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**Datasheet for the decision
of 1 June 2010**

Case Number: T 2083/08 - 3.2.01

Application Number: 97202643.9

Publication Number: 0835805

IPC: B64D 29/00

Language of the proceedings: EN

Title of invention:
Aircraft Labyrinth fire seal

Patent Proprietor:
The Boeing Company

Opponent:
AIRBUS SAS et al

Headword:
-

Relevant legal provisions:
EPC R. 103(1)(a), 116(2)
RPBA Art. 11

Relevant legal provisions (EPC 1973):
EPC Art. 113(1)

Keyword:
"Oral proceedings - right to amend (yes)"
"Procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 2083/08 - 3.2.01

D E C I S I O N
of the Technical Board of Appeal 3.2.01
of 1 June 2010

Appellant:
(Patent Proprietor)

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted 6 November 2008
revoking European patent No. 0835805 pursuant
to Article 101(2) EPC.**

Composition of the Board:

Chairman: S. Crane
Members: J. Osborne
 T. Karamanli

Summary of Facts and Submissions

- I. The appeal is directed against the decision posted 6 November 2008 revoking European patent No. 0 835 805.
- II. During oral proceedings the opposition division found that the subject-matter of a claim 11 as granted (main request) extended beyond the content of the application as originally filed. The same finding applied to corresponding claims in first to third auxiliary requests. The opposition division refused to admit fourth and fifth auxiliary requests filed during oral proceedings because it found that amendment to the respective claims 1 extended the subject-matter beyond the content of the application as originally filed.
- III. The appellant (patent proprietor) requested in a letter dated 4 March 2009 that the decision under appeal be set aside and the case remitted to the first instance for further prosecution on the basis of claims according to a main request and an auxiliary request, both filed therewith. It further requested reimbursement of the appeal fee.
- IV. In a letter dated 24 July 2009 the respondents (opponents) requested that the appeal be dismissed or in the alternative that oral proceedings be appointed.
- V. In a communication pursuant to Rule 100(2) EPC the board indicated its provisional opinion that there had been a fundamental deficiency in the conduct of the proceedings by the first instance which would justify reimbursement of the appeal fee and that it anticipated that it would remit the case to the first instance.

- VI. With a letter dated 10 March 2010 the opponents indicated that the request for oral proceedings was withdrawn on the condition that the case was remitted to the first instance as proposed by the board.

Reasons for the Decision

1. As regards the procedural steps which led to the contested decision, the following is derivable from the file:

- (i) The opponents filed an opposition on the grounds that the subject-matter of the claims was not new or did not involve an inventive step and that the subject-matter of dependent claim 11 as granted extended beyond that of the application as originally filed due to generalisation of the definition of a cut-out. In a written communication to the parties the opposition division expressed a provisional opinion that the objection of extension of subject-matter was not valid. The patent proprietor subsequently filed first to third auxiliary requests each including a respective dependent claim substantially identical to claim 11 as granted.

During oral proceedings:

- (ii) The opposition division found late-filed evidence (D3) to be highly relevant state of

the art and admitted it into the procedure. The opposition division subsequently reversed its provisional opinion in respect of the opponents' objection to claim 11 as granted regarding generalisation of the definition of a cut-out, finding that there had been an extension of subject-matter. The opposition division found the patent proprietor's main request and consequently also the first to third auxiliary requests unallowable.

- (iii) The opposition division gave the patent proprietor the opportunity to overcome the objection regarding generalisation of the definition of a cut-out by filing a new request. It further advised the patent proprietor to keep in mind, when formulating the request, that D3 had been introduced because of its relevance.
- (iv) The patent proprietor filed fourth and fifth auxiliary requests which, it seems, overcame the objection regarding generalisation of the definition of a cut-out but which, as the result of taking account of D3, included amendments in claims 1 (particularly the introduction of 'empty') which the opposition division found to lead to a new extension of subject-matter.
- (v) Due to the new objection the opposition division refused to admit the fourth and fifth auxiliary requests, consequently found

that none of the patent proprietor's requests was allowable and revoked the patent.

2. During the oral proceedings the opposition division reversed its provisional opinion regarding extension of subject-matter in a dependent claim due to a generalisation of the definition of a cut-out and gave the patent proprietor the opportunity to further amend its requests. The patent proprietor did so and apparently successfully overcame the objection since there is no further mention of it in either the contested decision or the minutes of the oral proceedings. Up to that point attention had been directed to an extension of subject-matter in claim 11 as granted and in the corresponding dependent claims according to first to third auxiliary requests. However, when formulating its fourth and fifth auxiliary requests the patent proprietor additionally made amendments to each claim 1 in response to the invitation of the opposition division to take into account D3. The introduction of the term 'empty' resulted in a second objection of extension of subject-matter. Whilst the two objections both were of extension of subject-matter, they were completely separate. The second objection arose from the opposition division's decision to introduce D3 into the procedure and to invite the patent proprietor to take account of it when filing the new request.

3. In the contested decision the opposition division cites Rule 116(1) EPC as the legal basis for not admitting the fourth and fifth auxiliary requests. Rule 116 EPC relates to the preparation of oral proceedings and the

second sentence of paragraph 1 requires the setting of a final date for making written submissions in preparation for the oral proceedings. The fourth sentence provides that "new facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed." Rule 116(2) EPC extends the provision of Rule 116(1), fourth sentence, EPC to the filing of requests by a patent proprietor. In the present case, however, the subject of the proceedings had changed by virtue of the introduction into the procedure of D3 and the opposition division's request that it be taken into account when formulating a request to overcome the first objection of extension of subject-matter. It follows that the opposition division had no discretion in accordance with Rule 116 EPC to disregard the fourth and fifth auxiliary requests in the way that it did.

4. In the first full sentence on page 8 of the decision the opposition division states as regards the introduction of 'empty' into the claims 1 that "Although the patentee must have been aware, through the objection raised by the opponent, that this expression might be objectionable as to the provisions of Article 123(2) EPC, he deliberately chose not to remove it from the claims of the auxiliary requests." This implies that the patent proprietor was given the opportunity to do so. But was that the case?

- 4.1 Study of the minutes reveals the following:

- (point 6.4) The opponents stated that the word 'empty' "seems to be present neither in the

description nor in the claims as filed and that, as a consequence, there is no support for such an amendment."

- (point 6.5) "At 11.27 the chairman of the oral proceedings interrupted the proceedings for deliberating on admissibility of requests 4 and 5."

- (point 6.6) The chairman announced that the introduction of 'empty' into the claims 1 constituted a violation of the requirement of Article 123(2) EPC and that "the auxiliary requests 4 and 5 are not admissible in application of Rule 116 EPC." The patent proprietor subsequently protested against the opposition division's actions, alleging a lack of good faith and "mentioned that his intention was actually to keep an auxiliary request with claim 1 corresponding to claim 1 of the main request and with amended claim 11". The opposition division responded that there was no lack of good faith because "the proprietor had been given the opportunity to file five auxiliary requests" and because the opposition division could have come to a final decision without permitting the patent proprietor to file them.

4.2 It is apparent from the above extract from the minutes that, contrary to the opposition division's statement in the contested decision, the patent proprietor did not deliberately choose not to remove the term 'empty' in response to an objection that it extended subject-matter. On the contrary, the opposition division did not give the patent proprietor an opportunity to file a further request. The opposition division was wrong to

refuse to admit the fourth and fifth auxiliary requests on the ground that they resulted in a new objection under Article 123(2) EPC without giving the patent proprietor the opportunity to file a further request which, as may be derived from the minutes, clearly would have been allowable under Article 123(2) EPC and formed a basis for a detailed discussion on novelty with respect to D3.

5. In the light of the foregoing the board finds that the opposition division infringed the patent proprietor's right to be heard (Article 113(1) EPC 1973), thereby committing a substantial procedural violation which amounts to a fundamental deficiency. Moreover, by failing to give the patent proprietor an opportunity to overcome the new objection the opposition division left the patent proprietor with no option but to appeal. The actions of the opposition division as considered above therefore also justify reimbursement of the appeal fee in accordance with Rule 103(1)(a) EPC.

6. In accordance with Article 11 RPBA (OJ EPO 2007, 536-547) a case shall be remitted to the first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. No such special reasons are present in this case.

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 to be reimbursed.

The Registrar:

The Chairman:

D. Sauter

S. Crane