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File No.: T 0892/92 - 3.3.1
Application No.: 85 302 769.6
Publication No.: 0 160 469
Classification: G03C 7/26
Title of invention: Light-sensitive silver halide multi-layer color
photographic material

D E C I S I O N
of 24 June 1993

Applicant: -
Proprietor of the patent: KONICA CORPORATION
Opponent: Agfa-Gevaert AG, Leverkusen

Headword: Remittal/KONICA

EPC: Art. 101(2), 111(1), 113(1) and 116(1); R. 67

Keyword: "Termination of opposition proceedings after remittal without
previous notification; procedural violation"

Headnote

Art. 113(1) EPC requires that an express opportunity to present observations be given to the parties by the Opposition Division after remittal to it of a case by a Board of Appeal for further prosecution on the basis of new evidence, even if submissions with respect to this new evidence have already been made during the preceding appeal proceedings (point 2.1 of the Reasons).

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DECISION
of 24 June 1993

Applicant: KONICA CORPORATION
Proprietor of the patent:
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previous notification; procedural violation"

Headnote

Headnote follows



Case Number: T 0892/92 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 24 June 1993

Appellant: KONICA CORPORATION
(Proprietor of the patent) 26-2, Nishi-shinjuku 1-chome
Shinjuku-ku
Tokyo (JP)

Representative: Ellis-Jones, Patrick George Armine
J.A. KEMP & CO.
14 South Square
Gray's Inn
London WC1R 5EU (GB)

Respondent: Agfa-Gevaert AG, Leverkusen
(Opponent) -Patentabteilung-
Postfach
W - 5090 Leverkusen 1 (DE)

Representative:

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 19 December 1990
revoking European patent No. 0 160 469 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: K.J.A. Jahn
Members: R.K. Spangenberg
J.A. Stephens-Ofner

Summary of Facts and Submissions

I. European patent No. 0 160 469 was granted on 2 November 1988 on the basis of ten claims in response to European patent application No. 85 302 769.6. A notice of opposition was filed on 13 February 1989, requesting the revocation of the patent in its entirety on the grounds of lack of novelty and inventive step. By teletype of 19 April 1990, confirmed by letter of 27 April 1990, the Patentee filed new Claims 1 to 9 and a correspondingly amended description. He also requested oral proceedings if the Opposition Division were not prepared to maintain the patent as amended. By an interlocutory decision dated 19 December 1990 the Opposition Division maintained the patent in amended form. Consequently, no oral proceedings were held.

Notice of Appeal, accompanied by a Statement of Grounds, was lodged by the Opponent on 8 February 1991, who relied solely on six documents never cited before. During the appeal proceedings, the Patentee filed a statement setting out the reasons why, in his opinion, the late filed documents did not prejudice the maintenance of the patent in amended form.

By its decision T 110/91, dated 24 April 1992 and notified to the parties on 5 May 1992, the Board remitted the case to the Opposition Division for further prosecution on the basis of the newly cited documents. In this decision, the Board expressed its doubts about the novelty of the then claimed subject-matter in the light of the new citations, but refrained from deciding this issue, in order to give the parties an opportunity to have it considered by two instances. For the same reason, the Patentee's request for an award of costs was left undecided, although the Board was not satisfied by

the Opponent's justification for the belated filing of these documents.

- II. Thereafter, and without any further notification or invitation to the parties for comments the Opposition Division revoked the patent by its decision of 31 July 1992, holding that, whilst the claimed subject-matter was novel in the light of the new citations, it lacked any inventive step. The Patentee's request for an award of costs having regard to the belated filing of the new documents was also rejected.

- III. On 23 September 1992 the Patentee lodged an appeal against this decision and paid the appropriate fee. A Statement of Grounds of Appeal was received on 27 November 1992.

- IV. The Appellant (the Patentee) argued that the manner in which the case had been handled by the Opposition Division after the Board had remitted it was contrary to the requirement of Article 101(2) EPC, since the case was decided without inviting the parties to file their observations. Furthermore he submitted that the oral proceedings he had originally requested had never taken place, in contravention of Article 116(1) EPC, and, therefore, the proceedings suffered from a substantial procedural violation.

In addition, he filed a set of eight new claims, together with the results of further comparative tests. New Claim 1 contained the essential features of Claims 1 and 5 on which the decision under appeal was based (corresponding to Claims 1, 2 and 6 as granted). In the light of the additional test results it became, so he argued, immediately clear that the reasons for the decision under appeal no longer applied to the subject-matter of the new claims.

- V. The Respondent indicated that he did not intend to comment on the Statement of Grounds of Appeal.

- VI. The Appellant requests that the decision under appeal be set aside and the patent maintained on the basis of the new claims. He further requests that the appeal fee be refunded pursuant to Rule 67 EPC.

The Respondent has not submitted any request.

Reasons for the decision

- 1. The appeal is admissible.

- 2. The first issue to be decided in these appeal proceedings is whether or not the proceedings before the Opposition Division that took place after remittal suffer from a substantial procedural violation, as was submitted by the Appellant.
 - 2.1 The main provision that is relevant to this issue is that of Article 113(1) EPC, which governs all proceedings before the EPO, and therefore also determines the meaning of the term "necessary" in Article 101(2) EPC, upon which the Appellant relied (see also decision T 669/90, OJ. EPO 1992, 739, point 2.3 of the reasons).

Article 113(1) provides that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. If the parties can be said to have been surprised, from an objective point of view, by the decision and the grounds and evidence on which it is based, then this opportunity cannot have been sufficiently granted. In other words, in the Board's

judgment, the term "opportunity" in this article can only be given effective meaning by applying the principle of good faith and the right to a fair hearing. However, it is obvious in the light of these principles that no such opportunity can exist where, as in the present case, a remittal by a Board of Appeal for further prosecution on the basis of new evidence is immediately, i.e. without any intervening communication announcing the resumption of the proceedings, followed by the revocation of the patent. For such an opportunity to exist, it is therefore necessary that the parties be expressly asked whether or not they wish to present, preferably within a fixed period of time, their comments, or if, as in the present case, the parties have already made detailed submissions during the preceding appeal proceedings, whether or not these submissions should be regarded as complete. Having regard to the fact that the resumed proceedings are governed by the existing requests, it is also desirable, at the same time to clarify whether any requests submitted originally, i.e. before the opposition proceedings were interrupted by the appeal proceedings, are maintained, modified or withdrawn (e.g. a request for oral proceedings) or whether further requests will be submitted.

For this reason, the Board finds that the immediate termination of the opposition proceedings following remittal was not in accordance with the provision of Article 113(1) EPC and, therefore, constituted a substantial procedural violation within the meaning of Rule 67 EPC, and the decision under appeal must be set aside. Since the appeal was clearly caused by this substantial procedural violation, the reimbursement of the appeal fee is also equitable.

- 2.2 Whilst it is not strictly necessary for the purposes of this decision, the Board has also considered the Appellant's submission that the original request for oral proceedings had been revived on remittal and was therefore legally effective, but, contrary to Article 116(1) EPC, had not been taken into account by the Opposition Division.

In the present circumstances, the Board is of the opinion that "further prosecution" proceedings on remittal by the Board of Appeal should be regarded as a continuation of the original opposition proceedings, particularly so, since the original interlocutory decision to maintain the patent as amended was set aside by the Board of Appeal and was therefore no longer legally effective. Consequently, the Patentee's original requests, which have never been withdrawn or amended, i.e. his main request to maintain the patent in amended form on the basis of the claims submitted with his counterstatement to the notice of opposition as well as his subsidiary request for oral proceedings became once more effective after remittal, so that the Opposition Division should not have taken a decision adversely affecting the Patentee, without giving him an opportunity to present his case orally (Article 116(1) EPC).

3. Since the Opposition Division has had no opportunity to consider the new set of claims in the light of the comparative test results filed together with the Statement of Grounds of Appeal, the Board has decided not to investigate the substantive questions of patentability but, and again in order to give the parties the opportunity to have these questions considered by two instances, to exercise its power under Article 111(1) EPC and to remit the case once more to the Opposition Division for further prosecution.

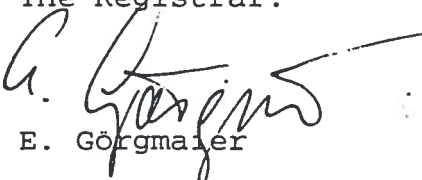
4. The Board is concerned that this case is again having to be remitted without a final decision on the substantive issues. The Board therefore observes that the aim to streamline the proceedings before the EPO, an aim which is strongly supported by the Boards of Appeal, cannot be reached at the expense of the parties' right to a fair procedure.

Order

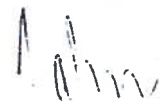
For these reasons, it is decided that

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of the claims submitted on 19 November 1992.
3. The appeal fee is to be refunded.

The Registrar:


E. Görgmaier

The Chairman:


K.J.A. Jahn