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D E C I S I O N
of 22 August 2003

Case Number: T 0400/02 - 3.3.5

Application Number: 96938075.7

Publication Number: 0859738

IPC: C01B 33/00

Language of the proceedings: EN

Title of invention:
Compacted sodium silicate

Patentee:
AKZO-PQ Silica VOF

Opponent:
HENKEL KGaA

Headword:
Sodium silicate/AKZO

Relevant legal provisions:
EPC Art. 111(1), 113(1), 116(1)
EPC R. 67

Keyword:
"Procedural violation: yes, mistake of the EPO"
"Remittal to first instance: yes"
"Reimbursement of appeal fee: yes"
"Order to appoint a different composition of the opposition division: no"

Decisions cited:
T 0231/85, T 0405/96, T 0071/99, T 0838/02, T 0433/93, G 0005/91

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0400/02 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 22 August 2003

Appellant: (Proprietor of the patent)
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Representative:
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Decision under appeal:
Decision of the Opposition Division of the European Patent Office posted 8 April 2002 revoking European patent No. 0859738 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: R. K. Spangenberg
Members: B. P. Czech
M. B. Günzel

Summary of Facts and Submissions

I. The appeal is from a decision of the opposition division dated 8 April 2002 revoking the European patent No. 0 859 738.

II. Referring specifically to the disclosure of documents

D1 = EP-A-0 425 427 and

D2 = Product information BRITESIL C 20,

the opposition division considered that the subject-matter of claim 1 lacked an inventive step.

III. With its statement of grounds of appeal, the appellant (proprietor of the patent) submitted the following documents:

A1a: Acknowledgement of receipt of the EPO stamped "EPO-DG1 02.11.2001 44", referring to a letter and a cited reference

A2a: A copy of a letter in reply to the opposition, dated 31 October 2001, comprising a precautionary request for oral proceedings

A3a: A copy of a reference labelled "Technisches Datenblatt - Specification" of Alexanderwerk, Remscheid

The appellant argued that the originals of documents A2a and A3a had been submitted in time but had not been considered by the opposition division in reaching the

contested decision, and that its precautionary request for oral proceedings had been disregarded. The decision of the opposition division had thus been taken in breach of the requirements of Articles 113 and 116 EPC. Moreover, the appellant felt that the opposition division in its present composition was prejudiced since it had reached the contested decision with all the facts and evidence at hand. Therefore, it was of the opinion that the case should be remitted to a "new" opposition division.

IV. In its communication dated 21 November 2002, the board

- referred to electronic (scanned) copies A2b and A3b of documents A2a and A3a which had been retrieved within the EPO by the board, both A2b and A3b having been "date-stamped 02.11.2001 by the EPO (Directorate General 1)";

- indicated that in view of the circumstances of the case a substantial procedural violation appeared to have occurred, which would appear to justify the remittal of the case and the reimbursement of the appeal fee; and

- pointed out that a request aiming at the replacement of one or more members of the present opposition division would have to be filed before the first instance.

V. With its reply letter dated 11 December 2002, the appellant submitted further arguments as to why the maintenance of the present composition of the opposition division would place it in an unfavourable

position. It requested the board to take a final decision (concerning this issue) taking into consideration the arguments presented.

VI. The respondent (opponent) filed neither a reply to the statement of the grounds of appeal nor to the communication of the board.

VII. The appellant requested

- that the contested decision be set aside,

- that the case be remitted to the first instance with the order to recompose an opposition division consisting of members other than the ones of the opposition division which had taken the impugned decision; and

- that the appeal fee be reimbursed.

The respondent did not present any request.

Reasons for the Decision

1. The acknowledgment of receipt A1a issued by the EPO and the documents A2b and A3b retrieved in the EPO's computer system clearly bear the same stamp "EPO-DG1 02.11.2001 44". The board is therefore satisfied that the evidence on file is sufficient to establish that in response to the EPO's communication of the notice of opposition dated 5 July 2001, the appellant had filed its reply within the time limit of four months set by the EPO, which reply inter alia comprised a letter with

comments in response to the notice of opposition and a precautionary request for oral proceedings.

2. It emanates from the contents of the file that some mistake must have occurred at the EPO after the receipt of the appellant's reply. Due to that mistake, said reply did not reach the examiners making up the opposition division and was not included in the opposition file until after the contested decision was taken, ie more then five months after the filing of the reply. As a consequence of this mistake, the decision was thus taken without taking into consideration the appellant's submission and without summoning the parties for oral proceedings.

3. Due to a mistake of the EPO, the impugned decision was taken in breach of the appellant's right to be heard (Article 113(1) EPC) and of its right to oral proceedings (Article 116(1) EPC), which amounts to a substantial procedural violation. The appellant has requested the remittal of the case, whereas the respondent has not taken position on this issue at all. Hence, in view of the said substantial procedural violation, the contested decision has to be set aside. Considering further that the appellant's substantive arguments concerning the grounds of opposition invoked have not yet been examined at all, the case is remitted to the first instance for further prosecution, pursuant to Article 111(1) EPC, see Rules of procedure of the Boards of Appeal, OJ EPO 3/2003, 89, Article 10.

4. The remittal being a consequence of a substantial procedural violation, the board also considers the reimbursement of the appeal fee under Rule 67 EPC to be

equitable, see eg T 231/85, OJ EPO 1989, 74, point 10 of the reasons and headnote 2, T 405/96 of 8 November 1996 (not published in the OJ EPO), point 2 of the reasons.

5. The present board shares the view already expressed by other boards that it is up to the relevant departments of first instance to select the members making up a particular opposition division, see eg the recent decisions T 71/99 of 20 June 2001 (not published in the OJ EPO), point 4 of the reasons, and T 838/02 of 29 January 2003 (not published in the OJ EPO), point 8 of the reasons.

5.1 The present board is aware of decision T 433/93, OJ EPO, 1997, 509, wherein another board suggested and ordered that the remitted case was "to be examined by a different composition of opposition division", see Order, point 2, and Facts and Submissions, point IV, third paragraph. However, neither does said decision, or decision G 5/91, OJ 1992, 617, to which it refers, indicate a legal provision upon which this particular order could be considered to be based, nor is the present board aware of any such provision in the EPC.

5.2 For its request that an entirely new opposition division be appointed, the appellant has given the reason that it does not wish to be placed in a worse position than if the mistake of the EPO had not taken place. More particularly, it considered that the opposition division which took the contested decision was now prejudiced since it could not arrive at another decision on the basis of the same facts and evidence.

5.3 However, since in the present appeal proceedings the board has no power to order a change of the composition of the opposition division to be entrusted with the case after its remittal, it will be up to the first instance to consider the appellant's submissions and requests, if any, when determining the said composition.

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 is to be reimbursed.

The Registrar: The Chairman:

U. Bultmann R. Spangenberg