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**Datasheet for the decision  
of 1 August 2014**

**Case Number:** T 1855/13 - 3.2.07

**Application Number:** 01983061.1

**Publication Number:** 1337345

**IPC:** B04B7/08

**Language of the proceedings:** EN

**Title of invention:**

A CENTRIFUGAL SEPARATOR AND A CENTRIFUGE ROTOR

**Patent Proprietor:**

Alfa Laval Corporate AB

**Opponent:**

Flottweg AG

**Headword:**

**Relevant legal provisions:**

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

**Keyword:**

Appealed decision - reasoned (no)  
Substantial procedural violation - (yes)  
Remittal to the department of first instance - (yes)  
Reimbursement of appeal fee - (yes)

**Decisions cited:**

G 0009/91, G 0007/93, T 0034/90, T 0740/93

**Catchword:**



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Case Number: T 1855/13 - 3.2.07

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.07**  
**of 1 August 2014**

**Appellant:** Alfa Laval Corporate AB  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 2 July 2013  
revoking European patent No. 1337345 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** H. Meinders  
**Members:** K. Poalas  
I. Beckedorf

### **Summary of Facts and Submissions**

- I. The patent proprietor (appellant) lodged an appeal against the decision of the opposition division revoking the European patent No. 1 337 345.
- II. Opposition had been filed against the patent as a whole based on Article 100(a) EPC (lack of novelty and lack of inventive step).
- III. The opposition division found that the subject-matter of claim 1 of the main request is not novel over the disclosure of D4 (US 5 916 083 A).
- IV. With its statement setting out its grounds of appeal dated 8 November 2013 the appellant requested that the decision under appeal be set aside and that the case be remitted to the opposition division, or, alternatively, that the patent be maintained in amended form on the basis of one of the sets of claims re-filed as main request and filed as first and second auxiliary request, all with said statement. As an auxiliary measure it requested oral proceedings.

The opponent (respondent) did not react to the appeal, nor to the grounds of appeal.

- V. In its communication dated 6 December 2013 the Board assessed the absence of any reasoning in the decision under appeal for not admitting the appellant's first auxiliary request as filed during the oral proceedings before the opposition division as a serious procedural violation. The result would be that the case had to be remitted to the opposition division and that it was also equitable to reimburse the appeal fee. Under these circumstances the Board considered oral proceedings as

not being necessary.

VI. With its submission dated 1 March 2014 the respondent requested the dismissal of the appeal and as an auxiliary measure oral proceedings. It presented also arguments against a remittal of the case to the department of first instance.

VII. In its annex to the summons to oral proceedings dated 13 March 2014 the Board informed the parties that it saw no reason for deviating from its opinion as expressed in its previous communication.

VIII. In its submission dated 10 June 2014 the respondent argued again for not remitting the case to the department of first instance.

IX. As a consequence, oral proceedings before the Board took place on 1 August 2014.

Both parties repeated their requests as filed during the written proceedings, see points IV and VI above.

X. Claim 1 according to the main request reads as follows:

"A centrifugal separator including a centrifuge rotor (1), which is rotatable in a rotary direction (d) around a rotary axis (x), and a casing (3), which forms an outer space (4) for the rotatable rotor, wherein the rotor (1) includes a rotor wall (5) , which defines an outer periphery of the rotor and encloses an inner space (6) , at least an inlet (7), which extends through the rotor wall (5) and permits feeding of a product to the inner space (6) , and a number of outlets (8) which extend through the rotor wall (5) and are arranged to permit intermittent discharge of a

separated product from the inner space (6) to the outer space (4), wherein said outlets (8) are distributed around the periphery of the rotor (1), wherein the rotor (1) includes a valve member (9), which is provided inside said outlets and arranged to be in a closed position, in which said discharge is prevented, and in an open position, respectively, in which said discharge is permitted, and wherein the valve member (9) in the closed position extends around the rotor wall (5) in such a way that a gap-like space (10) is formed between the rotor wall (5) and the valve member (9) at the level of said outlets (8), characterised in that said number of outlets (8) is uneven".

Claim 1 according to the first auxiliary request filed during the oral proceedings before the opposition division differed from claim 1 according to the (then and present) main request through the additional characterising feature that the number of outlets is at least five or at the most 17.

XI. The appellant's arguments, in so far as they are relevant to the present decision, may be summarised as follows:

The amendment in claim 1 of the first auxiliary request filed at the oral proceedings before the opposition division was the appellant's attempt to overcome the lack of novelty objection over the disclosure of D4 raised for the first time during the oral proceedings before the opposition division. Said amendment is a limitation of the subject-matter of claim 1 of the main request and has a basis on page 3, lines 24 to 25 of the originally filed description. Said amendment has also been the subject of a search, since it is obvious

that the search examiner would have searched for any uneven specific number of outlets, not only for the word "uneven" for the number of outlets.

Although there was a discussion during the oral proceedings before the opposition division concerning the admittance of the first auxiliary request into the proceedings no reasoning is to be found in the decision under appeal.

Thus, a substantial procedural violation has been committed and the appeal fees should be reimbursed.

XII. The respondent's arguments, in so far as they are relevant to the present decision, may be summarised as follows:

Due to the fact that the first auxiliary request was obviously late since it was filed at the oral proceedings no further justification is required of the opposition division when not admitting said request into the proceedings.

Furthermore, the proposed amendments in the independent claims are based on features taken from the description. Said features would not have been the subject of the search.

The fact that in the present case the preliminary opinion of the opposition division was in favour of the appellant is irrelevant. The appellant had to assume that the teaching of D4 filed in the opposition proceedings would have rendered the subject-matter of claim 1 of the patent as granted in any case not inventive. He should have filed an appropriate auxiliary request in due time.

## Reasons for the Decision

1. *Remittal due to a substantial procedural violation - Article 111(1) EPC and Rule 111(2) EPC*

1.1 In its opposition the respondent argued *inter alia* lack of novelty of the subject-matter of independent claim 1 of the patent as granted over the disclosure of D1 (US 1 882 389 A) and lack of inventive step of said subject-matter over the combination of the teachings of D3 (SE 463 903 A) and D2 (DE 40 27 993 A).

With its reply to the opposition the appellant filed a main request with *inter alia* an amended independent claim 1 comprising the features of claims 1, 2 and 3 of the patent as granted.

With its subsequent submission the respondent argued lack of inventive step of the subject-matter of the independent claim 1 of said main request over the combination of the teachings of D1 and D4 and also over the combination of the teachings of D4 and D2.

1.2 In its annex to the summons to oral proceedings set for 11 June 2013 the opposition division informed the parties that it considered the subject-matter of claim 1 of the main request not only to be novel over the teaching of D1 but also as involving an inventive step over *inter alia* the combination of the teachings of D1 and D4 with D4 being considered as the starting point.

With its submission dated 10 May 2013 the respondent argued *inter alia* lack of inventive step of the subject-matter of independent claim 1 of said main request, again over the combination of the teachings of



D1 and D4, over the combination of the teachings of D4 and D2 and also over the combination of the teaching of D4 with the general technical knowledge of the person skilled in the art.

- 1.3 At the start of the oral proceedings before the opposition division the appellant requested as main request the maintenance of the patent on the basis of the set of claims filed with its reply to the opposition.

At the oral proceedings, the opposition division then found that the subject-matter of claim 1 of said main request is not novel over the disclosure of D4. Its chairman then asked the appellant for any further request, see minutes, page 2.

After a break the appellant filed the first auxiliary request, see point X above, and requested the maintenance of the patent on the basis of said request.

According to the minutes of the oral proceedings the opposition division decided subsequently not to admit said auxiliary request into the proceedings as being late filed.

The patent in suit was then revoked.

- 1.4 In the impugned decision there is no reference whatsoever to said first auxiliary request, let alone has any reasoning been given as to why said auxiliary request was not admitted into the proceedings.
- 1.5 According to the first sentence of Rule 111(2) EPC, decisions of the EPO open to appeal shall be reasoned. The function of appeal proceedings is to give a

judicial decision upon the correctness of a separate earlier decision taken by a department of first instance, see *inter alia* T 34/90, OJ 1992, 454 and G 9/91, OJ 1993, 408. A reasoned decision issued by the first instance department meeting the requirements of Rule 111 EPC is accordingly a prerequisite for the examination of the appeal. The grounds upon which the decision was based and all decisive considerations in respect of the factual and legal aspects of the case must be discussed in detail in the decision, see Case Law of the Boards of Appeal, 7th edition 2013, III.K. 4.2.1, first three paragraphs.

- 1.6 It is the consistent case law of the Boards of Appeal, see e.g. T 740/93, point 5.4 of the reasons, that a "reasoned" decision should deal with **all** important issues of dispute. In the present case, the decision does not contain the slightest hint at the arguments brought forward by the parties or the reasoning why the opposition division assessed the admission of the appellant's auxiliary request into the proceedings as not appropriate.

In the Board's judgment the failure to comply with the provisions of the first sentence of Rule 111(2) EPC (stating the reasons for the decision not to admit the auxiliary request) amounts to a substantial procedural violation.

- 1.7 The respondent argues in this respect that since the opposition division has discretion not to consider submissions filed late by the appellant during the opposition proceedings there is no obligation for the opposition division for presenting arguments for not considering these submissions.

1.8 The Board does not agree with the respondent's argument for the following reasons.

1.8.1 According to the consistent case law of the Boards of Appeal, although Article 114(2) EPC gives an opposition division discretion not to consider facts, such as submissions, not submitted in due time, the division is obliged to give reasons for its decision. As already established, see point 1.6 above, the impugned decision does not mention any argument brought forward by the parties nor does it present any reasoning in this respect of the opposition division. The losing party has thus been deprived of its legitimate right to challenge the reasoning on which the decision was based, which is the very purpose of proceedings before the Boards of Appeal.

1.8.2 The mere fact that said request was filed after the ultimate date indicated in the summons to oral proceedings before the opposition division, see point 8 of the minutes, is not necessarily a sufficient reason for not admitting it, see Case Law of the Boards of Appeal, 7th edition 2013, IV.C.1.2 and IV.C.1.3.

Even if late filed, there is still the exercise of discretion of the opposition division that rules such an aspect of the proceedings. As a consequence, the decision needs to show the reasoning why the discretion was exercised one way or the other.

1.8.3 This is all the more necessary if, as in the present case, the preliminary opinion of the opposition division expressed in its annex to the summons was positive on novelty and inventive step, more in particular starting from D4. Also the opponent acknowledged novelty in its submission of 10 May 2013.

It was at the oral proceedings before the opposition division that the novelty objection based on D4 as well as on D3 gained again importance. Such facts have to be taken into account in the exercise of discretion, therefore require reasoning in the impugned decision.

- 1.8.4 This is all the more striking in view of the Guidelines for the Examination in the EPO. According to chapter E-II, 8.6, fourth paragraph of the applicable Guidelines 2012 concerning the conduct of oral proceedings and late filed facts or evidence or amendments introduced at a late stage, "the proprietor **should always be given the opportunity to submit amendments** intended to overcome objections raised by the Division which **depart from a previously notified opinion**" (emphasis added by the Board).

That situation applies here as well, since - though the objection was raised by the opponent at the oral proceedings - it was the opposition division which changed its appraisal, now different from its previously notified opinion.

- 1.8.5 Finally, the respondent argues that the appellant had to reckon with the possibility that the teaching of D4 renders the subject-matter of claim 1 of the patent as granted not inventive and should therefore have filed an appropriate auxiliary request in due time before the oral proceedings.

This is an argument which misses the point, since the crucial point in the impugned decision is the absence of any reasoning therein for not admitting the first auxiliary request. This does not even allow the Board to review the opposition division's exercise of discretion. In any case, when the Board does review it,

it is **not** the question whether the Board itself would have exercised it that way, based on arguments such as those presented by the respondent, see G 7/93, OJ EPO 1994, 775, reasons 2.6.

- 1.8.6 The result of the above is that the Board can only conclude that the absence of any reasoning in the impugned decision, as well as the circumstances of not admitting the first auxiliary request in the oral proceedings amount to a substantial procedural violation requiring immediate remittal Article 111(1) EPC and reimbursement of the appeal fee (Rule 103(1)(a) EPC).

2. *Auxiliary requests on remittal*

- 2.1 The first and second auxiliary requests filed with the statement of grounds of appeal differ from the first auxiliary request filed at the oral proceedings before the opposition division and are therefore not the subject of the impugned decision.

The Board will therefore deal with the respondent's arguments in this respect separately, as they form the basis for the remittal.

- 2.2 The respondent argues that the amendments in claim 1 of the first and second auxiliary requests are based on features extracted from the description and were therefore not the subject of the search. For that reason they should not be admitted into the proceedings.

The Board cannot accept this argument. If the main claim states that the number of outlets is "uneven", the search by necessity not only concentrates on

finding the term "uneven", but also should cover specific uneven numbers, such as 1, 3, 5, 7 etc. If it is unclear whether the search was of the required completeness, the opposition division should have an additional search be performed.

## Order

### For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The reimbursement of appeal fee is ordered.

The Registrar:

The Chairman:



G. Nachtigall

H. Meinders

Decision electronically authenticated