

Internal distribution code:

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

**Datasheet for the decision
of 30 October 2023**

Case Number: T 2024/21 - 3.2.06

Application Number: 15185751.3

Publication Number: 3009596

IPC: F01D5/06, F01D5/08

Language of the proceedings: EN

Title of invention:

SECONDARY FLOWPATH SYSTEM FOR A ROTOR ASSEMBLY OF A GAS
TURBINE ENGINE

Applicant:

RTX Corporation

Headword:

Relevant legal provisions:

EPC Art. 113(1), 116(1)
EPC R. 137(3), 103(1)(a)
RPBA 2020 Art. 11

Keyword:

Examination procedure - substantial procedural violation - request for oral proceedings ignored (yes)
Remittal - fundamental deficiency in first-instance proceedings (yes)
Reimbursement of appeal fee - equitable by reason of a substantial procedural violation

Decisions cited:

J 0006/22, T 0598/88, T 0668/89, T 0731/93, T 0808/94,
T 0556/95, T 0189/06, T 0552/06, T 0777/06, T 0263/07,
T 1426/07, T 0653/08, T 1251/08, T 0996/09, T 1829/10,
T 0740/15

Catchword:

Examining division's continual refusal to appoint oral proceedings rendered the appellant's request for oral proceedings futile. Withdrawal of the request for oral proceedings under these circumstances does not absolve the examining division from its duty to hold oral proceedings (Reasons 1.5).



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 2024/21 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 30 October 2023

Appellant: RTX Corporation
(Applicant) 10 Farm Springs Road
Farmington, CT 06032 (US)

Representative: Dehns
St. Bride's House
10 Salisbury Square
London EC4Y 8JD (GB)

Decision under appeal: **Decision of the Examining Division of the
European Patent Office posted on 23 June 2021
refusing European patent application No.
15185751.3 pursuant to Article 97(2) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
W. Ungler

Summary of Facts and Submissions

- I. The applicant's appeal is directed against the decision of the examining division of the European Patent Office posted on 23 June 2021 refusing European patent application No. 15185751.3 pursuant to Article 97(2) EPC.
- II. In its statement of grounds of appeal the appellant brought forward *inter alia* that several procedural violations had occurred during the examination procedure. Foremost, the appellant submitted that it had been deprived of its right to oral proceedings.
- III. The following facts of the examination proceedings are pertinent for the present decision:
- IV. In the European Search Opinion, objections were raised under Article 84 EPC *inter alia* for lack of essential features and for lack of clarity of certain terms used in the claims, as well as objections of lack of inventive step (Article 56 EPC). In reaction to the European Search Opinion, the appellant filed amended pages of the description and an amended set of claims. Furthermore, the appellant replied in substance to the objections contained in the European Search Opinion, in particular also to the clarity objections. Moreover, the appellant requested oral proceedings.
- V. In its communication dated 11 April 2019 the examining division raised new objections under Articles 123(2) and 84 EPC in relation to the amended set of claims and maintained most of the former objections. In addition, the appellant was informed that the examining division would not admit any further amendments under Rule

137(3) EPC unless the objections under Articles 84 and 123(2) EPC were resolved.

VI. In response to the examining division's communication the appellant filed, with letter of 27 September 2019, amended pages of the description and an amended set of claims. By deletion of claims 12 to 15 the appellant met some of the examining division's objections under Articles 84 and 123(2) EPC. Furthermore, the appellant replied in substance to the issues of novelty and inventive step of the claimed subject-matter. With regard to the outstanding objections under Articles 84 and 123(2) EPC the appellant expressed its disagreement and again requested oral proceedings in particular to discuss these topics.

VII. With its communication dated 28 August 2020 the examining division in essence maintained its objections under Articles 84 and 123(2) EPC against claims 1 to 11 and added in particular that also essential features from original claim 15 were to be included in claim 1. As regards the issue of inventive step, the examining division referred to its previous opinion without addressing the appellant's arguments provided in its letter of 27 September 2019. Furthermore, the examining division informed the appellant that it did not *"give its consent under Rule 137(3) EPC to the newly filed set of claims (Guidelines H-11, 2.3.1.2 and 2.3.1.3). The legal effect of this is that there is no agreed text, which would result in a refusal under Article 113(2) EPC."*

VIII. With its letter dated 5 January 2021 the appellant filed amended pages of the description, withdrew its request for oral proceedings and requested a decision according to the state of the file. However, the

appellant made clear that it maintained all previously filed arguments and amendments. In particular, the applicant complained about the conduct of the proceedings by the examining division, in particular that the "essential feature" objections had not been sufficiently substantiated, that arguments of the appellant had not been taken into account and that the appellant's request for oral proceedings, which would have brought *"the examination to a close in an efficient and effective way"*, had not been met. Furthermore, the appellant complained about the non-admittance of amendments under Rule 137(3) EPC. In addition, the appellant replied in substance to the objections under Articles 84 and 123(2) EPC.

- IX. By communication dated 25 January 2021 the examining division emphasised that a decision on the state of the file could only be taken if no further amendments and arguments were submitted with the request for a decision according to the state of the file. The appellant was therefore invited to re-submit his request for a decision according to the state of the file and to withdraw its request for oral proceedings. The examining division noted as follows: *"With respect to the so far missing summons to oral proceedings, as commented by the Applicant: Please note that it is the duty of the Applicant (not of three members of the European Patent Office) to fulfill the requirements of the EPC, to adapt the description appropriately and to provide an admissible and agreeable claim text which is adequate to provide remedy (with promise of success) and with which consensus can be achieved (Rule 137(3) EPC); a consensus (or at least an adequate approach) which is worth to spend the time and costs in oral proceedings. Please further note that oral proceedings increase the workload for three members of the*

Examining Division and not "reduce" it as supposed by the Applicant. Please further note that a proper amendment should be present as a first step for the Examining Division to do the next step, be it oral proceedings or to give consent. In such a case the Examining Division might be in the position to adequately and positively support the interests of the Applicant. Please further note that from the beginning, id est since the first amendments of the Applicant were submitted, the basic requirements of Article 123(2) were not met. Formulating an allowable claim text, also, is not the duty of an Examining Division." Furthermore, the examining division elaborated on its objections under Article 84 and 123(2) EPC.

- X. With letter of 4 May 2021 the appellant withdrew its request for oral proceedings and requested a decision according to the state of the file. Thereafter the examining division refused the application.

- XI. By communication of 18 August 2023 the Board informed the appellant of its intention to set aside the impugned decision due to a violation of the applicant's right to be heard in oral proceedings and to remit the case to the examining division for further prosecution. Furthermore, in view of the Board's assessment of the case the appellant was informed that a decision could be taken in writing and invited to comment on the question of whether its request for oral proceedings also included the issue of remittal of the case to the examining division.

- XII. With letter of 24 October 2023 the appellant noted that its request for oral proceedings did not include the issue of remittal of the case to the examining division.

Reasons for the Decision

1. Procedural violation

1.1 According to established case law the right to an oral hearing is an extremely important procedural right which the EPO should take all reasonable steps to safeguard (T 668/89, T 808/94, T 556/95, T 996/09, T 740/15). If a request for oral proceedings has been made, such proceedings have to be appointed. This provision is mandatory and leaves no room for discretion (T 283/88, T 795/91, T 556/95, T 1048/00, T 740/15), i.e. parties have an absolute right to oral proceedings. Considerations such as the speedy conduct of the proceedings, equity or procedural economy cannot take precedence over this right (cf. Case Law of the Boards of Appeal, 10th edition, III.C.2.1).

It should be noted in passing that a discussion of the recent decision J 6/22 does not appear necessary in the context of the present case, as this decision endorses, according to the understanding of the present Board, a restrictive interpretation of the right to oral proceedings for very specific procedural circumstances. However, a dynamic interpretation restricting explicitly regulated procedural rights of the parties does not seem to be considered in J 6/22 for the central area of the European grant procedure.

1.2 The reasoning contained in the contested decision (by reference to the communication of 25 January 2021, see point IX. above) is thus based on a manifestly incorrect understanding of the right to oral proceedings as enshrined in the EPC. The fact that oral proceedings cause costs is anyway no reason not to

comply with the appellant's repeatedly expressed wish to hold oral proceedings. The reminder in the contested decision of the applicant's duty to submit an EPC-compliant version of the application documents is also no reason not to comply with a request for oral proceedings. Nor is the repeated indication in the examining division's communications that amendments would not be admitted to the proceedings or had not been admitted under Article 137(3) EPC, so that no version of the application documents approved by the applicant would exist in the proceedings, a sound reason for not holding oral proceedings. Even if the examining division considered the possibility of not admitting amended application documents into the proceedings, oral proceedings would still have had to be held in the present case in order to discuss (at least) the question of (non-)admittance of the amendments with the applicant, which would have also comprised the issue of whether the objections raised by the examining division had been overcome by the amendments (see below point 1.4).

- 1.3 In the present case the appellant requested oral proceedings for the first time in its reply to the European Search Opinion. This request was later on repeated in particular for the discussion of the objections under Articles 84 and 123(2) EPC. In order to overcome the objections under Articles 84 and 123(2) EPC the appellant amended its application documents and argued against the outstanding objections. In particular the appellant asked for further explanation with respect to these objections and for oral proceedings in order to get the opportunity to discuss those issues with the examining division (cf. letter of 27 September 2019, page 3: *"We continue to respectfully disagree with these objections, and request that the*

Examining Division issue a summons to oral proceedings to discuss these points."). However, instead of summoning to oral proceedings, the examining division elaborated on the objections under Article 84 and 123(2) EPC and noted at the end of its communication as follows: *"The Applicant, however, did not provide any arguments as to the still existing Article 123(2) and 84 EPC objections. As already announced and for the above reasons, the Examining Division does not give its consent under Rule 137(3) EPC to the newly filed set of claims (Guidelines H-11, 2.3.1.2 and 2.3.1.3). The legal effect of this is that there is no agreed text, which would result in a refusal under Article 113(2) EPC."*

- 1.4 The examining division's approach of informing the applicant at that stage of the proceedings that it denied approval of the amended documents of the patent application under Rule 137(3) EPC and that there was therefore no valid text to which the applicant had given his consent under Article 113(2) EPC constituted a substantial procedural violation. In that respect, it must be taken into account that the appellant's request for oral proceedings also covered the issue of (non-)admittance of amended application documents under Rule 137(3) EPC. A decision under Rule 137(3) EPC is a discretionary decision which requires balancing the applicant's interest in obtaining a patent and the EPO's interest in bringing the examination procedure to a close. Furthermore, the exercise of discretion under Rule 137(3) EPC needs to be reasoned (cf. on that topic: Case Law of the Boards of Appeal, 10th edition, IV.B. 2.4.1). Due to its valid request for oral proceedings the appellant had the right to be heard in oral proceedings at least on the topic of admittance of the amended application documents under Rule 137(3)

EPC. Since the examining division based its non-admittance of the amended application documents on the failure to overcome objections raised under Articles 84 and 123(2) EPC, the appellant would thus also have had to be heard at the oral proceedings on the question of whether these objections had been overcome. It is therefore clear that the question of admittance of the amended application documents would have required not only a discussion in terms of formal law but, in particular, a discussion in terms of substantive content. In that regard, it must also be taken into account that the appellant had on several occasions commented on those objections. Thus, the appellant would have had to be heard on these substantive issues in oral proceedings, namely those for which it explicitly requested oral proceedings.

- 1.5 It is evident from the further course of the proceedings that this procedural deficiency adversely affected the entire further proceedings. With regard to the fact that the applicant ultimately withdrew its request for oral proceedings, it can only be concluded that the examining division's continual refusal to appoint oral proceedings and indeed its explanation for not doing so (see point IX above), made it evident that the appellant was left with no realistic possibility to have its request for oral proceedings met. Thus, maintenance of the request for oral proceedings had clearly been rendered futile. The Board thus considers that withdrawal of the request for oral proceedings under these particular circumstances did not therefore absolve the examining division from its duty to hold the originally requested oral proceedings. In this context, it must also be taken into account that the examination procedure had already lasted several years and it is immediately recognisable that the appellant

was given no other way out in order to obtain an appealable decision. And, without precluding that the objections might still be maintained, such an appealable decision may have been avoided had oral proceedings been held, giving the applicant the chance to submit its arguments as to why its application should be found allowable and to discuss the various objections with the examining division.

- 1.6 In view of the overall course of the examination proceedings it is to be noted that although the appellant ultimately withdrew its request for oral proceedings and requested a decision on the state of the file, it was deprived of its right to be heard in oral proceedings as enshrined in Articles 113(1) and 116(1) EPC. Due to this substantial procedural violation, the contested decision had to be set aside. Furthermore, the appeal fee is to be reimbursed under Rule 103(1) (a) EPC and the case is remitted to the examining division under Article 11 RPBA (Rules of Procedure of the Boards of Appeal) for further prosecution.
- 1.7 As regards the issue of remittal, the Board would like to emphasise that in view of the aforementioned fundamental procedural deficiency, the Board should in principle not perform the duty of the examining division by essentially dealing with the case itself for the first time in oral proceedings. Lastly, it cannot be assumed, merely because the examining division issued communications with previous objections maintained, that such objections would be maintained after oral proceedings are held and the oral arguments of the applicant in this respect taken into account, nor (in regard to the appellant's misgivings in this

regard) that the examining division would be "overly harsh" in this respect.

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:



D. Grundner

M. Harrison

Decision electronically authenticated