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D E C I S I O N
of 22 September 2000

Case Number: T 0914/98 - 3.2.1
Application Number: 93922109.9
Publication Number: 0662053
IPC: B60R 19/42, E01F 15/00, B60J 5/04

Language of the proceedings: EN

Title of invention:
Safety beam

Patentee:
SSAB HardTech Aktiebolag

Opponent:
Benteler AG

Headword:
-

Relevant legal provisions:
EPC Art. 111(1), 113(1)
RPBA Art. 10
EPC R. 67

Keyword:
"Substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"
"Remittal to first instance (yes)"

Decisions cited:
G 0012/91, T 0275/89, T 0951/92, T 0263/93, T 0494/95

Catchword:
-



Case Number: T 0914/98 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 22 September 2000

Appellant: Benteler AG
(Opponent) Residenzstrasse 1
D-33104 Paderborn (DE)

Representative: Bockermann, Rolf, Dipl.-Ing.
Bockermann & Ksoll
Patentanwälte
Bergstrasse 159
D-44791 Bochum (DE)

Respondent: SSAB HardTech Aktiebolag
(Proprietor of the patent) SE-971 88 Lulea (SE)

Representative: Körber, Wolfhart, Dr. rer.nat.
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D-80331 München (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 4 August 1998
rejecting the opposition filed against European
patent No. 0 662 053 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: S. Crane
J. van Moer

Summary of Facts and Submissions

- I. European patent No. 0 662 053 was granted on 9 April 1997 on the basis of European patent application No. 93 922 109.9.

Claim 1 of the granted patent reads as follows:

"A bar construction, in the form of a vehicle mounted safety bar for protection in the event of collisions, particularly side-on collisions, said bar having a generally trapezoidal and open cross-section which includes a centre-flange (6) which is embraced by two webs (7), and a side-flange (8) which extends outwardly on each side of the bar and connects with a respective web (7), wherein the bar optionally includes a first section (1) of constant cross-section in the centre part of the bar, and wherein the centre-flange (6) optionally includes a channel (9), the bottom of which is located in the same plane as the side flange (8), **characterized** in that the bar includes at least one second section (2) which has a centre-flange (6) whose width (b) decreases towards one end (5) of the bar, the second bar section (2) has a generally constant height (h), a transition part (3,4) of generally trapezoidal shape is located between the second section (2) and said one bar end (5), and in that the transition part has a height (h) which decreases towards one end of the bar."

- II. The granted patent was opposed by the present appellants on the grounds that its subject-matter lacked novelty and/or inventive step (Article 100(a) EPC).

In the notice of opposition the appellants argued in essence that a bar construction as defined in claim 1 was fully anticipated by JP-A-1 240 322 (D1) or insofar as the bar disclosed there might not be considered to meet the requirement that it has an open cross-section then it would be obvious to modify it in this sense having regard to JP-A-56-50813 (D2).

- III. The respondents (proprietors of the patent) filed a reply to the notice of opposition on 30 June 1998 which was posted to the appellants on 9 July 1998 with a short communication of the formalities officer of the Opposition Division with the invitation to "please take note".
- IV. The decision of the Opposition Division rejecting the opposition was posted to the parties on 4 August 1998. The cover sheet of the decision bears the information "to EPO postal service 30/07/98" (cf. decision G 12/91, OJ EPO 1994, 285).
- V. An appeal against this decision was filed on 12 September 1998 and the fee for appeal paid at the same time. The statement of grounds of appeal was received on 27 November 1998.
- VI. Oral proceedings before the Board were held on 22 September 2000.

The appellants requested that the decision under appeal be set aside and the case remitted to the first instance for further examination (main request) or in the alternative that the patent be revoked (auxiliary request). They also requested reimbursement of the appeal fee.

The respondents requested that the appeal be dismissed and the patent maintained unamended.

VII. In support of their main request the appellants argued substantially as follows:

After receiving the reply of the respondents to the notice of opposition on 13 July 1998 the representative of the appellants had recognised that it would be necessary to address the issues raised therein and had done everything within his power to make a speedy response. In particular he had faxed a copy of the respondent's reply to the appellants on the same day he received it and on 28 July 1998 had sent them his comments. The posting of the decision already on 4 August had robbed the appellants of any realistic opportunity of commenting on the arguments raised by the respondents, arguments on which the Opposition Division had heavily relied in the reasoning of its decision. This was a clear infringement of the appellants' right to be heard enshrined in Article 113(1) EPC. The only proper way of rectifying this was to remit the case to the Opposition Division for further examination.

VIII. The arguments of the respondents in reply can be summarised as follows:

The contested decision did not rely on any new facts or evidence introduced in the reply of the respondents to the notice of opposition. It had been established in decision T 494/95 (referred to on page 413 of the compendium "Case Law of the Board of Appeal of the EPO", 3rd edition 1998) that in situations such as this there was no requirement imposed on the Opposition

Division by any provision of the EPC to wait until the appellants had filed further submissions. The underlying principle which should guide the conduct of the opposition proceedings was that of equality of treatment of the parties. That had clearly been guaranteed in the present case. The appellants had had the opportunity to present their case in the notice of opposition and the respondents had answered it in their reply. Furthermore, even if the time involved for filing a further reply by the appellants had been limited it would certainly have been sufficient to inform the Opposition Division that a reply was intended. The contested decision was therefore not tainted by a substantial procedural violation which would justify remitting the matter to the Opposition Division. In any case, even if the Board were to decide otherwise, it should refrain from making a remittal as this would place an unfair burden on the respondents in the pursuit of their rights deriving from the patent, which was being infringed by the appellants.

Reasons for the Decision

1. The appeal complies with the formal requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.

2. In section VII-C, 2.3 of the above-mentioned case law compendium there are discussed several decisions which are concerned with the question of the time that should be allowed for a response to an EPO Communication to "take note". In both of T 275/89 (OJ EPO 1992, 126) and T 494/95 the respective Board considered that a sufficient time to be given to a party for filing an

adequate response was a minimum of one month. The Board in T 263/93 went further and stated that the right to a fair procedure required that the opposition division should have waited at least two months before issuing a decision, unless these are exceptional circumstances in which a shorter period of time is acceptable.

The underlying basis for the findings of the respective Boards in the decisions mentioned above is the fundamental requirement of Article 113(1) EPC that the decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In this context the terms "grounds or evidence" is not to be interpreted narrowly but should be understood as referring to the essential legal and factual reasoning leading to the decision T 951/92, OF EPO 1996, 53). Furthermore, the opportunity to present comments must be a genuine and realistic one in the circumstances of the case and not merely theoretical.

In the present case the Board is satisfied that the reasoning given in the contested decision contains essential elements derived specifically from the reply of the respondents to the notice of opposition. In particular, with respect to the question of novelty, the Opposition Division states at the end of point 8.1 that it "follows the argumentation brought forward by the patentees that the cross-section of the safety bar as known from document D1 is not open". With respect to the question of inventive step the Opposition Division states in the first paragraph of point 8.3 that safety bars with closed and open cross-sections serve "a different purpose", "in that the first kind aims to be as rigid and resistant as possible whereas the second

kind tends to deform elastically and plastically in a pre-defined manner". It is not possible to derive anything conceptually equivalent to this statement either from the patent specification itself as has been suggested by the respondents, or from the notice of opposition.

Having regard to the case law mentioned above the seventeen day period which elapsed between the appellants receiving the reply of the respondents on 13 July 1998 and the handing over of the decision to the EPO internal postal service on 30 July 1998 was manifestly too short to give the appellants an adequate opportunity for comment. The respondents have suggested that the appellants should have informed the Opposition Division within this period that a substantive reply would be forthcoming. The Board cannot agree as having regard to the case law the appellants could not reasonably have expected a decision to be issued so quickly.

In their written and oral submissions the respondents relied in the main on the extensive general considerations contained in decision T 494/95 (supra) as providing a basis for the conclusion that where the reply to the notice of opposition does not contain any new facts or evidence on which a decision to reject the opposition is to be based then the Opposition Division is free to issue this decision once it has communicated the reply to the opponents "to take note" and is therefore not obliged to wait even a relatively short period of time to enable the opponents to comment. That interpretation of the decision seems however distinctly at odds with the facts of the case involved and the specific finding in point 2.8 of the grounds that the

actual length of time of more than one month between the sending of the reply of the patentees to the opponents and the issue of the decision was sufficient to give them a realistic opportunity to comment or at the very least to inform the Opposition Division that it intended to comment. In any case, the submissions of the respondents are predicated on the assumption that the reasoning of the contested decision does not contain essential elements derived from the reply to the notice of opposition, with which as explained above, the Board cannot agree.

3. For the above reasons the Board is satisfied that the contested decision is procedurally flawed in a fundamental manner in that the appellants were denied their right to comment on the grounds on which the decision was based (Article 113(1) EPC).

According to Article 10 RPBA a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. The respondents see such a reason in the present case in the fact that infringement proceedings against the appellants have been opened before the German courts and argue that the unavoidable delay in reaching a final decision associated with a remittal would seriously disadvantage them in the exercise of their rights deriving from the patent. Nevertheless, the Board remains of the opinion that the fundamental right of the appellants to a fair hearing before the Opposition Division must outweigh any advantage that might accrue to the respondents by having the Board deal fully with the case rather than remit it. In this context the Board notes that the

infringement action was taking its normal course before the German courts and had not been stayed to await the outcome of the opposition.

4. Having regard to the remittal of the case to the first instance by reason of a substantial procedural violation, according to the appellants' main request, reimbursement of the appeal fee is equitable (Rule 67 EPC).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:

The Chairman:

S. Fabiani

F. Gumbel