in exercising its discretion under R.137(3) Exam Div refuses to admit amended claims it must give reasons for so doing.
 If no other requests are on file then there is no text agreed by the applicant and the application is to be refused under Art.113(2).

General principles



III.B.2.4.1

R5/15

it is not necessary to consider each and every argument of parties in detail in decision.
 boards may also refute arguments implicitly, and may disregard irrelevant arguments

Decision must demonstrably show that arguments were heard and considered



III.B.2.4.2

T206/10

The deciding department must demonstrably hear and consider the comments

T2352/13

Merely repeating parties' submissions is not enough;
 rather, it has to be clear from the reasons that substance of their core arguments has been addressed in arriving at decision

J7/82; T1039/00

T778/98, T1312/10

A decision which fails to take into account arguments submitted by a party and which is based on a ground on which party had had no opportunity to present its comments, contravenes Art.113(1) EPC and constitutes a substantial procedural violation

T1411/07

patent proprietor had challenged admissibility of opposition on ground of lack of substantiation but opposition division had found it admissible without stating any reasons.

opposition division's failure to make any reference to patent proprietor's submissions BoA a breach of R.68(2) EPC1973 (R.111(2) EPC) and a substantial procedural violation.

No obligation to address each and every argument



III.B.2.4.3

T1898/11

T1557/07

Provided that

reasons given enable parties concerned to understand whether decision was justified or not,
 deciding organ is under no obligation to address each and every argument presented by party concerned

Moreover

a party has no absolute right to be heard separately on each and every one of its auxiliary requests

Art.113

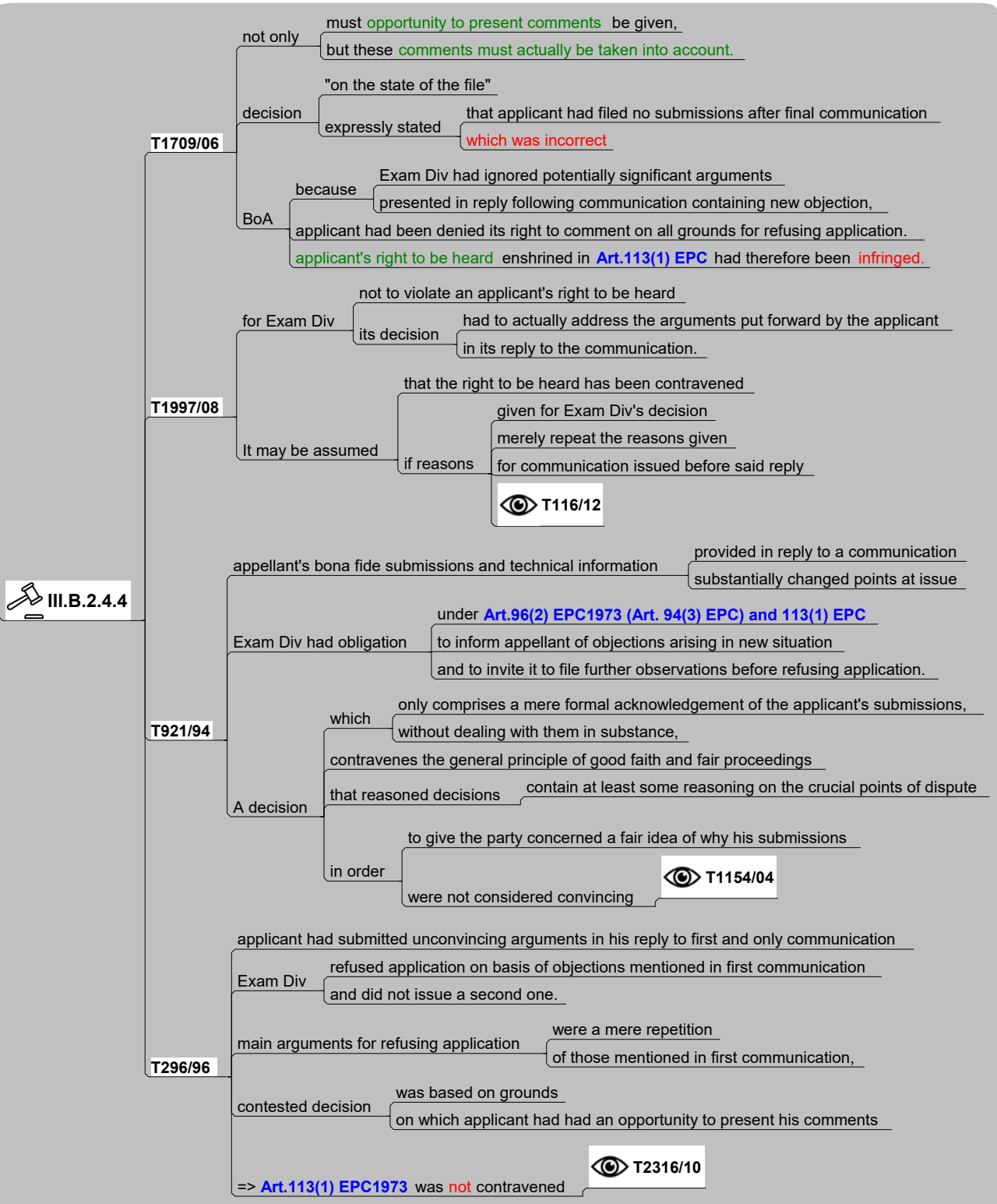
Right to be heard

Consideration of parties' arguments, submissions and evidence

Failure to consider submissions made after communication



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature



Part 7 Chapter I: Common provisions governing procedure

Art.113

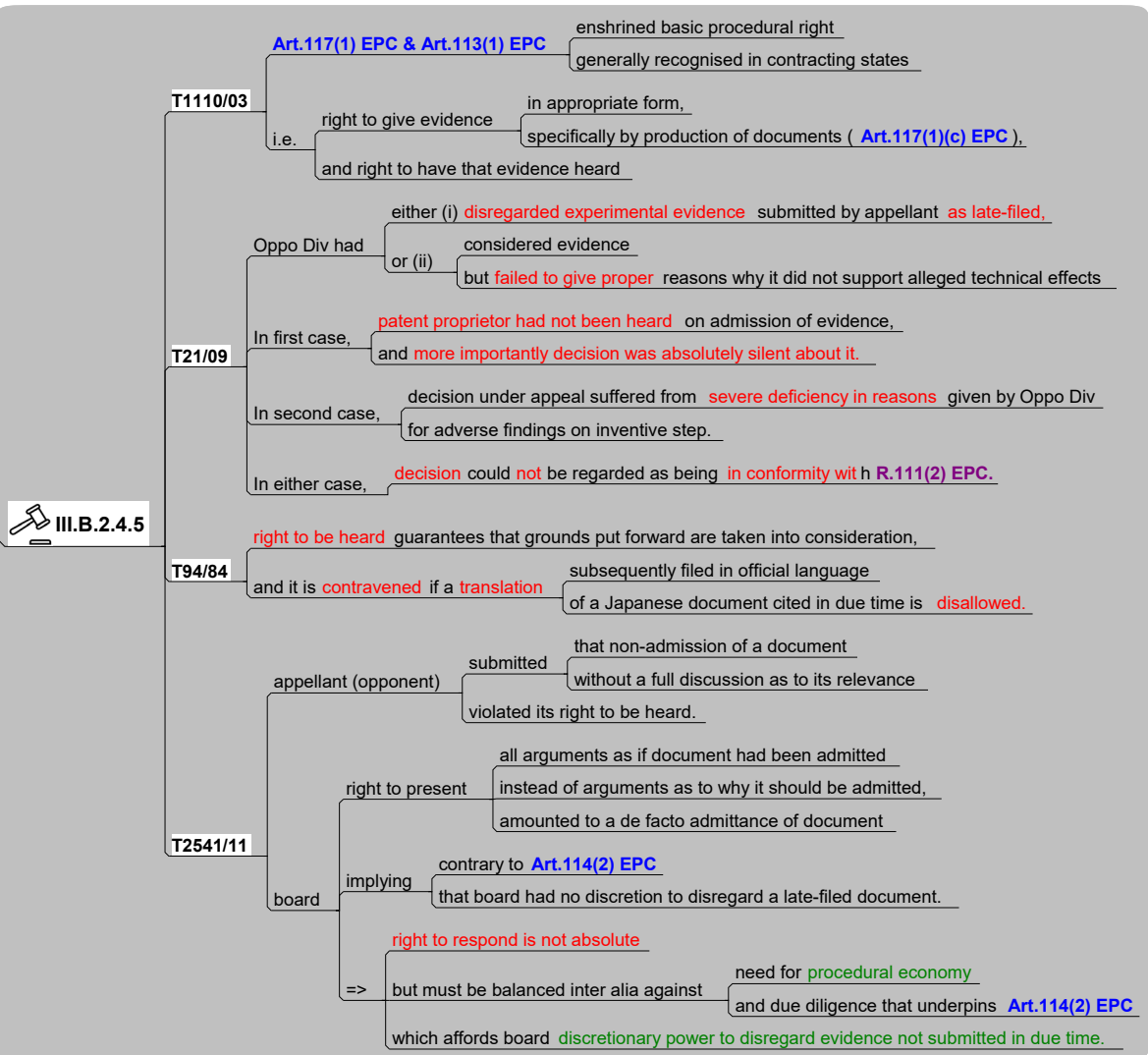
Right to be heard



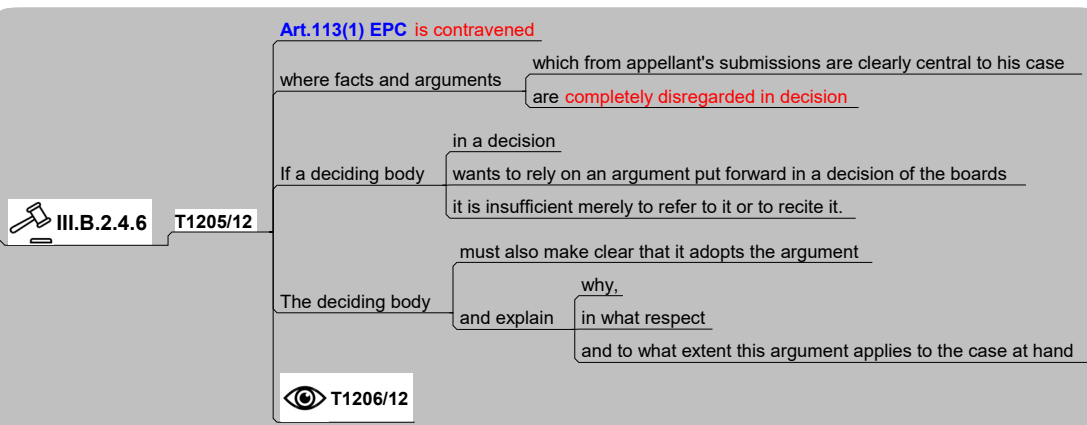
Basic principles of decisions
Right to be heard
Loss of rights
Signature

Consideration of parties' arguments, submissions and evidence

Failure to consider evidence



Mere reference to jurisprudence



Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Right to be heard in oral proceedings

T209/88
 T862/98
 T1050/09 right to oral proceedings regulated by [Art.116\(1\) EPC](#)
 forms substantial part of right to be heard granted by [Art.113\(1\) EPC](#)

T598/88
 T556/95
 T114/09 right to be heard in oral proceedings subsists so long as proceedings are pending before the EPO

Conducting oral proceedings effectively and efficiently although subject to discretionary power of chairman

T1027/13 must nevertheless guarantee that fundamental procedural rights of each party in adversarial proceedings
 i.e. right to fair and equal treatment,
 including right to comment in oral proceedings ([Art.113\(1\)&116 EPC](#))
are respected



III.B.2.6

T1055/05 no infringement of right to be heard where Exam Div refuses to minute party's submissions
during oral proceedings

statement such as "the next procedural step will be summons to oral proceedings
 during which the application will be refused"
 made prior to a final decision to refuse a patent application
may infringe a party's right to be heard
 and thus may lead to a substantial procedural violation.

T1414/18 "will be refused" on an objective basis
 Phrase Implied that, regardless of any facts or arguments
 applicant could potentially have brought forward thenceforth,
 application was finally to be refused under [Art.97\(2\) EPC](#).

Such a conduct of the proceedings was contrary to the very aim and purpose
 of the right to be heard under [Art.113\(1\) EPC](#).

Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard in oral proceedings

Introduction of new claim or relevant document

- The applicant does **not have a right in principle** to continuation in writing
party's right to be heard under **Art.113(1) EPC** is also observed
if applicant is **given adequate amount of time to study document and present comments.**
How much time is sufficient depends on nature of newly introduced document and preceding procedure
- a) Cases in which Art.113(1) EPC was violated in relation to the introduction of new claims or relevant documents**
- T2434/09**
although document D4 had been mentioned in ESR
it had not been cited at any stage in examination procedure prior to oral proceedings
had been too short a period
for an adequate analysis of **complex text of D4.**
half an hour adjournment of oral proceedings
As D4 was essential to finding of Exam Div in relation to inventive step,
on which applicants had **not had sufficient opportunity to present their comments**
decision was based on evidence
as required by **Art.113(1) EPC1973**  **T492/03**
- T951/97**
Oppo Div had proposed a new version of the main claim at the start of the oral proceedings
giving opponents 10 minutes to consider it.
BoA ruled that this had taken opponents by surprise
and that time given had **not been sufficient to study allowability of amendments.**
- T783/89**
Exam Div had introduced **2 days before oral proceedings**
2 additional documents and new objection into procedure
Appellant request for a postponement of the oral proceedings was rejected
did not attend oral proceedings
- T2235/12**
BoA new objection was not related to points indicated in summons
appellant should have been given adequate opportunity to react to new objection
would not have changed fact that **timeframe was too short**
Attending oral proceedings for representative to get instructions from client
and to prepare for oral proceedings with new focus.
rejecting appellant's request for postponement of oral proceedings **infringed appellant's right to be heard.**
- T482/16**
by rejecting the appellant's request for postponement of the oral proceedings
Exam Div had not provided appellant with the appropriate opportunity to present its comments
on **documents** Exam Div had introduced for the **first time during the oral proceedings**
- b) Cases in which Art.113(1) EPC was not violated even though new claims or relevant documents were introduced**
- T484/89**
Oppo Div empowered under **Art.114(1) EPC1973**
to take account of and refer to all relevant documents cited
Oppo Div had considered it necessary to refer to a document during oral proceedings.
In such cases parties should **at their request**
be granted an adjournment or else **new oral proceedings** should be appointed.
Since no such request was made according to decision and record of oral proceedings,
Art.113(1) EPC1973 had **not** been breached.
- T376/98**
Exam Div had referred to document D4 for first time during oral proceedings
and had stayed oral proceedings to give applicant time for consideration
When oral proceedings were resumed, appellant requested decision based on documents on file.
BoA appellant's request for decision **could only be taken to mean** that appellant was **not interested**
in further debate about relevance of D4.
- c) Cases where no new claims or relevant documents were introduced**
- T195/84**
appellant (patentee) objected at oral proceedings that new grounds on inventive step were presented
to which he had not had an opportunity to reply.
BoA did not share this opinion as **appellant had been aware that such prior art existed,**
and had **thus had sufficient time to consider it in full.**
Furthermore he had **not requested any additional time** and had **not asked for an adjournment.**
- T327/92**
Oppo Div at oral proceedings had relied on a document as closest prior art against an amended main claim,
which had been cited in opposition against a dependent claim only.
BoA did **not** consider this substantial procedural violation,
as patentee was dealing with **document which had always been part of the opposition,**
and **could further examine this document at oral proceedings.**



III.B.2.6.1

Part 7 Chapter I: Common provisions governing procedure

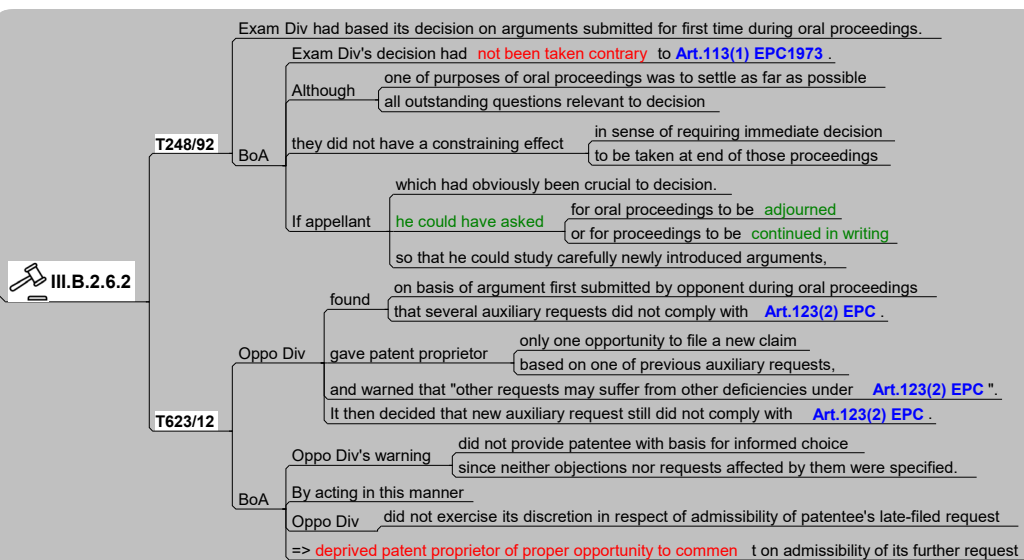
Art.113



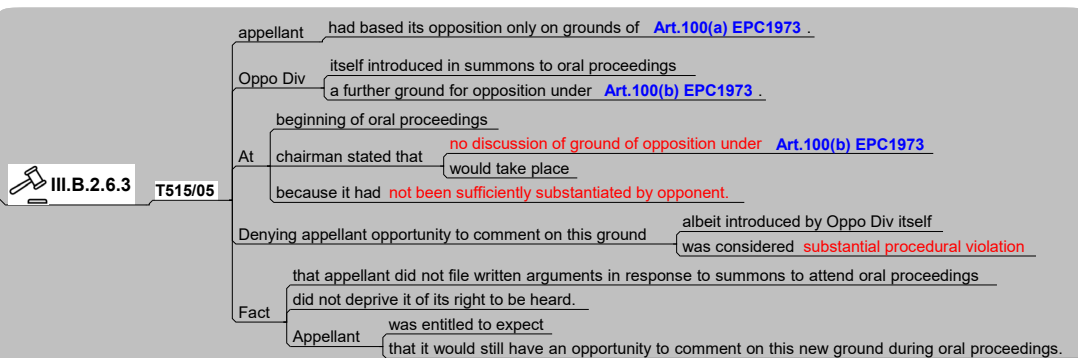
Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard in oral proceedings

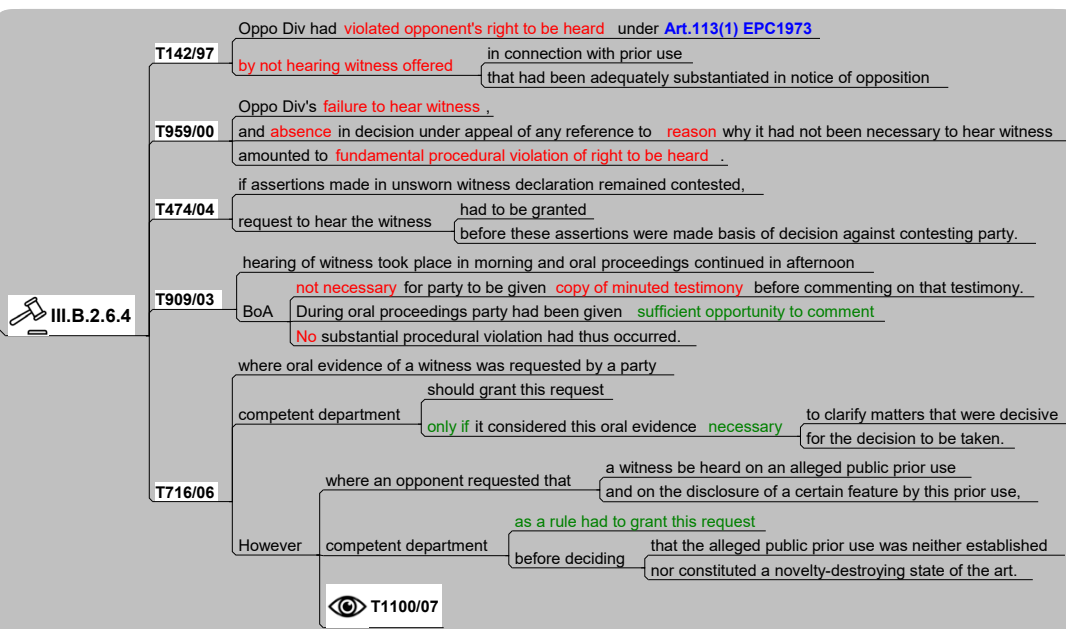
Introduction of new arguments



Introduction of new ground of opposition by opposition division



Hearing witnesses



Part 7 Chapter I: Common provisions governing procedure

Art.113

Basic principles of decisions
Right to be heard
Loss of rights
Signature

Right to be heard in case of non-attendance of oral proceedings

III.B.2.7 R.115(2) EPC R.71(2) EPC1973 proceedings may continue without duly summoned but non-attending party
however case law of boards demonstrates, non-attending party's right to be heard under Art.113 EPC must not be ignored

Facts and evidence put forward for first time during oral proceedings

III.B.2.7.1 G4/92 explicitly relates to inter partes proceedings only
decision against party who had been duly summoned but who failed to appear at oral proceedings
could not be based on facts put forward for first time during those oral proceedings.
in view of right to present comments
New arguments on the other hand did not constitute new grounds or evidence
but were reasons based on facts and evidence already put forward.
requirements of Art.113(1) EPC could thus be satisfied
T 2138/14 (ex parte) established case law that a non-attending party's right to be heard under Art.113(1) EPC must not be ignored

Non-attendance at oral proceedings before boards – case law on G4/92

III.B.2.7.2 T341/92 it was possible to base a decision on a ground discussed for the first time during oral proceedings,
at least if the stage reached in the case was such
that absent albeit duly summoned patent proprietors could have expected the question to be discussed and were aware of actual basis on which it would be judged.
BoA did not consider itself prevented by reasons of procedural law from rendering a decision on the basis of Art.123(3) EPC, on an issue brought up by the board for the first time at the oral proceedings.
argued that the situation differed from G4/92 in that the extension of the protection conferred, arose solely from a comparison of the wordings of the claims to which objection had been made and therefore not from facts that had only been introduced during oral proceedings.
T802/12 dismissed appeal on basis of Art.123(3) EPC, which had been discussed for first time at oral proceedings
appellant could have expected amendments it had made to be examined at oral proceedings as to their conformity with requirements of the EPC
A party duly summoned to oral proceedings
could not rely on proceedings being continued in writing or case being remitted to department of first instance simply because he had not attended the oral proceedings (Art.15(3) and (6) RPBA)
refusal of EPA was based on the common general knowledge as illustrated by document D3.
That stance was first taken in oral proceedings before Exam Div, which appellant did not attend.
G4/92 => arguments could be presented at any time even during oral proceedings in absence of a party
but the same did not apply to new facts forming basis for decision.
T1448/09 A reference to common general knowledge could be presented as argument, but existence of that knowledge was matter of fact.
If its alleged existence was disputed, facts relevant in that regard had to be established.
That meant that the party against which this knowledge was cited had to have the opportunity to dispute or accept it.
In the case in hand, appellant had neither been aware of Exam Div's invocation of common general knowledge until decision was announced, nor of the existence of document D3 and by extension on existence of invoked common general knowledge. This violated appellant's right to be heard on relevance of document D3
T1049/93 duly summoned respondent (opponent) chooses not to attend oral proceedings
can still consider prior art which might be an obstacle to the maintenance of the patent in suit.
BoA The opportunity to be heard is offered by summoning the parties to a hearing before the board.
=> right to be heard is exhausted to the extent that it concerns facts and arguments in support of his position.
G4/92 should not be construed as extending or prolonging the rights of a voluntarily absent party
T414/94 no general prohibition on amending requests during a party's absence from oral proceedings.
Absent party (opponent) must expect reactions of the opposing party (patentee) within the legal and factual framework of the case established prior to oral proceedings, and the possibility of decisions taking account of, and being based on, such reactions.

Art.113



Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Right to be heard in case of non-attendance of oral proceedings

Non-attendance at oral proceedings before boards – Art.15(3) RPBA2020



III.B.2.7.3

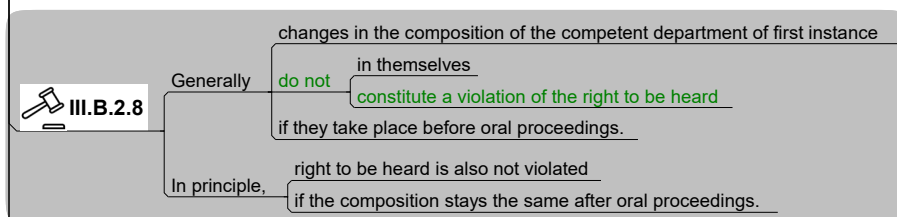
Part 7 Chapter I: Common provisions governing procedure

Art.113

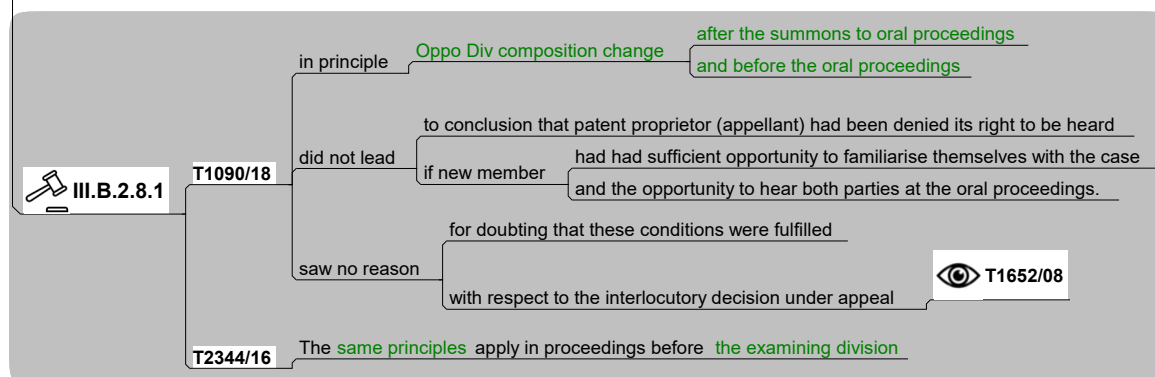


Basic principles of decisions
Right to be heard
Loss of rights
Signature

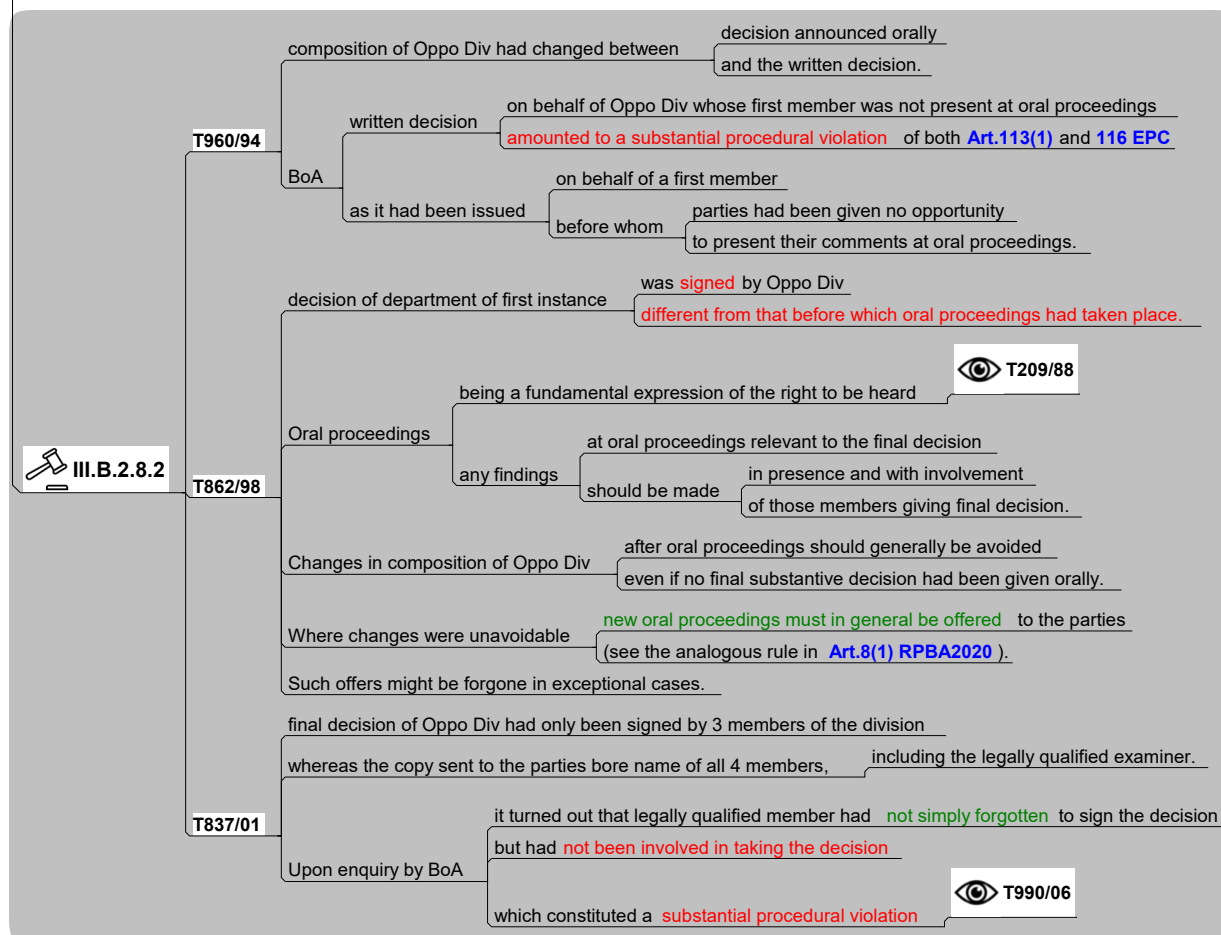
Changes in the composition of the competent department of first instance



Composition change BEFORE oral proceedings



Composition change DURING oral proceedings



Art.113

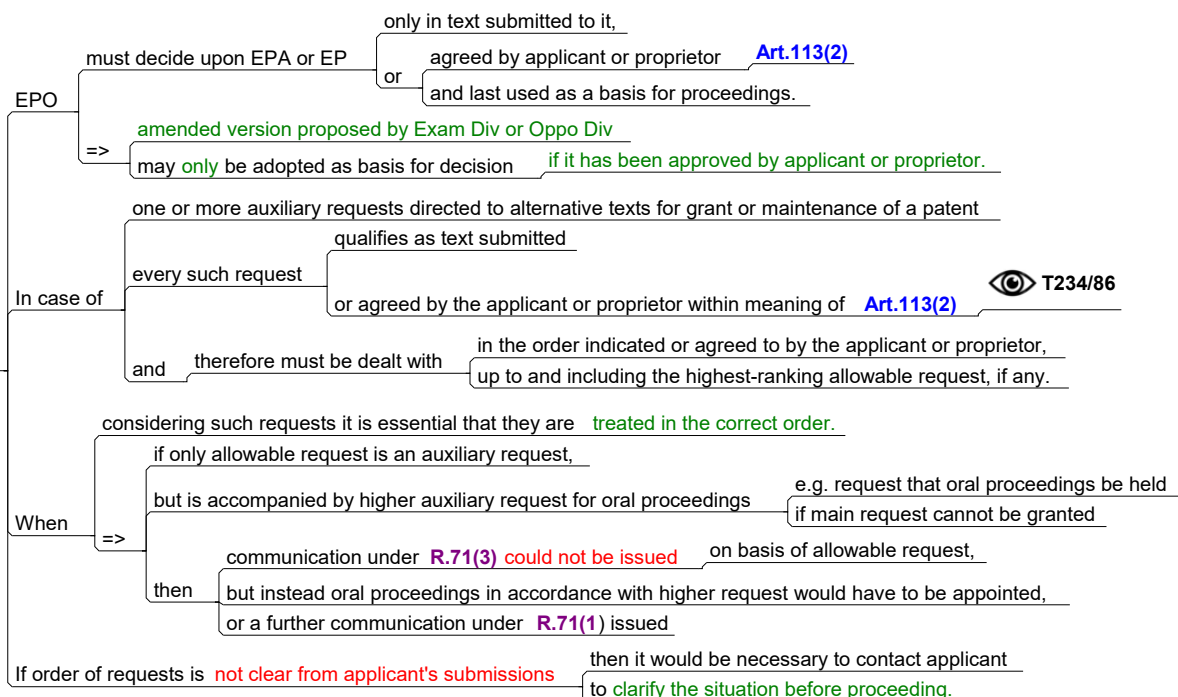


Basic principles of decisions
 Right to be heard
 Loss of rights
 Signature

Authoritative text



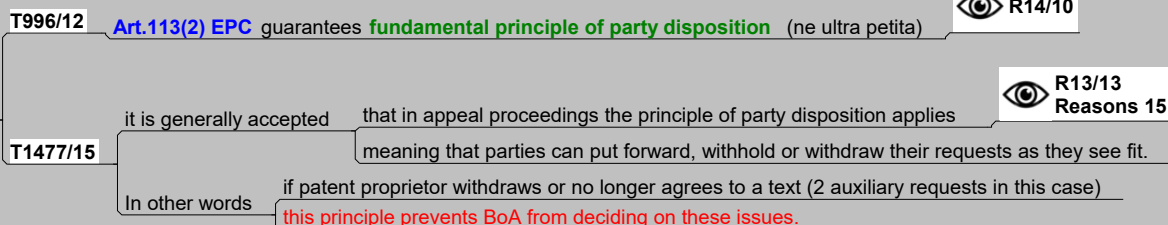
E.X.2.2



General



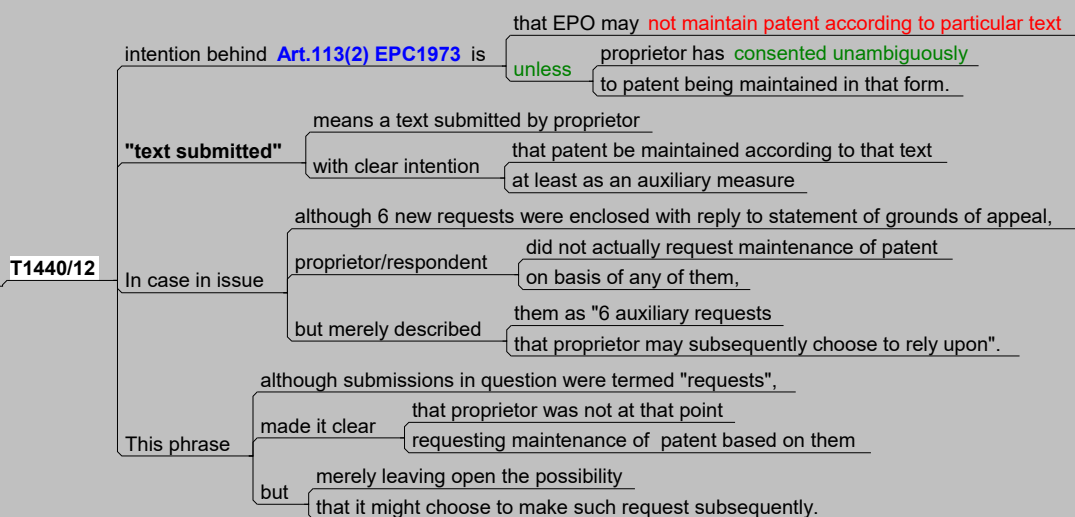
III.B.3.1



Requirement of text submitted by applicant



III.B.3.2



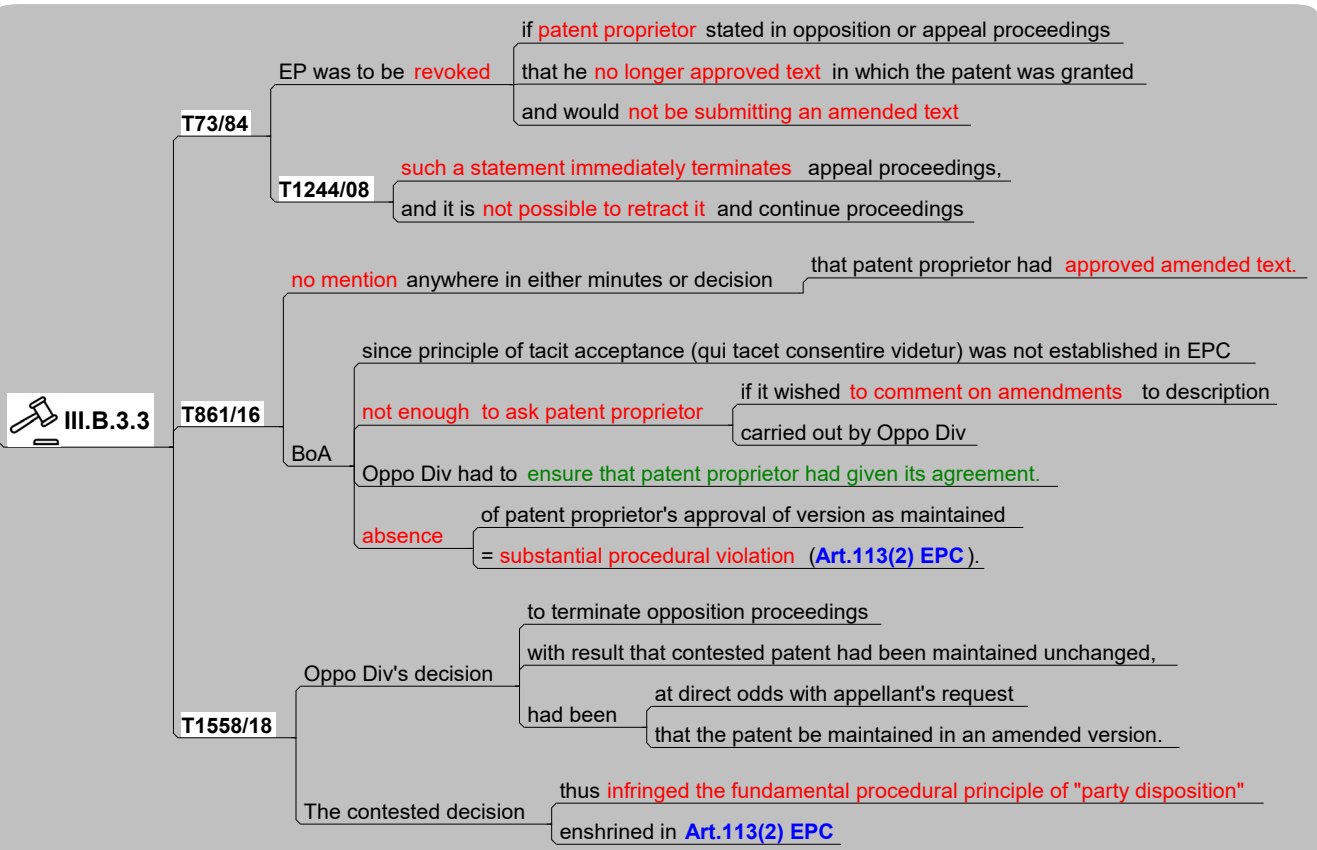
Art.113



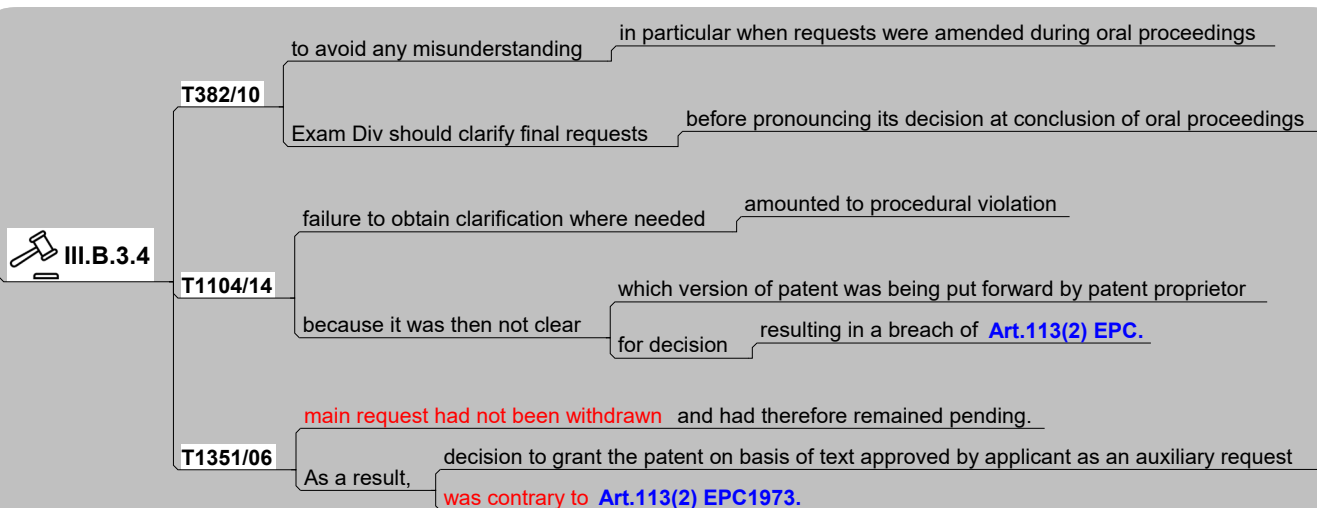
Basic principles of decisions
Right to be heard
Loss of rights
Signature

Authoritative text

Requirement of text agreed by applicant



Cases where EPO is uncertain or mistaken about approval of text



Part 7 Chapter I: Common provisions governing procedure

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

R.112 Noting of loss of rights

R.112 <=> R.69 EPC1973



- (1) If the EPO notes that a **loss of rights has occurred**, **without any decision concerning** the refusal of the EPA or the grant, revocation or maintenance of the EP, or the taking of evidence, **it shall communicate this** to the party concerned.
- (2) If the party concerned considers that the **finding of the EPO is inaccurate**, **it may**, **within 2 months** of the communication under **paragraph 1**, **apply for a decision** on the matter.
- The EPO shall take such decision **only if it does not share the opinion** of the **party requesting it**; **otherwise**, it shall inform that party.



R.112(2)EPC

within 2 months of communication R.112(1)



No



Ask for decision under R.112(2)



Loss of rights

Art.121 EPC



R.135(2) EPC

Art.122 EPC



R.136(1) EPC

Loss of rights

Cases of loss of rights



E.VIII.1.9.1

If

- a party to proceedings or a third party **fails to comply with a time limit** laid down in EPC or fixed by the EPO
- this will result in a loss of rights in certain cases specified in the EPC, **without any decision** concerning refusal of EPA or grant, revocation or maintenance of EP, or the taking of evidence.

Noting and communication of loss of rights



E.VIII.1.9.2

If there has been loss of right

- a formalities officer will note such loss of rights and communicate this to person concerned. **Art. 119 Rule 112(1)**
- The communication will be notified to person concerned as a matter of course

Purpose of notification of loss of rights under R.112(1) EPC



III.K.4.1

J7/92

- purpose of notification under **R.69(1) EPC1973** is **not to give applicant** a chance to take at least remedial action by way of request for re-establishment of rights.

Form of notification of loss of rights under R.112(1) EPC



III.K.4.2

J43/92

- R.69(1) EPC1973** did not prescribe any particular form for the communications provided therein, distinguishing them from other communications or notifications under EPC.
- A reference to time limit to apply for a decision was **not necessarily decisive** as to true nature of communication.
- document constituted communication pursuant to **R.69(1) EPC1973**
- Whether should be derived from its substantive content and its context **J8/81, T713/02, J24/01**

Responsibility for issuing decisions under R.112(2) EPC



III.K.4.4

OJ2014, A6

- decision of the President of the EPO
- responsibility for issuing communications and decisions within meaning of **R.112(2) EPC** transferred to formalities officers working for Exam and Oppo Divs

Art.113

Loss of rights

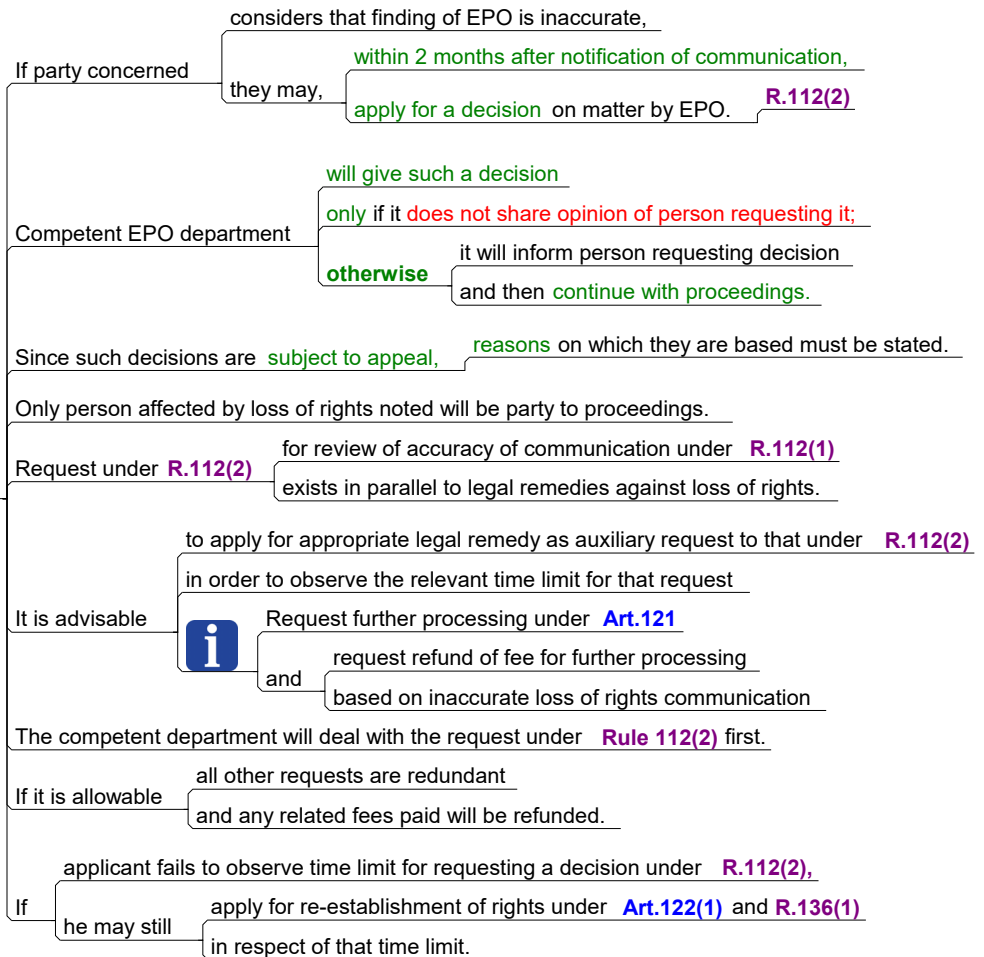
Decision on loss of rights



Basic principles of decisions
Right to be heard
Loss of rights
Signature



E.VIII.1.9.3



Request for a decision under **R.112(2) EPC** subsequent to communication



III.K.4.3

J43/92

decision pursuant to **R.112(2) EPC** could be applied for
only if it was preceded
by a communication under **R.112(1) EPC.**
Otherwise, there was no basis for EPO to issue such a decision.

Right to a decision under **R.112(2) EPC**



III.K.4.5

J29/86
J34/92

Right to decision after notification of loss of rights is a substantial procedural right
which cannot be ignored by EPO.
A party who applies for a decision under **R.112(2) EPC** is entitled to receive one.
correctness of a notification of loss of rights under **R.112(1) EPC** is challenged,
If EPO has a duty to reply within **reasonable period of time**
having regard to subject-matter of communication

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

R.113 Signature, name, seal

- (1) Any decisions, summonses, notices and communications from the EPO shall be signed by, and state the name of, the employee responsible.
- (2) Where a document referred to in paragraph 1 is produced by the employee responsible using a computer, a seal may replace the signature.
- Where the document is produced automatically by a computer, the employee's name may also be dispensed with.
- The same shall apply to pre-printed notices and communications.

Signatures on a decision under R.113 EPC



III.K.3.3

- R.113(1) EPC is not just a mere formality but an essential procedural step in decision-taking process.
- J16/17 The name and signature serve to identify decision's authors and express that they unconditionally assume responsibility for its content.
- This requirement is aimed at preventing arbitrariness and abuse and ensuring that it can be verified that competent body has taken decision.
- It therefore constitutes an embodiment of the rule of law.
- T989/19 cover page of Exam Div's decision had not been signed by all the division's members, this amounted to a substantial procedural violation and the decision was invalid.
- Under R.113(1) EPC EPO decisions had to be signed by the employee responsible and state their name.
- Since in addition Art.18(2) EPC stipulated that Exam Divs consisted of 3examiners, signatures of all 3 of those examiners were required.

Decisions to be signed



III.K.3.3.1

- R.113 EPC decisions, summonses, notices and communications from EPO must be signed by, or bear the seal of, the employee responsible.
- T390/86 if the decision of particular division was to be legally valid it had to bear signatures of members who had been appointed to that division to decide the issue.

Art.113



Basic principles of decisions
Right to be heard
Loss of rights
Signature

Signatures on a decision under R.113 EPC

Examples of invalid signatures



III.K.3.3.2

a) When decision is announced in oral proceedings

T390/86 in a case where final substantive decision has been given orally by Oppo Div during oral proceedings, subsequent written decision giving reasons for such oral substantive decision if is signed by persons who did not constitute opposition division during oral proceedings => decision is invalid.

T243/87 decision null and void where one of the 3 signatures was provided by a member who had not attended the oral proceedings.

b) Director's signature in place of examiner's signature

T211/05 a director's signature purporting to be on behalf of second examiner was invalid because nothing in the EPC1973 authorised a director to sign on behalf of a member of Exam Div to which he did not himself belong

Examples of valid signatures



III.K.3.3.3

a) Computer-generated communications

T225/96 forms accompanying decisions are never signed because they are computer-generated and therefore, under R.70(2) EPC1973 (R. 113(2) EPC), a seal may replace the signature.

b) Death of examiner between oral proceedings and written decision

T1170/05 1 of examiners had died => decision of 1st instance bore signatures of only 2 of 3 members of division chairman signing on behalf of the deceased examiner. => decision was valid.

c) Decision in written proceedings

T777/97 only 2 of members of Oppo Div had signed the contested decision refusing a request for correction, one purporting to sign on behalf of the absent chairman. Conclusions reached in T243/87 could be applied by analogy. Only those members who had taken the decision could decide on a request for its correction, but if one of the 3 members of decision-making department was absent (here: the chairman), one of the others (here: the first examiner) could sign on that absent member's behalf

d) Illegible signature

D8/82 surname of signature appeared only as a mark in which one could still discern the first letter and which was recognisably intended as a signature. it was valid since in several contracting states of EPO there is no requirement that a signature be legible or recognisably composed of letters.

e) Draft decisions

T225/96 only the first examiner on Oppo Divn had signed the contested decision. sent case back to the division for regularisation, but the 3 non-signing members replied that they were not prepared to put their names to a text issued without their knowledge or approval. in general, the decision as notified to the parties was presumed to be authentic. **T837/01** where it was clear that the document sent to the parties was merely a draft. This amounted in board's view to a substantial procedural violation. Had signatures simply been missing this could have been corrected under R.89 EPC1973 (now R.140 EPC)