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**Datasheet for the decision  
of 20 September 2017**

**Case Number:** T 0762/15 - 3.2.01

**Application Number:** 07117474.2

**Publication Number:** 2042394

**IPC:** B60S1/38

**Language of the proceedings:** EN

**Title of invention:**

Windscreen wiper device

**Patent Proprietor:**

Federal-Mogul S.A.

**Opponent:**

VALEO SYSTEMES D'ESSUYAGE

**Headword:**

**Relevant legal provisions:**

EPC Art. 100(c), 54(1)

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

RPBA Art. 11

**Keyword:**

Amendments - main request - extension beyond the content of the application as filed (no)

Novelty - main and first auxiliary request - (yes)

Substantial procedural violation - appealed decision sufficiently reasoned (no)

Remittal to the department of first instance - (yes)

Reimbursement of appeal fee - (yes)

**Decisions cited:**

T 1123/04, T 0679/14

**Catchword:**



**Beschwerdekammern**  
**Boards of Appeal**  
**Chambres de recours**

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Case Number: T 0762/15 - 3.2.01

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.01**  
**of 20 September 2017**

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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 February  
2015 revoking European patent No. 2042394  
pursuant to Article 101(3)(b) EPC.**

**Composition of the Board:**

**Chairman** G. Pricolo  
**Members:** W. Marx  
P. Guntz

## **Summary of Facts and Submissions**

- I. The appeal is directed against the decision of the opposition division revoking the European patent No. 2 042 394.
- II. In its decision the opposition division held *inter alia* that granted claim 1 infringed Article 123(2) EPC and that the subject-matter of claim 1 according to a new first auxiliary request, filed during oral proceedings, was not new in view of the disclosure of document E5 (DE20200600943U). The second auxiliary request as filed in the written procedure was considered not allowable in view of Article 123(2) EPC.  
As can be taken from the minutes, a new second auxiliary request was filed during oral proceedings but not admitted ("as it introduces new problems or questions for instance added subject-matter"), which is not reflected in the grounds for the decision. The only mention in respect of this request in the contested decision is to be found in the summary of facts submissions under point 7.1, acknowledging filing of this request and merely stating:  
"Reference is made to the minutes for facts and submission expressed during oral proceedings."
- III. At oral proceedings held on 20 September 2017 the appellant (patent proprietor) requested that the decision under appeal be set aside and that the patent be maintained as granted or, in the alternative, that the patent be maintained in amended form on the basis of one of auxiliary requests 1 to 3 as submitted with the statement of grounds of appeal, dated 1 July 2015. The respondent (opponent) requested that the appeal be dismissed.

IV. Claim 1 as granted reads as follows (amendments with respect to claim 1 as filed are marked by strike-through for deletions and underlining for additions):

"A windscreen wiper device (1) comprising an elastic, elongated carrier element, as well as an elongated wiper blade (2) to be placed in abutment with a windscreen to be wiped, said wiper blade (2) comprising an elongated upper part (3) and an elongated lower wiping part (4) of a flexible material, wherein said upper part (3) is provided with first retention means for retaining said lower wiping part (4), as well as with second retention means for retaining a longitudinal strip (6) of said carrier element, said second retention means defining a longitudinal groove (5) for inserting said longitudinal strip (6) therein, said upper part (3) being provided with a resilient member in the shape of a spoiler (19) at a side thereof facing away from said lower wiping part (4), which windscreen wiper device (1) comprises a connecting device (8) for an oscillating arm (9), and wherein said oscillating arm (9) can be pivotally connected to said connecting device (8) about a pivot axis near one end thereof, wherein characterized in that said second retention means are allowed to bend laterally outwardly upon insertion of said longitudinal strip (6) into said longitudinal groove (5), and wherein said longitudinal strip (6) is confined inside said longitudinal groove (5) upon mounting of said connecting device (8) and/or upon mounting connecting pieces (7) closing outer ends of said longitudinal groove (5) which has a closed circumference,  
**characterized in that** said spoiler (19) is made of a softer material than said second retention means to allow said bending."

Claim 1 according to the first auxiliary request corresponds to the first auxiliary request filed during oral proceedings before the department of first instance (the underlined feature was added compared to the version filed in writing on 22 September 2014) and was amended in comparison to granted claim 1 by adding the following features in the characterising portion:

"..., wherein

- said second retention means are hook-shaped and are allowed to bend due to elastic deformation; or
- said second retention means are in the form of a closed wall (17) of said longitudinal groove (5) having an arc-shaped cross-section, wherein side parts of said closed wall (17) are allowed to bend due to elastic deformation."

V. The appellant's submissions in as far as they are relevant to this decision may be summarised as follows:

The decision of the opposition division was completely silent as to the reasons why a new second auxiliary request filed during oral proceedings was not admitted into the proceedings and therefore contravened Rule 111(2) EPC. The patentee was left in doubt as to what would have been the reason(s) for inadmissibility, so that the patentee's interests in defending the case in appeal had been seriously damaged. Simply disregarding the new second auxiliary request amounted clearly to a procedural violation.

Claim 1 as granted met the requirements of Article 123(2) EPC because the skilled person would immediately understand from the application as filed that elastic and plastic deformation were both

technically possible (see page 9, lines 31 and 32), so the feature of the spoiler being softer than the second retention means (page 9, line 3 or lines 25-26) was not inextricably linked to elastic deformation. Moreover, the application as filed contained a general teaching in this respect (page 4, lines 13 ff), separate from further specific features. The description of the embodiments contained a summary of the invention (see page 9, line 29: "use of two materials differing in flexibility") corresponding to what was now claimed, which was not directly linked to the shape of the second retention means formed by hooks or a closed wall, as specified in dependent claims as optional features. Semi-rigid second retention means were defined in dependent claim 2 and therefore not essential. As regards the allegedly missing monobloc feature, first and second retention means made in one piece or integral were optional. The description of the embodiments (pages 8 and 9: "coextrusion, glueing or the like") made clear that any way of joining the spoiler to the second retention means was possible.

Claim 1 as granted and claim 1 of the first auxiliary request were new over document E5. E5 disclosed only rubber for the wiper blade (4) and the covers (5), but did not teach that the covers were made of a softer material than the holder. Moreover, E5 did not disclose any lateral bending of the channel, nor that such bending was possible. This characteristic - although not requiring that bending really took place - was a limiting feature because not every hook was allowed to bend, and E5 was lacking a direct and unambiguous disclosure of this feature. E5 showed measures to allow bending in the longitudinal direction due to the cuts (33), but did not describe whether it was allowed in the lateral direction. An outwardly bending of the

channel was not an inherent feature in E5 but merely a chance. There were further options possible, e.g. insertion of a strip with play, an over-dimensioned strip leading to abrasion or breaking when inserting the strip, or even use of an anisotropic material. E5 was completely silent in this respect. The schematic figures in E5 could not provide a basis for deriving bending hooks either. The wiper blade of E5 was not suitable to receive a longitudinal strip broader than the channel because of the close fit of an end cap onto the cover and the strip shown in E5 and because the side walls of a neighbouring claw of the channel blocked any further movement upon insertion of the strip at an outer end. And even considering the theoretical situation of a broader strip being inserted into the channel, any lateral and outward bending of the outer claws of the channel of the holder would prevent end caps (made of hard plastic) from being snapped over the longitudinal strip.

Remittal of the case to the department of first instance would involve further delay and was not expedient in the interest of the public.

VI. The respondent countered essentially as follows:

The contested decision was sufficiently reasoned as regards inadmissibility of the second auxiliary request filed during oral proceedings (see minutes page 3). Moreover, in view of the extensive discussion on patentability of the claims as granted and of the first auxiliary request in particular with regard to Articles 123(2) and 54 EPC, it was clear that the new set of claims according to the second auxiliary request filed during oral proceedings could not establish patentability. The arguments presented by the appellant



under point 5.1 in its grounds of appeal showed that it apparently understood the deficiencies of this request. Therefore, no procedural violation occurred in the proceedings before the department of first instance.

Claim 1 as granted constituted an intermediate generalisation violating Article 123(2) EPC. The term "softer" (which was not equivalent to "ductile") was always used in the context of the description of one of the embodiments of Figures 2 to 6 (but not in dependent claims), where it was disclosed in combination with further non-optional features. In particular, it related to the hardness of the materials used, which played a role in the embodiments of Figures 4 and 6 (not: Figure 5) as described on pages 8 and 9 of the application as filed, and could not be seen isolated from further features, specifying that

- the longitudinal groove had a specific form (rectangular, Figure 4; arc-shaped, Figure 6),
- the hooks were semi-rigid, which was required in the embodiment of Figure 4 with a soft spoiler,
- the arms 12 and the hooks were made in one piece,
- the hooks and the spoiler were joined through coextrusion or glueing.

Semi-rigid second retention means were even required for all the embodiments (page 8, line 24 and page 3, line 10). Page 9, line 29 mentioned two materials differing in flexibility in relation to the shape of the second retention means formed as hooks or as a closed wall.

The additional features in claim 1 of the first auxiliary request were arbitrarily extracted from the two different embodiments disclosed in Figures 4 and 6 (first alternative) and Figure 5 (second alternative), although disclosed only in combination with further

features necessary for solving the technical problem. Apart from the missing features already listed above, it was not specified that the longitudinal groove was central for all embodiments and had - in the embodiment according to Figure 6 - an arc-shaped cross-section. Moreover, the arms 12 and closed wall 17 according to the embodiment in Figure 5 were also made in one piece.

The feature of claim 1 according to which the "second retention means were allowed to bend laterally outwardly upon insertion of said longitudinal strip" described the technical effect for solving the technical problem and was not limiting. It did not require the second retention means to actually bend upon insertion of the strip, but merely a material soft enough to be deformable (the contested patent also mentioned plastic deformation). As derivable from Figure 4 in E5, slits 33 in the holder provided flexibility in the longitudinal direction due to the reduced material thickness, which also applied to the hooks. Assuming anisotropic material was not reasonable. Therefore, the subject-matter of claim 1 as granted and the first alternative specified in claim 1 of the first auxiliary request were not new over E5.

In order to have further objections examined by two instances (i.e. further novelty attacks, lack of inventive step, Articles 83 and 84 EPC with regard to the first auxiliary request), remittal to the department of first instance for further prosecution was appropriate. Reimbursement of the appeal fee was not justified, since the patent proprietor had appealed against the decision on the main request and the first auxiliary request irrespective of the alleged procedural violation.

## Reasons for the Decision

1. The opposition division dealt with and decided on issues of patentability of the patent as granted and of a new first auxiliary request filed during oral proceedings. Therefore, the board found it expedient to first review the contested decision with regard to the main request and the first auxiliary request before deciding on the issue of the alleged procedural violation with regard to the new second auxiliary request filed during oral proceedings.
2. *Amendments - patent as granted (Article 100(c) EPC)*
  - 2.1 As compared to the application as filed, claim 1 of the contested patent is amended by specifying that the longitudinal groove has a closed circumference, which has a basis in claim 5 as filed and was not objected to.  
Moreover, the characterising portion is defined by a new feature taken from the description of the embodiments on page 9 of the application as filed, which reads "said spoiler (19) is made of a softer material than said second retention means to allow said bending".
  - 2.2 The opposition division concluded (see point 1 of the contested decision) that granted claim 1 infringed Article 123(2) EPC because the softer material of the spoiler in comparison to the second retention means (a feature taken from the description of the embodiments of Figures 4 to 6) was inextricably linked to the fact that the second retention means was allowed to bend laterally outwardly due to **elastic deformation of the hooks and/or closed wall**.

- 2.3 The board notes that the use of two materials differing in flexibility as described in the application as filed with regard to the embodiments of Figures 4 to 6 (see page 9, last paragraph: "...**allows elastic deformation** of said hooks 17 and/or said closed wall 17, as can be seen in figures 4, 5 and 6. Instead of elastic deformation, **also plastic deformation** could take place") is not exclusively confined to elastic deformation. Therefore, the board takes the view that the only functional feature inextricably linked to these embodiments is the characteristic of the second retention means being deformable. However, such deformation characteristic is already specified in a more specific way in the preamble of claim 1, which states that the "second retention means are allowed to bend laterally outwardly", and repeated in the characterising portion ("to allow said bending"), so that such characteristic is already covered by the wording of claim 1.
- 2.4 It remains to be discussed whether the added feature that the spoiler is made of a softer material than the second retention means, without specifying the shape of the second retention means in the form of hooks (for embodiments of Figures 4 and 6) or a closed wall (embodiment of Figure 5), presents the skilled person with new technical information having regard to the content of the originally filed application. In particular, it has to be assessed whether the extracted feature is not inextricably linked (functionally or structurally) with the features of the specific combinations disclosed or whether the amendment is supported by other parts of the application as filed.

2.4.1 According to the description of the embodiments, the spoiler is joined somehow ("through coextrusion, glueing or the like") to the second retention means, i.e. there exists no further structural relationship between the two parts apart from what is already expressed in the preamble of claim 1 ("said upper part (3) [provided with second retention means] being provided with a resilient member in the shape of a spoiler"). The relevant functional relationship associated with the spoiler being made of a softer material than the second retention means, which implies that the spoiler does not prevent the second retention means from deforming, is already expressed in granted claim 1 through the supplement "to allow said bending". Moreover, this functional characteristic is not closely related to the function of the second retention means formed as hooks or as a closed wall, which provides a retaining function for the longitudinal strip and is already expressed in claim 1 by specifying second retention means "for retaining a longitudinal strip".

2.4.2 Furthermore, the board finds that the application as filed contains a more general teaching in this respect. On page 3 and 4 of the application as filed (see also claim 2 and claims 8-10 as filed) preferred embodiments are described, according to which

- the second retention means are semi-rigid (which "ensures that on the one hand a bending of said second retention means in lateral and outward direction is made possible upon mounting of said longitudinal strip into said longitudinal groove, and on the other hand a reliable and solid retention of said longitudinal strip in said longitudinal groove", page 3, lines 13-17) and
- the resilient member (in the shape of a spoiler) is ductile ("so that said resilient member can be

deformed so as to allow a bending of said second retention means in lateral and outward direction", page 4, lines 13-25).

Thereby, characteristics of the materials used for the second retention means and for the spoiler are already specified by the terms "semi-rigid" and "ductile". Moreover, it is made clear that the material of the spoiler is chosen such that it does not prevent the second retention means from bending in lateral and outward direction, whereas the second retention means must still perform its function of retaining the longitudinal strip. The board cannot see that any new technical information is introduced when describing the relationship between the two materials by using the term "softer" as introduced in the characterising portion of claim 1 as granted.

- 2.4.3 Therefore, the board sees no reason for further specifying the form of the second retention means when amending claim 1 as filed by specifying the material characteristics of the spoiler in relation to the second retention means.
- 2.5 The board cannot follow the respondent's view that the amendment in granted claim 1 concerning the hardness of materials could not be seen isolated from the following further features disclosed in particular in the context of the embodiments of Figures 4 and 6 and the related passages in the description as filed:
- As argued already above, further specification of the second retention means in the form of hooks is not required to comply with Article 123(2) EPC, so that further features disclosed in connection with the second retention means in the forms of hooks (as described for the embodiments according to Figures 4 and 6) can also be dispensed with.

- The dependency in the claims as filed (see claims 6 and 7, which define a rectangular cross-section and an arc-shaped cross-section and which are both dependent on any of claims 1 to 5) makes clear that the form of the longitudinal groove is not closely related to second retention means which are hook-shaped (as defined only in claim 4 as filed).
- The feature "semi-rigid" is not only disclosed in relation to hooks (see page 8; Figure 4), but also in dependent claim 2 as filed which refers back to second retention means in general and the related passage in the introductory part of the description as filed (page 3, lines 8-17). As argued already above, said passage describes the two functions associated with the term "semi-rigid" (allowing a bending of the second retention means and retaining the longitudinal strip) which are already expressed in the preamble of claim 1. Therefore, no further technical information is provided when omitting the rather vague term "semi-rigid", which has to be construed taking into account the definition given in the description as filed.
- Since the amendment in claim 1 as granted concerns the material of the spoiler in comparison to the **second** retention means, the board cannot see any close link of this feature to the allegedly missing feature that the second retention means is in one piece with the arms 12 forming part of the **first** (not: second) retention means.
- The methods of joining the spoiler to the hooks through coextrusion or glueing are explicitly characterised for all embodiments - in view of the supplement "or the like" - as not limiting, so any way of joining the spoiler to the hooks or to the second retention means is possible.

- A central position of the longitudinal groove (objected to with regard to claim 1 of the first auxiliary request), as mentioned in the description of Figures 2 and 3, is not inextricably linked to the choice of materials of the second retention means and the spoiler. It is even said (see last paragraph of the description as filed) that the central longitudinal strip could be replaced by two strips located in correspondingly shaped grooves.

2.6 In view of the foregoing, the board concludes that the subject-matter of claim 1 as granted satisfies the requirements of Article 100(c) EPC.

3. *Novelty - first auxiliary request (Article 54(1) EPC)*

3.1 The opposition division considered (see point 2 of the contested decision) that E5 disclosed the first option of the subject-matter as specified in claim 1 of the first auxiliary request.

3.2 The appellant contests that two features of claim 1 are directly and unambiguously derivable from E5, namely  
(a) that said second retention means are allowed to bend laterally outwardly upon insertion of said longitudinal strip, and  
(b) that said spoiler is made of a softer material than said second retention means to allow said bending.

3.3 The subject-matter of claim 1 relates to a windscreen wiper device in its finally assembled state. Claim 1 does not require the second retention means (such as the hooks claimed in the first alternative) to remain deformed after insertion of the longitudinal strip, as acknowledged by the appellant. However, the board does not follow the respondent in that feature (a) is not



limiting at all. The second retention means as claimed (i.e. which are allowed to bend upon insertion of the longitudinal strip) require at least a certain material characteristic and/or geometry of the second retention means in comparison to the longitudinal strip so that bending is possible upon insertion of the longitudinal strip. E5 is totally silent in this respect and does not specify the material of the holder forming the second retention means or any dimensional relationship in more detail. Therefore, the strict criterion of direct and unambiguous disclosure that has to be applied when judging on novelty is not fulfilled.

- 3.4 Admittedly, slits or cuts (33) are provided in the holder (3) representing the second retention means in E5 (see Figure 4), which allow for a flexibility of the holder in the longitudinal direction due to a reduced material thickness of the holder in the area of the slits. However, the board cannot follow the respondent that any flexibility of the hooks is derivable from the drawings. In accordance with the established case law, schematic drawings cannot provide a basis for deriving dimensions or ratios of dimensions. Hence, no teaching on the dimensions of the hooks and possibly their flexibility or bending properties is derivable from the schematic figures in E5.

E5 even states (see paragraph [0020]: "Einsägungen ... verringern die Steifigkeit des Halters (3) in Längsrichtung") that a rather rigid holder material is used so that slits have to be provided in order to provide some longitudinal flexibility, which speaks against a material of lower rigidity that would be already soft enough so that it bends without having to take further measures. Moreover, E5 suggests by using terms such as "eingelegt" and "am Herausfallen

gehindert" (paragraph [0015]: "Der elastische Streifen (2) wird in den Kanal (31) des Halters (3) eingelegt. Danach werden Halter (3) und Streifen (2) in die Gummiabdeckungen (5) eingelegt, wo sie durch die Absätze (51) am Herausfallen gehindert werden.") that the strip might be inserted with play so that the hooks do not necessarily bend laterally outwardly upon insertion of the strip.

Therefore, E5 does not disclose directly and unambiguously a design of the holder or second retention means within the meaning of feature (a).

3.5 For this reason alone, the board already takes the view that the subject-matter of claim 1 of the first auxiliary request is new over E5 (Article 54(1) EPC). The same conclusion applies with regard to claim 1 as granted which also contains feature (a).

3.6 In view of the foregoing, it can be left open whether feature (b) is directly and unambiguously known from E5 disclosing a spoiler made of rubber and a holder which is slitted in order to reduce its rigidity.

#### 4. *Alleged procedural violation*

4.1 A decision not to admit an auxiliary request is open to appeal and must be reasoned (Rule 111(2) EPC). In the present case, the contested decision does not contain any reasoning as regards non-admittance of the second auxiliary request filed during the oral proceedings, contrary to the requirements of Rule 111(2) EPC.

4.2 As is evident from the contested decision and the minutes of the oral proceedings before the opposition division, a new second auxiliary request was filed

during the oral proceedings. According to the minutes (see page 3), this request was not admitted by the opposition division because it "introduces new problems or questions for instance added subject-matter". The contested decision also refers to this request under point 7.1 of the facts and submissions, but the reasons of the contested decision are totally silent as to the grounds for not admitting the new second auxiliary request filed during oral proceedings.

- 4.3 The respondent's assertion that the contested decision, by referring to the minutes, was sufficiently reasoned cannot be followed. The contested decision states under point 7.1 of the facts and submissions that "Reference is made to the minutes for facts and submission expressed during oral proceedings". However, this statement is merely a reference to the minutes that supplements the facts and submissions of the contested decision and is neither meant for nor capable of replacing reasons.

Even taking into account the minutes, no substantiated reasoning for non-admitting the new second auxiliary request filed during the oral proceedings can be found. The minutes merely contain (see page 3) the vague statement that the new second auxiliary request "introduces new problems or questions for instance added subject-matter", which does not help understanding what are the deficiencies identified by the opposition division and thus understanding the reasons (e.g. in view of the requirements of Article 123(2) EPC) for not admitting the newly filed second auxiliary request.

- 4.4 The respondent argues that it was clear from the previous discussions during oral proceedings with

regard to Articles 123(2) and 54 EPC that the new set of claims could not establish patentability. As can be taken from the contested decision itself (point 2.2), the opposition division reached the preliminary opinion that the requirements of Articles 123(2), 83 and 84 EPC were fulfilled by the new first auxiliary request filed during the oral proceedings. Subsequently, it was found that the first option of the subject-matter of claim 1 of the first auxiliary request was disclosed by E5. Moreover, according to the minutes (page 3, lines 1-3) the second alternative specified in claim 1 of the first auxiliary request was considered new.

The new second auxiliary request filed during oral proceedings (as attached to the minutes) was amended in comparison to the first auxiliary request only by further specifying the first alternative claimed, i.e. apparently to overcome the raised novelty objection.

Therefore, in view of such course of proceedings, the board cannot see that the appellant already knew the reasons why the subject-matter of the new second auxiliary request should not comply with the requirements of Article 123(2) or 54 EPC.

- 4.5 As regards the respondent's allegation that it was clear from the appellant's arguments presented in its grounds of appeal that it apparently understood the deficiencies of the new second auxiliary request filed during oral proceedings, the board notes that the appellant contests (see point 5.1) that the second auxiliary request filed in writing on 22 September 2014 did not fulfil the requirements of Article 123(2) EPC.

Admittedly, the second auxiliary request filed on 22 September 2014 apparently corresponds at least in

part to the new second auxiliary request filed during oral proceedings on 22 October 2014, in particular as regards the first alternative claimed in the latter. However, in the absence of any reasoning given in the contested decision, the board does not know whether the new second auxiliary request filed during oral proceedings was rejected on the same formal ground under Article 123(2) EPC, or whether the opposition division did not admit the new second auxiliary request in the exercise of their discretion for being late-filed and not complying with the criteria to be applied in this case, such as *prima facie* allowability. In the latter case, the board's competence in reviewing the contested decision is confined to the way the department of the first instance has exercised its discretion, without assessing the formal and substantive requirements of the EPC, i.e. the grounds for non-admitting a late-filed request have a direct consequence on how the board of appeal has to deal with the case in their judicial review. In the present case, these grounds are unknown to the board.

According to the established case law, the grounds on which a decision was based have to be adequately reasoned. As noted in T 1123/04, such reasoning and grounds should be comprehensible to those conducting a later judicial review, as laid down in Rule 111(2) EPC. In particular, it should not be necessary for a board of appeal - as in the present case - to have to reconstruct or even speculate as to the possible reasons for a negative decision in first instance proceedings. In principle, a decision should be complete and self-contained (see also T 0679/14).

4.6 In view of the foregoing, the board had to conclude that the appealed decision is insufficiently reasoned

and does not meet the requirements of Rule 111(2) EPC, which constitutes a substantial procedural violation.

5. *Remittal*

5.1 In view of the fundamental deficiency as found above, the board decides to remit the case to the opposition division (Article 11 RPBA, Rules of Procedure of the Boards of Appeal, OJ EPO 2007, 536).

5.2 The appellant was in favour of not remitting the case to the department of first instance in order to avoid further delays. However, in the present case, the contested decision was not confirmed in respect of novelty of the subject-matter of claim 1 of the first auxiliary request over E5. Therefore, the board finds it expedient to follow the respondent's request to remit the case so that further objections raised by the respondent e.g. on novelty and inventive step can duly be considered, giving the appellant the appropriate opportunity to react and avoid loss of its patent.

6. *Reimbursement of the appeal fee*

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

In the present case, the appeal is allowable and the substantial procedural violation concerns the new second auxiliary request filed during oral proceedings before the opposition division, which is identical to the second auxiliary request submitted with the grounds of appeal. Despite the board's finding that the contested decision has to be set aside as regards the

appellant's main request and first auxiliary request, a final decision on these requests is still pending in view of the case being remitted to the opposition division in order to deal with further objections on patentability. Therefore, the substantial procedural violation affecting the new second auxiliary request filed during the oral proceedings might play a role.

Hence, a causal link between the substantial procedural violation and the filing of the appeal cannot be denied at the given stage of the proceedings and no reasons exist why it should not appear equitable to follow Rule 103(1)(a) EPC. Therefore, the reimbursement of the appeal fee is ordered.

## 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 appeal fee is to be reimbursed.

The Registrar:

The Chairman:



A. Vottner

G. Pricolo

Decision electronically authenticated