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D E C I S I O N
of 15 January 1996

Case Number: T 0671/95 - 3.3.3

Application Number: 83109652.4

Publication Number: 0107795

IPC: C08F 212/12

Language of the proceedings: EN

Title of invention:

Process for preparing alpha-methylstyrene-acrylonitrile copolymers

Patentee:

KANEGAFUCHI KAGAKU KOGYO KABUSHIKI KAISHA

Opponent:

Monsanto Services International S.A.
BASF Aktiengesellschaft, Ludwigshafen

Headword:

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Relevant legal provisions:

EPC Art. 116(1)
EPC R. 67

Keyword:

"Adverse decision without granting request for oral proceedings"
"Decision null and void"
"Appeal fee reimbursed - substantial procedural violation"

Decisions cited:

T 0019/87

Catchword:

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Case Number: T 0671/95 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 15 January 1996

Appellant:
(Proprietor of the patent) KANEGAFUCHI KAGAKU KOGYO KABUSHUKI KAISHA
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Representative: Türk, Gille, Hrabal, Leifert
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Respondents:
(Opponent) Monsanto Services International S.A.
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P.O. Box 21
B-1150 Bruxelles (BE)

Representative: -

(Opponent) BASF Aktiengesellschaft, Ludwigshafen
-Patentabteilung - C6-
Carl-Bosch-Strasse 38
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 1 June 1995 revoking
European patent No. 0 107 795 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: C. Gérardin
Members: B. ter Laan
J. Stephens-Ofner

Summary of Facts and Submissions

- I. Mention of the grant of European patent No. 0 107 795 in respect of European patent application No. 83 109 652.4, filed on 28 September 1983, claiming priority from an earlier application in Japan (173738/82 of 1 October 1982), was announced on 30 December 1992, on the basis of one claim.
- II. On 29 September 1993 and 30 September 1993 respectively, two Notices of Opposition against the granted patent were filed, in which the revocation of the patent in its entirety was requested. Oral proceedings were requested in case the Opposition Division would intend to maintain the patent.
- III. By a letter dated 12 April 1994 the Proprietor requested an extension by two months of the time limit of four months set by the Opposition Division for responding to the oppositions. It also requested to "... reject the oppositions and to maintain the patent in its full scope. As an auxiliary request we ask to set a term for an oral hearing.". By letters of 10 June 1994 and 12 August 1994 further extensions of two months each were requested and granted to a total of 10 months. The response to the last request contained an indication that this extension was granted "exceptionally". By a letter dated 12 October 1994, yet a further extension of two months was requested, which was refused. A final date by which a response would have to be filed was set at 14 November 1994. In none of the further requests for extension of the time limit any mention was made of oral proceedings. At the date of the Opposition Division's decision the Proprietor had failed to make a substantial response to the Notices of Opposition.

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- IV. By a reasoned decision issued on 1 June 1995, the Opposition Division revoked the patent.
- V. The Appellant (Proprietor) lodged an appeal against the above decision on 5 August 1995 and paid the prescribed fee at the same time. In the Notice of Appeal the Appellant pointed out that the Opposition Division had revoked the patent without taking into consideration the Proprietor's request for oral proceedings as submitted in its letter of 12 April 1994. The Statement of Grounds of Appeal was filed on 11 October 1995 and contained five pages of substantive arguments.
- VI. In the Counterstatements filed on 27 December 1995 and 24 October 1995, respectively, the Respondents (Opponents) took the opposite view regarding the patentability. Respondent 1 argued additionally that in case of remittal to the first instance, the technical information provided after issuance of the decision should not be taken into account and the oral proceedings should take place solely on the basis of the documents that were on file at the date of the decision, 1 June 1995.
- VII. The Appellant requested that the decision of the Opposition Division be set aside and that the appeal fee be reimbursed. If these requests could not be satisfied, the patent should be maintained in its entirety and, in case these requests could not be met, oral proceedings should be arranged.

Respondent 1 requested that the appeal be dismissed and, if the case would be remitted to the Opposition Division, that it should be reconsidered solely on the basis of the documents on file at the date of the decision. If none of these requests could be met, oral proceedings were requested.

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Respondent 2 requested that the appeal be dismissed, and the request for remittal to the Opposition Division be refused, or alternatively, as an auxiliary request, oral proceedings before the Board or possibly before the Opposition Division be arranged.

Reasons for the Decision

1. The appeal is admissible.

2. It is quite clear that the sentence of the Appellant's letter dated 12 April 1994 quoted in paragraph III above is a request for oral proceedings under Article 116 EPC, except in the event that a decision to maintain the patent was issued. It appears from the history of the proceedings set out in paragraphs I to IV above that the failure by the Opposition Division to hold such oral proceedings was neither deliberate nor was it due to an error of interpretation, but it was caused by an oversight. Although in this case the oversight is understandable in view of the several requests for extension of the time limit and the lack of response by the Proprietor, nevertheless, as pointed out in Decision T 19/87 (OJ EPO 1988, 268), if on the proper construction of a written communication from a party it constitutes a request for oral proceedings, there is no power to issue an adverse decision without first appointing such oral proceedings. Thus in the present case the decision of the Opposition Division dated 1 June 1995 infringes the absolute right to have oral proceedings given to parties under Article 116(1) EPC and it must be set aside as being null and void.

3. As the decision of the Opposition Division is hereby to be found null and void, the Board deems that, at this stage, it would be inappropriate to consider the case any further, so that none of the parties' requests can be taken into account, including the auxiliary requests for oral proceedings. Therefore, the case is remitted to the first instance without any further proceedings before the Board.

4. Furthermore, in the Board's judgement, the failure by the Opposition Division to hold oral proceedings in response to a clear request by the Appellant, because of an oversight, constitutes a substantial procedural violation justifying reimbursement of the appeal fee under Rule 67 EPC. In the present case, having regard to the history of the proceedings, the Appellant was entitled to oral proceedings before the decision was issued, and therefore the reimbursement of the appeal fee is fully justified.

Order

For these reasons it is decided that:

- 1. The Decision of the Opposition Division dated 1 September 1995 is set aside.
- 2. The case is remitted to the Opposition Division with the order that oral proceedings under Article 116 EPC shall take place.
- 3. The appeal fee shall be reimbursed to the Appellant.

The Registrar:

E. Gorgmaier
 E. Gorgmaier

The Chairman:

C. Gérardin
 C. Gérardin



