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**D E C I S I O N**  
**of 16 October 2001**

**Case Number:** T 0361/98 - 3.3.5

**Application Number:** 84301450.7

**Publication Number:** 0122013

**IPC:** C02F 5/08

**Language of the proceedings:** EN

**Title of invention:**  
Polymeric additives for water

**Patentee:**  
CALGON CORPORATION

**Opponent:**  
Metallgesellschaft AG, Frankfurt/M  
BetzDearborn, Inc.

**Headword:**  
Polymeric additives/CALGON

**Relevant legal provisions:**  
EPC Art. 113(1), 113(2)  
EPC R. 58(4), 67

**Keyword:**  
"Procedural violation - yes, amended text not sent to the  
opponent before decision was taken."  
"Reimbursement of appeal fee - yes."

**Decisions cited:**  
G 0001/88, T 0073/84, T 1079/96

**Catchword:**

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Case Number: T 0361/98 - 3.3.5

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.5**  
**dated 16 October 2001**

**Appellant:**  
(opponent 2)

BetzDearborn, Inc.  
4636 Somerton Road  
P.O. Box 2002  
Trevose, PA 19053-6783 (US)

**Representative**

Ellis-Jones, Patrick George Armine  
J. A. Kemp & Co  
14 South square  
Gray's Inn  
London WC1R 5LX (GB)

**Respondent:**  
(Proprietor of the patent)

CALGON CORPORATION  
Route 60-Campbell's Run Road  
Robinson Township  
Pennsylvania 15205 (US)

**Representative:**

Harding, Charles Thomas  
D. Young & Co  
21 New Fetter Lane  
London EC4A 1DA (GB)

**Other party:**  
(Opponent 1)

Metallgesellschaft AG, Frankfurt/M  
-ZA Recht und Patente-  
Reuterweg 14  
Postfach 10 15 01  
D-60271 Frankfurt am Main (DE)

**Decision under appeal:**

Interlocutory decision of the Opposition Division  
of the European Patent Office posted 12 February  
1998 concerning maintenance of European patent  
No. 0 122 013 in amended form.

**Composition of the Board:**

**Chairman:** R. K. Spangenberg

**Members:** G. J. Wassenaar

J. H. Van Moer

## Summary of Facts and Submissions

- I. The appeal is from the decision of the Opposition Division dated 12 February 1998 to maintain European patent No. 0 122 013 in amended form with claims 1 to 7 and a description consisting of pages 1 to 14 both filed with the letter dated 4 November 1997.
- II. Before the decision was taken the Opposition Division issued a communication pursuant to Article 101(2) EPC, dated 3 July 1997, indicating that it was the present opinion of the Opposition Division that the subject-matter of claims 1 to 7, filed during oral proceedings before the Boards of Appeal on 6 August 1996, involved an inventive step. Reasons for this opinion were also given. The proprietor was requested to file an amended description in compliance with the amended claims. The proprietor was given a time limit of 4 months and the other parties were given the opportunity to file observations within the period mentioned. An amended description was filed on 5 November 1997 and sent to the opponents with a brief communication dated 19 November 1997 without further comment. With a letter dated 13 November 1997, the appellant (opponent 2), requested a two month's extension for replying to the communication dated 3 July 1997 to allow more time to consult with the instructing US-attorney. In a communication dated 21 November 1997, signed by the Formalities Officer, it was indicated that in the said communication only the patentee was asked to file a reply within the four-months time limit, and that the opponent might file his reply in any case but without any time limit. An interlocutory decision to maintain the patent in amended form, dated 29 January 1998, was

issued. A corrected decision was sent on 12 February 1998. In the reasons for the decision it was indicated that the opponents had had adequate time to make comments on the communication of 3 July 1997.

- III. In the statement of the grounds of the appeal, the appellant, *inter alia*, submitted that the issuance of the interlocutory decision amounted to a procedural violation since the appellant was denied a proper opportunity to present his case. The following reasons were put forward:

When the case was remitted to the Opposition Division by the Board of Appeal for further prosecution on the basis of claims 1 to 7, the original request for oral proceedings was still pending. In the earlier oral proceedings before the Opposition Division only novelty was discussed. Further oral proceedings were however justified when the issue was not something which has already been discussed during the first oral proceedings. The pending request for oral proceedings should therefore have been complied with before a decision on inventive step was reached.

In view of the communication dated 21 November 1997, giving the appellant the opportunity to file further observations, the appellant could not be expected to receive a decision without having filed observations on inventive step and amendments to the description and without oral proceedings.

The parties to the opposition proceedings were not informed of the amended form in which the Opposition Division intended to maintain the patent and were not invited to state their observations within a period of

two months if they disapprove of the text in which it was intended to maintain the patent, as required by Rule 58(4) EPC.

- IV. With respect to the issue of procedural violation, the respondent (patentee) argued that further oral proceedings can only be arranged after a request to that end and that the appellant was given sufficient time to react on the inventive step argumentation given in the EPO communication of 3 July 1997. With the letter dated 11 September 2001 the respondent withdrew its approval of the text which was agreed before the Opposition Division and which was the subject of the appeal, and indicated that no replacement text would be filed.
- V. The appellant (opponent 2) requested that the decision under appeal be set aside, that the case be remitted to the Opposition Division for further examination and the appeal fee be refunded.

### **Reasons for the Decision**

1. The appeal is admissible.
2. It follows from Article 113(2) EPC that a European patent cannot be maintained against the proprietor's will. Thus, if a proprietor of a European patent states in appeal proceedings that he no longer approves the text in which the patent was granted and will not be submitting an amended text, the patent is to be revoked (cf. T 73/84, OJ EPO 1985, 241). Withdrawal of the approval of the text which was agreed before the

Opposition Division without providing a replacement text has the same effect and thus must have the same consequence.

3. The appellant's request for refund of the appeal fee is not affected by the respondent's statement that he no longer approves of the text upon which the decision under appeal was based. The Board, therefore, still has to consider the appellant's request for refund of the appeal fee.
  
4. Before the Opposition Division decides to maintain the patent in amended form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of two months if they disapprove of the amended text (Rule 58(4) EPC). Such information and invitation has not been given. The parties were informed with a communication pursuant to Article 101(2) EPC, dated 3 July 1997, that the Opposition Division was of the opinion that the matter then claimed involved an inventive step. With the same communication the patentee (respondent) was requested to file an amended description in compliance with the new claims. With the letter dated 4 November 1997, the respondent submitted a set of amended claims 1 to 7 and an amended description. This letter with the amended claims and description was sent to the opponents with a brief communication dated 19 November 1997 and signed by the Formalities Officer, with the sole remark "Please take note". According to the file the interlocutory decision was taken on 12 January 1998 and the first version of the written decision was dated 29 January 1998.
  
5. The communication dated 19 November 1997 cannot be



regarded as a communication under Rule 58(4) EPC because it neither contains the information that the Opposition Division intends to maintain the patent in the form as proposed by the patentee, nor an invitation to submit observations within a period of two months.

6. In decision G 1/88 of the Enlarged Board of Appeal (OJ EPO 1989, 189) it is observed that Rule 58(4) EPC does not need to be applied if the amended text, on the basis of which the Opposition Division intends to maintain the patent, emanates from the patentee himself. Irrespective of this, the opponent must, however, have had - or be given - sufficient opportunity, according to the circumstances, of commenting on the new text. This opportunity can be given, especially where the written procedure is being used, through the application of Rule 58(4) EPC (points 5.2.2 and 6). Decision G 1/88 does not indicate under what circumstances in a written procedure it would be appropriate not to apply Rule 58(4) EPC. In the present case, where the appellant clearly indicated in his letter dated 13 November 1997 that he wanted to reply to the communication dated 3 July 1997, the Board holds that the application of Rule 58(4) EPC was appropriate. Even if the Opposition Division had reasons not to apply all the requirements of Rule 58(4) EPC it follows from Article 113(1) EPC that the appellant must be informed of the text in which the Opposition Division intends to maintain the patent and a time limit for commenting on the new text must be given before a decision can be taken; cf. G 1/88, point 6. The brief communication dated 19 November 1997 cannot meet these requirements because it neither contains any statement of the Opposition Division nor an invitation or a time limit for reply. The appellant

could not conclude from that brief communication that the enclosed text submitted by the patentee was accepted by the Opposition Division and that no communication according to Rule 58(4) EPC would be issued.

7. The appellant, therefore, was given no opportunity to file observations on the text with which the Opposition Division wanted to maintain the patent before the interlocutory decision was taken. Thereby the Opposition Division contravened the requirement of Article 113(1) EPC that the decisions of the EPO may only be based on grounds on which the parties concerned have had an opportunity to present their comments. This amounts to a substantial procedural violation justifying the reimbursement of the appeal fee (Rule 67 EPC). See in this respect also decision T 1079/96 of 6 November 1998, point 4 of the reasons.
  
8. In view of the above, the question whether the delivery of the contested decision without further oral proceedings contravened Article 116(1) EPC or not, needs not to be investigated.

## **Order**

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

1. The decision under appeal is set aside.
  
2. The patent is revoked.
  
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

C. Eickhoff

R. Spangenberg