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D E C I S I O N
of 18 June 2003

Case Number: 1048/00 - 3.2.3

Application Number: 94914187.3

Publication Number: 0693983

IPC: B22D 17/32, B22D 17/30

Language of the proceedings: EN

Title of invention:
Method and apparatus for charging metal to a die cast machine

Patentee:
THE DOW CHEMICAL COMPANY

Opponent:
NORSK HYDRO ASA

Headword:
-

Relevant legal provisions:
EPC Art. 99(1), 106(1),(3), 110(1), 113(1), 116(1), 133(2),
134(1)
EPC R. 36(3), 56(1), 61a, 67, 68(2)

Keyword:
"Notice of opposition considered to be filed (yes)"
"Opposition admissible (yes)"
"Substantial procedure violation (yes)"
"Reimbursement of appeal fee (no)"

Decisions cited:
G 0003/99, G 0001/02, G 0004/95, T 0222/85, T 0161/96,
T 0295/01, T 0598/91, T 0451/89, T 0665/89, T 1062/99

Catchword:
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Case Number: 1048/00 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 18 June 2003

Appellant: THE DOW CHEMICAL COMPANY
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Respondent: NORSK HYDRO ASA
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 August 2000
revoking European patent No. 0693983 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: M. K. S. Aúz Castro
F. E. Brösamle

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 693 983 was published on 26 November 1997.
- II. On 25 August 1998 a notice of opposition was filed by Norsk Hydro ASA, having their place of business in Norway. In the notice of opposition a professional representative was named, but the notice itself was signed by the opponent (respondent).
- III. By communication of 8 September 1998 the respondent's attention was drawn to this deficiency and they were asked to rectify it by the professional representative signing or approving the notice of opposition within a period of two months.
- IV. In response thereto on 15 September 1998 the professional representative signed the notice of opposition and approved its appendix.
- V. By letter of 2 February 1999 the patentee (appellant) challenged the admissibility of the opposition because the notice of opposition was not signed by a person appearing on the list of professional representatives.

By a further letter of 3 February 1999 the appellant alleged with reference to Article 133(2) EPC that no notice of opposition had been filed within the nine months from the publication of the mention of grant of the patent. It was not possible to correct with the signature after the expiry of the time limit.

- VI. By communication of 3 August 1999 the opposition division summoned to oral proceedings on 29 June 2000 and informed the parties that it considered the opposition to be admissible (by mistake the word "allowable" was used).
- VII. By letter of 14 October 1999 the appellant requested that a decision on the question of admissibility of the opposition be taken and that separate appeal according to Article 106(3) EPC be allowed.
- VIII. On 18 January 2000 the opposition division issued a communication reiterating its assessment that the opposition was admissible and informing the parties that for reasons of procedural economy a decision on that point would be taken in the oral proceedings.
- IX. On 17 February 2000 the appellant filed an appeal against the opposition division's "decision to end the ex-parte proceedings and continue the opposition proceedings". On the same day the statement of grounds of appeal was filed and the appeal fee paid. By decision of 25 May 2000 the appeal was rejected as inadmissible. The board held that the appeal did not lie from a decision, as required by Article 106(1) EPC.
- X. In the oral proceedings of 29 June 2000 before the opposition division, the patent was revoked due to lack of novelty of its subject-matter. The written reasoned decision was posted on 4 August 2000.

XI. Against this decision a notice of appeal was filed by the appellant on 18 October 2000. On the same day the appeal fee was paid and the statement of grounds of appeal filed.

XII. The arguments of the appellant presented in writing and in the oral proceedings before the board of 18 June 2003 are summarised as follows:

The opposition division committed two substantial procedural violations.

The first is that at the oral proceedings of 29 June 2000 the opposition division started these proceedings by delivering its decision on the question of whether the notice of opposition had been filed and whether the opposition was admissible without previously inviting the parties to present their arguments on these questions.

The second substantial procedural violation consists in the fact that the impugned decision refers only to the guidelines and not to the EPC, that it does not discuss its - the appellant's - arguments put forward in favour of the opposition not having been filed and that the decision is insufficiently motivated.

The filing of the notice of opposition was not an act through a professional representative as required by Article 133(2) EPC which means that there is no act at all so that no opposition has been filed. The board's assessment in its communication of 29 April 2002, point 3.1 that it may not be neglected that a

professional representative had indeed been nominated does not seem to be correct.

The case under consideration differs completely from the case decided by the Enlarged Board in Decision G 0003/99 concerning a joint appeal filed by a non-entitled person and where the representative was permitted to sign within a given time limit. In that case all the appellants were from the European Union. A distinction must be made between cases in which a party to proceedings before the EPO comes from a country being a member to the Convention and cases in which a party is from any other country, such as Norway. This will show whether the obligation to act through a professional representative ("Vertretungszwang") is an "empty letter" or not.

Admissibility of an opposition and its deemed filing are separate items, although closely related. Decision T 0222/85 connects them whereas the Enlarged Board in its Opinion G 0001/02 under point 1.3 names them separately but does not decide whether there is a difference or not. This would however be important since if an opposition is deemed not to have been filed the question of admissibility does not arise.

As was stated in Decision T 0161/96 an opposition which is deemed not to have been filed does not exist. A non-existent opposition cannot be inadmissible and therefore Rule 56 EPC and - via Rule 61a EPC - Rule 36(3) EPC cannot be applied. So there is no possibility to set a time limit.

In Decision T 0295/01 which led to Opinion G 0001/02 the opposition was deemed not to have been filed, whereas in Decision T 1062/99, for the same reason - filing after the nine months time limit - the opposition was held inadmissible, but the opposition fee was reimbursed which means that, in reality, the opposition was deemed not filed.

The importance of the words "and act through him" in Article 133(2) EPC is particularly stressed in Decision G 0004/95 of the Enlarged Board. In the Summary of the Procedure, point IV, it is stated that these words were added to the Article later during the preparations of the drafts of the EPC. The significance of these words must lead to the conclusion that the non-acting through the professional representative cannot be repaired at a later moment after the nine months period. This is further confirmed by point 5 of the decision, emphasizing that a non-European party must be represented by a professional representative and point 6 which gives the reason for what is stated in point 5, namely to ensure efficiency and effectiveness of the European System, further by point 7 which highlights the words "act through him" and finally by point 8(b). The representative signing at a later moment to correct this deficiency in the notice of opposition should be refused by analogy with the rejection of the distinction between representation and "pleading" as set out in Decision T 0598/91 in point 8(b) because it could lead to a situation where a professional representative only states a party's request and leaves the presentation of the entire case to the accompanying person.

Reference is also made to Paterson, "The European Patent System" section 5 to 14, where the distinction between "European" and "non-European" persons is as well emphasized with regard to Article 133(2) EPC.

The same applies to Decision T 0451/89 in its points 5.1 and 5.2.

Coming back to Decision G 0003/99 cited at the beginning reference is now made to point 16 of the reasons which emphasizes that the relevant factual situation for assessing a procedural act is the situation at the time when this act is performed, which in the case under consideration is the filing of the notice of opposition on 25 August 1998.

In point 18 the competence of the formalities officer with regard to Rule 36(3) EPC in view of Article 110(1) EPC is commented on.

The reference in point 20 to Decision T 0665/89 is not applicable to this case because that decision according to which a procedural act performed by a non-entitled person is treated in the same way as a missing signature, is not concerned with the requirement of Article 133(2) EPC.

As a result of the foregoing it would appear to be appropriate that the matter be considered by the Enlarged Board, to whom the following question should be referred: in a first alternative whether a notice of opposition can be considered to have been filed if it was filed by a non-European entity itself and hence without **acting through** a European professional

representative, and in a second alternative whether the notice of opposition filed by a non-European entity while naming a European professional representative can then be checked pursuant to Rule 56 EPC as to its **admissibility** and whether the filing can be confirmed by the European professional representative after the 9 months period for filing oppositions?

XIII. The appellant requested that the points of law alternative I and II of the annex be referred to the Enlarged Board of Appeal, auxiliarily that the decision under appeal be set aside and that the opposition be deemed not to have been filed, further auxiliarily that the opposition be declared inadmissible and that the appeal fee be reimbursed.

XIV. The opponent alleged that the patent was invalid in view of the reasons given in the impugned decision.

Therefore, no further comments would be made with respect to the appeal and to any further documents to be exchanged between the board and the appellant.

Although duly summoned the respondent did not attend the oral proceedings, as previously announced, and did not put forward any specific request.

Reasons for the Decision

1. The appeal is admissible.

Substantial procedural violations

2. The appellant's first objection is that the opposition division started the oral proceedings of 29 June 2000 by delivering its decision that the opposition had been filed and that it was admissible without previously inviting the parties to present their arguments on these questions.
3. According to the minutes of the oral proceedings this objection is justified, as already acknowledged in the board's communication. In the minutes it is clearly stated that **before** hearing the requests of the parties the chairman announced the decision about the opposition being filed and admissible. Only after that announcement were the requests cited and the presentation of the arguments concerned only the allowability of the opposition.

Thus the opposition division committed a substantial procedural violation of Article 116(1) EPC, first sentence in connection with Article 113(1) EPC.

It is true that in the written procedure before the opposition division the parties already had an opportunity to present their comments with regard to the question whether the opposition was filed and admissible. But if oral proceedings are requested by a party this request must be followed. The right to oral proceedings is an absolute right and no discretion is

possible as results from the wording of the cited provision, "Oral proceedings shall take place ... at the request of any party to the proceedings."

Therefore, even if the parties already had an opportunity to present their comments in writing they must upon request nevertheless be given the opportunity to present them also orally before the body concerned can take a decision. It would run counter to this absolute right if the parties would only be given the opportunity to present comments orally on those points which have not yet been discussed in the written procedure.

4. Notwithstanding the substantial procedural violation the board has refrained from remitting the case to the first instance pursuant to Article 10 of the Rules of Procedure of the Boards of Appeal because special reasons present themselves for doing otherwise. The right to be heard in oral proceedings can be made up in the oral proceedings before the board and the conclusions of the impugned decision are correct, so that a remittal would only result in a procedural delay. Besides, the appellant has not requested that the case be remitted. Therefore, pursuant to Article 111(1) EPC the board decides on the appeal itself.

5. As to the appellant's second objection of substantial procedural violation concerning the various deficiencies of the impugned decision the board has come to the conclusion that this objection is not justified as also outlined in the board's communication.

6. Pursuant to Rule 68(2) EPC, first sentence, the decisions of the European Patent Office which are open to appeal shall be reasoned. "Reasoned" means that the decision must set out the logical chain of evaluations upon which the conclusion and therefore the final verdict is based with regard to each and every **ground** pleaded and substantiated, as far as this is necessary for the order to the decision. It does not necessarily mean that also all the arguments presented by the parties have to be discussed in the decision.

In the case under consideration one "ground" put forward by the appellant was that no opposition had been filed because it had not been filed pursuant to Article 133(2) EPC. Against this allegation the opposition division set out its legal reasoning that, since the professional representative had been indicated in the notice of opposition and since he had made up his missing signature within the time limit prescribed, the opposition was deemed to have been filed. The legal basis for this assessment, Rule 36(3) EPC was referred to, although not explicitly, but by a double reference, namely to the communication of 18 January 2000 in which the provision was cited, and to the Guidelines which also cite the provision.

In so doing the opposition division has complied, albeit briefly, with the requirement of giving a reasoned decision.

It is true that the relevant provisions of the EPC were not cited explicitly but implicitly as explained above, which is certainly a deficiency but does not amount to a substantial procedural violation.

7. With regard to the question of whether an opposition has been filed the appellant maintains that the requirement of Article 133(2) EPC that persons without either a residence or principal place of business within one of the Contracting States must be represented by a professional representative and act through him in all proceedings, other than in filing the European patent application, had not been fulfilled because the filing of the notice of opposition was not an act through a professional representative.

7.1 By this way of arguing the appellant unduly and erroneously presupposes that the requirement of acting through a professional representative and the requirement of observing a time limit - in this case the time limit for filing the notice of opposition - are dependent on each other and must be complied with at the same time.

7.2 That this is not the case is due to the existence of Rule 36(3) EPC which stipulates in its second sentence that if a document has not been signed the EPO shall invite the party concerned within a time limit to be laid down by the Office. In its third sentence the paragraph continues to determine that if signed in due time the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received. This means that for the requirement of acting through a professional representative an additional time limit is foreseen. Only if this additional time limit is not observed is the procedural act - the filing of the notice of opposition - considered not to have been performed.

7.3 The Enlarged Board has in its Decision G 0003/99 (OJ EPO 2002, 347) confirmed the extensive interpretation of Rule 36(3) EPC second sentence that the signature of a non-entitled person is treated by the EPO in the same way as a missing signature, an interpretation this board had given in Decision T 0665/89 (unpublished).

Neither in Rule 36(3) EPC nor in G 0003/99 is a distinction made between the two cases that a procedural act is performed by a European or a non-European person.

Therefore, contrary to the appellant's allegations, Decision G 0003/99 is pertinent for the case under consideration. But this does not mean that the obligation to be represented is "an empty letter". It merely signifies that as far as the observance of time limits is concerned an additional time limit in application of Rule 36(3) EPC second sentence can be given.

7.4 It is true that in some decisions of the boards of appeal the admissibility of an opposition and its deemed filing are not clearly distinguished and separated. But this fact does not have any repercussion on the case under consideration since here the notice of opposition has been filed and the opposition is admissible.

7.5 Therefore Decision T 0161/96 (OJ EPO 1999, 331) referred to by the appellant is not pertinent for this case since there the opposition was deemed not to have been filed because the opposition fee was only partly

paid. The comments put forward by the appellant with regard to Decision T 0161/96 are correct. Since pursuant to Article 99(1) EPC third sentence notice of opposition shall not be deemed to have been filed until the opposition fee has been paid a substantial underpayment cannot give rise to an opposition coming into existence, therefore the possibility of applying Rule 36(3) EPC does not exist either. Insofar the board concurs with the appellant.

But the case under consideration is different. Here together with the filing of the notice of opposition the full opposition fee was paid so that here Article 99(1) EPC third sentence does not apply and the opposition came into existence. The signature of a non-entitled person is a deficiency of an - at least potentially - existing opposition and for an existing opposition Rule 36(3) EPC is applicable via Rules 56(2) EPC and 61a EPC.

7.6 The cases underlying Decisions T 0295/01 (OJ, EPO 2002, 251) and T 1062/99 (unpublished) to which the appellant referred are also not pertinent for the case under consideration because there the notices of opposition were filed after the nine months time limit, so that the board can refer to its conclusions with regard to Decision T 0161/96.

7.7 Furthermore, the appellant points to Decision G 0004/95 (OJ, EPO 1996, 412) for endorsement of its allegations. This decision is concerned with oral submissions by an accompanying person during oral proceedings and it is held that such submissions are possible but that they must be made under the continuing responsibility and

control of the professional representative by which the requirement of Article 133(2) EPC "and act through him" is particularly stressed. From this assessment the appellant draws the erroneous conclusion that in the case under consideration there is no acting through the professional representative which is not true. It is only performed at a later moment as permitted by Rule 36(3) EPC and as explained above under point 7.2. The analogy drawn between point 8(b) of the reasons of the Decision and the signing at a later moment in the present case does not help the appellant because this is precisely to what the representative is entitled with regard to Rule 36(3) EPC.

7.8 That a distinction has to be made between "European" and "non-European" persons as emphasized by Decision T 0451/89 (unpublished) and by Paterson, is not denied by the board. But this distinction does not lead to the conclusion that with regard to a "European" party Rule 36(3) EPC is applicable whereas it is not with regard to a "non-European". This provision is not affected by the distinction and applies equally for both groups.

7.9 Finally the appellant has referred to points 16, 18 and 20 of the reasons of Decision G 0003/99 referred to already at the beginning of the presentation of its arguments.

In point 16 the question of the validity of an appeal filed by a non-entitled person was dealt with and it was stated that the relevant factual situation for assessing the admissibility of an appeal is the situation at the time when the appeal is filed.

This statement applies as well for assessing the existence of an opposition. If a notice of opposition is filed within the time limit of nine months and the opposition fee is also paid within this time limit the opposition becomes existent. If the notice of opposition has been filed by a non-entitled person the opposition is affected by a deficiency. Its further existence depends on the deficiency being remedied within a further time limit set pursuant to Rule 36(3) EPC. If the deficiency is remedied the opposition remains existent. If the deficiency is not remedied the opposition ceases to exist because pursuant to Rule 36(3) EPC third sentence the notice of opposition is then deemed not to have been received. Thus, the potential existence of the opposition affected by this deficiency can only turn into a definite existence by the deficiency being remedied within the further set time limit.

Point 18 of G 0003/99 concerning the competence of the formalities officer with regard to Rule 36(3) EPC in view of Article 110(1) EPC is of no relevance for the case under consideration because it is not concerned with the admissibility of an appeal.

Contrary to the appellant's allegations point 20 containing the reference to Decision T 0665/89 of this board is fully comparable to this case, because in both cases a procedural act was performed by a non-entitled person and, Decision T 0665/89 held that this has to be treated in the same way as a missing signature, this assessment being confirmed by the Enlarged Board. Again contrary to the appellant's contentions the requirement

of Article 133(2) EPC plays a part when the signature of the non-entitled person has to be replaced or supplemented by that of the professional representative within the time limit pursuant to Rule 36(3) EPC.

Thus, also points 16, 18 and 20 of G 0003/99 cannot lead to a different assessment of the case under consideration.

8. With regard to the question to be referred to the Enlarged Board according to the appellant's request the board holds that the conditions for referral as laid down in Article 112(1) EPC, namely ensuring uniform application of the law, or arising of an important point of law, are not fulfilled.

8.1 As the board has explained under point 7 the requirement of **acting through** pursuant to Article 133(2) EPC is observed, only at a later moment, namely within a time limit (Rule 36(3) EPC) following the time limit of nine months pursuant to Article 99(1) EPC. The **acting through** can be made up within the second time limit. If this is done the notice of opposition is considered to be filed.

This legal assessment is a long standing case law without any divergencies. Therefore, there is no reason for a referral to the Enlarged Board.

8.2 As to the second alternative of the question it has to be emphasized that the admissibility check pursuant to Rule 56(1) EPC can only start when the notice of opposition is acknowledged to have been filed i.e. when the professional representative has signed it. The mere

naming of the professional representative in the notice of opposition without his subsequent signature is not sufficient and will not lead to the consideration of the notice of opposition as having been filed and consequently no admissibility check would follow. That the deficiency of a notice of opposition filed within the nine months' time limit, but signed by a non-entitled person can be remedied by the signature of a professional representative pursuant to Article 134(1) EPC after the nine months' time limit has just been confirmed under point 8.1 above.

9. For the reimbursement of the appeal fee Rule 67 EPC requires, apart from the occurrence of a substantial procedural violation, that the appeal be allowable. Since this is not the case here the request for reimbursement must fail.

Order

For these reasons it is decided that:

1. The request for referral to the Enlarged Board is refused.
2. The appeal is dismissed.
3. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

A. Counillon

C. T. Wilson