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D E C I S I O N
of 9 December 2002

Case Number: T 0961/00 - 3.3.5

Application Number: 96902742.4

Publication Number: 0804382

IPC: C01B 33/143

Language of the proceedings: EN

Title of invention:

Novel temperature-activated polysilicic acids and their use in paper production processes

Patentee:

J.M. HUBER CORPORATION

Opponent:

Eka Chemicals AB

Headword:

Adverse effect/HUBER CORP.

Relevant legal provisions:

EPC Art. 100, 102, 102(3)(a), 107 first sentence, 113(2), 125
EPC R. 57(1), 57a
Legal Advice 11/82

Keyword:

"Revocation of patent after declaration according to Legal Advice 11/82 - adverse effect of decision - no"
"Admissibility of appeal by proprietor - no"
"Referral to Enlarged Board - no"

Decisions cited:

G 0009/91, G 0010/91, G 0009/93, J 0011/94, T 0114/82,
T 0115/82, T 0073/84, T 0244/85, T 0234/86, T 0073/88,
T 0392/91, T 0506/91, T 0644/93, T 0438/94, T 0542/96,

Catchword:

A patent proprietor who has declared in opposition proceedings before the opposition division that he withdraws his consent to the granted version of his European patent and will not file an amended version (see also Legal Advice 11/82), is not adversely affected within the meaning of Article 107, first sentence, EPC by the decision of the opposition division revoking the European patent.



Case Number: T 0961/00 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 9 December 2002

Appellant: J.M. HUBER CORPORATION
(Proprietor of the patent) 333 Thornall Street
Edison, NJ 08818 (US)

Representative: Goldbach, Klara, Dr
Grünecker, Kinkeldey, Stockmair & Schwanhäusser
Anwaltssozietät
Maximilianstrasse 58
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Respondent: Eka Chemicals AB
(Opponent) S-445 80 Bohus (SE)

Representative: Halldin, Bo
Dr Ludwig Brann Patentbyrå AB
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S-104 62 Stockholm (SE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 21 July 2000
revoking European patent No. 0 804 382 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: M. B. Günzel
M. M. Eberhard

Summary of Facts and Submissions

- I. European patent No. 0 804 382 was granted in response to European patent application No. 96 902 742.4, originally filed as a PCT application with the international publication number WO 96/22244.
- II. In response to the notification of a notice of opposition, the patent proprietor stated: "The patentee herewith declares that he withdraws his consent to the granted version of the above mentioned European patent and will additionally not file an amended version".
- III. By a decision dated 21 July 2000 the formalities officer, acting for the opposition division, revoked the patent. In the reasons for the decision it was indicated that the patent proprietor had stated that he no longer approved the text in which the patent was granted. The patent proprietor was bound by this statement. As a consequence there was no longer a version of the text submitted and/or approved by the patent proprietor (Article 113(2) EPC), in which the patent could be maintained (Article 102(3)(a) EPC).
- IV. On 19 September 2000 the appellant (proprietor) appealed the decision. He submitted a new set of claims and requested that the patent be maintained in amended form on the basis of these claims. The appeal fee was paid on the same day. The grounds of appeal were filed on 30 November 2000.

V. Oral proceedings took place on 9 December 2002 in the absence of the respondent (opponent), who had informed the Board in writing that he would not attend. In a communication accompanying the summons to the oral proceedings the Board had informed the parties of its preliminary opinion that the appellant was not adversely affected by the decision under appeal.

VI. With regard to the question of the admissibility of the appeal the appellant essentially argued as follows:

The appellant was adversely affected by the decision of the formalities officer acting for the opposition division to revoke the patent and the appeal was admissible.

1. The requirement in Article 107, first sentence, EPC that a party had to be adversely affected by a decision in order to be entitled to appeal could not be construed narrowly and in a formal way. There was not only an adverse effect for the party concerned if the order of the decision deviated from the party's request to its disadvantage. For the interpretation of Article 107 EPC in this respect national laws should also be taken into account, in accordance with Article 125 EPC. In the oral proceedings before the Board the appellant submitted copies of two pages from two different German commentaries on the German civil procedural law (Zivilprozeßordnung, ZPO), dealing with the definition of the term "adversely affected" where the defendant in a complaint is concerned, in particular in the situation where he had in first instance acknowledged the plaintiffs claim and a corresponding judgment was given

("Anerkenntnisurteil"). According to the appellant these commentaries showed that in German civil procedural law only an "adverse effect as to substance" (materielle Beschwer)" was required, which would be independent of the defendant's request in the previous instance. What was decided on by the court in the first instance was the claim put forward by the plaintiff and not the request of the defendant. Whether or not the defendant in the first instance proceedings was adversely affected by the decision depended on whether or not a judgment was given against him. Because in opposition proceedings it was acknowledged that even in the absence of a patentee's request to reject the opposition the opposition division had to examine as to substance whether the opponent's request for revocation of the patent was justified, the legal situation of a patentee in opposition proceedings was comparable to the situation of a defendant in a civil law suit as described in the cited commentaries. Therefore, the appellant was adversely affected by the decision because the opposition division had not examined whether the opponent's request to revoke the patent was justified for the reasons indicated by the opponent but had instead revoked the patent, without any substantive examination.

2. However, even if one assumed that being adversely affected required that the decision departed from the appellant's request in first instance to his disadvantage, this requirement was fulfilled in the present case. Firstly, the appellant had not filed a request in the opposition proceedings but just made a declaration. Secondly, the appellant's

declaration made before the opposition division was not legally possible and should therefore have been disregarded by the opposition division as being null and void, for the following reasons:

Because after grant dealing with European patents was in principle within the competence of the national authorities, the Articles and Rules of the Convention implementing the opposition proceedings had to be construed narrowly. The grounds on which an opposition division had the power to revoke a patent were exhaustively enumerated in Article 100 EPC, and the kind of decisions an opposition division could take were laid down in Article 102 EPC, which provisions were to be regarded as special provisions for opposition proceedings in relation to Article 113(2) EPC. Therefore, basing a revocation on Article 113(2) EPC, which only protected the proprietor's right to determine the form in which the patent should be issued, was not in accordance with the EPC.

As a consequence only certain requests from the patent proprietor were allowable in opposition proceedings, ie those resulting from Article 102 EPC. According to decision G 9/93 a patent proprietor could not oppose his own patent. By this decision and by opinion and decision G 9 and 10/91, which had redefined the nature of the opposition proceedings as being contentious proceedings between parties pursuing opposite interests, the competences of the patent proprietor in opposition proceedings had been reduced as compared to the case law existing at

the time of publication of Legal Advice 11/82, on which the current practice of the opposition divisions was based. It was therefore highly questionable whether a request of the proprietor to revoke his own patent was admissible. In any case a declaration that the approval to the granted text was withdrawn and that no amended version would be submitted was nothing else than a request to surrender the European patent, which was not legally possible before the EPO after grant. It was therefore not possible to construe the declaration filed as being a request for revocation or surrender of the patent because this was not in accordance with the EPC.

The declaration of the proprietor was therefore to be regarded as null and void and should have been disregarded by the opposition division. As a consequence, the legal situation in the opposition proceedings after the communication of the notice of opposition to the proprietor under Rule 57(1) EPC had to be regarded as being that the proprietor had not filed a request before the first instance. Because the silence of the proprietor in response to such a communication did not have any legal consequences other than that the opposition division had to decide whether or not the request of the opponent to revoke the patent was justified considering the facts and arguments on file, the proprietor was adversely affected, because this had not been carried out in the present case, and the patent was merely revoked.

Alternatively, the declaration filed by the

appellant before the opposition division could be interpreted as a request for rejection of the opposition or for maintenance of the patent in amended form. However, when interpreted in the latter sense, such a request was not in compliance with Rule 57a EPC, because it was not occasioned by a ground for opposition specified in Article 100 EPC.

VII. The respondent submitted that the appellant must have been well aware of the consequence of his declaration. In Article 102 of the version of the EPC as published by the EPO, there was in the heading a reference to Legal Advice No. 11/82, in which it was clearly stated that if the patent proprietor declared that he no longer approved the text in which the patent was granted and did not submit an amended text the patent had to be revoked. Thus, it was clear that the appellant knew the consequence of his declaration and that the decision to revoke the patent was the outcome the appellant had to expect. Accordingly, the appellant was not adversely affected by the decision under appeal and the appeal was inadmissible.

VIII. As main request the appellant requested that the decision under appeal be set aside and the patent be maintained on the basis of the set of claims filed with the notice of appeal.

As auxiliary request the appellant requested that the following questions be referred to the Enlarged Board of Appeal:

1. Is an appeal admissible under Article 107 EPC against a decision of the opposition division

revoking a European Patent according to Article 102 EPC based on a declaration filed by the patent proprietor which is not supported by the EPC?

2. Is an appeal admissible under Article 107 EPC against a decision of the opposition division revoking a European patent according to Article 102 EPC if the patent proprietor has filed a declaration stating that he withdraws his consent to the granted version and will not file an amended version?

IX. The respondent requested that the appeal be rejected as inadmissible.

Reasons for the Decision

The appeal is inadmissible. The appellant is not adversely affected by the decision under appeal within the meaning of Article 107, first sentence, EPC.

1. According to the established jurisprudence of the Boards of Appeal a party is only considered to be adversely affected by a decision if the decision does not accede to its requests (Benkard, EPÜ, Europäisches Patentübereinkommen, Munich 2002, Article 107, Note 13 and the decisions cited therein, Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001, VII.-D, 7.3.2, and the decisions cited therein). The meaning of this principle has been illustrated by a number of decisions. Thus, e.g., where several requests have been filed in the form of main and auxiliary requests a party is adversely affected, if the decision

does not accede to requests preceding the allowed request (see e.g. T 234/86, OJ EPO 1989, 79, point 5.8 of the reasons, T 392/91 of 24 June 1993, point 3 of the reasons). Conversely, there is no adverse effect within the meaning of Article 107, first sentence, EPC, and the party has no right to appeal, if it has withdrawn its main request or preceding auxiliary requests and agreed with the allowed request (T 506/91 of 3 April 1992, in particular points 2.4 and 2.8 of the reasons and T 613/97 of 26 May 1998, point 2 of the reasons). In such a case a proprietor is not adversely affected by the fact that the decision under appeal restricted the patent, in accordance with his request, because the requests of the parties constitute the basis and framework for the case (see in particular the rejection of corresponding reasonings of the appellants in T 54/00 of 19 December 2000, point 3.1 of the reasons, and T 506/91, point IV and point 2.3 of the reasons,).

That the requests of a party are decisive for the question whether or not there is an adverse effect is also illustrated by the decisions having held that where the decision of the opposition division accedes to a party's request, the party is not adversely affected by a reasoning in the decision which is adverse to him and he may not file an appeal against such a decision (T 73/88, OJ EPO 1992, 557, point 1.3 of the reasons, T 542/96 of 11 May 2000, point 2 of the reasons).

In order to determine whether there is an adverse effect the final requests which the party concerned has filed preceding the decision under appeal have to be compared with the decision given (T 506/91, point 2.3

of the reasons, and the further decisions cited therein, Benkard-EPÜ, loc. cit, Singer/Stauder, Europäisches Patentübereinkommen, 2nd edition, Cologne 2000, Article 107, Note 22). What is the subject-matter which has been decided, is determined in the order of the decision. There is therefore an adverse effect if the result of the decision as defined by its order does not come up to the party's request (T 244/85, OJ EPO 1988, 216, point 3 of the reasons, T 114/82, T 115/82, OJ EPO 1983, 323, Benkard-EPÜ, loc.cit.). Conversely, there is no adverse effect when the decision is consistent with what the party in question has requested (T 506/91, point 2.8 of the reasons).

In the Board's judgement it is not relevant in this respect whether the order of the decision is identical in wording to the appellant's request but it is decisive whether the substance of the decision given in the order accedes to the appellant's wishes as they were expressed in the appellant's final requests in the first instance proceedings.

2. In the proceedings before the Opposition Division, after notification of the notice of opposition, the appellant did not file a request to reject the opposition or to maintain the patent in an amended version but instead, with his letter dated 14 July 2000, declared *verbatim*: "The patentee herewith declares that he withdraws his consent to the granted version of the above mentioned European patent and will additionally not file an amended version".
3. In order to determine whether, in view of this declaration, the appellant is adversely affected by the formalities officer's decision to revoke the patent the

legal meaning of the appellant's declaration must be determined on an objective basis.

- 3.1 It is a long-standing and common legal practice before the EPO, almost from the outset of opposition proceedings before the EPO (see Legal Advice 11/82, OJ EPO 1982, 57), that according to Article 113(2) EPC the patent is to be and is revoked if the patentee declares that he no longer approves the text in which the patent was granted and does not submit an amended text. This principle has been approved in the jurisprudence of the Boards of Appeal and in the legal literature ever since decision T 73/84, OJ EPO 1985,241 (see e.g. Singer/Stauder, Article 102, Note 24, Benkard-EPÜ, Article 102, Note 6). It has also been applied by the Boards of Appeal whenever patentees made corresponding declarations at the appeal stage (Case Law VII-D,11.3, see also e.g. more recent unpublished decisions T 644/93 of 7 April 1995 and T 438/94 of 13 June 1997).

In the present case the appellant has made the said declaration, as foreseen in Legal Advice 11/82, which sets out that the patent must be revoked if the applicant/patentee states that he no longer approves the text. The appellant has moreover, as is also foreseen in said legal advice, unequivocally and without any reservation whatsoever stated, that he will not file an amended version.

On the basis of the above cited, long standing and hitherto not only undisputed, but appreciated practice before the EPO, the appellant's declaration in the opposition proceedings could on an objective basis clearly and unequivocally only be understood to mean that he agreed to, if not that he wanted, the

revocation of the patent. Had he wanted to express any reserve against his declaration being interpreted in the standard way, he should have done so. However, nothing of this kind can be derived from the appellant's statements. Even later, at no time in the course of the appeal proceedings has the appellant submitted that he was not aware of the legal consequences of his declaration made in the opposition proceedings and that he had not wanted them at that time. Therefore, the appellant's declaration has to be interpreted in accordance with the established ordinary meaning of such declarations. The objective meaning of the appellant's declaration being clear and unambiguous, decision J 11/87, OJ EPO 1988, 367, cited by the appellant, is not relevant in the present context.

- 3.2 The appellant has argued that he had just made a declaration which did not constitute a request.

Whether or not a declaration concerning the maintenance of the patent made by a patentee in the course of the proceedings has the legal meaning of a request does not depend on the wording used by the patentee. There is a request in the legal sense whenever it is to be derived from a patentee's declaration that he formally expresses therewith his will or agreement that the opposition division should decide in a certain way. As regards the firmness of a party's resolution there is hardly any wording which could express this more firmly and clearly than if the party uses himself the wording that he "declares" something. In the present case the appellant has even reinforced the strength of the wording of his declaration as compared with the wording proposed in Legal Advice 11/82. He has not only

declared that he does no longer approve the text in which the patent was granted but further that he "additionally will not file an amended text". Thus, by use of the words "additionally" and of "will not file" instead of "does not file" as proposed in Legal Advice 11/82 he has moreover also expressed quite clearly that he was not temporarily uncertain how to amend the patent in order to meet the objections raised in the opposition but that he was determined not to file any amendments in the proceedings and did also not want maintenance of the patent as granted. Therefore, the appellant's declaration had, as to its substance, the legal meaning of a request, which, when interpreted on the above described objective basis meant that the patentee wanted the revocation of his patent. The decision given by the opposition division thus takes full account of the appellant's request contained in the said declaration.

4. As regards the appropriate definition within the meaning of Article 107 EPC of the legal term "adversely affected", the appellant has referred to two text pieces of commentaries dealing with the definition of this term in German civil procedural law. According to the appellant, in accordance with Article 125 EPC these definitions should also be applied in the context of the EPC (for details of the appellant's argumentation, see above under VI.1).

4.1 Article 125 EPC provides that the principles of procedural law generally recognised in the Contracting States shall be taken into account in the absence of procedural provisions in the EPC. This requirement is not fulfilled in the present case. As regards the definition of an appellant's entitlement to appeal the

EPC contains a detailed provision in Article 107 EPC. There is thus *no lacuna* in the EPC insofar. Also as regards the definition of the term "adversely affected by a decision" in Article 107 EPC a comprehensive body of jurisprudence of the Boards of Appeal has defined this requirement and applied it to quite a number of different individual cases as has been set out above under point 1 of the reasons. It can therefore not be said that national law would have to be considered in order to be able to decide an as yet unresolved issue.

- 4.2 However, also as to substance, the Board is unable to follow the appellant's argument that the situation of a respondent-proprietor in opposition proceedings was comparable to that of a defendant in a civil law suit who had acknowledged the plaintiff's claim in the proceedings but was then nevertheless regarded as being adversely affected by the judgment going against him. The Board also doubts that the commentary extracts submitted by the appellant really show that this is an established principle in German civil procedural law, applicable under all circumstances. This is, however, not relevant in the present case, as the comparison does not hold good.

If, for the sake of argument the appellant's reasoning was followed and the principles set out by the appellant for the case of an acknowledgment of a plaintiff's claim by the defendant in German civil procedural law were applied to a proprietor in opposition proceedings, this would mean that a proprietor having himself only asked for the maintenance of his patent in amended form and having thereby "recognised" the opponent's claim for revocation of the patent to the extent of the subject-

matter deleted would nevertheless be adversely affected by and entitled to appeal the decision maintaining the patent in the form he had requested. Consequently, the proprietor would be entitled to appeal in all cases where something less than the patent as granted was maintained by the opposition division, even if the patent was maintained according to his main request, and thereby entirely in accordance with what the proprietor had asked the opposition division to decide. Such a view would not only be at odds with the established jurisprudence of the Boards of Appeal, described above under point 1 of the reasons, that a patent proprietor who has requested the maintenance of his patent in an amended form as main request before the opposition division is not adversely affected by the decision maintaining the patent in that form and is therefore not entitled to appeal. It would also be at variance with the principle that the requests of the parties constitute the basis and the framework for the case under consideration (See above under point 1 of the reasons, T 506/91, IV and point 2.3 of the reasons and G 9/91, OJ EPO 1993, 408, point 10 of the reasons, relating to a limited opposition) and that the very purpose of the appeal proceedings is to give a losing party, ie a party whose requests were not fully acceded to in first instance, the possibility to challenge the decision before the Boards of Appeal on its merits, the function of the Board of Appeal being then to review the first instance decision (G 9/91, loc.cit., point 18 of the reasons). In accordance with this function of the right to appeal there is no justification for a party to be entitled to further pursue a case before the Boards of Appeal when he already had got in first instance what he had asked for.

5. As a further line of argument the appellant has submitted that the opposition division should have disregarded the appellant's declaration and examined whether the grounds for opposition relied on by the opponent justified the revocation of the patent as to substance, because the administrative practice, as enshrined in Legal Advice 11/82, loc.cit., point 2, and the established jurisprudence that the patent is to be revoked without any substantive examination of the merits of an opponent's case when the proprietor has declared that he no longer approves the text of the granted patent and that he does not file an amended text, was contrary to the provisions of Articles 100 and 102 EPC, ie not legally possible under the EPC. The said declarations of proprietors were therefore to be regarded as null and void and the opposition division was in the present case obliged to disregard the appellant's declaration and to examine the case as to its substance as was done in those cases in which the proprietor had not filed any request at all in response to the opposition (for details of the appellant's comprehensive reasoning insofar, see VI.2 above).

The Board is unable to follow the appellant's view.

It is not a requirement for the validity of a party's request or declaration as a procedural declaration of his will that such request or declaration is foreseen or "possible" under the EPC. If a request or a declaration has been made by a party or by a person representing a party, in full legal capacity, and if its meaning can be clearly established (J 11/94, OJ EPO 1995, 596, point 2.2 of the reasons), be it by interpretation (G 9/91, OJ EPO 1993, 408, point 8 of the reasons), it is valid as such, ie it is a valid

declaration of the procedural will of the party. The opposition division is then bound to deal with it and cannot simply treat it as if it did not exist. It is a party's procedural right to file and maintain such requests as are regarded by the competent organ as unallowable or even inadmissible. If a party does that then the competent organ has to give a decision on it, ie to refuse it if it is unallowable or inadmissible (T 1105/96, OJ EPO 1998, 249, point 1 of the reasons), but it cannot simply disregard it and deal with the case as if the request did not exist. On the contrary, this would constitute a substantial procedural violation.

The appellant's declaration being valid as a procedural declaration of the appellant's will, for the question of whether the appellant is adversely affected by the decision taken it is irrelevant whether the established practice of dealing with the said proprietors' declarations is right or wrong. The only relevant issue is in this context whether by revoking the patent the opposition division has acceded to the objective meaning of the appellant's declaration. That this is the case has been set out above. Therefore, the reasons given by the appellant as to why the said declarations were not legally possible under the EPC need not be further considered here.

6. At no time in the course of proceedings has the appellant submitted that his declaration which was made after communication of the notice of opposition had been induced by an error or that the appellant was not aware of its legal consequences. On the contrary, the appellant being represented by experienced professional representatives, it can be assumed that these were well

aware of the common practice enshrined in Legal Advice 11/82 and of its legal consequences, if not that it was precisely the intention of the appellant to make use of his declaration in the traditional way, ie to use it as a means to relinquish the patent centrally after grant, without having to have recourse to national routes.

7. To summarise, the appellant's declaration in the opposition proceedings was a legally valid declaration of his procedural will. Its objective legal meaning was that the appellant asked for or at least agreed to the revocation of the patent. The decision of the opposition division has taken full account of that. Had the appellant wanted to put the established understanding of his declaration into question he should have expressed a corresponding reservation when making the declaration in the opposition proceedings. As the appellant has done nothing of this kind and has also not submitted that the declaration was made in error the Board cannot but conclude that the appellant is not adversely affected by the decision under appeal.

8. The appellant has requested referral of two questions to the Enlarged Board of Appeal, which are cited under VIII above.

These questions are, however, so broad that they would involve the Enlarged Board of Appeal in deciding the entire subject-matter of the present appeal which is not the function of the Enlarged Board of Appeal. As can be seen from the above considerations these are entirely based on principles which are to be regarded as established in the jurisprudence of the Boards of

Appeal and for which no divergence of opinion exists. There is therefore no issue in the present appeal for which a decision of the Enlarged Board of Appeal would be appropriate. The appellant's requests are therefore refused.

Order

For these reasons it is decided that:

1. The request to refer questions to the Enlarged Board of Appeal is rejected.
2. The appeal is rejected as being inadmissible.

The Registrar:

The Chairman:

U. Bultmann

R. Spangenberg