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File No.: T 0686/92 - 3.5.1
Application No.: 85 200 641.0
Publication No.: 0 161 030
Classification: H04Q 3/545
Title of invention: Method of using a data-processing system and data-processing system

D E C I S I O N
of 28 October 1993

Applicant: N.V. Philips' Gloeilampenfabrieken
Proprietor of the patent:
Opponent: Siemens AG

Headword:

EPC:

Keyword: "Decision issued without granting request for oral proceedings"
- "Silence not to be interpreted as withdrawal of the request" -
"Substantial procedural violation"

Headnote
Catchwords



Case Number: T 0686/92 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 28 October 1993

Appellant:

(Proprietor of the patent) N.V. Philips' Gloeilampenfabrieken
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NL - 5621 BA Eindhoven (NL)

Representative:

Evers, Hohannes Hubertus Maria
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Respondent:

(Opponent)

Siemens AG
Postfach 22 16 34
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Representative:

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 13 May 1992 revoking
European patent No. 0 161 030 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: P.K.J. Van Den Berg
Members: R. Randes
G. Davies

Summary of Facts and Submissions

I. By decision dated 13 May 1992 the Opposition Division revoked the European patent No. 0 161 030 on the ground of lack of inventive step according to Article 56 EPC. The decision was based on two independent Claims 1 and 2.

II. The decision was taken without oral proceedings having taken place, although such proceedings had been requested by the proprietor of the patent (now Appellant) in his submission filed on 11 February 1991, in the case that the Opposition Division envisaged revoking the patent. In the decision, the Opposition Division concluded:

"After having fully considered the grounds of opposition ... and the submissions of the proprietor ..., the Opposition Division is of the opinion that the questions at issue are sufficiently clarified in order to reach a decision in written proceedings. This opinion was communicated with C1 (communication dated 2 October 1991 the Board's remark) to the proprietor, who requested oral proceedings, together with a detailed reasoning concerning the patentability of the claims. In C1 the proprietor was invited to declare maintenance of the request for oral proceedings. Since the proprietor did not respond to the above invitation, the Opposition Division considers that there is not a valid request for oral proceedings, Article 116(1)."

III. Notice of appeal was filed on 10 July 1992 and the appeal fee paid the same day. On 14 September 1992 a statement of grounds of appeal was filed.

- IV. In the statement of grounds of appeal the Appellant criticised the decision taken by the Opposition Division and suggested that the reasoning of the decision did not take into account the specific features of the method according to the patent in suit. To more clearly emphasise the differences between the known method and the prior art a new Claim 1 was proposed. Claim 2 remained unamended. The Appellant requested the Board to set aside the decision of the Opposition Division and to maintain the patent with the enclosed new Claim 1 and Claim 2.
- V. The Respondent replied by letter dated 2 February 1993 requesting dismissal of the appeal.
- VI. Both parties requested oral proceedings in case the Board was minded to find against them.

Reasons for the Decision

1. The appeal is admissible.
2. It is an undisputed fact that the Appellant filed a request for oral proceedings to be held in the event the Opposition Division intended to revoke the patent and, moreover, 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 was filed. However, the Opposition Division interpreted the fact that the Appellant (Proprietor of the patent) remained silent with regard to the said communication C1 (see under Paragraph II above), wherein the Opponent was asked to indicate whether he maintained his request for oral proceedings, as a withdrawal of that request.

3. In proceedings before the Opposition Division, oral proceedings take place either at the instance of the Opposition Division or at the request of a party (Article 16(1) EPC). In the case of a request by a party there is no room for discretion on the side of the Opposition Division and the Opposition Division has no power to issue a decision adversely affecting such party without first appointing oral proceedings. Moreover, as has been pointed out by the Boards in earlier decisions (cf. the unpublished decisions T 766/90, T 35/92 and a recent decision by this Board, T 795/91, also unpublished) silence on the part of a party must not be interpreted as withdrawal of a request for oral proceedings. Thus in the present case the decision of the Opposition Division must be set aside as void and of no legal effect, even though the Appellant himself has not requested the decision to be set aside because of said reasons (cf. T 598/88, not published).
4. In the Board's judgement, the failure by the Opposition Division to hold oral proceedings in response to a clear request by the Appellant is clearly a substantial procedural violation and the Board therefore deems it equitable to order reimbursement of the appeal fee (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