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D E C I S I O N
of 7 March 2003

Case Number: T 0168/03 - 3.3.2

Application Number: 92101148.2

Publication Number: 0498231

IPC: A01N 25/04

Language of the proceedings: EN

Title of invention:
Biocodal and agrochemical suspensions

Patentee:
HUNTSMAN INTERNATIONAL LLC

Opponent:
American Cyanamid Company

Headword:
-

Relevant legal provisions:
EPC Art. 102(3)(5), 109(1)
EPC R. 67, 58

Keyword:
"Correction of errors made by the office-interlocutory
revision in opposition procedures possible in special cases"

Decisions cited:
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Catchword:
-



Case Number: T 0168/03 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 7 March 2003

Appellant: HUNTSMAN INTERNATIONAL LLC
(Proprietor of the patent) 500 Huntsman Way
Salt Lake City
Utah 84108 (US)

Representative: Savidge, Roger Gordon Madgwick
Huntsman Surface Sciences UK Limited
P.O. Box 9792
210-222 Hagley Road West
Oldbury
West Midlands B68 0WA (GB)

Respondent: American Cyanamid Company
(Opponent) Five Giralda Farms
Madison
New Jersey 07940 (US)

Representative: Fitzner, Ulrich, Dr.
Dres. Fitzner & Münch
Rechts- und Patentanwälte
Lintorfer Strasse 10
D-40878 Ratingen (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 15 January 2003
revoking European patent No. 0 498 231 pursuant
to Article 102(4)/(5) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: P. Mühlens
J. Riolo

Summary of Facts and Submissions

- I. The appeal lies against the decision of the opposition division dated 15 January 2003 revoking European patent No. 0 498 231 on the grounds of Article 102(4)/(5) EPC.
- II. The patent was granted on the basis of European patent application 92 101 148.2 on 2 May 1997. On 4 February 1998, a notice of opposition was filed. After oral proceedings held on 16 October 2001 the opposition division gave an interlocutory decision on 28 December 2001. No appeal was filed so the decision became final.
- III. Consequently, the appellant (patent proprietor) was requested by two communications pursuant to Rules 58(5) and (6) EPC to pay the fee for printing a new specification and to file translations of any amended claims into the two other EPO official languages. Although the appellant paid the fee, filed the translations and paid a surcharge under Rule 58(6) EPC, the EPO inadvertently did not take note of this and issued the impugned decision.
- IV. The appellant requests that the decision under appeal be set aside, that the grant of the patent be confirmed and that the appeal fee be reimbursed. He also requests that an overpayment of the printing fee be reimbursed and that the proceedings be accelerated. As an auxiliary request, he requests oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. After having decided that, account being taken of the amendments made by the patent proprietor, the patent met the requirements of the EPC and after this decision became final, the opposition division had to decide to maintain the patent as amended, provided that the fee for the printing of a new specification was paid and translations of the amended claims were filed (Articles 102(3)(b),(5) EPC and Rule 58(5)(6) EPC) in due time (or possibly within a prolonged delay with a surcharge).

2.1 Although the patent proprietor complied with all these requirements, the opposition division did not decide to maintain the patent but erroneously revoked it instead on the grounds of non-compliance with the said requirements. Thus, the decision under appeal must be set aside. The case has to be remitted to the opposition division for the decision to maintain the patent as amended according to the interlocutory decision of 28 December 2001 and for the remaining (formal) acts of the grant procedure, such as printing of the new specification to be completed. Overpaid fees, if any, will have to be reimbursed.

3. This appeal being occasioned by an error of the Office, it is equitable that the appeal fee be reimbursed (Rule 67 EPC).

4.

4.1 Although the case is clear and easy to decide, the first instance has refrained from rectifying its decision under Article 109 EPC. It can be assumed that it has seen an obstacle to an interlocutory revision in Article 109(1) 2nd sentence EPC where it is laid down

that rectifying a decision is not possible if "the appellant is opposed by another party to the proceedings". Actually, this provision generally prohibits interlocutory revision in opposition proceedings. Despite that, also in such proceedings situations can arise where the legitimate interest of parties other than the proprietor of the patent are not involved. The Guidelines for Examination in the European Patent Office (part E XI 7) mention in this respect the case where all notices of opposition have been withdrawn and the proprietor of a patent files an appeal.

- 4.2 In the present case, the problem arose in the very final phase of an opposition procedure, where the decision of the opposition division on the merits of the case had already become final and the procedure was only to be continued between the proprietor and the office for the (formal) decision to grant the patent as amended. In this final phase, the Board cannot find a substantial difference compared to the end of the grant procedure under Rule 50 EPC. Thus, the appellant was no longer "opposed" by another party. As a consequence, the first instance could have rectified its decision, this being the fastest and easiest way to remedy its mistake.

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:

A. Townend

U. Oswald