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**Datasheet for the decision
of 9 November 2011**

Case Number: T 1687/08 - 3.5.02
Application Number: 03100087.0
Publication Number: 1304704
IPC: H01B 3/20, H01F 27/12
Language of the proceedings: EN

Title of invention:
Vegetable oil based dielectric coolant

Patent Proprietor:
Cooper Industries, Inc.

Opponent:
ABB AB

Headword:
-

Relevant legal provisions:
EPC Art. 134(8)
EPC R. 103(1)(a)
RPBA Art. 11

Keyword:
"Legal practitioner"
"Substantial procedural violation (yes)"
"Remittal to first instance (yes)"
"Reimbursement of appeal fee (yes)"

Decisions cited:
-

Catchword:
-



Case Number: T 1687/08 - 3.5.02

D E C I S I O N
of the Technical Board of Appeal 3.5.02
of 9 November 2011

Appellant: Cooper Industries, Inc.
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Respondent: ABB AB
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 24 June 2008
revoking European patent No. 1304704 pursuant
to Article 101(3)(b) EPC.

Composition of the Board:

Chairman: M. Ruggiu
Members: R. Lord
P. Mühlens

Summary of Facts and Submissions

- I. This is an appeal of the proprietor against the decision of the opposition division to revoke European patent No. 1 304 704.
- II. During the course of the procedure before the opposition division, the division issued a summons to oral proceedings, dated 16 July 2007, in which the date set under Rule 71a EPC 1973 was 21 December 2007. The representative of the patent proprietor filed a letter dated 16 January 2008 (received at the European Patent Office on 17 January 2008) and headed "Substitute Authorisation", in which he stated that he authorised Mr Gerd Jaekel to represent the patent proprietor at the oral proceedings, referring to Mr Jaekel's entitlement to represent under Article 134(8) EPC. Oral proceedings before the opposition division took place on 25 February 2008, at which, in addition to taking the decision as indicated above, the division refused to allow Mr Jaekel to speak, in which context they referred to the date set under Rule 71a EPC 1973 and to the fact that the letter dated 16 January 2008 was not in their file.
- III. Oral proceedings before the board took place on 9 November 2011.

The appellant (patent proprietor) requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution. If that was not possible, he requested that the decision under appeal be set aside and that the patent be maintained in amended form on

the basis of the set of claims of the main request or of one of the sets of claims in accordance with the first to fourteenth auxiliary requests, all filed with letter of 27 October 2008. The appellant further requested that the appeal fee be reimbursed.

The respondent (opponent) requested that the appeal be dismissed.

IV. The appellant essentially argued as follows:

At the oral proceedings held on 25 February 2008 the opposition division incorrectly refused Mr Jaekel permission to speak, because they considered him as an accompanying person, and therefore applied the conditions set down in decision G 4/95. That decision was not relevant, because Mr Jaekel was authorised to represent the patent proprietor as a legal practitioner according to Article 134(8) EPC. Moreover, the division had given the patent proprietor no opportunity to resolve these issues. The decision not to allow Mr Jaekel to speak had therefore denied the patent proprietor his right to representation, which thus constituted a substantial procedural violation, which in turn justified immediate remittal of the case to the department of first instance and reimbursement of the appeal fee.

The patent proprietor's letter of 16 January 2008 was a valid authorisation according to Article 134(8) EPC, satisfying the requirements of that article and of the Decision of the President of the European Patent Office referred to in the summons to oral proceedings.

Mr Brunner, the representative who had signed that

letter, had a general authorisation from the patent proprietor, with power to sub-authorise. As indicated in that letter, Mr Jaekel was a Rechtsanwalt entitled to carry out representation under Article 134(8) EPC. The date set under Rule 71a EPC 1973 was not relevant for authorisations, nor were there any further requirements for such an authorisation beyond those stated in Article 2 of the cited decision of the President of the European Patent Office. In any case, such potential requirements were not relevant, because the opposition division had not considered the question of whether or not Mr Jaekel was properly authorised to carry out representation under Article 134(8) EPC.

The question as to whether or not Mr Jaekel's submissions might have altered the substantive outcome of the procedure was irrelevant to the issue of whether the opposition division's decision to deny him the right to speak at the oral proceedings was a substantial procedural violation, because that question was purely a matter of speculation.

- V. The arguments of the respondent in so far as they are relevant for the present decision can be summarised as follows:

The decision of the opposition division not to allow Mr Jaekel to speak was not a substantial procedural violation because the letter of 16 January 2008 did not meet the established requirements for such an authorisation, firstly because the letter of authorisation was filed after the date set in the summons to oral proceedings under Rule 71a EPC 1973, and secondly because no proof was provided of

Mr Jaekel's entitlement to carry out representation under Article 134(8) EPC. In the context of the latter point, the decision J 27/95 (not published in OJ) established the requirement for such proof. That the date set under Rule 71a EPC 1973 was applicable was apparent both from the fact that in the summons (EPO Form 2310 08.02) the mention of this date followed immediately after the mention of the Decision of the President of the European Patent Office concerning authorisations, and from the fact that the requirement of Article 2 of that decision for the setting of a period for providing an authorisation and for this to be checked implies that some sort of time limit must be applied.

Even if there had been a procedural violation, it was not a substantive one, because Mr Jaekel's submissions would not have changed the outcome of the procedure, as was evident from the fact that in the oral proceedings before the opposition division held on the day after those for the present case, which concerned a patent granted on the basis of a divisional application from the application which was the basis for the patent in suit, similar issues were discussed under Articles 76(1) and 123(2) EPC, in particular the question relating to the definition of the heat capacity of the oils, and the same conclusion was reached despite the fact that in that case Mr Jaekel had been allowed to speak.

Reasons for the Decision

1. The appeal is admissible.

2. At the oral proceedings held before the opposition division on 25 February 2008, the division refused Mr Gerd Jaekel permission to speak on behalf of the patent proprietor (now appellant).
 - 2.1 The requirements for representation by a legal practitioner are defined in Article 134(8) EPC and in Article 2 of the Decision of the President of the European Patent Office dated 19 July 1991 on the filing of authorisations (OJ EPO 9/1991, 489), as cited in the summons to oral proceedings issued by the opposition division (in EPO Form 2310). With the exception of renumbering of Articles and Rules, this decision is equivalent to the decision dated 12 July 2007 (OJ EPO 2007, Special edition No. 3, 128), which entered into force on 13 December 2007, i.e. between the date when the summons to oral proceedings was issued and the date when the authorisation of Mr Jaekel was filed. Article 134(8) EPC requires that the legal practitioner be qualified in a Contracting State, that he have his place of business in that State, and that he be entitled in that State to act as a professional representative in patent matters. The first sentence of Article 2 of the cited decision of the President of the European Patent Office requires additionally that the legal practitioner file either a signed authorisation or a reference to a general authorisation already on file. The letter from the representative of the patent proprietor dated 16 January 2008, headed "Substitute Authorisation" contained an authorisation for Mr Jaekel

to represent the patent proprietor in accordance with Article 134(8) EPC. This letter indicated the address of Mr Jaekel's place of business in Germany and his status as a Rechtsanwalt entitled to carry out representation as a legal practitioner within the meaning of Article 134(8) EPC, and was signed by the patent proprietor's authorised representative, Mr Brunner. The board therefore concludes that this letter represents an authorisation which establishes that Mr Jaekel was entitled under Article 134(8) EPC to carry out representation and which fulfils the requirements of the first sentence of Article 2 of the cited decision of the President of the European Patent Office.

2.2 From the minutes of the oral proceedings of 25 February 2008 and the decision under appeal, it is apparent that the opposition division did not consider Mr Jaekel's status as a legal practitioner under Article 134(8) EPC, at least in part because they did not have the letter of 16 January 2008 in their (paper) file. Instead, they treated Mr Jaekel as an accompanying person, and therefore applied the requirements set out in decision G 4/95 (OJ EPO 1996, 412). In particular they based their refusal to allow Mr Jaekel to speak on the failure of the patent proprietor to announce his intention that Mr Jaekel should be able to make oral submissions before the date set in the summons to oral proceedings pursuant to Rule 71a EPC 1973 (i.e. 21 December 2007).

2.3 Since the patent proprietor requested Mr Jaekel's participation in the oral proceedings as a legal practitioner under Article 134(8) EPC, not as an

accompanying person within the meaning of decision G 4/95, the division's decision not to allow him to speak was taken under the wrong legal provision. Moreover, since for the reasons indicated in paragraph 2.1 above, Mr Jaekel was entitled under Article 134(8) EPC to represent the patent proprietor, the outcome of that decision, i.e. not allowing Mr Jaekel to speak, was incorrect. The board thus concludes that the opposition division denied the patent proprietor his right to be represented in the manner he chose. Such a denial of the right of representation has to be considered as a substantial procedural violation.

- 2.4 The respondent's arguments in this respect are not found convincing for the following reasons.
 - 2.4.1 In his written submissions (see his letter of 4 October 2011), the respondent questioned whether Mr Brunner had had the power of sub-authorisation when filing the letter of 16 January 2008. However, during the oral proceedings before the board, the representative of the appellant stated that he had a general authorisation from the appellant dating back to 18 August 1997, which included the right to sub-authorise. The appellant did not challenge that statement, and the board has no reason to doubt its correctness.
 - 2.4.2 The respondent has also argued that the authorisation in the letter of 16 January 2008 was late-filed, because Rule 71a EPC 1973 was applicable to the filing of authorisations, as was clear from the fact that in the summons to oral proceedings issued by the opposition division, the reference to the decision of the President of the EPO concerning authorisation of

legal practitioners was immediately followed by the indication of the date set under Rule 71a EPC 1973, and because it is clear from the requirement in the second sentence of the cited Article in that decision, that some form of time limit is necessary to allow the filing and checking of such authorisations. The board does not consider this issue to be relevant to the present case, since from the minutes of the oral proceedings of 25 February 2008 and the decision under appeal, it is apparent that the opposition division did not consider whether Mr Jaekel was duly authorised under Article 134(8) EPC. Had they considered that question, and concluded that they had doubts on this matter, they would have been obliged to give the patent proprietor the opportunity to address those doubts, but since they do not seem to have addressed that issue at all, the question did not arise. Moreover, the board notes firstly that Rule 71a(1) EPC 1973 concerned only the filing of "written submissions" and "facts and evidence", but that authorisations do not fall into either of these categories, and secondly that since, as indicated in paragraph 2.1 above, the letter of 16 January 2008 satisfies the requirements of the first sentence of Article 2 of the cited decision of the President of the European Patent Office, the second sentence of that article, referring to the practitioner being required to file an authorisation within a period to be specified by the European Patent Office, is not applicable.

- 2.4.3 Finally, the respondent argued that, even if the decision of the opposition division not to allow Mr Jaekel to speak were to be considered as a procedural violation, it did not represent a

substantial procedural violation which would justify immediate remittal to the department of first instance, because a procedural violation could only be considered to be substantial if it had an effect on the outcome of the procedure. He argued further that in the present case that requirement was not satisfied, because it was apparent from the outcome of the oral proceedings held on 26 February 2008 concerning the patent granted on a divisional application from the application on which the patent in suit is based, in which the issues were similar, and at which Mr Jaekel had been allowed to speak, the outcome was the same. The board is not convinced by this line of argumentation, because any conclusions as to what might have happened at the oral proceedings in the present case had Mr Jaekel been allowed to speak are merely speculation, regardless of the outcome of the related oral proceedings held the next day.

- 2.5 The board therefore concludes that the decision of the opposition division not to allow Mr Jaekel to speak at the oral proceedings of 25 February 2008 represents a substantial procedural violation.

3. In the light of this conclusion, the board considers it appropriate to follow the appellant's request to remit the case to the department of first instance for further prosecution, in accordance with Article 11 of the Rules of Procedure of the Boards of Appeal, and to order the reimbursement of the appeal fee, in accordance with Rule 103(1)(a) EPC.

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 reimbursed.

The Registrar:

The Chairman:

C. Moser

M. Ruggiu