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D E C I S I O N
of 3 March 1997

Case Number: T 0394/96 - 3.2.3

Application Number: 90102682.3

Publication Number: 0386492

IPC: E02D 17/20

Language of the proceedings: EN

Title of invention:

System of vegetation strips for protection of slopes against erosion

Patentee:

Subic, Franc, Dipl.-Ing.

Opponent:

HYDROGREEN Landschaftsbau Gesellschaft m.b.H. & Co. KG.

Headword:

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Relevant legal provisions:

EPC Art. 113(1), 116(1),
EPC R. 67

Keyword:

"Substantial procedural violation"
"Reimbursement of the appeal fee (yes)"

Decisions cited:

G 0012/91, J 0007/82, T 0094/84, T 0047/94

Catchword:

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Case Number: T 0394/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 3 March 1997

Appellant:
(Opponent)

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Respondent:
(Proprietor of the patent)

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 6 March 1996
concerning maintenance of European patent
No. 0 386 492 in amended form.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. B. F. Kollar
L. C. Mancini

Summary of Facts and Submissions

- I. European patent No. 0 386 492 was granted on 18 August 1993 on the basis of five claims in response to European patent application No. 90 102 682.3
- II. A notice of opposition was received on 18 May 1994 and revocation of the patent in its entirety on the grounds of Article 100(a) EPC (lack of novelty and inventive step) and of Article 100(c) EPC (added subject-matter) was requested.
- III. In a communication dated 2 June 1995, the opposition division considering five requests on file informed the parties of its preliminary opinion that the subject-matter of claim 1 according to the main request (claim 1 as granted) was not novel, being anticipated by YU-A-1595/84 (D1) in the light of its German language translation received on 25 April 1994.

With regard to claim 1 of the first auxiliary request, the opposition division raised questions as to the clarity of the claim, but indicated that there appeared to be no prior art teaching which, starting from D1, would have led the skilled person to make changes to the known system so as to arrive at the subject-matter proposed in claim 1, so that claim 1 according to the first auxiliary request appeared to meet the requirements of Articles 52(1), 54 and 56 of the EPC.

The patentee was invited to file a new patent specification with amended claims, correctly delimited against the prior art, and to comment on the lack of clarity issue raised in the communication.

- IV. In a letter dated 26 June 1995 the opponent requested an opportunity to comment on the amendments to be filed prior to a decision being reached by the opposition division. If this were not possible, oral proceedings were requested.
- V. Amendments were filed by the patentee on 4 December 1995 and communicated to the opponent on 15 December 1995 with a covering letter including the final statement "Please take note".
- VI. On 21 February 1996 the opposition division took its decision using EPO Form 2339.3. This form bears the signatures of the three members of the opposition division and contains the following text:
- "Interlocutory decision** (Articles 102(3) and 106(3) EPC) on the amended form in which the European patent can be maintained, with the documents listed in Form 2339.4 (using Form 2327-IDOP)."
- VII. Form 2327 is date-stamped 6 March 1996 and states that account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates are found to meet the requirements of the convention, indicates that the reasons for the decision are attached on eight pages of Form 2916 together with Form 2339 relating to the documents on which it is based and draws attention to the possibility of appeal. Form 2327, with Form 2916 attached, was dispatched to the parties by registered letter with advice of delivery. The registered letters were dispatched by the EPO on 6 March 1996.

VIII. In a letter dated 26 February 1996 and received by the EPO on 28 February 1996 the opponent had submitted his comments on the new set of claims filed 4 December 1995 asserting that the amended claim 1 conflicted with Articles 84, 123(2) and 56 EPC in that its subject-matter was not supported by the description, disclosed added subject-matter and lacked inventive step with regard to the disclosure of document D1. This letter was not referred to by the opposition division in its decision.

IX. On 8 May 1996 the opponent (now the appellant) lodged an appeal against the decision of 6 March 1996, primarily arguing in his statement of grounds of appeal received 8 July 1996 that the opposition division, in the light of the appellant's request of 26 June 1995 to be given the opportunity to comment in writing or subsidiarily during oral proceedings on the amendments to be filed, should not have decided to maintain the patent on the basis of the amended claims filed on 4 December 1995 without taking into account the appellant's submissions dated 26 June 1995 and 26 February 1996. Failure to take into account these submissions constituted a breach of Article 113(1) and 116(1) EPC which justified reimbursement of the appeal fee.

The appellant formulated his requests in the statement of grounds of appeal received 8 July 1996 as follows:

- the decision under appeal to be set aside and the case to be remitted to the Opposition Division for further proceedings,
- the appeal fee to be refunded,
- subsidiarily, oral proceedings to be appointed.

- X. In the submission received 11 November 1996 the respondent defended the decision of the first instance. Regarding the requirements of Article 113(1) EPC he pointed out that the claims filed on 4 December 1995 corresponded to the former first auxiliary request on which the appellant had already filed his comments in his letter dated 2 March 1995.

The respondent requested to maintain the patent in the version on which the interlocutory decision of the opposition division of 6 March 1996 had been based, subsidiarily to maintain the patent on the basis of one of four auxiliary requests specified at page 2 of the letter dated 8 November 1996. Alternatively oral proceedings were requested.

Reasons for the Decision

1. The appeal is admissible.
2. It is established jurisprudence of the Boards of Appeal (see J 07/82, OJ 1982, 391 and T 0094/84, OJ EPO 1986, 337) that the right to be heard in accordance with Article 113(1) also guarantees the right to have the relevant grounds fully taken into account in the written decision. In the case of a decision maintaining the patent in amended form, this clearly includes not only the ground (s) for opposition themselves, but also the facts, evidence and arguments presented in support of these grounds.

A failure to do so was considered a substantial violation of the right to be heard (Article 113(1) EPC).

3. In the decision under appeal the opposition division came to the conclusion that the patent as amended in accordance with the letter of 4 December 1995 met the requirements of the EPC.

This decision had completely ignored the arguments which were brought forward by the opponent in his letter of 26 February 1996.

4. However, decision G 12/91 of the Enlarged Board of Appeal dated 17 December 1993, published in OJ EPO 5/1994, pages 285 to 295, lays down that the point in time up to which the parties can expect account to be taken of any further submission they might make lies three days, (that is three working days), before the date of dispatch stamped on the decision. In the present case, the decision under appeal bears 6 March 1996 as the date of dispatch, which, applying the period referred to in G 12/91, means that any submission of the parties received before 1 March 1996 should have been considered by the opposition division.
5. Hence, in the Board's judgment the failure to consider these arguments constitutes a violation of the right to be heard and thus a substantial procedural violation as well as a fundamental deficiency in the first instance proceedings.
6. Article 10 RPBA (Rules of Procedure of the Boards of Appeal) provides that a Board shall remit the case to the first instance, if a fundamental deficiency is apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

Since remittal of the case to the opposition division has been requested by the appellant and since the Board sees no special reason to do otherwise, the case is to be remitted to the opposition division in application of Article 10 RPBA to allow consideration of the arguments raised in the letter of 26 February 1996.

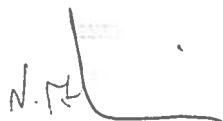
7. Moreover, since the appeal is allowed and the decision under appeal suffered from a substantial procedural violation, as set out above, it is in the Board's judgement equitable that the appeal fee should be reimbursed, pursuant to Rule 67 EPC.
8. Since the case is remitted to the first instance for further prosecution without decision as to its merits, it is, in the Board's view, neither necessary nor appropriate to appoint any oral proceedings in spite of the subsidiary requests of both parties (see T 0047/94 of 16 January 1995, not to be published).

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 is to be reimbursed.

The Registrar:




N. Maslin

The Chairman:



C. T. Wilson


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