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**Datasheet for the decision
of 28 September 2017**

Case Number: T 0763/15 - 3.2.01

Application Number: 08160187.4

Publication Number: 2143602

IPC: B60S1/40, B60S1/34

Language of the proceedings: EN

Title of invention:

A windscreen wiper device

Patent Proprietor:

Federal-Mogul S.A.

Opponent:

Valeo Systèmes d'Essuyage

Headword:

Relevant legal provisions:

EPC Art. 54(1), 111, 113(1), 116

RPBA Art. 11

EPC R. 103(1) (a)

Keyword:

Novelty - main request (no)

Right to be heard - substantial procedural violation (yes)

Remittal to the department of first instance - (yes)

Reimbursement of appeal fee - (yes)

Decisions cited:

G 0003/14, R 0003/10

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 0763/15 - 3.2.01

D E C I S I O N
of Technical Board of Appeal 3.2.01
of 28 September 2017

Appellant: Federal-Mogul S.A.
(Patent Proprietor) Avenue Champion
6790 Aubange (BE)

Representative: Hooiveld, Arjen Jan Winfried
Arnold & Siedsma
Bezuidenhoutseweg 57
2594 AC The Hague (NL)

Respondent: Valeo Systèmes d'Essuyage
(Opponent) 8, rue Louis Lormand
78321 Le Mesnil-Saint-Denis (FR)

Representative: Ex Materia
41, boulevard Vauban
78280 Guyancourt (FR)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 20 February
2015 revoking European patent No. 2143602
pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman G. Pricolo
Members: W. Marx
P. Guntz

Summary of Facts and Submissions

- I. The appeal is directed against the decision of the opposition division revoking the European patent No. 2 143 602.
- II. In its decision the opposition division held *inter alia* that the subject-matter of claim 1 as granted and the subject-matter of claim 1 of auxiliary request 1 filed on 5 November 2014 was not new in view of document E5 (DE 100 40 129 A1).
The second auxiliary request 2 filed on 5 November 2014 was not admitted for raising new questions linked to Article 123(2) and Article 83 EPC and for not being an attempt to overcome the ground for opposition against auxiliary request 1 (Rule 80 EPC). Further auxiliary requests 3 to 5 filed on 5 November 2014 were not admitted for raising *prima facie* new questions linked to Article 123(2) and Article 84 EPC and thus contradicting the requirements of Rule 80 EPC.
As one of the combined features in claim 1 of the new auxiliary requests 2 and 3 filed during oral proceedings on 9 December 2014 originated from the description, the opposition division took the view that the new combination of features raised a problem under Article 84 and Article 123(2) EPC. For these reasons, both auxiliary requests filed during oral proceedings were not admitted into the proceedings.
- III. Oral proceedings before the board took place on 28 September 2017.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance or, in the alternative, that the patent be maintained as granted

or in amended form on the basis of one of 1st to 2nd auxiliary requests as filed with the letter of 2 August 2017 or of 3rd to 7th auxiliary requests as filed with the grounds of appeal on 25 June 2015.

The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 as granted reads as follows:

"A windscreen wiper device (1), particularly for automobiles, comprising an elastic, elongated carrier element, as well as an elongated wiper blade (2) of a flexible material, which can be placed in abutment with a windscreen to be wiped, which wiper blade (2) is of the flat blade type and includes at least one groove (3), in which groove (3) a longitudinal strip (4) of the carrier element is disposed, wherein said windscreen wiper device (1) further comprises a mounting head (8) for transferring a reciprocal movement to said wiper blade (2), **characterized in that** said windscreen wiper device (1) further comprises a connecting device (7) for detachably connecting said wiper blade (2) directly to said mounting head (8), wherein said connecting device (7) is positioned near one end of said wiper blade (2), wherein said connecting device (7) comprises at least one resilient tongue (10) engaging in a correspondingly shaped hole (11) provided in said mounting head (8), and wherein said resilient tongue (10) is movable between a outward position retaining said wiper blade (2) onto said mounting head (8) and an inward position releasing said wiper blade (2) from said mounting head (8)."

V. The appellant's submissions in as far as they are relevant to this decision may be summarised as follows:

The subject-matter of granted claim 1 was distinguished from the disclosure of E5 by the following two features (i) and (ii):

- (i) "a connecting device (7) for detachably connecting said wiper blade (2) directly to said mounting head (8)":

The term "mounting head" in the field of windscreen wipers had a well-defined and clear technical meaning for the skilled person, namely a head directly mounted on a drive shaft for transferring a reciprocal movement to a wiper blade (see patent specification, paragraphs [0007], [0013], [0017]). An expert declaration (see annex 4 of grounds of appeal) explained in detail the technical meaning of this term, and in line with this declaration the term "mounting head" was indeed found in numerous patent specifications, in patent classifications, in court cases and on the market (annexes 5-10 of the grounds of appeal). In each of these cases, a mounting head was the unit directly connected to the drive shaft and not a system of movable parts according to the interpretation of the opposition division. The gist of the present invention was (see column 1, lines 55 ff) to refrain from the use of an intermediate oscillating arm, thereby avoiding an articulation between the oscillating arm and the wiper blade, as well as between the mounting head and the oscillating arm. It would thus be contrary to this teaching to interpret in document E5 a combination of a mounting head and an (intermediate) wiper arm as a mounting head. The skilled person looking at E5 would identify part 2 due to its length as an arm, irrespective of

whether it was formed integral with part 4 (as suggested in paragraph [0028]) or not, so the connecting device 17 in E5 was not directly connected to the mounting head 4. In case that parts 2 and 4 were formed in one piece, only the end portion of this integral part represented the mounting head.

(ii) "said connecting device (7) comprises at least one resilient tongue (10) engaging in a correspondingly shaped hole (11) provided in said mounting head (8)":

This issue was not new but had been discussed before the first instance (see minutes, page 4). Figure 7 of E5 did not show a bayonet-connection as clearly claimed. Part 64 in E5 was an actuating part going through hole 67 and was only received in this hole with some space so that it moved freely (in view of the rotational movement of the tongue when pushing down part 64; see paragraph [0044]: "gut zugängliche Aussparung"), but there was no engagement as claimed. The term "engaging" required an interlocking or meshing relationship implying an engaging contact, not a part residing in a void, which was not directly and unambiguously disclosed. Such interpretation was supported by the contested patent, according to which the resilient tongue was snapping/clipping into the hole (column 2, line 16; or column 5, line 13, also reciting a bayonet-connection), which holes enhanced the retention of the connection device onto the mounting head (see column 3, paragraph [0014]). Claim 1 specified "retaining said wiper blade (2) onto said mounting head (8)", i.e. suggested a firm interlocking and excluded any play around the whole circumference of the hole, since otherwise the tongue got loose. The push button 64 in E5 was only used to activate and

deactivate the locking of the tongue, whereas the actual locking (with form-fit; paragraph [0045]) occurred between the flexors and the tongue.

During the oral proceedings the patentee's interest in defending its case had been seriously damaged (as set out in a complaint to the director of the opposition division filed the day after the oral proceedings; furthermore, a request for amendment of the minutes had been refused - annexes 1-3 of the grounds of appeal). The chairman had declared that remaining auxiliary requests 2 to 5 were inadmissible, without having allowed to discuss them or to comment on the grounds of inadmissibility, thus violating a party's fundamental right (**procedural violation 1**). Moreover, the patentee was subsequently not allowed to properly defend its case because it was allowed to file only one new request as a final chance (**procedural violation 2**). When filing after the lunch break new second and third auxiliary requests (a simple combination of the requests already on file and adapted in line with the objections and a hint of the opposition division), the opponent introduced a new clarity objection. The allegedly unclear feature remained unchanged in comparison to the requests already on file, i.e. this objection was also applicable to at least the second auxiliary request as filed in preparation to the oral proceedings. The newly filed requests did therefore not introduce "new problems", nor did they include unforeseen new amendments. The clarity objection was a new attack and easy to remedy. However, the patentee was not given the opportunity to react correspondingly by way of an amendment (not only arguments), i.e. to file a slightly adapted request, which resulted in the chairman deciding to revoke the patent on the basis of lack of clarity (**procedural violation 3**).

Thereby, the patentee's right to be heard and the general principle of "equality of arms" had been violated.

Amended claim 1 of the first auxiliary request filed with the grounds of appeal (actual auxiliary request 3) corresponded to amended claim 1 of the second auxiliary request dated 5 November 2014, with the difference that the elastic, elongated carrier element, i.e. the longitudinal strip, was now defined as being part of the wiper blade in response to the alleged clarity issue in paragraph 5.2 of the contested decision. The connecting device detachably connected the wiper blade directly to the mounting head, while the connecting device itself was connected to the longitudinal strip. In fact, all new requests filed with the grounds of appeal were amended in view of a new clarity issue raised in opposition proceedings.

New first and second auxiliary requests were filed on 2 August 2017, since neither the opponent nor the patentee had realised thus far the relevance of paragraph [0028] of document E5 (could be interpreted as: mounting head 5 in one piece with the wiper arm 2). This new fact justified in the interest of the patentee and the public that the new requests were admitted and evaluated. Amended claim 1 of the new first auxiliary request corresponded to claim 1 as granted with the added feature that the connecting device with said wiper blade was retained onto or released from said mounting head, whereas in E5 the connecting element always stayed on the wiper arm. Amended claim 1 of the new second auxiliary request additionally defined the longitudinal strip as being part of the wiper blade in response to the alleged clarity issue in the contested decision.

VI. The respondent countered essentially as follows:

The term "directly" in claim 1 specified a relation between the wiper blade and the mounting head which was totally against the teaching of the contested patent, according to which the connection was established via the longitudinal strips. Moreover, the appellant's definition of the term "mounting head" (supported by an expert opinion), according to which "mounting head" always referred to the part of a wiper arm assembly which was directly mounted on a drive shaft, was not consistent with the patent specification, which showed in Figures 1 and 2 a bushing interposed between drive shaft and mounting head, and no support was to be found in the description either. According to the patent classification CPC, a mounting head (sub-class of constructional aspects of arms) was a part of an arm.

Document E5 disclosed two embodiments of a mounting head falling under the wording of claim 1, either formed by two parts (2, 4) and providing the specified function ("for transferring a reciprocal movement to said wiper blade"), or formed in one piece (see paragraph [0028]). Claim 1 did not require a monobloc mounting head, and such definition was not confirmed by the additional prior art filed by the appellant in appeal (see annex 5: e.g. EP 0 670 252 showed a mounting head comprising several pieces). Moreover, claim 1 did not exclude a mounting head that was represented by a part in the shape of an arm, as demonstrated by prior art documents provided in opposition (e.g. E12, E16, E22, E23).

As to the alleged second difference put forward for the first time in appeal proceedings, claim 1 neither

required a frictional engagement or a tongue locked in the mounting head, nor a bayonet-connection (which in the field of wiper blades referred to legs with inwardly bend edges). Claim 1 specified a tongue engaging in a hole, i.e. in a void, but not engaging in the mounting head. The tongue of E5 was also snapping into the hole. Moreover, the push button would enter into contact with the mounting head during operation of the wiper blade.

The appellant's allegations of procedural violations were considered unfounded. As regards the alleged **procedural violation 1**, the auxiliary requests had been filed only one month prior to the date of oral proceedings. In view of the preliminary opinion of the opposition division regarding lack of novelty of granted claim 1, the auxiliary requests should have been filed earlier in the written procedure, observing the well-established criteria on admissibility. Moreover, the patentee had deliberately taken the risk of filing requests which introduced new problems, since they were not based on a combination of granted claims. Without explaining why the amendments were considered to overcome all outstanding objections, the requests hadnot been introduced correctly. As can be taken from the contested decision (point 3.2), the patentee had had the opportunity to be heard. Therefore, no procedural violation could be seen because the patentee had had the chance to file requests complying with the criteria for admissibility. Finally, a decision taken and pronounced by the opposition division during oral proceedings could not be challenged any more.

Since new second and third auxiliary requests had been filed during oral proceedings replacing the auxiliary requests already on file (see minutes, point 9.), the

second auxiliary request which had not been admitted by the opposition division no longer formed part of the appeal proceedings. Since the appellant was not interested any more in this request, the case should not be remitted.

As regards the alleged **procedural violation 2**, the patentee had been given a late chance to save its patent by filing an auxiliary request during the oral proceedings, and it had even been allowed to file two new auxiliary requests.

As regards the alleged **procedural violation 3**, the added feature in claim 1 of the new second auxiliary request affected granted features by rendering them less clear, so it had not been possible to raise this clarity objection before. As regards the former second auxiliary request which had been filed only one month before the date of oral proceedings, there had not been sufficient time for the opponent to react by filing observations. According to the preamble of claim 1, the wiper blade and the longitudinal strip of the carrier element were distinct elements. The amendment, which specified that the connecting device and the mounting head were made of one piece, rendered less clear the feature of a connecting device for detachably connecting the wiper blade directly to the mounting head. There was no reason for giving the patentee a further chance to file amendments in case of new objections raised against late-filed requests.

Reasons for the Decision

1. The opposition division dealt with, *inter alia*, and decided on, the issue of patentability of the patent as granted, corresponding to the appellant's main request. Therefore, the board found it expedient to first review the contested decision with regard to the main request before deciding on the issue of the alleged procedural violations raised by the appellant.

2. *Novelty over E5 (Article 54(1) EPC)*
 - 2.1 The subject-matter of claim 1 as granted is not new over the disclosure of document E5 (Article 54(1) EPC).

 - 2.2 E5 discloses (Figure 1 and the detailed representation of a connecting device in Figures 7 and 8) a windscreen wiper device (1), comprising an elastic, elongated carrier element (Federschienen 13, Federschienenenden 14), as well as an elongated wiper blade (3) of a flexible material (Wischgummi 8), which can be placed in abutment with a windscreen to be wiped, which wiper blade (3) is of the flat blade type (paragraph [0002]) and includes at least one groove (12), in which groove (12) a longitudinal strip (13) of the carrier element is disposed. The windscreen wiper device (1) further comprises a connecting device (17) positioned near one end of said wiper blade (3). So far, these features of granted claim 1 have not been contested.

 - 2.3 It was disputed whether the windscreen wiper device of E5 comprises a mounting head as specified in claim 1. The term "mounting head" is to be found in the remaining features of claim 1 (these will be referred in the following as features (a) to (d)).

Features (a) and (b) specify further the windscreen wiper device ("wherein said windscreen wiper device (1) further comprises"):

- (a) "a mounting head (8) for transferring a reciprocal movement to said wiper blade (2)"
- (b) "a connecting device (7) for detachably connecting said wiper blade (2) directly to said mounting head (8)"

Features (c) and (d) specify further the connecting device ("wherein said connecting device (7) comprises at least"):

- (c) "one resilient tongue (10) engaging in a correspondingly shaped hole (11) provided in said mounting head (8)"
- (d) "wherein said resilient tongue (10) is movable between a outward position retaining said wiper blade (2) onto said mounting head (8) and an inward position releasing said wiper blade (2) from said mounting head (8)"

- 2.3.1 The board acknowledges that a mounting head is the unit forming part of the wiper device which is connected to the drive shaft. However, in view of the patent specification showing e.g. a mounting head coupled to the drive shaft via a bushing, the board cannot accept the appellant's view that the term "mounting head" requires a direct connection between mounting head and drive shaft. Moreover, as expressed by the term itself, it simply describes a part ("head") of the wiper device for "mounting" the wiper blade to the drive shaft. A mounting head within this meaning is known from E5 in the first embodiment according to Figure 1 (articulated assembly 2/4 comprising hub 5 mounted to a drive shaft), as found by the opposition division. This mounting head identified in E5 also provides the function of transferring a reciprocal movement to said

wiper blade according to feature (a). Moreover, as recognised by the appellant itself (see letter dated 2 August 2017, which caused the appellant to file new first and second auxiliary requests), E5 even discloses an alternative embodiment which avoids an intermediate oscillating arm (see paragraph [0028]: wiper arm 2 comprising hub 5 for mounting it to the drive shaft).

The appellant contests that the term "mounting head" might comprise the use of an intermediate arm, i.e. a unit consisting of two parts as shown in Figure 1 of E5 (driven part 4 and wiper arm 2). In this respect, the board follows the view of the opposition division that claim 1 is not limited to a one-piece or monobloc mounting head, since claim 1 defines the mounting head merely by its function (see definition (a)). However, in view of the alternative embodiment disclosed in E5 in paragraph [0028], as noted by the appellant itself, a mounting head made of one piece according to the more restrictive interpretation of the term "mounting head" as proposed by the appellant is also known from E5, so there is no need to further argue in respect of the embodiment shown in Figure 1 comprising an intermediate oscillating arm. The appellant's argument that in this case the mounting head would only be represented by the end portion of the integral part, i.e. of wiper arm 2, does not convince the board. The wording of claim 1 does not exclude an elongated mounting head having the shape of an arm. Such a restrictive interpretation would be at odds with the disclosure of the patent specification itself, which shows an elongated mounting head (reference sign 8).

- 2.3.2 The connecting device (17) known from E5 detachably connects the wiper blade (3) directly to the mounting head (2), as required by the feature (b). As explicitly

said in E5 (paragraph [0029]), the wiper blade comprises a rubber (8), which in turn comprises longitudinal grooves housing longitudinal strips. Since the longitudinal strips (13) in E5 - which establish the connection to the connecting device (17), see Figures 7 and 8 - form part of the wiper blade, there is no doubt that the wiper blade in E5 falls under the wording of feature (b).

It is noted that the respondent objected to the term "directly" in definition (b) in claim 1, basically objecting to its clarity, since the contested patent taught that the connection between the wiper blade and the mounting head was not established directly but via the longitudinal strips. However, since this feature already formed part of claim 1 as granted, it is not open to a clarity objection but has to be interpreted accordingly (see G 3/14). In fact, feature (b) only makes sense in the event that the longitudinal strips form part of the wiper blade, as taken into account by the appellant by filing a new second auxiliary request on 2 August 2017.

2.3.3 The mounting head (2) according to E5 is provided (see Figure 7) with a hole (67) cooperating with a resilient tongue (63, 64) as structurally required by feature (c) in claim 1. The appellant argues that the engaging function according to feature (c) was not provided in E5, since the term "engaging" required an interlocking or meshing relationship implying an engaging contact between the resilient tongue of the connecting device and the correspondingly shaped hole in the mounting head. In particular, the contested patent allegedly suggested a firm interlocking and excluded any play around the whole circumference of the hole, due to terms used in the patent such as "snapping/clipping

into the hole", "bayonet-connection", or "retention/retaining ... onto the mounting head".

However, the board cannot accept such restrictive interpretation of the term "resilient tongue engaging in a correspondingly shaped hole" in feature (c). There is no basis in the patent specification for a perfect form-fit between the tongue and the hole, excluding any play around the whole circumference of the hole.

Typical clip connections are established e.g. by a mushroom head entering a hole, in which the mushroom head might be slightly oversized so that some force is needed to make it entering the hole, but afterwards the lower portion of the mushroom head might be received with some play in the hole. The push button 64 of the resilient tongue 63 disclosed in E5 (see Figure 7) also snaps into the hole 67, irrespective of its primary function as an actuating means for releasing the resilient tongue and a further "snap"-connection provided in E5 between the tongue and the flexors (see paragraph [0045] in E5). The terms "engaging in" or "snapping/clipping" might only relate to the step of establishing the connection between the connecting device and the mounting head, when the resilient tongue enters the hole.

The board concurs with the respondent that in the field of wiper blades the term "bayonet-connection" refers to legs with inwardly bend edges, i.e. to an U-shaped cross-section of the mounting head comprising clamping members in order to provide an enhanced retention of the connecting device onto the mounting head in a direction perpendicular to the longitudinal direction of the mounting head, as described in the patent specification (paragraph [0021]), which is also disclosed in E5 (Figure 9). The board holds that no

further limitation regarding the resilient tongue engaging in a hole can be derived therefrom. The term "retaining" used in feature (d) itself cannot be interpreted as suggested by the appellant, allegedly excluding any play around the whole circumference of the hole, since it merely describes a complementary function to the function of releasing the wiper blade from the mounting head by pushing in the resilient tongue. Thus, it relates to the function of the tongue/hole-connection enabling an exchange of the wiper blade and possibly preventing that the wiper blade might get lost in case of forces acting in the longitudinal direction of the wiper blade, i.e. perpendicular to the wiping direction. Such function is also realised by the tongue/hole-connection in E5. The appellant also refers to paragraph [0014] of the contested patent, which describes an enhanced retention function ("closed holes enhance the retention of the connection device onto the mounting head in all possible directions, particularly both horizontally and vertically"). However, this passage relates to a further preferred embodiment which comprises, in addition to a hole in the base of the U-shaped cross-section of the mounting head, additional holes having a specific shape ("closed holes") provided in each leg of the U-shaped cross-section of the mounting head. As such, it cannot serve as a basis for construing the broader wording of claim 1 ("resilient tongue engaging in a correspondingly shaped hole") in a more limited sense.

- 2.3.4 In view of the foregoing, the board finds that E5 also shows (see Figure 7) a resilient tongue (64) movable between an outward position retaining said wiper blade (3) onto said mounting head (2) and an inward position releasing said wiper blade (3) from said mounting head (2) according to definition (d) in claim 1.

2.3.5 Therefore, irrespective of the fact that the appellant might have raised a new argument for the first time in appeal proceedings with regard to feature (c), the board does not follow the appellant's interpretation that this feature implies the meaning of form-fit, i.e. a resilient tongue being in contact with the whole circumference of the hole. Even taking into consideration the drawings of the patent specification, the board cannot see that such a limited interpretation would be justified. Moreover, as argued above, a mounting head within a meaning as supported by the patent specification itself is known from E5.

As a consequence, the subject-matter of claim 1 as granted lacks novelty over E5.

3. *Alleged procedural violations*

3.1 The appellant alleges that its interests in defending its case had been seriously damaged in opposition proceedings in several respects (alleged procedural violations 1 to 3). Allegedly, the decision not to admit e.g. the auxiliary request 2 filed in writing on 5 November 2014 into the opposition proceedings was taken without giving the patentee the opportunity to argue on its admissibility (alleged **procedural violation 1**), thus violating the party's fundamental right to be heard.

3.2 According to the established jurisprudence, the right of any party for oral proceedings to be held on request and to present its case orally is absolute and, with respect to the party's right to be heard on its case, a more specific embodiment of the general principle enshrined in Article 113(1) EPC. Moreover, the parties'

absolute right to be heard in oral proceedings, Articles 113(1) and 116(1) EPC, is not restricted to new and substantial arguments which have not yet been presented in writing (see R 3/10, Reasons 2.11).

- 3.3 In the present case, the board cannot see any indication that the appellant was allowed to argue during the oral proceedings on the issue of admissibility of the auxiliary request 2 filed in writing on 5 November 2014. Without going into the merits of the case as regards the reasons for not admitting this request, according to the minutes (see point 7.) the chairman of the opposition division, after commenting on the amendment made to claim 1 of auxiliary request 2, immediately announced "that AUX2 is not admitted in the proceedings". As acknowledged by the respondent, a decision taken and pronounced by the opposition division cannot be challenged any more in the same proceedings. Therefore, it is considered irrelevant that "The Patentee did not react on this decision not to admit AUX2 in the proceedings", as recited in the minutes.

The respondent refers to point 3.2 of the contested decision ("As explained by the Proprietor, the feature ... has been added to claim 1 of the granted patent. This feature originates from ..."), allegedly proving that the patentee had the opportunity to be heard. However, the board cannot see that this passage, which rather relates to the submissions made in writing in the letter dated 5 November 2014 (and shows the basis for the amendment in the originally filed description), demonstrates that the patentee was given the right to present its case orally during the oral proceedings.

3.4 For this reason alone, irrespective of whether the allegations of further procedural violations 2 and 3 are acknowledged by the board, the board comes to the conclusion that the patentee's right to be heard had been violated. Although an effective and efficient conduct of oral proceedings is subject to the discretionary power exercised by the chairman in oral proceedings with regard to specific issues, it must nevertheless guarantee that the fundamental procedural rights of each party in adversarial proceedings, i.e. the right to a fair and equal treatment, including the right to present comments in oral proceedings are respected (Articles 113(1) and 116 EPC).

3.5 In addition, the board observes the following:

- It appears that the opposition division did not admit the second auxiliary request according to Rule 80 EPC, because it was considered not to be a limitation of the first auxiliary request and not an attempt to overcome the ground for opposition against auxiliary request 1. However, a limitation of the patent as granted which is an alternative to the limitation provided in a first auxiliary request might be an attempt to overcome a ground for opposition, irrespective of whether it limits the subject-matter of a first auxiliary request.
- It appears that the lack of clarity put forward by the opposition division against the new auxiliary requests 2 and 3 filed during oral proceedings was already present in requests already filed before, so the patentee was not given the opportunity to react correspondingly by way of amendment (**alleged procedural violation 3**).

4. *Remittal*

4.1 In view of the fundamental deficiency as found above, the board decides to remit the case to the opposition division (Article 111 EPC; Article 11 RPBA, Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536).

4.2 The respondent requested that the case should not be remitted because the second auxiliary request, which was not admitted by the opposition division, was not maintained any more in appeal proceedings. However, as pointed out by the appellant, this request was still there in substance in form of the first auxiliary request filed with the grounds of appeal, which was only amended by taking into account the further clarity objection raised during oral proceedings at a later stage against the new auxiliary request 2 filed during oral proceedings (see contested decision, point 5.2).

Moreover, a new issue was raised for the first time in appeal proceedings by the appellant with regard to paragraph [0028] of document E5, which might affect the discussion when coming to the assessment of inventive step of the subject-matter of the auxiliary requests on file. In fact, inventive step of the claimed subject-matter has not been discussed so far. Furthermore, the new first and second auxiliary requests filed by the appellant on 2 August 2017, allegedly an attempt to delimit the subject-matter claimed over E5 in this respect, might raise new issues to be discussed.

4.3 In view of the foregoing, the board finds it appropriate to follow the appellant's request to remit the case in order to give the appellant the appropriate opportunity to be heard on its arguments.

5. *Reimbursement of the appeal fee*

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

In the present case, the appeal is allowable and the substantial procedural violation acknowledged above concerns non-admission of the second auxiliary request filed on 5 November 2014, which forms the basis for filing a first auxiliary request with the grounds of appeal (taking into account further objection raised later in oral proceedings as stated above). Since the board confirms the contested decision as regards the appellant's main request, there is a self-evident causal link between the violation of the appellant's right to be heard and the necessity to appeal. Therefore, and in the absence of any grounds to the contrary, the reimbursement of the appeal fee is equitable.

Order

For these reasons it is decided that:

1. The impugned decision is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated