

Internal distribution code:

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

**Datasheet for the decision
of 27 August 2018**

Case Number: T 1403/16 - 3.2.05

Application Number: 01109388.7

Publication Number: 1149699

IPC: B41F31/00, B41F31/02, B41F31/10

Language of the proceedings: EN

Title of invention:
Inking apparatus for printing press

Patent Proprietor:
Komori Corporation

Opponent:
KBA-NotaSys SA

Headword:
Discontinuation of the opposition proceedings / re-
establishment of rights

Relevant legal provisions:
EPC Art. 114, 122
EPC R. 83, 84(1)

Keyword:

Re-establishment of rights in opposition proceedings - loss of rights being the direct consequence of the failure to observe time limit (no)

Re-establishment of rights - time limit under Rule 84(1) EPC (no)

Late-filed request - failure of observe the two-month time limit under Rule 84(1) EPC

Decisions cited:

G 0001/90, G 0002/90

Catchword:



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 1403/16 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 27 August 2018

Appellant: KBA-NotaSys SA
(Opponent) Avenue du Grey 55
1000 Lausanne 22 (CH)

Representative: Denis Aivazian
Aivazian Moreau - Novaimo
ActiTech 8
60, avenue Marie Curie
Archamps Technopole
74166 Saint-Julien-en-Genevois Cedex (FR)

Respondent: Komori Corporation
(Patent Proprietor) 11-1, Azumabashi 3-chome
Sumida-ku
Tokyo (JP)

Representative: Georg Both
Uexküll & Stolberg
Partnerschaft von
Patent- und Rechtsanwälten mbB
Beselerstraße 4
22607 Hamburg (DE)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 6 April 2016 to
discontinue the opposition proceedings.**

Composition of the Board:

Chairman G. Weiss
Members: P. Lanz
 O. Randl

Summary of Facts and Submissions

- I. The present appeal lies against the decision of the opposition division of 6 April 2016 concerning the discontinuation of the opposition proceedings under Rule 84(1) EPC.
- II. The opposition division, having noted that the patent in suit had lapsed in all the designated contracting states, issued a communication under Rule 84(1) EPC inviting the opponent to file, within two months, a request for continuation of the opposition proceedings. That communication was duly notified, and the opponent instructed its representative in due time to file such a request.
- III. By mistake, the opponent's representative did not follow that instruction and failed to file the request within the two-month time limit. By letter dated 21 April 2015, he filed a duly reasoned request for re-establishment of rights, accompanied by an auxiliary request for an appealable decision should the request for re-establishment of rights not be granted.
- IV. To support the request for re-establishment of rights, the opponent's representative argued in particular that Article 122 EPC and Rule 136 EPC applied in the event of non-compliance with the time limit under Rule 84(1) EPC, and that this approach was entirely in keeping with the principles laid down in Enlarged Board of Appeal decision G 1/86, the "legal process" having begun with the filing of the notice of opposition. In G 1/86, the Enlarged Board had weighed up the (side) effects on the various parties involved. In the present case, the effect on the opponent - and indeed third parties - was extremely negative, but there was little

effect on the patent proprietor. The opponent's representative also argued that its rights should be re-established because, although it had taken all due care required by the circumstances, it had been unable to observe the time limit under Rule 84(1) EPC simply because of a mistake on the part of its representative. Evidence was filed.

V. On 6 April 2016, the opposition division decided as follows:

- (i) The request for re-establishment of rights was refused as inadmissible. There was no justification for extending the scope of Article 122(1) EPC to cover re-establishing an opponent's rights in the event of non-compliance with the time limit under Rule 84(1) EPC;
- (ii) the request for an interlocutory decision allowing a separate appeal within the meaning of Article 106(2) EPC was refused; and
- (iii) the opposition proceedings were discontinued.

VI. In its statement setting out the grounds of appeal, the appellant requested that the contested decision be set aside and, as its main request, that the board rule that Article 122 EPC applies in the event of non-compliance with the time limit under Rule 84(1) EPC and in particular that the board confirm that the appellant is entitled to assert its rights under Article 122 EPC for re-establishment in respect of that time limit. Should the board be minded to allow its main request but not to grant re-establishment itself, the appellant sought remittal to the department of first instance for that purpose. Should the board instead be minded to

refuse its main request, the appellant's auxiliary request was for oral proceedings, and for a referral of the question of Article 122 EPC's applicability to non-compliance with the time limit under Rule 84(1) EPC to the Enlarged Board under Article 112(1)(a) EPC as a point of law of fundamental importance.

VII. In a communication pursuant to Article 15(1) RPBA dated 27 July 2017, the board gave its preliminary opinion that Article 122 EPC does not apply in the event of non-compliance with the time limit under Rule 84(1) EPC, in particular because non-compliance with that time limit does not directly cause the loss of a right within the meaning of Article 122(1) EPC. Thus, the decision under appeal should be set aside and the case remitted to the opposition division so that it could decide whether or not to continue the opposition proceedings under Rule 84(1) EPC.

VIII. By letter dated 3 April 2018 the appellant withdrew its request for oral proceedings and requested, further to the above-mentioned communication of 27 July 2017, that the case be remitted to the opposition division.

Reasons for the Decision

1. The present appeal concerns the applicability of Article 122 EPC, in the light of Enlarged Board decision G 1/86, in the event that an opponent fails to comply with the time limit under Rule 84(1) EPC. The opposition division decided that there was no justification for extending the scope of Article 122(1) EPC in the present case: "The extensive interpretation of Article 122(1) EPC has been recognised only with respect to the appeal procedure ..., and only where this would be demanded by general principles of law, in

particular the principle that all parties to proceedings before a court must be accorded the same procedural rights" (see contested decision, page 3, second paragraph).

2. The board, having examined the applicability of Article 122 EPC in the general context of opposition proceedings, arrives at the following conclusions:

2.1 Regardless of whether an opponent may validly request re-establishment in respect of the two-month time limit under Rule 84(1) EPC, one of the basic preconditions for applying Article 122(1) EPC is not fulfilled in the present case, namely that non-compliance with the time limit leads directly to a loss of rights (*"if the non-observance of this time limit has the direct consequence of causing ... the loss of any other right..."*). In opposition proceedings, in the event of a failure to reply in due time to a communication from the opposition division, there is no loss of rights which occurs automatically by operation of law. The board observes that the legal situation is different in the proceedings up to grant, where failing to reply to a communication in due time leads to a loss of rights by operation of law (application deemed withdrawn; see for example Article 94(3) and (4) EPC).

Leaving aside the opposition division's decision to discontinue the opposition proceedings under Rule 84(1) EPC, Article 101 EPC provides for three possibilities to terminate opposition proceedings, namely the revocation of the patent (paragraph 1, first sentence), the rejection of the opposition (paragraph 1, second sentence) and the maintenance of the patent as amended (paragraph 3). For each of these possible results an act is expressly defined (*"shall revoke the patent"*,

"shall reject the opposition", "shall decide to maintain the patent as amended"). In view of that, and as illustrated by the comparison with the grant procedure, the EPC makes it clear that in each of these cases the opposition division has to deliver a decision within the meaning of Article 106(1) EPC and that the decision must be reasoned (Rule 111(2) EPC). For detailed explanations on these issues, see G 1/90, OJ EPO, 1991, 275, Reasons 6 and 7, and G 2/90, OJ EPO 1992, 10, Reasons 3.3.

- 2.2 During substantive examination of an opposition, that is, once the opposition has been deemed admissible and the grounds for opposition have been examined, the opposition division, pursuant to Article 101(1), second sentence, EPC, invites the parties, as often as necessary, to file observations within a given time limit (generally four months, see Guidelines for Examination in the European Patent Office, D-VI, 3). Failing to reply to such a communication does not have any direct legal effect within the meaning of Article 122(1) EPC; filing a response after expiry of the time limit *may* only result in the response being disregarded in accordance with Article 114(2) EPC (see Singer/Stauder/Kroher (German version), 7th edition, Art. 122, point 39). The legislator made this legal consequence quite clear in Rule 83, second sentence, EPC, in which it is explicitly stated that, if documents referred to by an opponent in its notice of opposition are neither enclosed nor filed in due time upon invitation by the EPO, the opposition division may, in accordance with Article 114(2) EPC, decide not to take into account any arguments based on them.

Therefore, re-establishment of rights is not available in the event of non-compliance with a time limit set in

a communication under Article 101(1) EPC and, if a request to that effect were to be filed, it would have to be refused.

- 2.3 This conclusion equally applies to the time limit under Rule 84(1) EPC. A discontinuation of the opposition proceedings under Rule 84(1) EPC generally requires an appealable decision by the opposition division. Hence, non-compliance with the two-month time limit under Rule 84(1) EPC does not directly cause a loss of rights. Rather, the decision on whether or not to continue the opposition proceedings under Rule 84(1) EPC lies within the opposition division's discretion. In view of that, the question of whether opponents are entitled to request re-establishment in respect of the two-month time limit under Rule 84(1) EPC does not arise. If an opponent requests that the opposition proceedings be continued, but does so only after expiry of the two-month time limit under Rule 84(1) EPC, it is up to the opposition division to consider that request - by application of Article 114 EPC - and to decide on whether or not to continue them. If, where appropriate, the opposition division takes a decision to discontinue the proceedings, this decision is open to appeal.
3. In the light of the above, the decision under appeal is based on an inaccurate assessment of the legal situation underlying the case in hand. In consequence, the board judges that the opposition division's decision has to be set aside and the case remitted in order for the opposition division to decide on whether or not to continue the opposition proceedings under Rule 84(1) EPC, provided that the appellant confirms that it wants them to be continued.

4. The board considers that, by requesting that the case be remitted to the department of first instance in its letter dated 3 April 2018, the appellant has withdrawn its request for referral to the Enlarged Board.

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.

The Registrar:

The Chairman:



L. Malécot-Grob

G. Weiss

Decision electronically authenticated