

Internal distribution code:

- (A) [] Publication in OJ
(B) [X] To Chairmen and Members
(C) [] To Chairmen
(D) [] No distribution

D E C I S I O N
of 28 February 2003

Case Number: T 0042/02 - 3.5.1
Application Number: 87905893.1
Publication Number: 0294397
IPC: H04L 9/00, G06K 19/06
Language of the proceedings: EN

Title of invention:
Automated transaction system using microprocessor cards

Patentee:
PITNEY BOWES INC.

Opponent:
Société SECAP
Francotyp-Postalia Aktiengesellschaft & Co.
GIESECKE & DEVRIENT GmbH
NEOPOST LTD

Headword:
Transaction system/PITNEY BOWES

Relevant legal provisions:
EPC Art. 19(2), 102, 113(1), 116
EPC R. 68, 70(1)

Keyword:
"Intermediate decisions announced by differently composed
opposition divisions at first and second oral proceedings -
commonly reasoned and jointly signed final decision -
substantial procedural violation (yes)"

Decisions cited:

-

Catchword:

If binding intermediate decisions are announced by an Opposition Division at first oral proceedings and further binding intermediate decisions and the final decision are announced by a differently composed Opposition Division at second oral proceedings, then these decisions cannot be commonly reasoned and jointly signed by all members of the two Opposition Divisions without violating fundamental principles deriving from Articles 113(1) and 116 EPC (see point 8 of the "Reasons for the decision").



Case Number: T 0042/02 - 3.5.1

D E C I S I O N
of the Technical Board of Appeal 3.5.1
of 28 February 2003

Appellant:
(Proprietor of the patent) PITNEY BOWES INC.
World Headquarters
One Elmcroft
Stamford
Connecticut 06926-0700 (US)

Representative:
Avery, Stephen John
Hoffmann Eitle
Patent- und Rechtsanwälte
Postfach 81 04 20
D-81904 München (DE)

Appellant:
(Opponent 04) NEOPOST LTD
South Street
Romford
Essex RM1 2AR (GB)

Representative:
Weinmiller, Jürgen
SPOTT & WEINMILLER
Lennéstrasse 9
D-82340 Feldafing (DE)

Parties as of right:
(Opponent 02) Francotyp-Postalia Aktiengesellschaft & Co.
Triftweg 21-26
D-16547 Birkenwerder (DE)

Representative:
Schaumburg, Thoenes, Thurn
Patentanwälte
Postfach 86 07 48
D-81634 München (DE)

(Opponent 03)

GIESECKE & DEVRIENT GmbH
Prinzregentenstrasse 159
D-81677 München (DE)

Representative:

Klunker, Schmitt-Nilson, Hirsch
Winzererstrasse 106
D-80797 München (DE)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office posted 16 November
2001 concerning maintenance of European patent
No. 0 294397 in amended form.

Composition of the Board:

Chairman: S. V. Steinbrener

Members: E. Lachacinski

R. S. Wibergh

Summary of Facts and Submissions

- I. European Patent No. 0 294 397, based on European patent application 87 905 893.1 was filed on 1 September 1987. The grant of the patent was mentioned in European Patent Bulletin 95/01 of 4 January 1995.
- II. Notices of opposition were filed by four opponents. All the opponents requested revocation of the patent in its entirety, arguing mainly that the subject-matter of claims 1 to 39 lacked novelty or inventive step. Opponent 01 also invoked the provisions of Article 100(b) EPC.
- III. Oral proceedings were held on 26 October 2000.
- IV. The Opposition Division gave a series of formal intermediate decisions in the course of the oral proceedings. The oral proceedings were adjourned without reaching a final decision and without any explanation being given. No minutes were written.
- V. Summonses to attend further oral proceedings were sent to the parties on 21 December 2000. In a communication annexed to the summons and signed by the three technical members who had participated at the oral proceedings of 26 October 2000 the Opposition Division stated that the further oral proceedings were the continuation of those of 26 October 2000.
- VI. The oral proceedings took place on 26 June 2001.
- VII. The common minutes of the two oral proceedings indicate that the Opposition Division was composed during each of the hearings of 26 October 2000 and 26 June 2001 of

three technical members, the chairman and first examiner remaining the same and there being two different second examiners. In the minutes it was also indicated that the oral proceedings were adjourned on 26 October 2000 and resumed on 26 June 2001, that the minutes were taken by one of the second members of the division on 26 October 2000 and by the other one on 26 June 2001 and that the common minutes were signed by both second examiners.

VIII. The decision under appeal (EPC Form 2339) was signed on 19 October 2001 by the three technical members of the changed opposition division and the former second member who had participated in the first oral proceedings. The Opposition Division decided "to maintain the Patent in amended form on the basis of the second auxiliary request of main request (IV), Article 102(3) EPC".

IX. The reasons for the decision were dispatched to the parties on 16 November 2001 in a package comprising the following documents:

- EPO form 2327 as first page bearing the printed names of the three members of the changed Opposition Division. The name of the second technical member who participated in the oral proceedings on 26 October 2000 did not appear.
- 37 pages of reasons,
- the text of Articles 106 to 108 EPC (EPO Form 2019),
- documents relating to the amended text (EPO

Form 2339.4),

- the minutes of the oral proceedings.

Whether a copy of EPO Form 2339 WP (Sheet 1) i.e. the first page of the decision bearing the original signatures of four technical members, was also sent to the parties, cannot be seen from the file.

- X. Opponent 01 in a letter dated 30 November 2001 withdrew his opposition.
- XI. The Patentee and Opponent 04 both lodged appeals in due time on 16 and 7 January 2002 respectively and paid the corresponding appeal fees.

They developed, also in due time, in their submissions dated 19 February and 14 March 2002 respectively their arguments concerning patentability without any comment on the fact that four technical members were involved in taking and signing the decision.

- XII. The Board, in a communication dated 12 April 2002, invited the parties to comment on this apparent deficiency.
- XIII. The first Appellant (Patentee) responded that a substantial procedural violation had taken place and requested that the case should be remitted to the first instance for reconsideration before a newly constituted Opposition Division and that the case could be decided in writing.
- XIV. The second Appellant (Opponent 04) and Opponents 02 and 03 stated that the appeal proceedings could continue in

writing.

Reasons for the Decision

1. The appeals comply with Articles 106 to 108 and Rules 1 and 64 EPC and are thus admissible.
2. If in proceedings before the EPO it appears that a serious breach of a fundamental principle contained in the EPC has occurred the Boards are duty bound to react of their own motion and to take all necessary measures to remedy the breach, especially when it constitutes a substantial procedural violation.
3. It is undisputed that the second technical examiner who participated as minute writer in the oral proceedings on 26 June 2001 had not been a member of the Opposition Division on 26 October 2000.
4. It is also undisputed that the impugned decision (EPO Form 2339 WP (Sheet 1)) was signed by four technical members including two different second examiners.
5. It appears from the common minutes and from the "Facts and submissions" section of the impugned decision that at the oral proceedings of 26 October 2000 the Opposition Division, composed of three technical members, took intermediate decisions which were binding on the further Opposition Division.

After "resumption" of the oral proceedings on 26 June 2001, further intermediate decisions and a final appealable decision were taken and announced on 26 June 2001 by the Opposition Division composed of three

technical members, the second examiner having been changed.

6. The Board notes that on no occasion was the Opposition Division composed of more than three technical members. Thus Article 19(2) EPC has been complied with in the course of proceedings.

However, difficulties exist with respect to the minutes and the reasons for the impugned decision sent afterwards.

The minutes should reflect precisely what happens during oral proceedings. But in this case the minutes, signed by the chairman and both second examiners, give the Board no absolute certainty about the course of the proceedings. The contributions of the two second technical members remain unclear. The immediate writing of the minutes after an oral proceedings serves to guarantee the parties an accurate record of the proceedings.

This cannot happen when the minutes are, as in this case, written more than one year after the first hearing!

It is also desirable that an intermediate decision taken during oral proceedings be notified in writing to the parties as soon as possible.

7. As regards the reasoned decision signed by four members, in the Board's view the following problems arise.

Pursuant to Rule 68(2) EPC, decisions of the European

Patent Office which are open to appeal shall be reasoned. Moreover, any decision of the European Patent Office is to be signed by and to state the name of the employee responsible (Rule 70(1) EPC). Decisions in opposition proceedings fall within the responsibility of the Opposition Division (Articles 19(1) and 102 EPC).

In the present case, binding decisions were not taken by "the" Opposition Division, but by two differently composed Opposition Divisions, each Division being responsible for its decisions announced during separate oral proceedings. Since it follows from the above fundamental requirements that decisions taken by different deciding bodies cannot normally be commonly reasoned and jointly signed, it would have been necessary for each Opposition Division to give the reasons for, and to sign, its respective decision only.

The impugned decision is thus already flawed for these formal reasons.

8. But above all, there are deficiencies as to the degree of participation of each second examiner in the writing of the reasons for the final decision.

Article 113(1) EPC requires that decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. In accordance with the established case law of the boards of appeal (see the decisions cited in "Case Law of the Boards of Appeal of the European Patent Office, 4th edition 2001", page 376 ff), this requirement implies that when oral proceedings pursuant to Article 116 EPC are held

within opposition proceedings, such oral proceedings should ensure that the subsequent decision is based on grounds or evidence on which the parties have had a proper opportunity to present their comments. In order to be legally valid, any decision announced orally must be written on behalf of and represent the views of the members who were appointed to the particular Opposition Division responsible for that oral decision, and must bear signatures which indicate this. Hence, if even one member of the Opposition Division has been replaced after oral proceedings where a decision was given orally, there is no longer any guarantee that the reasoned decision signed subsequently accurately reflects the point of view of all three members who took part in the oral proceedings. In such a case, it could well be that the reasons are influenced by the views of the new member which were neither formed on the occasion of the oral proceedings, nor communicated to the parties on this occasion.

In the present case, the various decisions announced orally by two differently composed Opposition Divisions at separate oral proceedings are commonly reasoned in the "Grounds for the Decision". The decision constantly refers to "the" Opposition Division and does not distinguish between intermediate decisions given orally by the first Opposition Division at the first oral proceedings and intermediate decisions and the final decision given orally by the second Opposition Division at the second oral proceedings. Consequently, the views and contributions of the second examiners, each participating in only one of those oral proceedings, respectively, have indistinguishably entered into the whole decision and have influenced it in an undefined way, possibly also with respect to those parts of the

reasons relating to decisions announced at the corresponding oral proceedings where the respective second examiner was absent.

The Board considers this irregularity to not comply with the principles deriving from Articles 113(1) and 116 EPC and thus to be a fundamental deficiency justifying remittal of the case to the department of first instance pursuant to Article 10 of the Rules of Procedure of the Boards of Appeal.

9. In the Board's view, if the first instance feels it necessary to orally announce binding intermediate decisions, the correct procedure under the present circumstances would have been to issue an intermediate written decision (not allowing separate appeal pursuant to Article 106(3) EPC) dealing with the issues decided at the first oral proceedings followed by a final decision dealing with the remaining issues, each decision being properly signed by only the three examiners concerned. In view of this it might be argued that splitting up the present decision accordingly would be sufficient. However, the Board holds that in the circumstances of the present case where the reasoned decision was dispatched almost one year after the first oral proceedings not even the examiners involved may know with certainty what was argued at the separate hearings, and thus any such respective decisions cannot be expected to meet the requirements of Rules 68(1) and (2) EPC. Hence, re-examination of the case before a properly constituted Opposition Division is necessary.

Despite the present irregularity, the Board does not see a need to exclude any of the members of the

Opposition Division in its first or second composition, as in effect requested by the Patent Proprietor, since the opposition procedure was apparently otherwise without deficiencies and there is no suspicion of partiality. In view of the length of these proceedings the case should however be treated with priority.

10. For reasons of equity the substantial procedural violation justifies the reimbursement of the appeal fees (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 Opposition Division for further prosecution.
3. Both appeal fees are to be reimbursed.

The Registrar:

The Chairman:

M. Kiehl

S. Steinbrener