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**Datasheet for the decision
of 23 November 2007**

Case Number: T 0165/07 - 3.5.03

Application Number: 99115002.0

Publication Number: 0961184

IPC: G05B 19/418

Language of the proceedings: EN

Title of invention:

System for use in a field device management

Patentee:

Fisher-Rosemount Systems, Inc.

Opponent:

Endress+Hauser (Deutschland) AG+Co. KG

Headword:

Appealable decision/FISHER-ROSEMOUNT

Relevant legal provisions:

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Relevant legal provisions (EPC 1973):

EPC Art. 106(1),(3), 113(1), 116(1)

EPC R. 67, 89

Keyword:

"Decision by communication of formalities officer (no)"

"Admissibility of appeal (no)"

Decisions cited:

G 0008/95, J 0008/81, J 0001/06, T 0713/02

Catchword:

See points 1 to 9 of the reasons.



Case Number: T 0165/07 - 3.5.03

D E C I S I O N
of the Technical Board of Appeal 3.5.03
of 23 November 2007

Appellant: Endress+Hauser (Deutschland) AG+Co. KG
(Opponent) Colmarer Strasse 6
D-79576 Weil am Rhein (DE)

Respondent: Fisher-Rosemount Systems, Inc.
(Patent Proprietor) 8301 Cameron Road
Austin
Texas 78754 (US)

Representative: Bohnenberger, Johannes
Meissner, Bolte & Partner
Widenmayerstrasse 48
D-80538 München (DE)

Decision under appeal: Communication of the Formalities Officer of the
European Patent Office dated 2 November 2006.

Composition of the Board:

Chairman: A. S. Clelland
Members: R. Moufang
D. H. Rees

Summary of Facts and Submissions

- I. The appellant is the sole opponent in the opposition proceedings against the European patent 0 961 184; the respondent is the patent proprietor. The opposition was based on the ground of added subject-matter. It was argued that contrary to Article 100(c) EPC a certain feature contained in claim 1 of the opposed patent ("means for initiating (56) a command related to a position of the device data") was not originally disclosed so that the patent included subject-matter extending beyond the content of the application as filed. The notice of opposition contained an auxiliary request for oral proceedings.
- II. The proprietor submitted in its reply to the opposition that a typographical error ("position" instead of "portion") had occurred when claim 1 had been amended in the course of the pre-grant procedure. With letters dated 27 December 2005 and 21 March 2006, it requested inter alia that the opposition proceedings be stayed and that the case be remanded to the examination division for re-issuance of the granted patent after correction under Rule 89 EPC.
- III. In a communication of 5 July 2006 the opposition division summoned both parties to attend oral proceedings scheduled to take place on 9 November 2006. In an annex to the summons, it noted that both parties had requested oral proceedings and stated that the issue of added subject-matter (Article 123(2) EPC) would be discussed. No mention was made of the proprietor's request that the proceedings be stayed. With letter dated 9 October 2006 the proprietor inter

alia reiterated the request to correct the patent grant decision and to stay the proceedings until a decision had been taken by the competent EPO body, presumably the examining division.

IV. A formalities officer acting for the opposition division sent out an unsigned communication dated 2 November 2006 to the parties. The communication used the EPO Form 2310A and, under the heading "BRIEF COMMUNICATION", contained the following statements:

"Oral proceedings on 09.11.06 and Adjournment of Opposition Proceedings

Subject: Letter from the proprietor of the patent of 21-03-06 requesting correction under Rule 89 EPC

Communication: The summons to attend oral proceedings/taking of evidence on 09.11.06 has been cancelled. The procedure will be continued in writing. The case is referred to the Examining Division. Examination of the opposition filed against the above identified European Patent is adjourned pending the final decision of the Examining Division. Once the Examining Division has given its decision a further communication will be issued concerning the resumption of the opposition proceedings.

Please take note."

- V. After having received the above communication, the opponent made a complaint about the procedure in a letter to the President of the European Patent Office in which it requested that the referral (to the examining division) be set aside and the proceedings before the opposition division be continued. In response, a letter dated 28 November 2006 was sent to the opponent by the EPO. It was signed on behalf of the director of the directorate "Support for Quality Management" and, after summarizing the issues raised by the opponent, gave reasons why the case was correctly handled by the opposition division. The letter ended by stating that it fell within the competence of the boards of appeal to decide whether the procedural step taken by the opposition division constituted an appealable decision under Articles 106 and 107 EPC.
- VI. On 11 January 2007 the opponent filed a notice of appeal against the "Entscheidung der Einspruchsabteilung vom 02.11.2006" (decision of the opposition division dated 2 November 2006) and paid the appeal fee. A statement of grounds of appeal was filed in a letter dated 12 March 2007 and received on the same day.
- VII. The proprietor (respondent) replied to the grounds of appeal by a submission dated 17 July 2007.
- VIII. The board issued a summons to attend oral proceedings. In the accompanying communication the board stated that the discussion at the oral proceedings would be restricted to issues relating to the admissibility of the appeal and in particular the questions whether the communication dated 2 November 2006 was a decision or

communicated a decision and, assuming that it was, whether it was a final decision terminating the proceedings.

- IX. At the oral proceedings held on 23 November 2007 the appellant requested that the decision under appeal be set aside and the case be remitted to the opposition division with the order to continue the opposition procedure without referring the respondent's request for correction under Rule 89 EPC to the examining division. It further requested reimbursement of the appeal fee.

The respondent requested that the appeal be rejected as inadmissible or dismissed as unfounded.

- X. The written and oral submissions by the appellant, insofar as they are relevant to the present decision, can be summarized as follows:
- The appeal was admissible since the appealed communication of the formalities officer was a decision within the meaning of Article 106(1) EPC and adversely affected the opponent. It followed from the communication that the opposition proceedings would be stopped and "intermediate" ex parte proceedings opened which would take place before the examination division without the participation of the opponent. Such ex parte proceedings could deprive the opponent of the very basis of its opposition. Although no separate appeal was explicitly allowed in the communication, Article 106(3) EPC did not apply since the stay of the proceedings was equivalent to a de facto

termination of the proceedings as regards the opponent.

- The appeal fee should be reimbursed since substantial procedural violations occurred before the department of first instance. The opponent's right to be heard was not observed and the decision was not adequately reasoned.

XI. The written and oral submissions by the respondent, insofar as they are relevant to the present decision, can be summarized as follows:

- The appeal was inadmissible since the appealed communication was not a decision. Even if it were considered to be a decision, the appeal would still be inadmissible since no separate appeal was allowed as required by Article 106(3) EPC and since the opponent was not adversely affected by the communication.

XII. The decision of the board was announced at the end of the oral proceedings.

Reasons for the decision

Admissibility of the appeal

1. According to Article 106(1) EPC an appeal shall lie from decisions of, inter alia, opposition divisions. This must include decisions made by competent formalities officers acting for the opposition division in accordance with the Notice of the Vice-President of Directorate-General 2 of the EPO concerning the entrustment to formalities officers of certain duties

normally the responsibility of the Opposition Divisions of the EPO, dated 28 April 1999 (OJ EPO 1999, 506). It thus has to be ascertained whether the subject of the present appeal, i.e. the communication of the formalities officer dated 2 November 2006, constitutes a decision within the meaning of Article 106(1) EPC.

2. Viewed from a merely formal perspective, the nature of the above communication appears somewhat ambiguous. On the one hand, it contains formulations such as "[t]he case is referred to the Examining Division" and "[e]xamination ... is adjourned", which resemble formulas usually found in decisions. On the other hand, the communication was issued on the EPO form 2310A which is the standard form for communicating a cancellation of oral proceedings to the parties. Neither its heading ("Brief Communication") nor its further text makes reference to a decision or to deciding. In addition, it does not have the typical structure of a written decision setting out facts and reasons (see J 1/06 of 20 November 2006, point 1.1).
3. However, according to the established case law of the boards of appeal, whether a document constitutes a decision or not depends on the substance of its content and not on its form (see e.g. J 8/81, OJ EPO 1982, 10). The criterion of substance has to be assessed in its procedural context (see T 713/02, OJ EPO 2006, 267, point 2.1.4). The decisive question thus is whether the document at issue when objectively interpreted in its context could have been understood by its addressees as a final, i.e. not merely preliminary, and binding determination of substantive or procedural issues by the competent organ of the EPO.

4. The appealed communication of the formalities officer primarily deals with the proprietor's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under Rule 89 EPC. This request was made in letters dated 27 December 2005 and 21 March 2006 and, after the opposition division did not deal with it at all in the annex to the summons dated 5 July 2006, was reiterated in a further submission of the proprietor dated 9 October 2006.

5. It is obvious that a decision on this procedural request can have an important impact on the outcome of the opposition proceedings in the present case:
 - If the request is allowed, the termination of the opposition proceedings might be delayed for a considerable amount of time, in particular when taking into account the possibility of an appeal of the proprietor against a negative decision of the examining division. Furthermore, the opponent would presumably not have party status in the proceedings before the examining division but, if the correction were allowed, might be deprived of the very basis on which the opposition was founded.
 - If the request were not allowed and the opposition proceedings continued, the proprietor might be precluded from relying on the legal remedy provided by Rule 89 EPC since the opposition division's competence to decide on the correction on its own appears questionable in view of decision G 8/95 of the Enlarged Board of Appeal (OJ EPO 1996, 481, point 3.4).

6. To determine the above issue in a binding and final manner clearly falls outside the competences of a formalities officer. The Notice of the Vice-President of Directorate-General 2 of the EPO mentioned above (point 1) does not entrust formalities officers with matters of this kind. Thus, a decision of the formalities officer on the proprietor's request would be ultra vires. Furthermore, in view of the conditional request for oral proceedings contained in the notice of opposition, a procedural decision which possibly predetermines the outcome of the opposition proceedings would, if taken without oral proceedings, amount to a serious violation of the provisions of Articles 113(1) and 116(1) EPC.

7. In view of the above considerations, the appealed communication, when objectively interpreted in its procedural context from the perspective of its addressees, cannot be regarded as a decision of the formalities officer. This leads to the conclusion that it in fact constitutes a mere communication indicating a proposed course of action, not a decision. In reaching this conclusion, the board has to disregard any internal note excluded from file inspection under Rule 93(b) EPC and therefore inaccessible to the parties or the public.

8. Nor is the above conclusion put into question by the fact that the opponent complained about the appealed communication in a letter to the President of the EPO and received a response letter which was signed on behalf of the director of the directorate "Support for Quality Management" and justified the procedural steps taken by the opposition division. Neither the addressee

of the complaint letter nor the author of the response letter is the competent organ for taking decisions in ongoing opposition proceedings or for giving an authoritative interpretation of communications sent out in such proceedings.

9. Since the appealed communication does not constitute a decision within the meaning of Article 106(1) EPC, the present appeal is premature and must therefore be rejected as inadmissible. It furthermore follows that the opposition division has not yet actually taken a decision on the proprietor's request to stay the opposition proceedings and to remit the case to the examination division for a decision on the request for correction under Rule 89 EPC. Thus it is still incumbent upon the opposition division to deal with this request appropriately. Should it consider taking an interlocutory procedural decision in this respect, it will have to take into account the parties' requests for oral proceedings and to exercise its discretion as to whether a separate appeal should be allowed pursuant to Article 106(3) EPC (= Article 106(2) EPC 2000).

Reimbursement of the appeal fee

10. One of the requirements for the reimbursement of the appeal fee pursuant to Rule 67 EPC is that the board deems the appeal to be allowable. However, the present appeal has been found inadmissible.
11. The board furthermore notes that the letter which was sent to the opponent as a response to its complaint to the President of the EPO explicitly refrained from expressing any opinion as to whether or not the

procedural step taken by the opposition division was an appealable decision or not. Thus the letter did not mislead the opponent into filing the present appeal.

12. It follows that the appellant's request for reimbursement of the appeal fee has to be refused.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

D. Magliano

A. S. Clelland