

Publication in the Official Journal Yes / ~~No~~

File Number: T 811/90 - 3.2.4
Application No.: 85 302 903.1
Publication No.: 0 162 602
Title of invention: Reinforced pistons

Classification: F02F 3/00

D E C I S I O N
of 2 April 1992

Proprietor of the patent: AE PLC

Headword:

EPC Articles 107 and 116; Rules 67 and 93

Keyword: "Opponent did not appeal against the decision rejecting the opposition, and is not a party in the present appeal (section 2)"
"A modified request of a party and the change of a previously communicated intention of the Opposition Division should be communicated to the parties before a decision is taken";
"Substantial procedural violation - yes"
"Letter and its enclosures filed by the Appellant to be withdrawn from the file and to be returned to him"
"Reimbursement of the appeal fee - yes"

Headnote



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number : T 811/90 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 2 April 1992

Appellant :
(Opponent)

AE PLC
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Representative :

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Decision under appeal :

Decision of Formalities Officer of the European
Patent Office dispatched 10 August 1990 relating
to European patent No. 0 162 602.

Composition of the Board :

Chairman : C.A.J. Andries
Members : J.P.B. Seitz
M.G. Hatherly

Summary of Facts and Submissions

- I. European patent No. 0 162 602 results from European patent application No. 85 302 903.1 which was filed on 25 April 1985.

The mention of the grant of the patent was published in Bulletin 88/26 on 29 June 1988.

- II. Notice of opposition was filed on 18 March 1989.

The Opponent requested:

- the revocation of the patent on the basis of lack of novelty and lack of inventive step;
- oral proceedings if the patent were not to be revoked as a result of written proceedings.

- III. By facsimile dated 2 or 8 January 1990, the correct date not being clear in the file, the Opposition Division proposed a date for oral proceedings and requested agreement from the parties within ten days.

The Patentee (Appellant) gave his approval to the proposed date by a facsimile dated 10 January 1990 and stated that he might file further submissions or amended claims before the oral proceedings.

By a facsimile dated 8 January 1990 and confirmed by letter of the same date, the Opponent withdrew his request for oral proceedings. As far as can be seen from the file the Patentee was informed of this withdrawal neither by the Opponent nor by the EPO.

- IV. With a letter dated 25 January 1990 received in the EPO on 30 January 1990, the Patentee filed further submissions, an amended Claim 1, and an amendment to part of the description, and expressed the view that they obviated the need for oral proceedings.
- V. On 18 January 1990, however, the Opposition Division had already decided to reject the opposition, without oral proceedings (EPO Form 2339).
- VI. This decision was dispatched to the parties on 30 January 1990 and no appeal was filed against it within the time limit. Thus, the opposition proceedings were terminated and the European patent maintained as granted.
- VII. By facsimile dated 1 February 1990 and confirmed by letter of the same date, the Patentee acknowledged receipt of the rejection of the opposition and requested that, in view of the rejection of the opposition, his letter dated 25 January 1990 be considered withdrawn and deemed not to have been filed. By letter of 17 May 1990 he repeated his request for withdrawal of the letter and submissions, adding that they should not be placed on the part of the file open to public inspection, since they formed no part of the documents on the basis of which the patent had been maintained unamended.
- VIII. On 8 June 1990, the Formalities Officer sent him a Brief Communication stating that although the amendments had not been taken into consideration, his letter dated 25 January 1990 was part of the official file.
- IX. The Patentee replied to this communication in a letter dated 26 June 1990 requesting once more the removal of the documents filed on 30 January 1990 from the public part of

the file, arguing that no prejudice to any third party's rights could follow from such a withdrawal.

- X. In a decision notified on 10 August 1990 the Formalities Officer refused to reverse his already expressed opinion and rejected the request to remove the documents from the public part of the file.

The main reasons for the decision were:

- the documents filed with letter dated 25 January 1990 did not belong to those parts of the file which were excluded from public inspection under Rule 93(a) to (c) EPC, or by specific decision of the President of the EPO according to Rule 93(d) EPC.
- new submissions and amended claims represented information concerning the European patent as granted, giving third parties an indication about the Patentee's position, therefore this information was of public interest.

- XI. On 10 October 1990, the Patentee lodged an appeal against this decision. The fee for appeal was paid on the same date, and the Statement of Grounds was filed on 10 December 1990.

- XII. In his written submissions, the Patentee argued essentially as follows:

- (a) Pursuant to Rule 58(1) EPC, the EPO was under an obligation to inform him of the Opponent's withdrawal of the request for oral proceedings, since it constituted an important indication of the way the latter considered the merits of his opposition.

- (b) In the present case, the EPO failed to comply with this obligation, so that the Patentee, in view of the scheduled oral proceedings, filed new submissions which would never have been filed had he been informed in due time of the withdrawal of the request for oral proceedings.
- (c) Such a failure could result in prejudice to the Patentee, since third parties could be led to believe that the Patentee himself considered the Patent as granted to be in some measure invalid in the light of the prior art.
- (d) The request of the Patentee by facsimile dated 1 February 1990, immediately after receipt of the decision rejecting the opposition, to treat the further submissions dated 25 January 1990 as having not been filed, arrived in due time since the amendments contained therein were of no utility for the reasons of that decision, according to the EPO itself (Brief Communication dated 8 June 1990).
- (e) the EPO had a duty to do its best to comply with the Patentee's wish that the further submissions be deemed not to have been filed, as would be the case if he had withdrawn a patent application prior to publication.

XIII. The Patentee requested that the impugned decision be set aside and that the EPO remove the further submissions filed with letter dated 25 January 1990 from that part of the file open to public inspection.

XIV. On 28 December 1990 the EPO sent the Statement of Grounds of the Appeal to the Opponent, whose opposition had been rejected. By letter dated 18 December 1990, he had indeed already pointed out that the decision dated

30 January 1990 was not effective since it had been taken on the basis of a version of the patent which by implication had been cancelled by the submission filed with the letter of 25 January 1990.

XV. In response, the Patentee made the following observations:

- (a) The decision under appeal was that issued on 10 August 1990 which was not linked in any way with that issued by the Opposition Division on 30 January 1990, so that, whatever might be decided by the Board of Appeal, it would not affect the maintenance of the patent.
- (b) The time limit for filing an appeal against the decision to reject the opposition and maintain the patent in unamended form, expired on 30 March 1990, and since that date the opposition proceedings had been concluded.
- (c) The Opponent had no right to be a party at the present stage of the proceedings, so that any submission filed by him should be disregarded.

XVI. The Patentee maintained his above request (cf. section XIII).

Reasons for the decision

1. The Appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. Whether the Opponent has the right to be a party to the present proceedings

According to Article 107 EPC, any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings, as of right.

In the present case, the impugned decision is that issued on 10 August 1990, to which the Opponent was not a party; consequently he is not entitled to be a party to the present proceedings.

In fact, the Opponent was only involved in the now concluded Opposition proceedings since he did not appeal against the decision of the Opposition Division to reject the opposition (i.e. to maintain the patent in unamended form), although on 5 February 1990 the new submissions filed by the Patentee with letter dated 25 January 1990 were communicated to him. Consequently he had enough time to consider them, that is, until 9 April 1990, the end of the time limit for lodging an appeal.

Hence, his request dated 18 December 1990 is inadmissible. It can however be considered as an observation by a "third party" according to Article 115 EPC.

3. The Opposition Division rejected the opposition in a decision issued without oral proceedings.

On the one hand, the decision was notified to the parties by registered letter dated 30 January 1990. On the other hand, the opposition file contains a form (EPO Form 2339.2) dated 18 January 1990 indicating a decision of rejection of the opposition signed by the three members of the Opposition Division.

4. Meanwhile, in a letter dated 25 January 1990 and received in the EPO on 30 January 1990, the Patentee filed further submissions, without making any conditions or stipulations concerning his right to withdraw them if the Opponent were to withdraw his request to oral proceedings.

Nevertheless, these submissions, according to their title, had been specifically filed in reply to the notice regarding preparation for oral proceedings dated 2 or 8 January 1990.

This clearly indicates that, the Patentee would not have filed such submissions, if he had been informed in due time of the Opponent's withdrawal of his request for oral proceedings.

- 4.1 Moreover, a comparison between the date on which the decision was actually taken (18 January 1990) and the date it was notified to the parties (30 January 1990) clearly proves that the submission (filed 30 January 1990) could not have been taken into account in the decision.

Furthermore the decision itself clearly states that the Patentee requested the maintenance of the patent in its published form, so that it implicitly and necessarily confirms that the last filed documents had not been taken into consideration.

5. As stated above, the Patentee was not informed before he received the decision dated 30 January 1990, that:
- firstly, the Opponent had withdrawn his request for oral proceedings; and
 - secondly, that the Opposition Division no longer intended to hold the planned oral proceedings.

5.1 Although the Patentee did not receive the summons to oral proceedings according to Rule 71(1) EPC, the Board considers that it was the duty of the Opposition Division, immediately after the withdrawal by the Opponent of his request for oral proceedings, to inform the Patentee as soon as possible:

- firstly of the withdrawal of this request of the Opponent; and
- secondly of the change of the Opposition Division's attitude with respect to holding oral proceedings, particularly since the original intention to hold them had already been communicated to the parties.

The Opposition Division failed to fulfil this duty.

5.2 The fact, that the Patentee was only informed of the withdrawal of the Opponent's request for oral proceedings in the decision rejecting the opposition is not considered by the Board to be providing appropriate information "as soon as possible" to the Patentee, since the withdrawal of the Opponent's request had already been received by the EPO on 8 January 1990 whereas the decision was only dispatched to the parties on 30 January 1990.

According to the Board such a long period is unacceptable, bearing in mind that the oral proceedings were proposed for 28 March 1990.

6. Due to such a lack of information, the Patentee continued to think that it was in his interest to file amendments in due time before the planned oral proceedings, (cf. above Section 4, second and third paragraphs).

Such an attitude, set out in the note "Opposition Procedure in the EPO" (OJ EPO 1989, 417 Section 13) where it is stated that requests must be submitted at the

earliest opportunity by the parties, cannot be allowed to lead to a prejudice of the Patentee's interests, since he handled in good faith by filing his amendments as soon as possible after he was asked to agree a proposed date for oral proceedings, hoping thereby that it would be possible to avoid the need for these proceedings.

The Board considers that the failure to inform the Patentee in due time of such major developments in the case, constitutes, in the special circumstances of the case, a substantial violation of the Patentee's right to fair treatment.

To decide the contrary could result in a disadvantage to the Patentee, through no fault of his own, since his behaviour was, on the one hand, in accordance with the general procedure wished by the EPO and, on the other hand, the result of misleading or missing information from the EPO.

7. The fact that, on the one hand, such documents are normally not excluded from public inspection pursuant to Article 128(4) and Rule 93(a) to (d) EPC, and that, on the other hand, it is not up to the parties to decide whether the aforesaid documents should remain confidential, is irrelevant in the present case. It is undeniable that these documents were issued as an immediate consequence of a substantial procedural violation, namely the failure of the EPO to comply with its obligation to inform the Patentee of the withdrawal of the Opponent's request for oral proceedings, and of the change of the previously communicated intention of the Opposition Division with respect to oral proceedings.
8. For these reasons the appeal was fully justified.

It is therefore decided that the letter of the Patentee dated 25 January 1990 and its accompanying submissions, amended Claim 1 and amended part of the description are to be withdrawn from that part of the file available to public inspection.

Moreover since these documents neither fall under one of the alternatives (a) to (c) of Rule 93 EPC nor belong to the classes of documents designated in the President's decision dated 16 September 1985 (OJ EPO 1985, 316), the Board is of the opinion that these documents should be returned to the Patentee. (cf. T 516/89 dated 19 December 1990, section V).

9. Since the Appeal is allowable and is the consequence of a substantial procedural violation, the reimbursement of the appeal fee is equitable.

Order

For these reasons, it is decided that:

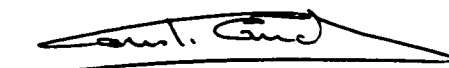
1. The decision under appeal is set aside.
2. The letter dated 25 January 1990 filed by the Patentee and its accompanying submissions, amended Claim 1 and amended part of the description are to be removed from the opposition file, and have to be returned to the Patentee.
3. The appeal fee is to be reimbursed.

The Registrar:



M. Maslin

The Chairman:



C. Andries