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**Datasheet for the decision  
of 10 June 2009**

**Case Number:** T 2300/08 - 3.3.05

**Application Number:** 03700757.2

**Publication Number:** 1469944

**IPC:** B01L 3/00

**Language of the proceedings:** EN

**Title of invention:**

Modular robotic system for sample processing

**Patentee:**

Thermo CRS Ltd.

**Opponent:**

Schneider, Dr. Peter c/o Fiedler, Ostermann & Schneider

**Headword:**

Robotic system/THERMO CRS

**Relevant legal provisions (EPC 1973):**

EPC Art. 116, 111(1)

EPC R. 67

RPBA Art. 11

**Keyword:**

"Substantial procedural violation: yes - request for oral proceedings not granted"

"Remittal to department of first instance: yes"

"Reimbursement of appeal fee: yes - equitable"

**Decisions cited:**

G 0012/91, T 0093/88, T 0209/88, T 0766/90

**Catchword:**

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Case Number: T 2300/08 - 3.3.05

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.05  
of 10 June 2009

**Appellant:** Thermo CRS Ltd.  
(Patent Proprietor) 5344 John Lucas Drive  
Burlington  
Ontario L7L 6A6 (CA)

**Representative:** Lang, Friedrich  
Lang & Tomerius  
Patentanwälte  
Landsberger Strasse 300  
D-80687 München (DE)

**Respondent:** Schneider, Dr. Peter c/o Fiedler, Ostermann &  
(Opponent) Schneider  
Obere Karaspüle 41  
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**Representative:** -

**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 13 October 2008  
revoking European patent No. 1469944 pursuant  
to Article 102(1) EPC 1973.

**Composition of the Board:**

**Chairman:** G. Raths  
**Members:** B. Czech  
H. Preglau

## **Summary of Facts and Submissions**

- I. The appeal lies from the decision of the opposition division posted on 13 October 2008 revoking European patent No. 1 469 944 on the ground of lack of novelty.
- II. Subsequently to the filing of an opposition against the patent in suit, the patent proprietor was invited by the opposition division with the communication posted 30 March 2007 to file observations within a period of four months. Two requests of the patent proprietor for extension of the said time limit were granted by the opposition division (up to a total of eight months). The patent proprietor did not file a response within the extended time limit.
- III. A "BRIEF COMMUNICATION" including EPO Form 2344A was posted on 11 January 2008 by the formalities officer of the opposition division informing the patent proprietor that failure to reply to the communication dated 30 March 2007 would not lead to a termination of the opposition proceedings.
- IV. On 23 September 2008 the patent proprietor filed a response to the opposition, wherein it requested that the opposition be dismissed and that the patent be upheld as granted. Furthermore, as an auxiliary request, it requested oral proceedings in accordance with Article 116 EPC.
- V. With a "BRIEF COMMUNICATION" posted on 2 October 2008, the opposition division forwarded a copy of the patent proprietor's letter dated 23 September 2008 to the opponent.

VI. The contested decision of the opposition division revoking the patent in suit was posted on 13 October 2008. The contested decision neither mentions the letter of 23 September 2008 nor the requests formulated therein. In the "SUMMARY OF FACTS AND SUBMISSIONS" it is merely stated that *"the patentee did not contest the grounds of opposition although he was invited by the opposition division (letter of 30.03.07), extension of two months granted."*

VII. In its statement of grounds of appeal the appellant (patent proprietor) argued as follows:

*"The right of a party to Oral Proceedings in Examination, Opposition and Appeal Procedure is embodied in Art. 116 EPC. Accordingly, an adverse decision issued without granting the aggrieved parties' request for Oral Proceedings must be declared void up initio and without legal effect (see decisions T 19/87, T 93/88, T 668/89 and T 766/90)."*

*"The Opposition Division has ignored the request for Oral Proceedings though it was validly filed: If a particular time limit is not complied with and no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit, but before a decision is handed over to the EPO's internal postal service for transmittal to the parties are to be regarded in the rest of the proceedings as if they had been received in time (see G 12/91). This is also outlined in the Guidelines Part E, Chapter VIII, 1.8.*

*a) The response to the opposition filed on 23.09.08 contained two requests. The first request was to*

*dismiss the opposition and to uphold the patent as granted. The second request was formulated as an auxiliary request and concerned Oral Proceedings. The response filed on 23.09.2008 did not contain facts or evidence which could have been treated as not filed in due time (Art. 114 (2) EPC).*

*b) For not complying with the time limit of eight months to file the observations concerning the opposition, no specific legal sanction is laid down in the EPC. There was also no legal sanction indicated in the grant of the extension of the time limits issued by the Opposition Division. It was just stated that "if no reply to the communication is received in due time, the procedure will be continued. Attention is drawn to Art. 114 (2) EPC."*

*Furthermore, silence on the part of the proprietor of the patent in response to the communication of 30.03.2007 requesting to file observations concerning the opposition must not be interpreted as signifying agreement to the requested revocation of the patent by the opponent (see T 766/90 following the considerations outlined in G 1/88).*

*c) When the request for Oral Proceedings was filed on 23.09.2008, the decision to revoke the patent was also not handed over to the EPO's internal postal service yet: The decision to revoke the patent dates from 13.10.08 which is 20 days later than the filing date of the requests for Oral Proceedings. Furthermore, nine days after receipt of the request to hold Oral Proceedings, the request for Oral Proceedings was forwarded in a brief communication to the opponent. The brief communication was issued on 02.10.08 and therefore still eleven days before the date indicated in the decision to revoke the patent. Consequently, the*

*decision was not handed over to the internal postal service when the request for Oral Proceedings was received."*

*"It is concluded that the Opposition Division was obliged to hold Oral Proceedings before a decision could be taken to revoke or to uphold the patent in suit. Consequently, ignoring the request for Oral Proceeding represents a substantial procedural violation and justifies to set the decision of the Opposition Division to revoke the patent in its entirety aside and to remit the case to the Opposition Division as well as to reimburse the appeal fee."*

VIII. With the communication of the board's registrar posted 19 February 2009, the respondent was given the opportunity to reply to the appellant's statement of grounds within a time limit of four months. Subsequently, the board issued a further communication with its provisional opinion that in view of the particular facts and circumstances of the case it was most likely that the contested decision would have to be set aside, the appeal fee refunded and the case remitted to the opposition division for further prosecution, without decision on the merits. For the sake of a possible shortening of the overall pendency time of the case, the respondent was invited to indicate in its reply whether or not it requested oral proceedings even in case the board intended to decide accordingly.

IX. In its letter dated 26 March 2009, the respondent replied as follows:

*"In case that the board of appeal decides to remit the case to the opposition division for further prosecution our request for oral proceedings is herewith withdrawn. Our request for oral proceedings is maintained in the case that the board of appeal decides to handle the case and decides on the merits."*

The respondent's letter does not include any comments concerning the issue of the procedural violation invoked by the appellant.

- X. The appellant requested that the decision under appeal be set aside, that the case be remitted to the opposition division and that the appeal fee be reimbursed (main request).

As a first auxiliary request, it requested that the decision of the opposition division be set aside and that the opposition be rejected and the patent be maintained.

- XI. The respondent requested that the appeal be dismissed.

### **Reasons for the Decision**

1. The appeal is admissible.
2. The letter of the patent proprietor dated 23 September 2008 was received and date-stamped by the EPO in Munich on the same date. The said letter of 23 September 2008 contains a request to dismiss the opposition and an auxiliary request for oral proceedings.

3. A copy of the said letter was forwarded to the opponent with a "BRIEF COMMUNICATION" posted on 2 October 2008 in the name of the opposition division. Therefore at least the formalities officer who dispatched this communication must have been aware of the patent proprietor's letter dated 23 September 2008 before 2 October 2008.
  
4. The decision of the opposition division revoking the patent in suit was posted on 13 October 2008, i.e. about three weeks after receipt of the later dated 23 September 2008 and several days after the dispatch of the "BRIEF COMMUNICATION" posted on 2 October 2008 by the formalities officer. The board has also checked the contents of the opposition file and found that that the decision to revoke the patent was apparently only taken on 8 October 2008, which is the date appearing on "EPO Form 2339 (Sheet 1)" signed by all three members of the opposition division.
  
5. However, the contested decision is silent about the letter of 23 September 2008 and does not mention any request of the patentee. The board can only speculate about the reasons for which the decision of the opposition division does not take into account the letter and the requests formulated therein. Considering the facts of the case, the opposition division, when taking its decision, had the duty to consider and take position on the requests filed earlier by the patentee. The fact that the patent proprietor had not contested the grounds of opposition previously to its letter of 23 September 2008 cannot lead to a different conclusion.



6. In "EPO Form 2334A" attached to the "BRIEF COMMUNICATION" posted on 11 January 2008, which was the last communication of the opposition division before issuance of the contested decision, the patent proprietor was expressly informed that its failure to reply to the opposition division's earlier communication did not lead to termination of the opposition proceedings and that in the absence of a reply within a period of two months, it was likely that the opposition proceedings would be continued pursuant to Article 101 EPC. The fact that the patent proprietor only filed its reply to this "BRIEF COMMUNICATION" on 3 September 2008 can thus not justify ignoring the requests formulated in the said reply.
  
7. According to decision G 12/91 of the Enlarged Board of Appeal (OJ EPO 1994, 285), point 9.2 of the Reasons, the moment the formalities section hands over the decision to the EPO postal service clearly marks the point in time up to which the parties can expect account to be taken of any further submission they might make, insofar as they are not disregarded as fresh matter submitted late in accordance with Article 114(2) EPC. However, in the present case, the opposition division did not disregard the patent proprietor's requests for being filed late, but ignored them altogether.
  
8. In the present case, the taking of the adverse decision to revoke the patent without granting the patentee's request for oral proceedings pursuant to Article 116 EPC thus constitutes a substantial procedural violation, see e.g. T 93/88 of 11 August 1988 (not published in the OJ), Reasons point 3; T 209/88 of 20 December 1989

(not published in the OJ), Reasons point 4.3, first paragraph; T 766/90 of 15 July 1992 (not published in the OJ), Reasons points 2 to 3.

9. According to Article 11 of the RPBA (OJ EPO 2007, 536ff.), a board shall remit the case to the department of first instance (pursuant to Article 111(1) EPC) if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise. The procedural violation that occurred in the present case is a fundamental deficiency and the board is not aware of any "special reasons" in the sense of the quoted provision.
  
10. The board thus deems the appeal to be allowable and the reimbursement of the appeal fee to be equitable by reason of the substantial procedural violation (Rule 67 EPC 1973).
  
11. In view of the above, the appellant's auxiliary requests need not be dealt with.

**Order**

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

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

The Registrar

The Chairman

P. Cremona

G. Raths