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**Datasheet for the decision
of 7 February 2022**

Case Number: T 2553/19 - 3.4.02

Application Number: 12164014.8

Publication Number: 2650679

IPC: G01N29/04, G01N29/28, F01D25/28

Language of the proceedings: EN

Title of invention:

Device and method to perform ultrasonic testing of
turbomachines

Applicant:

Siemens Energy Global GmbH & Co. KG

Relevant legal provisions:

EPC Art. 9(2), 9(4), 104, 111(1), 113(1), 114(1)
EPC R. 103(1)(a)
RPBA 2020 Art. 11, 12(2)
RPBA Art. 12(2), 12(4)

Keyword:

Substantial procedural violation in the first-instance oral
proceedings (no)
Remittal and reimbursement of the appeal fee (no)
Admission of requests filed in appeal (no)
Award of costs (no)

Decisions cited:

J 0014/87



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Case Number: T 2553/19 - 3.4.02

D E C I S I O N
of Technical Board of Appeal 3.4.02
of 7 February 2022

Appellant: Siemens Energy Global GmbH & Co. KG
(Applicant) Otto-Hahn-Ring 6
81739 München (DE)

Decision under appeal: **Decision of the Examining Division of the European Patent Office posted on 25 July 2019 refusing European patent application No. 12164014.8 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman R. Bekkering
Members: F. J. Narganes-Quijano
T. Karamanli

Summary of Facts and Submissions

I. The appellant (applicant) lodged an appeal against the decision of the examining division refusing European patent application No. 12164014.8.

II. In the decision under appeal reference was made to the following documents:

D1: US 6 487 922 B1

D2: US 4 194 400 A

D3: US 4 368 642 A

D5: GB 2 139 353 A.

In its decision the examining division concluded as follows in respect of the main request and auxiliary requests 1 to 3 then on file:

- Main request: The application lacked unity within the meaning of Article 82 EPC, the subject-matter of claim 1 was not new in view of document D1 and did not involve an inventive step over any of documents D2 and D3, and independent claim 11 was not clear (Article 84 EPC) and its subject-matter did not involve an inventive step over any of documents D1 and D2.

- Auxiliary request 1: The application lacked unity within the meaning of Article 82 EPC, the subject-matter of claim 1 was not new in view of document D5, and independent claim 10 was not clear (Article 84 EPC) and its subject-matter did not involve an inventive step over document D5.

- Auxiliary request 2: The claims were not admitted under Rule 116(2) EPC for being late filed and *prima facie* not allowable (lack of clarity and lack of novelty in view of document D5).

- Auxiliary request 3: The subject-matter of claim 1 did not involve an inventive step over document D5 and the common general knowledge.

- III. The appellant's letter dated 1 August 2019 and filed on 7 August 2019 contained its notice of appeal and the statement setting out the grounds of appeal. With the mentioned letter the appellant also submitted claims according to a main request and auxiliary requests I to IV. An identical copy of the claims of the main request was subsequently filed with the letter dated 13 August 2019 and filed on 19 August 2019.
- IV. In a communication under Article 15(1) RPBA annexed to the summons to oral proceedings the board presented a preliminary assessment of the case.
- V. Oral proceedings before the board were held on 7 February 2022.

The oral proceedings were opened in the absence of the appellant. Thereafter, the board was informed by the registrar that the appellant's authorised employee had informed her in a telephone call that the appellant would not be attending the oral proceedings and that, as subsequently confirmed in an email received during the oral proceedings, the appellant had requested a decision according to the state of the file.

The Chairman noted that the appellant had requested in writing that

- the decision under appeal be set aside, the case be remitted to the department of first instance for further prosecution, and the appeal fee be reimbursed,
- the decision under appeal be set aside and a European patent be granted on the basis of the claims

of the main request or one of auxiliary requests I to IV filed by letter dated 1 August 2019, and

- the appellant be awarded the costs incurred by the first-instance oral proceedings.

At the end of the oral proceedings the chairman announced the decision of the board.

Reasons for the Decision

1. *The appeal is admissible.*
2. *Non-attendance of the appellant at the oral proceedings before the board*

In view of Rule 115(2) EPC and Article 15(3) RPBA 2020 (which applies in accordance with Article 25(1) RPBA 2020), a board has the discretionary power to hold the oral proceedings in the absence of a duly summoned party.

In the case in hand, having been informed after the opening of the oral proceedings that the duly summoned appellant would not be attending the oral proceedings, the board decided to proceed with the oral proceedings in the absence of the appellant.

Moreover, in the case in hand, by not attending the oral proceedings, the appellant effectively chose not to avail itself of the opportunity to present its observations and counter-arguments orally but instead to rely on its written submissions. This was also confirmed by the appellant's request for a decision

according to the state of the file submitted by its email received during the oral proceedings before the board.

The board was in a position to announce a decision at the conclusion of the oral proceedings in accordance with Article 15(6) RPBA 2020, which is applicable in accordance with Article 25(1) RPBA 2020.

3. *Allegation of a substantial procedural violation - Requests for remittal, reimbursement of the appeal fee, and award of costs*

3.1 The appellant submitted that the first-instance oral proceedings were tainted with a substantial procedural violation.

The following essential course of the first-instance oral proceedings can be taken from the corresponding minutes:

- After the main request then on file had been discussed, the patentability of the claims of auxiliary request 1 then on file was discussed on the basis of document D1 and, subsequently, the examining division introduced a new document, namely document D5, and summarised the content of the document (minutes, page 1, section "Main request" and "Auxiliary request 1").

- The appellant's authorised employee was then offered time to study document D5, and the oral proceedings were interrupted from 09:35 to 10:00 (minutes, page 2, last four paragraphs).

- Thereafter, the chairman announced the opinion of the examining division that the subject-matter of claim 1 of auxiliary request 1 was not new in view of document D5 (minutes, page 3, first paragraph).

- Subsequently, the appellant filed a new auxiliary request (auxiliary request 2) which, after discussion, was not admitted by the examining division (minutes, page 3, second paragraph, to page 4, second paragraph), and thereafter a further auxiliary request which, after discussion, was withdrawn by the appellant (minutes, page 4, third paragraph) and, finally, a further auxiliary request (auxiliary request 3), which was then discussed and refused by the examining division (minutes, page 4, fifth paragraph, to page 5, last paragraph).

3.1.1 The appellant submitted that

- document D5 had not been submitted before and also not at the beginning of the oral proceedings, but during the oral proceedings;

- there had not been sufficient opportunity for the appellant's authorised employee to assess the content of document D5, especially as this would have had required an internal discussion with the appellant on the technical relevance of the document and on possible limitations to the application;

- the examining division had been aware of document D5 at least some days before the oral proceedings and could have informed the appellant of document D5 in advance of the oral proceedings, so that the appellant could have discussed internally the document and considered new requests; and

- the introduction of document D5 was therefore abusive and amounted to a violation of the right to be heard.

3.1.2 The board notes, however, that the examining division is empowered under Article 114(1) EPC to refer during the examination procedure to any document it considers appropriate, and the mere introduction of a new

document during the oral proceedings is not procedurally objectionable - let alone abusive - as long as the right to be heard under Article 113(1) EPC is sufficiently respected, i.e. as long as the applicant is given an adequate amount of time to study the document and an appropriate opportunity to present comments on - and in particular to react to - the introduction of the document and the corresponding objections raised by the examining division.

In the present case the appellant was given about 25 minutes to consider document D5. This period of time is considered as adequate by the board in view of the fact that document D5 is a relatively simple and short patent document (one figure and two one-half pages of text). In addition, there is no record on file - in particular not in the minutes of the oral proceedings - that the appellant's authorised representative argued at the oral proceedings that he considered this period of time insufficient or that he requested additional time or even an adjournment of the oral proceedings in order to study the contents of the new document and to prepare comments in reaction to the examining division's objections. More particularly, there is no record on file that the appellant was not given sufficient opportunity to present counter-arguments to the examining division's objections in respect of document D5 or to react thereto. On the contrary, the appellant reacted to the introduction of document D5 by filing a new auxiliary request (auxiliary request 2) and, after the admittance of this request into the proceedings was discussed and the examining division decided not to admit this request into the proceedings, by filing a further auxiliary request which was discussed and then withdrawn, and then by filing a yet further auxiliary request (auxiliary request 3), which

was then admitted into the proceedings and discussed. In addition, the decision under appeal points out that the appellant did not bring forward any argument against document D5 as regards the objections raised by the examining division in respect of auxiliary request 1 (reasons of the decision, point 18.2.3), and the decision reproduces the counter-arguments submitted by the appellant in reply to the objections raised by the examining division in respect of auxiliary requests 2 and 3 (reasons of the decision, points 19.2, and 20.1.4). The corresponding statements in the decision indicate that the appellant was given the opportunity to comment on document D5 and on the objections raised by the examining division, and that it actually did so in respect of auxiliary requests 2 and 3.

3.1.3 The board is therefore of the opinion that, contrary to the appellant's assertion, the right to be heard enshrined in Article 113(1) EPC was not violated by the introduction of document D5 into the proceedings during the first-instance oral proceedings.

3.2 In view of the considerations in point 3.1 above, the board does not see a fundamental deficiency in the first-instance proceedings that would justify the remittal of the case to the examining division for further prosecution under Article 111(1) EPC and Article 11 RPBA 2020, which applies in accordance with Article 25 RPBA 2020 in the present case. The board also sees no substantial procedural violation in this which - if the appeal had been found allowable - would have justified the reimbursement of the appeal fee under Rule 103(1) (a) EPC.

The board concludes that the appellant's requests for remittal of the case to the examining division and for reimbursement of the appeal fee are not allowable.

3.3 As regards the request of the appellant that it be awarded the costs incurred by the first-instance oral proceedings, in particular the travel expenses and the expenses of the appellant's authorised representative, the board first notes that the appellant indicated no legal basis for such refund. In addition, the board sees no legal basis in the EPC on the basis of which the board could consider and, if appropriate, order such refund. In particular, the board notes the following:

- Article 104 EPC applies only to opposition proceedings and relates to apportionment of costs between the parties to opposition proceedings.

- Rule 103(1)(a) EPC provides for the possibility of the reimbursement of the appeal fee under certain conditions, but not for refund of the costs incurred by the first-instance oral proceedings.

- The board also has no competence to make an order against the EPO to pay any costs to the appellant incurred by the first-instance oral proceedings. Neither the EPC nor any other legal text empowers the board to consider claims against the EPO for compensation in respect of loss or damage allegedly sustained in the course of European patent grant proceedings (see also J 14/87, OJ EPO 1988, 295, Reasons, point 13). According to Article 9(2) EPC, any claim for damages against the EPO is governed by national law and has to be asserted before the competent court according to Article 9(4) EPC.

Therefore, the request for award of the costs incurred by the appellant during the first-instance oral proceedings is not allowable.

4. *Main request and auxiliary requests I to IV*

4.1 Main request - Admittance

4.1.1 The claims of the present main request are identical to the claims of auxiliary request II filed with letter dated 12 April 2019 in preparation for the first-instance oral proceedings. The board notes that

- the claims of auxiliary request II filed with the letter dated 12 April 2019 were objected to by the examining division in the telephone consultation dated 6 June 2019 (see results of the consultation dated 13 June 2019; see also decision under appeal, section "Summary of Facts and Submissions", point 12) as being directed to subject-matter relating to one of the inventions identified in the non-unity objection raised in the European Search Report and for which no additional search fee was paid;

- subsequently, with the letter dated 13 June 2019, auxiliary request II filed with the letter dated 12 April 2019 was withdrawn, and the withdrawal of this request was confirmed at the beginning of the first-instance oral proceedings (see minutes, page 1, fourth paragraph, and section "Summary of Facts and Submissions" of the decision, point 13); and

- the claims of the mentioned auxiliary request II filed with the letter dated 12 April 2019 were re-submitted and withdrawn again during the first-instance oral proceedings (minutes, page 4, third paragraph).

4.1.2 According to Article 12(4) of the Rules of Procedure of the Boards of Appeal in the version of 2007 (RPBA 2007, see OJ EPO 2007, 536), which applies in the present case according to Article 25(2) RPBA 2020, the board has the discretionary power "to hold inadmissible [...] requests which could have been presented [...] in the first instance proceedings". Since the claims of the

present main request were submitted but then withdrawn during the first-instance proceedings, the re-submission of these claims in appeal proceedings is tantamount to the submission of claims of a new request that could have been presented in the first-instance proceedings. In the circumstances of the present case, the board sees no reason that would justify taking the present main request into account in the appeal proceedings under Article 12(4) RPBA 2007.

It is noted in this respect that the withdrawal - and the subsequent re-submission and withdrawal - of auxiliary request II filed with the letter dated 12 April 2019 prevented the examining division from giving a reasoned decision on this request, in particular on the issue of whether the claims of this request involved subject-matter for which no search fee was paid. By reinstating in appeal the corresponding claims as a main request the appellant has presented the board with subject-matter on which no decision was taken by the department of first instance, and the admission of the present main request into the proceedings would compel the board either to give a first ruling on the issue of whether the subject-matter of the claims was covered by the search and, in the affirmative, on further issues (Articles 123(2), 84 and 52(1) EPC) - a task incompatible with its primary role, namely the examination of the contested decision (*cf.* Article 12(2) RPBA 2020) -, or to remit the case to the department of first instance, which is clearly contrary to procedural economy.

In addition, the present main request filed with the letter dated 1 August 2019 is not complete and substantiated within the meaning of Article 12(2) RPBA 2007 (to which Article 12(4) RPBA 2007 refers to) and according to which "[the] statement of grounds of

appeal [...] shall contain a party's complete case" and "shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".

4.1.3 The appellant submitted in support of the admission of the present request that during the first-instance oral proceedings the appellant could not - at least not sufficiently - react to document D5 because it was denied the possibility to react. However, as already noted in point 3.1.2 above, the appellant could, and as a matter of fact did (among others, by submitting the then auxiliary requests 2 and 3), react to the introduction of document D5 into the proceedings and to the corresponding objections raised by the examining division. In addition, the fact that the claims of the present main request, which were submitted and then withdrawn before the first-instance oral proceedings, were subsequently re-submitted during the first-instance oral proceedings after the introduction of document D5 into the proceedings and then withdrawn again (see minutes, page 4, third paragraph) is at variance with the appellant's submissions that it was denied the possibility to react and that this would justify submitting for the third time the mentioned claims in appeal.

4.1.4 In view of these considerations, the board exercises its discretionary power under Article 12(4) RPBA 2007 and does not admit the main request into the proceedings.

4.2 Auxiliary request I - Article 12(4) RPBA 2007

The claims of auxiliary request I are identical to the claims of auxiliary request 3 underlying the decision under appeal. In its decision the examining division held that the subject-matter of claim 1 of this request did not involve an inventive step over document D5 and the common general knowledge (Article 56 EPC).

In accordance with Article 12(4) RPBA 2007 the present auxiliary request I is to be taken into account by the board "if and to the extent it [...] meets the requirements in [Article 12(2) RPBA 2007]", according to which "[the] statement of grounds of appeal [...] shall contain a party's complete case" and "shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on".

However, neither the notice of appeal nor the statement of grounds of appeal filed with letter dated 1 August 2019 contains any substantive submission as to why the examining division's finding of lack of inventive step was not correct and the decision under appeal should be reversed in this respect. Therefore, the appellant's case is not complete and substantiated within the meaning of Article 12(2) RPBA 2007 in respect of the present auxiliary request I.

For these reasons, auxiliary request I is not taken into account in the appeal proceedings in accordance with Article 12(4) RPBA 2007.

4.3 Auxiliary requests II, III and IV - Article 12(4) RPBA 2007

As noted by the appellant, the claims of auxiliary requests II, III and IV consist of different combinations of claims of the application as originally filed. In addition, these claims have been filed for the first time with the notice of appeal and do not correspond to any of the claims filed during the first-instance proceedings.

In support of the admittance of auxiliary requests II, III and IV the appellant submitted that during the first-instance oral proceedings the appellant could not - at least not sufficiently - react to document D5 because it was denied the possibility to react.

However, as already noted in points 3.1.2 and 4.1.3 above, the appellant could, and as a matter of fact did, react to the introduction of document D5 into the proceedings and to the corresponding objections raised by the examining division.

In addition, the statement of grounds of appeal contains no substantive submission as to why the claims of auxiliary requests II, III and IV would overcome the objections raised by the examining division in its decision in respect of the then main request and auxiliary requests 1 and 3, and in particular as to why the subject-matter of the amended claims was covered by the search or would be new and involve an inventive step over the documents considered by the examining division in its decision, and in particular over document D5.

Therefore, the appellant's case is not complete and substantiated within the meaning of Article 12(2) RPBA 2007 in respect of auxiliary requests II, III and IV, and, for considerations analogous to those set forth in

point 4.2 above in respect of auxiliary request I, auxiliary requests II, III and IV are not taken into account in the appeal proceedings in accordance with Article 12(4) RPBA 2007.

- 4.4 In view of the above considerations, none of the main request and auxiliary requests I to IV is allowable and therefore the appeal must be dismissed.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The request for reimbursement of the appeal fee is refused.
3. The request for award of costs is refused.

The Registrar:

The Chairman:



H Jenney

R. Bekkering

Decision electronically authenticated