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**D E C I S I O N**  
**of 25 May 2000**

**Case Number:** T 0263/00 - 3.2.3

**Application Number:** 94914187.3

**Publication Number:** 0693983

**IPC:** B22D 17/32

**Language of the proceedings:** EN

**Title of invention:**

METHOD AND APPARATUS FOR CHARGING METAL TO A DIE CAST MACHINE

**Patentee:**

THE DOW CHEMICAL COMPANY

**Opponent:**

NORSK HYDRO ASA

**Headword:**

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**Relevant legal provisions:**

EPC Art. 106, 107, 116, 125

EPC R. 57

**Keyword:**

"Appeal inadmissible - lack of decision"

"Apportionment of costs (no)"

**Decisions cited:**

T 0461/88

**Catchword:**

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Case Number: T 0263/00 - 3.2.3

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.3**  
**of 25 May 2000**

**Appellant:** THE DOW CHEMICAL COMPANY  
(Proprietor of the patent) 2030 Dow Center  
Midland, Michigan 48674 (US)

**Representative:** Smulders, Theodorus A.H.J., Ir.  
Vereenigde  
Postbus 87930  
NL-2508 DH Den Haag (NL)

**Respondent:** NORSK HYDRO ASA  
(Opponent) N-0240 OSLO (NO)

**Representative:** Bleukx, Luc  
Norsk Hydro Technology B.V.  
Avenue Marcel Thiry 83  
B-1200 Brussels (BE)

**Decision under appeal:** Communication of the Opposition Division of the  
European Patent Office posted 18 January 2000.

**Composition of the Board:**

**Chairman:** C. T. Wilson  
**Members:** M. K. S. Aúz Castro  
F. E. Brösamle

## Summary of Facts and Submissions

- I. The mention of the grant of European patent EP 0 693 983 was published on 26 November 1997.
- II. On 25 August 1998 an opposition was filed by Norsk Hydro ASA, having their place of business in Norway. In the notice of opposition a professional representative was indicated, but the notice itself was signed by the opponent.
- III. By communication of 8 September 1998 the opponent's (respondent) attention was drawn to this deficiency and they were asked to rectify it by the professional representative signing or approving the notice of opposition within a period of two months.
- IV. In response thereto on 15 September 1998 the professional representative signed the notice of opposition and approved its appendix.
- V. By letter of 2 February 1999 the patentee (appellant) challenged the admissibility of the opposition because the notice of opposition was not signed by a person appearing on the list of professional representatives.

By a further letter of 3 February 1999 the appellant alleged with reference to Article 133(2) EPC that no notice of opposition had been filed within the nine months from the publication of the mention of grant of the patent. It was not possible to complete with the signature after the expiry of the time limit.

- VI. By communication of 3 August 1999 the opposition division summoned to oral proceedings on 29 June 2000 and informed the parties that it considered the opposition to be admissible (by mistake the word "allowable" was used).
- VII. By letter of 14 October 1999 the appellant requested that a decision on the question of admissibility of the opposition be taken and that separate appeal according to Article 106(3) EPC be allowed.
- VIII. On 18 January 2000 the opposition division issued a communication reiterating its assessment that the opposition was admissible and informing the parties that for reasons of procedural economy a decision on that point would be taken in the oral proceedings.
- IX. On 17 February 2000 the appellant filed an appeal against the opposition division's "decision to end the ex-parte proceedings and continue the opposition proceedings". On the same day the statement of grounds of appeal was filed and the appeal fee paid.
- X. In two communications the board drew the appellant's attention to its preliminary assessment of the case, namely that the appeal seemed to be inadmissible since it did not seem to be based on an appealable decision and that therefore the question whether the opposition was valid or admissible could not be examined by the board. Consequently, the principal point of discussion in the oral proceedings requested by the appellant would be the admissibility of the appeal.
- XI. The appellant's allegations presented in writing and in the oral proceedings which took place on 25 May 2000

can be summarized as follows:

Until a notice of opposition is filed the procedure is ex parte. If a notice of opposition is filed, then there is an opposition procedure. But this procedure can only exist if, in fact, the notice of opposition is filed. After accepting the notice of opposition the inter partes procedure starts.

The end of the ex-parte procedure is an important event for the patent proprietor which requires a decision. As no consecutive step can be taken without prior assessment on a preceding step, the assessment as to whether an opposition has been filed must have been completed **and decided** prior to starting an opposition procedure. In the communication of 18 January 2000 the opposition division explicitly took the position that the inter partes procedure be continued. This means that, hence, the opposition division decided to end the ex-parte procedure. The appeal lies from this - direct, implicit - decision to end the ex-parte proceedings.

Furthermore, reference is made to Article 125 EPC. At least in accordance with Dutch administrative law, if an administrative body is requested to take a decision, then the fact that the body does not take this decision within a reasonable term is itself considered to be a decision that can be appealed.

The appellant requested that the "decision that the notice of opposition had been validly filed" be set aside and to declare that the opposition had not been filed, by way of auxiliary request to refer the following question to the Enlarged Board:

Does the patentee have a legal right to an appealable decision of the opposition division whether a notice of opposition has been validly filed.

- XII. The respondent rejected the appellant's arguments submitting that no decision to accept an opposition was foreseen in the EPC and requested that the appeal be rejected as inadmissible and that apportionment of costs be ordered because of abuse of procedure by the appellant.

### **Reasons for the Decision**

1. Pursuant to Article 106(1) first sentence EPC an appeal shall lie from decisions of .... opposition divisions. Thus, a prerequisite for the admissibility of an appeal is the existence of a **decision**. A decision is an administrative act which settles a given case finally and in a legally binding way. This excludes such matter as communications indicating the preliminary assessment of a responsible body of the EPO or guiding measures determining the course of the procedure in order to prepare the taking of a decision. Whether or not a particular document emanating from the EPO is a "decision", depends on its content, not on its form.
  
2. In the case under consideration the appellant attributes to the opposition division the competence to end the ex-parte procedure and to start the inter partes opposition procedure after having accepted a notice of opposition as validly filed. According to the appellant this assessment required a "decision" which was final and which in this case was implicitly contained in the opposition division's communication of

18 January 2000 informing the parties that it considered the opposition admissible.

3. The appellant's contentions do not have a basis in the EPC. Pursuant to Article 19(1) EPC an opposition division shall be responsible for the examination of oppositions against any European patent. This provision stipulates the competence of the opposition division which is the examination of oppositions. When an opposition is filed the procedure becomes automatically bilateral, no matter whether the opposition is valid, admissible or allowable. Rule 57(1) EPC expressly stipulates that the opposition division shall communicate the opposition to the proprietor of the patent and the Guidelines for Examination in the European Patent Office provide in part D, Chapter IV, point 1.5 that communications and decisions in the course of the examination as to whether the opposition is deemed to have been filed and is admissible are also notified to the proprietor of the patent.

Thus a decision of the opposition division "to end the ex-parte proceedings" is not foreseen in the EPC. The fact that in the course of withdrawal of the opposition the procedure can become unilateral is not pertinent for the questions under consideration.

4. In this case a procedural violation had occurred in so far as the communication of the opposition division of 8 September 1998 inviting the respondent to rectify deficiencies of the notice of opposition as well as the respondent's reply to it had not been notified to the appellant. The appellant was informed about this correspondence only indirectly with a delay of nearly one year by the communication of 3 August 1999

summoning to oral proceedings in which the opposition division informed the parties that due to the rectification of the deficiencies in the notice of opposition the opposition was considered admissible. The procedural violation was remedied on request of the appellant by sending copies of the relevant documents.

5. The fact that contrary to the recommendations in the Guidelines the appellant was not informed about the examination of the admissibility of the opposition did, however, not have any repercussion on the bilateral nature of the opposition proceedings.
6. Since there is no decision "to end the ex-parte proceedings" it has to be examined whether another appealable decision has been taken by the opposition division.

In its communications of 3 August 1999 and of 18 January 2000 the opposition division stated that it considered the opposition to be admissible which implicitly included the assessment that the opposition was validly filed. But this statement is not to be considered as a "decision", all the more since in the communication of 18 January 2000 the opposition division explicitly advised the parties that the decision on that point would be taken at the oral proceedings.

7. Even if one considered the communications to contain a decision as to substance, this would be an interlocutory decision, which would not terminate the proceedings and could only be appealed together with the final decision, unless the decision allowed separate appeal. Since a corresponding request of the



appellant was not complied with by the opposition division, it is clear that there is no appealable decision.

8. Also the appellant's reference to Article 125 EPC cannot lead to another result. This provision expressly stipulates, that in the **absence** of procedural provisions in this Convention the principles of procedural law generally recognised in the Contracting States shall be taken into account.

As is apparent from the preceding reasons of this decision the Convention has provided procedural provisions for the procedural problems to be examined in this case, namely in particular Article 106(1) and (3) EPC. Thus, the prerequisite of Article 125 EPC that there are no procedural provisions is not fulfilled.

9. Therefore, the board comes to the conclusion that the appeal is inadmissible, because - contrary to the allegations of the appellant - it does not lie from a decision, as required by Article 106(1) EPC.
10. As regards the respondent's request for apportionment of costs, Article 104(1) EPC stipulates the principle that each party to the proceedings shall meet the costs he has incurred and that a different apportionment of costs incurred during taking of evidence or in oral proceedings can only be ordered for reasons of equity. There is no definition of equity in the EPC. To come to a conclusion in this respect all the details of a case have to be taken into account and evaluated. In general apportionment of costs is justified in cases where costs arise in whole or in part as a result of the conduct of a party which is not in keeping with the

care required in the exercise of his legal rights, or which stems from culpable actions or an irresponsible or even malicious nature (T 461/88, OJ EPO 1993, 295).

In the present case no such improper behaviour has taken place. The appellant, THE DOW CHEMICAL COMPANY, merely availed themselves of their right to file an appeal, Article 107 EPC, first sentence, and to request oral proceedings, Article 116(1) EPC, because erroneously they were of the opinion that the opposition division had given an appealable decision. An error in assessing a case cannot be equated with an abuse of procedure. Besides, the wording of Article 116(1) EPC, according to which "oral proceedings shall take place ... at the request of any party to the proceedings" makes it clear that there is no restriction for a party to request oral proceedings if he considers it necessary. A party being of the opinion that the first instance has taken a wrong decision is entitled to file an appeal and to try to convince the board in oral proceedings that his appeal has to be allowed.

As no abuse can be established in this case, there is no reason for not following the principle that each party meets the costs he has incurred.

**Order**

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

1. The appeal is rejected as inadmissible.
2. The request of the respondent for apportionment of costs is refused.

The Registrar:

The Chairman:

G. Magouliotis

C. T. Wilson