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**Datasheet for the decision  
of 4 August 2020**

**Case Number:** T 1817/16 - 3.2.03

**Application Number:** 06821780.1

**Publication Number:** 2029853

**IPC:** E21B7/02, E21B19/083,  
E21B19/14, E21B19/15

**Language of the proceedings:** EN

**Title of invention:**

WELL DRILLING MACHINE WITH NEW DRILL PIPE LOADER

**Patent Proprietor:**

Comacchio S.r.l.

**Opponent:**

Casagrande SpA

**Headword:**

**Relevant legal provisions:**

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

EPC R. 103(1) (a), 116

**Keyword:**

Appeal decision - remittal to the department of first instance  
(yes)

Reimbursement of appeal fee - (yes)

Substantial procedural violation - violation of the right to  
be heard (yes)

**Decisions cited:**

R 0005/16, T 0048/98

**Catchword:**



**Beschwerdekammern**

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Case Number: T 1817/16 - 3.2.03

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.03**  
**of 4 August 2020**

**Appellant:** Comacchio S.r.l.  
(Patent Proprietor) Via Callalta 24/B  
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**Respondent:** Casagrande SpA  
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**Decision under appeal:** **Decision of the Opposition Division of the  
European Patent Office posted on 20 June 2016  
revoking European patent No. 2029853 pursuant to  
Article 101(3) (b) EPC.**

**Composition of the Board:**

**Chairman** G. Ashley  
**Members:** C. Donnelly  
N. Obrovski

## **Summary of Facts and Submissions**

I. The appeal lies from the decision of the opposition division to revoke European patent no. EP-B-2 029 853.

In its decision the opposition division held that the subject-matter of claim 1 as granted lacked novelty in view of EP 0 978 628 A2 (D1), US 4 547 110 (D2) and EP 1 176 283 A2 (D3). The opposition division also considered that the patent proprietor's right to be heard had been respected since the grounds for revocation of the patent were brought to the attention of the proprietor in a timely and non-surprising manner.

The patent proprietor (hereinafter: the "appellant") lodged an appeal against this decision.

### *II. Requests*

The appellant requests that the decision under appeal be set aside and that the patent be maintained on the basis of the set of claims filed with the grounds of appeal.

The appellant also requests reimbursement of the appeal fee under Rule 103 EPC since the opposition division did not respect its right to be heard which constitutes a substantial procedure violation.

### *III. Summary of procedural steps in the opposition proceedings*

The summons to attend oral proceedings on 19 September 2016 was issued by the opposition division

on 10 February 2016. In its provisional opinion, annexed to the summons, the division indicated that the subject-matter of claim 1 as granted lacked novelty with respect to D1, D2 and D3. EPO form 2040 sent with the provisional opinion stated the final date for making written submissions as being one month before the scheduled date of the oral proceedings i.e. 19 August 2016.

By letter of 18 April 2016 the opponent withdrew its opposition and indicated it would not attend the oral proceedings. By letter of 20 April 2016 the patent proprietor indicated that it too would not attend the oral proceedings.

By official communication of 30 May 2016 using EPO form 2310A, the opposition division informed the parties that the oral proceedings scheduled for 19 September 2016 were cancelled and ticked the box indicating that "The procedure will be continued in writing".

The decision to revoke the patent was issued on 20 June 2016.

*IV. The appellant's submissions concerning the allegation of a substantial procedural violation can be summarised as follows:*

The appellant had no reason to think that the final date of 19 August 2016 for making written submissions had been changed since no new date had been communicated by the EPO.

Therefore, the decision to revoke the patent issued on 20 June 2016, came as a complete surprise since it was

received before the final date previously communicated and without giving the possibility to react to the preliminary objections raised by the opposition division.

Consequently, a substantial procedural violation has occurred since the appellant's right to be heard has not been respected.

### **Reasons for the Decision**

1. *Applicable Rules of Procedure of the Boards of Appeal*

The revised Rules of Procedure of the Boards of Appeal (RPBA 2020) entered into force on 1 January 2020. Subject to the transitional provisions (Article 25 RPBA 2020), the revised version also applies to appeals pending on the date of the entry into force.

2. *Substantial procedural violation*

2.1 The right to be heard according to Article 113(1) EPC is an important procedural right intended to ensure that no party is caught unaware by grounds and evidence in a decision turning down a request on which that party has not had the opportunity to comment (R 5/16, point 6 of the reasons). The right to be heard is violated if a decision is taken before expiry of a time limit for responding to a communication (Case Law of the Boards of Appeal, 9th edition 2019, Chapter III.B. 2.5.2; see also T 48/98).

- 2.2 In its summons to attend oral proceedings on 19 September 2016, the opposition division stated the following: "The final date for making written submissions and/or amendments (R 116 EPC) is 19.08.16". Nevertheless, the opposition division's decision to revoke the patent was issued on 20 June 2016, i.e. almost two months before that date.
- 2.3 In the reasons for its decision to revoke the patent, the opposition division states that it provided the patent proprietor in its preliminary opinion annexed to the summons to the oral proceedings with detailed reasons why claim 1 of the granted patent lacked novelty with respect to documents D1-D3. The opposition division further states that the patent proprietor had not reacted to this negative preliminary opinion for more than two months after it had informed the opposition division that it would not attend the oral proceedings. The patent proprietor had thus been given ample time to react in order to overcome the opposition division's objections.
- 2.4 The Board does not share this view. If a final date for making written submissions is fixed by the European Patent Office in accordance with Rule 116 EPC, the party concerned is entitled to make full use of the specified time limit. If a department of first instance shortens that time limit by issuing a decision before its expiry, it violates the party's right to provide comments within the specified time limit, and thereby its right to be heard. In this context, it is irrelevant how much time was available to the party before the decision was issued prematurely, i.e. before the expiry of the specified time limit.

- 2.5 The fact that the appellant announced that it would not attend the oral proceedings is also immaterial in this regard. The appellant's announcement was restricted to its participation in the oral proceedings. It thus cannot be interpreted as including a waiver of its right to comment in writing on the opposition division's preliminary opinion.
- 2.6 The appellant's referral to the withdrawal of the opposition and its statement that it would "therefore" not attend the oral proceedings is rather counter-indicative in this regard.
- 2.7 The cancellation of the oral proceedings and the continuation of the procedure in writing by the opposition division has no bearing on the above assessment either. In particular, the cancellation of the oral proceedings did not automatically lead to the cancellation of the final date that had been set for making written submissions. While this date had been specified relative to the date for oral proceedings, its purpose was not limited to these. Rather, it constituted a date for providing written comments on the opposition division's preliminary opinion. This purpose was not affected by the cancellation of the oral proceedings. Thus, in the absence of any indication to the contrary, the final date for making written submissions remained valid after the opposition division had cancelled the oral proceedings.
- 2.8 Therefore, the opposition division violated the patent proprietor's right to be heard when issuing the decision to revoke the patent before expiry of the time limit it had previously set for making written submissions.



2.9 This violation of the right to be heard constitutes a substantive procedural violation within the meaning of Rule 103(1)(a) EPC. It affects the outcome of the decision under appeal in that it deprived the appellant of the opportunity to comment on the opposition division's preliminary opinion before it issued its decision to revoke the patent.

3. *Remittal to the opposition division*

3.1 Since a substantial procedural violation has occurred there is a fundamental deficiency in the opposition proceedings which constitutes a special reason for remittal under Article 11 RPBA 2020.

3.2 For these reasons the Board considers it appropriate to exercise its discretion under Article 111(1) EPC to remit the case to the opposition division for further prosecution.

4. *Reimbursement of the appeal fee*

In view of the causal link between this substantive procedural violation and the filing of the appeal, the reimbursement of the appeal fee under Rule 103(1)(a) EPC is also 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:



C. Spira

G. Ashley

Decision electronically authenticated