

Publication in the Official Journal Yes / No

File Number: T 154/90 - 3.2.4
Application No.: 84 308 814.7
Publication No.: 0 146 391
Title of invention: Unstrapping apparatus

Classification: B65B 69/00

D E C I S I O N
of 19 December 1991

Applicant: DE LA RUE SYSTEMS LIMITED
Opponent: GAO Gesellschaft für Automation und
Organisation mbH

Headword: Apportionment of costs/DE LA RUE SYSTEMS LIMITED
EPC Art. 106(4), 108 and 116; R.63 and 65.
Keyword: "admissibility of appeal" - "withdrawal of request for oral
proceedings - in time" - "apportionment of costs"

Headnote

I. If the appeal relating to the revocation of a patent is rejected as inadmissible and there is no other admissible request, an appeal relating to apportionment of costs is inadmissible, it being the sole subject of an appeal (Article 106(4) EPC).

II. If, however, the impugned decision did not take into account the withdrawal of the request for oral proceedings and was, therefore, based on a substantial procedural violation, the part of the impugned decision relating to apportionment of costs is to be set aside.

TO BE PUBLISHED

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DECISION
of 19 December 1991

Applicant: DE LA RUE SYSTEMS LIMITED
Opponent: GAO Gesellschaft für Automation und
Organisation mbH

Headword: Subjects of appeal
EPC Art. 106(4), 108 and 116; R.63 and 65.
Keyword: "appeal - different subjects of appeal";
"first subject of appeal inadmissible (section 1.2);
"other subjects of appeal admissible (section 1.3);
"withdrawal of request for oral proceedings - in time (section 3 to
5);
"no apportionment of costs".

Headnote

A subject of appeal is that type of request which can only be successful if the
announced decision is totally or partially cancelled.

HEAD NOTE

NOT TO BE PUBLISHED

allows that an appeal can have two or more subjects
subject of an appeal (for example the inadmissibility
of the Patent) does not automatically cause that
admissible; the inadmissibility of an appeal in its
admissibility of all subjects of that appeal filed
filed in Article 108 EPC.



Case Number : T 154/90 - 3.2.4

**DECISION
of the Technical Board of Appeal 3.2.4
of 19 December 1991**

Appellant :
(Opponent)

GAO Gesellschaft für Automation und
Organisation mbH
Euckenstrasse 12
W-8000 München 70 (DE)

Representative :

Klunker Schmitt-Nilson Hirsch
Winzererstrasse 106
W-8000 München 40 (DE)

Respondent :
(Proprietor of the patent)

DE LA RUE SYSTEMS LIMITED
De la Rue House
3/5 Burlington Gardens
London W1A 1DL (GB)

Representative :

Skone James, Robert Edmund
GILL JENNINGS & EVERY
53-64 Chancery Lane
London WC2A 1HN (GB)

Decision under appeal :

Interlocutory decision of the Opposition Division
of the European Patent Office dispatched on
09.01.90 concerning maintenance of European
patent No. 0 146 391 in amended form.

Composition of the Board :

Chairman : C.A.J. Andries
Members : J.C. Saisset
H.J. Seidenschwarz

Summary of Facts and Submissions

- I. European patent no. 146 391 was granted on 29 July 1987 in response to the European patent application no. 84 308 814.7 filed on 17 December 1984.
- II. On 22 April 1988 the Opponent filed a notice of opposition against this European patent, requesting that it be revoked on the ground of non-patentability because of lack of novelty and lack of inventive step.
- III. In a communication dated 31 March 1989 the Opposition Division informed the parties of its opinion that a decision could be reached without oral proceedings. Thereupon the Patentee withdrew his request for oral proceedings. However, in a letter dated 6 July 1989, the Opponent maintained his request for oral proceedings. By letter dated 20 September 1989 the Patentee requested reimbursement of "costs in the sum of attorneys fees incurred subsequent to the 11th May 1989", if the Opposition Division finally decided in favour of the Patentee.
- IV. Oral proceedings were held on 15 December 1989. The Opponent was not present. The Patentee filed a new set of claims, overcoming thereby an objection made by the Opponent in his letter dated 6 July 1989, and requested the maintenance of the patent on the basis of this new set of claims.
- V. The Opposition Division, in its interlocutory decision, taken at the end of the oral proceedings and dispatched to the parties on 9 January 1990, maintained the patent in an amended form and decided that the Patentee's costs incurred in connection with the oral proceedings should be borne by the Opponent since, in the Opposition Division's

opinion, firstly, the Opponent had not attended the oral proceedings held at his request and, secondly, oral proceedings were not necessary to reach the decision.

- VI. The Opponent (Appellant) filed an appeal on 19 February 1990 and paid the appeal fee at the same time. The statement of grounds of appeal was filed on 15 May 1990. The Opponent requests: the cancellation of the impugned decision, the revocation of the patent on the grounds set out during the opposition proceedings, and the cancellation of the apportionment of costs on the ground that he had informed the EPO in due time, i.e. by letter dated 6 December 1989 and received by the EPO the same day, that he withdrew his request for oral proceedings but that the EPO had not taken that withdrawal into account.
- VII. In a communication pursuant to Article 110(2) EPC dated 25 September 1990 the Board made the preliminary observation that, in accordance with previous decisions of the Boards of Appeal, the Opponent's reference to the grounds filed during the opposition proceedings was insufficient to make the request to revoke the patent admissible but that his request relating to the apportionment of costs could be considered as admissible because it appeared to be the consequence of a main request relating to the cancellation of the impugned decision on the ground of a substantial procedural violation.
- VIII. The Patentee (Respondent) then requested, in a letter dated 1 October 1990, that, in the event the apportionment of costs is set aside, the EPO reimburse him for costs incurred as result of the EPO not communicating the letter from the Opponent to the Patentee.

- IX. With letter dated 4 December 1990, the Opponent requested a decision in line with the Board's communication dated 25 September 1990.
- X. In a second communication dated 18 June 1991, the Board pointed out that it did not find, either in the EPC or in any other legal text, a provision which enabled it to consider requests against the EPO for compensation in respect of loss or damage allegedly sustained in the course of European patent proceedings. Additionally, because a new set of claims was filed at the oral proceedings, the Board hesitated to agree with the Opposition Division's statement that the oral proceedings were not necessary to reach the decision.
- XI. In his last letter dated 3 July 1991 the Patentee argued that in his view no substantial procedural violation by the EPO had in fact taken place and he submitted that the appeal should be considered inadmissible since a clear statement of the grounds of appeal had not been made. He still contested the necessity for the oral proceedings and argued that decision T 10/82 dated 15 March 1983 (OJ EPO, 1983, 407), in which a Board of Appeal had considered that 8 working days between the receipt of a letter and the date of oral proceedings was an unacceptable and unreasonably short length of time, was a complete precedent for the present case because here also there were exactly 8 working days between the date of receipt and the date of the oral proceedings. Furthermore, he drew the attention of the Board to Part D-IX, 1.4 of the Guidelines for Examination in the European Patent Office which sets out a number of examples of situations in which costs will be apportioned and he stressed that one of these examples is the case where "a party requests the postponement of oral proceedings which have already been fixed, without good reason, and so late that the other

parties summoned cannot be informed of the postponement in time."

He requested finally that the Appeal Board find the appeal inadmissible or alternatively dismiss it on the grounds that there has been no substantial procedural violation by the EPO and the decision of the Opposition Division should be upheld and costs awarded to the Proprietor. He did not further mention the former request for reimbursement of costs by the EPO.

- XII. The Opponent in his answer dated 29 August 1991 contended, relating to the admissibility of the appeal, that his request for the revocation of the patent sufficiently set out the grounds of appeal because it was German legal practice to refer to statements filed in the foregoing proceedings in order to avoid repetition. He stressed that his withdrawal of the request for oral proceedings had occurred in time and contested that decision T 10/82 could be considered as a precedent for the present case because in that decision the 8 days related to the filing of a letter containing new facts submitted for the consideration of the Board and not to a simple withdrawal of a request for oral proceedings.

Reasons for the Decision

1. According to the Board, the appeal lodged by the Appellant in order to obtain the cancellation of the impugned decision has two different aims: the first relates to the revocation of the patent whereas the second relates to the cancellation of the apportionment of costs. In order to achieve these aims, the Opponent filed two corresponding requests. Prima facie it appears that these requests constitute two different subjects of appeal: the first

concerns the cancellation of the part of the impugned decision relating to the maintenance of the patent (see section 1.2 below), the second concerns the cancellation of the part of the impugned decision relating to the apportionment of costs (see section 1.3 below). In the Board's view, a subject of appeal is that type of request which can only be successful if the impugned decision is totally or partially cancelled. That an appeal can have two or more subjects is clear from Article 106(4) EPC (see section 1.3 below).

1.1 Although the appeal clearly complies with Articles 106(1) to (3) and (5) and 107 and with Rule 64 EPC, as well as with the first two sentences of Article 108 EPC, the Board wants to consider the question whether or not the grounds advanced in support of the subject of appeal concerning the revocation of the patent can be regarded, in terms of content, as having met the condition relating to the written statement laid down in the third sentence of Article 108 EPC (see section 1.2 below) and whether or not Article 106(4) EPC hinders the admissibility of the subject of appeal relating to the apportionment of costs (see section 1.3 below).

1.2 With respect to the grounds put forward by the Opponent for revocation of the patent, the Board considers that, having regard to previous decisions taken by the Boards of Appeal (T 220/83 OJ EPO 1986,249; T 213/85 OJ EPO 1987,482 and T 432/88, unpublished), these grounds are insufficient to make this first subject of appeal admissible.

1.2.1 The grounds of opposition brought forward by the Opponent in the opposition proceedings, have in fact been dealt with by the Opposition Division in a comprehensive communication and in their decision. The written statement relating to this first subject of appeal only makes a

general reference to the Opponent's submissions in the foregoing opposition proceedings, without stating the legal or factual reasons why that impugned decision should be set aside.

- 1.2.2 Consequently, the Opponent has left it entirely to the Board and the Patentee to conjecture why the Opponent considers the decision relating to the maintenance of the patent in the amended form to be defective. It is precisely this situation which, according to the established jurisprudence of the Boards of Appeal of the EPO, the requirement that grounds for appeal be filed is designed to prevent.

The reference by the Opponent to German legal practice does not help further, since this particular practice would run contrary to the established jurisprudence of the Boards of Appeal of the EPO.

- 1.2.3 It follows that the mere reference in the written statement in the present case to what was set out by the Opponent during the opposition proceedings for revocation of the impugned patent does not comply with the requirement of Article 108 EPC, last sentence, for a written statement setting out the grounds of appeal. Consequently, and in accordance with Rule 65(1) EPC, the part of the appeal requesting revocation of the patent and which constitutes the first subject of said appeal has to be rejected as inadmissible.

- 1.2.4 However, the inadmissibility of this first subject of appeal does not automatically cause the appeal as a whole to be inadmissible when, as in the present case, other subjects of appeal have been filed in due time (see section 1, last sentence).

1.3 Consequently, having regard to the Opponent's prima facie second subject of appeal for cancellation of the part of the decision relating to the apportionment of costs, it is noted first, that the Opponent gave a sufficient explanation as to why this part of the impugned decision should be set aside, so that this subject of appeal satisfies the requirement of Article 108 EPC, last sentence. However, Article 106(4) EPC states that the apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. Prima facie, it therefore seems that the second subject of appeal must fail.

1.3.1 In the present case, the subject of appeal relating to the revocation of the patent no longer exists because of its inadmissibility (see section 1.2).

1.3.2 However, the written statement filed by the Opponent by letter dated 15 May 1990 makes it clear that the request relating to the apportionment of costs is the consequence of another request relating to the cancellation of that part of the impugned decision which did not take into account the withdrawal of the request for oral proceedings and which is therefore based on a substantial procedural violation. Following the definition given above (see section 1), this latter request is in the Board's view the second subject of the present appeal, a subject which is different from the third one relating, in accordance with Article 106(4) EPC, to the apportionment of costs as such.

1.3.3 The Board considers that these two subjects of appeal, namely the second and the third subjects of appeal, have the same grounds i.e. the substantial procedural violation alleged by the Opponent. Therefore, it is stated that both satisfy Article 108 EPC, last sentence, and consequently that the subject of appeal relating to the apportionment of costs is not the sole remaining subject of the present

appeal. These two subjects therefore are admissible.

2. With respect to the second subject of appeal (see section 1.3.2., last sentence), it was stated in the impugned decision that the Patentee's costs incurred in connection with the proceedings should be borne by the Opponent because he did not appear at the oral proceedings held at his request.
 - 2.1 However, in the opposition file there is a letter dated 6 December 1989 in which the Opponent withdrew his request for oral proceedings. During the appeal proceedings the Opponent filed a copy of this letter which proves with its EPO date perforation that the receiving date by the EPO was also the 6 December 1989.
 - 2.2 Due to unexplained circumstances inside the EPO the Opposition division received the letter only after the oral proceedings took place. Consequently, the decision taken at the end of these oral proceedings did not take into account the Opponent's withdrawal of his request for oral proceedings and it ordered an apportionment of costs. Therefore, due to the Opposition division lacking information, the part of the impugned decision relating to the apportionment of costs is based on the wrong premiss and is therefore the result of a substantial procedural violation.
3. With respect to the third subject of appeal (see section 1.3.2, last sentence), it is clear from the file of the case that a period of 6 working days (or 8 days in total) separates the date of receipt of the letter by the EPO and the date of the oral proceedings (these two days are not included in the period).

3.1 Consequently, the question to be answered in order to decide whether the costs have to be borne by the opponent or not is the following: Is a period of 6 working days sufficient for the EPO to cancel planned oral proceedings or not? The question of whether it was necessary to hold the oral proceedings is of no relevance. Indeed, before his withdrawal, only the Opponent had requested the oral proceedings. If he withdrew his request in time, there would have been no reason to hold them since the Patentee and the Opposition Division had clearly stated that they did not want oral proceedings.

3.2 In decision T 10/82, the Respondents filed new facts 8 working days before the oral proceedings were held and the Opposition Division decided that: "the oral proceedings would have been unnecessary if the Respondents had communicated to the EPO at an earlier stage the above-mentioned facts pertinent to the decision." This means that a period of 8 working days was considered as insufficient for the Opposition Division to examine the newly submitted facts and then to cancel the oral proceedings.

In the present case, during the period of 6 working days, the only action to be taken by the Opposition Division after receiving the withdrawal of the request was to cancel the oral proceedings. No evaluation of new facts or arguments was needed. Therefore, the Board concludes that decision T 10/82 cannot be considered as a precedent to the present case.

3.3 In the present case, the oral proceedings were not cancelled because the letter received by the EPO on 6 December 1989 was not sent in time to the Opposition Division. This failure has to be attributed to the EPO which should be organised in such a way that incoming mail

relating to proceedings is promptly forwarded to the competent department, which, with the help of the available technical means of communication such as telephone, telegram, telex or facsimile, should have immediately informed all the parties to the proceedings not only of the withdrawal of the Opponent's request, but also of the cancellation of the (unnecessary) oral proceedings. In conclusion, if the EPO had taken in this case all due care required by the circumstances, a period of 6 working days (which means 8 days in total) would have been sufficient to cancel the oral proceedings and to inform the Patentee accordingly in due time.

3.4 The Patentee's reference to the Guidelines for Examination in the EPO does not help his case. The example given in the last paragraph of Part D-IX, 1.4 of the Guidelines concerns a case where the other parties summoned cannot be informed of the postponement in time. According to the Board, there is no relation between such a case and the present one since, in the present case, it is not reasonable to state that a period of 8 days, including 6 working days, is too short to inform the other parties involved, for example, simply by sending a note by facsimile to the effect that the oral proceedings are cancelled. As already put forward above, it is up to the EPO to organise itself in such a way that incoming mail is promptly forwarded, at least within a couple of days.

3.5 Furthermore, Article 116 EPC gives each party to the proceedings the right to be heard orally. This right stands even if all other parties involved and the Opposition Division believe that the oral proceedings are superfluous. If at a later stage, after the parties have been summoned, the party which requested the oral proceedings changes its mind, for whatever reason, and correspondingly informs the Opposition Division in time,

it does not automatically follow that irresponsible or malicious conduct on the part of that party is proven, so that the Board considers there is no automatic link between such conduct and apportionment of costs.

4. Therefore, considering that the Opponent informed the EPO in time that he withdrew his request for oral proceedings, the Board decides that the order of the impugned decision to apportion costs was the consequence of the substantial procedural violation (see section 2.2) and consequently that this particular order must be set aside.
5. Referring to Article 104 EPC, due to the above considerations, the Board considers that there are no reasons of equity to decide that the Patentee's costs incurred as a result of the oral proceedings held before the Opposition Division should be borne by the Opponent. Accordingly, each party to the opposition proceedings shall meet the costs he has incurred.

Order

For these reasons, it is decided that:

1. The subject of appeal relating to the revocation of the patent is rejected as inadmissible.
2. The subjects of appeal relating to the cancellation of the impugned interlocutory decision on the ground that the EPO did not consider the withdrawal of the request for oral proceedings, and to the apportionment of costs are both admissible.
3. The part of the impugned interlocutory decision relating to the apportionment of costs is set aside.

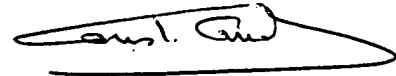
4. The patent is maintained on the basis of the documents accompanying the impugned interlocutory decision.
5. The Patentee's costs incurred as a result of the oral proceedings held before the Opposition Division are not to be borne by the Opponent.

The Registrar:

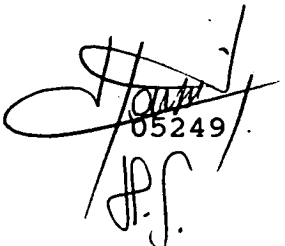


N. Maslin

The Chairman:



C. Andries



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