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**Datasheet for the decision
of 21 November 2014**

Case Number: T 0285/11 - 3.3.10

Application Number: 03021191.6

Publication Number: 1408029

IPC: C07C319/18

Language of the proceedings: EN

Title of invention:

Continuous method for producing 3-methylthiopropenal

Patent Proprietor:

Sumitomo Chemical Company, Limited

Opponent:

Evonik Degussa GmbH

Headword:

EVONIK DEGUSSA / SUMITOMO CHEMICAL COMPANY

Relevant legal provisions:

EPC Art. 19(2), 111(1), 112(1) (a)

Keyword:

Wrong composition of Opposition Division -
Substantial procedural violation (yes)
Remittal to the department of first instance (yes)
Reimbursement of the appeal fee (yes)
Referral to the Enlarged Board of Appeal (no)

Decisions cited:

G 0005/91, R 0021/11, T 0251/88, T 0835/90, T 0939/91,
T 0382/92, T 0433/93, T 0476/95, T 0611/01, T 0400/02,
T 0838/02

Catchword:



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Case Number: T 0285/11 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 21 November 2014

Appellant:
(Opponent)

Evonik Degussa GmbH
Rellinghauser Strasse 1-11
45128 Essen (DE)

Representative:

Godemeyer Blum Lenze - werkpatent
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Respondent:
(Patent Proprietor)

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Tokyo 104-8260 (JP)

Representative:

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Decision under appeal:

**Decision of the Opposition Division of the
European Patent Office posted on 1 December 2010
rejecting the opposition filed against European
patent No. 1408029 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman: P. Gryczka
Members: C. Komenda
D. Rogers

Summary of Facts and Submissions

- I. European patent No. 1 408 029 was granted on the basis of European patent application No 03 021 191.6. The mention of the grant of the patent was published on 22. November 2006. The decision to grant the patent was signed, *inter alia*, by Mr. R. as first examiner and by Mr. H. as second examiner.
- II. In its decision posted on 1st December 2010, the Opposition Division rejected the opposition. The decision was again signed by Mr. R. as first examiner and by Mr. H. as second examiner.
- III. On 27 January 2011 the Appellant (Opponent) filed an appeal and paid the appeal fee. The statement of the grounds for appeal was filed on 6 April 2011.
- IV. In a communication posted on 13. February 2012, the Board observed that the composition of the Opposition Division did not comply with the requirements of Article 19(2) EPC, since two members of the Opposition Division have taken part in the proceedings for the grant of the European patent to which the opposition relates. The Board indicated that it intended to remit the case to the department of first instance and to reimburse the appeal fee because the faulty constitution of the Opposition Division was a substantial procedural violation.
- V. In its letters dated 12 April 2012 and 10 July 2012 the Appellant requested that if the case were remitted to the department of first instance the Board should order that all of the members of the Opposition Division, who contributed to the decision under appeal, be replaced. He argued that he did not wish to be placed at a

possible disadvantage by the involvement of the other members of the initially appointed Division who have already made up their minds in the previous opposition proceedings. If the case were remitted to an Opposition Division, wherein members of the previous Opposition Division participated again, these members would be influenced by their previous decision and a fair and unbiased treatment of the case would no longer be possible. In referring to decisions T 251/88, T 433/93, T 611/01 and T 400/02 he pointed out that for the same situation the Boards have taken diverging decisions. This situation of conflicting case law should lead to the referral of questions to the Enlarged Board of Appeal in order to ensure uniform application of law. The Appellant, therefore, requested during the oral proceedings before the Board on 21 November 2014 that the following questions, submitted as document "Fragen GBK", be referred to the Enlarged Board of Appeal:

"1.

Ist eine BK befugt, bei einer Zurückverweisung anzuordnen, dass Mitglieder der Prüfungsabteilung oder Einspruchsabteilung, die mit dem Fall befasst waren, ersetzt werden sollen, wenn im Verfahren vor der 1. Instanz ein schwerwiegender Verfahrensfehler begangen wurde?

2. Wenn ja,

gilt dies bei allen schwerwiegenden Verfahrensfehlern oder ist das eine Ermessensentscheidung im Einzelfall?

3.

Wenn es eine Ermessensentscheidung im Einzelfall ist, nach welchen Kriterien ist dieses Ermessen auszuüben?"

- VI. In its letter of 23 April 2012 the Respondent (Patent Proprietor) stated that it did not maintain its request for oral proceedings should the Board remit the case to the department of first instance. Further, it argued that the participation of members of the previous Opposition Division in the repeated opposition proceedings did not relate to an unfair treatment of the parties. Even if members of the previous Opposition Division might be influenced by their previous opinion on the technical issues, this would not constitute partial behaviour, since deciding on technical issues was part of an examiners work. The case law cited by the Appellant did not constitute a conflicting case law, because it did not relate to the same situation, but to cases of substantial procedural violation based on different Articles of the EPC. Further, the responses to the questions referred to in document "Fragen GBK" would not provide any guidance for the decision to be taken in the present case. Therefore, a referral of the questions to the Enlarged Board of Appeal did not appear appropriate.
- VII. The Appellant requested as a main request that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution with the order that all members of the Opposition Division be replaced, and as an auxiliary request, that the questions filed at the oral proceedings before the Board on 21 November 2014 in the document "Fragen GBK" be submitted to the Enlarged Board of Appeal. The Appellant further requested that the appeal fee be reimbursed.
- VIII. The Respondent requested that the case be remitted to the Opposition Division for further prosecution.

IX. At the end of the oral proceedings the decision of the Board was announced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. Under Article 19(2) EPC, "[a]n Opposition Division shall consist of three technically qualified examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent may not be the Chairman."

3. In the present case, the first member and the second member of the Opposition Division had taken part as first and second members, respectively, in the proceedings for the grant of the opposed patent when they signed the communication dated 24 May 2006, which established the text of the patent to be granted. For this reason, the composition of the Opposition Division violated Article 19(2), second sentence, EPC.

4. Violations of Article 19(2) EPC are substantial procedural violations which lead to a remittal of the case under Article 111(1) EPC and to the reimbursement of the appeal fee (see decisions T 251/88, T 939/91, T 382/92, T 476/95, T 838/02, none of them published in the OJ EPO).

5. The decision under appeal therefore has to be set aside and the case has to be remitted to the department of first instance. The appeal fee has to be reimbursed.

6. *Replacement of all members of the Opposition Division*

6.1 According to its main request the Appellant requested that upon remittal to the department of first instance the Board should order that all members of the Opposition Division, who contributed to the decision under appeal, should be replaced. The reason being that he did not wish to be placed at a possible disadvantage by the involvement of the other members of the initially appointed Division, who might be influenced by their previously taken decision. This would no longer allow a fair and unbiased treatment of the case.

6.2 The Appellant has cited various cases supporting its position that the Board should order the replacement of all members of the Opposition Division upon remittal of the case.

Only one of the cited cases, T 251/88, concerns a wrongly constituted Opposition Division under Article 19(2) EPC. The other cited decisions concern various other types of substantial procedural violations. The Board finds decision T 251/88 of little assistance as no reasons are given as to why the Board in this case ordered the replacement of all members of the Opposition Division upon remittal of the case.

6.3 The decision to order the replacement of all members of the Opposition Division upon remittal of the case, involves the exercise of the Board's discretion in such a matter (see G 5/91, point 6, OJ 1992, 617). The exercise of its discretion necessarily involves a

consideration of the particular facts of the case in question; hence the nature of the substantial procedural violation in question needs to be taken into account.

6.4 The Board notes that in all the cases cited by the Appellant, (except for T 251/88), the substantial procedural violations in issue were linked to various irregularities in the conduct of the proceedings which could be traced back to the way the actual members of the first instance department in question chose to conduct the proceedings. In the present case, the substantial procedural violation in question, the non-compliance of the composition of the Opposition Division with Article 19(2) EPC, was not due to actions taken by the members of the division but by their director exercising delegated powers under Article 10(2) (a) and (i) EPC.

6.5 The Board further notes that if it simply remits the case to the department of first instance, this leaves open the possibility that one, or two members of the Opposition Division will have been members of the Opposition Division that took the decision currently under appeal. In T 433/93 (OJ 1997, 509, see also R 21/11) and T 611/01 it was accepted that a new composition could be ordered if otherwise the same question would be considered before the first instance department in the same composition for a second time. In T 433/93 the Board found that if a party had grounds to suspect that the Opposition Division in the same composition would have difficulty re-hearing and dealing with the case without being tainted by its previous decision, then the Board should order a re-hearing with a new composition.

- 6.6 If the Board is to actually have any discretion to exercise, the mere existence of such a suspicion in the mind of a party cannot automatically oblige the Board to order remittal upon the basis of an entirely new composition of the first instance department. Hence such a suspicion must be one that a reasonable party would entertain given the objective facts of the case. In other words would the notional reasonable party consider under the facts of the case that the members of the first instance department would be "tainted" by their previous decision?
- 6.7 The Board noted that Article 14 of the Service Regulations provides that officials of the office are to exercise their duties and conduct themselves with only the interests of the EPO in mind. In the context of this case this means that members of the Opposition Division will apply the relevant provisions of the EPC in an impartial manner. Thus a rebuttable presumption exists that officials take their obligations under the Service Regulations seriously. If a party is able to show that a member of the Opposition Division has, by his conduct, demonstrated that the necessary impartiality is lacking, then he may be replaced.
- 6.8 The Board has not been presented with any evidence or arguments that the proceedings before the Opposition Division were conducted by the members in an irregular way. Thus, on the facts of this case, the Board concludes that a party would have no objective grounds to suspect that the members of the Opposition Division would not observe the obligation of impartiality under the Service Regulations if called upon to re-hear the case. Hence the Board is not minded to order the remittal of this case to an Opposition Division with a completely new composition.

Auxiliary request

7. *Referral of questions to the Enlarged Board of Appeal (Article 112(1) (a) EPC)*

7.1 The Appellant argued that in the decisions T 251/88, T 611/02 and T 433/93 the Boards found that a substantial procedural violation has occurred and decided to order replacement of all members of the previous Opposition or Examining Divisions, whereas in decision T 400/02, which related to the same situation, the Board explicitly did not order the replacement of all members. This finding amounted to a situation of conflicting case law. In order to ensure uniform application of law it required that the questions submitted as document "Fragen GBK" (see paragraph V. *supra*) be submitted to the Enlarged Board of Appeal.

7.2 However, the decisions referred to by the Appellant do not relate to the same legal situation, but concerned cases of substantial procedural violation, which were based on different regulations of the EPC, namely Article 19(2) EPC in case of decision T 251/88 and violation of the right to be heard (Article 113(1) EPC) in case of the decisions T 400/02, T 433/93 and T 611/01. Therefore, the Board does not consider that there is conflicting case law, which could justify the referral of questions to the Enlarged Board of Appeal.

7.3 Further, the questions in document "Fragen GBK" (see paragraph V. *supra*) relate to

whether a Board of Appeal has the power to order replacement of members of an Examining or

Opposition Division in case of a substantial procedural violation (question 1),

if the answer to question 1 is affirmative, to whether it is within the discretionary power of the Boards to order replacement of members of Examining or Opposition Divisions in all cases of substantial procedural violation (question 2) and

to which criteria have to be applied when exercising its discretionary power in this respect (question 3).

- 7.4 Irrespective of how the answers to these questions could read, they appear to be of no relevance to the decision to be taken in the present case (see paragraph 5 *supra*). Therefore, the questions in document "Fragen GBK" reflect a purely theoretical interest in clarifying points of law which do not justify a referral to the Enlarged Board of Appeal (see T 835/90).

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 before an Opposition Division constituted in accordance with Article 19(2) EPC.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated