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D E C I S I O N
of 14 July 2005

Case Number: T 0742/04 - 3.3.5

Application Number: 89106332.3

Publication Number: 0336450

IPC: C04B 35/00

Language of the proceedings: EN

Title of invention:
Metal oxide materials

Patentee:
HER MAJESTY THE QUEEN IN RIGHT OF NEW ZEALAND

Opponents:
Siemens AG
Hoechst AG

Headword:
Metal oxide materials

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

Keyword:
"Termination of opposition proceedings after remittal without previous notification - substantial procedural violation"

Decisions cited:
T 0769/91, T 0892/92, T 0120/96, T 0679/97, T 0549/00,
T 0552/97, T 0500/01

Catchword:
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Case Number: T 0742/04 - 3.3.5

D E C I S I O N
of the Technical Board of Appeal 3.3.5
of 14 July 2005

Appellant 01: Siemens AG
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Appellant 02: Hoechst AG
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Respondent: HER MAJESTY THE QUEEN IN RIGHT OF NEW ZEALAND
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 17 May 2004
rejecting the opposition filed against European
patent No. 0336450 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairwoman: M. M. Eberhard
Members: E. O. Wäckerlin
S. U. Hoffmann

Summary of Facts and Submissions

- I. European patent No. 0 336 450 was granted on 16 October 1996 on the basis of 4 claims in response to European patent application No. 89 106 332.3. Two notices of opposition were filed on 16 July 1997, requesting the revocation of the patent in its entirety on the grounds of lack of novelty and lack of inventive step (Article 100(a) EPC). In addition the opponent 02 raised an objection on the ground of insufficient disclosure within the meaning of Article 100(b) EPC. Only the opponent 01 and the proprietor of the patent made subsidiary requests dated 16 July 1997 and 28 September 1998, respectively, to institute oral proceedings before taking any adverse decision.
- II. Oral proceedings before the opposition division were held on 9 March 2000. According to the minutes two substantive issues were addressed, namely the validity of the first priority and the sufficiency of the disclosure, whereas the grounds of opposition under Article 100(a) EPC were not discussed. In its decision posted on 29 March 2000 the opposition division held that it was not entirely clear from the disclosure of the patent how the claimed composition could be obtained. For this reason the patent was revoked on the ground of insufficient disclosure (Article 100(b) EPC).
- III. Notice of appeal was filed by the proprietor of the patent on 29 May 2000 against this first decision of the opposition division. He complained about several procedural flaws. Moreover he argued, *in essence*, that the claimed composition was sufficiently disclosed in view of the crystallographic data given in the example.

Opponents 01 and 02 (respondents at this stage of the proceedings) refuted the argumentation of the appellant and maintained that the patent did not disclose a method for obtaining the claimed material. Oral proceedings were held on 21 March 2003 before the Board of Appeal 3.3.5.

- IV. By its decision T 0549/00, dated 21 March 2003 and notified to the parties on 3 June 2003, the board set aside the impugned decision and remitted the case to the opposition division for further prosecution. The board held that the ground of opposition under Article 100(b) EPC was unfounded. The grounds of opposition under Article 100(a) EPC were not addressed in the decision.
- V. On 27 May 2003 the registry of the Board of Appeal 3.3.5 returned the file to the opposition division. The parties were not informed about this procedural step.
- VI. Subsequently, the opposition division rejected the oppositions by its decision posted on 17 May 2004, without any further notification or invitation to the parties for comments. In the section "facts and submissions" of the opposition division's decision the following statements are made in the last two paragraphs: *"The decision to revoke the patent was set aside by the Board of Appeal Decision T 0549/00, issued to the parties with letter dated 28.3.03, and the case was remitted to the first instance for further prosecution since the grounds of opposition under Article 100(a) EPC had not been dealt with in the decision of the Opposition Division."* and *"No*

subsequent communication or request from any of the parties has been received by the first instance. No request for a further oral proceedings before the first instance has been made." The opposition division held that the claimed compositions were novel and involved an inventive step with regard to the disclosure of the documents referred to by the opponents.

VII. By letters dated 8 June 2004 and 24 June 2004, respectively, notices of appeal were filed by the two appellants (opponents 01 and 02).

Appellant 01 (opponent 01) argued that the manner in which the case had been handled by the opposition division after the board had remitted it was contrary to the requirement of Article 113(1) EPC, because the case was decided without summoning the parties to oral proceedings in order to give them an opportunity to present their comments regarding the grounds of opposition under Article 100(a) EPC. He argued that his subsidiary request for oral proceedings contained in the notice of opposition dated 16 July 1997 became once more effective after remittal.

By letter dated 3 September 2004 appellant 01 submitted extensive comments on the issues of novelty and inventive step. Moreover he referred to three further documents in support of his argumentation.

Appellant 02 (opponent 02) argued also that the right to be heard according to Article 113(1) EPC had not been observed by the opposition division. The parties were not informed that the proceedings before the opposition division had been resumed, and they were not

invited to file their comments on the issues under Article 100(a) EPC, viz. novelty and inventive step. This would have been required, particularly in view of the fact that the proprietor of the patent had presented contradicting views during the opposition and the (first) appeal procedure, respectively, on the precise meaning of the chemical formula of the claimed compositions. Furthermore appellant 02 argued that the opposition division had deprived him of his right to present his arguments regarding novelty and inventive step before two instances, i.e. the opposition division and the board of appeal.

In his letter of reply dated 28 January 2005 the respondent (proprietor) contemplated the possibility that the case be remitted to the opposition division for further examination and appointment of oral proceedings. Alternatively he asked for a two months extension of the time limit for finalising and submitting his response in respect of the issues of novelty and inventive step. By letter dated 5 April 2005 the respondent submitted detailed comments on the issues of novelty and inventive step.

Both appellants held that the non-observance of the right to be heard amounted to a substantial procedural violation and requested the reimbursement of the appeal fee.

VIII. Appellant 01 requested in the notice of appeal to set aside the impugned decision dated 17 May 2004 and taken by the opposition division, to remit the case to the opposition division for further prosecution including appointment of oral proceedings, and to refund the

appeal fee. In the statement of grounds of appeal he further requested oral proceedings and revocation of the patent in its entirety.

Appellant 02 requested to set aside the impugned decision, to remit the case to the opposition division for further prosecution, to refund the appeal fee, to revoke the patent in its entirety and, as an auxiliary request, to conduct oral proceedings.

The respondent requested that the appeals be dismissed and the patent be maintained as granted or, as an auxiliary request, that the patent be maintained on the basis of amended claims 1 to 4 submitted with his letter dated 28 January 2005. Oral proceedings were requested before any decision other than allowance of the main request was taken. However, in the event that the board would decide to remit the case to the opposition division for the appointment of oral proceedings, the respondent requested that immediate order be given for remittal to the opposition division for further prosecution, including appointment of oral proceedings.

- IX. In its communication of 30 June 2005, the board informed the parties of its provisional opinion that the case should be remitted without assessment of novelty and inventive step to the opposition division for further prosecution including appointment of oral proceedings. The parties were invited to indicate whether they requested oral proceedings before the board on procedural matters before a decision of remittal to the first instance was taken and issued. In reply the appellant 01 withdrew the request for oral

proceedings before the board, but on the condition that the appellant 02 and the respondent agreed also to the remittal of the case (see letter of 4 July 2005). The appellant 02 withdrew the request for oral proceedings before the board (see letter of 12 July 2005). The respondent explained that he did not request oral proceedings before the issuance of any decision for remittance (see letter of 1 July 2005).

Reasons for the Decision

1. The question arises whether or not the proceedings before the opposition division that took place after remittal of the case for further prosecution suffer from a substantial procedural violation, as alleged by the appellants.

2. The provision that is relevant to this issue is that of Article 113(1) EPC. This Article provides that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. As stated in decision T 0892/92 (see OJ EPO 1994, 664), this means that *"if the parties can be said to have been surprised, from an objective point of view, by the decision and the grounds and evidence on which it is based, then this opportunity cannot have been sufficiently granted."* (see T 0892/92, point 2.1 of the reasons, OJ EPO 1994, 664). In view of the fact that the resumed proceedings are governed by the existing requests, it is also necessary for the opposition division to clarify whether any previous requests that have been submitted before the opposition proceedings were

interrupted by the appeal proceedings are maintained, modified or withdrawn, or whether further requests are submitted (see T 0892/92, point 2.1 of the reasons, OJ EPO 1994, 664; T 0769/91, point 2 of the reasons; T 0120/96, point 2.2 of the reasons; T 0679/97, points 2.2 and 2.3.2 of the reasons).

3. In the present case appellant 01 has argued that his original request for oral proceedings before the opposition division had been revived on remittal and was therefore legally effective, but had not been taken into account by the opposition division.

The present board notes that the first decision by the opposition division, posted on 29 March 2000, was set aside by the Board of Appeal 3.3.5 (in a different composition) and was therefore no longer legally effective. In the present circumstances the board, following the established case law of the boards of appeal (see T 0892/92, point 2.2 of the reasons, OJ EPO 1994, 664; T 120/96, point 2.3 of the reasons; T 0679, point 2.3.3 of the reasons), is of the opinion that further proceedings on remittal by the board of appeal ordering "further prosecution" have to be regarded as a continuation of the original opposition proceedings. Consequently, since the issues of novelty and inventive step have neither been discussed at the oral proceedings held before the opposition division on 9 March 2000, nor dealt with by the board during the first appeal procedure, opponent 01's original request for revocation of the patent as well as the subsidiary request for oral proceedings became again effective after remittal. Therefore the opposition division should have given opponent 01 an opportunity to present

his arguments on novelty and inventive step orally in accordance with Article 116(1) EPC, if it intended to issue a decision adversely affecting opponent 01.

Furthermore, the board holds that decision T 0549/00 of board 3.3.5 to remit the case to the opposition division for further prosecution created a new procedural situation which required the opposition division, in order to comply with Article 113(1) EPC, to give the parties the opportunity to present their comments anew. The parties' right to be heard had not been safeguarded sufficiently by the fact that the parties had already submitted comments in writing on the requirements of Articles 54 and 56 EPC during the proceedings prior to decision T 0549/00, because the reasons given in this decision were capable of affecting the parties' lines of argument on novelty and inventive step. Thus, even if, after remittal of the case for further prosecution, no request for oral proceedings had been made, the opposition division would have been obliged to invite the parties to present their comments anew.

For the sake of completeness, the board notes that it would be inappropriate to regard the mere lapse of time after the issue of decision T 0549/00 as the parties' renunciation of their right to be heard before the opposition division, since the parties did not know when the board of appeal administratively carried out the remittal and when the case was actually pending before the opposition division anew.

Therefore, the parties should have been informed in any case by a written communication about the fact that the case was again pending before the opposition division.

Consequently, the opposition division's failure to announce resumption of the opposition proceedings to the parties and its failure to summon the parties to oral proceedings before the issue of the decision rejecting the opposition amount to a substantial procedural violation and constitute a violation of Article 113(1) EPC. Therefore, the decision under appeal must be set aside.

4. Since appellant 01's appeal is clearly caused by the above stated substantial procedural violation, the reimbursement of the appeal fee to appellant 01 is equitable within the meaning of Rule 67 EPC.

Although appellant 02 did not request oral proceedings prior to the first (and second) decision by the opposition division, reimbursement of the appeal fee to appellant 02 has to be ordered, too, since his appeal could not be heard on the merits in view of the present remittal of the case to the opposition division because of the substantial procedural violation (see decision T 0552/97, point 6 of the reasons).

5. Both the appellant 02 and the respondent have withdrawn their requests for oral proceedings before the board on procedural matters in the case of remittal to the opposition division for further prosecution. Concerning the conditional withdrawal by the appellant 01 of the request for oral proceedings before the board (see letter of 4 July 2005), the board observes that neither

the appellant 02 nor the respondent have objected against the remittal of the case, without assessment of novelty and inventive step, to the opposition division. Under these circumstances there is no need to hold oral proceedings before the board.

On the basis of the present decision the opposition division is bound to summon the parties to oral proceedings unless the parties drop their respective requests.

The board is not empowered to decide at this procedural stage that accelerated proceedings are to take place before the first instance, because a request for accelerated proceedings was not the subject of the decision under appeal (see decision T 0500/01, point 33 of the reasons). It is self-evident, however, that the opposition division will consider the acceleration of the opposition procedure.

6. For the reasons given above the board has decided not to investigate the substantive questions of patentability, but to exercise its power under Article 111(1) EPC and remit the case to the opposition division for further prosecution, thus giving the parties the opportunity to have the issues of novelty and inventive step examined by two instances.

The board is concerned that this case has to be remitted again to the opposition division without a final decision on the substantive issues of novelty and inventive step (Articles 54 and 56 EPC). Nevertheless the board observes that the aim of streamlining the

proceedings before the EPO must not be achieved at the expense of the parties' right to a fair procedure.

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 for further prosecution.
3. The appeal fee is to be reimbursed to appellants 01 and 02.

The Registrar:

The Chairwoman:

A. Wallrodt

M. M. Eberhard