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File Number: T 795/91 - 3.5.1

Application No.: 84 105 875.3

Publication No.: 0 129 090

Title of invention: Numerical control method and system, and a machine tool controlled by the method or the system

Classification: G05B 19/405

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

Applicant: MITSUBISHI DENKI KABUSHIKI KAISHA

Opponent: Siemens Aktiengesellschaft, Berlin und München

Headword: Oral proceedings/MITSUBISHI

EPC Article 116(1) and Rule 67

Keyword: "Substantial procedural violation - oral proceedings not held"



Case Number : T 795/91 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 2 November 1992

Appellant :
(Opponent)

Siemens Aktiengesellschaft,
Berlin und München
Postfach 22 16 34
W - 8000 München 22 (DE)

Respondent :
(Proprietor of the patent)

MITSUBISHI DENKI KABUSHIKI KAISHA
2-3, Marunouchi 2-chome
Chiyoda-ku
Tokyo 100 (JP)

Representative :

Lehn, Werner, Dipl.-Ing.
Hoffmann, Eitle & Partner
Patentanwälte
Arabellastrasse 4
W - 8000 München 81 (DE)

Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 16 August 1991
rejecting the opposition filed against European
patent No. 0 129 090 pursuant to Article 102(2)
EPC.

Composition of the Board :

Chairman : P.K.J. van den Berg
Members : R. Randes
W. Schar

Summary of Facts and Submissions

- I. By decision dated 16 August 1991 the Opposition Division rejected the Opposition requesting revocation of the European patent No. 0 129 090 on the ground of lack of inventive step according to Articles 100(a) and 56 EPC.
- II. The decision was taken without preceding oral proceedings although such proceedings had auxiliarily been requested by the Opponent in his submission dated 15 May 1990. The Opposition Division held that in its communication of 19 November 1990 it had clearly asked the Opponent to indicate whether he maintained his request for oral proceedings. The absence of a reply to this communication was taken by the Opposition Division to mean that the Opponent had withdrawn his request for oral proceedings (point II.2. of its decision).
- III. On 10 October 1991 the opponent filed an appeal against the decision mentioned in point I. above and the appeal fee was paid on the same day. The Statement of Grounds dated 18 December 1991 was filed on 19 December 1991.
- IV. The Appeal was based on the ground of lack of inventive step (Article 56 EPC). The Appellant requested revocation of the patent in question.
- V. The Respondent replied by letter dated 12 May 1992 requesting rejection of the appeal and maintenance of the patent as granted.
- VI. Both parties auxiliarily requested oral proceedings.
- VII. On 2 November 1992 oral proceedings in which both parties took part were held before the Board of Appeal. The Appellant requested that the decision under appeal be set

aside and that the patent be revoked. Under an auxiliary request the Appellant requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution on the grounds that the Opposition Division had committed a substantial procedural violation due to their unfounded assumption that his silence following the Opposition Division's communication meant a withdrawal of his request for oral proceedings. The Appellant concluded that this constituted an unfounded refusal of his request and a violation of Article 116(1) EPC. The Respondent (Patentee) requested that the appeal be dismissed and auxiliarily that the patent be maintained as amended according to his letter dated 6 July 1992.

Reasons for the Decision

1. The Appeal complies with the requirements of Article 106 to 108 and Rules 1(1) and 64 EPC; it is therefore admissible.

2. It is an undisputed fact that the Appellant filed an auxiliary request for oral proceedings to be held in the event the Opposition Division intended not to revoke the patent. It is also undisputed that the Opposition Division took the contested final decision without having heard the parties at oral proceedings. No withdrawal of the request for oral proceedings can be found in the file. However the Opposition Division construed such a withdrawal from the fact that the Appellant (then Opponent) remained silent with regard to the communication of the Opposition Division dated 19 November 1990 wherein the Opponent was asked to indicate whether he maintained his request for oral proceedings.

3. In proceedings before the Opposition Division oral proceedings take place either on the Opposition Division's own motion or on request by a party (Article 116(1) EPC). In the case of a request by a party there is no room for discretion on the side of the Opposition Division (T 283/88, not published, point 2).

Such a request may later be withdrawn. However a withdrawal requires an unambiguous expression of the party's will to withdraw. There is no clause in the EPC nor can there be derived any other indication from the facts of the present case which could lead to the conclusion that the silence of a party in this context could constitute an expression of a party's will. The Opposition Division's interpretation of the Appellant's silence is therefore unfounded. Its refusal to hear the party concerned at oral proceedings constitutes a severe violation of the right to be heard and thus a substantial procedural violation. The case has therefore to be remitted to the Opposition Division without regard to the merits of the case. Therefore the main request has not to be decided at this stage of the proceedings.

The Opposition Division has to undertake further prosecution which consists in this case "inter alia" of the appointment of oral proceedings and in due course of taking of a new decision.

4. The Board therefore deems it equitable to order reimbursement of the appeal fee by reason of the said substantial procedural violation (Rule 67 EPC).

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The case is remitted to the Opposition Division for further prosecution.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Kiehl

P.K.J. Van den Berg