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**Datasheet for the decision
of 30 April 2021**

Case Number: T 2365/17 - 3.3.03

Application Number: 99922271.4

Publication Number: 0998522

IPC: C08K3/26, C08K9/04, C08K13/06,
C08J5/18

Language of the proceedings: EN

Title of invention:

USE OF PARTICULATE CARBONATES IN THERMOPLASTIC FILM
COMPOSITIONS

Patent Proprietor:

IMERTECH SAS

Opponents:

Omya International AG
SA REVERTÉ Productos Minerales

Relevant legal provisions:

EPC R. 84(1), 100(1)

Keyword:

Lapse of patent in all designated states - termination of
appeal proceedings

Decisions cited:

G 0002/97, R 0004/09, T 0708/01



Beschwerdekammern
Boards of Appeal
Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 2365/17 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 30 April 2021

Appellant: IMERTECH SAS
(Patent Proprietor) 43, quai de Grenelle
75015 Paris (FR)

Representative: Haseltine Lake Kempner LLP
Redcliff Quay
120 Redcliff Street
Bristol BS1 6HU (GB)

Respondent 1: Omya International AG
(Opponent 1) Baslerstrasse 42
4665 Oftringen (CH)

Representative: Glas, Holger
Maiwald Patentanwalts- und
Rechtsanwaltsgesellschaft mbH
Elisenhof
Elisenstraße 3
80335 München (DE)

Respondent 2: SA REVERTÉ Productos Minerales
(Opponent 2) Ctra. N-340 km 1196,6
43719 Bellvei Tarragona (ES)

Representative: Ungria López, Javier
Avda. Ramón y Cajal, 78
28043 Madrid (ES)

Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 4 October 2017
revoking European patent No. 0998522 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman F. Rousseau
Members: O. Dury
 C. Brandt

Summary of Facts and Submissions

- I. The appeal lies from the decision of the opposition division posted on 4 October 2017 revoking European patent No. 0 998 522, which is based on European patent application 99 922 271.4 filed on 21 May 1999.

- II. By communication of the Board of 9 February 2021, the parties' attention was drawn to the fact that as more than 20 years had passed since the filing date of the application underlying the patent in suit, the patent had to have lapsed in all contracting states (Article 63(1) EPC). It was further indicated that the present proceedings could therefore only be continued at the request of the opponent (Rule 84(1) EPC). However, if - as in the present case - the patent proprietor was the appellant, it would be inappropriate to allow the opponents (respondents) to decide whether the appeal proceedings shall be continued. For this reason, Rule 84(1) EPC had to be applied *mutatis mutandis*, so that it was the patent proprietor who could request that the appeal proceedings be continued (see decision T 708/01 of 17 March 2005, point 1 of the Reasons). Finally, it was stressed that such a request had to be filed within two months from notification of this communication (Rule 84(1) EPC).

- III. The appellant (patent proprietor) did not reply within the time limit of two months.

- IV. Additional submissions were also not made past that time limit. Upon inquiry by the Registrar, the appellant informed the Board with an email dated 27 April 2021 that they had duly received the Board's

communication on 12 February 2021.

- V. The oral proceedings scheduled on 2 June 2021 were subsequently cancelled.

Reasons for the Decision

1. The fact indicated in the Board's communication (see above section II) that the patent has lapsed in all contracting states (Article 63(1) EPC) was not contested.
2. If a European patent has lapsed in all designated contracting states, opposition proceedings may be continued at the request of the opponent (Rule 84(1) EPC). According to Rule 100(1) EPC, this also applies in appeal proceedings following opposition proceedings. However, if, as in the present case, the patent proprietor is the appellant, it would be inappropriate to allow the opponents (respondents) to decide whether the appeal proceedings shall be continued. For this reason, Rule 84(1) EPC has to be applied *mutatis mutandis* in such opposition appeal proceedings so that it is the patent proprietor who can request that the appeal proceedings be continued (see decision T 708/01 of 17 March 2005, point 1 of the Reasons; see also Case Law of the Boards of Appeal of the EPO, 9th edition, 2019, III.Q.1.2.2).
3. Users of the European patent system have the responsibility to take all necessary steps to avoid a loss of rights (G 2/97, OJ EPO 1999, 123, point 4.2 of the Reasons; R 4/09 of 30 April 2010, point 2.3.2 of the Reasons). By not replying to the Board's communication dated 9 February 2021 within the set time

period or within the period under Rule 133(1) EPC, which was confirmed to have been duly received, the appellant failed to satisfy the stipulations of Rule 84(1) EPC with respect to the continuation of appeal proceedings. This is interpreted as meaning that the appellant did not wish to request continuation.

4. Under these circumstances, the Board sees no reason to continue the appeal proceedings of its own motion. Therefore, the appeal proceedings are terminated without a decision on the merits of the case (Case Law, *supra*, III.Q.1.2).

Order

For these reasons it is decided that:

The appeal proceedings are terminated.

The Registrar:

The Chairman:



B. ter Heijden

F. Rousseau

Decision electronically authenticated