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DECISION
of 15 September 1995

Case Number: T 0276/93 - 3.3.3

Application Number: 86302328.9

Publication Number: 0197728

IPC: C08L 25/12

Language of the proceedings: EN

Title of invention:

Preparation of thermoformed plastics articles

Patentee:

GE CHEMICALS, INC.

Opponent:

Bayer AG, Leverkusen Konzernverwaltung RP Patente Konzern

Headword:

Applicability of Rule 71(a) EPC to the Boards of Appeal

Relevant legal provisions:

EPC Art. 23(3), 23(4), 33(1)(b), 164(2)

RPBA Art. 11(2)

EPC R. 10, 11, 71(a)

Keyword:

Applicability of Rule 71(a) EPC to the Boards of Appeal

Decisions cited:

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Catchword:

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Case Number: T 0275/93 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 15 September 1995

Appellant: Bayer AG, Leverkusen
(Opponent) Konzernverwaltung RP
Patente Konzern
Bayerwerk
D-51368 Leverkusen (DE)

Representative: -

Respondent: GE CHEMICALS, INC.
(Proprietor of the patent) Parkersburg Center
5th & Avery Streets
Parkersburg, West Virginia 26102 (US)

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14 South Square
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office dated 1 February
1993 concerning maintenance of European patent
No. 0 197 728 in amended form.

Composition of the Board:

Chairman: C. R. J. Gérardin
Members: J. A. Stephens-Ofner
H. H. R. Fessel

Summary of Facts and Submissions

- I. By its decision dated 1 February 1993 the Opposition Division maintained European patent No. 0 197 728 in the name of G. E. Chemicals Inc., in amended form.
- II. The Appellant (Opponent) who was Bayer AG, appealed against the above decision, filing his Notice of Appeal on 19 March 1993 together with the prescribed fee, and his Statement of Grounds of Appeal on 12 May 1993. By letter dated 29 November 1993 the Respondent (Patentee) responded in detail to the pleadings, evidence and arguments adduced by the Appellant, to which letter the Appellant in turn responded on 16 December 1993.
- III. The nature and scope of the single issue i.e. obviousness that calls for decision by the Board, is fully and comprehensibly set out in the pleadings, evidence and arguments to date submitted by both parties in writing.
- IV. Since the Board's decision will need to be rendered upon this one issue and nothing else, and be based on the written matters so far submitted as well as on any relevant arguments advanced in the course of oral proceedings in explanation or in amplification of them, the Board sees nothing that need, let alone should, be communicated to the parties at this stage in order either to expedite the proceedings or to clarify any of the issues in the appeal. There is therefore no reason to comply with the provisions of Rule 71(a) EPC promulgated on 1 June 1995 which rule calls for the

mandatory dispatch with the summons for oral proceedings of such a communication. In the Board's view the case stands ready for hearing, so that all that is required is a formal summons to the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. Until the promulgation of Rule 71(a) EPC the above state of affairs would not have caused any difficulty, by virtue of the existence of Article 11(2) of the Rules of Procedure of the Boards of Appeal (RPBA), duly enacted by the Administrative Council in 1980 pursuant to the special powers conferred upon it by Article 23(4) EPC and Rules 10 and 11 EPC.
3. Article 11(2) RPBA provides that "the Board may send with the summons to oral proceedings a communication drawing attention to matters which seem to be of special significance, or to the fact that questions appear no longer to be contentious or containing other observations that may help concentration on essentials during the oral proceedings".

Rule 10(2) EPC establishes the sole authority, namely the Presidium, that is responsible for determining the procedure of the Boards of Appeal pursuant to Rule 11 EPC.

4. Both the above rules give effect to Article 23(3) and (4) EPC which jointly establish the legislative basis of the independence of the members of the Boards of Appeal and thus of the Boards themselves. In particular, Article 23(3) provides that "in their decisions the members of the Boards shall not be bound by any

instructions and shall comply only with the provisions of this convention"; whilst Article 23(4) lays down that "the rules of procedure of the Boards of Appeal and the Enlarged Board of Appeal shall be adopted in accordance with the provisions of the implementing regulations. They shall be subject to the approval of the Administrative Council".

The language of Article 23(3) and 23(4) is mandatory in all three official languages. In particular, Article 23(4) in conjunction with Rules 10 and 11 EPC provides a special power, derogating from the general power conferred upon the Administrative Council by Article 33(1)(b) EPC. It follows that once the RPBA has been promulgated under this special power and via the above route, it may only be validly amended or repealed by the exercise of the same special power via the self same route as special provisions derogate from general provisions: "**generalibus specialia derogant**".

5. Rule 71(a) EPC was enacted by the Administrative Council under its general powers, and not under its special powers. The rule provides that: "when issuing the summons, the European Patent Office shall draw attention to points which in its opinion need to be discussed for the purposes of the decision to be taken at the same time the final date for making written submissions in preparation for the oral proceedings shall be fixed..."

It is obvious that Rule 71(a) is mandatory whereas Article 11(2) RPBA confers discretion upon the Boards in the sending of communications with the summons. Clearly the two procedural provisions are in direct conflict, the former to abolishing the discretion conferred by the latter.

6. In the light of this conflict between two rules, Article 164(2) EPC is, in the Board's judgement decisive, providing as it does that: "in the case of conflict between the provisions of this convention and those of the implementing regulations the provisions of this convention shall prevail." In the present case, the relevant provision with which Rule 71(a) EPC is in conflict by virtue of abolishing the discretion conferred by the RPBA is Article 23(4) EPC, under the special powers of which the RPBA had been enacted.

7. Thus the question of law arises whether the Administrative Council can, in the exercise of its general powers under Article 33(1)(b) EPC, derogate from or abrogate an existing rule of procedure, which it had already legally enacted pursuant to its special powers under Article 23(4) EPC as implemented by Rules 10 and 11 EPC. This question of law has legal as well as predominantly practical aspects, both of which make it of considerable importance within the meaning of Article 112(1)(a) EPC. The reasons for the importance of the question are as follows:

(a) New Rule 71(a) EPC infringes the independence of the Boards of Appeal, derived through the independence of its members as specifically provided for in Article 23(3) EPC. Such independence cannot be severed from the manner in which it is routinely exercised in the course of the decision-making process.

(b) The applicability of Rule 71(a) EPC to the Boards of Appeal is being interpreted in a disparate manner by the Boards. Such a lack of procedural consistency is bound to reflect adversely on the Boards' reputation.

Order

For these reasons it is decided that:

The following questions of law shall be referred to the Enlarged Board of Appeal pursuant to Article 112(1)(a) EPC:

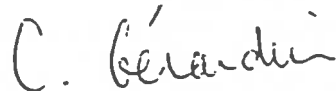
1. Does it lie within the general powers of the Administrative Council pursuant to Article 33(1)(b) EPC to change an existing rule of procedure of the Boards of Appeal which it had already enacted pursuant to special powers under Article 23(4)?
2. If the answer to the above question is "yes" to what extent, if any, does Article 23(3) EPC limit the changes which the Administrative Council may so enact?

The Registrar:



P. Martorana

The Chairman:



C. R. J. Gérardin

15/17.9.95

