

**Internal distribution code:**

- (A) [ - ] Publication in OJ
- (B) [ - ] To Chairmen and Members
- (C) [ - ] To Chairmen
- (D) [ X ] No distribution

**Datasheet for the decision  
of 14 December 2021**

**Case Number:** T 2610/18 - 3.2.06

**Application Number:** 14704890.4

**Publication Number:** 2958461

**IPC:** A46D1/00, B24D13/04, B24D13/10,  
A46B13/00, A46B7/00, B60S3/06,  
A46B7/10, B24D13/06

**Language of the proceedings:** EN

**Title of invention:**  
ROTARY BRUSH, FOR MOTOR VEHICLE WASHING SYSTEMS

**Patent Proprietor:**  
Favagrossa Edoardo S.r.l.

**Opponent:**  
Morelite S.r.l.

**Headword:**

**Relevant legal provisions:**  
EPC Art. 113(1), 113(2), 111(1)  
EPC R. 82(1), 103(1) (a)  
RPBA 2020 Art. 11

**Keyword:**

Right to be heard - substantial procedural violation (yes)

Remittal - fundamental deficiency in first instance  
proceedings (yes)

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

**Decisions cited:**

**Catchword:**



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

Boards of Appeal of the  
European Patent Office  
Richard-Reitzner-Allee 8  
85540 Haar  
GERMANY  
Tel. +49 (0)89 2399-0  
Fax +49 (0)89 2399-4465

Case Number: T 2610/18 - 3.2.06

**D E C I S I O N**  
**of Technical Board of Appeal 3.2.06**  
**of 14 December 2021**

**Appellant:** Morelite S.r.l.  
(Opponent) Via Guardia di Rocca, 37  
47899 Serravalle (SM)

**Representative:** Negrini, Elena  
Agazzani & Associati S.r.l.  
Studio Ing. Giampaolo Agazzani  
Via dell'Angelo Custode 11/6  
40141 Bologna (IT)

**Respondent:** Favagrossa Edoardo S.r.l.  
(Patent Proprietor) Via Lepanto 51  
26041 Roncadello di Casalmaggiore (CR) (IT)

**Representative:** Rastelli, Franco  
Dott. Franco Cicogna & C. SRL  
Via Visconti di Modrone, 14/A  
20122 Milano (IT)

**Decision under appeal:** **Interlocutory decision of the Opposition  
Division of the European Patent Office posted on  
22 August 2018 concerning maintenance of the  
European Patent No. 2958461 in amended form.**

**Composition of the Board:**

**Chairman** M. Harrison  
**Members:** M. Dorfstätter  
W. Ungler

## **Summary of Facts and Submissions**

- I. An appeal was filed by the opponent against the interlocutory decision of the opposition division dated 22 August 2018 in which the opposition division found that European patent No. 2 958 461 in an amended form met the requirements of the EPC.
- II. The appellant (opponent) requested that the decision under appeal be set aside and the patent be revoked (main request). Furthermore, it requested reimbursement of the appeal fee due to a procedural violation. The respondent (patent proprietor) requested that the appeal be dismissed. Both parties requested oral proceedings on an auxiliary basis.
- III. Under point IX of the statement of grounds of appeal the appellant pointed out in essence that the opposition division had taken a decision on the patent proprietor's amended main request without having complied with its obligation to issue a communication indicating the reasons decisive for the maintenance of the patent beforehand. The appellant noted that it had not been given the opportunity to comment on the reasons decisive for the maintenance of the patent. The appellant concluded that its right to be heard had been violated.
- IV. The Board issued a communication under Article 15(1) RPBA 2020 containing its provisional opinion, in which it indicated its intention to remit the case to the department of first instance due to a procedural violation and to order reimbursement of the appeal fee. Furthermore, the parties were invited to indicate

whether their requests for oral proceedings were maintained.

- V. With letter of 22 June 2021 the respondent agreed to the envisaged remittal of the case to the opposition division.
- VI. Due to the fact that the appellant had not withdrawn its request for oral proceedings the Board summoned the parties to oral proceedings and informed them on the restriction of the subject of the oral proceedings to the issue of the alleged procedural violation, the reimbursement of the appeal fee and the remittal of the case to the opposition division.
- VII. With letter of 29 November 2021 the appellant agreed to the envisaged remittal of the case to the opposition division.
- VIII. The Board subsequently cancelled the scheduled oral proceedings.

### **Reasons for the Decision**

- 1. Alleged procedural violation
  - 1.1 The basic issue to be decided in these appeal proceedings is whether or not the proceedings before the opposition division suffered from a substantial procedural violation.
  - 1.2 The main request underlying the decision under appeal was filed by the patent proprietor with letter dated 19 October 2017 in reply to the notice of opposition. It is undisputed that independent claim 1 of the main

request was substantially modified compared to the granted version.

1.3 By communication of the formalities officer dated 26 October 2017 the patent proprietor's reply to the Notice of opposition, containing *inter alia* the aforementioned main request, was submitted to the opponent. The opponent did not file any submission in reaction to the patent proprietor's reply. The impugned decision was issued by the opposition division on 22 August 2018 without having issued a communication containing its preliminary opinion or an invitation to the parties to submit observations prior to the despatch of its decision. In its decision the opposition division emphasised that none of the parties had requested oral proceedings.

1.4 The Board finds that the issuing of a communication under Rule 82(1) EPC was required in that specific situation. Rule 82(1) EPC reads as follows: "Before the opposition division decides to maintain the European patent as amended, it shall inform the parties of the text in which it intends to maintain the patent, and shall invite them to file their observations within two months if they disapprove of that text." Rule 82(1) EPC ensures that the right of the parties to be heard is respected in opposition proceedings before any decision is taken. In the present case, no objection against the amended main request was raised by the opponent and - evidently - the opposition division had no such objection either. However, contrary to the stipulations of Rule 82(1) EPC, the parties had not been informed of the opposition division's intention to maintain the patent on the basis of the amended main request and on the description and drawings as contained in the specification. Furthermore, the parties were not

invited to comment on that text within a specified period as also foreseen in Rule 82(1) EPC.

1.5 In that regard it is also noted that the patent proprietor's main request consisted only of a set of claims but did not make reference to any version of the description and drawings, on the basis of which the patent should have been maintained. Also the issue of whether there was any need to adapt the description/drawings had never even been addressed in the proceedings. Thus, the parties were unaware of the complete text on which the impugned decision was later based. The decision under appeal thus came as a surprise to the parties and violated their right to be heard (Article 113(1) EPC).

1.6 Furthermore, the procedural handling of the opposition division is also not in line with Article 113(2) EPC. According to Article 113(2) EPC, the EPO shall examine, and decide upon, the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or the proprietor of the patent. In the present case the impugned decision was based on the description and drawings as contained in the specification, although the patent proprietor never specified any version of the description/drawings forming part of its main request. Thus, the impugned decision was issued without having clarified beforehand the question as to which pages of the description and drawings were intended to be maintained together with the amended claims.

1.7 Thus, the provisions of Article 113(1) and (2) and Rule 82(1) EPC have not been complied with. The opposition proceedings are therefore tainted by substantial procedural deficiencies.

2. Remittal of the case to the opposition division
  - 2.1 According to Article 111(1) EPC the Board may exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution. It is thus at the Board's discretion whether it examines and decides on the case or whether it remits the case to the department of first instance.
  - 2.2 Furthermore, according to Article 11 RPBA 2020, the Board shall not remit a case to the department whose decision was appealed for further prosecution, unless special reasons present themselves for doing so. As a rule, fundamental deficiencies which are apparent in the proceedings before that department constitute such special reasons.
  - 2.3 The procedural defects set out above in point 1.7 amounting *inter alia* to a violation of the appellant's right to be heard (Article 113(1) EPC) and constitute a fundamental deficiency within the meaning of Article 11 RPBA 2020, justifying a remittal to the opposition division.
  - 2.4 The decision to remit the case to the opposition division is not adverse to any of the parties, since both parties agreed to the remittal (cf. points V. and VII. above). Hence, the Board was in a position to issue a decision in the written proceedings without the need for oral proceedings.
3. Reimbursement of the appeal fee

- 3.1 According to Rule 103(1)(a) EPC the appeal fee is to be reimbursed in full where the Board deems an appeal allowable, if such reimbursement is equitable by reason of a substantial procedural violation.
- 3.2 Since the Board has come to the conclusion that a substantial procedural violation has occurred, due to which the decision under appeal is to be set aside, reimbursement of the appeal fee in full is equitable in accordance with Rule 103(1)(a) EPC.

## 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 to be reimbursed.

The Registrar:

The Chairman:



D. Grundner

M. Harrison

Decision electronically authenticated