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**Datasheet for the decision  
of 19 February 2024**

**Case Number:** T 1529/20 - 3.5.02

**Application Number:** 14190170.2

**Publication Number:** 2869436

**IPC:** H02K3/48, H02K15/00, H02K15/12

**Language of the proceedings:** EN

**Title of invention:**  
Vibration damage repair in dynamoelectric machines

**Patent Proprietor:**  
General Electric Company

**Opponent:**  
Andritz AG

**Relevant legal provisions:**  
EPC Art. 108, 113(1), 133, 134  
EPC R. 79(1), 81, 103(1)(a), 125(2), 126(2), 129, 130

**Keyword:**

Admissibility of appeal - (yes)

No proof of receipt of communication under Rule 79(1) EPC

Right to be heard - opportunity to comment (no) - violation  
(yes)

Reimbursement of appeal fee - equitable by reason of a  
substantial procedural violation

**Decisions cited:**

R 0015/11, R 0004/17, R 0006/19, J 0009/05, T 0247/98,

T 1535/10, T 0966/17, T 2037/18, T 1219/19



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Case Number: T 1529/20 - 3.5.02

**D E C I S I O N**  
**of Technical Board of Appeal 3.5.02**  
**of 19 February 2024**

**Appellant:** General Electric Company  
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**Representative:** de Rooij, Mathieu Julien  
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**Respondent:** ANDRITZ AG  
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**Representative:** Wirnsberger & Lerchbaum Patentanwälte OG  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 6 April 2020  
revoking European patent No. 2869436 pursuant to  
Article 101(2) EPC.**

**Composition of the Board:**

**Chairman** R. Lord  
**Members:** H. Bronold  
A. Bacchin

## **Summary of Facts and Submissions**

- I. The appeal of the patent proprietor lies from the decision of the opposition division revoking European patent No. 2 869 436.
- II. During the whole opposition proceedings, no reply of the proprietor to the communications of the opposition division or to the invitation to give notice of the appointment of a professional representative was received. The opposition division issued a direct decision refusing the patent in writing without prior communication of its preliminary opinion less than two months after the time limit to file observations set according to Rule 79(1) EPC had expired.
- III. In a communication under Article 15(1) RPBA sent together with the summons to oral proceedings, the board indicated its preliminary opinion that the appeal was admissible and that it intended to remit the case to the opposition division and to reimburse the appeal fee due to a substantial procedural violation.
- IV. Neither party filed a written response in substance to the board's preliminary opinion.
- V. Oral proceedings before the board took place on 19 February 2024 as a videoconference, as requested by both parties.
- VI. The appellant (patent proprietor) requested that the decision under appeal be set aside, that the case be remitted to the opposition division because of a substantial procedural violation in the first instance

proceedings, that after remittal a four month time limit be set for them to file observations on the notice of opposition, and that the appeal fee be reimbursed (main request).

As first auxiliary request the appellant requested that the decision under appeal be set aside, that the case be remitted to the opposition division, that after remittal an appropriate time limit be set for them to file observations on the notice of opposition.

As second auxiliary request the appellant requested that the decision under appeal be set aside and the patent be maintained as granted.

Further, the appellant requested that the decision under appeal be set aside and that the patent be maintained on the basis of the claims of either the third or fourth auxiliary request, both filed with the statement of grounds of appeal.

VII. The respondent (opponent) requested as main request that the appeal be rejected as inadmissible, or as auxiliary request that the appeal be dismissed.

VIII. The parties' arguments which are of particular relevance for the decision are detailed below together with the reasons for the decision.

## **Reasons for the Decision**

### 1. Admissibility of the appeal - Article 108 EPC

In the present case there are two issues at stake concerning admissibility of the appeal, namely (i) whether the appeal was timely filed and (ii) whether the appellant was negatively affected by the opposition division's decision, the latter issue having been raised by the respondent.

#### 1.1 (i) According to Article 108, first sentence, EPC a notice of appeal shall be filed, in accordance with the Implementing Regulations, at the European Patent Office within two months of notification of the decision.

In the present case the decision of the opposition division is dated 6 April 2020 and following the legal fiction set by Rule 126(2) EPC, in the version applicable until 31 October 2023 (see Rule 126 EPC after the amendment introduced with CA/D 2/19, in OJ EPO 2019, A31 and after CA/D 10/22 in OJ EPO 2022, A101), was deemed to be notified to the parties on the tenth day following its handover to the postal service provider, i.e. on 16 April 2020.

Notification was done to the then proprietor and not to the representative, as would have been required by Rule 130(1) EPC, since in the relevant period the appellant was not represented by a professional representative.

#### 1.2 The appellant submitted that they had never received the opposition division's decision and that they had

become aware of it and more generally of the opposition proceedings only by an email of an employee of the EPO, PA admemp patent FO Team Central Formalities MU, Dir 1.2.5.1 dated 26 June 2020, 6 pm.

- 1.3 The legal fiction indicated under Rule 126(2) EPC above is rebutted if the registered letter had failed to reach the addressee or had reached them at a later date. In the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee.
- 1.4 With the abolition of advices of delivery for notification of decisions by registered letter (see CA/D 2/19 in OJ EPO 2019, A31), it was the practice of the EPO at the relevant time to enclose an acknowledgement of receipt (Form 2936) with notifications by registered letter of decisions incurring a period for appeal and summonses. Addressees were requested to date and sign the form and return it immediately, as evidence of receipt (see points 3 and 5 of the Notice on Rule 126(1) EPC, indicated in OJ EPO 2019, A57).
- 1.5 However in the present case such confirmation of receipt for the decision of the opposition division was available in the file from the then opponent (respondent) only, but not from the then patent proprietor (appellant).
- 1.6 For the purposes of Rule 126(2) EPC, the present board therefore initiated a postal investigation concerning the delivery of the decision dated 6 April 2020 (parcel number: RD432322983NL), within one year from the date in which the decision was posted. The outcome of the investigation carried out by the responsible service

provider was negative, as the postal provider could not track any delivery of the parcel to the addressee, and the parcel had thus to be declared lost.

- 1.7 Since the EPO could not prove whether the registered letter reached the appellant, as required by Rule 126(2) EPC, it must be accepted that the legal fiction of deemed notification did not apply and the appellant became aware of the appealed decision for the first time with the email on 26 June 2020. This date is therefore the date of notification of the decision.

A further notification of the decision is not necessary since the proprietor acknowledged to have become fully aware of the decision and of its content at that time.

- 1.8 Notice of appeal was filed on 30 June 2020, together with the payment of the appeal fee. A statement of grounds of appeal was filed on 28 August 2020. The appeal was received within the appeal period and is therefore to this extent admissible.

- 1.9 (ii) The respondent has objected to the admissibility of the present appeal for the reason that, since the appellant did not present any request in the first instance proceedings, they are not negatively affected by the opposition division's decision (Article 107 EPC). The respondent bases this argument on the assumption that the appellant received all of the EPO's notifications, but chose not to react.

- 1.10 The board does not share the respondent's view in this regard. The lack of participation of the then proprietor to the opposition proceedings, particularly the fact that they were prevented from filing any



submission and requests during the opposition proceedings as they became aware of those proceedings for the first time when they discovered that a decision had already been issued, is actually the main reason for the present appeal. Since as indicated below the board has reached the conclusion that a substantial procedural violation occurred, because it was not shown that the appellant had actually received the notice of opposition, the appellant cannot be penalised for not having reacted to the opposition. Under these circumstances, the question whether the appellant had to be regarded as negatively affected does not have any merit on admissibility of the appeal.

The appeal is therefore admissible.

2. Right to be heard - Article 113(1) EPC

The alleged violation of the right to be heard under Article 113(1) EPC is substantially based on the fact that the appellant was not given the possibility to participate in the opposition proceedings and take position on the opposition.

2.1 The appellant brought forward the argument that they received neither the communication pursuant to Articles 133 and 134 EPC inviting them to give notice of the appointment of a professional representative dated 6 June 2019, nor the communication informing them about the notice of opposition against European patent No. 2 869 436 dated 18 September 2019 (EPO Form 2316), nor the communication under Rule 79(1) EPC dated 4 October 2019, giving them the opportunity to file observations and amendments in response to the opposition (EPO Form 2317). With respect to the first,

there was not even an entry into the European Patent Register.

Further, the appellant allegedly only learned about the decision to revoke the patent by an email of an employee of the EPO dated 26 June 2020 reminding them to appoint a new professional representative.

2.2 The respondent essentially argues that it was not plausible that the appellant had not been aware of the fact that the previous representative had withdrawn its representation. They contend that the withdrawal of representation by the former representative concerned plural files of the appellant for some of which the appellant had appointed new representatives and for some not. Since the withdrawal was also present in the files for which new representatives were appointed the appellant must have been aware of the fact that the former representative had withdrawn its representation. They also argued that the appellant had to be aware of the withdrawal of representation because it was its own subsidiary that had withdrawn the representation for the plurality of files.

2.3 The board does not agree with the respondent. There are two distinct issues related to the submitted violation of the right to be heard: the first concerning the invitation to appoint a professional representative under Articles 133(2) and 134 EPC and the second, and most important one, concerning the notification of the notice of opposition. The board considers it essential that a party is informed that opposition proceedings against their patent have been initiated.

2.4 The respondent submitted that no substantial procedural violation was committed by the opposition division,

which acted fully in line with the legal framework and actually had no obligation to investigate delivery of any communication under the present circumstances.

2.4.1 The board cannot accept this argument. While it is correct that, as the respondent argued, the opposition division had complied with the Notice from the European Patent Office dated 16 June 2019 concerning implementation of amended Rule 126(1) EPC (OJ EPO 2019, A57) not to enclose an acknowledgement of receipt (Form 2936) with the invitation to appoint a professional representative and with the communication of the notice of opposition, the board is not convinced that as a consequence, no violation of the right to be heard had occurred, as further argued by the respondent.

2.5 As correctly pointed out by the appellant, even the Notice from the European Patent Office dated 16 June 2019 contains in point 5. the clarification that:

*"For the sake of completeness, it is noted that all other provisions governing notification will remain unaffected, in particular those in Rule 126(2) EPC."*

and that

*"In the event of any dispute, it will still be incumbent on the EPO to establish either that the notification has reached its destination or to establish the date on which it was delivered to the addressee."*

2.6 The Notice of the European Patent Office thus merely determines the format of notifications which is already apparent from its introductory paragraph

*"By decision dated 28 March 2019 the Administrative Council of the European Patent Organisation amended Rule 126(1) EPC to discontinue the use of advices of delivery."*

- 2.7 It does not contain any information about "when" a document is considered to be notified. Most importantly, it is expressly stated that the provisions of Rule 126(2) EPC remain unaffected, so that the obligation of the EPO to establish whether a letter has reached its destination or the date of its delivery to the addressee, continues to apply.

Therefore, the respondent's conclusion that compliance with the Notice rules out the possibility of a violation of the right to be heard has no factual basis.

- 2.8 Further, the provisions of Rule 126(2) EPC in force at the relevant time define a rebuttable fiction of notification, which, in case of dispute, has to be verified. It therefore does not represent a conclusive definition of "when" a document is actually notified. This is clear already from the wording of Rule 126(2) EPC which explicitly points to the possibility of dispute regarding notifications and clearly defines the burden of proof regarding such notifications to lie with the European Patent Office.

- 2.9 The respondent's argument, that the burden of proof regarding notification was on the appellant's side thus has no legal basis in the EPC. To the contrary, the board agrees with the appellant that a party submitting that something has not happened, i.e. that a communication was not received, is in difficulties in trying to prove a negative (*negativa non sunt probanda*,

see also T 2037/18, reasons 4 and 8; R 15/11, Reasons 5 and R 4/17, Reasons 4). The filing of cogent evidence showing that a letter was not received is hardly ever possible (see also J 9/05, Reasons 3). Therefore, the respondent's arguments that the appellant allegedly had the duty to register mail incoming at their premises but failed to provide an excerpt of such register is not pertinent, since there is no trace in the file that the EPO discharged its burden of proving delivery of any of the above mentioned communications. Accordingly, the submissions that it was plausible that the appellant had in fact received the notice of opposition and the invitation to appoint a representative, is purely speculative.

Under such circumstances, the appellant does not have to bear the risks normally falling in their sphere of responsibility, (T 1535/10, Reasons 1.5.1 and 1.5.2), so that they have to be given the benefit of the doubts (J 9/05, Reasons 4 and 8).

The board does not disregard that Rule 126(2) EPC refers to a dispute ("im Zweifel", "en cas de contestation") for the EPO's burden of proof, nor that the mere absence of the advice of delivery or the receipt from the file is not in itself sufficient to give rise to a dispute (see T 247/98, Reasons 2.1 and 2.6).

However in this case the appellant when filing the appeal has immediately disputed having received *inter alia* the communication of the notice of opposition and the communication under Rule 79(1) EPC.

In addition, this board takes the view that under the present circumstances legal certainty and the

protection of the right to be heard in relation to the initiation of opposition proceedings, would have required that the opposition division established, by any available means, the fact and date of delivery of the communication of the notice of opposition also before a dispute was formally raised, when the appellant was not yet in the position of raising a "dispute" on delivery.

- 2.10 In the case of opposition proceedings initiated against a patent, it is essential that the patent proprietor is duly notified of the initiating document, i.e. the notice of opposition, before a negative decision against the proprietor can be issued.

Opposition proceedings are *inter partes* proceedings and, due to their adversarial character, the principle of the protection of the right to be heard acquires a particular importance. The provisions of Articles 101 and 102 EPC as well as the corresponding provisions of the Implementing Regulations are there to ensure that in principle both parties are given equal rights and sufficient opportunity to present their case. A decision cannot be taken without making sure that the parties to the proceedings effectively participate to them.

- 2.10.1 As a matter of principle, the notice of initiation of proceedings must be duly served on the persons/legal entities against whom the decision takes effect or who/which may be adversely affected by it. Accordingly, the communication of the notice of opposition and the communication under Rule 79(1) EPC to the proprietor of the patent have the function to make known to the patent proprietor that proceedings have been initiated, which are capable of affecting their legal position.

They also trigger the exercise of the proprietor's rights as a party to the proceedings through the submission of observations, documents and amendments to the patent within a period to be specified.

- 2.10.2 The patent proprietor may decide not to react to the notice of opposition. Nevertheless the communication under Rule 79(1) EPC does not constitute a mere formality, rather it has the function of allowing the patent proprietor to both contribute to the opposition division's appreciation of the facts and to defend its interests. In fact Rule 79 EPC expresses the obligations of the opposition division for clarifying the proprietor's position in the opposition. This communication forms the basis for the preparation of the factual examination of the opposition (Rule 81(1) EPC), including the collection of all documents.

A patent proprietor who does not react or reacts late to the notice of opposition however runs the risk of compromising their defence. For instance, whereas the opposition division has in principle no discretion not to admit submissions filed within the time limit under Rule 79(1) EPC (*The Opposition Division shall...give him the opportunity to file his observations and to amend, where appropriate, the description, claims and drawings within a period to be specified*), submissions filed at a later stage, such as under Rules 81(3) or 116(2) EPC, are subject to the opposition division's discretion not to admit them (see R 6/19, Reasons 6 to 11, T 966/17, Reasons 2.2.1, T 1219/19, Reasons 39).

- 2.11 In the present case, it was not established whether the the notice of opposition (Rule 79(1) EPC) had reached the patent proprietor. Nevertheless, the opposition

division started to examine the opposition and decided to revoke the patent in a written procedure within only seven weeks after the period set for reply to the notice of opposition had expired.

No attempts at investigation by the opposition division whether the proprietor had been duly informed about the opposition proceedings against their patent are apparent from the file for the period between the filing of the notice of opposition and the decision revoking the patent. Although the contested decision under VI. contains a statement that the proprietor was informed about the notice of opposition in a communication dated 18 September 2019, no proof of delivery is mentioned in the contested decision and the file contains no proof of delivery. Thus, the opposition division's conclusion, that the proprietor had been informed has no factual basis.

The email by an employee of the EPO dated 26 June 2020, which the appellant considers the first point of time of having been informed about the opposition proceedings, dates from almost three months after the decision revoking the patent was issued (6 April 2020).

This course of events deprived the proprietor of the opportunity to defend their patent from the very beginning of the opposition, thereby amounting to a violation of their right to be heard, as embodied in Article 113 EPC.

- 2.12 This holds true even more since, as is evident from the file, the opposition division was aware that a problem in communicating with the proprietor existed because already the communication of the notice of opposition dated 18 September 2019 contained as an enclosure an



invitation to give notice of the appointment of a professional representative and the communication under Rule 79(1) EPC dated 4 October 2019 contained a notice that without a professional representative the proprietor could not take any valid procedural steps in the opposition proceedings, together with a reference to Article 133(2) EPC. No answer had been received with respect to these communications. No postal investigation regarding the notification of the communication of the notice of opposition or the communication under Rule 79(1) EPC setting a time limit of 4 month for filing observations and amendments had been initiated by the opposition division subsequently. In the presence of such serious doubts the opposition division could not just consider that the time limit for the proprietor's reaction to the opposition had been duly triggered.

Thus, even in view of the above mentioned Notice of the European Patent Office dated 16 June 2019 concerning implementation of amended Rule 126(1) EPC (OJ EPO 2019, A57), the requirements of Article 113 EPC must be complied with, so that before a negative decision revoking a patent is issued, it has to be established that the patent proprietor has been duly informed about the initiation of opposition proceedings.

2.13 The board finds that the opposition division, faced with the difficulties of notification by registered letter, should not have just continued opposition proceedings. Rather, it should have first made all necessary investigations such as postal investigations or attempts to reach the appellant otherwise, as it appeared possible with the email sent after issuing the final decision. In order to ensure a legally sound notification of the relevant documents, they could have

even opted for a notification by public notice according to Rule 125(2)(d) EPC in conjunction with Rule 129 EPC. The board is aware that under the applicable legal framework it was no longer required to enclose advices of delivery, or that a public notification would not have been required in the present case, because the letter was not returned (Rule 129(1) EPC). However, even if not required by law, nothing prevents the taking of additional measures to ensure legal certainty when there are serious doubts as to whether a procedurally relevant notification, such as the one concerning the notice of opposition, has actually reached the addressee. For this reason, the board also finds that there is no need to consider whether the existing legal framework of notifications is insufficient, as was suggested by the respondent during the appeal oral proceedings.

- 2.14 In this context the respondent's argument that in addition to the protection of the right to be heard also the interest of the public in getting invalid patents revoked must be taken into account must fail. A balance of interests between a proprietor and the public requires first of all that the same rights are guaranteed to both sides, including the right to effectively participate to the adversarial proceedings.
- 2.15 Neither does the board find the respondent's argument convincing, that endorsing the appellant's submissions would encourage a practise in the first instance for proprietors not to react to a notice of opposition in order to prolong a state of uncertainty. It is not only purely speculative, but simply not credible that a patent proprietor would intentionally not react to a notification that opposition proceedings have been initiated and to the possibility to make submissions

and file amendments, thereby running the risk that their patent is revoked. Therefore the board does not agree that a procedural deficiency was artificially construed just for the purpose of prolonging the existence of a patent.

- 2.16 As correctly argued by the appellant, the missing opportunity to present their arguments during the opposition proceedings amounts to a substantial procedural violation in the sense of Article 113(1) EPC. The board further considers that since the initial act of (non-)notification of the notice of opposition was flawed, the entire opposition proceedings including the decision of the opposition division was flawed.
- 2.17 The board consequently concludes that the contested decision is to be set aside and the case is to be remitted to the department of first instance.

As to the appellant's request that certain time limits should be given by the opposition division after remittal in order to allow the proprietor to reply to the notice of opposition, the board considers that this is an issue which, subject to the requirements of the EPC, falls within the competence of the opposition division.

### 3. Reimbursement of the appeal fee

According to Rule 103(1)(a) EPC reimbursement of the appeal fee shall be ordered where the board of appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural

violation. A substantial procedural violation is an objective deficiency affecting the entire proceedings (see J 7/83, OJ 1984, 211, Reasons 12).

In the present the case the lack of a due notification of the notice of opposition and, irrespective of that, the continuation of the opposition proceedings with the issuance of the decision, prevented the appellant from participating to the whole opposition proceedings, thus violating its right to be heard. Under these circumstances, a reimbursement of the appeal fee is equitable.

## 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 Chairman:



U. Bultmann

R. Lord

Decision electronically authenticated