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**D E C I S I O N**  
**of 15 May 2001**

**Case Number:** T 0291/00 - 3.2.1  
**Application Number:** 93116048.5  
**Publication Number:** 0591908  
**IPC:** B60T 1/06, B60K 17/04,  
F16D 65/853

**Language of the proceedings:** EN

**Title of invention:**

Transmission with integrated brake particularly for vehicles

**Patentee:**

ZF FRIEDRICHSHAFEN AG

**Opponent:**

Kordel Antriebstechnik GmbH

**Headword:**

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**Relevant legal provisions:**

EPC Art. 55(c), 113(1), 117(1)(3)  
EPC R. 56(1), 67

**Keyword:**

"Admissibility of opposition (yes)"  
"Substantial procedural violation (yes)"

**Decisions cited:**

T 0328/87, T 0142/97

**Catchword:**

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Boards of Appeal

Chambres de recours

**Case Number:** T 0291/00 - 3.2.1

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.1**  
**of 15 May 2001**

**Appellant:** Kordel Antriebstechnik GmbH  
(Opponent) Rödder 28  
D-48234 Dülmen (DE)

**Representative:** Ackmann, Günther, Dr.  
Ackmann, Menges & Demski  
Patentanwälte  
Postfach 10 01 01  
D-47001 Duisburg (DE)

**Respondent:** ZF FRIEDRICHSHAFEN AG  
(Proprietor of the patent) Allmannweilerstrasse 25  
D-88038 Friedrichshafen (DE)

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 10 February 2000  
rejecting the opposition filed against European  
patent No. 0 591 908 pursuant to Rule 56(1) EPC.

**Composition of the Board:**

**Chairman:** F. Gumbel  
**Members:** S. Crane  
G. Weiss

## Summary of Facts and Submissions

- I. European patent No. 0 591 908 was granted on 11 June 1997 on the basis of European patent application No. 93 116 048.5.

Claim 1 of the granted patent reads as follows:

"Transmission with integrated brake particularly for vehicles, comprising, in an oil bath inside a containment and support casing (10), an epicyclic reduction unit (14) which is kinematically connectable to a drive unit (15) by means of at least two gears (16,17), of which the driven one (17) is coaxial to a sun gear (19) of the reduction unit and is associated therewith by means of a splined coupling, a disk brake (33) being arranged between said epicyclic reduction unit and said driven gear, with at least one first disk (34) rigidly coupled to an internally toothed ring gear (18) which is rigidly coupled to said containment casing and at least one second disk (35) which is rigidly coupled so as to rotate together with said driven gear, said disk brake being associated with axially movable packing pushers (39) for axially moving the disks (34,35) of the disk brake into braking contact, the transmission being characterized in that the driven gear (17) is axially fixed such that it does not move in the axial direction."

Dependent claims 2 to 18 relate to preferred embodiments of the transmission according to claim 1.

- II. The granted patent was opposed by the present appellants on the ground that its subject-matter lacked inventive step (Article 100(a) EPC).

In support of this objection the appellants stated in the notice of opposition that early in 1991 they had supplied nine transmission units according to workshop drawing No. 00.00597.1 to the company Jungheinrich, GmbH & Co KG. The transmission unit involved differed from that claimed solely in the way the disk brake was arranged between the driven gear and the containment casing rather than between the driven gear and the epicyclic reduction unit as stated in the preamble of the claim. Given that the latter arrangement was known from DE-A-4 011 304, on which the preamble was based, it would not have involved an inventive step to modify the prior used transmission unit in this sense.

As evidence for the alleged prior use the appellants filed copies of the workshop drawing No. 00.0597.1, a delivery note dated 30 January 1991 and a report of the company Jungheinreich dated 8 March 1991 concerning test runs with the transmission units. They also filed a solemn declaration (eidesstattliche Erklärung) of one of their employees, Mr Raue, concerning the workshop drawing. In addition, for the case that the written evidence was held to be insufficient, they offered the oral testimony of Mssrs Raue, Kordel (a director of the appellants) and Bartels (of the company Jungheinreich).

III. In a reply dated 19 August 1998 to the notice of opposition the present respondents (proprietors of the patent) requested that the opposition be rejected and the patent maintained unamended. In their view the allegation of prior use had not been sufficiently proved. A further exchange of submissions took place (letters of the appellant dated 24 September 1998 and 18 January 1999, letter of the respondents dated 30 November 1998). In the latter the respondents argued

that the supply of the transmission units to the company Jungheinreich was covered by an implicit agreement of confidentiality.

With a letter dated 17 February 1999 the respondents made an auxiliary request for oral proceedings and with a letter dated 6 December 1999 the appellants requested that the date for the oral proceedings be set.

- IV. On 10 February 2000 the Opposition Division posted its decision rejecting the opposition as inadmissible under Rule 56(1) EPC.

The reason given for the decision was that the notice of opposition did not meet the requirements of Rule 55(c) EPC, in particular because it provided an insufficient indication of the facts, evidence and arguments presented. On the evidence available the Opposition Division took the view that there had been no public prior use of the transmission units involved, these having been supplied under implied conditions of confidentiality.

- V. A notice of appeal against this decision was filed on 20 March 2000, the fee for appeal having been paid three days earlier. The statement of grounds of appeal was received on 26 May 2000. The appellants requested that the contested decision be set aside and the patent revoked. They also made an auxiliary request for oral proceedings.

- VI. With a reply dated 28 September 2000 the respondents requested dismissal of the appeal, with oral proceedings requested as an auxiliary measure.

VII. In a communication posted on 9 March 2001 the Board stated that in its preliminary view the notice of opposition met the requirements of admissibility. It is also noted that the contested decision infringed Article 113(1) EPC since it was based on a ground on which the appellants had had no opportunity to present their comments and that the decision had been taken without the requested oral proceedings having been held.

In view of these circumstances the Board stated that it intended to remit the case for further prosecution and to reimburse the appeal fee.

VIII. With letters dated 14 March 2001 and 20 March 2001 respectively the respondents and the appellants withdrew their auxiliary requests for oral proceedings. The appellants also stated that they were in agreement with remittal of the case to the Opposition Division.

### **Reasons for the Decision**

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.
2. The details given by the appellants in their notice of opposition of the alleged prior use on which they relied were sufficient to meet the "when, what and how" criteria established in decision T 328/87 (OJ EPO 1992, 701) and mentioned in the Guidelines for Examination, part D, chapter IV 1.2.2.1 (v). In particular, the pieces of written evidence submitted by the appellants provide *prima facie* support for their allegation that

in 1991 they supplied by sale a number of transmission units, constructed as shown in the workshop drawings 00.0597.1, to a third party. Indeed, that set of circumstances as such has never been called into question, either by the respondents or by the Opposition Division, which issued its decision without having made a substantive communication to the parties. What the respondents did dispute in the opposition proceedings was whether the supply of the transmission units made them available to the public in the sense of Article 54(2) EPC, since in their view an implicit agreement of confidentiality between the appellants and the third party could be assumed to exist. It must be noted however that this argument was not at that stage advanced by the respondents against the **admissibility** of the opposition but against its substantive merits, which is where, in the opinion of the Board, it firmly belongs. In any case, it is not clear to the Board how the Opposition Division reached the conclusion it did without being prepared to hear the witnesses offered by the appellants in the notice of opposition, since these witnesses would clearly have been in a position to offer evidence not only on the structure of the transmissions supplied, as suggested by the Opposition Division, but on all the circumstances surrounding the sale (cf. T 142/97, OJ EPO 2000, 358).

3. As a corollary of the above it is apparent that at no stage before the issue of the decision under appeal rejecting the opposition as inadmissible had the question of its admissibility been addressed. Thus the decision was based on a ground on which the appellants had had no opportunity to present their comments, in contravention of Article 113(1) EPC. A further contravention of the right of the appellants to be

heard as provided for by Article 113(1) EPC is to be seen in the fact that the decision was issued without holding the oral proceedings as requested in the letter of the appellants dated 6 December 1999.

In this context the request in this letter to set a date for oral proceedings ("den Termin für eine mündliche Verhandlung anzuberaumen") can only realistically be understood as a request for such oral proceedings. Indeed, the Opposition Division clearly understood it in this way, cf. the paragraph bridging pages 2 and 3 of the contested decision "The opponent...in a letter dated 6.12.1999...requested oral proceedings."

4. In view of the substantial procedural violations which have occurred and the fact that the Opposition Division has not yet fully investigated inventive step of the claimed transmission unit the Board makes use of its power under Article 111(1) EPC to remit the case for further prosecution.

In these circumstances reimbursement of the appeal fee is clearly equitable (Rule 67 EPC).

## **Order**

### **For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.



3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel