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D E C I S I O N
of 21 September 2004

Case Number: T 0830/03 - 3.5.2

Application Number: 96306891.1

Publication Number: 0765017

IPC: H01T 13/52

Language of the proceedings: EN

Title of invention:
A spark plug for use in an internal combustion engine

Patentee:
NGK SPARK PLUG CO., LTD.

Opponent:
Robert Bosch GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 106, 107, 108, 109(1), 111(1)
EPC R. 68-70, 89

Keyword:
-

Decisions cited:
G 0004/91, G 0012/91, T 0371/92, T 1176/00, T 1081/02

Catchword:
- legal validity of a decision of an Opposition Division
- devolutive effect of the appeal
- protection of legitimate expectations applicable to late filed statement of grounds of appeal (yes)
- admissibility of the appeal (yes)

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0830/03 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 21 September 2004

Appellant: (Opponent)
Robert Bosch GmbH
Postfach 30 02 20
D-70442 Stuttgart (DE)

Representative:
-

Respondent: (Proprietor of the patent)
NGK SPARK PLUG CO., LTD
14-ban, 18-gou
Takatsuji-cho
Mizuho-Ku
Nagoya-shi (JP)

Representative:
Senior, Alan Murray
J.A. KEMP & CO.
14 South Square
Gray's Inn
London WC1R 5JJ (GB)

Decision under appeal:
Interlocutory decision of the Opposition Division of the European Patent Office posted 2 April 2003 concerning maintenance of European patent No. 0765017 in amended form.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: F. Edlinger
B. J. Schachenmann
M. Ruggiu
E. Lachacinski

Summary of Facts and Submissions

I. An opposition had been filed against European patent No. 765 017. The opposition division, enlarged by the addition of a legally qualified member pursuant to Article 19(2) EPC, held oral proceedings on 12 February 2003.

II. According to the minutes of the oral proceedings, the chairman of the opposition division, referring to Article 102(3) EPC and giving short reasons, announced the following decision at the end of the oral proceedings:

"Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates are found to meet the requirements of the European Patent Convention. The currently valid documents are those according to the main request."

III. A written reasoned decision dated 2 April 2003 was notified to the parties in compliance with Rule 68(1) and (2) EPC (in the following referred to as "first written decision"). It included an official cover sheet "Interlocutory decision …" (EPO Form 2327), eight pages of reasoning and documents relating to the amended text of the patent. It was accompanied by the minutes of the oral proceedings and a written communication of the possibility of appeal (EPO Form 2019). EPO Form 2327 indicated the names of four members of the opposition division and that of the formalities officer and bore the EPO seal. The name of the legal member indicated on

EPO Form 2327 was different from that indicated in the minutes of the oral proceedings.

IV. The opponent filed a notice of appeal received on 8 May 2003 against this decision. In this notice, the appellant requested that the appeal fee be debited from the account as indicated. However, it appears from the file that this appeal fee was never debited from that account.

V. The formalities officer informed the parties by telephone on 26 and 27 May 2003, respectively, that the written decision "was only a draft" and that the EPO would contact the parties again in the following week (confirmed by brief communications dated 27 May 2003). The reason given was that it was recognisable from section II, item 5 (prior use) of the reasons that the interlocutory decision sent out was only a draft because only the title was given therein.

VI. A second written decision was issued by the EPO on 2 July 2003 together with a communication dated 2 July 2003, which referred to the "Communication of 02.04.03" and gave the following brief explanation:

"EPO Form 2327 dated 02.07.03 supersedes the above mentioned communication. Please accept our apologies for the clerical error."

The second written decision was thus intended to supersede the first written decision. Its reasoning was ten pages long and included reasons (point II.5) as to why the opposition division considered that the alleged prior use was made available to the public before the

priority date of the opposed patent. Some other passages of the decision were also amended, and the decision (point II.8) concluded with the following statement:

"Attention is drawn to the fact that the decision is open to appeal pursuant to Articles 106 to 108 EPC. For the time limit mentioned in Article 108 EPC the date of the notification of this decision is relevant. The notification of the draft decision dated 02-04-2003 does not have any legal effect."

VII. With a letter dated 8 July 2003 the opponent filed a second notice of appeal, received on 18 July 2003. This time the appeal fee was debited in accordance with a request similar to the one in the first notice of appeal. A statement of grounds of appeal dated 8 July 2003 was filed on 30 October 2003. The appellant opponent, *inter alia*, provided new evidence, document D16, which was said to be highly relevant. The appellant requested that the contested decision be set aside and that the opposed patent be revoked in its entirety.

VIII. With a letter dated 4 March 2004 the respondent proprietor filed new claims according to a main request and seven auxiliary requests. The respondent requested that the patent be maintained with the claims amended in accordance with the main request, or according to one of the first to seventh auxiliary requests.

IX. The Board informed the parties in a communication dated 28 May 2004 that it had examined *ex officio* the legal validity of the contested decision. The Board expressed

the opinion that the first appeal filed by the opponent appeared admissible and, consequently, all actions carried out by the opposition division after the filing of the first appeal were *ultra vires* and should be declared by the Board to have no legal effect. The Board intended to remit the case to the opposition division. The parties were requested to state whether they maintained their requests for oral proceedings in these circumstances.

X. Both parties withdrew their requests for oral proceedings if the Board remitted the case to the opposition division for further prosecution. They did not comment on the issues raised by the Board.

Reasons for the Decision

1. *Decision under appeal*

1.1 The need for legal certainty requires a presumption of validity in favour of a written decision which is notified to the parties by an opposition division in accordance with the formal requirements of the Convention, in particular Rules 68 to 70 EPC. The time limits pursuant to Article 108 EPC start to run with the date of notification of the decision. The decision enters into force at the latest with its notification, and the opposition division can no longer amend its decision (G 12/91, OJ EPO, 1994, 285, points 2 and 9.3; G 4/91, OJ EPO, 1993, 707, point 7). The need to ensure legal certainty thus requires that this moment be clearly fixed.

1.2 Once the decision was pronounced and the (first) written decision, in the present case, notified to the parties, the opposition division was bound by it even if it considered its decision not to "have any legal effect" (cf point II.8 of the second written decision; see T 371/92, OJ EPO, 1995, 324, points 1.4, 1.5 and 2.3). The decision could be set aside only by the second instance on the condition that an allowable appeal was filed under Article 106 ff EPC. With the filing of the first notice of appeal, the power to deal with the issues involved in this case passed from the department of first instance to the appeal instance (devolutive effect of the appeal). Therefore, after notification of the first written decision, the opposition division had no power to go beyond a correction of errors in the decision pursuant to Rule 89 EPC. Interlocutory revision according to Article 109(1) EPC was not an option because the appellant was opposed by another party. This remains true even if the first written decision contained certain irregularities which might have been detectable by the parties, such as a wrong name of the legal member indicated in EPO Form 2327 dated 2 April 2003 and, as the case may be, a missing passage in the reasons. The fact that the first written decision did not contain any text under the paragraph heading "5. Prior use" was also not sufficient to deprive the decision as a whole of its presumption of validity. In fact, the appellant did rely on the validity of the decision and filed the first notice of appeal. Only when the formalities officer informed the parties that the documents were "only a draft" was it possible for the parties to have serious doubts whether the notified decision was actually intended to be sent out. However,

this occurred after the first notice of appeal had been filed, and in any case the correction of a "clerical error" as referred to in the communication dated 2 July 2003 (see point VI above), could not alter the material content of the decision, nor its date or the time limit for appeal (cf T 1176/00, point 1.2).

1.3 Therefore, in the judgement of the Board, the written decision dated 2 April 2003, which was notified to the parties by the opposition division in accordance with the formal requirements of the Convention, in particular Rules 68 to 70 EPC, constitutes the only legally valid written decision. All actions carried out by the opposition division after the notification of the decision, and *a fortiori* after the filing of the first appeal, were *ultra vires* and have thus no legal effect.

2. *Admissibility of the appeal*

2.1 The parties had no reason to doubt that the first written decision was the decision terminating the opposition proceedings, from which an appeal would lie pursuant to Article 106(1) EPC. The party adversely affected by the maintenance of the opposed patent (Art. 107 EPC), ie the appellant opponent, accordingly filed a notice of appeal within the time limit under Article 108 EPC. With the notice of appeal, the appellant requested that the appeal fee be debited from the account as indicated. If this request was not acted on by the EPO, as it appears from the file, this was not within the appellant's responsibility. The Board therefore considers that the appeal fee paid with the

second notice of appeal shall be deemed to have been paid in due time for the first appeal.

2.2 However, the statement of grounds of appeal dated 8 July 2003 was filed only on 20 October 2003, thus outside the period of four months after the date of notification of the first written decision prescribed by Article 108 EPC. The appellant opponent has obviously been misled by the formalities officer's communication which declared the first written decision to be "only a draft" and to be "superseded" by the second written decision, confirmed by paragraph II.8 of the second decision. The appellant opponent, apparently relying on this wrongly changed date of notification of the decision, filed the statement of grounds of appeal within the time limit after the date of notification of the second written decision. The Board has no reason to doubt that the appellant would have filed the statement of grounds in time if he had not been misled. In application of the principle of protection of legitimate expectations, the statement of grounds of appeal filed in the second appeal shall thus be deemed to have been filed within the time limit required by Article 108 EPC after the date of notification of the legally valid written decision.

2.3 Since both the first and second appeals are against the maintenance of the patent as announced at the oral proceedings, the statement of grounds of appeal containing the legal and factual reasons why the decision should be set aside is, in substance, also directed against the first written decision and is sufficiently substantiated. The appeal thus fulfils all

the formal requirements for it to be admissible (see also T 1081/02, points 1.3.1 to 1.3.5).

3. *Allowability of the appeal*

3.1 There is no evidence that a substantial procedural violation had occurred in the proceedings leading to the legally valid written decision. The indication of a wrong name of the legal member in this decision was not the cause for its replacement by the opposition division and would have been correctable under Rule 89 EPC. Thus there is no reason to order reimbursement of the appeal fee (Rule 67 EPC). In effect, the admissible appeal is directed against this decision.

3.2 Indeed, the opposition division acted *ultra vires* after the notification of the first written decision by replacing it by a second written decision. This has led to confusion as is apparent from the foregoing, which is not compatible with the principle of legal certainty. Even if these procedural irregularities had not occurred, the present case was likely to be remitted to the department of first instance because the appellant opponent, in the appeal proceedings, has introduced a new document D16 and the proprietor has filed new sets of claims in response thereto, so that the factual basis on which the decision under appeal was based has changed substantially. In these circumstances, the Board considers that the decision under appeal should be set aside and the Board should use its power under Article 111(1) EPC to remit the case to the department of first instance.

3.3 For these reasons, the decision under appeal given orally at the oral proceedings of 12 February 2003 and notified to the parties in writing (posted 2 April 2003) has to be set aside, and the second written decision (posted 2 July 2003) has to be declared null and void.

Order

For these reasons it is decided that:

1. The decision under appeal posted 2 April 2003 is set aside.

2. The decision dated 2 July 2003 is null and void.

3. The case is remitted to the department of first instance for further prosecution.

The Registrar: The Chairman:

D. Sauter W. J. L. Wheeler