

Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen
(D) No distribution

**Datasheet for the decision
of 25 October 2012**

Case Number: T 0366/11 - 3.2.04

Application Number: 02790223.8

Publication Number: 1412641

IPC: F04D 29/32, F04D 29/52

Language of the proceedings: EN

Title of invention:
Ventilation unit

Patentee:
SPAL Automotive S.r.l.

Opponent:
ebm-papst Mulfingen GmbH & Co. KG

Headword:
-

Relevant legal provisions:
EPC Art. 113(1)
RPBA Art. 11

Keyword:
"Right to be heard - opposition procedure - violation (yes)"
"Principle of equal treatment - opportunity to respond to
amendments" (reasons 2, 3.4, 3.6 to 3.8)

Decisions cited:
-

Catchword:
-



Case Number: T 0366/11 - 3.2.04

DECISION
of the Technical Board of Appeal 3.2.04
of 25 October 2012

Appellant: ebm-papst Mulfingen GmbH & Co. KG
(Opponent) Bachmühle 2
D-74673 Mulfingen (DE)

Representative: Solf, Alexander
Patentanwälte Dr. Solf & Zapf
Candidplatz 15
D-81543 München (DE)

Respondent: SPAL Automotive S.r.l.
(Patent Proprietor) Via per Carpi, 26/B
D-42015 Correggio (Reggio Emilia) (IT)

Representative: Lanzoni, Luciano
Bugnion S.p.A.
Via di Corticella, 87
I-40128 Bologna (IT)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
15 December 2010 concerning maintenance of
European patent No. 1412641 in amended form.

Composition of the Board:

Chairman: A. de Vries
Members: P. Petti
C. Heath

Summary of Facts and Submissions

I. With letter dated 16 February 2011, the appellant (opponent) filed an appeal against the decision of the opposition division dated 15 December 2010 concerning the amended form in which European Patent Nr. 1412641 could be upheld, and simultaneously paid the appeal fee. The statement of the grounds of appeal was received 15 April 2011.

The opposition had been filed against the patent as a whole based among others on Article 100(a) in combination with Articles 54 and 56 EPC for lack of novelty and inventive step in view of inter alia the following documents:

D1: DE-A-1 428 034

In an annex to summons to oral proceedings issued on 2 June 2010, the opposition division communicated its preliminary opinion that the cited prior appeared prejudicial to both novelty and inventive step.

Prior to the oral proceedings the opponent, with two letters received on 5 and 9 October 2010 respectively, filed new documents as further evidence of lack of novelty against the granted claims. These include :

D6: DE-A-1 488 640

D7: US-A-3 385 516

D8: DE-A-969 793

D9: DE-A-1 106 853

Almost at the same time, with letter received 7 October 2010, the patentee submitted new main and auxiliary requests directed at amendments to the granted claims.

Oral proceedings before the opposition division took place on 8 November 2010. According to the minutes, section 4, admissibility of the new documents D6 to D9, then, section 5, admissibility of the new requests were discussed. As recorded there the opposition division decided not to admit the new documents but to admit the new requests. It subsequently held that the patent could be maintained in amended form according to the main request. The reasons are set out in detail in its written decision.

II. With the appeal the appellant (opponent) takes issue with the decision to admit the new requests but not the new documents, as well as the findings regarding patentability. He requests as main request that the decision under appeal be set aside and that patent revoked, as an auxiliary request that the case be remitted to the first instance and the appeal fee be reimbursed by virtue of a substantial procedural violation, and that documents D6 to D9 be admitted into the proceedings. Admission of D7 is no longer sought.

The respondent (patentee) requests that the appeal be dismissed, in the alternative that the patent be maintained based on one of the auxiliary requests 1 and 2 filed on 7 October 2010, in the alternative that the case be remitted to the first instance in the event that at least one of documents D6 to D9 is admitted into the proceedings.

III. Oral proceedings before the Board were held on 25 October 2012.

IV. The appellant argued as follows:

D6 to D9 should already have been admitted on formal grounds, as they were cited against the newly filed claims, even though they were originally filed against the granted claims. These newly filed claims contained elements from the description, and accordingly could not have been anticipated by the opponent. The documents D6, D8 and D9 are highly relevant particularly when compared to the new main request. D6 shows the added features of a frame with central sleeve and centrifugal force as well as the other features of claim 1 of the main request. D8 is also highly relevant and also novelty-destroying for the main request. D9 is relevant for inventive step. By not admitting these documents the opposition division severely curtailed the opponent's right to be heard and thereby committed a substantial procedural violation.

The respondent argued as follows:

The documents were clearly filed against the granted claims and not as a reaction to the amended claims. The amendments on the other hand directly address points raised in the opposition division's provision opinion and were foreseeable. The opponents had sufficient time to argue the relevance of the late-filed documents. In any case D6 is not relevant, as its teaching cannot be carried out because of serious discrepancies between drawings and description. D8 and D9 are even less relevant.

V. Claim 1 as *granted* reads as follows:

"A ventilation unit (1) of the type comprising an electric motor (4), the output shaft (5) of which is fitted with a fan (3) having a cup-shaped central body (11) and a number of blades (15); said central body (11) being defined by a base wall (12), and by an annular wall (13) from whose outer face said blades (15) extend; and said ventilation unit (1) being characterized in that at least one through window (25) is formed in said annular wall (13) to channel cut, in use, any condensate formed inside said central body (11)."

Claim 1 of the *main request* reads as follows:

"A ventilation unit (1) of the type comprising a frame (2) having an annular wall (6), a central sleeve (7) coaxial with the annular wall (6) and a number of ribs (8) connecting the outer face of the central sleeve (7) with the inner face of the annular wall (6), an electric motor (4), the output shaft (5) of which is fitted with a fan (3) having a cup-shaped central body (11) and a number of blades (15); said central body (11) being defined by a base wall (12), and by an annular wall (13); characterized in that said annular wall (13) of the central body (11) extends from the base wall (12) towards said sleeve (7), wherein said blades (15) extend from the outer face of the annular wall (13), and at least one through window (25) is formed in said annular wall (13) of said central body (11) of the fan (3) to channel out, in use, any condensate formed inside said central body (11) by the centrifugal force

to which the condensate is subjected by rotation of said fan (3)."

Claim 1 of the auxiliary requests adds further features to claim 1 of the main request. The exact wording of these claims is not important to the present decision.

Reasons for the Decision

1. The appeal is admissible.
2. *Legal Framework*

The fundamental principle of equal treatment that underpins proceedings before the EPO and the right to be heard as enshrined in Article 113(1) EPC require that in inter partes proceedings a party be given equal opportunity to react to actions of the other party, see e.g. Singer Stauder, *Europäisches Patentübereinkommen*, 5. Auflage, Article 113, note 44. Thus, late filing (of new evidence) may be justifiable in reaction to developments in the proceedings, such as for example unforeseeable amendments by the proprietor, see the Case Law of the Boards of Appeal, 6th edition, 2010 (CLBA hereinafter), section VII.C.1.5, first two paragraphs, and the case law cited therein. Indeed, where a proprietor files amendments in timely response to summons to oral proceedings and which have the result that a new document becomes relevant it is recommended practice to allow an opponent to present this document in reaction, see the Guidelines (edition of June 2012), E-II.8.6., 2nd paragraph. In summary, an opponent must be given an opportunity to respond in an

appropriate way when the subject of proceedings has changed, for example due to amendment. Depending on the nature of the amendment this may involve the filing of further documents.

3. *Substantial Procedural Violation*

3.1 In the case at hand, the appellant-opponent in the lead-up to oral proceedings before the opposition division filed new documents D6 to D9 in two submissions on 5 and 8 October 2010. Both were filed on or before the deadline for filing submission set in the summons. In the accompanying letters the Appellant cited these documents in new attacks against the granted claims then on file.

3.1.1 Almost concurrently the respondent proprietor on 7 October 2010 filed new main and auxiliary requests. Whereas granted claim 1 was directed at a ventilation unit with a fan with cup-shaped central body and connected blades and at least one through window in the annular walls of the central body for channelling out condensate, the new requests added features of an external frame with an annular wall, a central sleeve and connecting ribs, with the annular wall of the fan central body extending from its base wall to the central frame of the sleeve, and of the condensate being channelled out due to centrifugal force when the fan rotates.

3.1.2 At the oral proceedings, the opposition division chose to first discuss admissibility of D6 to D9, deciding not to admit them. The division reasoned, see its written decision, reasons 2, first paragraph, that

these documents were "prima facie not more relevant than documents D1-D5". In the following paragraphs it then summarized each document's contents in relation to the features of granted claim 1, in particular the central features of openings in the annular wall of the fan's central body. D6 and D7 were not found to have this feature, while D8 and D9 were not seen to relate to a ventilation unit but were in a different technical field. No mention is made of any of the features added to claim 1 of the new main or auxiliary requests. Clearly, the division assessed prima facie relevance of D6 to D9 in relation to the granted claim 1 then still on file.

3.1.3 Subsequently, it discussed admissibility of the new requests and decided to admit them, as recorded in sections 4 and 5 of the minutes. This would have been unobjectionable but for the fact that the appellant-opponent had expressly stated at the oral proceedings that he was now citing D6 to D9 against the new requests: point 4.1 of the minutes records: "OPP argues that D6-D9 are admissible due to the newly filed main request and auxiliary requests from PRO, where new subject-matter has been introduced into the claims from the description.... " and again at point 4.5: "OPP repeats that new features were introduced".

3.1.4 After the new requests had been admitted and the discussion had moved on to inventive step, the appellant opponent made a further attempt to introduce D6 to D9: the minutes duly record at section 9.6 : "OPP ... also considers that novelty of claim 1 is not fulfilled in view of documents D6 and D9 and requests that this statement is minuted". The opposition

division denied this attempt stating, point 9.7 of the minutes: "CH reminds the OPP that documents D6-D9 are not part of the file and hence no novelty objections on the basis of D6-D9 had been validly brought in the opposition procedure".

3.2 D6 to D9 may thus have been originally cited against the granted claims, it is clear from the above that at the first instance oral proceedings the appellant-opponent decided to cite these documents in response to the new requests, which he had received shortly before the proceedings. He did so in particular as he believed these documents to be more pertinent than those already on file for the features added to claim 1 in the new requests, as is clear from the minutes, points 4.1, 4.5 and 9.6 cited above.

3.3 The Board notes that the amendments made to claim 1 in the new main and auxiliary requests are by no means trivial or insignificant. More importantly, the appellant-opponent could not reasonably have foreseen them.

3.3.1 As stated, the new main and auxiliary requests added new features to claim 1 that pertain to an external frame with annular wall, central sleeve and connecting ribs, the relative position of the fan central body and the external frame, as well as condensate being channelled out due to centrifugal force when the fan rotates.

As indicated in the accompanying letter of 7 October 2010, section 4.1, the respondent-proprietor included these features to better distinguish the claimed

ventilation unit from that of D1 cited in the opposition grounds. He was reacting to the provisional finding of the opposition division in section 3 of the annex to the summons, dated 11 June 2010, that the ventilation unit of D1 appeared to fall within the terms of granted claim 1, taking away novelty. The new features were thus intended to establish novelty. They were thus clearly substantial amendments to the claimed subject-matter.

3.3.2 However, rather than being based on dependent claims, which together with the independent claims define the exclusive rights that are the object of an opposition, they derive from the description. Section 1.2 of the accompanying letter cites paragraphs [0012], [0013] and [0017] of the specification as basis. As the description is not the main focus of an opposition, and it moreover contains a wealth of detail it is difficult if not impossible for an opponent to foresee amendments deriving from the description.

Nor was there any hint in the annex to the summons of the opposition division that exactly those parts of the description, or those specific features should play a role in the discussion on novelty vis-à-vis D1. Section 3 of the annex of 11 June 2010 identifies as central to novelty the question of how to interpret the features in granted claim 1 of the base and annular wall of the fan central body. There is no suggestion, let alone mention, of the external frame or its role in the unit. In conclusion the amendments could not reasonably have been foreseen.

3.4 Confronted with amendments filed shortly before oral proceedings that were significant and could not reasonably have been foreseen by the opponent, the opposition division had the discretion to take two possible courses of action. The first was to *not* admit the amendments, exactly because the opponent could not have reasonably foreseen the amendments, and continue the proceedings on the basis of the claims then on file, namely the granted claims.

It chose not to follow this route but to rather admit the requests. In this case, however, the principles of equal treatment and the right to be heard required that the opposition division should then afford the appellant opponent a fair opportunity of responding in an appropriate manner to what were objectively speaking, unforeseeable amendments. Here, according to established jurisprudence and best practice as summarized above, an appropriate response could mean adducing new evidence. This indeed is how the opponent responded, when he stated at the oral proceedings that he wished to cite D6 to D9 against the new requests.

3.5 The appellant opponent cited D6 to D9 in particular because he considered these documents to disclose all or some of the added features. A cursory examination of these documents confirms this view. They are all indisputably concerned with electrically driven cooling fan units.

3.5.1 Figures 1 and 2 of D6 show a fan 10 with a cup-shaped hub 12 having a base 13 and an annular wall 14 set within an external frame with annular wall 44, central sleeve 52 and connecting ribs 48. The central hub 12

moreover has what appear to be openings 26 where base and walls meet, similar to the placement of the windows 25 in figures 2 and 4 of the contested patent.

That the teaching of D6 might be so deficient as not to be realizable is not immediately apparent to the Board from the cursory inspection necessary to determine whether its citation is an appropriate response.

- 3.5.2 D7, see figures 5 and 6, also shows a frame 10 surrounding bladed fan 16.
- 3.5.3 The passages of D8 cited by the appellant opponent in the accompanying letter of 9 October 2010, page 1, lines 12 and 13, and figure 1, page 2, lines 69 to 92, 116 and 117 refer to the use of centrifugal force to expel water in a motor that can be used for a fan.
- 3.5.4 D9, finally, shows a similar arrangement of an electric motor with surrounding fan unit 10 with airing holes at 10, see also cited passage in column 2, lines 41 and 42.
- 3.5.5 Upon cursory inspection the Board thus finds D6 to D9 to be relevant to the added features. It considers their citation to thus constitute an appropriate response to the amendments.
- 3.5.6 In this regard it is irrelevant that D6 and D9 had originally been cited against the granted claims and before the appellant opponent could have known of the amendments. Once the amendments had been admitted it was his prerogative under the principle of equal treatment and the right to be heard to adduce evidence of his choice in formulating an appropriate response.

That he should choose to rely on the same documents he had belatedly submitted against the granted claims, as these by chance also happened to be relevant to the added features, cannot change this fact.

3.6 As the appellant-opponent's citation of D6 to D9 is seen to constitute an appropriate response to substantial amendments to claim 1 that were not reasonably foreseeable, the opposition division's final refusal during the discussion of inventive step of the amended claim 1 (points 9.6 and 9.7 of the minutes, see above) to consider these documents deprived the appellant-opponent of the opportunity to respond in an appropriate manner to the amendments. This refusal severely limited his ability to react to these unforeseeable amendments. In a manner of speaking the appellant-opponent was made to fight with his hands tied behind his back. This violated both the principle of equal treatment of parties and the appellant-opponent's right to be heard. This violation of fundamental procedural principles is a substantial procedural violation that has seriously flawed the procedure and prejudiced its outcome. It justifies a remittal to the first instance and the reimbursement of the appeal fee, Article 11 of the Rules of Procedure of the Boards of Appeal and Rule 103(1) (a)EPC.

3.7 The Board adds that an opposition division, naturally, must have some discretion in the way it conducts oral proceedings, this in particular if it wishes to hear the parties on all decisive issues in as efficient a manner as possible. It is therefore not wrong in principle to decide the admissibility of new documents prior to discussing the admissibility of new claims.

This would be the case, for example, if new documents are cited exclusively against the claims then on file (say, the granted claims) or, alternatively, if the amendments do not result in significant changes in the claimed subject-matter. In that case admissibility could be decided on the basis of the documents' prima facie relevance to the claimed subject-matter in accordance with well-established practice. Nor can this approach be faulted if the amendments in question are then subsequently not admitted.

- 3.8 In the present case, however, in order to safeguard the appellant-opponent's rights, once he had cited D6 to D9 also against the proposed substantial amendments the opposition division should have first discussed the admissibility of the amendments. Only once that issue had been decided, would it have been clear in which context - that of the granted or the amended claims - admissibility of the documents could be discussed. Here the Board notes that documents that have limited relevance to an initial set of claims may acquire new relevance as a result of subsequent amendments to those claims. A document's relevance is thus not an absolute; (for the purpose of admissibility) it should normally be decided relative to the amended claims against which it is cited.

4. Further procedure

To expedite the procedure and given the prima facie relevance of D6, D8 and D9 to the amended claims of the main request that the opposition division admitted into the proceedings and ultimately held allowable, the Board exercises the powers of the first instance under

Article 111(1) EPC and admits these documents into the proceedings. The appellant-opponent no longer requests admission of D7 and this document can be disregarded. Further prosecution of the case should consider all outstanding issues raised by the appellant-opponent in view of the prior art of D6, D8 and D9, in particular novelty and inventive step, as well as any issues that may arise in connection with amendments made.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar

The Chairman

G. Magouliotis

A. de Vries