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**Datasheet for the decision
of 6 June 2019**

Case Number: T 0602/18 - 3.3.05

Application Number: 04733842.1

Publication Number: 1626796

IPC: B01D53/26

Language of the proceedings: EN

Title of invention:

AIR DRYER CARTRIDGE

Patent Proprietor:

WABCO GmbH

Opponent:

Knorr-Bremse Systeme für Nutzfahrzeuge GmbH

Headword:

Binding effect/WABCO

Relevant legal provisions:

EPC Art. 111(2)
EPC R. 103(1)(a), 111(2)
RPBA Art. 11, 12(4)

Keyword:

Substantial procedural violation - (yes) - appealed decision
reasoned (no)

Reimbursement of appeal fee - (yes)

Remittal to the department of first instance - (no) -
fundamental deficiency in first instance proceedings (yes) -
special reasons for not remitting the case

Decisions cited:

T 0079/89, T 0843/91, T 0405/12, T 0303/13

Catchword:



Beschwerdekammern

Boards of Appeal

Chambres de recours

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Case Number: T 0602/18 - 3.3.05

D E C I S I O N
of Technical Board of Appeal 3.3.05
of 6 June 2019

Appellant: Knorr-Bremse
(Opponent) Systeme für Nutzfahrzeuge GmbH
Moosacher Str. 80
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Representative: Schumacher & Willsau
Patentanwalts-gesellschaft mbH
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Respondent: WABCO GmbH
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Representative: Gray, James
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Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted on
3 January 2018 concerning maintenance of the
European Patent No. 1626796 in amended form.

Composition of the Board:

Chairman E. Bendl
Members: A. Haderlein
O. Loizou

Summary of Facts and Submissions

I. The appeal was filed by the opponent (appellant) against the interlocutory decision of the opposition division dated 3 January 2018.

II. In the previous appeal case, T 303/13, regarding European patent No. 1 626 796 and between the same parties, the then competent board ordered in its decision dated 29 October 2015:

"The case is remitted to the opposition division with the order to maintain the patent in amended form on the basis of claims 1 to 5 of auxiliary request 6, filed with the letter dated 26 April 2013, and the description and figures to be adapted."

With a communication dated 23 November 2016 the opposition division invited the patent proprietor to adapt the description and the figures to the claims of auxiliary request 6 filed with the letter dated 26 April 2013.

III. Responding with a letter dated 21 March 2017, the proprietor (respondent) filed amended description pages, amended drawing sheets and new claims 1 to 5. In this letter, it is stated that the claims "have been amended to correct or delete erroneous reference numerals in claim 1".

IV. With a letter dated 7 July 2017, the respondent filed a claim set comprising claims 1 to 5.

V. The opposition division issued a further communication dated 7 August 2017 inviting the opponent to file

observations.

VI. The decision under appeal was issued on 3 January 2018. The documents issued on that date are composed of:

- 2 pages of EPO Form 2327 (cover page), titled "Interlocutory decision in Opposition proceedings (Art. 101(3)(a) and 106(2) EPC)".
- 2 pages of EPO Form 2916 containing the grounds for the decision.
- 2 pages containing information about means of redress.
- 24 pages of documents titled "DESC-CLEANO", "CLMS-CLEANO" AND "DRAW-CLEANO" (i.e. the "Druckexemplar").
- 1 page of Form 2339 titled "Interlocutory decision in opposition proceedings (Art. 101(3)(a) and 106(2) EPC)" bearing the names and signatures of the members of the opposition division.
- 1 page titled "CLMS SIXTH AUXILIARY REQUEST" bearing the date 26 April 2013.
- 2 acknowledgements of receipt.

VII. In its grounds of appeal, the appellant argued essentially that the inconsistencies in the documents making up the impugned decision led the appellant to examine the documents intended for grant and it discovered that the claims dated 7 July 2017 differed from those contained in the order of the previous decision T 303/13 not only by reference numerals.

VIII. With its reply, the respondent filed an amended set of claims as its main request and requested, on an auxiliary basis, that the patent be maintained in amended form based on the claims as referred to in the order of the previous decision T 303/13 and on the description pages and drawing sheets filed with the

letter dated 21 March 2017.

IX. During the oral proceedings before the board, the respondent withdrew said main request. The previous auxiliary request subsequently became its sole request.

X. The appellant essentially argued as follows:

The case should not be remitted to the department of first instance, but should be finally dealt with by the board. The defect in the decision under appeal could be considered not substantial so that the board could deal with the case without remittal. There were no objections to the amended description or the amended drawing sheets. The respondent's sole request should not be admitted into the proceedings because it could have been filed in the first-instance proceedings.

XI. The respondent essentially argued as follows:

The case should not be remitted to the department of first instance but should be finally dealt with by the board. As the claims were those as referred to in the order of the previous decision T 303/13 and since the description and drawing sheets had never been objected to by the appellant, the respondent's sole request was admissible.

XII. Requests

The appellant requested that the decision under appeal be set aside and that the patent be revoked.

The respondent requested that the patent be maintained on the basis of its sole request comprising the set of claims 1 to 5 as referred to in the order of the board

in the decision of 29 October 2015 in case T 303/13 as well as the amended description and drawing sheets both submitted with letter dated 21 March 2017.

Reasons for the Decision

1. The appeal is admissible.
2. Substantial procedural violation
 - 2.1 The board is competent to examine whether there are fundamental deficiencies apparent in the first-instance proceedings, even in the absence of a corresponding objection by the parties (T 405/12, Reasons 3).
 - 2.2 According to the cover page (EPO Form 2327) of the impugned decision, the "Documents for the maintenance of the patent as amended" include claims 1 to 5 as filed on 7 July 2017. According to "Sheet 2" of EPO Form 2327, the decision contains enclosures comprising "2 page(s) reasons for the decision (Form 2916)", "Documents relating to the amended text" and "sixth auxiliary request".
 - 2.3 The "Documents relating to the amended text" (or "Druckexemplar") contain sixteen description pages dated 23 March 2017, one claims page dated 7 July 2017, and seven pages of drawings dated 23 March 2017. On sheet 1 of EPO Form 2339 bearing the signatures of the members of the opposition division, reference is made to claims 1 to 5 filed on 7 July 2017 as "currently valid documents". The enclosure mentioned on "Sheet 2" of EPO Form 2327 and referred to as "sixth auxiliary request" is entitled "SIXTH AUXILIARY REQUEST" and dated 26 April 2013. The "Ground for the decision", section "II. REASONS FOR THE DECISION" contains the

following statement:

"With reference to the decision T 0303/13 of the Technical Board of Appeal 3 March 2005, the patent is maintained in amended form on the basis of claims 1 to 5 of auxiliary request 6, filed with the letter dated 26 April 2013."

- 2.4 In conclusion, while the cover page, the page bearing the signatures of the opposition division and the "Druckexemplar" appear contain or refer to the claim set dated 7 July 2017, the reasons of the decision as well as an enclosure of the decision refer to the claim set dated 26 April 2013.

The wording of claim 1 dated 7 July 2017 uncontestedly differs from that of claim 1 dated 26 April 2013 at least in that "the cartridge (10, 110) including a valve (168)" is replaced by "the cartridge (10, 110) includes a valve (168)" (emphasis added). The two requests in question are therefore not identical and it is not unambiguously derivable from the decision on which request the decision under appeal is actually based, i.e. which documents "are found to meet the requirements of the Convention".

- 2.5 A decision is not reasoned within the meaning of Rule 111(2), first sentence, EPC if it is not unambiguously clear from it, possibly after consulting other parts of the file, which request(s) - including any items such as claims, description pages and drawings - it is based on (T 405/12, *supra*, Reasons 6 to 16).

- 2.6 As set out above, it is not unambiguously clear from the impugned decision which request it is based on.

None of the other parts of the file are of help here. In particular, while the appellant's last request before the issuance of the impugned decision is the set of claims dated 7 July 2017, the communication under Article 101(1) and Rule 81(2) to (3) EPC issued by the opposition division and dated 7 August 2017 states that the respondent had been invited "to adapt **only** the description and the figures" (emphasis in the original) and filed "a set of claims equivalent to that of the auxiliary request 6".

From these facts, it can be concluded, at most, that it did not matter to the opposition division which claim set the decision was based on, since it considered both claim sets to be "equivalent" without giving any reasons for this conclusion, especially when the order of the board in its decision T 303/13 dated 29 October 2015 was unambiguously clear and referred to auxiliary request 6 of 26 April 2013.

- 2.7 The decision therefore lacks sufficient reasoning within the meaning of Rule 111(2), first sentence, EPC. Thus, the opposition division committed a substantial procedural violation, and fundamental deficiencies in the first-instance proceedings are apparent.
3. No remittal
 - 3.1 Pursuant to Article 11 RPBA, a board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first-instance proceedings, unless special reasons present themselves for doing otherwise.
 - 3.2 Both parties requested the case not to be remitted for further prosecution and to be finally dealt with by the board. These requests, and the fact that the present

appeal is the second appeal in these proceedings, are special reasons within the meaning of Article 11 RPBA. The board therefore decided not to remit the case to the department of first instance for further prosecution, but to reach a final decision.

4. Admittance of the respondent's sole request

4.1 The appellant requests that the respondent's sole request be rejected as inadmissible pursuant to Article 12(4) RPBA. It does not object to the adapted description or the adapted drawing sheets but argues that, in the proceedings before the opposition division, after remittal, the respondent had not requested the maintenance of the patent based on the wording of the claims of the now sole request, i.e. the claims referred to in the order of decision T 303/13. As the respondent could and should have requested this in the proceedings before the opposition division, but did not, the respondent's sole request should not be admitted into these appeal proceedings pursuant to Article 12(4) RPBA.

4.2 The present appeal proceedings concern a decision taken by the opposition division after remittal by a first board of appeal. The present board is thus bound by the order in decision T 303/13 made by the first board (Article 111(2); T 843/91 of 5 August 1993, Reasons 3.4 citing T 79/89). In T 303/13, the first board ordered the maintenance of the patent based on the claims of what is now the respondent's sole request. Considering the above binding effect, the present board has no discretion to reject as inadmissible the claims of respondent's main request. As to the description and the drawings, these were filed in the first-instance proceedings and, thus, Article 12(4) RPBA does not

apply. Moreover, it is noted that the appellant does not object to the description or the drawings in substance.

4.3 For these reasons, the board rejected the appellant's request to hold the respondent's sole request as inadmissible.

5. Reimbursement of the appeal fee

5.1 The board may, even in the absence of a request to this effect, examine *ex officio* whether reimbursement of the appeal fee is equitable by reason of a substantial procedural violation (see Case Law of the Boards of Appeal, 8th edition, IV.E.8.2.1).

5.2 For the reasons set out above, the board considers the reimbursement of the appeal fee equitable (Rule 103(1) (a) EPC). The appeal fee is thus to be reimbursed.

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 with the order to maintain the patent in amended form on the basis of the following:

Claims 1 to 5 of the request as referred to in the order of the decision of 29 October 2015 in case T 303/13 and the description, pages 1 to 16, and drawing sheets 1 to 7, both submitted with letter dated 21 March 2017.

3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



C. Vodz

E. Bendl

Decision electronically authenticated