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D E C I S I O N
of 10 October 2001

Case Number: T 0740/00 - 3.2.6

Application Number: 91308725.0

Publication Number: 0482763

IPC: B27B 17/02

Language of the proceedings: EN

Title of invention:
Guide bars for tree harvesters

Patentee:
BLOUNT, INC.

Former Opponent:
SANDVIK AB
(opposition withdrawn during the appeal proceedings)

Headword:
-

Relevant legal provisions:
EPC Art. 107, 111, 113(2)
EPC R. 36(3), 58(4), 67, 68(1), 68(2), 76(1), 89

Keyword:
"Patentee adversely affected by a decision not dealing with its main request (yes)"
"Substantial procedural violations (yes): decision announced in oral proceedings must be based on the same patent documents as the decision in writing; the procedure followed by the opposition division must be clear as to what is expected of the parties; the requests of the parties must be properly established before a decision is taken"
"Remittal (yes)"
"Reimbursement of the appeal fee (yes)"

Decisions cited:
J 0012/85, T 0234/86, T 0850/95, T 0666/90, T 0552/97

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0740/00 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 10 October 2001

Appellant: (Proprietor of the patent)
BLOUNT, INC.
4909 S.E. International Way
Portland
Oregon 97222 (US)

Representative:
Walker, Antony James Alexander
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Decision under appeal: **Interlocutory decision of the Opposition Division of the European Patent Office posted 15 May 2000 concerning maintenance of the European patent No. 0 482 763 in amended form.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: H. Meinders
M. J. Vogel

Summary of Facts and Submissions

I. European Patent No. 0 482 763 was granted on European patent application No. 91308725.0. An opposition was filed in due form by the firm Sandvik AB.

II. During the written part of the ensuing Opposition Proceedings the Patentee filed a main request dated 9 May 1996 and four auxiliary requests dated 10 May 1999, being requests to be dealt with at the oral proceedings to be held before the Opposition Division on 11 June 1999. The main request involved claim 1 in the form as granted.

Oral proceedings were held on 11 June 1999.

III. By a letter of 14 September 1999 the Patentee enquired when the minutes of the oral proceedings could be expected. The oral proceedings were in its opinion concluded on the basis that the patent was maintained in amended form, but for the convenience of the participants the Opposition Division determined that amendments to the description, needed to bring it into conformity with the new claims and to include an acknowledgement of the prior art be submitted later. It further asked whether the Opposition Division would issue an interlocutory decision against which an appeal could be filed before the amendments were submitted or if that were not the case whether a formal invitation with a time limit for submitting these amendments would follow.

IV. The minutes of the oral proceedings were sent to the parties on 20 October 1999.

The cover pages of the minutes (EPO form 2309) mention:

"After deliberation of the opposition division, the chairman announced the following decision:

"Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates are found to meet the requirements of the European Patent Convention. The currently valid documents are those indicated below:"

.....

Description, pages:
1 to 6 of the patent specification.

Claims, No.:
2 to 7, 9 to 12 received on 11.05.96 with letter of 09.05.96
1,8 during oral proceeding on 11.06.99

Drawings, sheets:
1/2 and 2/2 of the patent specification."

It is further mentioned therein:

"Regarding the reasons for the decision the chairman referred to Article 102(1) EPC: one of the grounds for opposition mentioned in Article 100 EPC prejudices the maintenance of the patent as granted."

The text of the minutes itself was added as an annex to these cover pages (EPO form 2906).

V. In this text it is stated that at the beginning of the oral proceedings the chairman verified the requests as on file (point 1). They further mention discussion of claim 1 as granted and that after deliberation of the Opposition Division the parties were informed that claim 1 as granted lacked novelty (point 6). The Opposition Division then dealt with the auxiliary requests, against which the first member of the Opposition Division and the opponent raised objections. The proceedings were interrupted for the representative of the patentee to confer with his client (points 7 and 8). At point 9 of the minutes it is mentioned that "the proprietor introduced a new main request, dropping the original main request and the four auxiliary requests". A claim according to this request was discussed, the first member of the Opposition Division and the opponent raising objections (points 9 to 13), resulting in the filing of handwritten copies of claims 1 and 8 as annexed to the minutes, with an ensuing discussion on inventive step. After deliberation and resumption of the proceedings the chairman declared (point 16):

"that the subject-matter of claim 1 of the main request as amended fulfilled the requirements of the EPC and that the same applies to independent method claim 8. The patent specification should be brought in accordance with the claims, documents D4-TR and D2 were to be acknowledged in the description and reference numbers should be introduced in the claims. A fair copy of the current claims and an adapted description should be filed."

The proceedings were then declared closed by the Chairman.

VI. In the file, inserted directly after the minutes, is the text of a claim 1 and a claim 8.

Claim 1 is marked "Auxiliary request 2" in typewritten form with the number 2 deleted by hand. The substituted number 5 has also been deleted by hand. The page further bears the handwritten indication "main request" in pencil and "filed during oral proceedings 11.05.99" in ink. In the same handwriting amendments have been made in the typewritten part of claim 1. The handwriting is different from the handwriting of the handwritten part of claims 1 and 8. Only one of the handwritten amendments corresponds to a suggestion of the Opposition Division as referred to in the minutes as having been accepted by the patentee ("substantially intolerant"). The other handwritten amendments are not mentioned in the minutes.

Claim 8 (with the number "8" deleted, replaced by "9", which was again deleted and replaced by "8", all in handwritten form) is marked "Auxiliary request 2" in typewritten form with the number "2" deleted by hand and replaced by "5". The wording "auxiliary request" is further deleted by hand and replaced by "Main request for claim 8 filed during O.P. 11.05.99".

None of the pages containing the text of the claims has been signed or initialled.

VII. By a letter of 23 November 1999 the patentee filed amended pages for the description and a new set of claims 1 to 7. He questioned the content of the minutes (point 9) arguing that it was not accurate to state that the main and the four auxiliary requests submitted prior to the oral proceedings had been "dropped" by the

proprietor during the oral proceedings. The opposition division had made it quite clear that the main and auxiliary requests 2 and 4 would not be upheld for lack of novelty, that he had sought permission to submit a further amended set of claims which he had obtained. It was not the intention of the proprietor to "drop" the original main request and indeed he had no reason to do so as the opposition division had already signified that this request was refused following the first break in proceedings. In his opinion the amended claims as submitted by the proprietor and as referred to by the opposition division as a new main request constituted a further auxiliary request, as did the amended claims which were eventually accepted. The letter ended with: "I trust that the decision of the Opposition Division when it issues will reflect this".

VIII. By a letter of 8 December 1999 the Opponent made some minor textual remarks regarding the text submitted by the Patentee. It added that to its recollection the patentee had actually dropped the main and auxiliary requests in favour of the new main request.

IX. The Opposition Division sent an interlocutory decision to the parties on 15 May 2000.

The cover page (form 2339) mentions:

"The Opposition Division - at the oral proceedings dated 11.06.99 - has decided:

Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent EP-B-0482763 and the invention to which it relates are found to meet the requirements of the

Convention.

The currently valid documents are:

.....

Description, pages:
3*, 3a-3c* as received on 25.11.99 with letter of 23.11.99,

Description, columns:
1,2**, 3-6 of the patent specification,

Claims, No.:
1-7 as received on 25.11.99 with letter of 23.11.99,

Drawings, No.:
1-8 of the patent specification

With the following amendments to the above-mentioned documents by the division:

Claims, No.:
2,5***."

The asterisks refer to the comments of the Opposition Division regarding amendments carried out by it.

X. The decision deals with only one request, maintaining the patent in amended form according to claims 1 to 7. The arguments presented by the patentee in his letter of 23 November 1999 regarding the question of there only being a new main request are dealt with as follows:

"Argument of the proprietor stated in a letter of 23.11.99.

The proprietor argues that the former requests for rejection of the opposition and the further former auxiliary requests have not been dropped during oral proceedings.
However, this cannot be accepted because the protocoll states clearly that all these former request have been dropped during Oral Proceedings and have been replaced by a single new main request comprising the current claims as cited above".

XI. Against this decision an appeal was filed by facsimile by the Appellant (Patentee) on 14 July 2000, with payment of the appeal fee on that same day. The statement of grounds of appeal was filed on 22 September 2000.

XII. The Appellant requested that the decision under appeal be set aside and the patent be maintained in amended form on the basis of claims in accordance with a main or one of two auxiliary requests, attached to the statement of grounds of appeal.

The Appellant argued that a substantial procedural violation had been committed by the Opposition Division, warranting reimbursement of the appeal fee, in that the decision under appeal had not dealt with the main and auxiliary requests as maintained by the Patentee in the opposition proceedings. The decision was based on the assumption that the Patentee had no longer maintained these requests, in favour of a new main request. However, that had not been the case.

The Appellant auxiliarily requested oral proceedings if a favourable decision could not be issued due to clarification being required on any particular point.

XIII. The Respondent notified the Board by letter of 29 November 2000 that it withdrew the opposition.

XIV. In a notification pursuant to Article 12 of the Rules of Procedure of the Boards of Appeal the Board agreed with the Appellant that substantial procedural violations had occurred in the Opposition Proceedings, warranting immediate remittal to the first instance and reimbursement of the appeal fee, without the Board's examining the substantive merit of the Appellant's case. Under these circumstances, oral proceedings would not serve any purpose and the Appellant was requested to reconsider its request in that respect.

With letter of 9 August 2001 the Appellant withdrew its request for oral proceedings.

Reasons for the Decision

1. *Admissibility*

1.1 According to Article 107 EPC any party to proceedings adversely affected by a decision may appeal. If the Appellant indeed withdrew its prior requests in the oral proceedings before the Opposition Division in favour of the request dealt with in the decision, as was stated by the Opposition Division in the decision under appeal, the Appellant would not have been adversely affected by the decision to maintain the patent in amended form according to that request,

resulting in the appeal being inadmissible.

1.2 To establish what actually were the requests in the oral proceedings before the Opposition Division, the Board has taken recourse to the minutes of these proceedings.

According to Rule 76(1) EPC the minutes should contain the essentials of the oral proceedings and the relevant statements of the parties. This means, as is also indicated in the Guidelines for Examination E-III, 10.2, that new or amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents such as claims, description or drawings should be noted in the minutes. If a decision is given, the wording of the operative part must be reproduced in the minutes.

1.3 According to the **text** of the minutes (see point V above) the prior main and auxiliary requests were withdrawn in favour of a new main request for maintenance of the patent in amended form, of which claims 1 and 8, submitted during the oral proceedings, were annexed.

According to the **cover page** of the minutes a decision was pronounced at the end of the oral proceedings maintaining the patent in amended form with, among others, claims 1 and 8 as submitted during the oral proceedings (see point IV above).

However, that same cover page mentions the following: "Regarding the reasons for the decision the chairman referred to Article 102(1) EPC: one of the grounds of opposition mentioned in Article 100 EPC prejudices the

maintenance of the patent as granted".

From this statement the Board can only conclude that the Patentee apparently maintained a request for rejection of the opposition, i.e. maintaining the patent in the form as granted, which was decided upon and rejected by the Opposition Division. The main request as argued by the Appellant and submitted with letter of 9 May 1996 comprised at least claim 1 as granted.

A request for maintenance of the patent as granted is a higher ranking request than one for maintenance of the patent in amended form.

1.4 It is consistent case law of the Boards of appeal that if a patent can only be maintained on the basis of an auxiliary request the decision has to contain a reasoned statement why the version of the higher ranking request does not meet the requirements of the EPC (see T 234/86, OJ 1989, 79).

The written decision does not contain any reasoning to that effect and therefore does not comply with Rule 68(2) EPC. The Appellant is adversely affected by such a decision because it is inconsistent with what he specifically requested (in this respect reference is made to the French text of Article 107(1) EPC which reflects this requirement most clearly: "Toute partie à la procédure ayant conduit à une décision peut recourir contre cette décision pour autant qu'elle n'ait pas fait droit à ses prétentions." (see J 12/85, OJ 1986 155).

The appeal, which further fulfils the formal and

substantive requirements, is therefore admissible.

2. *Procedural violation*

2.1 According to the cover page of the minutes of the oral proceedings before the Opposition Division on 11 June 1999, at the end of the oral proceedings a **decision** was announced stating that the patent and the invention to which it related were found to meet the requirements of the EPC and that the currently valid claims were (see point IV above):

Claims 2 to 7, 9 to 12 received on 11 May 1996 with letter of 9 May 1996, and claims 1 and 8 filed during oral proceedings on 11 June 1999.

2.2 The written decision refers in its tenor to the following claims as forming the basis for the decision:

Claims 1 to 7 as received on 25 November 1999.

To claims 2 and 5 the Opposition Division had furthermore made amendments of its own accord.

2.3 It is clear from the above facts that there are substantial discrepancies between the decision announced at the oral proceedings and the written decision following the oral proceedings:

The written decision involves a patent maintained with only 7 claims, the decision pronounced at the oral proceedings involves a patent maintained with 12 claims.

The decision announced at the oral proceedings finds

that the patent fulfils the requirements of the EPC with the documents then on file whereas the written decision is based upon subsequently filed patent documents, to which the Opposition Division has even made further amendments of its own motion.

2.4 Rule 68(1) EPC allows for decisions being given at oral proceedings and that subsequently the decision in writing shall be notified to the parties. The Rule unambiguously refers, in its two parts, to the **same** decision given orally prior to being notified in writing.

2.5 Decisions can only be corrected pursuant to Rule 89 EPC as far as linguistic errors, errors of transcription or obvious mistakes are involved.

Analogous to examination proceedings, wherein the decision to grant the patent refers to the documents approved by the applicant under Rule 51(4) EPC whereby they become an integral part of that decision (see T 850/95, OJ 1997, 152), the present Board finds that in opposition proceedings the documents referred to in the decision to maintain the patent in amended form also form an integral part of that decision.

Thus, in principle, errors in these documents may also be corrected under Rule 89 EPC, if the text was not and obviously could not be the text corresponding to the real intention of the Opposition Division. That would namely amount to an obvious mistake. However, the differences between the decision pronounced at the oral proceedings and the written decision do not relate to such mistakes.

This is already clear from a comparison of the two sets of claims.

The first set of claims, mentioned in the minutes, comprises:

- an independent apparatus claim 1 with dependent claims 2 to 7,

- an independent method claim 8 with dependent claims 9 to 12.

The second set of claims, mentioned in the written decision, comprises:

- an independent apparatus claim 1 with dependent claims 2 to 4,

- an independent method claim 5 with dependent claims 6 and 7.

Apart from unexplainable differences in the wording of the individual claims of the two sets, the different number and arrangement of the claims in the second set in particular cannot be considered as a correction of an obvious mistake made in the claims of the first set.

2.6 In the Board's judgement, such discrepancies between the documents forming an integral part of the decision notified in writing from those of the decision taken at the oral proceedings and given orally, according to the minutes, amounts to a substantial procedural violation on its own requiring immediate remittal of the case to the first instance, for taking a new decision with proper identification of the documents on which the

decision is based.

2.7 Although the above-mentioned procedural violation is sufficient to set aside the decision under appeal, for remittal to the first instance pursuant to Article 111(1) EPC and for reimbursement of the appeal fee in accordance with Rule 67 EPC, the Board considers it necessary to point out further procedural irregularities in the present case.

3. *Ambiguity in the procedure followed*

3.1 According to the **text** of the minutes of the oral proceedings before the Opposition Division the chairman declared that the subject-matter of claims 1 and 8 of the main request as amended fulfilled the requirements of the EPC and that amended patent documents taking account thereof and acknowledging certain prior art as well as a fair copy of the claims should be filed (see point V above).

3.2 The above would mean that the Opposition Division, in the oral proceedings, expressed its intention to maintain the patent in amended form on the basis of claims 1 and 8 as amended, as soon as an amended description had been filed.

That is in fact the procedure recommended in the Guidelines for Examination D-VI, 7.2.1 and 7.2.2 when a complete text approved by the patentee is not available in the oral proceedings. In such a case the patentee is set a time limit for filing amended documents, the minutes functioning as a communication pursuant to Article 101(2) EPC. Only after the opponent has been given the opportunity to comment on the proposed new

text can the Opposition Division issue its interlocutory decision.

However, the **cover sheet** of the minutes mentions that the oral proceedings ended with the decision to maintain the patent with the documents then on file.

3.3 The minutes containing these contradictory statements were sent to the parties on 20 October 1999, more than four months after the oral proceedings and more than one month after receiving the Appellant's letter of 14 September 1999 enquiring whether he would receive an appealable interlocutory decision first or whether he would receive a formal invitation with a time limit to submit amended documents.

Apart from the fact that a period of four months can hardly be considered being in agreement with the statement in the Guidelines for Examination E-III, 10.2 ("The minutes .... are communicated to the parties as soon as possible"), the Appellant was left completely in the dark as to what was actually expected of him: should he submit amended documents as the text of the minutes and the annexed form 2042 ("you are invited to file your observations and to correct the deficiencies indicated within a period of 1 month") implied, or did he not need to because the cover sheet of the minutes indicated that the patent was maintained anyway with documents it had previously filed in the opposition proceedings and had thus agreed to?

3.4 If the Opposition Division sends a communication pursuant to Article 101(2) EPC to the parties inviting them to file observations, it sets a time limit. According to Rule 84 EPC such a time limit shall not be

less than two months nor more than four months. Setting a time limit of one month does not comply with this requirement.

3.5 The Board considers that due to the Opposition Division's actions the situation of the file was unclear to the Appellant in relation to the procedure followed and in respect of what was expected of him.

4. *The appellant's requests*

4.1 As already discussed in points 1 and 2 above, there is a contradiction within the minutes as well as between the minutes and the written decision as regards the requests of the Appellant and the documents forming the basis for these requests.

4.2 It is the procedural obligation of the Opposition Division to establish the requests of the parties, the order in which these are to be dealt with, and deal with these requests in the established order. A subsequent request can only be considered as having been agreed to by the patent proprietor when the preceding request has been dismissed. Only thus can the requirements of Article 113(2) EPC be observed (see T 666/90 and T 552/97, both not foreseen for publication in the Official Journal).

From the above it is clear that the Opposition Division did not clearly establish what were the requests of the patentee and in which order they were to be dealt with, before it took its decision.

4.3 This is furthermore evident from the file: the (partly) handwritten claims 1 and 8 apparently forming the basis

for the decision announced at the oral proceedings are not signed by the patentee's representative, contrary to Rule 36(3) EPC. There is no indication in the file that the Opposition Division invited the representative in the oral proceedings to remedy this deficiency.

4.4 Claim 1 further bears the heading "auxiliary request" as well as "main request", the latter, however, having been added in handwriting. The identity of the person making the handwritten amendments to the text of the claims cannot be established as no signature or initials of that person are present, nor whether the patentee's representative agreed thereto. The claims are marked "filed during oral proceedings 11.05.99", however the oral proceedings were set for and took place on 11 June 1999.

4.5 If these amendments were made by a member of the Opposition Division during the oral proceedings, it should have been clear from the file that the patentee agreed thereto. If these amendments were made after the oral proceedings, they reflect the intention of the Opposition Division to maintain the patent in that form. However, in that case the notification of this text has to fulfil the requirements of Rule 58(4) EPC in that the time limit to submit observations is two months and not one month as mentioned on form 2042 accompanying the minutes and the text of claims 1 and 8.

4.6 Therefore it has to be concluded that the Opposition Division committed a further substantial procedural violation in not properly establishing the requests of the parties before announcing the decision at the oral proceedings.

5. *Correction of minutes of the oral proceedings before the Opposition Division*

5.1 The Board wishes to remark on the procedure followed by the Opposition Division regarding the minutes of the oral proceedings before it.

In its letter of 23 November 1999 the Appellant informed the Opposition Division of its opinion that the minutes sent on 20 October 1999 did not reflect the actual conduct of the proceedings. However, the Appellant did not explicitly request a correction of the minutes, instead it relied on the decision to reflect the situation as it thought it had occurred.

5.2 The Opposition Division apparently did not consider this letter to constitute a request for correction of the minutes, as there is no trace of any reaction thereto on its part. The decision itself, which followed six months later, did not address the issue of correction either (see point 5.4 below).

5.3 As already discussed above, the inconsistencies in the minutes are evident. Had the Opposition Division in the present case reacted promptly, i.e. at a point in time at which the memory of the members of the Opposition Division of the course of the oral proceedings before it was still fresh, they could not have missed them and could have reacted thereupon. Thus it would have provided not only a reliable basis for the Board's decision as to what actually happened or did not happen in the oral proceedings, but also it would have had the opportunity to correct the minutes in case in actual fact no decision but only an intention to maintain the patent in amended form had been announced in the oral

proceedings, the latter following the procedure as suggested in the Guidelines for Examination D-VI, 7.2.1 and 7.2.2 referred to above (see point 3.2).

5.4 Instead of examining whether the minutes actually fulfilled the requirements of Rule 76(1) EPC and then deciding whether or not to correct them, the Opposition Division (point 7 of the decision under appeal) argued in essence that the minutes were correct because the minutes say so (".... , this cannot be accepted because the protocoll states clearly that all these former request have been dropped during Oral Proceedings and have been replaced by a single main request comprising the current claims as cited above").

The Board considers such a reasoning circular and thus as not fulfilling the requirements of Rule 68(2) EPC, which requires decisions of the European Patent Office to be reasoned. This constitutes another procedural violation.

6. *Further procedure*

Having regard to the facts of the case, the Board is of the opinion that the number and severity of the procedural violations and irregularities on the part of the Opposition Division lead to serious doubt as to whether the Appellant's rights can be guaranteed when the present case is dealt with by the Opposition Division in its present composition. However, in the present case the Board considers it appropriate to leave it to the Appellant to decide whether it shares this doubt to a degree necessitating a request for a change in the composition of the Opposition Division.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the first instance for further prosecution.

3. The appeal fee shall be reimbursed.

The Registrar: The Chairman:

M. Patin P. Alting van Geusau