

Internal distribution code:

- (A) [-] Publication in OJ
(B) [-] To Chairmen and Members
(C) [-] To Chairmen
(D) [X] No distribution

**Datasheet for the decision
of 22 April 2015**

Case Number: T 1027/13 - 3.3.06

Application Number: 07727742.4

Publication Number: 2029711

IPC: C11D1/74, C11D3/00

Language of the proceedings: EN

Title of invention:

COMPOSITION WHICH CONTAINS A MIXTURE OF MONO-, DI-, AND TRIGLYCERIDES AND GLYCERINE

Patent Proprietor:

KAO CORPORATION, S.A.

Opponent:

Evonik Degussa GmbH

Headword:

Glycerides mixture/KAO CORPORATION S.A.

Relevant legal provisions:

EPC Art. 111(1), 113(1), 116(1), 133, 134

Keyword:

Fundamental procedural defect - (yes)
Reimbursement of appeal fee - (yes)
Remittal to the department of first instance - (yes)

Decisions cited:

G 0004/95

Catchword:



**Beschwerdekammern
Boards of Appeal
Chambres de recours**

European Patent Office
D-80298 MUNICH
GERMANY
Tel. +49 (0) 89 2399-0
Fax +49 (0) 89 2399-4465

Case Number: T 1027/13 - 3.3.06

**D E C I S I O N
of Technical Board of Appeal 3.3.06
of 22 April 2015**

Appellant: Evonik Degussa GmbH
(Opponent) Rellinghauserstrasse 1-11
45128 Essen (DE)

Representative: Evonik Industries AG
CI-IPM-PAT
Bau 1042 / PB 15
Paul-Baumann-Straße 1
45772 Marl (DE)

Respondent: KAO CORPORATION, S.A.
(Patent Proprietor) Puig dels Tudons 10
Centre Industrial Santiga
08210 Barbera del Vallés - Barcelona (ES)

Representative: ABG Patentes, S.L.
Avenida de Burgos, 16D
Edificio Euromor
28036 Madrid (ES)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 February 2013
rejecting the opposition filed against European
patent No. 2029711 pursuant to Article 101(2)
EPC.**

Composition of the Board:

Chairman B. Czech
Members: G. Santavicca
J. Geschwind

Summary of Facts and Submissions

- I. The appeal lies from the decision of the Opposition Division rejecting the opposition against European patent 2 029 711.
- II. In the decision under appeal, the Opposition Division *inter alia* came to the conclusion that the grounds of opposition raised did not prejudice maintenance of the patent as granted.
- III. In its notice of appeal, the Appellant (Opponent) submitted that a substantial procedural violation had occurred during the oral proceedings before the Opposition Division (hereinafter "first instance oral proceedings"). Hence, the appeal fee had to be reimbursed and the case had to be remitted to the department of first instance, with the order that oral proceedings be held once more before the Opposition Division, but in a different composition.

In its statement setting out the grounds of appeal, the Appellant expanded on the alleged substantial procedural violation but also maintained that the patent had to be revoked on the grounds of Article 100(a) and (b) EPC.

- IV. In its reply, the Patent proprietor (Respondent) submitted that no substantial procedural violation had occurred during the first instance oral proceedings and rebutted all the substantive objections of the Appellant.
- V. The parties were summoned to oral proceedings. In a communication issued in preparation for the oral proceedings, the Board commented on certain aspects of

the case and expressed its preliminary opinion that no substantial procedural violation had occurred and that it was thus not inclined to remit the case on this ground alone. The Board also considered that hearing either the members of the Opposition Division or the parties' respective representatives was neither necessary nor expedient.

VI. Oral proceedings were held on 22 April 2014.

The debate essentially focused on the question of whether a substantial procedural violation had occurred during the first instance oral proceedings.

VII. The Appellant (Opponent) requested:

- that the decision under appeal be set aside,
- that the case be remitted to the department of first instance in a different composition to hold new oral proceedings,
- to order the reimbursement of the appeal fee or, in the alternative,
- that the patent be revoked.

The Respondent (Patent Proprietor) requested that the appeal be dismissed.

VIII. The arguments of the parties of relevance for the present decision can be summarised as follows.

The **Appellant** submitted that the fact that at the first instance oral proceedings the Chairman of the Opposition Division had categorically forbidden Mr Herrmann, present as accompanying person announced in time, to address the Board and to communicate with its authorised representative Mr Wolf, amounted to a serious procedural violation justifying setting aside

the decision negatively affecting it, the remittal of the case and the reimbursement of the appeal fee. More particularly, its right to fair proceedings and its right to be heard had been breached. In particular, it submitted in this respect that the Opposition Division had obviously merely based itself on an assessment of the entitlement of Mr Herrmann to represent pursuant to Article 133 and 134 EPC, without giving proper consideration to the criteria of decision G 4/95 of the Enlarged Board of Appeal, as regards the request submitted by the Opponent concerning oral submissions to be made by Mr Herrmann solely as an accompanying person. Prompted by the Board at the oral proceedings, the Appellant indicated that Mr Wolf had been sufficiently prepared and able to represent the Opponent at the first instance oral proceedings and had not, therefore, considered requesting a postponement thereof, taking also into account that it had been convinced that its procedural rights had been clearly breached, since the Opposition Division had not correctly exercised its discretion on the basis of the criteria established in G 4/95.

The **Respondent** (Patent Proprietor) submitted that no procedural violation had occurred, but that the Opposition Division had correctly exercised its discretion according to the principles established in G 4/95. At the first instance oral proceedings, Mr Herrmann had been trying to actually dictate (by whispering) the complete speech, in particular the argumentation, to Mr Wolf. It had thus been clear that considering the short period of time between his appointment and the oral proceedings, Mr Wolf had not been prepared to make a complete presentation of the case, to be supplemented by some oral submissions of Mr Herrmann under its continuing control. This was also

apparent from the fact that Mr Wolf then merely referred to the written submissions as regards the substance of the case (Points 3, 4 and 5 of the minutes of the first instance oral proceedings).

The Opponent had neither requested an interruption of the debate nor a postponement of the oral proceedings. Instead, in effect, Mr Herrmann had been trying to make a complete presentation of the case in lieu of the authorised representative of the Opponent. This clearly ran counter to the provisions of Articles 133 and 134 EPC in the light of G 4/95. As regards the criteria established in G 4/95, the Respondent argued that the mere request for allowing oral submissions by Mr Herrmann ("das Wort zu erteilen") did not amount to an indication of the subject-matter of the proposed oral submissions. The intention had obviously been that Mr Herrmann would present the entire case on behalf of the authorised representative. Such a course of action was, however, expressly prohibited according to G 4/95 (Reasons, Point 8(b), first paragraph). However, prompted by the Board at the oral proceedings, the Respondent expressly confirmed that at the first instance oral proceedings Mr Wolf had not expressly stated that he was not prepared to present the case, but that this could be derived from Mr Wolf's behaviour during the oral proceedings.

Considering the circumstances of the case, no procedural error had occurred as regards the Opponent's right to fair proceedings and its right to be heard. Hence, there was no reason to remit the case to the department of first instance. A remittal would be to the sole detriment of the Respondent, who would have to bear the consequences of the inappropriate, if not tactically abusive, behaviour of the Opponent's representation at the first instance oral proceedings.

Reasons for the Decision

1. The appeal is admissible. This was not in dispute.
2. At the oral proceedings before the Board, it was common ground that Mr Herrmann had not been entitled to represent the Opponent pursuant to Articles 133 and 134 EPC at the oral proceedings before the Opposition Division (hereinafter "first instance oral proceedings").
 - 2.1 The status of Mr Herrmann on the day of the first instance oral proceedings had thus been that of an "accompanying person" (within the meaning of G 4/95).
 - 2.2 It is not in dispute that during the first instance oral proceedings, the Chairman of the Opposition Division had neither allowed Mr Herrmann to make oral submissions addressing the Opposition Division, nor tolerated Mr Herrmann's attempts to communicate with the authorised representative Mr Wolf, be it by whispering or handing over writs (cf. e.g. the statement of grounds, page 3/28, antepenultimate and penultimate full paragraphs; reply of the Respondent of 18 October 2013, page 2, penultimate paragraph, page 3, first paragraph).
3. As established in decision G 4/95 (see Order, 3a), oral submissions by a person accompanying the professional representative of a party can only be made "*with the permission of and under the discretion of the EPO*". G 4/95 (Order, 4b) lists the following four "*main criteria*" i) to iv) to be considered when exercising this discretion (emphasis added):

"(i) The professional representative should request permission for such oral submissions to be made. The request should state the **name and qualifications of the accompanying person, and should specify the subject-matter of the proposed oral submissions.**

(ii) The request should be made **sufficiently in advance** of the oral proceedings so that all opposing parties are able properly to prepare themselves in relation to the proposed oral submissions.

(iii) A request which is made shortly before or at the oral proceedings should in the absence of exceptional circumstances be refused, unless each opposing party agrees to the making of the oral submissions requested.

(iv) The EPO should be satisfied that oral submissions by an accompanying person are made **under the continuing responsibility and control of the professional representative**".

4. Concerning the categorical refusal to allow Mr Herrmann to speak and to communicate with the authorised representative

4.1 By letters of 20 September (Point 1) and 21 September 2012, i.e. two months before the date of the first instance oral proceedings, the Opponent had requested permission for Mr Herrmann to make oral submissions at these oral proceedings under the continuing control of the (then) authorised representative (Mr Wins). From the minutes of the first instance oral proceedings including annexes, it can be gathered that Mr Wins had subsequently fallen ill, shortly before the day of the oral proceedings, and that the Opponent had thereupon authorised Mr Wolf to represent it in the case at issue.

4.2 Regarding criteria i) and ii) of G 4/95, it had not

been and still is not in dispute, that said request had been filed sufficiently in advance, indicating the name and the qualifications of Mr Herrmann. In particular, it had been indicated in the letter of 20 September 2012 (cf. Point "1. Redeanträge") that Mr Herrmann had been in charge of the opposition on the side of the Opponent since its very beginning. The Board moreover observes with regard to criterion i) of G 4/95 that the Opponent had expressly announced in its letter of 20 September 2012 (page 1/32, last paragraph) that Mr Herrmann would make oral submissions regarding the relevant legal and technical issues in dispute, which are addressed in great detail in the same letter. The Board thus holds that it could be reasonably expected that these issues would constitute the subject-matter of the proposed oral submissions by Mr Herrmann.

4.3 The Board notes that according to the minutes of the first instance oral proceedings (Point 1, second sentence) "The **Proprietor's representative argued** that Mr Herrmann **was only allowed** to present technical subject-matter" (emphasis added by the Board). The Board observes also that none of the parties requested correction of these minutes. Hence, it appears that the event the Proprietor had not, at least initially, considered that Mr Herrmann should not be allowed to speak at all. In any case, it cannot be gathered from the minutes of the first instance oral proceedings that the criteria of G 4/95 had actually been considered by the Opposition Division in deciding not to let Mr Herrmann speak at all at said oral proceedings.

4.4 However, in the written decision under appeal (Facts and Submissions, point VIII) the Opposition Division states "*Mr Wolf declared that he received the case in a short notice, he studied it very quickly and he is not*

prepared to defend the case ... [and] that, Dr. Lutz Herrmann, the expert of the case, will present the legal and technical matters of the case as specified in letter dated 20-09-2012". The Opposition Division also states that "[t]he patentee contested the representation of the case by Dr Lutz Herrmann who is not qualified under Art. 133(3) and Art. 134 to represent the Opponent ... and the suitable supervision and control by Mr Wolf, the professional representative of the Opponent because he declared that he was not prepared to defend the case in oral proceedings, thus not able to supervise completely Dr. Lutz Herrmann (G 4/95)". The Opposition Division then indicates "Dr Lutz Herrmann was not allowed to defend the case: the presentation of the party's case should be to the professional representative, Mr Wolf".

- 4.5 It is in dispute between the parties
- a) whether or not the Opposition Division had actually considered the criteria of G 4/95 on the day of the oral proceedings, or whether it had only been focused on the question of whether Mr Herrmann had been authorised to **represent** the Opponent; and
 - b) whether any submissions of Mr Herrmann would have been made **under the responsibility and continuing control of the authorised representative Mr Wolf**.

- 4.5.1 In respect of point a), the Board observes that, on the one hand, the minutes of the first instance oral proceedings are silent as regards G 4/95 and the criteria laid down therein and end with the phrase "*The Chairman concluded that **only** Mr Wolf would **represent** the Opponent*" (emphasis added by the Board).

On the other hand, decision G 4/95 as such is only mentioned expressly in the decision under appeal (in

parentheses; see Point 4.4, *supra*). Considering the content of the minutes, and the contradicting assertions of the parties regarding the course of action and the arguments exchanged during the first instance proceedings, the Board concludes that it is not established that the criteria of G 4/95 had actually been addressed as such at the oral proceedings and/or considered by the Opposition Division.

- 4.5.2 As regards point b), the Board observes that the minutes of first instance oral proceedings do not contain any **objective** indication that the representative was not sufficiently prepared and thus not in a position to present the Opponent's complete case and/or that he was unable to control, under its continuing responsibility, any oral submission to be made by Mr Herrmann. Nor is there any other form of evidence on file which would point in the direction of a course of action as precluded by G 4/95 (Reasons, 8, question (b) and subsequent paragraph), i.e. "*a situation where a professional representative could attend oral proceedings merely in order to state a party's formal requests, and an accompanying person could present the entire case on behalf of such party*", which the Enlarged Board held to be "*clearly contrary to what is intended under Article 133 EPC*".

Quite to the contrary, upon being specifically asked by the Board at the oral proceedings, the Respondent expressly confirmed that at the first instance oral proceedings Mr Wolf had not expressly stated that he was not prepared to present the case, but that this could be **derived from Mr Wolf's behaviour** during the oral proceedings.

For the Board, it thus turned out at the oral

proceedings that, in contrast to what appears to be implied in the decision under appeal (see point 4.4, *supra*), the Patent Proprietor and the Opposition Division had concluded that Mr Herrmann had actually been trying to act as the representative of the Opponent, thereby circumventing the provisions of Articles 133 and 134 EPC, i.e. that the decision had merely been reached on the basis of an interpretation of a perceived behaviour of the other party. Hence, for the Board, it is not convincingly established

- that Mr Wolf had "not been prepared to defend the case" or that he had not been "able to supervise completely" Mr Herrmann, and
- that allowing Mr Herrmann to speak to, and/or to communicate with Mr Wolf during the hearing, would have amounted to a circumvention of the provisions of Articles 133 and 134 EPC.

5. The question to be decided by the Board in the present case is thus whether or not the categorical refusal to let Mr Herrmann make oral submissions or even communicate with the authorised representative, as imposed by the Chairman of the Opposition Division at the first instance oral proceedings, merely amounted to a very strict but, nevertheless, correct exercise of his discretionary power, still in line with the principles stated in G 4/95 or, instead, to an inappropriate exercise of this discretion, going beyond the discretionary remit.

5.1 Firstly, the Board observes that as held in G 4/95 (Reasons, 6, third paragraph) the purpose underlying the regulations of Articles 133 and 134(1) EPC "*is to ensure that proceedings before the EPO are conducted efficiently and effectively*" ... "*to the overall benefit of the European patent system*".

5.2 In the present case, since the former authorized representative Mr Wins had become unavailable, the Opponent had decided to authorise another professional representative, i.e. Mr Wolf, for the first instance oral proceedings. Consequently, the Opposition Division had a *priori* to assume that the new representative Mr Wolf had been briefed such as to be in a position to defend the complete case and to control the accompanying person's oral submissions.

5.3 However, as apparent from the written submissions of both parties (point 2.2, *supra*) and from the minutes of the first instance oral proceedings, the conditions for a normal conduct of the oral proceedings, in the sense of a fair and balanced adversarial debate, had not been given from their beginning to their end. In particular, it is not in dispute that the Chairman had categorically forbidden Mr Herrmann to address the Opposition Division and to communicate with Mr Wolf, apparently under the mere impression that Mr Herrmann had not only been present to make submissions regarding some specific legal or technical points, but had actually been intending to present the complete case in place of the newly appointed representative Mr Wolf. It cannot be derived either from the minutes of the first instance oral proceedings that at least one opportunity had been given to the Opponent's representative to confer with Mr Herrmann in order to avoid possibly disturbing "whispering" or passing on of written information.

5.4 As a consequence of this conduct of the oral proceedings, the representative of the Opponent appears to have been totally deprived of any support he was expecting to get from the announced accompanying person Mr Herrmann, i.e. a person very familiar with all

aspects of the case that he was in charge of the opposition case on the Opponent's side from its very beginning. The strict approach of **only** allowing the authorised professional representative to present the party's case and make oral submissions is, however, in contradiction with the position explicitly expressed by the Enlarged Board in G 4/95 (Reasons, 8, Question (b), third subsequent paragraph).

- 5.5 The Board concludes that the categorical refusal for Mr Herrmann to make oral submissions or even to communicate with Mr Wolf in effect had been keeping the Opponent from taking position in an "*efficient and effective manner*" on the contentious issues of the case, which would also have included the obviously very important supporting oral contributions by Mr Herrmann. This is clearly apparent from the minutes of the first instance oral proceedings (Points 3 and 4) insofar as they mention that with regard to the substantive issues of sufficiency of disclosure and novelty, the Opponent's representative essentially had relied on his written submissions. Hence, only the Patent Proprietor had been in a position to make exhaustive oral submissions in this respect.
6. The Board holds that an effective and efficient conduct of oral proceedings, although being subject to the discretionary power exercised by the Chairman in oral proceedings with regard to specific issues, must nevertheless guarantee that the fundamental procedural rights of each party in adversarial proceedings, i.e. the right to a fair and equal treatment, including the right to present comments in oral proceedings (Articles 113(1) and 116 EPC) are respected.
7. In the Board's judgment, the unconditional refusal for

Mr Herrmann to address the Opposition Division as an accompanying person, and to communicate with the authorised representative, deprived the Opponent of a fair trial, since its procedural rights had not been fully respected in the oral proceedings. This conduct of the oral proceedings thus amounts to an inappropriate exercise of its discretion by the department of first instance.

8. The Board thus concludes that the first instance proceedings suffer from a fundamental procedural deficiency requiring that the case be remitted to the department of first instance (Article 11 RPBA; Article 111 EPC).
9. Moreover, as a consequence of this finding, the reimbursement of the appeal fee is equitable (Rule 103(1) a) EPC).
10. As regard the Appellant's request for holding once more oral proceedings before the Opposition Division in a different composition, the Board informed the Appellant at the oral proceedings that, as confirmed by the relevant department of the EPO, the Examiner who had chaired the first instance oral proceedings had retired in the meantime. The composition of the Opposition Division entrusted with the further prosecution of the case and hearing the parties in oral proceedings (if a request to this end is maintained by the Appellant) will thus necessarily be a different one, in accordance with the request of the Appellant.

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 reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:



D. Magliano

B. Czech

Decision electronically authenticated