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Chambres de recours

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Aktenzeichen / Case Number / N° du recours : T 197/88 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 79 300 234.6

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 003 890

Bezeichnung der Erfindung: Herbicidal pyridine compounds and herbicidal
Title of invention: compositions containing them
Titre de l'invention :

Klassifikation / Classification / Classement : C07D 213/64

ENTSCHEIDUNG / DECISION

vom / of / du 02 August 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Imperial Chemical Industries PLC

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Continuation of opposition proceedings/ICI

EPO/EPC/CBE Art. 113(1), Rules 58(4), 60(2), 67

Schlagwort / Keyword / Mot clé : Opposition proceedings - continuation;
Opposition - withdrawal;
basis of decisions;
reimbursement of appeal fee -
violation of Art. 113(1) - taking a party
by surprise.

Leitsatz / Headnote / Sommaire

I. If an opposition is withdrawn after the dispatch of the communication pursuant to Rule 58(4) EPC, the opposition proceedings should, in principle, be continued by the Opposition Division of its own motion.

II. The appeal fee has to be reimbursed if the failure to give a party an opportunity to present his comments amounts to a breach of the requirements of Article 113(1) EPC.

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Case Number : T 197 /88 - 3.3.2



D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 02 August 1988

Appellant :
(Proprietor of the patent) Imperial Chemical Industries PCL
Imperial Chemical House
Millbank
London SW1P 3JF
GB

Representative :

Respondent :
(Opponent)

Representative :

Decision under appeal : Decision of the Opposition Division of the
European Patent Office dated 26 January 1988
terminating the opposition proceedings on
European patent No. 0 003 890.

Composition of the Board :

Chairman : P. Lançon
Members : R. Schulte
G. Szabo

Summary of Facts and Submissions

- I. European patent No. 3 890 was granted on 26 January 1983. A notice of opposition to this European patent was filed on 19 August 1983. The Opponent requested that the patent be revoked since its subject-matter failed to meet the requirements of patentability according to Articles 52 to 57 EPC.
- II. At the end of the oral proceedings held on 26 June 1985 the Chairman informed the parties that the Opposition Division intended to maintain the patent in amended form on the basis of the auxiliary claims submitted on 14 June 1985 and modified during oral proceedings. The Patentee should submit an amended description brought into agreement with the new claims. The Patentee complied with this decision and submitted amended pages of the description.
- III. On 10 January 1986 a Communication pursuant to Rule 58(4) EPC was dispatched. The Opponent informed the Opposition Division that the new claim does not meet the requirements of Article 100(b) EPC, whereas the Patentee agreed with the amended form of the patent. Because of the objections of the Opponent, the Opposition Division in a communication pursuant to Article 101(2) and Rule 58(1) to (3) EPC resumed the opposition proceedings. The Patentee was invited to file observations in response to the objections raised by the Opponent, which the Patentee filed with his letter 9 December 1986.
- IV. With letter dated 5 November 1986 the Opponent withdrew his opposition. On 26 January 1988 the Opposition Division gave a decision which terminated the opposition proceedings because the Opponent had withdrawn the

opposition and the European Patent Office had no cause to continue the proceedings of its own motion as the file now stands. Against this decision the Patentee filed on 15 March 1988 a combined Notice of Appeal and Statement of Grounds and simultaneously paid the appeal fee. The Patentee stressed that he was highly interested in maintaining the patent in the amended form because he wished to be sure that the claims are valid and avoid both ambiguity and conflict with his European patent application EP-A-1 473.

Reasons for the Decision

1. The appeal is admissible.
2. According to Rule 60(2), second sentence EPC, "opposition proceedings may be continued" by the European Patent Office of its own motion when an opposition is withdrawn. The wording of the provision in all three official languages shows that the European Patent Office has a certain discretion to continue an opposition proceedings after withdrawal of the opposition. This discretion should be exercised in a fair way, taking into account the interests of the public, the Patentee and the European Patent Office.
- 3.1 In the decision under appeal, the Opposition Division took the view that as the case stood, there was no reason for the Office to continue the proceedings of its own motion. Detailed grounds for this statement were not given. In contrast to the Opposition Division, the Board considers that there are in this case sufficient reasons for continuation of the proceedings.

- 3.2 After withdrawal of an opposition, the opposition proceedings should be continued if they had reached such a stage that they are likely to result in a limitation or revocation of the European patent without further assistance from the Opponent and without the Opposition Division itself having to undertake extensive investigations (see Guidelines for examination in the European Patent Office part D, chapter VII, 6.2 and 6.3). The continuation of the opposition proceedings under these circumstances corresponds to the general duty of the European Patent Office vis-a-vis the public, not to maintain patents which it is convinced are not legally valid at all or with necessary limitations only (see T 156/84, Pressure swing adsorption/AIR PRODUCTS, paragraph 3.5, to be reported; headnote in OJ EPO 1988, 187).
- 3.3 In the light of this obligation the European Patent Office should, in principle, continue an opposition proceedings when a communication pursuant to Rule 58(4) EPC was already sent to the parties before the opposition was withdrawn. The dispatch of the communication shows clearly that the Opposition Division was of the definite opinion that the European patent could not be maintained in the granted form. Under these circumstances it is in the public interest to continue the opposition proceedings after the withdrawal of the opposition even if the Patentee would have disagreed the amended text proposed by the European Patent Office, the more in this case where the Patentee explicitly declared his agreement.
- 3.4 Therefore the decision under appeal terminating the opposition proceedings has to be set aside and the case has to be remitted to the first instance.

4. In accordance with Rule 67 EPC, reimbursement of an appeal fee shall be ordered when a Board deems an appeal to be allowable "if such reimbursement is equitable by reason of a substantial procedural violation". The Opposition Division did not give the Patentee the possibility to file his observations before announcing the decision terminating the opposition proceedings. This failure amounted to a breach of the requirements of Article 113(1) EPC because the contested decision was based on grounds on which the Patentee had not an opportunity to present his comments. To take a party by surprise means a substantial procedural violation in the meaning of Rule 67 EPC. The Board considers therefore, that it is equitable to order the reimbursement of the appeal fee.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to continue the opposition proceedings.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

F. Klein

P. Lançon