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**Datasheet for the decision  
of 29 May 2018**

**Case Number:** T 2340/13 - 3.5.03

**Application Number:** 02019725.7

**Publication Number:** 1398677

**IPC:** G05B19/042

**Language of the proceedings:** EN

**Title of invention:**

Modular control system for a glass forming machine

**Patent Proprietor:**

futronic GmbH

**Opponent:**

Siemens Aktiengesellschaft

**Headword:**

Modular control system/FUTRONIC

**Relevant legal provisions:**

EPC Art. 111(1)  
EPC R. 103(1)(a), 111(2)  
RPBA Art. 11

**Keyword:**

Substantial procedural violation (yes)

Reimbursement of appeal fee (yes)

Remittal (yes)

**Decisions cited:**

T 0094/84, T 0358/10, T 1843/11, T 2352/13

**Catchword:**



**Beschwerdekammern**  
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Case Number: T 2340/13 - 3.5.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.03**  
**of 29 May 2018**

**Appellant:** Siemens Aktiengesellschaft  
(Opponent) Werner-von-Siemens-Straße 1  
80333 München (DE)

**Respondent:** futronic GmbH  
(Patent Proprietor) Tolnauerstr. 3-4  
88069 Tettnang (DE)

**Representative:** Hoffmann Eitle  
Patent- und Rechtsanwälte PartmbB  
Arabellastraße 30  
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**Decision under appeal:** Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
17 September 2013 concerning maintenance of the  
European Patent No. 1398677 in amended form.

**Composition of the Board:**

**Chairman** F. van der Voort  
**Members:** T. Snell  
P. Guntz

## **Summary of Facts and Submissions**

- I. This case concerns an appeal filed by the opponent against the interlocutory decision of the opposition division which held that, account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates met the requirements of the EPC, "especially those regarding Articles 123(2), 52(1), 54(1) and (2) and 56 EPC".
- II. In the statement of grounds of appeal, the opponent (henceforth, "appellant") requested that the decision under appeal be set aside and that the patent be revoked in its entirety. The appellant argued on the basis of Articles 123(2) and (3) (amendments), 84 (clarity) and 52(1) EPC (novelty and inventive step).
- III. In support of its case for revocation based on the grounds of lack of novelty and inventive step, the appellant filed new documents D19 to D30 with the statement of grounds of appeal.
- IV. In a reply to the statement of grounds of appeal, the patent proprietor (henceforth, "respondent") requested that the appeal either be held inadmissible or be dismissed, i.e. that the patent be maintained in amended form in the version held allowable by the opposition division on the basis of the claims filed with the letter dated 24 May 2012. The respondent requested further that documents D19 to D30 be not admitted.
- V. Both parties conditionally requested oral proceedings.

VI. The board sent a communication in which it gave the following preliminary opinion:

(i) the appeal was admissible; and

(ii) in view of the particular circumstances applying in this case (as will be discussed below in the reasons for the decision), the board considered that remittal of the case for further prosecution would be appropriate and equitable, thereby leaving it to the opposition division to give a first decision in respect of the objections pursuant to Articles 123(3) and 84 EPC, to decide whether or not to admit one or more of documents D19 to D30 newly filed by the appellant (subject to the board itself not holding D19 to D30 inadmissible), and, where appropriate, to decide on novelty and inventive step.

The board requested the parties to clarify the circumstances in which the conditional requests for oral proceedings should apply in view of the board's preliminary opinion.

VII. In a letter dated 8 March 2018, the appellant stated that oral proceedings were not requested in the case that the board of appeal were to hold the appeal admissible and to remit the case to the opposition division. The appellant stated, inter alia, that remittal was appropriate in view of "substantial procedural violations", referring to the board's provisional opinion.

VIII. In a letter dated 19 March 2018, the respondent withdrew the request for oral proceedings and stated that "It is now expected that the case will be remitted to the first instance before the Opposition Division."

- IX. In view of the board's decision, there is no need to reproduce the wording of any claim.

### **Reasons for the Decision**

1. *Admissibility of the appeal*

1.1 The respondent argues that the appeal is inadmissible due to a lack of an adequate substantiation. In this respect, the respondent argues firstly that there is no analysis in detail vis-à-vis the main reasons given in the contested decision and secondly that the appellant "puts on the table a completely fresh case", based on new documents.

1.2 However, the board points out that in accordance with case law, an appeal is not inadmissible merely because it is based on a fresh case, in particular when it concerns the same ground for opposition (here, novelty and inventive step; cf. Case Law of the Boards of Appeal, 7th edition (this being the edition cited by the respondent), page 964, section 2.6.5, or 8th edition, page 1103, section 2.6.5). That however does not preclude the appellant's "fresh case" based on new prior art from being held inadmissible having regard to Article 12(4) RPBA (as will be discussed below); however, that is not a matter concerned with the admissibility of the appeal as such but with the examination of the appeal. In any case, the board considers the appeal to be admissible since it is also based on other grounds (infringement of Articles 123(3) and 84 EPC) for which a substantiation is provided. In particular, it is stated in the decision that compliance with, *inter alia*, Article 123(3) EPC "was

discussed in detail" (see point VI of the Summary of facts and submissions). At least the objection pursuant to Article 123(3) EPC is therefore apparently not based on a fresh case and this ground alone thus suffices to render the appeal as a whole admissible.

2. *Scope of the appeal*

2.1 It follows from Articles 12(2) and 12(4) RPBA that the board need only take into account those parts of the appeal for which a proper substantiation within the meaning of Article 12(2) RPBA is contained in the statement of grounds of appeal. In accordance with case law, a simple reference to submissions in the first instance proceedings does not normally suffice (cf. Case Law of the Boards of Appeal, 8th Edition, page 1102, paragraph 2.6.4 a)).

2.2 In the statement of grounds of appeal, the appellant gives no explicit reasons dealing with those parts of the decision concerned with compliance with Article 123(2) EPC (added subject-matter) and Article 52(1) EPC (novelty/inventive step) in the light of the disclosures of documents D1 to D18. With respect to novelty and inventive step, D2 to D18 are not mentioned at all, and, as regards D1 (either alone or in combination with D20), the appellant relies on a general reference to arguments set out in the notice of opposition (cf. page 20, lines 5-13 and page 24, point 11). In respect of Article 123(2) EPC, the appellant also only makes a general reference to arguments set out in the notice of opposition regarding features M5 and M6 (cf. page 8, point 4). As pointed out above, such general references do not suffice to substantiate the objections within the meaning of Article 12(2) RPBA. Consequently, objections based on the disclosures

of D1 to D18 as well as on Article 123(2) EPC are not relevant to the proceedings and do not require any further comment.

2.3 It follows that the substantive issues relevant to the present appeal proceedings concern compliance with Articles 123(3) and 84 EPC, and novelty and inventive step with respect to documents D19 to D30.

3. *Substantial procedural violations*

3.1 The board notes that the decision was announced at the oral proceedings which took place on 26 June 2012. The minutes were however not issued until 24 July 2013, i.e. more than one year later, and the impugned decision itself is dated 17 September 2013. The board notes that in another case, namely T 358/10, a lengthy time between the oral proceedings and the issuing of the minutes and the written decision was regarded as a substantial procedural violation (cf. point 5.1 of the reasons), albeit the times taken in case T 358/10 were somewhat longer (19 and 22 months respectively). In the present case, even if this delay by itself were not considered to be a substantial procedural violation, it plausibly contributed to other procedural violations, as explained below.

3.2 The board notes that in the present case there is a discrepancy between what is stated in the "Summary of facts and submissions" of the written decision, where it is stated in point VI that, *inter alia*, Article 123(3) EPC was discussed in detail and that the opposition division announced that the request on file satisfied the requirements of, *inter alia*, Article 123(3) EPC, and the minutes, which although very detailed, do not mention any discussion concerned with



Article 123(3) EPC. Neither is there any discussion of this matter (i.e. extension of the scope of protection) in the "Grounds for the decision", except that the title above point 3 reads "*Added subject-matter (Articles 100(c), 123(2), 123(3) EPC)*". Evidently, if the matter had been discussed, the opposition division should properly have given an indication thereof in the minutes and indicated in the decision whether and why Article 123(3) EPC was regarded as being complied with. The fact that it is not known what, if anything, was discussed on this matter at the oral proceedings is now all the more problematic as Article 123(3) EPC is one of the issues forming part of the appellant's case. The board can only speculate as to whether the absence of any reasoning with respect to Article 123(3) EPC was due to the very long time taken in issuing the minutes and the written decision. In any event, the omission of any reasons in respect of Article 123(3) EPC is not only a violation of Rule 111(2) EPC (decision inadequately reasoned) but also of Article 113(1) EPC, since the right to be heard also guarantees that arguments put forward and relevant to the decision to be taken are actually taken into consideration, which cannot be verified with regard to the opponent's arguments concerning Article 123(3) EPC (see T 1843/11, point 5.6 of the reasons and T 94/84 (OJ EPO 1986, 337) and the summary of relevant case law in T 2352/13, point 2.3 of the reasons). This is a substantial procedural violation within the meaning of Rule 103(1) (a) EPC.

4. *Admissibility of D19 to D30*

- 4.1 In accordance with Article 12(4) RPBA, the board has the power to hold inadmissible facts, evidence or requests which could have been presented in the first

instance proceedings. In the case at hand, the question arises if the appellant should not have submitted the new documents D19 to D30 at the latest as a reaction to the communication of the opposition division dated 29 March 2012 and whether by not submitting them during the opposition proceedings, the opposition division was deprived of a chance to render a decision on their admission and their evaluation with respect to novelty and inventive step. The board is therefore empowered to not admit these documents which have been filed for the first time with the statement of grounds of appeal, and on which the appellant's case in respect of novelty and/or inventive step relies. However, as the case is to be remitted (see below) due to fundamental deficiencies of a procedural nature, the board sees no reason to prejudge the issue of the admissibility of the documents D19 to D30, and therefore leaves this matter to the discretion of the opposition division.

5. *Remittal*

5.1 In accordance with Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. No such special reasons present themselves in the present case. On the contrary, if the board were to proceed to substantive examination of the outstanding issues (i.e. compliance with Articles 123(3) and 84 EPC and novelty and/or inventive step with respect to the disclosures of the documents D19 to D30, should any of these documents be admitted), it would be examining matters which have not been considered in the impugned decision. Thus, the proprietor would face the risk of the patent being revoked after only one instance of jurisdiction with

respect to these matters. Furthermore, both parties are in agreement with remittal. The board therefore exercises its discretion under Article 111(1) EPC to remit the case to the opposition division.

6. *Reimbursement of the appeal fee*

According to Rule 103(1)(a) EPC, the reimbursement of the appeal fee shall be ordered where the board deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation. It follows that the appeal fee is to be reimbursed.

## 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 on the basis of the claims filed with the letter dated 24 May 2012.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



M. Cañueto Carbajo

F. van der Voort

Decision electronically authenticated