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Datasheet for the decision of 24 June 2008

Case Number: T 1556/06 - 3.2.06

Application Number: 97201482.3

Publication Number: 0810056

IPC: B23K 26/12

Language of the proceedings: EN

Title of invention:
Friction stir welding with simultaneous cooling

Patentee:
The Boeing Company

Opponent:
Airbus SAS

Headword:
-

Relevant legal provisions:
EPC Art. 56, 84, 111(1), 114(1),(2)
EPC R. 103(1)
RPBA Art. 13(1)

Relevant legal provisions (EPC 1973):
-

Keyword:
"Inventive step (no) - patent as granted"
"Late-filed documents - partly admitted"
"Clarity (no) - patent as maintained"
"Late-filed auxiliary requests I to VI - not admitted because not clearly allowable"
"Late-filed auxiliary request VII - admitted [reasons, 4.4.1]"
"Remittal (yes)"
"Substantial procedural violation (no) - allowing a PowerPoint presentation during oral proceedings is a matter of discretion for the competent tribunal"
"Apportionment of costs (no)"

Decisions cited:
T 1110/03, T 1122/01

Catchword:
The Opposition Division has a discretion as to the way oral proceedings are conducted. It is not a wrongful exercise of this discretion, and thus not a procedural violation, to refuse to allow a party to use a PowerPoint presentation during oral proceedings if the party is not thereby prevented from presenting its arguments orally (reasons, 5.2.1-5.2.7).

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1556/06 - 3.2.06

D E C I S I O N
of the Technical Board of Appeal 3.2.06
of 24 June 2008

Appellant: (Patent Proprietor)
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 16 August 2006 concerning maintenance of European patent No. 0810056 in amended form.**

Composition of the Board:

Chairman: K. Garnett
Members: G. Pricolo
M. Harrison

Summary of Facts and Submissions

I. The appeal stems from the interlocutory decision of the Opposition Division posted on 16 August 2006 maintaining European patent No. 0 810 056 in amended form.

II. In the decision under appeal the Opposition Division considered that the patent in suit as granted met the requirements of Article 83 EPC (sufficiency of disclosure) and of Article 54(2) EPC (novelty). It held that the subject-matter of claim 1 as granted was not inventive in view of the disclosure of document

E8: WO-A-95/26254.

However, the subject-matter of claim 1 as amended in accordance with the patent proprietor's first auxiliary request, for which document

E7: "Friction Stir Process Welds Aluminum Alloys", by C.J. Dawes and W.M. Thomas, published in Welding Journal, 1 March 1996;

was considered to represent the closest prior art, was inventive.

III. The patent proprietor and the opponent each lodged an appeal against this decision. The notices of appeal were received at the EPO on 5 and 23 October 2006, respectively. Payment of the appeal fees was recorded on the same dates. The statements setting out the grounds of appeal were received at the EPO on 18 and 27 December 2006, respectively.

With the grounds of appeal the appellant/opponent filed the following additional prior art documents:

E9 : pages 1 and 2 of the book "Techniques de l'Ingénieur, traité Matériaux métalliques", volume M 651, by Roger Develay ;

E10 : FR-A-1 472 909 ;

E11 : WO-A-91/12097 ;

E12 : Article : "An introduction to friction stir welding and its development", by C.J. Dawes, published in Welding & Metal fabrication, January 1995 (pages 13 to 16).

IV. In an annex to the summons for oral proceedings pursuant to Article 15(1) Rules of Procedure of the Boards of Appeal the Board expressed its preliminary opinion according to which it appeared that the opposition division did not commit a substantial procedural violation as alleged by the appellant/patent proprietor by not allowing the patent proprietor to use a PowerPoint presentation at the oral proceedings. The Board further expressed the preliminary opinion that the amendment made to claim 1 in accordance with the auxiliary request allowed by the opposition division introduced a lack of clarity (Article 84 EPC) because it was not clear what aluminium alloys fell under the definition of "non-extrudable" aluminium alloys. As regards inventive step, the Board stated that document E7 appeared to represent an appropriate starting point

for the subject-matter of both claim 1 as granted and as maintained.

V. In reply to the communication of the Board the appellant/patent proprietor filed on 23 May 2008 amended claims in accordance with auxiliary requests I to VII.

VI. Oral proceedings, at the end of which the decision of the Board was announced, took place on 24 June 2008.

The appellant/patent proprietor requested that:
1. Documents E9, E10, E11 and E12 be not admitted into the proceedings.
2. The decision under appeal be set aside and the patent be maintained as granted.
3. Alternatively the opponent's appeal be dismissed and the patent be maintained on the basis of the auxiliary request upheld by the Opposition Division.
4. Alternatively that the decision under appeal be set aside and the patent be maintained on the basis of one of the first to seventh auxiliary requests filed with its letter dated 23 May 2008.
5. The appeal fee be reimbursed.
6. Remittal of the case to the Opposition Division.

The appellant/opponent requested that:
1. Documents E9, E10, E11 and E12 be admitted into the proceedings.
2. The decision under appeal be set aside and the patent be revoked.
3. An order be made for an apportionment of costs in its favour.

VII. Claim 1 as granted reads as follows:

"1. A method of friction stir welding, the method comprising:
(a) using a rotating friction stir welding tool (30, 60, 100) to weld a workpiece comprised of a friction stir weldable material; characterized by
(b) simultaneously removing excess heat produced by the using of the friction stir welding tool;
whereby the removing of heat produces a smoother weld surface, without machining the weld surface, at a faster rate."

Claim 1 in the form as allowed by the opposition division in the decision under appeal includes the following feature (before the expression "characterized by"):

"wherein the workpiece is comprised of a non-extrudable Aluminium alloy".

Claim 1 according to auxiliary requests I to VI is amended over claim 1 as granted by adding the text underlined as shown below:

Auxiliary requests I and II:
"…(b) reducing the degree of adherence between the tool and the softened material by simultaneously…"

Auxiliary request III:
"… to weld a workpiece comprised of a difficult to friction stir weld material; characterized by
(b) reducing the degree of adherence between the tool and the softened material by simultaneously…"

Auxiliary request IV:
"… to weld a workpiece comprised of a difficult to friction stir weld material; characterized by
(b) reducing the degree of adherence between the tool and the softened, difficult to friction stir weld material by simultaneously…"

Auxiliary request V:
"… a workpiece comprised of a friction stir weldable material wherein the workpiece is comprised of one of the following alloys: 2024, 7075, 2014 and 2090 alloys; characterized by …"

Auxiliary request VI:
"…(b) simultaneously removing excess heat produced by the using of the friction stir welding tool, wherein the removal of excess heat consists in cooling by a coolant flow, wherein the coolant flow is controlled to avoid overcooling;…"

Independent claims 1 and 3 according to auxiliary request VII read as follows:

"1. A friction stir welding tool, the tool comprising a tool body (60) having a pin and shoulder (66) at a distal end, the pin and shoulder adapted for generating frictional heat when rotating in contact with parts to be welded together, the heat causing a weld to form between the parts, characterized by: an internal space (94) defined within the body of the welding tool, the space in fluid communication with a source of coolant and walls of the space in heat conducting communication with the distal end of the tool body, whereby, when

coolant flows through the space during welding operations, the distal end (64) is cooled."

"3. A friction stir welding tool, the tool comprising a tool body (100) having a pin (106) and shoulder (108) at a distal end of the tool body, the pin and shoulder adapted for generating frictional heat when rotating in contact with a workpiece being welded, said heat causing a weld to form, characterized by: a jacket (110) surrounding the distal end of the tool body, the jacket having an inlet (116) in fluid communication with a source of coolant, and an outlet (118) for exit of the heated coolant, whereby, when coolant flows through the jacket during welding, excess heat is removed from the distal end of the tool body."

VIII. The arguments of the appellant/patent proprietor which are relevant to the present decision can be summarized as follows:

Patent as granted

Document E7 represented the closest prior art as regards the method according to claim 1. The problem underlying the patent in suit consisted in allowing faster friction stir welding whilst maintaining an acceptably smooth welding surface. The invention was based on the recognition that the adherence of the material to the friction welding tool encountered when increasing the welding rate could be avoided by removing excess heat. Linking the adherence problems to excessive heat was counter-intuitive. Nor did the prior art give any hints in this direction.

Patent as maintained

For a skilled person it was clear what aluminium alloys were of the extrudable type and what aluminium alloys were of the non-extrudable type. Alloys of the 2000, 7000 and 5000 series were of the non-extrudable type. Although some of the alloys of these series could be extruded, this was difficult and only possible under particular circumstances. Accordingly, even the latter alloys would be classified by a skilled person as non-extrudable.

Auxiliary requests I to IV

Claim 1 according to auxiliary requests I to IV included the feature of reducing the degree of adherence between the tool and the softened material by simultaneously removing excess heat produced by the using of the friction stir welding tool. This feature defined more specifically the manner in which a smoother weld was achieved.

Auxiliary request V

Claim 1 included a restriction to specific aluminium alloys for which the problem of adherence between the tool and the softened material represented a serious hindrance to carrying out the conventional friction stir welding disclosed by E7. For joining these specific alloys, the skilled person would consider other joining techniques.

Auxiliary request VI

The feature added to claim 1 implied that only the right amount of heat was removed, thereby allowing a smoother weld surface to be obtained and overcooling to be avoided. The prior art did not disclose or suggest such controlled cooling.

Auxiliary request VII

Claims 1 and 3 corresponded to independent claims 7 to 9 as maintained and were directed to a friction stir welding tool having specific features. Since the decision under appeal was silent as regards inventive step of these claims, auxiliary request VII essentially represented a fresh case which should not be dealt with for the first time in the appeal proceedings. Accordingly, it was appropriate to remit the case to the opposition division for further prosecution.

Reimbursement of the appeal fee

The opposition division committed a substantial procedural violation, justifying the reimbursement of the appeal fee, by not allowing the patent proprietor to give a PowerPoint presentation during the oral proceedings. The PowerPoint presentation was filed one month before the oral proceedings and was merely a visual aid which should have been allowed. A party had a right to use visual aids, such as a blackboard, or an overhead projector, in order to present its case in the best manner. In fact, even the representative's file could be regarded as a visual aid, for which no objection could reasonably be made. Furthermore, the

PowerPoint presentation was about document E8 which was filed late and for which the patent proprietor was not given sufficient opportunity to discuss in writing. If the patent proprietor had had a chance to give a Power Point presentation, E8 would have been correctly interpreted by the Opposition Division.

IX. The appellant/opponent's reply to these arguments can be summarized as follows:

Patent as granted

Friction stir welding was an hybrid process combining machine-tool technology and hot working of metals. Especially in the latter technical field, controlling the heat input was a matter of common general knowledge. It was evident that in the event of excessive heating the heat input could be reduced by cooling. In particular, cooling for that purpose was well known in joining processes analogous to friction stir welding, such as the conventional friction welding disclosed by document

E1 : US-A-4 106 167.

Accordingly, the skilled person would regard it as obvious to cool the friction stir welding tool used in the method of E7. In any case, the skilled person seeking to increase the welding rate of the friction stir welding process according to E7 would appreciate that higher welding rates would cause adherence of the material to the friction stir welding tool. As a matter of common general knowledge, he would obviously consider avoiding this inconvenience by controlling the

heat input to the workpiece, i.e. by cooling the friction welding tool. The features of claim 1 according to which the removal of heat produced a smoother weld surface at a faster rate, without the need to machine the weld surface, did not constitute a limitation of the claimed subject-matter because the claim did not define the situation with respect to which a smoother weld surface was obtained at a faster rate. Accordingly, the skilled person would arrive at the subject-matter of claim 1 without inventive skill.

Patent as maintained

All aluminium alloys could be extruded, even the non-extrudable aluminium alloys mentioned in the patent in suit, as shown by E9 and E10. Accordingly, it was not clear what aluminium alloys fell under the feature in claim 1 of "non-extrudable aluminium alloys". Claim 1 therefore did not meet the requirements of Article 84 EPC.

Auxiliary requests I to IV

Since it was not clear what further limitations were introduced into claim 1 by means of the expression "reducing the degree of adherence between the tool and the softened material", auxiliary requests I to IV should not to be admitted, in accordance with the Rules of Procedure of the Boards of Appeal.

Auxiliary request V

Since E7 disclosed friction stir welding of one of the specific alloys mentioned by claim 1, its subject-

matter lacked inventive step for the same reasons as claim 1 as granted.

Auxiliary request VI

The additional feature included in claim 1 did not change the substance of the claim. The fact that overcooling was to be avoided was, for a skilled person, an implicit requirement in the cooling of a tool used to deliver heat in a joining process.

Apportionment of costs

An order for apportionment of costs against the appellant/patent proprietor in the event of a remittal was justified because the remittal would be due to the filing of auxiliary request VII by the appellant/patent proprietor in the appeal proceedings and would cause extra costs, in view of the fact that a final decision would not be taken at the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. *Patent as granted*

2.1 Document E7 can undisputedly be regarded as an appropriate starting point for the assessment of inventive step. It discloses a method of friction stir welding comprising using a rotating friction stir welding tool to weld a workpiece comprised of a friction stir weldable material (see Fig. 2 on page 42).

The subject-matter of claim 1 differs from this known method by simultaneously removing excess heat produced by the use of the friction stir welding tool, whereby the removal of heat produces a smoother weld surface, without machining the weld surface, at a faster rate.

2.2 The technical effect of the method step of simultaneously removing excess heat produced by the use of the friction stir welding tool is, as stated by claim 1 itself, that of producing a smoother weld surface, without machining the weld surface, at a faster rate. As pointed out by the appellant/opponent, the latter definition of claim 1 is a relative expression and does not constitute, in the absence of specific terms of reference, any clear limitation for the claimed subject-matter. According to the description of the patent in suit (see par. [0005]), the step of removing excess heat prevents the softened material from adhering to the rotating pin and shoulder of the friction stir welding tool. Adherence of material would cause a rough weld surface or even render continuing the weld impossible (see col. 1, line 52 to col. 2, line 6, of the patent in suit). Therefore, the above-mentioned relative expression of claim 1 is to be read to imply that the step of removing excess heat allows for an increase in the welding rate whilst obtaining a satisfactory weld surface.

Accordingly, the objective technical problem solved by the distinguishing features can be seen in how to

increase the welding rate whilst obtaining a satisfactory weld surface.

2.3 The skilled person faced with the problem of increasing the welding rate would immediately appreciate that this would involve increasing the heat input to the workpieces. The skilled person would also appreciate that, for a given friction stir welding tool, an increase of the heat input to the workpieces would result in increased heat input to the tool itself: not all the additional heat generated by the friction between the tool and the workpieces would be taken up by the workpieces but a part thereof would be taken up by the tool itself. The skilled person would then obviously recognise that at high welding rates, and thus high heat input, overheating of the tool would present a problem and thus when increasing the heat input would obviously consider providing additional means for dissipating the heat taken up by the tool, in particular cooling means. It is indeed well known in the general field of metal joining processes to cool welding tools in order to prevent overheating. This is in particular exemplified by E1, which relates to the neighbouring technical field of friction welding by means of friction wheels (see col. 1, lines 22 to 42). According to E1 the friction wheels are cooled to prevent overheating (see col. 4, lines 39 to 42). Therefore, the skilled person would obviously consider modifying the method of friction stir welding according to E7 by cooling the tool, thereby arriving at a friction stir welding method in which, in accordance with the wording of claim 1 of the patent in suit, excess heat produced by the use of the friction stir welding tool is simultaneously removed. Since the

skilled person would increase the welding rate only by as much as would still allow a satisfactory weld to be obtained, in particular a satisfactory weld surface, in doing this he would necessarily arrive at a method according to claim 1 of the patent in suit.

2.4 Even assuming that the feature of claim 1 according to which the removal of heat produces a smoother weld surface, without machining the weld surface, at a faster rate, should be read to mean that by removing excess heat a weld surface is obtained which is smoother than the weld surface which is obtained when carrying out a "reference" method, namely a friction stir welding method carried out under same conditions but without removing heat and at a slower rate, the above conclusion remains unchanged. As submitted by the appellant/patent proprietor during the oral proceedings before the Board, a weld surface which is produced when removing heat is always smoother than a weld surface obtained under the same conditions but without removing heat, independently of the workpiece material. Therefore, for the same welding rate, a friction stir welding method in which heat is removed always leads to a smoother weld surface than the same friction stir welding method in which heat is not removed. Clearly, this result will be unchanged if the welding rate is only slightly reduced and the cooling is carried out efficiently. In the absence of any specific indication, the welding rate for the reference method can be arbitrarily defined. Accordingly, for the method of friction stir welding according to E7 modified by cooling the tool, it is always possible to find a reference friction stir welding method in which the tool is not cooled and the welding rate is slightly

lower and which produces a weld surface which is less smooth.

2.5 Therefore, the subject-matter of claim 1 as granted does not involve an inventive step (Article 100(a) and 56 EPC).

3. *Patent as maintained*

3.1 *The documents E9 to E12 filed in the appeal proceedings*

These documents were said by the appellant/opponent to have been filed in response to the amendment made to the patent in the amended form allowed by the opposition division, consisting of introducing into claim 1 the feature taken from the description according to which the workpiece is comprised of a non-extrudable aluminium alloy.

Documents E9 and E10 show that hard aluminium alloys of the 2000 and 7000 series can be extruded (E9: page M651-2; E10: page 3, first par.). According to the patent in suit, non-extrudable alloys are exemplified by the 2024, 7075, 2014 and 2090 alloys, i.e. alloys belonging to the 2000 and 7000 series. Since E9 and E10 are relevant in assessing the meaning of the feature "non-extrudable aluminium alloy", they effectively constitute a reaction to the amendment made. For this reason the Board decided that E9 and E10 were not to be disregarded for reasons of late-filing.

Since E11 relates to an extrusion die and as such is not prima facie relevant to the claimed subject-matter, and E7 discloses essentially the same subject-matter of

E12 and is not more relevant than the latter (E7 and E12 in fact have many passages in common), the Board decided pursuant to Article 114(2) EPC not to admit E11 and E12 into the proceedings.

3.2 *Clarity*

The amendment made by including in claim 1 the term "non-extrudable aluminium alloy", which is taken from the description of the patent in suit (see e.g. col. 1, line 45), introduces a lack of clarity, contrary to Article 84 EPC. Although it is generally known that some aluminium alloys are easier to extrude than others (see in particular E9, page M651-2, last paragraph, where it is stated that there are soft alloys which are well suited for the extrusion process and hard alloys which are less suited), there is no recognized standard for classifying aluminium alloys as "extrudable" and "non-extrudable". In fact, alloys of the series 2000 and 7000, which are included in the examples of non-extrudable aluminium alloys given in the patent in suit (see col. 1, lines 48, 49 and col. 4, line 20), can be extruded, as shown by documents E9 (page M651-2) and E10 (page 3, first paragraph), it being noted that E9 refers in general to a method of manufacturing a workpiece by extrusion. A skilled person might possibly classify an aluminium alloy as "extrudable" or "non-extrudable", as submitted by the appellant/proprietor. However, he would do so on a subjective basis and not on an objective basis. Accordingly, since it is not clear what aluminium alloys can be regarded as being "non-extrudable" on an objective basis, the claim does not clearly define the matter for which protection is sought (Article 84 EPC).

4. *Auxiliary requests*

The auxiliary requests filed with the letter dated 23 May 2008 constitute an amendment to the appellant/patent proprietor's case after it filed its grounds of appeal and therefore pursuant to Article 13(1) of the Rules of Procedure of the Boards of Appeal may only be admitted and considered at the Board's discretion.

4.1 *Auxiliary requests I to IV*

4.1.1 Claim 1 according to auxiliary requests I to IV includes the feature of (the wording added is in italics) *reducing the degree of adherence between the tool and the softened material by* simultaneously removing excess heat produced by the using of the friction stir welding tool. The wording added is taken from the description of the patent in suit (see col. 3, line 56 to col. 4, line 3).

During the oral proceedings the appellant/patent proprietor submitted that the intended result, namely the achieving of a smoother weld surface at a faster rate, was the direct result of the step of removing excess heat. In fact, the disclosure of the patent in suit does not allow any different conclusion. As stated in par. [0005] of the description (lines 36 to 38), "excessive heat causes the softened material to adhere to the rotating pin and shoulder of the friction stir welding tool…". It is therefore not clear what further limitation is introduced into claim 1 by including the

above-mentioned wording. This applies to claim 1 of all requests I to IV.

4.1.2 In view of this, the Board decided not to exercise its discretion pursuant to Article 13(1) RPBA to admit the auxiliary requests I to IV.

4.2 *Auxiliary request V*

4.2.1 Compared to claim 1 as granted, claim 1 is restricted to friction stir welding of a workpiece made of one of the alloys 2024, 7075, 2014 and 2090. Since E7 already discloses friction stir welding of workpieces made of the aluminium alloy 2014 (see page 43, left col., 3rd and 4th par.), the subject-matter of claim 1 is distinguished from the method of E7 by the same distinguishing features as with claim 1 as granted. Therefore, the subject-matter of claim 1 of this request appears to lack an inventive step for the same reasons given above in respect of the subject-matter of claim 1 as granted (see point 2 of this decision).

4.2.2 Since claim 1 is prima facie not allowable for the same reasons as for claim 1 as granted, the Board decided not to exercise its discretion pursuant to Article 13(1) RPBA to admit the auxiliary request V.

4.3 *Auxiliary request VI*

Claim 1 of this request is amended over claim 1 as granted by including the feature taken from the description (see col. 6, lines 48 to 58 of the patent in suit) according to which the removal of excess heat consists of cooling by a coolant flow, wherein the

coolant flow is controlled to avoid overcooling. As already explained above in respect of claim 1 as granted, the skilled person would consider it as obvious to cool the friction stir welding tool used in the method according to E7. Considering that cooling using a coolant flow is a matter of normal design procedure and as such an obvious feature, and that the fact that cooling should not be so intense such as to interfere with the welding process appears to be self-evident, the amendments made do not appear prima facie such as to introduce inventive subject-matter over that of claim 1 as granted. On this ground the Board also decided not to exercise its discretion pursuant to Article 13(1) RPBA to admit also the auxiliary request VI.

4.4 *Auxiliary request VII*

4.4.1 Auxiliary request VII includes claims 1 to 3 only. It constitutes a clear limitation of the patent in the form as maintained by the opposition division since these claims 1 to 3 correspond to claims 7 to 9 as maintained. The Board does not see any reasons not to admit this request. Nor did the appellant/opponent object to its admissibility.

4.4.2 In contrast to independent claim 1 of the patent as maintained, which is directed to a friction stir welding method, claims 7 to 9 as maintained are directed to a friction stir welding tool, whereby claims 7 and 9 are independent claims. The opposition division stated that the first auxiliary request met the requirements of the EPC, but gave reasons as regards inventive step only for claim 1. Since claims 7

and 9 as maintained define inter alia specific cooling means for the friction stir welding tool, it is not possible to directly apply to these claims the arguments of inventive step given in respect of claim 1.

4.4.3 It follows from the above that the issue of inventive step of claims 1 and 3 of the auxiliary request VII essentially represents a fresh case. Under these circumstances the Board considers it appropriate, in accordance with Article 111(1) EPC, to remit the case to the opposition division for further prosecution. By this means both appellants have the opportunity to have the case further examined with respect to inventive step without loss of an opportunity to appeal.

5. *Reimbursement of the appeal fee*

5.1 Rule 103(1) EPC provides for reimbursement of appeal fees in a case where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the present case the appeal of the patent proprietor has not been allowed, and therefore reimbursement of the appeal fee cannot be ordered.

5.2 Notwithstanding the above conclusion, the Board considers it appropriate to clarify the issue of the alleged substantial procedural violation.

5.2.1 It is not in dispute that the purpose of the PowerPoint presentation was only to enable the patent proprietor better to present its **arguments**, not to give evidence.

5.2.2 Article 116 EPC guarantees a party the right to oral proceedings. The basic purpose of such oral proceedings is to give the party an opportunity to present its argument orally (T 1110/03, para. 3.2). As established by Boards of Appeal case law, a refusal to allow a party to present its arguments orally is thus capable of amounting to a substantial procedural violation.

5.2.3 However, the essence of an oral presentation is in the Board's view just that: presentation of arguments by word of mouth. A PowerPoint presentation is not by itself an oral presentation in this sense. Decision T 1110/03, mentioned by the appellant/patent proprietor, explains some of the ways in which it differs from and is inferior to an oral presentation.

5.2.4 In the Board's view, Examining and Opposition Divisions, and Boards of Appeal, have a discretion as to the way oral proceedings are conducted, particularly having regard to the need for procedural economy and fairness to the parties. This discretion enables the competent tribunal to allow a party to use flip charts, PowerPoint presentations, etc., as an aid to oral presentation, or to refuse to allow the use of such means.

5.2.5 Any discretion must, of course, be exercised in a judicial manner and having regard to the interests of justice, particularly, in the present context, having regard to the right of a party to present its arguments orally.

5.2.6 It is perhaps possible to imagine a case in which a party would objectively be unable to present its

arguments adequately without the aid of a PowerPoint presentation. Usually, however, the presentation of materials by a PowerPoint presentation is simply an alternative way of presenting written materials or drawings and, as such, belongs to the written stage of the proceedings (see T 1110/03, para. 3.2). Indeed, T 1122/0l (also cited by the appellant/patent proprietor) makes it clear that the content of a PowerPoint presentation should have been notified in advance of the hearing. This means that usually a party will be fully able to present its arguments orally by reference in the ordinary way to such materials or drawings. The refusal to allow a party to supplement its arguments by reference to a PowerPoint presentation therefore usually cannot amount to a substantial procedural violation because the party's right to present its arguments orally will not have been violated.

5.2.7 In the present case, the patent proprietor was given the opportunity to present its arguments orally, and indeed did so. The nub of the grounds of appeal is that if the appellant had been allowed to give a PowerPoint presentation, one of the prior art documents (E8) would not have been incorrectly interpreted by the Opposition Division. However, nothing in what was submitted by the appellant/patent proprietor explains how a proper understanding of E8 could have been obtained **only** with the help of the PowerPoint presentation as opposed to a normal oral presentation with reference to the patent and prior art.

5.2.8 In conclusion, the Opposition Division had a discretion to allow or not allow the patent proprietor to use a

PowerPoint presentation. There is nothing to suggest that this discretion was exercised against the patent proprietor incorrectly, in particular in such a way as to infringe its procedural rights arising under the EPC, in particular Article 116 EPC. Accordingly, no substantial procedural violation was made by the Opposition Division.

6. *Apportionment of costs*

It is clear that additional costs will be occasioned by a remittal. However, the Board cannot see an abuse of procedure in the appellant/patent proprietor's behaviour: the seventh auxiliary request corresponds to the patent in the form maintained by the opposition division, amended only by way of deletion of the method claims 1 to 6 in reaction to the objections raised by the appellant/opponent and the Board during the appeal proceedings (see in particular above point IV). Therefore, there are no reasons of equity which in accordance with Article 104(1) EPC would justify a different apportionment of costs. The appellant/opponent's request cannot therefore be allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the Opposition Division for further prosecution.

3. The appellant/patent proprietor's request for reimbursement of the appeal fee is refused.

4. The appellant/opponent's request for an apportionment of costs is refused.

The Registrar: The Chairman:

D. Sauter K. Garnett