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**Datasheet for the decision  
of 12 August 2010**

**Case Number:** T 1536/08 - 3.2.04

**Application Number:** 01903796.9

**Publication Number:** 1219830

**IPC:** F04B 1/00

**Language of the proceedings:** EN

**Title of invention:**

Cam device for removing and tilting the front plate in a vertical mold casting machine

**Patentee:**

LORAMENDI, S.A.

**Opponent:**

DISA Industries A/S

**Headword:**

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**Relevant legal provisions:**

EPC Art. 113, 104(1)

EPC R. 103(1)(a)

**Relevant legal provisions (EPC 1973):**

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**Keyword:**

"Evidence provided in photocopies not in the original printed version"

"Decision refusing for this reason to take this evidence into account, despite an offer made in the notice of opposition to provide the original printed version"

"Apportionment of costs (no)"

"Violation of the right to be heard"

"Remittal of the case to the first instance without comment as to its merits"

"Reimbursement of appeal fee"

**Decisions cited:**

J 0007/82, T 0094/84, T 0135/96

**Catchword:**

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Case Number: T 1536/08 - 3.2.04

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.04  
of 12 August 2010

**Appellant:**  
(Opponent)

DISA Industries A/S  
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**Representative:**

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**Respondent:**  
(Patent Proprietor)

LORAMENDI, S.A.  
Poligono Industrial Ali-Gobeo  
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ES-01010 Vitoria (ES)

**Representative:**

Carpintero Lopez, Francisco  
Herrero & Asociados, S.L.  
Alcalá 35  
ES-28014 Madrid (ES)

**Decision under appeal:**

Decision of the Opposition Division of the  
European Patent Office posted 3 June 2008  
rejecting the opposition filed against European  
patent No. 1219830 pursuant to Article 101(2)  
EPC.

**Composition of the Board:**

**Chairman:** M. Ceyte  
**Members:** A. de Vries  
C. Heath

## **Summary of Facts and Submissions**

- I. The Appellant (Opponent) lodged an appeal, received 1 August 2008, against the decision of the Opposition Division posted 3 June 2008 to reject the opposition, and simultaneously paid the appeal fee. The statement setting out the grounds was received 8 October 2008.
- II. Opposition was filed against the patent as a whole and based on Article 100(a) together with Articles 52(1) and 54 EPC 1973, for lack of novelty in view of an alleged prior use substantiated inter alia by photocopies of pages of manuals O1 and O2 and a spare parts catalogue O3.
- III. The Opposition Division in a written communication of 8 June 2007 stated its provisional opinion that O1 to O3 represented the closest prior art.
- In its written decision the Division then decided not to consider O1 to O3 as prior art as no originals had been provided. As none of the remaining prior art prejudiced the maintenance of the patent as granted it rejected the opposition.
- IV. In a communication pursuant to Rule 100(2) EPC dated 7 August 2009 the Board informed the parties of its provisional opinion regarding apparent substantial procedural violations and the possibility of remittal of the case.
- V. The Appellant (Opponent) requests that the decision under appeal be set aside and the case be remitted to the department of first instance. As an auxiliary

request, it requests that the patent be revoked in its entirety.

The Respondent (Proprietor) also requests remittal as main request. This request was originally presented as fourth auxiliary request accompanied by a request to "preferably" apportion costs. In auxiliary requests the Respondent requests that the appeal be dismissed and the patent be maintained as granted, or, in the alternative, that it be maintained in a form according to first, second or third auxiliary requests filed with letter of 16 January 2010.

Both parties also request oral proceedings as a final auxiliary request.

## **Reasons for the Decision**

1. The appeal is admissible.
2. Substantial Procedural Violation.
  - 2.1 It is established jurisprudence of the Boards of Appeal, see inter alia J 7/82 (OJ EPO 1982, 391), T 94/84 (OJ EPO 1986, 337) and T 135/96, that the right to be heard enshrined in Article 113(1) EPC also guarantees the right to have relevant grounds that could potentially influence the outcome taken into account in the written decision. In the case of a decision rejecting the opposition, it must therefore take into account the ground(s) for opposition raised as well as facts and evidence put forward in support of these grounds, inter alia the cited prior art documents. Failure to consider

evidence will normally constitute a substantial procedural violation of this fundamental right as it deprives the party of the right to have its case fully heard.

2.2 In the opposition as filed the Appellant-Opponent rested his case squarely on O1 to O3 as evidence of prior art. This evidence was provided in the form of photocopies of the relevant pages. The notice of opposition, see page 5, second paragraph of section 5.3, however, stated: "The enclosed documents O1-O3 are copies from the original printed versions and if considered necessary original printed versions can be provided in a limited number (at least one), if considered necessary". This constitutes a clear and unmistakable offer to give evidence on the authenticity of O1 to O3 if this is "considered necessary". This conditional offer can only be read as meaning: if authenticity should become an issue.

2.3 In the subsequent procedure authenticity did indeed become an issue. After initially accepting O1 to O3 as closest prior art (see its communication under Article 101(2) and Rule 581(1) to (3) EPC, dated 8 June 2007, points 9 and 10), the opposition division in its written decision then decided otherwise. In reasons 3, it held that, "no proof was provided that the subsequent pages showing the technical details of the machines actually belong to the aforesaid manuals because the printing number is not mentioned on these pages. The Opponent didn't bring up an original bound manual either." For these reasons it decided that "O1 to O3, cannot be considered as prior art in the sense of Article 54(2)".

2.4 The decision to reject the opposition ultimately rests on the opposition division's negative finding regarding authenticity of O1 to O3. Had it admitted O1 to O3 the division would have needed to consider this prior art before it could have conclusively decided the case made against the patent based thereon.

However, the decision completely ignores the unambiguous offer by the opponent in the notice of opposition to provide the original printed versions of O1 to O3, see above.

Given the fact that the opponent's offer to provide the original printed versions was made in due time and that such evidence is central to the Appellant-Opponent's case - which could only be decided conclusively by considering O1 to O3 - the failure to consider this offer constitutes a violation of the right to be heard. As a result the first instance proceedings are fundamentally flawed and have been subject to a substantial procedural violation.

2.5 As the procedure leading to the decision under appeal is fundamentally deficient the Board is compelled to set the decision aside without any consideration of the merits of the appeal.

### 3. *Remittal and reimbursement of the appeal fee*

3.1 Article 11 of the Rules of Procedure of the Boards of Appeal provides for the remittal of the case to the department of first instance if a fundamental deficiency is apparent in the first instance

proceedings, unless special reasons present themselves for doing otherwise. The Board is unaware of any such reasons and in fact both parties request remittal as main request. It therefore decides to remit the case to the opposition division in order to procure and inspect the originals of documents 01 to 03 and in the light of such evidence to then decide the case on the basis of the remaining (auxiliary) requests. Such remittal shall be without prejudice to the merits of the case, nor does it abrogate the parties' right under Article 116 EPC to have their *complete* case heard at oral proceedings in accordance with their final auxiliary requests.

- 3.2 The violation of this fundamental procedural right has directly led the Appellant-Opponent to seek redress by lodging an appeal. For this reason the Board finds it equitable to reimburse the appeal fee in accordance with Rule 103(1)(a) EPC.

#### 4. Apportionment of Costs

The appeal is the direct result of the division's failure to procure evidence already offered by the Appellant-Opponent, rather than that it is due to a culpable error or oversight on the part of the latter. The Board therefore holds that a different apportionment of costs than provided for under Article 104(1) EPC is not equitable and refuses this request by the Respondent.



**Order**

**For these reasons it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be refunded.

The Registrar

The Chairman

G. Magouliotis

M. Ceyte