

T 650/10 and the right to be heard

Kluwer Patent Blog

January 15, 2016

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Please refer to this post as: Thorsten Bausch, 'T 650/10 and the right to be heard', Kluwer Patent Blog, January 15 2016, <http://patentblog.kluweriplaw.com/2016/01/15/t-65010-and-the-right-to-be-heard/>

By Klemens Stratmann

Currently, the parties involved in appeal proceedings before the EPO see a clear trend towards decisions rendered on formal grounds. If the patentee files new requests along with the statement setting out the grounds of appeal without sufficiently addressing the decision per se, he runs the risk that the appeal is held inadmissible (T 2532/11, T 327/13) even if one were to assume that the requests meet all the requirements of the EPC. Further, an ever increasing number of Boards are rejecting requests as being belated for the sole reason that, theoretically, they could have been filed in the first instance.

A recent case illustrating this approach is [T 650/10 of 30 September 2015](#) which concerned an appeal lodged by the patent proprietor against the decision of the Opposition Division to maintain EP 1 356 929 in an amended form on the basis of the sixth auxiliary request. The Opposition Division held that various claims pursued in the first instance by means of one main request and five auxiliary requests did not meet the requirements of Article 56 EPC. The main request filed by the proprietor with a statement of the grounds of appeal was essentially identical to claim 1 of the 1st auxiliary request filed before the Opposition Division.

Claim 1 of the main request concerned a method for the preparation of a lithographic printing plate comprising the steps of:

1. imagewise recording on a lithographic printing-plate precursor comprising a support having a hydrophilic surface and a thermosensitive layer, the thermosensitive layer comprising polymer particles;
2. showering the printing-plate precursor, in which a processing liquid is..... supplied to the printing plate precursor; and
3. rubbing the printing plate precursor by a rubbing member in the presence of the processing liquid...

In addition, the proprietor submitted nine auxiliary requests with the statement setting out the grounds of appeal; not a single one of these requests, however, was admitted by Board 3.2.05 into the appeal proceedings pursuant to Article 12(4) of the Rules of Procedure before the Boards of Appeal (RPBA).

The Board correctly notes in the decision (Items 6.5 to 6.7) that the auxiliary requests filed before the Opposition Division concerned constructional details of the automatic processor, whereas auxiliary requests 1 to 4 and 6 to 9 filed in the appeal proceedings included the feature "the thermosensitive layer comprising a cyanine dye", which concerned the chemical composition of the lithographic printing plate precursor, and auxiliary request 5 filed in the appeal proceedings included the feature "the processing liquid is a hydrophilic aqueous solution containing a surfactant", which concerned the chemical composition of the processing liquid.

In the view of the Board, the filing of auxiliary requests 1 to 9 constituted a change in the way the appellant defended its patent before the first instance.

However, the Board did not consider, at all, whether justification existed for these amendments and for the change in focus from constructional details of the automatic processor to chemical features of the plate precursor and the processing liquid.

The amendments conducted in auxiliary requests 1 to 9 were filed, among other reasons, in response to an objection raised by the Opposition Division for the first time in the written grounds of the decision, where the Opposition Division held that the experimental data filed by the appellant / proprietor did not provide evidence that the alleged surprising synergistic effect was present over the whole scope of the claim, inter alia since the comparative experiments referred to a *specific* composition of the printing plate precursor in combination with a *specific* composition of the processing liquid. Auxiliary requests 1 to 9 addressed this objection and limited the chemical composition of the printing plate precursor and the chemical composition of the processing liquid, accordingly.

In the "Reasons for the Decision", the Board did not consider, at all, that the proprietor had no possibility to address the objection at an earlier point in time. The mere change from a mechanical focus of the claims to a more chemical focus was sufficient to deny the admissibility of the auxiliary requests. Evidently, the Board believed that the right to be heard was already safeguarded if the party was afforded the opportunity to comment on the issue of admissibility. In addition, the competent Board discussed with the parties at the hearing whether auxiliary requests 1 to 9 are prima facie suited to overcome the inventive-step objections, which discussion is, however, not reflected in the written grounds for the decision. Particularly noteworthy here is whether a prima facie assessment to establish whether a new request is likely to overcome an objection is adequate to satisfy the right to a thorough discussion under Article 113 EPC (cf. also [Wegner and Hess in epi-Information 1/2014, page 32: The right to be heard before the EPO Boards of Appeal - overruled by formal regulations?](#), and Rudolf Teschemacher in Mitteilungen, Heft 11/2014, page 488: Zulässigkeit der Beschwerde und notwendiger Inhalt der Beschwerdebegründung - Anmerkungen zu T 2532/11).

T 650/10 hence represents another decision raising the question whether the current application of the Rules of Procedure (RPBA) by some Board of Appeals can lead to the right to be heard undergoing a fundamental loss of substance.