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**Datasheet for the decision
of 5 March 2018**

Case Number: T 0068/16 - 3.2.05

Application Number: 09734391.7

Publication Number: 2276950

IPC: F16J15/08, F16J15/12, F01N13/18

Language of the proceedings: EN

Title of invention:
Metallic Flat Gasket

Patent Proprietor:
REINZ-Dichtungs-GmbH

Opponent:
Federal-Mogul Sealing Systems GmbH

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

Keyword:
Substantial procedural violation (yes)
Remittal to the department of first instance (yes)
Reimbursement of the appeal fee (yes)

Decisions cited:

R 0002/08



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Case Number: T 0068/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 5 March 2018

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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 11 December 2015 rejecting the opposition filed against European patent No. 2276950 pursuant to Article 101(2) EPC.**

Composition of the Board:

Chairman M. Poock
Members: O. Randl
D. Rogers

Summary of Facts and Submissions

- I. The opponent filed an appeal against the decision of the opposition division rejecting the opposition against European patent No. 2 276 950.

The opposition division had found the invention to be sufficiently disclosed. Claim 1 was found to be inventive in view of document D16 (EP 1 566 582) as well as several other combinations involving documents D1 (GB 1 567 407), D14 (EP 1 079 155), D10 (DE 102 44 794) and D11 (DE 101 56 603). Claim 20 was found to be inventive for the same reasons.

- II. The appellant (opponent) requested the board to set aside the decision and to revoke the patent. In addition it requested that the appeal fee be reimbursed because its right to be heard had been violated.

The respondent (patent proprietor) requested that the appeal be dismissed.

- III. The independent claims of the opposed patent read as follows:

"1. Metallic flat gasket (1) with
- at least one metallic layer (10),
- at least one through opening (20), and
- a sealing element (4) formed in a first one of the at least one gasket layer (10),
- with the sealing element (4) completely surrounding the through-opening (20) and being formed as a periodic structuring in the material of the gasket layer (10),
- where the periodic structuring comprises

protrusions (41), depressions (42) and transition regions (43) between the protrusions (41) and depressions (42) and comprises at least two periods for at least 70 % of the circumference of the through-opening (20),

- where the first gasket layer (10) is completely coated at least in the area of the periodic structure, and **characterised in that** the period length (P) of the periodic structuring corresponds at the most to four times the material thickness of the first gasket layer (10), wherein the coating contains thermosets to less than 5 %,

- where the thickness of the coating (3) in the region of the sealing element (4) varies only to such an extent that in the area of the depressions (42) it shows a coating thickness (HV) which is less than 120 % of the coating thickness in the area of the protrusions (41),

- where the thickness (HB 1, HB 2) of the coating (3) in the non-structured area at room temperature does not flow,

- and wherein the metallic flat gasket (1) is obtainable using either coil-coated material or partially coated material by embossing the periodic structuring into the coil-coated or partially coated material."

"20. Method for the production of a metallic flat gasket (1) according to one of the preceding claims, **characterized in that** the periodic structuring is embossed into an area of the at least one gasket layer (10) which is completely coated."

IV. The board issued a communication under Rule 100(2) EPC in which it expressed its provisional opinion that the case should be remitted to the department of first

instance. In particular, the board invited the respondent to state whether it maintained its request for oral proceedings before the board.

V. In respect of the alleged violation of its right to be heard, the appellant argued as follows (see point V of the statement of grounds of appeal):

- Although the opposition division found document D17 US 2,850,999) to be *prima facie* relevant (see point 3.1.3 of the decision under appeal) and admitted it into the proceedings, the discussion of the inventive step involved in the subject-matter of claim 1 in the decision is silent on this document.
- The opposition division has not taken account of the appellant's submission with regard to the lack of a lower limit for the amount of thermoset.
- The opposition division has failed to take into account the problem-solution approach, nor has it stated the reasons for departing from this approach.

VI. In response to the board's communication under Rule 100(2) EPC, the respondent argued as follows:

The respondent agreed to a remittal to the department of first instance without oral proceedings.

It nevertheless pointed out several issues on which it disagreed with the preliminary opinion of the board.

According to the respondent:

- The amount of thermoset does not necessarily determine whether a non-flowing coating within the meaning of the invention is obtained. Such coatings may be obtained even without thermoset.

- By definition, claim 1 only encompasses coatings having non-flowing properties. Therefore, the opposition division did not have to assume any such technical effect.

Reasons for the Decision

1. Violation of the appellant's right to be heard

The appellant argued that the opposition division had violated its right to be heard on three counts:

1.1 Document D17 not taken into account

Having received the summons to the oral proceedings before the opposition division, the opponent filed written submissions comprising two new documents, D16 and D17. It argued that the subject-matter of claim 1 was not inventive over document D16 and "not inventive over D17, but at least not inventive over a combination of documents D17 and D16 or D17 and D1" (see page 15 of the submissions of 7 October 2015).

The opposition division admitted the new documents into the proceedings because it found them to be *prima facie* relevant (see point 3.1.3 of the decision under appeal).

The division discussed the inventive step of claim 1 with document D16 as closest prior art (point 3.2 of the decision) and then explained why the inventive step attacks based on D1+D14 and D10+D11 had to fail (see point 3.3). Document D17 is not mentioned in this context.

A reference of the opponent to Figure 4 of document D17 is, however, mentioned once when the inventive step involved in the subject-matter of claim 20 is discussed. However, the opposition division did not base its reasoning on this reference but referred to its discussion of claim 1, which is silent on document D17 (see point 3.4 of the decision).

Once the opposition division had found the subject-matter of claim 1 to be inventive with respect to the teaching of document D16, it should have discussed inventiveness in respect of document D17. This discussion appears not to have taken place.

According to the established jurisprudence of the boards of appeal, the mere presence of information somewhere in the file does not relieve a party of its duty to draw attention to it when necessary or to present arguments relying on such information at the appropriate time (see, for instance, R 2/08 of 11 September 2008, Reasons, points 8.5 and 9.10). It is not clear from the minutes of the oral proceedings, whether, after the discussion of inventive step over document D16, the opposition division has offered the appellant an opportunity to make further comments on inventive step, and if so, whether the appellant has drawn the attention of the opposition division to the fact that it had not yet taken account of its arguments based on document D17. The minutes do not provide details on what happened between 13:20 and 14:23. The statement of the minutes according to which "there were no further substantiated objections raised by the opponent against the subject-matter of claim 20" (sheet 5, fifth paragraph) appears to indicate that the opponent has had the opportunity to

comment and, therefore, to draw the division's attention to document D17.

Considering all the above, the board has reached the conclusion that it has not been established that the failure to take into account an inventive step argument based on document D17 constitutes a substantial procedural violation.

1.2 No reasoning for the alleged effect of thermoset amount

Claim 1 requires the coating of the first gasket layer to contain thermosets to less than 5 % (see point III.; this feature has been referred to as feature M1.8). The description of the opposed patent mentions thermosets only in its paragraph [0019].

In the summons to oral proceedings the opposition division stated that "[i]t appears clearly from paragraphs [0011] to [0019] that the flowing properties of the coating is [sic] influenced by the proportion of thermoset" (sheet 4, second paragraph).

This statement was challenged by the appellant in point II of its written submission dated 7 October 2015. The appellant argued that there was no technical effect over the whole claimed range.

In its discussion of sufficiency of disclosure (see point 2.2 of the grounds for the decision, fourth paragraph), the opposition division repeated the statement of the summons and explained that the skilled person would be able to determine the appropriate thermoset, and the proportion of thermoset, by trial and error, thus arriving at a material fulfilling the requirements of feature M1.8.

In the discussion of inventive step (see point 3.2.3 of the grounds for the decision), the opposition division found that document D16 did not disclose feature M1.8 and then continued:

"However it is assumed that the presence of thermoset has an effect on the flowability of the coating and the opposition division follows the argumentation of PR and considers that the skilled person would have no incentive to add thermoset to the coating disclosed in D16.

Thus claim 1 is inventive (art. 56 EPC) in view of D16."

By reasoning in this way, the opposition division appears not to have taken account of the assertion of the appellant that the "assumed" technical effect was not obtained over the whole claimed range and in particular at low amounts of thermoset, although the technical effect of the distinguishing features clearly is of crucial importance when inventive step is to be assessed.

Incidentally, the board wishes to point out that a finding of inventive step (or lack thereof) cannot be based on a mere assumption.

In view of the wording of the decision ("... it is assumed ..."), the board is unable to endorse the respondent's argument that the opposition did not base its decision on an assumed technical effect.

Having failed to consider an argument that might have led to a different conclusion, the opposition division has violated the appellant's right to be heard.

1.3 Problem-solution approach not applied

From the passage in point 3.2.3 of the grounds for the decision quoted above (see point 1.2) it is clear that the opposition division has not used the problem-solution approach.

This fact in itself does not constitute a substantial procedural violation. The problem-solution approach is not enshrined in the EPC and, as acknowledged by the appellant, its use is not mandatory.

The board agrees that, as a rule, a division that does not use the problem-solution approach should indicate its reasons for doing so, if only to dispel the impression that it acts arbitrarily. The appellant has argued that this is a requirement established by the jurisprudence. However, although an opposition division should indeed keep in line with the established jurisprudence, it should be noted that the jurisprudence of the boards as such is not formally binding on the departments of first instance. Only the department whose decision was appealed is bound by the *ratio decidendi* of the board (Article 111(2) EPC). The Guidelines for Examination, which are binding on the opposition division, only state that any "deviation from this approach should be exceptional" and do not require a justification (see point G-VII,5). Consequently, a division that, in an exceptional situation, chooses not to use the problem-solution approach and not to explain its choice does not commit a substantial procedural violation.

The statement of the opposition division in respect of inventive step is unsatisfactory on several counts, in particular because it is based on an unreasoned assumption and on the finding that there was no incentive to add thermosets, which is irrelevant if thermosets are an obvious alternative to the skilled person. Using the problem-solution approach might have prevented the opposition division from presenting a defective reasoning. However, the board is unable to see how the fact that the reasoning of the opposition is perfectible and its conclusion might be wrong could constitute a further violation of the appellant's right to be heard going beyond the denial of the right to be heard discussed under point 1.2.

2. Remittal to the department of first instance

According to the established jurisprudence of the boards of appeal, a violation of the right to be heard may constitute a fundamental deficiency within the meaning of Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA), which stipulates that "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" (see "Case Law of the Boards of Appeal of the EPO", 8th edition, 2016, III.B.1).

The deficiency established under point 1.2 above is fundamental insofar as the decision of the opposition division might have been different had it not occurred. Therefore, a remittal appears to be appropriate. The board is not aware of any special reasons for not remitting the case. Therefore, the board intends to set

aside the decision and remit the case to the opposition division for further prosecution.

The board interprets the statement of the respondent in the second paragraph of its response to the communication of the board ("Grundsätzlich erklärt sich die Patentinhaberin ... mit der Zurückverweisung der Sache ohne vorherige mündliche Verhandlung an die Einspruchsabteilung ... einverstanden.") as a withdrawal of its request for oral proceedings before the board. Therefore, no oral proceedings need to be held and the decision can be taken in writing.

When resuming its examination of the case, the opposition division should:

- take due account of the arguments of the appellant based on document D17;
- apply the problem-solution approach or at least explain why the approach is not used;
- discuss the appellant's argument that the technical effect is not obtained over the whole claimed range;
- consider the respondent's arguments presented in its letter dated 21 June 2017;
- note the respondent's request for oral proceedings before the opposition division (*cf.* the respondent's letter of 21 June 2017).

3. Reimbursement of the appeal fee

According to the established jurisprudence of the boards of appeal, a violation of the right to be heard may also constitute a substantial procedural violation justifying a reimbursement of the appeal fee

(see "Case Law of the Boards of Appeal of the EPO",
8th edition, 2016, III.B.1).

In the present case, the appellant's right to be heard
was violated (see point 1.2 above).

Therefore, the board grants the appellant's request for
a reimbursement of the appeal fee in application of
Rule 103(1)(a) EPC.

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 reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



N.Schneider

M. Poock

Decision electronically authenticated