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**Datasheet for the decision
of 24 August 2018**

Case Number: T 1401/16 - 3.2.05

Application Number: 09736456.6

Publication Number: 2331855

IPC: F16J15/32

Language of the proceedings: EN

Title of invention:

Energised seal

Applicant:

James Walker & Co. Ltd

Relevant legal provisions:

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

EPC R. 103(1)(a)

RPBA Art. 11

Keyword:

Substantial procedural violation - opportunity to comment (no)

- appealed decision sufficiently reasoned (no)

Remittal to the department of first instance (yes)

Reimbursement of appeal fee (yes)

Decisions cited:

R 0012/12



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Case Number: T 1401/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 24 August 2018

Appellant: James Walker & Co. Ltd
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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 27 January 2016
refusing European patent application No.
09736456.6 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman S. Bridge
Members: P. Lanz
D. Rogers

Summary of Facts and Submissions

I. The applicant appealed the decision of the examining division dated 27 January 2016 refusing European patent application No. 09736456.6 for lack of inventive step.

II. The documents referred to during the appeal proceedings include the following:

D1: US 5 245 741 A;

D2: US 2006/0022414 A;

E1: J.A. Brydson: *Plastics Materials*, Butterworth-Heinemann Ltd., Sixth Edition, 1995;

E2: A. Ahmed, J. Sturges: *Materials Science in Construction: An Introduction*, Routledge, 2015, page 222;

E3: V. Mittal: *High Performance Polymers and Engineering Plastics*, Scrivener Publishing LLC, 2011;

E4: *Industrial Plastics, Theory and Application*, Delmar Cengage Learning, Fifth Edition, 2010;

E5: Wikipedia web page "Interference fit" from 4 January 2009.

III. After an exchange of communications between the examining division and the applicant (appellant), the examining division summoned the appellant on 9 November 2015 to oral proceedings on 12 January 2016. In an annex to the summons, the examining division essentially stated that the subject-matter of claim 1 of the main request was not based on an inventive step: document D1

disclosed all features of claim 1 with the exception of the selection of the material for the energising band, which was, however, known from document D2. The subject-matter of claim 1 was therefore not based on an inventive step.

- IV. With letters dated 11 December 2015 and 11 January 2016, the appellant submitted two auxiliary requests. Moreover, it argued why document D1 could not render obvious the claims of the main request or of auxiliary requests 1 and 2, either alone or in combination with document D2. With the later of these two submissions, handbook excerpts E1 to E4 were provided in order to support the argument that the material selection claimed in auxiliary request 2 was not obvious for the person skilled in the art. Finally, the appellant announced that it would not attend the oral proceedings.
- V. On 12 January 2016, the examining division held oral proceedings in the absence of the appellant and decided to refuse the application due to a lack of inventive step starting from document D1. In its written decision, it was in particular held that, *inter alia* on the basis of the Wikipedia entry "Interference fit", the claimed feature of the flexible energising band could not inventively distinguish the subject-matter of claim 1 of the main request from document D1, which disclosed a reinforcement ring made of rigid plastic. The difference between claim 1 of the main request and document D1 resided in the list of plastic materials suitable for the energising band. However, in view of the rigid band of document D1 the choice of a non-metallic material was straightforward for the person skilled in the art. The same reasoning was valid for claim 1 of auxiliary request 1. Based on the Wikipedia

entry "Polysulfone", the examining division further concluded that polysulfone, despite being an amorphous polymer, was rigid, so that the subject-matter of claim 1 of auxiliary request 2 did not involve an inventive step and the application was refused.

VI. Claim 1 according to the main request on which the contested decision is based reads:

"A seal assembly comprising an elastomeric component having a sealing surface for providing a sealing function, and an energising band, the elastomeric component including an aperture for the energising band; wherein the aperture of the elastomeric component is generally circular and the outer diameter of the band is larger than the inner diameter of the aperture of the elastomeric component; wherein the energising band is flexible such that it can be deformed during installation in the elastomeric component and is adapted to fit in the aperture of the elastomeric component such that, in use, the energising band applies a sealing force to the elastomeric component; wherein the energising band component includes substantially non-metallic material; and wherein the material of the band includes one or more of PEEK, polyoxymethylene, aromatic polyether, polyphenylene sulphide, aromatic polysulphone, polyphenyl sulphone, polyamide, polyimide or polyamide-imide."

VII. Claim 1 according to auxiliary request 1 on which the contested decision is based differs from claim 1 according to the then main request in that the alternative "PEEK" is deleted.

VIII. Claim 1 according to auxiliary request 2 on which the contested decision is based differs from claim 1

according to the then main request in that the alternatives "*PEEK, polyoxymethylene, aromatic polyether, polyphenylene sulphide*" and "*polyamide, polyimide*" are deleted.

- IX. The appellant requested that the decision be set aside, that the application be sent back to the examining division for "*properly reasoned examination*" and that the appeal fee be refunded; alternatively, it requested that the application be accepted for grant on the basis of any of the main request and of auxiliary requests 1 or 2, all filed together with the statement setting out the grounds of appeal.
- X. The appellant's submissions at the appeal stage concerning the procedural issues of the examination proceedings may be summarised as follows:

The decision under appeal referenced documents which were never a part of the first-instance proceedings. In particular, the Wikipedia pages cited in the contested decision as evidence for the knowledge of the person skilled in the art had never been mentioned before. To rely upon such documents was a serious procedural violation. Further, the decision against the main request was nothing more than a cut-and-paste of the examination report arguments, no effort was made by the examining division to address the points raised by the applicant. With respect to auxiliary request 1, the examining division failed to justify their position with respect to the knowledge of the skilled person as clearly and unambiguously requested by the appellant. Concerning auxiliary request 2, the examining division based their objection on a Wikipedia page, again ignoring the comments provided by appellant, as well as the cited references E1 to E4 which were intended to

demonstrate the knowledge of the skilled person. The examining division thus did not examine the application in a fair and open manner allowing the applicant to understand why the arguments submitted were not considered to be of merit and to know the prior art being used to support the examining division's position. In view of these deficiencies, the appeal fee should be refunded. In addition, appellant should be provided the courtesy of having two instances to obtain a grant of this application, one where the examining division actually attempted to engage in the arguments provided by appellant and a second where, if that fails, the appellant could seek reconsideration of the decision before the board of appeal. Furthermore, in its reasoning on inventive step, the examining division relied on a version the Wikipedia entry "Interference fit", which had been created after the priority date of the application. The status of this Wikipedia page at the priority date was reflected in document E5. The latter did not support the examining division's reasoning.

Reasons for the Decision

1. *Alleged violation of the right to be heard*
- 1.1 The right of parties to a fair trial is a generally recognised procedural principle under Article 125 EPC, and to be observed in all proceedings before the European Patent Office. The predictability and verifiability of all state actions are indispensable elements of the rule of law and the respect of fundamental procedural rights. The right to be heard under Article 113 EPC is an embodiment of these fundamental principles. Under Article 113(1) EPC the *ratio decidendi* of decisions by the European Patent

Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. This also applies to evidence related to establishing the skilled person's common general knowledge (see for example R 12/12, Reasons 2).

Moreover, the right to be heard under Article 113(1) EPC 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. It has to be clear from the reasons that the substance of their core arguments has been addressed in arriving at the decision.

A decision which is based on a ground on which the party had no opportunity to present their comments and/or which fails to take into account the arguments submitted by a party, contravenes Article 113(1) EPC and constitutes a substantial procedural violation (see Case Law of the Boards of Appeal of the European Patent Office, 8th edition 2016, III.B.2.4.1).

1.2 In the case at hand, the question of inventive step of the subject-matter of claim 1 of all requests on file essentially hinges on

- whether or not the feature *"wherein the energising band is flexible such that it can be deformed during installation in the elastomeric component and is adapted to fit in the aperture of the elastomeric component such that, in use, the energising band applies a sealing force to the elastomeric component"* was disclosed in document D1 and on

- whether or not the proposed choice of materials for the energising band was obvious for a person skilled in the art at the relevant date of the application.

The board notes that the examining division bases its conclusions on these critical issues, at least in part, on two Wikipedia entries cited in the decision. However, this evidence was never referred to during the examination proceedings and both entries are mentioned for the very first time in the appealed decision itself. In consequence, the applicant had no opportunity to present their comments in that respect. This constitutes a violation of the provisions of Article 113(1) EPC.

- 1.3 In addition, in the letter dated 11 January 2016 (cf. page 2, penultimate paragraph) the appellant *inter alia* argued that materials such as polysulfones were known to be soluble in solvents, such as those that may be found in the use of the seals of the present application. In this regard, reference was made to page 479 of document E4, which was annexed to the appellant's letter. The appellant further submitted that, in view of this information, it would be counter-intuitive, and indeed surprising, that materials that were less resistant to solvents were used in the seal assemblies of the present claims. Consequently, the subject-matter of the present claims had to be considered inventive.

In the contested decision (cf. page 5, point 1), the examining division, based on a Wikipedia entry, essentially held that polysulfones were rigid and of high dimensional stability. Although not explicitly stated, it appears that, for this reason, it considered polysulfone to be an obvious choice for the rigid

plastic ring of document D1 (cf. column 4, lines 18 and 19). However, the decision under appeal does not address the appellant's above argument based on document E4 that the reduced resistance to solvents would lead to the skilled person away from using polysulfone as a material for the seal assembly of the present claims. The fact that the examining division did not verifiably take into account this argument submitted by the appellant on a crucial aspect of the present case constitutes a further violation of the appellant's right to be heard.

1.4 The board concludes that the examining division did not respect the provisions of Article 113(1) EPC when taking the decision under appeal. This amounts to a substantial procedural violation in the sense of Rule 103(1) (a) EPC.

2. *Remittal of the case*

2.1 Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA) provides that a case shall be remitted to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

2.2 No such reasons are apparent in the present case. On the contrary, the appellant as the party concerned by the procedural violation explicitly requests the remittal of the case. In addition, it would appear appropriate for the examining division to explicitly establish what belongs to the state of the art and the skilled person's common general knowledge at the relevant date of the application before drawing any conclusions concerning the question of inventive step,

duly taking into account the applicant's case and preferably using the problem-solution approach.

The board thus exercises its discretion under Article 111(1) EPC and Article 11 RPBA to set the decision aside and remit the case to the examining division for further prosecution.

3. *Reimbursement of the appeal fee*

Since the decision is set aside and in view of the serious procedural violation established in point 1 above, the appeal fee is to be reimbursed in accordance with 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 examining division for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:



L. Malécot-Grob

S. Bridge

Decision electronically authenticated