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D E C I S I O N
of 12 April 1995

Case Number: T 0081/93 - 3.2.4

Application Number: 83303751.8

Publication Number: 0098733

IPC: B07C 5/16

Language of the proceedings: EN

Title of invention:
Egg processing system

Patentee:
DIAMOND AUTOMATIONS INC.

Opponent:
Terpa Poultry B.V.

Headword:
Egg processing

Relevant legal provisions:
EPC Art. 111(1)
Rules 67 and 68(2)

Keyword:
"Remittal - decision not reasoned for the subsidiary request"

Decisions cited:
T 0234/86, T 0005/89

Catchword:
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Case Number: T 0081/93 - 3.2.4

D E C I S I O N
of the Technical Board of Appeal 3.2.4
of 12 April 1995

Appellants: DIAMOND AUTOMATIONS INC.
(Proprietor of the patent) 23400 Haggerty Road
Farmington
Michigan 48024 (US)

Representative: Bayliss, Geoffrey Cyril
BOULT, WADE & TENNANT
27 Furnival Street
London EC4A 1PQ (GB)

Respondent: Terpa Puoltry B.V.
(Opponent) Postbus 7
NL-3770 AA Barneveld (NL)

Representative: Smulders, Theodorus A.H.J., Ir.
Vereenigde Octrooibureaux
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dispatched on 17 November
1992 revoking European patent No. 0 098 733
pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: C. A. J. Andries
Members: P. Petti
J. P. B. Seitz

Summary of Facts and Submissions

- I. The European patent No. 98 733 was opposed on the grounds of Article 100(a) EPC.
- II. During the opposition proceedings, the Proprietor (Appellants) requested the maintenance of the patent in amended form on the basis of independent Claims 1 and 15 filed with the letter of 28 June 1991 (main request).

Furthermore, during the opposition proceedings, the Proprietor submitted a auxiliary request based on independent Claims 1 and 14 filed by facsimile on 16 October 1992.

- III. On 20 October 1992 oral proceedings were held before the Opposition Division. The Opposition Division accepted the introduction of the auxiliary request into the proceedings.
- IV. According to the impugned decision, the Opposition Division decided that the subject-matter of Claims 1 and 15 of the main request did not involve an inventive step. Furthermore, in the impugned decision (section IV, page 9) it is stated that: "... independent Claims 1 and 14 of the Patentees' auxiliary request do have novelty. However ... it became evident ... that there were serious doubts as to whether those independent claims satisfy the clarity requirements of Article 84 EPC ... The Division did not have sufficient time to consider the clarity of the claims ... The issue of the clarity of the independent claims of the auxiliary request was not fully discussed and the Division reached no decision as to whether those claims were clear. Likewise the Division took no decision as to whether those claims have inventive step".

- V. According to the minutes of the oral proceedings (section 9), the Opposition Division asked the Appellants whether "they wished to abandon their main request and to proceed with the auxiliary request as their new main request". In its decision the Opposition Division stated that: "... when the Patentees indicated during the oral proceedings that they wished to maintain their main request ... the Division decided simply to revoke the patent".
- VI. On 18 January 1993 the Appellants filed an appeal against this decision and simultaneously paid the appeal fee. A statement setting out the grounds of appeal was received on 26 March 1993.
- VII. The Appellants request that the decision under appeal be set aside and the patent be maintained on the basis of a new set of Claims 1 to 12 filed with the statement of grounds of appeal.
- VIII. The Respondents request that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. According to Rule 68 (2) EPC, "decisions of the European Patent Office which are open to appeal shall be reasoned ...". This Rule obviously applies to the decisions of an Opposition Division which are open to appeal before the Boards of Appeal.

According to the established jurisprudence of the Boards of Appeal, such a reasoned decision must be given by the Opposition Division for each of the different requests

of the patent proprietor for the maintenance of the patent (main and auxiliary requests) before issuing a decision revoking the patent (see T 234/86, OJ EPO 1989, section 5.8). The Opposition Division must therefore ensure that, before issuing a decision revoking the patent solely on the basis of the patent proprietor's main request, the proprietor has expressly withdrawn all subordinate requests (see T 5/89, OJ EPO 1992, section 2.2).

Therefore, if the patent proprietor files one or more auxiliary requests relating to the maintenance of the patent and does not withdraw it or them, an Opposition Division issuing a decision revoking the patent is obliged to give reasons in its decision why each auxiliary request is not allowable. If this is not done, then the requirement of Rule 68(2) EPC cannot be considered to be fulfilled.

3. In the present case, the Opposition Division gave reasons why the main request of the Appellants was unallowable and revoked the patent without considering the remaining auxiliary request.

Indeed, having regard to the statements on page 9 of the impugned decision (see section IV above), it cannot be held that a decision with respect to the remaining auxiliary request was taken by the Opposition Division.

Moreover, since the reasons given with regard to the main request cannot be interpreted as being implicitly directed to the auxiliary request and since there is no indication in the opposition file that the patent proprietor had withdrawn its auxiliary request, the Board comes to the conclusion that the Opposition Division has contravened Rule 68(2) EPC.

Such a contravention constitutes a substantial procedural violation which justifies the reimbursement of the appeal fee (Rule 67 EPC).

4. Claims 1 to 12 filed with the Statement of Grounds of Appeal replace the claims upon which the decision under appeal is based.

In the present independent Claim 1, which is directed to an egg transfer apparatus comprising means, disposed at eggs receiving stations, for releasing the eggs from a first conveyor means, the adjustment of the position of the releasing means in relation to the speed of the first conveyor means and the adjustment of the conveyor speed in relation to the position of the releasing means are set out as alternatives.

In this independent Claim 1 many features are specified which were not specified in Claim 1 according to the main request submitted by the Appellant during the opposition proceedings but which were specified in Claim 1 according to the auxiliary request. The present Claim 1 therefore differs substantially from the Claim 1 upon which the impugned decision is based.

The subject-matter of the present independent Claim 1 - in the first alternative - essentially constitutes a further modification of the subject-matter of the Claim 1 according to the auxiliary request submitted by the Appellant during the opposition proceedings. With regard to this claim, the question of whether its subject-matter involves an inventive step within the meaning of Article 56 EPC has not been considered either explicitly or implicitly by the Opposition Division.

Moreover, the present independent Claim 1 - in its second alternative - specifies some features which were not specified in Claim 1 according to each of the main or auxiliary requests submitted by the Appellants during the opposition proceedings.

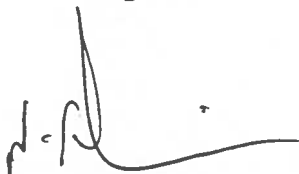
5. Having regard to sections 2 to 4 above and in order to give both parties the opportunity of having two instances, the Board exercises its discretion according to Article 111 (1) EPC and remits the case to the Opposition Division for further prosecution on the basis of the claims filed with the Statement of Grounds of Appeal.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of the Appellants' request submitted with its Statement of Grounds of Appeal of 26 March 1993.
3. The appeal fee is to be reimbursed.

The Registrar:



N. Maslin

The Chairman:



C. Andries

