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D E C I S I O N
of 5 July 1994

Case Number: T 0089/94 - 3.3.3

Application Number: 86 104 315.6

Publication Number: 0 238 702

IPC: C08J 7/04

Language of the proceedings: EN

Title of invention:

Direct coating composition for polyolefin moldings and use thereof

Applicant:

Asahipen Corporation

Opponent:

Herberts GmbH
BASF Lacke + Farben AG

Headword:

-

Relevant legal norms:

EPC Art. 113(2) EPC
EPC R. 67

Keyword:

"Decision under appeal not based on the text submitted by the Applicant"
"Substantial procedural violation"

Decisions cited:

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Catchword:

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Case Number: T 0089/94

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 5 July 1994

Appellant:

Asahipen Corporation
1-12, 4-chome Tsurumi
Tsurumi-Ku
Osaka-City
Osaka (JP)

Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office dated 24 November 1993
rejecting the opposition filed against European
patent No. 0 238 702 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Antony
Members: H.H.R. Fessel
M. Schar-Schuppisser

Summary of Facts and Submissions

- I. European patent No. 238 702 was granted with effect of 18 December 1991 on European patent application No. 86 104 315.6 filed on 27 March 1986.
- II. Oppositions were filed on 15 September 1992 by Herberts GmbH, and on 17 September 1992 by BASF AG, alleging lack of novelty and inventive step.
- III. The said oppositions were duly communicated to the Patentee requesting his observations within the usual four-month term, later extended by two months. The Patentee's observations, including experimental results, were submitted within the extended term and communicated to both Opponents giving them an "opportunity to reply" within two months. Both Opponents made use of such opportunity, and their further comments were brought to the Patentee's attention with "brief communications" dated 16 July 1993 and 29 July 1993 respectively, setting no term for reply and merely containing the sentence "Please take note".
- IV. On 16 November 1993, referring to the said brief communications, the Patentee submitted revised claims and further arguments.
- V. On 24 November 1993, the Opposition Division issued its Decision revoking the patent, based on the version thereof as granted, and disregarding the submissions referred to under IV hereinabove, to which submissions reference was only made in a later "brief communication" dated 8 December 1993, as follows:

"Your a.m. letter reached the file after dispatch of the decision dated 24.11.93. Your letter will be placed on the file and you have the possibility to appeal."

- VI. On 24 January 1994, the Patentee (Appellant) filed a Notice of Appeal and paid the prescribed fee. A Statement of Grounds (erroneously dated "23.04.1994") was received on 23 March 1994, along with a fresh set of three claims. The Appellant requests that the decision under appeal be set aside and the patent be maintained ("granted") on the basis of this set of claims.
- VII. Without awaiting the Respondents' (Opponents') observations on the appeal grounds duly communicated to them, the Board sent a communication under date of 27 May 1994, expressing its provisional view that the decision under appeal was not legally effective because it was not based on the claims which were in the case on the date it was taken and, moreover, this fact as well as the fact that the Appellant's arguments of 16 November 1993 were disregarded constituted a substantial procedural violation. The parties' early comments were invited.
- VIII. On 13 June 1994, the Appellant replied, agreeing with the above-referred view. He now requests remittal of the case to the Opposition Division for further consideration on the basis of the claims filed on 23 March 1994, as well as reimbursement of the appeal fee.
- IX. The Respondent BASF, with telefax received on 3 June 1994, indicated to have no objection to such remittal.
- X. The Respondent Herberts, in a telefax received on 27 May 1994, had asked the Board to take the fact into consideration that the claims of 23 March 1994 had

superseded those on which the Opposition Division should have decided, but he left it to the Board to remit the case without oral proceedings, in effect reserving his position on the substantive issues.

Reasons for the Decision

1. The appeal is admissible.
2. According to Article 113(2) EPC, the EPO "shall consider and decide upon ... the European patent only in the text submitted to it, or agreed, by the ... proprietor of the patent". In the present case the decision under appeal was taken on 21 November 1993, i.e. three days before the written decision was date-stamped (cf. G 12/91, point 9.1 of the Reasons, published in OJ EPO 1994, 285). This means that the Appellant had substituted fresh claims five days prior to the date at which the decision under appeal was taken; hence the Opposition Division would have had the obligation to decide upon the patent in suit in the text resulting from the said substitution of fresh claims.

While, subjectively, the Opposition Division may not have been in a position to do so, because the Appellant's submission of 16 November 1993 seems not to have reached it before the decision under appeal was taken, it is not acceptable for the parties to the proceedings to be adversely affected by such circumstances. Once a piece of mail has been received at the EPO it must be considered to have been received by the organ deciding a given case. Therefore the decision under appeal, objectively speaking, has been taken in violation of Article 113(2) EPC and for that reason cannot be maintained.

3. Moreover, such violation of Article 113(2) EPC constitutes a substantial procedural violation within the meaning of Rule 67 EPC, which in the circumstances of the case renders reimbursement of the appeal fee equitable.

4. Having arrived at the above conclusions, the Board observes obiter that, following the "brief communications" of 16 and 29 July 1993, the Appellant could indeed have reacted earlier, at least by indicating his possible intention of commenting and of submitting fresh claims. Considering, however, that Rule 84 EPC specifies normal terms for reply to official communications of between two and four months, the delay in the Appellant's reply cannot be said to have been excessive. Besides, the safest way to preclude situations such as the present one would be for the EPO to **always** set terms for reply, even in the case of "brief communications" of the type discussed here. Once such terms (and any extensions thereof) would have expired, a decision disregarding any later submission would be unobjectionable.

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 shall be reimbursed.

The Registrar:

The Chairman:

E. Görgmaier

F. Antony

