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**Datasheet for the decision
of 13 June 2012**

Case Number: T 1607/08 - 3.5.04

Application Number: 02012773.4

Publication Number: 1263234

IPC: H04N7/24, H04N7/26

Language of the proceedings: EN

Title of invention:

Method for arranging compressed video data for transmission
over a noisy communication channel

Patentee:

Thomson Licensing

Headword:

Relevant legal provisions:

EPC 1973 R. 60(2), 67

Keyword:

Principle of the protection of legitimate expectations

Decisions cited:

G 0005/88, G 0007/88, G 0008/88, G 0002/97, J 0027/94,
J 0014/95, J 0015/95, J 0016/95, J 0017/95, J 0024/95,
J 0025/95, T 0905/90

Catchword:

See section 2.



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Case Number: T 1607/08 - 3.5.04

D E C I S I O N
of the Technical Board of Appeal 3.5.04
of 13 June 2012

Appellant: Thomson Licensing
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Representative: Verhauwen, Axel
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 3 March 2008 revoking European patent No. 1263234 pursuant to Article 101(3) (b) EPC.**

Composition of the Board:

Chairman: F. Edlinger
Members: C. Kunzelmann
C. Vallet

Summary of Facts and Submissions

- I. The appeal is from the decision of the opposition division revoking European patent No. **1 263 234**, filed as European application No. **02 012 773.4**, which is a divisional application from European application No. **98 102 501.8**, itself a divisional application from application No. **93 911 321.3**, which had been filed as an International application and published as **WO 94/00952 A1**.

- II. A notice of opposition dated 15 November 2006 was filed by ODS Optical Disc Service GmbH, based on the grounds of Article 100(c) EPC 1973 and Article 100(a) EPC 1973 in conjunction with Articles 54 and 56 EPC 1973. The opponent requested that the patent be revoked in its entirety.

The notice of opposition was communicated to the patent proprietor pursuant to Rule 57(1) EPC 1973 by EPO Form 2317A dated 21 December 2006, setting a time limit of four months to file observations or amendments to the claims, description and drawings where appropriate.

- III. The opposition was withdrawn by a letter dated and received on 1 March 2007.

- IV. By a brief communication dated 19 March 2007, the EPO informed the patent proprietor of the withdrawal of the opposition, drawing attention to the provisions of Rule 60(2) EPC 1973.

- V. In a brief letter dated 20 March 2007, the patent proprietor, without commenting on the merits of the case, requested rejection of the opposition and maintenance of the patent as granted.

- VI. By decision dated 3 March 2008, the opposition division revoked the patent on the ground for opposition under Article 100(c) in conjunction with Article 76(1) EPC 1973.

The opposition division stated that it had continued the opposition proceedings of its own motion since the arguments submitted with respect to Article 100(c) EPC 1973 were such that the patent could be revoked without further assistance of the opponents. Concerning Article 100(c) EPC 1973, it set out that an essential feature of the invention, namely redundant transmission of critical data, was the main thrust of the whole earlier application and contained in all its independent claims, but was missing in the definition of the subject-matter of claim 1 of the contested patent as granted. The suppression of this essential feature extended the subject-matter of the patent beyond the content of the earlier application.

- VII. On 2 May 2008 the patent proprietor filed an appeal against this decision and paid the corresponding fee.

In the statement of grounds of appeal, filed in due time, the appellant presented arguments as to why the grounds for opposition were not well founded and did not prejudice the maintenance of the patent unamended. The appellant also suggested that interlocutory revision under Article 109 EPC 1973 be granted because the opposition division had not informed the patent proprietor of the continuation of the opposition proceedings contrary to what is set out in the Guidelines Part D, Chapter VII, points 6.2 and 6.3.

- VIII. In a letter dated 20 October 2008, the appellant submitted further observations as to why the patent proprietor's right to be heard under Article 113 EPC 1973 had been violated, essentially because the patent proprietor had a legitimate expectation that the opposition proceedings would not be continued *ex officio* without him being notified of the opposition division's intention to do so. The opposition division had thus committed a substantial procedural violation.
- IX. In a letter dated 14 May 2012, in response to the board's communication, the appellant filed supplementary comments on the procedural matters and new claims according to three auxiliary requests.
- X. Oral proceedings took place on 13 June 2012. The appellant requested that the decision under appeal be set aside and that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. Under the provisions of Rule 60(2) EPC 1973 the opposition proceedings may be continued by the EPO of its own motion in the event of the death or legal incapacity of an opponent. The same shall apply when the opposition is withdrawn.
- 1.1 The Guidelines (Part D, Chapter VII, point 6.2, last paragraph, of the December 2007 version) state that "[t]he proprietor of the patent and any other parties are to be informed that the proceedings will be continued. Otherwise the proceedings are closed and the decision to close the proceedings is communicated to the parties". This section of the Guidelines, published

before the date on which the decision under appeal was taken, refers to new Rule 84(2) EPC, which has the same wording as Rule 60(2) EPC 1973.

1.2 In the present case, the decision to revoke the contested patent was issued without any previous information being given to the patent proprietor as to the continuation of the proceedings which means that the opposition division did not follow the aforementioned provisions of the Guidelines, although it cannot be derived from the documents of the file what the reasons for departing from them were.

1.3 The appellant argued that acting in such a way amounted to a violation of the principle of the protection of legitimate expectations, which had led to a violation of his right to be heard (Article 113(1) EPC). In essence, the reasoning developed by the appellant is as follows:

- when the opponent withdrew his opposition the period of four months open to the patent proprietor to file observations and amendments, where appropriate, was still running;

- the then patent proprietor considered that this time limit had been annulled due to the withdrawal of the opposition; that was the reason why he sent, as a precautionary measure, only a brief letter by which he formally requested the maintenance of the patent as granted;

- he legitimately expected that the opposition division would first decide on the continuation or closure of the proceedings and would give him the opportunity to file observations in case of continuation;

- he could not expect that a decision revoking the patent would be issued about one year after the withdrawal of the opposition without any comments on his part on the merits of the grounds for opposition.

2. The principle of the protection of legitimate expectations, also referred to as the principle of good faith, generally recognised among the Contracting States, is also a well established principle in proceedings pursuant to the EPC. Its application to procedures before the EPO implies that measures taken by the EPO should not violate the reasonable expectations of the users of the European patent system (see the decisions of the Enlarged Board of Appeal G 5/88, G 7/88, G 8/88; G 2/97, OJ EPO 1999, 123, point 1 of the Reasons).

2.1 It is established case law that the Guidelines published by the EPO are one of the sources of legitimate expectations (T 905/90, OJ EPO 1994, 306, point 5 of the Reasons; followed in J 25/95, J 24/95, J 14/95, J 15/95, J 16/95, J 17/95; J 27/94, OJ EPO 1995, 831, point 5 of the Reasons).

Therefore, where the Guidelines give the clear indication that the continuation of the opposition proceedings has to be communicated to the patent proprietor, the latter is entitled to expect that such information will be given before a decision on the substantive issues is issued.

Otherwise, as in the present case, the decision to revoke the contested patent comes to the surprise of the patent proprietor.

2.2 Contrary to the principle applying to the boards of appeal, which are not bound by any instructions (Article 23(3) EPC), parties can expect the departments of first instance to follow the general instructions in the existing Guidelines, although a department of first instance may depart from them in exceptional cases (see the Guidelines, General Part, point 3.2).

The board considers that departing from the Guidelines in exceptional cases has to be justified by reasonable and clear grounds, such as particular circumstances which lead to a conflict with relevant legal provisions. Such grounds are not apparent in the present case since the Guidelines give a general instruction for the withdrawal of a sole opposition and Rule 60(2) EPC 1973 does not provide a clear basis for departing from this general instruction in the present case.

2.3 In the present case the failure to comply with the published instructions was the cause of the revocation of the patent in so far as the patent proprietor legitimately expected to be given an opportunity to present observations on the merits of the grounds for opposition after being informed of the continuation of the opposition proceedings.

2.4 It is true that the patent proprietor was given the opportunity to comment following the communication of the notice of opposition at the very beginning of the proceedings, a possibility he did not make use of during the four-month period. This opportunity was not curtailed by the communication of the withdrawal of the opposition. In particular, there is no justification for understanding that the period was cancelled, as considered by the appellant.

2.5 Nevertheless, the circumstances of the withdrawal explain why the patent proprietor did not consider it worth preparing an exhaustive answer before having received the information of the continuation of the opposition proceedings *ex officio*. In particular, there was only one opposition and its withdrawal occurred while the period for replying was still running, such that the withdrawal could have led to the termination of the opposition proceedings without the patent proprietor's comments as to the merits of the opposition. Moreover, the patent proprietor in the present case had not presented any requests for amendment of the patent and the Guidelines led him to believe that he would be informed whether the opposition proceedings would be continued.

2.6 In this situation, the patent proprietor's expectations were especially justified as the Guidelines (Part D, Chapter VII, point 6.2, second paragraph, of the December 2007 version) state that "[t]he Opposition Division should continue the proceedings if, for instance, the proprietor of the patent has submitted amendments to the patent in response to the notice of opposition ..." or "if it considers that the stage reached in the opposition proceedings is such that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent(s) concerned and without the Opposition Division itself having to undertake extensive investigations ...". In the present case, as already explained, the proceedings were in the very first stage and no amendment had been submitted in response to the notice of opposition.

- 2.7 The patent proprietor's letter dated 20 March 2007, despite its brevity and laconic nature, was clear as to the patent proprietor's requests. Even if the opposition division had considered that the patent proprietor had no interest any more in the maintenance of the patent, such an assumption did not relieve the opposition division of its duty to communicate its intention to continue the proceedings, and thereby clarify the procedural situation. Such a communication would have given the patent proprietor an opportunity to react (which, in the present case, would have been a further opportunity, see point 2.4 above).
3. Thus, the revocation of the patent is the direct consequence of the procedural violation of the principle of the protection of legitimate expectations. In the present case, in which this violation led to the decision to revoke the contested patent and came to the surprise of the patent proprietor, this constitutes a substantial procedural violation.
- 3.1 Consequently, the contested decision is to be set aside and the case remitted to the department of first instance for further prosecution (Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA), OJ EPO 2007, 536).
4. In accordance with the provisions of Rule 67 EPC 1973 the board considers it equitable, on account of the circumstances set out above, to order the reimbursement of the appeal fee.

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 reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



K. Boelicke

F. Edlinger

Decision electronically authenticated