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**Datasheet for the decision
of 24 November 2023**

Case Number: T 2020/20 - 3.3.02

Application Number: 07110011.9

Publication Number: 1887076

IPC: C10M163/00, C10N40/25

Language of the proceedings: EN

Title of invention:
Lubricating oil compositions

Applicant:
Infineum International Limited

Relevant legal provisions:
EPC Art. 113(1), 116(1), 18
EPC R. 71(3), 113(1)

Keyword:
Substantial procedural violation: change in composition of
examining division - obligation to offer new oral proceedings

Decisions cited:
T 0390/86, T 0243/87, T 0714/92, T 0862/98, T 0900/02,
T 0211/05, T 1170/05, T 0160/09, T 1207/09, T 2175/16



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Case Number: T 2020/20 - 3.3.02

D E C I S I O N
of Technical Board of Appeal 3.3.02
of 24 November 2023

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Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 25 June 2020
refusing European patent application
No. 07110011.9 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. O. Müller
Members: A. Lenzen
B. Burm-Herregodts

Summary of Facts and Submissions

- I. This decision concerns the appeal filed by the applicant (appellant) against the examining division's decision (decision under appeal) to refuse European patent application No. 07110011.9 (application).
- II. A summary of the history of the case before the examining division is set out in the reasons for the decision below.

The appellant had argued that the decision under appeal was affected by a substantial procedural violation due to the fact that the composition of the examining division hearing the case at oral proceedings differed from the composition of the examining division signing the decision. One member signing the decision had not heard the case.

- III. The appellant requested that the decision under appeal be set aside and that the case be remitted to the examining division for further prosecution.
- IV. At the end of the oral proceedings before the board, which took place on 24 November 2023 by videoconference, the chair announced the order of the present decision.

Reasons for the Decision

1. The history of the case before the examining division is relevant to the present decision. It can be summarised as follows:

- 1.1 The examining division issued a communication pursuant to Rule 71(3) EPC on 14 September 2017, after which a third party filed its observations on 26 January 2018. The examining division issued a second communication according to Rule 71(3) EPC on 26 June 2018, after which new observations were filed by the same third party. Oral proceedings before the examining division took place on 16 July 2019. The admissibility of the third-party observations, the main request, auxiliary request 1 and auxiliary request 2 were discussed. The examining division decided to admit the two sets of observations filed by the third party prior to the oral proceedings. With respect to the main request and auxiliary request 1, the examining division set out its opinion that claim 1 in each case lacked clarity (Article 84 EPC). At the end of the oral proceedings, the examining division informed the appellant that it could expect a communication pursuant to Rule 71(3) EPC on the basis of auxiliary request 2, provided that a clean copy of the application documents was filed.
- 1.2 The appellant filed a clean copy of the application documents, as requested.
- 1.3 On 21 August 2019, the examining division issued a third communication pursuant to Rule 71(3) EPC expressing its intention to grant a European patent based on auxiliary request 2. In an annex, the examining division set out the reasons why it had admitted the third-party observations and why it considered the claims of the main request and auxiliary request 1 to be unclear and thus not allowable.
- 1.4 On 6 September 2019, the third party filed a third set of observations and new documents, which the examining division considered irrelevant.

- 1.5 By letter dated 20 December 2019, the appellant indicated that it did not approve the text proposed for grant in the third communication pursuant to Rule 71(3) EPC. It requested a decision which could be appealed if the examining division was not able to grant a patent based on either the main request or auxiliary request 1.
- 1.6 On 25 June 2020, the examining division issued the decision under appeal. The reasoning given for the admittance of the third-party observations and the non-allowability of the main request and auxiliary request 1 is an almost verbatim copy of the reasoning annexed to the third communication pursuant to Rule 71(3) EPC. Compared to the composition of the examining division which had conducted the oral proceedings and which had issued the third communication pursuant to Rule 71(3) EPC, the composition of the examining division which signed the decision under appeal was changed: the first examiner was no longer part of the division, the previous chairman had become the first examiner and a new chairman had been appointed. The examining division pointed out that following the advice of the Directorate Patent Law, it had come to the conclusion that this change in composition did not preclude it from issuing the decision under appeal without a further summons to oral proceedings.
2. According to Rule 113(1) EPC, any decision of the European Patent Office shall be signed by, and state the name of, the responsible employee.

It is clear from the summary above that the chairman of the examining division who signed the decision under

appeal had not taken part in the prior oral proceedings and that the signature of one of the three original members of the examining division was missing.

3. It is established case law that a signed written decision issued after oral proceedings should be taken by the same members of the first-instance division who conducted the oral proceedings. If a change in the composition of the division occurs after oral proceedings, parties should therefore be offered new oral proceedings. Failure to do so constitutes a substantial procedural violation (Case Law of the Boards of Appeal, 10th edition, 2022, III K 1.1; T 390/86, points 5 to 10 of the Reasons; T 243/87, point 3 of the Reasons; T 862/98, point 2.3 of the Reasons; T 900/02, point 9 of the Reasons; T 1170/05, points 2.1 to 2.5 of the Reasons; T 2175/16, point 3 of the Reasons).

4. According to T 862/98 (point 2.3.2 of the Reasons), an offer of new oral proceedings may be foregone only in exceptional cases, for example if the final decision given by a differently composed division is not substantially based on findings arrived at during the oral proceedings but rather on fresh facts and arguments communicated to the parties in the resumed written proceedings.

However, this does not apply to the present case because the reasons for which the third-party observations were admitted and for which the main request and auxiliary request 1 were not considered allowable in the decision under appeal had been discussed and assessed by the examining division in the prior oral proceedings.

5. The fact that the appellant did not request further oral proceedings after the oral proceedings that had already been held and before the written decision by the differently composed examining division, as the examining division stated in the decision under appeal, certainly did not relieve the examining division of its obligation to offer new oral proceedings. Irrespective of this, the reasoning of the examining division is not logically comprehensible in the present case because the appellant could only have become aware of the change in composition after the decision under appeal had been notified.
6. According to Article 18 EPC, oral proceedings should be held before the examining division itself. The right under Article 116(1) EPC to have oral proceedings can therefore only mean a right to have oral proceedings before the examining division in a composition which also takes the final decision on the case. If the division conducting the oral proceedings could be different from that taking the final decision, oral proceedings would be deprived of its purpose and Article 116(1) EPC would be meaningless.
7. Contrary to the assertions made in the decision of the examining division, it is irrelevant that the new chairman, after having studied the written file, arrived at the same opinion as that expressed in the minutes of the oral proceedings and in the annex to the communication pursuant to Rule 71(3) EPC.
8. In particular, it cannot be ruled out that the written file did not contain all of the arguments presented during the oral proceedings. To make matters worse, even an argument present in the written file can have a completely different persuasive value when submissions

on this argument have been heard during the oral proceedings, for example because it is presented in a context that is not apparent to the reader from studying the written file alone. This is precisely the reason why oral proceedings are considered to be such a fundamental expression of the right to be heard. The conclusion indirectly drawn in the decision under appeal that the examining division, even in its new composition, would have come to the same conclusion in oral proceedings as the examining division in its previous composition is therefore not correct. On the contrary, the outcome of the oral proceedings before the new composition of the division could very well have been different from that before the previous composition.

9. It is thus unclear whether the new chairman simply went along with the opinion announced during the oral proceedings by the examining division in its previous composition or whether he took the decision on the case on his own. In this respect, it should be noted that the applicant's right to be heard is only safeguarded when the principle of the power to examine and decide on a patent application is personally exercised by a full examining division and when it is seen, by both the applicant and the public, that this power is being exercised personally by this composition (T 211/05, point 2 of the Reasons, and T 390/86, point 7 of the Reasons). In the present case, even if, objectively, the new chairman did decide on the case on his own, this still cannot necessarily be seen by the applicant and the public to have been the case.
10. Contrary to the opinion of the examining division, it is also irrelevant to the finding of a substantial procedural violation that the examining division in its

former composition did not announce its decision at the oral proceedings that it considered the main request and auxiliary request 1 non-allowable or that it intended to refuse the application but instead merely expressed opinions on the requests which were to become the subject of the decision under appeal (T 862/98, point 2.3.2 of the Reasons).

11. Lastly, decisions T 1207/09 and T 160/09, which were relied on by the examining division as support for its course of action, concern cases in which the composition of an examining division was changed before the oral proceedings. Therefore, these cases are not relevant to the present case, in which the change in composition occurred after the oral proceedings and before the written decision was issued.

12. It has to be concluded that the examining division in the composition issuing the decision under appeal committed a substantial procedural violation by not offering new oral proceedings to the appellant. The decision under appeal is to be considered void *ab initio* and without any legal effect (Case Law of the Boards of Appeal, 10th edition, 2022, III. K 1.1.2; T 714/92, point 6 of the Reasons). The case is to be re-examined, including the issue of the admittance of the third-party observations. In the present case, a refund of the appeal fee is clearly equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the examining division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:



M. Schalow

M. O. Müller

Decision electronically authenticated