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D E C I S I O N
of 30 September 2004

Case Number: T 0468/04 - 3.2.2

Application Number: 99110313.6

Publication Number: 0960609

IPC: A61F 9/00

Language of the proceedings: EN

Title of invention:
Laser treatment apparatus

Patentee:
Nidek Co., Ltd.

Opponent:
Carl Zeiss Jena GmbH

Headword:
-

Relevant legal provisions:
EPC Art. 111(1), 113(1)
EPC R. 55, 56, 78(2)

Keyword:
"Basis of decision - opportunity to comment (no)"

Decisions cited:
T 0543/95

Catchword:
-



Case Number: T 0468/04 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 30 September 2004

Appellant: Carl Zeiss Jena GmbH
(Opponent) Carl-Zeiss-Promenade 10
D-07745 Jena (DE)

Representative: Breit, Ulrich
Geyer, Fehners & Partner (GbR)
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D-80687 München (DE)

Respondent: Nidek Co., Ltd.
(Proprietor of the patent) 7-9, Sakae-cho
Gamagori-shi
Aichi 443-0035 (JP)

Representative: Prüfer, Lutz H., Dipl.-Phys.
PRÜFER & PARTNER GbR
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 26 January 2004
rejecting the opposition filed against European
patent No. 0960609 as inadmissible under
Rule 56 EPC.

Composition of the Board:

Chairman: T. K. H. Kriner
Members: M. G. Noël
A. Pignatelli

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal, received on 20 March 2004, against the decision of the Opposition Division, dispatched on 26 January 2004 rejecting the opposition as inadmissible. The statement setting out the grounds of appeal was received on 20 March 2004 and the fee for appeal was paid on the same date.

The Opposition Division held that it was not proven that the documents submitted by the opponent had been made available to the public.

- II. On 29 May 2003, the Opposition Division had sent a communication to the parties requesting further evidence supporting the allegation that the documents referred to by the opponent had been made available to the public.

The opponent did not answer to the communication within the time limit.

After the time limit had lapsed, the Opposition Division decided on the case.

- III. Oral proceedings before the Board were held on 30 September 2004.

The appellant requested that the decision under appeal be set aside, the case remitted to the department of first instance for further prosecution, and the appeal fee reimbursed.

The respondent requested that the appeal be dismissed.

IV. The appellant argued as follows:

He had never received the communication of the Opposition Division so that he was not aware of the fact that the Opposition Division had held that the filed evidence was not sufficient and had not therefore been able to provide further evidence.

The Opposition Division had thus decided on reasons on which the appellant had not had an opportunity to present his comments. This was a violation of his right to be heard and as such, a procedural violation which justified setting aside the decision and remitting the case back to the department of first instance. Since this procedural violation was an important one, the reimbursement of the appeal was also justified.

V. The respondent argued as follows:

The decision under appeal rejecting the opposition should be confirmed because the opposition was inadmissible and no violation of the right to be heard had occurred during the opposition procedure.

The opposition was inadmissible because it did not contain sufficient evidence in support of the opponent's allegation that the state of the art submitted by the opponent had been made available to the public. The respondent analysed the details of the submitted documents and gave reasons why in its opinion their availability to the public was not sufficiently proved.

The respondent further submitted that a violation of the right to be heard had not occurred for the following reasons:

- (a) The Opposition Division is not required to issue at least one communication before taking its decision. Not issuing at least one communication cannot in itself substantiate an allegation of infringement of the right to be heard.
- (b) The opponent had not requested oral proceedings before the Opposition Division and had thus relinquished his right to be heard.
- (c) The appellant was aware of the objections against his opposition through the response of the patent proprietor in which doubts were expressed as to the sufficiency of the filed evidence.
- (d) The Opposition Division is not required to request evidence before taking a decision. It is a requirement for the admissibility of an opposition that evidence supporting the alleged availability to the public of a document be provided. The Opposition Division was therefore entitled to reach a decision without any further communication.
- (e) The issue of a communication would be a violation of the principle of equal treatment of the parties since it would support the opponent against the patent proprietor.

The respondent further submitted that the principle of fair treatment of the parties would be violated if the Board remitted the case to the department of first instance because the opponent would get a second possibility to change the factual framework of the opposition.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rule 65 EPC and is therefore admissible.

2. According to the EPO, the communication was sent out by registered letter. Rule 78(2) EPC states that a communication sent by registered letter is deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee. In the event of any dispute, it shall be incumbent on the EPO to establish that the letter has reached its destination.

Through the submission of the appellant, a dispute about the delivery of the communication has arisen. The EPO is unable to prove that the communication has reached its destination.

The Board therefore holds that the communication did not reach the appellant. This finding is supported by the respondent's statement that he also did not receive the communication.

3. The fact that the communication did not reach the appellant constitutes a procedural violation, if in this case it was necessary to send a communication in order to give the party the possibility to present comments on the reasons for the decision, i.e. if the communication was a means to give the party the possibility to be heard on a decisive issue(Article 113(1) EPC).

3.1 In the present case, the communication was sent in order to inform the opponent that the Opposition Division was not satisfied with the evidence submitted to it.

The decision of the Opposition division is based on missing evidence which could have been provided if the communication had reached the appellant and he had had the possibility to react to it. This point was therefore decisive.

3.2 Without the communication, the party could not be aware that the decision would be based on this issue. The fact that the patent proprietor contested the availability to the public of the cited state of the art does not imply necessarily that the Opposition Division considered that the evidence submitted was not sufficient. It was therefore necessary to inform the party of this opinion of the Opposition Division in order to provide the possibility to react to it.

Although it is true, as submitted by the respondent, that not issuing at least one communication before taking a decision cannot in itself infringe the right to be heard, such an infringement can nevertheless

arise where the Opposition Division considers that further information is necessary and bases its decision on the fact that this information was not provided by the party which could have done so. To communicate to the party the necessity of further evidence does not favour a party but is one way to perform the examination ex officio.

3.3 The fact that the opponent had not requested oral proceedings cannot be interpreted as a renunciation of the right to be heard, since the EPC does not require that the right to be heard take a particular form.

3.4 The necessity of sending a communication cannot be considered in a different way where problems concerning the admissibility of the opposition arise. Even in cases where the opposition should be rejected as inadmissible the party still has the right to present its comments.

In any event, in the present case, the communication concerned a problem of evidence which is a matter for substantial examination. A distinction has to be drawn between the terms "evidence" and "substantiation". The time at which something could be said to have been made available to the public is substantiated by indicating a date or a particular period of time and by indicating the means by which the time claimed is established. The purpose of evidence is to verify whether the assertion made is in fact correct. Substantiation does not extend to evidence, even if it is possible for both to coincide when using written documentation as a means of proof (see also T 543/95).

In its opposition, the appellant submitted documents which, according to its argumentation, represented the state of the art. As recognised by the respondent this state of the art was not only a prior use but also a written state of the art represented by document D1.

The documents submitted were dated.

It was therefore possible for the respondent and the Opposition Division to know that a document existed at a particular point in time. Thus, the opposition was substantiated to this extent.

The patent proprietor questioned the submissions of the opponent. The decision on this question relates to the evaluation of evidence. The evaluation of evidence is a matter for the substantial examination of the opposition and not an admissibility requirement.

4. For the reasons set out above, the Board concludes that the Opposition Division based its decision on grounds on which the appellant had no opportunity to present its comments.

This is a violation of Article 113(1) EPC.

This violation is so serious that the decision of the department of first instance has to be set aside and the case remitted to it for further prosecution (Article 111(1) EPC) and the appeal fee reimbursed according to Rule 67 EPC.

The remittal to the department of first instance does not give the opponent the right to change the framework

of the opposition and cannot be considered an unfair treatment of the parties.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairman:

V. Commare

T. K. H. Kriner