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**Datasheet for the decision  
of 22 June 2010**

**Case Number:** T 1950/07 - 3.2.08

**Application Number:** 00301891.8

**Publication Number:** 1035342

**IPC:** F16D 23/14

**Language of the proceedings:** EN

**Title of invention:**  
Clutch release bearing

**Patent Proprietor:**  
NSK LTD

**Opponents:**  
Masashi Shiotani  
SKF FRANCE

**Headword:**  
-

**Relevant legal provisions:**  
RPBA Art. 11

**Relevant legal provisions (EPC 1973):**  
EPC Art. 114(2)  
EPC R. 68(2), 71a, 67

**Keyword:**  
"Decision reasoned (no)"  
"Substantial procedural violation (yes)"  
"Remittal (yes)"  
"Refund of appeal fees (yes)"

**Decisions cited:**  
-

**Catchword:**  
-



Case Number: T 1950/07 - 3.2.08

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.08  
of 22 June 2010

**Appellant I:** Masashi Shiotani  
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**Appellant II:** SKF FRANCE  
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**Respondent:** NSK LTD  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted  
10 October 2007 concerning maintenance of the  
European patent No. 1035342 in amended form.

**Composition of the Board:**

**Chairman:** E. Dufrasne  
**Members:** M. Alvazzi Delfrate  
P. Acton

## Summary of Facts and Submissions

I. With its decision posted on 10 October 2007 the opposition division held that European patent No. 1 035 342 in amended form according to the main request then on file met the requirements of the EPC.

II. Claim 1 of the main request underlying the appealed decision reads as follows:

"A clutch release bearing (10) comprising:  
an outer ring (12); a rotatable inner ring (11) having an outer diameter; rolling members (15) provided between the outer ring (12) and the inner ring (11); and a seal (17) fixed to the outer ring (12), and comprising a labyrinth seal section (17c) located in an external portion of the bearing (10) to form a labyrinth seal with the inner ring (11), and a contact seal section (17b) located in an internal portion of the bearing (10) to be in a slight contact relationship with the inner ring (11), characterised in that the contact seal section (17b) has a triangular shape in cross-section, and the ratio of the interference of the contact seal section (17b) with respect to the outer diameter of the inner ring (11) is from 1/1000 to 1/100, and in that the seal (17) has a protrusion (17e) located on the internal side portion of the contact seal section (17b), the protrusion (17e) having an inner periphery to define a parting portion in an approximately cylindrical shape in a non-contact relationship with the inner ring (11)."

III. Appellant I (opponent 1) lodged an appeal against this decision on 30 November 2007, paying the appeal fee on the same day. The statement setting out the grounds for appeal was filed on 14 February 2008.

IV. A further appeal was lodged by appellant II (opponent 2) on 5 December 2007, with the appeal fee being paid on the same day. The statement setting out the grounds for appeal was filed on 8 February 2008.

V. Appellant I submitted in the statement setting out the grounds for appeal inter alia that the appealed decision was not sufficiently reasoned in respect of inventive step since it did not give any arguments as to why the subject-matter of claim 1 involved an inventive step in respect of the combination of

D1: DE- A- 19 709 056

with either of the documents

D4: US -A- 3 642 335 and

D6: DE -A- 19 527 340.

VI. In the statement setting out the grounds for appeal (point II) appellant II also submitted that the appealed decision was not reasoned, arguing in this respect essentially as follows:

It was not possible to understand from the appealed decision the reasons why the opposition division considered the subject-matter of claim 1 to involve an inventive step.

In respect of the sufficiency of disclosure the appealed decision merely stated that the drawings disclosed a possible shape of the seal before and after mounting, without refuting the arguments put forward by appellant II in respect of the definition of the parting portion, the positioning of the fabrication mould and the contradictions in the description relating to interference ratio.

Additionally, appellant II had raised in the opposition proceedings an objection of lack of novelty based on the assumption that, as already argued in the notice of opposition, the priorities of the patent in suit were not validly claimed. Both the objection to the validity of the priority and the ground of opposition of lack of novelty had not been considered by the opposition division on the sole ground that they had been submitted late. This could not be regarded as a reasoning within the meaning of Rule 68(2) EPC 1973.

Since the appealed decision was not reasoned, it should be set aside, the case remitted to the opposition division and the appeal fee reimbursed.

VII. The respondent (patent proprietor) disagreed and argued in respect of the reasoning of the decision essentially as follows:

The subject-matter of claim 1 involved an inventive step, especially in view of the interference ratio. Moreover, point 5 of the reasons for the appealed decision addressed the reasoning as to inventiveness.

In respect of sufficiency of disclosure the opposition division had accepted the reasoning that the description of the seal provided in the patent and at least as shown in the figures was sufficient to permit the person skilled in the art to put the claimed invention into practice.

Additionally, appellant II failed to provide arguments concerning the issue of priority in advance, and to allow the proprietor time to consider fully such arguments. Furthermore, this objection was considered to be entirely without substance.

- VIII. With a communication dated 18 December 2009 the Board of appeal appointed oral proceedings as requested by the parties as a precautionary measure. It also expressed the provisional opinion that a substantial procedural violation justifying the remittal of the case to the first instance and the refund of the appeal fee seemed to have occurred. It further indicated that the oral proceedings would be restricted to the discussion of the alleged procedural violations, without considering the merits of the case. In view of this fact the parties were invited to reconsider their requests for oral proceedings.
- IX. Appellant I and the respondent withdrew their requests for oral proceedings with letters dated 2 June 2010 and 25 May 2010 respectively.
- X. The oral proceedings were cancelled by notification dated 10 June 2010.

- XI. Appellant I requested that the appealed decision be set aside and the patent revoked.
- XII. Appellant II requested that the case be remitted to the opposition division and the appeal fee be reimbursed, since the appealed decision was not reasoned. In the event that the Board does not remit the case to the first instance, it requested that the appealed decision be set aside and the patent revoked. Oral proceedings were requested as an auxiliary measure.
- XIII. The respondent requested that the appealed decision be upheld and the patent be maintained in the form as allowed by the opposition division (primary request). Moreover, it submitted by letter dated 15 September 2008 five auxiliary requests to be considered in the event of the primary request being refused.

### **Reasons for the Decision**

1. The appeals are admissible.
2. In order to comply with the requirement of Rule 68(2) EPC 1973, a decision must contain, in a logical sequence, those arguments which justify its tenor. Therefore, all the facts, evidence and arguments essential to the decision must be discussed in sufficient detail in order to enable the parties and, in case of an appeal, the Board of appeal to examine whether the decision was justified or not.

3. In the present case, the tenor of the appealed decision is that the patent in amended form meets the requirements of the EPC.

One of the objections raised by the opponents was that the claimed subject-matter lacks an inventive step. Therefore, a reasoned decision must indicate at which point the inventive step occurs, together with the reason why it is considered to be not obvious, and why any negative ground put forward is invalid.

- 3.1 In the decision under consideration, the "Reasons for the Decision" provide some information in respect of inventive step, starting in point 4, where it is stated that D1 is seen as the closest prior art and that it discloses the features of the preamble of claim 1.

The issue of inventive step is also treated in point 5 of the "Reasons for the decision", to which the respondent referred. The first four paragraphs of this point reproduce some of the arguments of the parties, without however giving the position of the opposition division on them. The fifth paragraph reads as follows: "The opponents could neither show that all features of claim 1 were part of the prior art, nor prove that the man skilled in the art would combine corresponding disclosures or documents to arrive at the subject-matter of claim 1."

As can be seen, this paragraph merely contains the conclusion of a possible reasoning as to why the claimed subject-matter was not obvious, but not the reasoning itself. In particular it fails to indicate, starting from the closest prior art D1, what it is, in



the view of the opposition division, that rendered the claimed invention not obvious, and why.

This information cannot be found in the rest of the decision either.

As a consequence, the appealed decision fails to enable the parties and the Board of appeal to examine whether the finding that the claimed subject-matter involved an inventive step was justified or not. Therefore, it is not reasoned in this respect.

- 3.2 The respondent argued that the decision is reasoned, since the claimed subject-matter involved an inventive step in view of the interference ratio.

The question whether a decision is reasoned or not must be assessed on the basis of its content. Since it cannot be inferred from the appealed decision whether the opposition division shared this view and why, the respondent's argument is not convincing.

- 3.3 In view of the fact that the objection of lack of inventive step, if successful, would have caused the revocation of the patent, a deficient reasoning in this respect is to be seen as a substantial procedural violation.

4. Appellant II submitted that a further violation of the procedure had occurred, since the submission that the priorities were not valid and the ground of opposition of lack of novelty were not considered on the sole basis that they were submitted late.

In order to establish whether a substantial procedural violation occurred in this respect as well, some careful analysis of the appealed decision is necessary, to establish what exactly, if anything, was disregarded by the opposition division and which reasoning, if any, is deficient.

- 4.1 First of all it should be established if the ground of opposition of lack of novelty, i.e. the individual legal basis for objection to the maintenance of the patent, was considered by the opposition division or not.

According to point 3 of the "Facts and submissions" of the appealed decision, the submission that the subject-matter of claim 1 was not new because the priorities were not valid "... was seen as a new ground for opposition and not considered by the Opposition Division under Rule 71a EPC". Taken in isolation, this statement would appear to support the view of appellant II that the ground of opposition of lack of novelty had not been considered.

However, this view is proven erroneous when the whole decision is taken into consideration. In particular under point 4 of the "Reasons for the Decision", following a brief analysis of the features disclosed by D1, it is concluded that novelty is given ("Therefore the subject-matter of claim 1 is new.").

Accordingly, it is apparent that, in contradiction with the statement under point 3 of the "Facts and submissions", the ground of opposition of lack of novelty was indeed considered by the opposition

division, which found that novelty in view of D1 was to be acknowledged.

Therefore, the submission of appellant II that the opposition division did not consider the ground of opposition of lack of novelty is not correct.

4.2 Nevertheless, it can be seen from the same point 4 of the "Reasons for the Decision" that in the examination of novelty the opposition division decided to disregard the objection that, since the priorities were not validly claimed, the subject-matter of claim 1 lacked novelty ("In the Oral Proceedings Opponent 2 said that once he had proven the priorities were not validly claimed, he would prove that claim 1 lacked novelty. However the Opposition Division did not consider this late filed objection and no corresponding document was produced.").

It is thus appropriate to consider if this constitutes a procedural violation.

According to the appealed decision, this objection was raised for the first time during the oral proceedings and was therefore late-filed. This assessment has not been contested by the parties. Since no trace of the objection can be found in the written procedure, the Board is satisfied that it was indeed late-filed.

Accordingly, it was within the power of the opposition division as enshrined in Art. 114(2) and Rule 71a EPC1973 to disregard it.

Nevertheless, when exercising its power, whether for or against a particular party, the opposition division should give reasons. In the present case, the fact that the objection was late-filed is not a sufficient reason, but merely a precondition. Even though the sole ground for disregarding the objection mentioned in the "Reasons for the Decision" above is its late filing, in point 3 of the "Facts and submissions" the appealed decision indicates that the validity of the two priorities was discussed and that the opposition division "... decided they were validly claimed". Since the objection of lack of novelty was based on the assumption that the priorities were not validly claimed, the finding that this was not the case, which is clearly indicated in the appealed decision, was sufficient reason to disregard the objection of lack of novelty.

- 4.3 That said, when it comes to the finding that the priorities were validly claimed, no reason for this conclusion can be found in the appealed decision.

An objection to the validity of the priorities had already been raised in the notice of opposition of appellant II (point 3). Therefore, this submission was not late-filed and it was not within the power of the opposition division to disregard it.

Indeed, even if it appears from point 5.8 of the minutes that some arguments put forward in this respect may have been disregarded, there is no doubt that the validity of the priorities was considered and discussed at length during the oral proceedings, as documented by points 5.1 to 5.12 of the same minutes.

However, the appealed decision itself (point 3 of the "Facts and submissions") indicates solely that the validity of the priorities was discussed and that the opposition division decided that they were validly claimed, without giving any reasons for this conclusion. This part of the decision is therefore not reasoned within the meaning of Rule 68(2) EPC 1973.

The fact that a possible reasoning can be found under point 5.12 of the minutes ("The chairman further stated that the opposition division is of the opinion that the priority is valid due to the content of the figures.") is, irrespective of the question whether said possible reasoning would be sufficient, immaterial to the issue of compliance with Rule 68(2) EPC 1973. This rule refers to the decisions which are open to appeal, i.e. not to the minutes, which are rather a record of the essentials of the oral proceedings.

The respondent submitted that during the opposition proceedings appellant II failed to provide arguments in advance and failed to allow the proprietor time to fully consider such arguments. Furthermore, it argued that the objection to the validity of the priorities was considered to be entirely without substance. The Board points out that since these considerations are not part of the content of the appealed decision, they cannot contribute to its reasoning. Therefore, the respondent's arguments are not convincing.

- 4.4 Accordingly, the finding that the priorities were validly claimed was not reasoned. Since this finding is the sole possible reason presented in the decision for

disregarding the objection of lack of novelty, which, if successful would have justified the revocation of the patent, this lack of reasoning constitutes a further substantial procedural violation.

5. Point 1 of the "Reasons for the decision" of the appealed decision deals with the issue of sufficiency of disclosure and reads as follows:

"Regarding the disclosure of the invention, Opponent 2 has explained that the wording "parting portion" of claim 1 relates to an undisclosed moulding method, making it impossible for the person skilled in the art to carry out the invention. However the drawings of the application disclose a possible shape of the seal before and after installation which is enough information for carrying out the invention as required by Article 83 EPC."

- 5.1 From this paragraph it can be gathered that the opposition division was not convinced that the fact that the wording "parting portion", allegedly relating to an undisclosed moulding method, rendered the disclosure of the claimed invention insufficient. Moreover, the opposition division regarded the disclosure in the drawing of a possible shape of the seal before and after installation as sufficient information for carrying out the claimed invention consisting of a clutch release bearing.

Therefore, the logical chain of facts and reasons underlying the finding that the requirements of sufficiency of disclosure were met can be inferred from the appealed decision.

- 5.2 Appellant II contested that its submissions in respect of the wording "parting portion", the positioning of the fabrication mould and the contradictions in the description relating to interference ratio were not refuted.

A reasoned decision does not necessarily have to deal in detail with all the arguments submitted. It is normally sufficient for it to contain some reasoning on the crucial points of dispute, in order to give the losing party a fair idea of why its submissions were not considered convincing.

In the present case, it is apparent from the reasons given why the main argument relating to the wording "parting portion" did not convince the opposition division. Since this appears to have been the crucial point of dispute, the Board sees no ground for regarding the reasoning of the appealed decision as deficient in this respect.

6. Pursuant to Article 11 of the Rules of Procedure of the Boards of Appeal (Supplement to OJ EPO 1/2010, 39), when fundamental deficiencies are apparent in the first instance proceedings, the case is remitted to the first instance for further prosecution.

In the present case the first instance proceedings infringed Rule 68(2) EPC 1973 in a way which constitutes a substantial procedural violation. Since no special reasons are present in the file or have been mentioned by the parties for doing otherwise, the remittal is justified.

7. The appeals of both appellants are allowed insofar as the decision under appeal is set aside. Since the decision of the first instance clearly contravened Rule 68(2) EPC 1973, and the appellants had to appeal in order to obtain a fully reasoned decision it is equitable to reimburse their appeal fees pursuant to Rule 67 EPC 1973.

## **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 fees are reimbursed.

The Registrar:

The Chairman:

V. Commare

E. Dufrasne