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**Datasheet for the decision
of 10 July 2024**

Case Number: T 2241/19 - 3.4.02

Application Number: 07789472.3

Publication Number: 2052447

IPC: H02B7/01, E21B41/00,
H02B13/035, E21B33/035

Language of the proceedings: EN

Title of invention:
A Subsea Switchgear Apparatus

Patent Proprietor:
Vetco Gray Scandinavia AS

Opponent:
Siemens Energy Global GmbH & Co. KG

Headword:
Substantial Procedural Violation/VETCO GRAY SCANDINAVIA

Relevant legal provisions:
EPC Art. 111(1)
EPC R. 111(2)
RPBA 2020 Art. 11

Keyword:

Substantial procedural violation (yes)

Transfer of status as opponent (acknowledged)

Decisions cited:

R 0005/19, G 0002/04, G 0004/88



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 2241/19 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 10 July 2024

Appellant: Siemens Energy Global GmbH & Co. KG
(Opponent) Otto-Hahn-Ring 6
81739 München (DE)

Respondent: Vetco Gray Scandinavia AS
(Patent Proprietor) P.O. Box 423
1302 Sandvika (NO)

Representative: Illingworth-Law, William Illingworth
Baker Hughes
245 Hammersmith
Chalk Hill Road
London W6 8DW (GB)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
24 May 2019 concerning maintenance of the
European Patent No. 2052447 in amended form.**

Composition of the Board:

Chairman R. Bekkering
Members: F. Giesen
B. Müller

Summary of Facts and Submissions

- I. This appeal was filed by the original opponent (Siemens Aktiengesellschaft) against the interlocutory decision of the opposition division to maintain the patent in amended form according to the sole request.
- II. The board will refer to documents E1, E3, E6, and E8, as well as (a) to (n).

E1 WO 02/41336 A1

E3 US 2006/0131143 A1

E6 US 4,241,379

E8 US 4,767,351

(f) Abspaltungs- und Übernahmevertrag zwischen Siemens AG und Siemens Energy AG, Auszug aus der Urkunde Nr. 1167 G/2020, München, 22 May 2020

(k) Auszug aus dem Handelsregister, chronologisch, Siemens Energy Global GmbH & Co. KG, München, 15 October 2020

(m) Auszug aus der Niederschrift der Gesellschafterversammlung der Siemens Gas and Power GmbH & Co. KG, 20 December 2019

(n) Agreement on the Transfer of Pending Litigation between Siemens AG and SE Global

It is not necessary for the purposes of this decision to individually identify the other documents. Reference is made to the electronic file.

III. The written requests of the parties are as follows:

The appellant (opponent) requests that the decision under appeal be set aside and the patent be revoked.

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

IV. With the letter of 14 June 2023 the company Siemens Energy Global GmbH & Co. KG (hereinafter: "SE Global"), the other party, requested the transfer of the status as an opponent from the original opponent/appellant Siemens Aktiengesellschaft to itself.

In support of this request, SE Global filed a number of documents labelled (a) to (l) and announced that two additional documents (m) and (n) would be filed with a subsequent letter.

SE Global requested that documents (a) to (l) be not added to the public file. Consequently, the board provisionally excluded documents (a) to (l) from file inspection pending a final decision on the request (pursuant to Article 1(2) and (3) of the *"Decision of the President of the European Patent Office dated 12 July 2007 concerning documents excluded from file inspection"*, originally published in OJ EPO 2007, Special edition No. 3, 125, published again in Supplementary publication 1, OJ EPO 2020, 102).

On 15 June 2023, SE Global filed a further letter, together with the two announced annexes (m) and (n) again requesting that they not be added to the public file. Further to SE Global's request, the letter and

the two annexes were likewise provisionally excluded from file inspection.

- V. With the interlocutory decision dated 24 January 2024, the board decided that the requests for exclusion from file inspection of 14 and 15 June 2023 were refused.
- VI. SE Global withdrew the request for oral proceedings on 16 June 2023 provided that the board remitted the case to the opposition division due to a substantial procedural violation.
The respondent withdrew its request for oral proceedings on 26 June 2023 on the condition that the board remitted the case to the opposition division.
- VII. With the communication dated 6 February 2024 the board informed the parties that, taking into account all documents (a) to (n), the board tended to accept the request for transfer of the status as an opponent. On 4 April 2024, the respondent made objections to such acceptance. In a further communication of 17 April 2024 the board asked the respondent to clarify whether its withdrawal of the request for oral proceedings of 26 June 2023 covered the request of transfer of the status as an opponent.
- VIII. With a letter dated 5 June 2024, the respondent informed the board that the request for oral proceedings was withdrawn provided that the board remitted the case to the opposition division, regardless of the board's decision regarding the transfer of the status as an opponent.
- IX. Claim 1 of the sole request reads as follows:

"A subsea switchgear apparatus comprising:

*a frame (10);
at least one electrical power inlet (11) mounted to
the frame (10);
at least one electrical power outlet (12) mounted
to the frame (10);
a distribution chamber (31) mounted to the frame
(10);
at least one canister (20) mounted to the
distribution chamber (31) and comprising a chamber
(21) accommodating at least one high voltage
circuit breaker (22);
electrical connections (32) arranged in the
distribution chamber (31) for electrically
connecting the respective circuit breaker (22) of a
canister (20) to the associated power inlet (11)
and power outlet (12) of the switchgear apparatus
(1);
the chamber (21) of the respective canister (20)
being separated from the distribution chamber (31)
by a pressure barrier (23);
wherein the respective canister (20) constitutes a
pressure vessel, the chamber of the canister being
filled with gas."*

Claims 2 to 17 of the sole request are dependent on
claim 1.

Reasons for the Decision

1. *Admissibility of the appeal*

The appeal was filed by the original opponent (Siemens Aktiengesellschaft). At the time of filing of the appeal, no request for the transfer of the status as opponent had been made.

The appeal meets the requirements of Articles 106 to 108 EPC and Rule 99 EPC. The appeal has been in compliance in particular with Article 107, first sentence, EPC, both as long as it stood in the name of the original opponent and subsequently, from the point in time when the transfer of the status as an opponent to SE Global, the other party to the appeal proceedings, became valid (see below, point 3). It is therefore admissible.

2. *Decision in written proceedings*

The decision is handed down in written proceedings pursuant to Article 12(8) RPBA.

The board acknowledges the transfer of the status as an opponent taking effect on 15 June 2023, see point 3.4 below. The new opponent and appellant withdrew the request for oral proceedings one day later on 16 June 2023 provided that the board remitted the case to the opposition division due to a substantial procedural violation. The board is therefore satisfied that the new opponent was entitled to this procedural act.

The respondent withdrew the request for oral proceedings on 5 June 2024 provided that the board remit the case to the opposition division due to a substantial procedural violation and irrespective of the board's decision on the transfer of the status of opponent.

The reasons for this decision were communicated to the parties in the communication pursuant to Article 15(1) RPBA annexed to the summons to oral proceedings dated 16 May 2023, as well as the communications dated 6 February 2024 and 17 April 2024. The parties were afforded the opportunity to comment.

3. *Transfer of the status as an opponent*

3.1 The board acknowledges the transfer of the status as an opponent.

3.2 According to the case law of the boards of appeal the party status as an opponent cannot be freely transferred (see G 2/04, OJ EPO 2005, 549). However, it may be transferred in opposition and opposition appeal proceedings as part of the opponent's business assets together with the assets in the interests of which the opposition was filed (see G 4/88 headnote; T 2357/12, reasons 2 to 4; and Case Law of the Boards of Appeal of the European Patent Office, 10th edition, July 2022 ["CLBA"], III.O.2).

3.3 The case law of the boards of appeal suggests that the transfer needs to be requested and that it can only be acknowledged as from the date when adequate evidence is produced (see CLBA, III.O.2.6 and references cited therein).

3.4 The board considers that the submissions of SE Global establish the transfer of the business assets relating to the patent in suit from Siemens AG to SE Global taking effect on 15 June 2023.

SE Global's letter of 15 June 2023, together with documents (m) and (n) annexed thereto, establish that the present opposition appeal proceedings were transferred from Siemens AG to SE Global. This conclusion is based in particular on the following passages of the "*Agreement on the Transfer of Pending Litigation*" (document (n)) between Siemens AG and SE Global:

Preamble (C)

"Under Article 11.1 of the Contribution Agreement [between Siemens AG and Siemens Gas & Power GmbH & Co. KG, being part of annex (m)] the Parties may agree that certain Pending Legislations be transferred from Transferor to Transferee."

Article 1, Point 1.3

"Parties hereby confirm their earlier agreement that Transferor transferred the Transferred Pending Litigation to Transferee with effect from the Effective Date."

Preamble (D)

"Pending Litigation is defined in the Contribution Agreement and means any court or administrative proceedings, including litigation, arbitral proceedings and opposition, arising from the Transferred Business, including those centrally managed cases set out in Annex 8.1.5 to the Contribution Agreement, pending on the Effective Date."

Article 1, point 1.1 specifies that the present appeal proceedings are transferred.

Siemens Energy Global GmbH & Co. KG (SE Global) is the amended company name of former Siemens Gas & Power GmbH & Co. KG being party to the Contribution Agreement; see SE Global's letter of 14 June 2023, page 5, together with annexed document (f), and the extract of the company register, document (k).

- 3.5 The board also has no doubts that the opposed patent is part of the business assets which were transferred. It is in the technical field of subsea switch gear. According to document (n), Article 1, point 1.2 the patent concerns a subsea switchgear, which is a solution for energy transmission in a subsea environment.

4. *Substantial procedural violation*

- 4.1 The board considers that a substantial procedural violation occurred in the opposition proceedings. The decision under appeal is not sufficiently reasoned within the meaning of Rule 111(2), first sentence, EPC, because it does not address an objection which, at least potentially, could have changed the decision.

- 4.2 While the appellant did not request remittal originally, the board could verify whether or not the right to a reasoned decision pursuant to Rule 111(2), first sentence, EPC was complied with by the department of first instance of its own motion, in analogy to CLBA, III.B.2.1 relating to Article 113(1) EPC.

4.3 In the notice of opposition, in point V. on page 14, the appellant raised an objection that the subject-matter of dependent claim 2 as granted, which is identical to claim 1 of the sole request in opposition and appeal, did not involve an inventive step in view of document E8 as closest prior art in combination with document E6.

4.4 The decision under appeal does not contain any reasoning and conclusion concerning this objection, be it explicit or implicit. Therefore the decision does not meet the requirements of Rule 111(2), first sentence, EPC.

4.5 The board is aware that the opposition division informed the parties in point 6.3.1 of the annex to the summons to oral proceedings dated 15 June 2018 of their preliminary opinion according to which the subject-matter of claim 1 of the sole request appeared to involve an inventive step in view of document E8 in combination with E6.

However, the final decision must address all those objections which could potentially have led to a different outcome in order to comply with the requirement of Rule 111(2) EPC. The objection in question had at least the potential to change the outcome of the case.

4.6 The board currently cannot discern any declaration or action by the opponent that could be taken to be an explicit or implicit abandonment of the objection of lack of inventive step in view of E8 as closest prior art in combination with document E6.

- 4.6.1 In the board's view, neither the minutes nor the decision under appeal contain any explicit declaration by the opponent to this effect.
- 4.6.2 They also do not reflect any implicit abandonment.

According to the minutes, point 10

"[the opponent] was then [after a discussion of novelty] requested to begin his arguments with the grounds relating to Art. 100(a) EPC by identifying the most promising closest prior art document and using the feature analysis as appended to the summons".

In the following, objections based on E1 in combination with E10 as well as E3 in combination with E10 were discussed.

By discussing these objections, the opponent merely followed the chairman's conduct of the oral proceedings but did not implicitly abandon any or all further objections besides those discussed. The opposition division accepted a discussion of inventive step starting from documents E1 or E3 as starting point. Due to this fact, the opponent could not assume that the opposition division had implicitly dealt with the further objection based on E8 in combination with E6 by only accepting a single piece of prior art or only exclusively accepting E1 or E3 as the starting point for the assessment of inventive step.

According to point 28 of the minutes, the opponent declared that he had no *"further objections to raise"*. However, objections presented in writing do not need to be repeated at the oral proceedings in order for the

deciding body to have an obligation to taken them into account in the final decision, see for example decision R 5/19, reasons 3.6. Therefore, this statement also can not be considered an implicit abandonment.

- 4.7 There was thus at least no clear abandonment. Therefore, the opposition division could not legitimately assume that the objection in question was abandoned. Rather in case of doubt it would have been incumbent on them to clarify the procedural situation.
- 4.8 It follows that the decision under appeal does not contain reasons concerning the objection of lack of inventive step based on E8 as closest prior art in combination with document E6. Not presenting reasons in the decision under appeal concerning this objection adversely affected the opponent-appellant's right to a sufficiently reasoned decision.

5. *Remittal*

- 5.1 The board finds the appeal to be allowable due to the substantial procedural violation found in point 4 above. It remits the case to the opposition division pursuant to Article 111(1), second sentence, EPC in conjunction with Article 11 RPBA.
- 5.2 According to Article 11 RPBA, the board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.

5.3 It is apparent from the preceding considerations that the proceedings before the opposition division are tainted by a substantial procedural violation, which, at least in this case, also constitutes a fundamental deficiency within the meaning of Article 11 RPBA. (CLBA, V.A.9.4.3)

6. *Reimbursement of the appeal fee*

6.1 The board deems the appeal to be allowable given the substantial procedural violation found above (in point 4). Pursuant to Rule 103(1)(a) EPC, the board deems reimbursement of the appeal fee equitable by reason of that violation.

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 in full.

The Registrar:

The Chairman:



H. Jenney

R. Bekkering

Decision electronically authenticated