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File Number: T 494/90 - 3.3.2
Application No.: 81 303 773.6
Publication No.: 049 041
Title of invention: Porcelain enamel frit

Classification: C03C 8/02

D E C I S I O N
of 14 June 1991

Proprietor of the patent: NGK Insulators, Ltd.
Opponent: Bayer AG

Headword: Oral proceedings/NGK
EPC Art. 116
Keyword: "Request for oral proceedings - interpretation"

Headnote



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Boards of Appeal

Chambres de recours

Case Number : T 494/90 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 14 June 1991

Appellant :
(Proprietor of the patent)

NGK Insulators, Ltd.
2-56, Suda-cho, Mizuho-ku
Nagoya-shi, Aichi 467 (JP)

Representative :

Paget, Hugh Charles Edward
MEWBURN ELLIS
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Respondent :
(Opponent)

Bayer AG, Leverkusen
Patentabteilung
Bayerwerk
5090 Leverkusen (DE)

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 24 April 1990 revoking
European patent No. 0 049 041 pursuant to Article
102(1) EPC.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : A. Nuss
R. Schulte

Summary of Facts and Submissions

- I. European patent No. 49 041 was granted on European application No. 81 303 773.6.
- II. The Respondent filed opposition against the said patent.
- III. In a letter of the Appellants dated 14 July 1986 and in an accompanying counterstatement it was stated: "We request that we be given the opportunity to attend an oral hearing which may be appointed".
- IV. In response to an official communication the Appellants gave notice in a letter dated 12 December 1988 that, "If it becomes necessary for an oral hearing to be appointed in respect of these proceedings, we intend to maintain at said hearing our opposition to the introduction into the proceedings of SU-477 122 and SU-375 686".
- V. By a decision posted on 24 April 1990 the Opposition Division revoked the European patent for lack of inventive step without oral proceedings.
- VI. The Appellants filed a notice of appeal against the decision of the Opposition Division and paid the appeal fee. The Appellants submit that the appealed decision was issued incorrectly, because the proprietors of the patent were not granted oral proceedings as they had requested. In their letter of 26 July 1990 the Respondents said that they did not want to comment on this argument and made an auxiliary request for oral proceedings. In a telephone enquiry by the Board, the Respondents confirmed that the auxiliary request for oral proceedings was only meant in case the Board wished to decide the appeal in substance.

VII. The Appellants request that the decision under appeal be set aside and the case be remitted to the first instance.

The Respondents request that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 116(1) EPC oral proceedings shall take place either at the instance of the European Patent Office if it considers this to be expedient or at the request of any party to the proceedings. This provision is mandatory and leaves no room for discretion. If a request for oral proceedings has been made such proceedings must therefore be appointed.
3. If one judges the statement of 14 July 1986 in isolation and on a strictly grammatical basis one could draw the conclusion that no formal request for an oral hearing was filed because it is said "Oral hearings which may (instead of should) be appointed". But seen in its context and especially having regard to the letter dated 12 December 1988, filed more than two years later, the Board is of the opinion that the statement and the letter of 14 July 1986 - although the chosen wording is rather unusual - could be regarded as a valid auxiliary request for oral proceedings in the event that any adverse decision should be issued against the Appellant. This interpretation is especially reasonable since the Respondent had made no request for oral proceedings and so the above circumstance would have been the only circumstance in which oral proceedings would become "necessary" (letter 12 December 1988). Even if the Opposition Division had any doubts about accepting this interpretation it should have been its obligation to

clarify this uncertainty by asking the Appellant how his letter had to be understood (T 283/88 of 7 September 1988, not published in the OJ EPO). In this case it is highly probable that the answer to a telephone call would have been that the Appellant wanted to make an auxiliary request for an oral hearing.

4. If a request for oral proceedings was made in the letter dated 14 July 1986 there was no power to issue an adverse decision without first appointing such oral proceedings (T 19/87, OJ EPO 1988, 268; T 93/88 of 11 August 1988 not published in the OJ EPO). Thus, according to the established jurisprudence of the appeal boards the decision under appeal must be set aside as void and of no legal effect and the case has to be remitted to the Opposition Division.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The application is remitted to the Opposition Division with the order that oral proceedings under Article 116 EPC shall take place before a decision of the Opposition Division is given.

The Registrar:

The Chairman:

M. Beer

P.A.M. Lançon

