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**D E C I S I O N**  
**of 4 February 1999**

**Case Number:** T 0118/95 - 3.2.2

**Application Number:** 89200276.7

**Publication Number:** 0329220

**IPC:** C22C 38/14

**Language of the proceedings:** EN

**Title of invention:**  
Non-ageing low-alloy hot-rolled strip-form formable steel

**Patentee:**  
Hoogovens Groep B.V.

**Opponent:**  
Thyssen Stahl AG

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 107  
EPC R. 65(1)

**Keyword:**  
"Opponent not adversely affected"

**Decisions cited:**  
T 0156/90, T 0833/90, T 0562/94

**Catchword:**  
-



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Boards of Appeal

Chambres de recours

Case Number: T 0118/95 - 3.2.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.2.2  
of 4 February 1999

**Appellant:** Thyssen Stahl AG  
(Opponent) Kaiser-Wilhelm-Strasse 100  
47166 Duisburg (DE)

**Representative:** Cohausz & Florack  
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**Respondent:** Hoogovens Groep B.V.  
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**Representative:** Wentzel, Hendrik Cornelis  
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Industrial Property Department  
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**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office posted 1 December  
1994 concerning maintenance of European patent  
No. 0 329 220 in amended form.

**Composition of the Board:**

**Chairman:** W. D. Weiß  
**Members:** M. G. Noel  
J. C. M. De Preter

## Summary of Facts and Submissions

- I. European patent No. 0 329 220 was granted on 24 June 1992 with two product claims and three method claims for the manufacture of the product.
- II. Upon opposition by the appellant against the European patent, the Opposition Division decided on 1 December 1994 to maintain the patent in amended form with method claims 1 to 3 filed on 11 October 1994 according to a second auxiliary request. The main and first auxiliary requests were refused during oral proceedings for lack of inventive step.
- III. Method claim 1 as maintained reads as follows:

"Method for the manufacture of a non-ageing low-alloy hot-rolled strip-form formable steel having a composition with a carbon content in the range 0.02 to 0.10 wt %, the content of nitrogen being less than 0.02 wt %, the content of sulphur being less than 0.05 wt %, the contents of non-oxide bound titanium; nitrogen and sulphur in wt % satisfying the conditions  $Ti > 2.28 N$  and  $Ti < 3.43 N + 1.5 S$  and the steel being free from titanium carbide and niobium carbide wherein a cast steel slab with the said composition is thermally homogenized from the casting heat and then hot-rolled to a thickness in the range of 0.5 to 1.5 mm and wherein the last reduction stage is performed in a temperature range where the steel essentially has a ferrite crystal structure."

- IV. The appellant (opponent) lodged an appeal on 2 February 1995 against the first instance's decision and paid the appeal fee in due course. In its statement of grounds received on 8 March 1995, revocation of the European patent was requested on the basis of lack of novelty and inventive step of the method claims 1 and 3, having regard to the state of the art supplemented by a new document.
- V. The respondent (patentee) replied by letter dated 26 September 1995 and requested rejection of the appeal as inadmissible and maintenance of the patent as amended in the decision under appeal. Decision T 156/90 and T 833/90 were cited to support its allegations against admissibility of the appeal. The appellant replied to the respondent's contentions by letter dated 19 August 1996.
- VI. In a communication sent to the parties on 2 October 1998 the provisional opinion of the Board was, having regard to the statements made in the contested decision and in the minutes of oral proceedings, that the appellant appeared *prima facie* to be adversely affected by the decision under appeal and, therefore, entitled to appeal under Article 107 EPC.
- VII. By response dated 4 January 1999, the respondent maintained its view of considering the appeal as inadmissible, drawing the attention of the Board more particularly on the opponent's statement made in item 1 of the minutes. In addition, an auxiliary request was filed, incorporating amended method claims.

VIII. Oral proceedings were held on 4 February 1999 during which the parties argued as follows:

(i) The appellant:

- It was clear from the very beginning of the opposition proceedings that revocation of the patent was requested with respect to all claims, i.e. also with respect to the claims related to the method.
- The appellant was not given enough time to comment on the claims filed late (11 October 1994) by the respondent and, consequently, received by the appellant less than one month before the holding of the oral proceedings before the Opposition Division.
- At the oral proceedings before the Opposition Division the appellant never gave its agreement as to maintenance of the patent with the claims according to the second auxiliary request. "No further comment" (minutes, point 10) or "no objection to the method claims" (minutes, point 8) actually meant that there was no use repeating all what had been already said with respect to the main or the first auxiliary requests in the statement of grounds of opposition or during oral proceedings. The respective statements by the first instance originated, therefore, from a misunderstanding.
- T 156/90 cited by the respondent was irrelevant to the present case, since the appellant's consent to the maintenance of the patent there was subject to further amendments to be applied to the claims. T 833/90, however, was applicable in the present case, because the Board had to

decide in favour of admissibility of the subsequent appeal if there were any doubt as to the opponent's agreement to the form the patent was maintained by the first instance.

(ii) The respondent:

- Method claims 1 to 3 according to the second auxiliary request had never been challenged by the appellant in the course of the opposition proceedings, including oral proceedings, although they were filed early in response to the statement of grounds of opposition and contained a number of significant amendments with respect to the version as granted.
- At the start of the oral proceedings the appellant clearly did not request revocation of the patent based upon the second and the third auxiliary requests (minutes, point 1). Further, while the second auxiliary request was specifically discussed, the appellant still had, consistently, no objection against the method claim 1 according to this request (minutes, point 8 and decision, page 8).
- Given that the appellant had no objection against the maintenance of the patent as amended according to the second auxiliary request, which became later on the main request, it was not adversely affected by the decision of the Opposition Division (Article 107 EPC). Consequently, the appeal should be dismissed as inadmissible, in line with the previous case laws of the Boards T 156/90, T 833/90 and T 562/94.

## Reasons for the Decision

1. At the beginning of the oral proceedings before the Opposition Division the appellant's requests were clearly confined to the revocation of the patent on the basis of the sets of claims according to the main and first auxiliary requests. As a matter of fact, it is expressly mentioned in the minutes of oral proceedings (point 1): "He (the opponent) does not request revocation based upon the second and third auxiliary requests". These requests contained only method claims.

These method claims 1 to 3, which according to the decision under appeal meet the requirements of the EPC, were filed by the respondent for the first time on 23 September 1993 in response to the statement of grounds of opposition by the appellant. Method claim 1 (see point III above) was formulated by incorporating features from claims 1, 3 and 4 of the version as granted along with an additional feature (the last one) taken from the description (cf. page 3, lines 29 to 31). Since the filing of these new method claims which was long before the oral proceedings, the appellant had never raised any objection against these method claims although they contained major amendments when compared with the respective version as granted.

2. After the main and the first auxiliary requests had been refused during oral proceedings before the Opposition Division, the discussion turned more specifically to the second auxiliary request. At this point, the minutes (point 8) state once more: "The second auxiliary request is now subject for discussion. The opponent has no objection to the method of claim 1 according to this request".

The respondent having been given an opportunity to comment on the merits of the method at issue, the first instance announced its favourable opinion. As a consequence thereof the second auxiliary request was transformed to the main request. At this time, the appellant still had "no further comment" (cf. minutes, point 10). This consistent behaviour of the appellant is, again, summarised in the decision under appeal (cf. point 5.2 of the reasons) as follows: "It is noted in this context that, in the oral proceedings, the opponent did not present any counterarguments with respect to the novelty and to inventive step of the claimed method, and neither did he have any objection to the second (or third) auxiliary request".

Therefore, the Board is satisfied that from the very beginning of the opposition proceedings the appellant never intended to dispute the method claims according to the second auxiliary request neither to their form nor their substance.

3. It is true that the appellant originally requested revocation of the patent in its entirety, i.e. also of the method claims in the version as granted. However, the various and substantive amendments introduced by the respondent necessarily called for new comments on behalf of the appellant, because the objections raised in the statement of grounds of opposition against the claims as granted had become superseded. Since the appellant never expressed its view and even refused to comment upon the different amendments on several occasions, such constant silence seemed to indicate that the appellant had no objection against it.



This was confirmed explicitly and unambiguously at the oral proceedings, as appears from the different statements of the appellant referred to in the minutes of the oral proceedings and in the decision as cited above.

As to the physical inability of the appellant to present its comments in time, that is before the oral proceedings, the Board cannot accept this argument since the method claims at issue were already on file well before the one month time-limit given by the first instance. The appellant did not seize the last opportunity to comment on the method during oral proceedings before the Opposition Division, the aim of which is however to give the parties a final occasion to comment on the points at issue.

4. Article 107 EPC, first sentence, provides that any party to proceedings adversely affected by a decision may appeal. In the present case the appellant's consistent behaviour before the Opposition Division is to be interpreted as consent to the claims now under appeal. Consequently, the Board finds that the appellant is not adversely affected by the first instance's decision and, therefore, not entitled to appeal.

This reasoning is in line with decision T 562/94, 29 November 1995 (not published) (cf. points 1.1. to 1.3) which comes closest to the present case. Decision T 156/90, 9 September 1991 (not published) is not applicable in the present case because the appellant's agreement to the maintenance of the patent was conditional on the claims to be amended exactly in the

way requested by the first instance, which actually occurred. In decision T 833/90, 19 May 1994 (not published) admissibility of the appeal was accepted because some doubt still remained whether the opponent had agreed. In the present case, the Board cannot see any doubt.

5. For all these reasons, the present appeal must be dismissed as inadmissible, under the provisions of Article 107 and Rule 65(1) EPC..

### Order

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

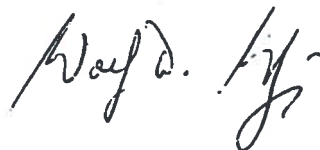
The appeal is rejected as inadmissible.

The Registrar:



S. Fabiani

The Chairman:



W. D. Weiß