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**Datasheet for the decision
of 10 November 2015**

Case Number: T 0740/15 - 3.3.03

Application Number: 09004422.3

Publication Number: 2067820

IPC: C08L33/08, C09D133/08,
F16F15/00

Language of the proceedings: EN

Title of invention:
Water-based emulsion for vibration damper

Patent Proprietor:
Nippon Shokubai Co., Ltd.

Opponent:
The Dow Chemical Company

Relevant legal provisions:
EPC Art. 116(1), 111(1)
EPC R. 103(1) (a)

Keyword:
Substantial procedural violation -
request for oral proceedings ignored (yes)
Substantial procedural violation -
reimbursement of appeal fee (yes)
Remittal to the department of first instance - (yes)

Decisions cited:
G 0009/91, T 1182/05



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Case Number: T 0740/15 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 10 November 2015

Appellant: The Dow Chemical Company
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Midland, MI 48674 / US

Representative: Kent, Venetia Katherine, et al
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Respondent: Nippon Shokubai Co., Ltd.
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Representative: Mai, Dörr, Besier
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted on 18 February 2015 to discontinue the opposition proceedings against the European patent EP 2 067 820.**

Composition of the Board:

Chairwoman B. ter Laan
Members: D. Marquis
C. Brandt

Summary of Facts and Submissions

- I. The appeal by the Opponent lies from the decision of the Opposition Division dated 18 February 2015 to discontinue the opposition proceedings against European patent No. 2 067 820 (Form 2351).
- II. An Opposition had been filed against the patent on 27 January 2012 on the grounds of lack of sufficiency, novelty and inventive step. Oral proceedings were requested as an auxiliary measure.
- III. The proprietor responded with a letter dated 17 September 2012, requesting to maintain the patent in amended form according to a new main request or two auxiliary requests filed therewith.
- IV. On 11 August 2014, a communication pursuant to Rule 84(1) EPC was sent by the opposition division stating that the opposed patent had been surrendered or lapsed with effect for all the designated contracting states. In the communication it was stated that "the opposition proceedings may be continued at the request of the opponent, provided that within two months from notification of this communication a request is so filed." The communication further advised that the opposition proceedings would be discontinued if no such request was filed in due time "and the state of the files give no grounds for the proceedings to be continued by the European Patent Office".
- V. The opponent filed a response to the communication on 15 September 2014, in which it was requested that the opposition proceedings "be continued". It was also stated that "for the avoidance of doubt, the Opponent

maintains its previous arguments against the Patent and its request for oral proceedings."

VI. On 18 February 2015, the opposition division issued the decision to discontinue the opposition proceedings.

VII. A notice of appeal against that decision was filed by the opponent on 9 April 2015 (the appeal fee being paid on the same day) in which it was requested that the decision be set aside, that the opposition proceedings be continued, and that the patent be revoked for the reasons given in the written statements filed in the opposition proceedings. Further, the Appellant requested that the appeal fee be reimbursed according to Rule 103(1)(a) EPC as the decision of the opposition division amounted to a substantial procedural violation in view of the request in the letter of 15 September 2014 that the opposition proceedings be continued, and in view of the specific and repeated request in that letter for oral proceedings.

VIII. The statement of the grounds of the appeal was filed on 19 June 2015. It was requested to set aside the opposition division's decision so that the opponent would have an opportunity to have the patent revoked *ab initio*, that the appeal fee be refunded and that the opposition proceedings be continued. Further, it was requested that, "during the continued opposition proceedings, or as part of the appeal, that the patent be revoked in its entirety, in any form, on the basis of the substantive arguments provided in relation to insufficiency (see statement of opposition of 27 January 2012 and 1 February 2013), lack of novelty and lack of inventive step (see opposition statement)".

IX. The respondent did not provide any reply to the statement of the grounds of the appeal.

Reasons for the Decision

1. The appeal is admissible.
2. With a communication dated 11 August 2014 the parties were informed that pursuant to Rule 84(1) EPC the opposition proceedings could be continued if a corresponding request was filed by the opponent within two months. In reply to that communication, on 15 September 2014, the opponent requested that the opposition proceedings be continued and also maintained his previous request that oral proceedings in accordance with Article 116 EPC be held in the event that the opposition division was inclined to maintain the patent as granted or in amended form. Therefore, the Opponent had clearly shown its interest in the revocation of the patent with retroactive effect (Article 68 EPC).
3. On 18 February 2015 and without prior notification to the parties, the opposition division issued the following decision:

"The opposition proceedings in respect of European Patent no. 2067820 are discontinued.

The proprietor of the patent has surrendered the European patent for all the designated states or the European patent has lapsed for all those States.

Appeal

This decision is open to appeal. Attention is drawn to the attached text of Articles 106 to 108 EPC and Rules 97 and 98 EPC."

4. The decision of the opposition division to terminate the opposition proceedings consisted solely of the EPO Form 2351 and did not contain a reasoning why it was taken against the explicit request of the appellant to continue the opposition proceedings and also against the request of the respondent to maintain the patent as amended according to his main request or two auxiliary requests filed on 17 September 2012. This is in breach of Rule 111(2) EPC according to which decisions that are open to appeal should be reasoned. This lack of reasoning amounts to a substantial procedural violation that in itself justifies the reimbursement of the appeal fee.

5. Furthermore, the decision of the opposition division was issued without oral proceedings, against the express requests made by the proprietor on 17 September 2012 and the opponent on 15 September 2014.

- 5.1 Article 116(1) EPC establishes the right to oral proceedings at the request of any party. According to the case law of the Boards of Appeal, the right to oral proceedings is an extremely important procedural right which the EPO should take all reasonable steps to safeguard. If a request for oral proceedings has been made, such proceedings have to be appointed. This provision is mandatory and leaves no room for discretion. If such a request is ignored, even due to an oversight, the decision must be set aside as null and void (cf. Case Law of the Boards of Appeal of the European Patent Office, Seventh edition, 2013, III.C.

- 1). In line therewith, the infringement of Article 116(1) EPC is considered to be a substantial procedural violation justifying in itself the reimbursement of the appeal fee (cf. "Case Law", supra, IV.E.8.3.2a)).
- 5.2 In view of the facts of the present case, the Board considers that the requirements of Article 116(1) EPC have not been fulfilled, resulting in a substantial procedural violation justifying setting aside the decision under appeal and the reimbursement of the appeal fee in accordance with Rule 103(1)a) EPC.
6. Rule 84(1) EPC (Rule 60(1) EPC 1973) sets out that:
"If the European patent has been surrendered in all the designated Contracting States or has lapsed in all those States, the opposition proceedings may be continued at the request of the opponent filed within two months of a communication from the European Patent Office informing him of the surrender or lapse."
- 6.1 It is the Board's understanding of Rule 84(1) EPC that, provided the opponent files a request for continuation of the opposition proceedings within two months of the communication from the European Patent Office informing him of the surrender or lapse of the opposed patent, the scope of discretion of the opposition division provided in Rule 84(1) EPC is thereby limited to only one possible lawful decision and that is the continuation of the opposition proceedings. That understanding finds support in the Travaux Préparatoires of the EPC 1973. During the Diplomatic Conference in Munich 1973 Main Committee I examined a proposal submitted by the Member States of the European Communities according to which provisions for dealing with the consequences of lapse and surrender of a

patent should be introduced in what later became Article 99, Article 106 EPC and Rule 60 EPC (see Doc. M/14 dated 12 April 1973, points 4, 6 and 16). The legislative motive underlying the proposed amendment to future Rule 60 EPC was explained in that document in the following way:

"This proposal supplements the proposal for the insertion of a new paragraph 2a in Article 98 [...] The Member States of the European Communities considered that if any party interested is granted the right to institute proceedings against a European patent which has been surrendered or which has lapsed for all the designated States, it would logically be necessary to grant the opponent the right to have the opposition proceedings continued where the European patent is surrendered or lapses whilst the proceedings are taking place."

The proposal was agreed on by Main Committee I. The minutes of the proceedings record the following further explanation (See Minutes of the Munich Diplomatic Conference for the Setting Up of a European System for the Grant of Patents, page 94, point 2284):

"Speaking on behalf of those States, the delegation of the Federal Republic of Germany said that this amendment was merely the consequence of the acceptance of the proposal by the Member States of the European Communities concerning Article 98. It would therefore appear logical to recognise an opponent's right to have opposition proceedings continued where a European patent had been surrendered or had lapsed while opposition proceedings were still in progress."

- 6.2 The Board deduces from the Travaux Préparatoires that in the presence of a valid request of the opponent to continue the opposition proceedings against a European patent that has been surrendered in all the designated Contracting States or has lapsed in all those States, the scope of Rule 60(1) EPC (now Rule 84(1) EPC) was intended to limit the discretion of the opposition division to the continuation of the opposition proceedings. The opposition division had therefore in the circumstances of the present case no other discretion than to continue the opposition proceedings.
7. On pages 1 and 4 of its the statement of the grounds of the appeal the appellant requested that the opposition proceedings be continued and that "during the continued opposition proceedings, or as part of this appeal, that the Patent be revoked in its entirety, in any form, on the basis of the substantive arguments provided in relation to insufficiency (see statement of opposition of 27 January 2012 and 1 February 2013), lack of novelty and lack of inventive step (see opposition statement)". The Board interprets that statement as a request to continue the opposition proceedings either before the opposition division or before the Board of Appeal. Since the opposition division has not given any decision on the grounds of opposition raised by the opponent, the Board finds it appropriate, in these circumstances, not to investigate the substantive questions of patentability but, in order to give the parties the opportunity to have those questions considered by two instances, to exercise its power under Article 111(1) EPC and to remit the case to the opposition division for further prosecution.
- 7.1 As pointed out above (point III), the patent proprietor had filed new requests. Since at the moment there is no

request to maintain the patent as granted, those requests (of 17 September 2012) form the basis on which, at the present stage of the procedure, the opposition should be continued.

Order

For these reasons it is decided that:

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

The Registrar:

The Chairwoman:



B. ter Heijden

B. ter Laan

Decision electronically authenticated