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

Case Number: T 2374/16 - 3.3.10

Application Number: 04763960.4

Publication Number: 1716111

IPC: C07C273/12

Language of the proceedings: EN

Title of invention:

INTEGRATED PROCESS FOR UREA AND MELAMINE PRODUCTION

Patent Proprietor:

CASALE SA

Opponent:

Stamicarbon B.V.

Headword:

Relevant legal provisions:

EPC Art. 113(2)
EPC R. 82(2), 82, 140

Keyword:

Basis of decision - substantial procedural violation (yes)

Decisions cited:

Catchword:



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Case Number: T 2374/16 - 3.3.10

D E C I S I O N
of Technical Board of Appeal 3.3.10
of 27 April 2018

Appellant: CASALE SA
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Appellant: Stamicarbon B.V.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
19 August 2016 concerning maintenance of the
European Patent No. 1716111 in amended form.**

Composition of the Board:

Chairman P. Gryczka
Members: R. Pérez Carlón
C. Schmidt

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the opposition division to maintain European patent No. 1 716 111 in amended form. Both the opponent (appellant 1) and the patent proprietor (appellant 2) appealed the decision.

- II. Notice of opposition had been filed on the grounds of added subject-matter (Article 100(c) EPC), insufficiency of disclosure (Article 100(b) EPC), and lack of novelty and inventive step (Article 100(a) EPC).

- III. According to the reasoning of the decision, the opposition division intended to maintain the patent in suit on the basis of the claims of the then pending first auxiliary request, filed with letter dated 4 February 2016, containing the feature "of the non-catalytic high pressure type" in claims 1 and 6, in addition to those of the corresponding claims of the patent as granted (see page 10 of the decision under appeal).

This decision was also announced at the end of the oral proceedings (7th paragraph on page 1, and 10th and last paragraphs on page 5 of the minutes).

- IV. Form 2399, sheet 1, of the decision, indicates, however, that the patent in suit is maintained in the form of the main request, whose claims 1-8 and pages 2, 4 and 5 are those of the patent as granted, and page 3 of the description corresponds to that filed with letter dated 5 April 2016. These are also the documents which form part of the "Druckexemplar".

V. In a communication dated 28 April 2017, the board informed the parties that such an inconsistency between the decision announced at the oral proceedings, the reasoning of the decision and the documents upon which the patent was maintained would appear to amount to a fundamental procedural violation, which could justify that the decision under appeal be set aside, the case remitted and the appeal fees reimbursed.

VI. The arguments of appellant 1 relevant for the present decision were the following:

The decision of the opposition division had not been sufficiently reasoned, as it contained no reasoning as to why the claims of the patent as granted were novel over document D1. This amounted to a procedural violation.

Appellant 1 stated that it would not request oral proceedings if the board remitted the case to the opposition division.

VII. Appellant 2 argued that no procedural violation had been committed but that a simple mistake had been made.

Appellant 2 further argued that the decision under appeal was an interlocutory decision. The appeal suspended that decision so that the granted patent still had legal force. Third parties were thus not affected by the inconsistency between the reasoning of the decision and the documents upon which the opposition division intended to maintain the patent, as that decision was suspended.

Lastly, it argued that if both parties withdrew their appeal, the procedure would still continue according to

Rule 82 EPC, and the opposition division could still correct its mistake under Rule 140 EPC.

Appellant 2 stated that it would not request oral proceedings if the board remitted the case to the opposition division.

VIII. The final requests, in writing, of the parties with respect to the issue of the alleged procedural violation were the following:

- Appellant 1 requests that the decision under appeal be set aside, the case remitted to the opposition division and the appeal fee reimbursed.
- Appellant 2 requests that the board examines the substance of the appeal.

Reasons for the Decision

1. The appeals are admissible.
2. Alleged procedural violation
 - 2.1 It is not disputed that there is an inconsistency between the decision under appeal, which in its reasoning results in the patent being maintained in the form of the first auxiliary request, and the "Druckexemplar" and the currently valid documents on form 2339 of the impugned decision, which mentions that the documents for the maintenance of the patent are those of the main request, corresponding to the patent as granted with the exception of page 3 of the description. The minutes of the oral proceedings before the opposition division indicate that the opposition

division's decision was that the patent would be maintained on the basis of the first auxiliary request (last paragraph on page 5).

It needs to be examined whether such an inconsistency amounts to a fundamental procedural violation, which could justify the decision under appeal being set aside, the case being remitted to the opposition division and the appeal fee being reimbursed.

2.2 None of the parties requested a correction of the opposition division's decision prior to these appeal proceedings.

2.3 Appellant 2 argued that the minutes of the oral proceedings and the reasoning in the opposition division's decision should prevail and have legal force, as they reflected the true intention of the division and were fully in accordance with the decision announced at the end of the oral proceedings.

However, the wording of the "Druckexemplar" represents the legally binding version of the text of the patent as maintained. That wording does not correspond to any of the requests of the patent proprietor, as its description was filed as part of the first auxiliary request, i.e. in combination with the corresponding claims of the first auxiliary request, and not with those as granted. Maintaining the patent in a form not requested by the patent proprietor and to which the reasons of the written decision do not correspond in itself represents a fundamental procedural violation (Article 113(2) EPC).

2.4 Appellant 2 argued that the decision under appeal was an interlocutory decision, suspended by the appeal.

This suspension had as a consequence that the granted patent and not the amended patent had legal force. For this reason, third parties were not affected and thus the legal situation was different from that underlying G 1/10. If both parties withdrew their appeal, the procedure would nevertheless continue as the requirements of Rule 82(2) EPC would still need to be fulfilled, and the opposition division would have to invite the proprietor to pay the prescribed fee and file a translation of any amended claim. At that point in time, the division could correct the discrepancy in the decision under Rule 140 EPC.

However, it is not within the board's powers to take a decision on developments that may or may not happen in the future, but only on the facts of the case before it. In the present situation, and having regard to the decision of the opposition division on which are based the appeals, it can only conclude that a procedural violation occurred.

2.5 Lastly, appellant 2 argued that a remittal would only have as a consequence that the opposition division would arrive at the same decision, so that a final decision on the substance would only be delayed.

However the board cannot take into consideration future scenarios about which it can only speculate. It is indeed possible that the board will be confronted with the same situation with respect to the substance of the case, but the opposition division could also decide in a different way, an intervention might be filed or the opposition could be withdrawn, to mention but a few of the possible outcomes.

These arguments of appellant 2 are therefore not convincing.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division.
3. The appeal fees are reimbursed.

The Registrar:

The Chairman:



C. Rodríguez Rodríguez

P. Gryczka

Decision electronically authenticated