

Internal distribution code:

- (A) [ ] Publication in OJ  
(B) [X] To Chairmen and Members  
(C) [ ] To Chairmen

D E C I S I O N  
of 12 January 1994

Case Number: T 0263/93 - 3.3.1

Application Number: 86103844.6

Publication Number: 0203296

IPC: C09D 3/48

Language of the proceedings: EN

Title of invention:

A liquid coating composition and a process for coating a substrate with such coating composition

Patentee:

Akzo N.V.

Opponent:

BASF Lacke + Farben Aktiengesellschaft, Münster

Headword:

Opportunity to present comments/AKZO

Relevant legal norms:

EPC Art. 101(2), 113(1)  
EPC R. 67

Keyword:

"Decision based on facts to which a party to the proceedings had no opportunity to present comments"  
"Fair procedure (no)"  
"Substantial procedural violation"  
"Reimbursement of the appeal fee (yes)"

Decisions cited:

T 0669/90, T 0275/89, T 0892/92, T 0439/91

.../...

**Catchword:**

The right to be heard laid down in Article 113(1) EPC requires that the party concerned be given sufficient time to submit an adequate response, if the EPO decides to communicate to a party to proceedings before it an objection raised by another party without an express invitation to reply within a specified time limit. Although the length of the period of time necessary to comply with that requirement depends on the particular circumstances of the case, a party to opposition proceedings before the EPO can fairly expect that it would normally have at least two months to present its comments to such objections, before a decision based on them is taken (point 2.2.2 of the reasons).



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0263/93 - 3.3.1

DECISION  
of the Technical Board of Appeal 3.3.1  
of 12 January 1994

**Appellant:** Akzo N.V.  
(Proprietor of the patent) Velperweg 76  
NL - 6824 BM Arnhem (NL)

**Representative:** Schalkwijk, Pieter Cornelis  
Akzo N.V.  
Patent Department (Dept. APTA)  
PO BOX 9300  
NL - 6800 SB Arnhem (NL)

**Respondent:** BASF Lacke + Farben Aktiengesellschaft  
(Opponent) Münster  
-Patentabteilung-  
Max-Winkelmann-Straße 80  
Postfach 61 23  
D - 48165 Münster (DE)

**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office dated 22 December 1992  
revoking European patent No. 0 203 296 pursuant to  
Article 102(1) EPC.

**Composition of the Board:**

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

## Summary of Facts and Submissions

- I. European patent No. 0 203 296 was granted on 27 September 1989 on the basis of 16 claims in response to European patent application No. 86 103 844.6. A notice of opposition was filed on 16 June 1990 and revocation of the patent in its entirety on the grounds of lack of novelty and inventive step was requested. On 8 May 1992 oral proceedings were held. During these proceedings, one main and five auxiliary requests were considered. In the minutes of these oral proceedings it was stated that after detailed discussion it became apparent that the composition defined in the main claim of the fifth auxiliary request was novel, which was conceded by the opponent. For the decision on inventive step, the results of comparative tests submitted by the Patentee during the oral proceedings were considered relevant. Thus it was announced that the proceedings were to be continued in writing, and that the Opponent was given six months to present his observations in respect of these test results. Such observations were received on 9 November 1992 and communicated to the Patent Proprietor on 16 November 1992 with a cover letter in which the box "please take note" was crossed. By a decision notified to the parties on 22 December 1992 the Opposition Division revoked the patent.
- II. The Opposition Division considered *inter alia* that one part of the subject-matter of Claim 1 according to the fifth auxiliary request was not novel in the light of
- (4) EP-A-0 040 288,
- and the other parts lacked any inventive step in respect of the disclosure in that document since their subject-matter was an obvious selection therefrom. Following the

line of argument presented by the Opponent in his observations received on 9 November 1992, the Patentee's test results were said to be unsuitable to demonstrate a surprising effect and, thereby, non-obviousness. In addition, objections under Article 84 EPC were raised against the amended claim according to the fifth auxiliary request.

III. On 18 February 1993 the Appellant (Patentee) lodged an appeal against this decision and paid the appropriate fee. A Statement of Grounds of appeal was received on 19 April 1993, in which the Appellant argued that the decision under appeal did not satisfy the provisions of Articles 101(2) and 113(1) EPC since he had not been given an opportunity to answer the Opponent's assertions. In addition, he contested the Opposition Division's finding that Claim 1 of the fifth auxiliary request lacked novelty and inventive step.

IV. The Respondent (Opponent) maintained the position that the subject-matter of the fifth auxiliary request lacked inventive step, since the comparative tests submitted by the Appellant during the opposition proceedings did not compare the claimed subject-matter with the structurally closest related compositions of the state of the art and were therefore not suitable to demonstrate unexpected properties of the claimed compositions.

V. The Appellant requests as his main request that the decision under appeal be set aside, the case be remitted before the Opposition Division and the appeal fee reimbursed. Alternatively, he requests reconsideration of the fifth auxiliary request made before the Opposition Division and a hearing.

The Respondent requests as his main request that the appeal be dismissed and, alternatively, oral

proceedings. In response to a communication of the Board he limited that latter request to the event that the Board would intend to consider not only the procedural questions raised by the Appellant's main request but would give an opinion on the substantive questions of patentability.

### Reasons for the Decision

1. The appeal is admissible.
2. According to the above main request, it falls at first to be decided whether the decision under appeal satisfies the provisions of Articles 101(2) and 113(1) EPC.
  - 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 decisions T 669/90, OJ EPO 1992, 739, point 2.3 of the reasons and T 892/92 of 24 June 1993, point 2.1; for Headnote of this decision see OJ EPO 12/1993).

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 (see T 892/92, point 2.1 of the reasons).

2.2 In the present case, the Appellant must necessarily have been surprised by the decision under appeal for two reasons.

2.2.1 The first reason is that during the oral proceedings held before the Opposition Division, after detailed discussion of the matter, an agreement was reached that the subject-matter of the main claim of the fifth auxiliary request was novel (see point 3 of the minutes). The Appellant could therefore not reasonably expect that this request would later on be rejected on the ground of lack of novelty, particularly so since novelty was no longer contested by the Opponent in the submissions filed in response to the result of the oral proceedings. Thus it was necessary, pursuant to Articles 102(1) and 113(1) EPC, to communicate to the parties the reasons for this change of opinion and to invite them to present their observations, particularly since the objection against the novelty of the claimed subject-matter was based on a reconsideration of the true content of document (4) and therefore on a fact on which the parties had not yet an opportunity to present their comments. For these reasons, which *mutatis mutandis* also apply to the objections under Article 84 raised for the first time in the reasons for the decision under appeal, this decision was taken in breach of the provision of Article 113(1) EPC.

2.2.2 The second reason why the Appellant must have been surprised by the decision under appeal is that the Opposition Division, after having given the Respondent a time limit of six months to present his observations in respect of comparative tests submitted by the Appellant during the oral proceedings, took a decision adversely affecting the Appellant and being based essentially on the Respondent's counterstatement, about one month after

having communicated that counterstatement to the Appellant.

In the Board's judgment, the right to be heard laid down in Article 113(1) EPC requires that the party concerned is given sufficient time to submit an adequate response, if the EPO decides to communicate to a party to proceedings before it, any objections raised by another party without an express invitation to reply within a specified time limit. Thus, it is necessary that a decision relying on such objections is not taken until an adequate period of time had expired in which the other party could have been fairly expected to present its comments. The question regarding which period of time is sufficient for this purpose (see e.g. T 22/89 of 26 June 1990, cited in T 669/90, and T 275/89, OJ EPO 1992, 126, point 3.3 of the reasons) is a question of fact which has to be answered on the basis of the merits of each particular case. However, the Board observes that, since Rule 84 requires that **any** time limit set by the EPO should not be shorter than two months, thus regardless whether or not the action required within such a time limit is simple or could be performed immediately, normally, i.e. in the absence of any exceptional circumstances, an adequate period of time for presenting comments should not be shorter than that mentioned in the above rule. Such exceptional circumstances, in which a shorter period of time was acceptable, were mentioned in point 3.3 of the reasons of decision T 275/89, because in this case the documents on which the decision under appeal was based were already mentioned in the notice of opposition together with an assessment of their substantive and legal significance, so that the decision under appeal was not based on fresh matter.



However, in the present case, even if the Board would accept that the relevance of the Respondent's counterstatement to the issue of inventive step might have been immediately apparent, so that the principle of good faith relied upon in decision T 669/90 might not have required an express invitation to file observations within a prescribed time limit, the Appellant's right to a fair procedure, which follows from Article 125 EPC (see decision T 669/90, point 2.3 of the reasons) would have required that the Opposition Division should have waited at least two months before issuing a decision based on the objections raised for the first time in this counterstatement. In any case, a period of time of about one month was in the present circumstances, where difficult technical questions had to be considered, not even sufficient to give the Appellant a realistic opportunity to inform the Opposition Division of his intention to file a substantive reply and to ask for an appropriate time limit for this purpose, let alone to present substantive comments.

2.3 Having regard to these considerations, the Board holds that the decision under appeal was taken in violation of substantial provisions of the applicable procedural law and has to be set aside for this reason alone.

3. As a consequence of these procedural defects, the Opposition Division must be deemed not to have considered the substantive issues of patentability in the light of the Appellant's observations. Therefore, any decision of the Board on these issues would necessarily deprive the Appellant of his right to have his case considered by two instances. Consequently, the Board exercises its power under Article 111(1) EPC and remits the case to the Opposition Division for further prosecution according to the Appellant's main request.

4. Since the appeal is allowed and the decision under appeal suffered from substantial procedural defects, as set out above, it is in the Board's judgment equitable that the appeal fee should be reimbursed, pursuant to Rule 67 EPC.

**Order**

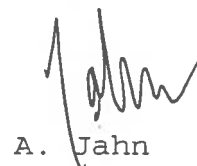
**For these reasons, it is decided that:**

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

  
E. Gorgmaier

The Chairman:

  
A. Jahn

