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**Datasheet for the decision  
of 18 February 2019**

**Case Number:** T 0460/16 - 3.2.08  
**Application Number:** 07732806.0  
**Publication Number:** 2035179  
**IPC:** B23K20/12, C22C19/03,  
C30B11/00, C30B33/00, F01D5/30,  
F01D5/34  
**Language of the proceedings:** EN

**Title of invention:**

LINEAR FRICTION WELDING OF A SINGLE CRYSTAL COMPONENT TO A  
SECOND COMPONENT WITH MINIMISATION OF IN PLANE FRICTION AND  
FORGE FORCES

**Applicant:**

Rolls-Royce plc

**Opponent:**

MTU Aero Engines AG

**Headword:**

**Relevant legal provisions:**

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

**Keyword:**

Substantial procedural violation

Reimbursement of appeal fee - request for oral proceedings  
ignored (yes) - (yes)

**Decisions cited:**

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 0460/16 - 3.2.08

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.08**  
**of 18 February 2019**

**Appellant:** Rolls-Royce plc  
(Patent Proprietor) 62 Buckingham Gate  
London SW1E 6AT (GB)

**Representative:** Rolls-Royce plc  
Intellectual Property Dept SinA-48  
PO Box 31  
Derby DE24 8BJ (GB)

**Respondent:** MTU Aero Engines AG  
(Opponent) Postfach 50 06 40  
80976 München (DE)

**Representative:** Lang, Christian  
LangPatent Anwaltskanzlei  
Ingolstädter Straße 5  
80807 München (DE)

**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 21 December  
2015 rejecting the opposition against European  
patent No. 2035179 as inadmissible pursuant to  
Rule 77(1) EPC.**

**Composition of the Board:**

**Chairwoman** P. Acton  
**Members:** C. Herberhold  
Y. Podbielski

## **Summary of Facts and Submissions**

- I. By decision posted on 21 December 2015 the Opposition Division decided on the basis of Rule 77(1) EPC to reject the opposition against European patent No. 2 035 179 as inadmissible.
- II. The appellant (opponent) lodged an appeal against that decision in the prescribed form and within the prescribed time limit.
- III. In accordance with both parties' requests the Board issued a summons for oral proceedings.

In a communication pursuant to Article 15(1) RPBA dated 13 December 2018 the Board provided its preliminary opinion according to which fundamental deficiencies were apparent in the first instance proceedings.

Consequently, oral proceedings were to be held solely for discussion of the question whether the opposition division's failure to hold oral proceedings prior to issuing its decision constituted a substantial procedural violation which justified reimbursement of the appeal fee (Rule 103(1) (a) EPC) and remittal of the case to the opposition division (Article 11 RPBA).

It was further stated that if both parties indicated in writing that they did not request oral proceedings for the purpose of a decision on the above question, the Board would be ready to decide thereon in the written proceedings.

- IV. In its letter dated 27 December 2018 the appellant agreed that a decision on the question formulated by

the Board in its communication could be taken in written proceedings.

V. With letter dated 31 January 2019 the respondent withdrew its request for oral proceedings on the question as to whether the opposition division's failure to hold oral proceedings, prior to issuing its decision, was a procedural violation.

VI. Thus, the Board is in a position to decide in written proceeding on the question formulated by the Board in its communication. Consequently, oral proceedings were cancelled.

VII. The parties' requests relevant to this decision are as follows:

The appellant requests that the decision under appeal be set aside, the case be remitted to the opposition division for further prosecution and the appeal fee be reimbursed.

The respondent requests that the decision to find the Opposition inadmissible is upheld, as is the decision not to hold oral proceedings in front of the Opposition Division on the question of admissibility.

VIII. The essential arguments of the appellant can be summarised as follows:

Contrary to the statement in point 5 of the opposition division's decision, the appellant had requested oral proceedings several times in the opposition proceedings. By not holding oral proceedings the appellant had been deprived of the opportunity to orally present facts and arguments in support of the

admissibility of the opposition and to have those facts and arguments discussed with the opposition division and the proprietor.

Not granting the appellant its right to be heard orally constituted a substantial procedural violation.

It was thus not only justified to set aside the opposition division's decision and give the appellant the opportunity to present facts and arguments supporting the admissibility of the opposition in an oral hearing before the opposition division, but also to reimburse the appeal fee.

IX. The respondent argued essentially as follows:

Contrary to the appellant's view, no valid request for oral proceedings was made on the decision under appeal, such that there was also no violation of the right to be heard.

In particular, the opposition division decided that the opposition was not admissible because it did not comply with the requirements of Rule 76(2)(c) EPC. Admissibility of the opposition was to be determined from the notice of opposition and any deficiencies could not be remedied after the end of the opposition period. The only correspondence received from the appellant before the end of the opposition period was the notice of opposition, which did not contain a request for oral proceedings. Consequently, the appellant did not make a request for oral proceedings on the decision of the opposition division in question, i.e. on that of admissibility, because no such request was made before the deadline for submitting any

material relevant to the question of admissibility under Rule 76(2)(c) EPC.

Furthermore, the only requests for oral proceedings made by the appellant were conditional on an outcome from subsequent written proceedings which did not even commence, and did not relate to the event that the opposition was rejected as inadmissible.

Therefore, the opposition division's decision should be upheld.

### **Reasons for the Decision**

1. The right of a party to oral proceedings in proceedings before the European Patent Office is set out in Article 116 EPC. According to Article 116(1) EPC "oral proceedings shall take place ... at the request of any party to the proceedings." The wording of the provision makes it clear that when oral proceedings have been requested, they have to be appointed, and that there is no room for discretion.
2. In the present case, the notice of opposition filed on 13 April 2012 (Fax) did not contain a request for oral proceedings.

However, with letter dated 1 August 2013, the opponent (now the appellant) requested oral proceedings in case the opposition was not allowed in the written proceedings ("Gleichzeitig wird für den Fall, dass dem Einspruch im schriftlichen Verfahren nicht stattgegeben werden sollte, die Durchführung einer mündlichen Verhandlung gemäß Artikel 116 EPÜ beantragt").

With letter dated 10 January 2014 (see last paragraph) the opponent stated that the request for revocation of the granted patent was maintained, as was the auxiliary request for holding oral proceedings in accordance with Article 116 EPC if the patent was not revoked in the written proceedings ("Der Antrag auf Widerruf des erteilten Patents im gesamten Umfang aufgrund mangelnder Neuheit und mangelnder erfinderischer Tätigkeit wird daher genauso aufrecht erhalten, wie der Hilfsantrag auf Durchführung einer mündlichen Verhandlung gemäß Artikel 116 EPÜ, falls das Patent nicht im schriftliche[n] Verfahren widerrufen wird.")

3. Despite these requests, which had at no point been withdrawn, the Opposition Division stated in its decision, erroneously, that "no oral proceedings were requested by the Opponent" (point 5 of the facts and submissions) and took its decision without holding oral proceedings.
4. In deciding without holding oral proceedings, the division based the decision on grounds or evidence on which the appellant had not had an opportunity to present its comments orally, contrary to the appellant's rights enshrined in Articles 116(1) and 113(1) EPC.
5. The respondent has argued that the requests were not contained in the notice of opposition and were therefore irrelevant for deciding on the admissibility of the opposition. However, according to Article 116(1) EPC, if there is a request of a party for oral proceedings, they shall take place, irrespective of the point in time they have been requested. Before this



right to be heard has been granted to the party, the decision cannot be taken (Article 113(1) EPC).

6. The respondent has further argued that the requests for oral proceedings were conditional on an outcome from subsequent written proceedings. With the opposition being inadmissible, no written proceedings commenced, and the condition was thus not met. This meant that there was no valid request for oral proceedings.

This argument is likewise not convincing:

The appellant had formulated as a main request to "allow the opposition in the written proceedings" (letter dated 1 August 2013) / "revocation of the patent" (letter dated 10 January 2014).

The respective main request has not been granted, because the patent was not revoked. With the main request not being granted, the auxiliary request became valid, i.e. to hold oral proceedings in accordance with Article 116 EPC.

The passages in both letters thus constitute valid requests for oral proceedings which the opposition division was obliged to respect.

7. The failure to hold oral proceedings violated the appellant's right to be heard as enshrined in Article 113(1) EPC and constitutes a substantial procedural violation which justifies reimbursement of the appeal fee under Rule 103(1)(a) EPC and remittal to the opposition division (Article 11 RPBA), so that oral proceedings can be appointed before a decision is taken by the Opposition Division.

## Order

### For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



C. Moser

P. Acton

Decision electronically authenticated