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**Datasheet for the decision
of 6 April 2021**

Case Number: T 0558/16 - 3.5.02

Application Number: 07798759.2

Publication Number: 2033285

IPC: H01T13/32, H01T13/39

Language of the proceedings: EN

Title of invention:

Spark plug with fine wire ground electrode

Patent Proprietor:

Tenneco Inc.

Opponent:

Reininger, Jan Christian

Relevant legal provisions:

EPC Art. 113(1), 112(1)(a)

EPC R. 111(2), 103(1)(a), 101(1)

Keyword:

Right to be heard - substantial procedural violation (yes)

Appealed decision - sufficiently reasoned (no)

Reimbursement of appeal fee - (yes)

Referral to the Enlarged Board of Appeal - (no)

Admissibility of appeal - patent proprietor (no)

Decisions cited:

T 0073/88, T 0084/02, T 0840/09



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 0558/16 - 3.5.02

D E C I S I O N
of Technical Board of Appeal 3.5.02
of 6 April 2021

Appellant: Reininger, Jan Christian
(Opponent) Adares Patent- und Rechtsanwälte
Reininger & Partner GmbH
Tauentzienstraße 7 b/c
10789 Berlin (DE)

Representative: Reininger, Jan Christian
Adares
Patent- und Rechtsanwälte
Reininger & Partner GmbH
Tauentzienstrasse 7 b/c
10789 Berlin (DE)

Respondent: Tenneco Inc.
(Patent Proprietor) 500 North Field Drive
Lake Forest, IL 60045 (US)

Representative: Marchitelli, Mauro
Buzzi, Notaro & Antonielli d'Oulx S.p.A.
Corso Vittorio Emanuele 11, 6
10123 Torino (IT)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 7 January 2016
rejecting the opposition filed against European
patent No. 2033285 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman R. Lord
Members: H. Bronold
 R. Cramer

Summary of Facts and Submissions

- I. The appeals of the patent proprietor and of the opponent lie from the decision of the opposition division to reject the opposition against European patent No. 2 033 285.
- II. The appellant/patent proprietor requested as main request that the decision under appeal be set aside, that the priority right be reinstated, and that the patent be maintained as granted.
- III. The appellant/opponent requested that the decision under appeal be set aside and that the patent be revoked in its entirety. The opponent further requested that the appeal of the patent proprietor be rejected as inadmissible as well as that their appeal fee be reimbursed because the contested decision was not sufficiently reasoned and their right to be heard was violated.
- IV. In a communication under Rule 100(2) EPC the board informed the parties of its preliminary opinion that the opponent's right to be heard was violated and the case should be remitted to the first instance. Further, the proprietor's appeal seemed to be inadmissible. The board also indicated that it considered a decision in writing possible.
- V. With letter dated 9 July 2020, the opponent withdrew their request for oral proceedings provided that the board did not finally deviate from its preliminary opinion.

VI. With letter dated 10 July 2020 the patent proprietor requested *inter alia* that the oral proceedings be held and that three questions be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC regarding sufficiency of reasoning under Rule 111(2) EPC, violation of the right to be heard under Article 113 EPC and the admissibility of an appeal by the patent proprietor in a case where the patent was maintained as granted but the entitlement to the priority date was denied.

VII. In a communication under Article 15(1) RPBA sent together with a summons to oral proceedings, the board informed the parties that during the upcoming oral proceedings it intended to discuss only the issues of admissibility of the patent proprietor's appeal, sufficiency of reasoning of the contested decision and violation of the opponent's right to be heard. Since the facts underlying the latter two aspects of the appeal were all apparent from the file, the board still considered it possible to reach a decision to remit the case without holding oral proceedings.

VIII. In a letter dated 16 December 2020, the patent proprietor withdrew their request for oral proceedings and repeated their request to refer three questions to the Enlarged Board of Appeal, wherein the three questions were slightly rephrased compared to the version submitted with letter dated 10 July 2020 and now read as follows:

"i) whether a decision maintaining a European Patent as granted, but denying entitlement to the priority date, can be regarded as negatively affecting the Proprietor

under Article 107 EPC, thereby legitimating the filing of an appeal by the Patent Proprietor;

ii) whether a violation of Rule 111 (2) occurs when, in addition to the reasons set forth in a Decision, minutes of Oral Proceedings are available that provide an additional, thorough, insight as to the same reasons;

iii) whether a party's claim about an alleged violation of right to be heard under Article 113 EPC is legitimate, provided that the official record of events - never challenged by the party raising the claim - appears to prove that no such violation occurred."

IX. With letter dated 7 January 2021 the opponent requested the rejection of the request for referral of the three above-mentioned questions to the Enlarged Board of Appeal and argued that regarding questions i) and ii) the board's position was fully in line with established case law and that question iii) was moot.

X. The opponent's arguments, as far as they are relevant for this appeal, can be summarised as follows:

In the preliminary opinion, the opposition division held document E5 to be novelty-destroying for claim 1 of the granted patent. Inventive step starting from E5 was also discussed during the oral proceedings before the opposition division but not even mentioned in the minutes. In the contested decision document E5 was no longer found novelty-destroying, but no reasons were given for this. The opposition division had not dealt with the arguments brought forward by the opponent regarding document E5. Therefore, the contested decision was not sufficiently reasoned and the

opponent's right to be heard had been violated. A reimbursement of the appeal fee was therefore justified.

Moreover, the patent proprietor's appeal was inadmissible because they were not adversely affected by the contested decision since the patent had been maintained as granted. The opinion of the opposition division, that the patent was not entitled to the claimed priority, was not a decision that adversely affected the patent proprietor.

The request for referral of three questions to the Enlarged Board of Appeal was to be rejected because regarding questions i) and ii) the board acted fully in line with established case law and question iii) was moot.

XI. The patent proprietor's arguments, as far as they are relevant for this appeal, can be summarised as follows:

The contested decision was sufficiently reasoned. A preliminary opinion of the opposition division was not binding. Thus, an interlocutory decision diverging from a preliminary opinion did not violate Rule 111(2) EPC. It was not true that the contested decision did not deal with documents E2 and E5. Section 2.1 indicated that E2 did not disclose features 1d and 1f of claim 1. The minutes contained reasoning why documents E2 and E5 were not novelty-destroying for claim 1 under points 3.2 to 3.10 and 3.18. The contested decision expressly indicated that document E5 was not novelty-destroying for claim 1. The reasoning could be found in the minutes under points 3.11 to 3.18. Moreover, the fact that the opponent was in a position to argue why

document E5 was novelty-destroying in their grounds of appeal showed that the contested decision was not unsubstantiated.

It also followed from the minutes that the opponent's right to be heard had not been violated. According to points 4.1 and 4.12 of the minutes, starting from document E2 the opponent attacked inventive step in combination with document E6, not E5. The opponent simply failed to make its own case because they did not argue inventive step based on E5. This did not amount to a violation of their right to be heard.

Further, the patent proprietor's appeal was not inadmissible. The appealed decision negated the priority date and consequently, the patent was not maintained as granted. The patent proprietor was adversely affected because the effective filing date would become 10 June 2007 instead of the priority date of 16 June 2006. The cited decision T 73/88 suffered from a fundamental flaw in that the possibility for the patent proprietor to overturn an unfavourable decision regarding the priority right was entirely dependent on the course of action of the opponent.

Reasons for the Decision

1. Admissibility of the appeals
 - 1.1 At least the opponent's appeal is admissible because it was filed in due time and form and sufficiently reasoned.
 - 1.2 Having regard to the proprietor's appeal, see below under point 5.
2. Insufficient reasoning (Rule 111(2) EPC)
 - 2.1 The opponent argued that the contested decision is not sufficiently reasoned in the sense of Rule 111(2) EPC, in particular, that no reasons were given in the decision why the opposition division reversed its preliminary opinion as issued with the annex to the summons dated 12 May 2015. The board agrees with the opponent in this respect.

In the annex to the summons, the opposition division informed the parties that it considered documents E2 (US 2002/0105254 A1) and E5 (US 2006/0181185 A1) novelty-destroying for the subject-matter of claim 1 of the patent as granted (see page 3, point 6.3). Document E5 was also considered novelty-destroying for the subject-matter of claim 1 according to the auxiliary request, which comprises more features than claim 1 according to the main request (see page 4, point 7.3).

In the contested decision, however, the opposite was decided. Neither the preliminary opinion nor the contested decision contains any reasoning why the respective conclusion was reached.

Moreover, the opponent had, both in writing and during the oral proceedings before the opposition division, presented detailed arguments as to why the subject-matter of claim 1 was not new over the disclosure of documents E2 and E5 (see for example the notice of opposition, points V.1.1 and V.1.4 respectively, the opponent's letter dated 13 November 2015, page 1, point 3, as well as (for E2) page 2, point 3.3, page 3, points 3.5, 3.7 and 3.10, and (for E5) page 3, point 3.13 and page 4, point 3.16 of the minutes of the oral proceedings before the opposition division).

The contested decision, however, does not deal with any of those arguments.

- 2.2 Contrary to the patent proprietor's arguments, the problem regarding Rule 111(2) EPC identified by the board does not arise from the fact that the opposition division had reversed their preliminary opinion on document E5, but from the fact that they did not explain why they did so. Therefore, the decision of the opposition division is not sufficiently reasoned in the sense of Rule 111(2) EPC.

The board is also not convinced by the patent proprietor's argument that the minutes of the oral proceedings before the opposition division could be seen as part of the reasoning of the contested decision. According to Rule 124(1) EPC, the minutes of oral proceedings shall contain the essentials of the oral proceedings or of the taking of evidence, the

relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection. Minutes of oral proceedings are therefore normally not suitable to replace any missing reasoning of a decision.

The board has thus arrived at the conclusion that the contested decision is not sufficiently reasoned, contrary to the requirements of Rule 111(2) EPC.

3. Right to be heard (Article 113(1) EPC)

3.1 The opponent argued that their right to be heard was violated since their arguments regarding inventive step based on document E5 were neither reflected in the minutes of the oral proceedings before the opposition division, nor discussed in the contested decision.

3.2 The patent proprietor contested that the opponent had argued lack of inventive step based on document E5 during the oral proceedings before the opposition division.

3.3 For this decision, however, the question can be left aside as to whether the disputed inventive step attack of the opponent had been orally presented or not, because it is already evident from the file that the opponent's right to be heard was violated.

Whether the opponent's right to be heard was violated depends on whether the opponent was given the reasons why the opposition division had changed their mind, or at least why the opposition division no longer considered feature 1f to be disclosed in figures 13 to 16 of document E5. Both the minutes of the oral

proceedings and the contested decision merely contain a statement that feature 1f is not considered to be disclosed in E5, but no reasons why this conclusion was reached.

From the minutes it further follows that the opponent's arguments regarding document E5 are not reflected in the decision. It is for example clear from point 3.13 of the minutes that the opponent argued that figure 1 of E5 showed that the base surface was smaller than the cross section of the insert 51 and that this can be read onto figure 15. Detailed reasoning why feature 1f is considered disclosed in E5 by the opponent can also be found in the notice of opposition under point V.1.4. Neither the minutes nor the contested decision contains any reasoning as to why the opposition division was no longer of the opinion that feature 1f is disclosed in document E5, taking into account the opponent's arguments as presented in writing or during the oral proceedings.

According to point 3.18 of the minutes the opposition division just stated "*Referring to E5, the opposition division is of the opinion that feature 1f is not disclosed*". According to the contested decision, point 2.2, feature 1f "*is not disclosed in combination with the embodiments shown in figures 13-16*", although in the preliminary opinion the opposition division had found in point 6.3 that "*E2 ... and E5 (see figs. 13-16) disclose all features of claim 1.*"

In the absence of any reason why the visible gap in figure 15 of E5 was no longer interpreted as disclosing feature 1f, i.e. why the inset planar surface was no longer regarded as extending outwardly from the base end of the sparking tip, the contested decision cannot

be regarded as reasoned in the sense of Rule 111(2) EPC.

3.4 Merely for the sake of completeness the board also would like to mention the fact that a valid novelty attack based on document E1 was presented by the opponent in their notice of opposition under point V. 1.3, but this was not dealt with in the contested decision at all, although according to the minutes, point 3.16, the opponent had even explicitly referred to this attack during the oral proceedings. This untreated novelty attack alone would amount to a violation of the opponent's right to be heard.

3.5 The right to be heard requires that those involved be given an opportunity not only to present comments (on the facts and considerations pertinent to the decision) but also to have those comments considered, that is, reviewed with respect to their relevance for the decision on the matter. The deciding department must demonstrably hear and consider the comments (Case Law of the Boards of Appeal of the European Patent Office, 9th Edition, III.B.2.4.1 and 2.4.2).

The board therefore concludes that the opponent's right to be heard was violated.

4. Reimbursement of the appeal fee (Rule 103(1)(a) EPC)

It is established case law of the boards of appeal (see Case Law *supra*, V.A.9.5.8 and 9.5.9) that inadequate reasoning and a violation of the right to be heard represent substantial procedural violations in the sense of Rule 103(1)(a) EPC.

Consequently, the board has decided to remit the case to the department of first instance according to Article 111(1) EPC and Article 11 RPBA for proper consideration of the patentability of the subject-matter of the patent as granted, i.e. dealing with all arguments presented. The board further orders the reimbursement of the appeal fee according to Rule 103 (1) (a) EPC.

5. Admissibility of the patent proprietor's appeal

5.1 According to Article 107 EPC, any party to proceedings adversely affected by a decision may appeal.

In the present case, the opposition against European patent No. 2 033 285 was rejected. Thus, the right conferred by the patent is still valid in unamended form. The main request of the patent proprietor, i.e. to have the patent maintained as granted, was allowed by the rejection of the opposition. Thus, the patent proprietor is not adversely affected by the contested decision (see also T 73/88; reasons 1.3).

5.2 The board is not convinced by the patent proprietor's arguments regarding the validity of the priority claim. As a result of the decision of the opposition division to reject the opposition the patent was maintained as granted, thus including the priority claim. The fact that the opposition division concluded that the priority claim was not valid for the sole purpose of establishing whether document E5 was state of the art does not alter the fact that the priority claim continues to be included in the B-Publication and in the European Patent Register. The reasoning of the opposition division is also not binding on national

courts in infringement proceedings. Therefore, the alleged loss of the right to priority has not taken place and the argument of the patent proprietor, that the cited decision T 73/88 suffered from a fundamental flaw, is moot and thus does not convince the board. The fact that a patent proprietor is not adversely affected if an opposition division found a priority to be invalid, yet accedes to their main request, has also been confirmed in decisions T 84/02 and T 840/09.

The board therefore concludes that the patent proprietor's appeal is inadmissible.

6. Referral to the Enlarged Board of Appeal

6.1 The first proposed question of the patent proprietor is based on the assumption that in the contested decision, the European patent was maintained as granted but the entitlement to the priority date was denied. However, that does not reflect the legal effects of the contested decision, and therefore has no bearing on the present appeal.

Contrary to the patent proprietor's assumption, the contested decision is not a decision maintaining the patent in unamended form, but is instead a decision rejecting the opposition, as is explicitly laid down in Article 101(2), 2nd sentence EPC. A rejected opposition cannot have any effect on the patent, by definition. Thus, the opposition has no effect on the European patent. Therefore, the patent remains valid as if no opposition had been filed against it, i.e. including the valid claim to priority. As there is *de facto* no loss of the right to priority, the patent proprietor cannot be adversely affected. Therefore, the patent

proprietor is not entitled to appeal according to Article 107 EPC.

Consequently the alleged loss of the right to priority has not happened in the present case and there is no necessity to refer the corresponding question i) to the Enlarged Board of Appeal.

- 6.2 Question ii) is not decisive for the appeal either. Neither the contested decision nor the minutes contain reasons why the opposition division reversed its opinion. These facts have led to the board's conclusion that the contested decision is not sufficiently reasoned, and hence an answer to question ii) is not required to arrive at the board's conclusion.
- 6.3 Question iii) deals with the situation whether a violation of the right to be heard can be acknowledged without written proof of the violation. As is evident from the board's conclusion under 3.3 above, the question whether the opponent's right to be heard has been violated can be answered without an answer to question iii). Thus also question iii) is not decisive for the present appeal and no referral is required.
- 6.4 The board therefore concludes that it is not necessary to refer any of the three questions presented by the patent proprietor to the Enlarged Board of Appeal in order to answer a question related to uniform application of the law or to a point of law of fundamental importance in the sense of Article 112(1) (a) EPC. Consequently, the request for referral is refused.

Order

For these reasons it is decided that:

1. The case is remitted to the department of first instance for further prosecution.
2. Reimbursement of the opponent's appeal fee is ordered.
3. The patent proprietor's appeal is rejected as inadmissible.

The Registrar:

The Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated