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D E C I S I O N
of 12 November 2002

Case Number: T 0597/02 - 3.2.2

Application Number: 93921213.0

Publication Number: 0656956

IPC: C22C 21/00

Language of the proceedings: EN

Title of invention:

Tough aluminum alloy containing copper and magnesium

Patentee:

Alcoa Inc.

Opponent:

PECHINEY

Headword:

-

Relevant legal provisions:

EPC Art. 116(1)

EPC R. 67

Keyword:

"Request for oral proceedings (yes)"

"Adverse decision issued without oral proceedings"

"Appeal fee reimbursed"

Decisions cited:

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Catchword:

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Case Number: T 0597/02 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 12 November 2002

Appellant: Alcoa Inc.
(Proprietor of the patent) 100 Technical Drive
Alcoa Center
PA 15069-001 (US)

Representative: Bergen, Klaus, Dipl.-Ing.
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Respondent: PECHINEY
(Opponent) 7, Place du Chancelier Adenauer
FR-75218 Paris Cedex 16 (FR)

Representative: Mougeot, Jean-Claude
PECHINEY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 April 2002
revoking European patent No. 0 656 956 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. D. Weiß
Members: R. Ries
J. C. M. de Preter

Summary of Facts and Submissions

I. European patent No. 0 656 956 was granted on 20 October 1999 on the basis of European patent application No. 93 921 213.0.

II. The granted patent was opposed by the present respondents (opponent PECHINEY) on the ground that its subject matter did not involve an inventive step with respect to the state of the art (Article 100(a) EPC). The notice of opposition contained a detailed reasoning in support of the ground of opposition and revocation of the patent in its entirety was requested. Oral proceedings were requested, should a different decision be contemplated by the opposition division.

III. In a telefax dated 27 April 2001 the patentee (appellant) asked for an extension of the time limit pursuant to Rule 84 EPC to respond to the notice of opposition, and further requested that oral proceeding to be held. The telefax was followed by a confirmation copy which was received by the EPO on 28 April 2001. In each letter, the appellant's request for oral proceedings was printed in bold letters on the second page.

On 31 July 2001, the patentee submitted detailed observations in reply to the notice of opposition and requested that the opposition be rejected as unfounded.

IV. In the decision dated 9 April 2002, the opposition division revoked the patent. The opposition division held in its decision in point I-3, last sentence that "at no stage the patentee did request for oral proceedings to be appointed".

V. An appeal against this decision was filed by the patentee (appellant) on 10 June 2002 and the appeal fee was paid on the same date. The written statement setting out the grounds of appeal was filed within the time limit given in Article 108 EPC. The appellant argued that - despite the existence of a request for oral proceedings submitted on 28 April 2001 - the opposition division decided to revoke the patent without due regard to Article 116(1) EPC. In the appellant's view this constitutes a substantial procedural violation and justifies the repayment of the appeal fee under Rule 67 EPC.

The appellant, therefore, requested that the decision under appeal be set aside and the appeal fee be reimbursed.

VI. In its letter received on 23 August 2002, the respondent shared the appellant's view and requested that the case be remitted to the opposition division as soon as possible.

Reasons for the Decision

1. The appeal is admissible.

2. From the second page of the appellant's letter dated 27 April 2001, it is beyond any doubt that a valid request for oral proceedings had been submitted by the patentee. Having regard to the history of the opposition proceedings summarized in the paragraphs II to IV above, the failure by the opposition division to hold such oral proceedings does not appear to be in consequence of an error of interpretation, but simply due to an oversight.

However, the provision pursuant to Article 116(1) EPC that oral proceedings shall take place at the request of any party to the oral proceedings is mandatory and, therefore, the appellant was entitled to oral proceedings before the decision was issued. In these circumstances, the decision of the opposition division dated 9 April 2002 has to be set aside.

The right to an oral hearing as provided for by Article 116(1) EPC is a very important procedural right. The failure by the opposition division to hold oral proceeding in response to a clear request by the appellant represents a substantial procedural violation under Rule 67 EPC. The reimbursement of the appeal fee is, therefore, equitable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division with the order that oral proceedings under Article 116(1) EPC shall take place before the opposition division decides on the opposition.
3. The appeal fee shall be reimbursed to the appellant.

The Registrar:

The Chairman:

V. Commare

W. D. Weiß