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D E C I S I O N
of 16 May 1997

Case Number: T 0167/96 - 3.5.2

Application Number: 83300802.2

Publication Number: 0088538

IPC: G11B 7/08

Language of the proceedings: EN

Title of invention:

Optical memory system having an improved track following

Patentee:

UNISYS CORPORATION

Opponent:

I. Philips Electronics N.V.

II. Armaturen- und Apparatebau Franz Schuck GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 102(1), 113,

EPC R. 68(2), 67

RPBA Art. 10

Keyword:

"Lack of reasons in the decision - fundamental deficiency (yes)
- substantial procedural violation (yes) - but reimbursement of
appeal fee not equitable"

Decisions cited:

T 0186/84, J 0027/86

Catchword:

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Case Number: T 0167/96 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 16 May 1997

Appellant:
(Proprietor of the patent)

UNISYS CORPORATION
1, Burroughs Place
Detroit
Michigan 48232 (US)

Representative:

Carmichael, David Andrew Halliday
G. F. REDFERN & CO.
Redfern House
149/151 Tarring Road
Worthing
West Sussex BN11 4HE (GB)

Respondent:
(Opponent 01)

Philips Electronics N.V.
Groenewoudseweg 1
NL-5621 BA Eindhoven (NL)

Representative:

Groenendaal, Antonius Wilhelmus Maria
INTERNATIONAAL OCTROOIBUREAU B.V.
Prof. Holstlaan 6
5656 AA Eindhoven (NL)

Respondent:
(Opponent 02)

Armaturen- und Apparatebau
Franz Schuck GmbH
Daimlerstrasse 5
D-89555 Steinheim (DE)

Representative:

Heusler, Wolfgang, Dipl.-Ing.
Dr. Dieter von Bezold
Dipl.-Ing. Peter Schütz
Dipl.-Ing. Wolfgang Heusler
Briener Strasse 52
80333 München (DE)

Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 21 December 1995
revoking European patent No. 0 088 538 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: W. J. L. Wheeler
Members: R. G. O'Connell
B. J. Schachenmann

Summary of Facts and Submissions

- I. The appellant contests the decision of the Opposition Division revoking European patent No. 0 088 538. The reason given for the revocation was that there were no documents (filed) meeting all the requirements of the EPC.
- II. Oral proceedings were held before the opposition division on 27 January 1993 at the conclusion of which, as recorded on EPO Form 2009.2, the chairman informed the parties that: " the division intends to maintain the European patent as amended", and that: "the proprietor is to be given a period of three months within which to amend claim 1 (see minutes paragraph 27) and adapt the description."

Paragraph 27 of the minutes made it clear that the intention to maintain the patent was subject to "the following changes to the proposed new claim 1:

- Limiting claim 1 against OP4. This means moving the characterizing portion to before: "so as to cause said deflector (42) to be radially moved..."; Transferring all the features added to the original claim 1 in the new claim 1 proposed by the proprietor (handed out by the proprietor during the proceedings) to the precharacterizing part of claim 1.
- Clarifying claim 1 to: "characterized in that said linear(sic) positioning system is adapted to cause said (42)(sic) to be radially moved...".

Further the proprietor was requested to acknowledge OP12, OP2 and OP4 in the description and to adapt the description to the claims to be filed."

- III. In a communication dated 16 March 1993 the opposition division indicated, in a reasoned statement, that claim 2 then on file should be amended by deletion of the words "the sole" to avoid contravening Article 123(2) EPC. The division also informed the parties, in a reasoned statement, that the document DE-B-2 364 143, which opponent I had sought to introduce into the procedure following the oral proceedings, would be disregarded pursuant to Article 114(2). A term of three months was set for reply to this communication.
- IV. On 8 December 1993 the proprietor faxed amended pages which, in its words, "conform with the request set out in the minutes of the oral proceedings held on 27 January 1993."
- V. By a communication pursuant to Article 101(2) and Rule 58(1) to (4) EPC and dated 14 October 1994 the opposition division informed the parties that the amendments requested in the minutes of the oral proceedings had not been made in the documents submitted and that two claims numbered "8" had been filed. It concluded with the statement that:
"Maintenance of the patent in suit in amended form is only possible on the basis of documents amended with respect to the requests in paragraph 27 of the minutes of 27.01.93". The patent proprietor was invited to reply within a period of two months.
- VI. No reply having been received from the proprietor, the opposition division sent a further communication (EPO Form 2901) dated 31 January 1995 which included the information that:

"If, within the period indicated below," (two months)
"you do not request the revocation of the patent or state as above that you no longer approve the text in

which the patent was granted and if the prerequisites for the procedure pursuant to Rule 60(1) EPC are not fulfilled within that period, it is likely that the opposition proceedings will be continued pursuant to Arts. 101 and 102 EPC."

- VII. In response to telephone requests from the proprietor, copies of the communication dated 14 October 1994 were sent to the proprietor on 3 March 1995 and again on 28 April 1995 (to a newly notified address).
- VIII. No reply having been received from the proprietor, the opposition division issued the decision under appeal dated 21 December 1995. The first page of the decision (EPO form 2331) is headed "Decision revoking the European patent (Article 102(1) EPC)" and the operative part or order reads as follows:

"The opposition division - at the oral proceedings dated 27.1.93 - has decided:

European patent No. 0 088 538 is revoked."

The decision does not contain a part headed "Reasons for the decision", but the end of the "Facts and submissions" reads as follows:

"The patentee did not respond to the official communication of 14.10.1994 and the further invitations.

Hence, there are no documents meeting all the requirements of the EPC, and therefore maintenance of the Patent in suit in amended form as agreed in the Oral Proceedings of 27.1.93 is not possible.

Thus the contested patent is revoked."

- IX. On appeal the proprietor filed amended claims and description and requested that the patent be maintained as thus amended. It expressed the belief that there had been a misunderstanding concerning the amendments previously submitted.
- X. The respondents have not filed any submissions or requests in the appeal proceedings.

Reasons for the Decision

1. The appeal is admissible.
2. The decision under appeal purports to be a decision pursuant to Article 102(1) EPC. The board gleaned this much from the heading to EPO Form 2331, the rest of the decision containing no reference to any article or rule of the EPC. Such a decision is required to be reasoned (Rule 68(2) EPC) and to be based on the text submitted or agreed by the proprietor (Article 113(2) EPC) and the reasoning should normally support the opinion that the grounds for opposition prejudice the maintenance of the patent (Article 102(1) EPC). An exception to the requirement for substantive reasons arises when the patent is revoked in response to the proprietor's express withdrawal of approval of the granted text without any amended text being offered by way of replacement, or in response to the proprietor's explicit request for revocation; cf EPO legal advice 11/82, OJ EPO 1982, 57 and T 186/84, OJ EPO 1986, 79, points 4 and 5 of the reasons. In the present case the proprietor filed amended patent documents on 8 December 1993 (point IV above) and there is no suggestion anywhere in the opposition file, that the proprietor disapproved this amended text at any stage nor that it requested revocation of the patent, so that the

exception noted immediately above did not apply. The other provisions under which a patent can be revoked on formal grounds, ie Article 102(4) or (5) EPC or Rule 90(3)(a) EPC are irrelevant to the present case.

3. The nominal reason given in the impugned decision, viz, "there are no documents meeting all the requirements of the EPC" is interpreted by the board to mean that there are agreed documents on file which, in the opinion of the opposition division, do not meet all the requirements of the EPC. If in this situation the opposition division wanted to revoke the patent pursuant to Article 102(1) EPC, it was its duty to proceed in a manner complying with the requirements of Article 113(1) and (2) EPC and Rule 68(2) EPC and dealing substantively with the grounds for opposition and the requirements of the EPC which are alleged not be met. In fact the decision under appeal does not contain any substantive discussion of the grounds for opposition nor of the patent and accordingly does not meet the minimum requirements for a reasoned decision. What is offered as a reason is only the formal proximate legal ground entailing revocation as a legal consequence, whereas what is required is a clear and convincing chain of reasoning based on the facts of the case and the applicable law and yielding the conclusion that the said legal ground subsists in the present case.

4. The failure to provide reasons in a decision means that the latter lacks one of its essential elements and it is therefore void *ab initio*. This represents a fundamental deficiency in the first instance procedure within the meaning of Article 10 of the Rules of Procedure of the Boards of Appeal which, absent special reasons, entails a mandatory remittal to the department of first instance; cf J 27/86 of 13 October 1987 (published in [1988] EPOR 48). It also constitutes a

substantial procedural violation within the meaning of Rule 67 EPC which means that the question of whether reimbursement of the appeal fee would be equitable in the circumstances has to be considered.


5. The appellant has not requested reimbursement and has referred to a misunderstanding in relation to the amendments previously submitted. It is clear from the file history that the opposition division afforded the proprietor a very considerable period of time to file appropriate amendments but that the proprietor did not avail of this nor otherwise make any response which would have enabled the opposition division to divine its intentions. The appellant has now filed on appeal amendments which, it believes, overcome the outstanding objections. The board views this as a tacit acceptance on the part of the appellant that further amendments were necessary and that the lack of substantive reasons in the decision under appeal in relation to the text of 8 December 1993 was not determinative in causing the appeal to be filed. In the judgement of the board the appellant has availed of the appeal procedure to file amendments which the opposition division had sought in vain over a period of years to elicit. In such circumstances a refund of the appeal fee would not be equitable.

Order

For these reasons it is decided that:

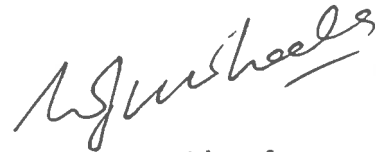
1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:



M. Kiehl

The Chairman:



W. J. L. Wheeler

