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Aktenzeichen / Case Number / N° du recours : T 317/86 - 3.2.1

Anmeldenummer / Filing No / N° de la demande : 81 3055 677.7

14 + 16

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 054 378

Bezeichnung der Erfindung: Method of controlling operation of an
Title of invention: electronstatic precipitator
Titre de l'invention :

Klassifikation / Classification / Classement : B03C 3/68

ENTSCHEIDUNG / DECISION

vom / of / du 15 April 1988

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet :

Smidth & Co. A/S

Einsprechender / Opponent / Opposant :

Metallgesellschaft A.G.

Stichwort / Headword / Référence :

Titel of invention/SMIDTH

*Bitte bei Veröffentlichung
im Inhalt berücksichtigen*

*Danke
Kühnert*

X

EPO / EPC / CBE Rules 56(2), 55(b)

Kennwort / Keyword / Mot clé :

"Opposition - requirements" "Title of Invention
- necessity of mentioning"

Leitsatz / Headnote / Sommaire

If the particulars available to the EPO are together sufficient to identify an opposed patent easily and beyond doubt, no deficiency within the meaning of Rule 56(2) EPC exists with regard to the omission of the title of that patent from the notice of opposition. Either of the numbers (publication number or application number) will normally suffice, provided that all the other particulars given with the notice of opposition together with the file establish beyond all doubt that the patent is the one intended.

Europäisches
Patentamt
Beschwerdekammern

European Patent
Office
Boards of Appeal

Office européen
des brevets
Chambres de recours



Case Number : T 317/86 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 15 April 1988

Appellant :
(Opponent 01)

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Representative :

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Respondent :
(Proprietor of the patent)

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Representative :

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Participant :
(Opponent 02)

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Decision under appeal :

Decision of the Formalities Officer of the
Opposition division of the European Patent Office
dated 16 July 1986 rejecting the opposition filed
against European patent No. 0 054 378 pursuant to
Rule 56(2) EPC

Composition of the Board :

Chairman : P. Delbecque
Members : O. Bossung
C. Wilson

Summary of Facts and Submissions

I. On 20 February 1985 announcement was made in the European Patent Bulletin of the grant of a patent with the publication number 0 054 378 (application number 81 305 677.7). The patent proprietor was "F.L. Smidth & Co. A/S", the language of the proceedings English and the title of the invention "Method of controlling operation of an electrostatic precipitator". Claim 1 begins in English with the words: "A method of controlling the operating parameters of an electrostatic precipitator" and in German with the words: "Verfahren zur Regelung der Betriebsparameter eines elektrostatischen Abscheiders".

II. On 21 November 1985 Opponent 01 filed notice of opposition in German. This contained the publication number, the application number and the name of the proprietor of the contested patent. The statement of grounds, likewise drawn up in German, begins with the words: "Das Patent bezieht sich auf ein Verfahren zur Regelung der Betriebsparameter eines elektrostatischen Abscheiders, der ..." (The patent relates to a method of controlling the operating parameters of an electrostatic precipitator which ...) and runs to more than five pages in which particulars of the patent are quoted.

III. By communication (EPO Form 2302.9 04.81) dated 2 December 1985 the formalities officer notified Opponent 01 in accordance with Rule 56(2) that the notice of opposition did not contain the title of the invention as required under Rule 55(b) EPC and requested him to remedy this deficiency within a period of two months. The Opponent immediately completed his notice of opposition by telex (received on 5 December 1985) by supplying the title of the patent in English.

The Opponent did not submit any confirmation of the telex.

IV. No objections were raised to the admissibility of a further opposition (02) entered against the European Patent in question. Opponent 02 did not comment on the question of the admissibility of Opposition 01 in the proceedings of the first and second instance and did not enter any petitions in this connection.

V. In a communication (EPO Form 2305.2 11.80) dated 21 May 1986 (with hand-written amendments appropriate to the case) Opponent 01 was informed that since the telex had not been confirmed it was deemed not to have been received; the deficiency complained of, i.e. the missing title, had therefore not been remedied on time, and the notice of opposition was expected to be rejected as inadmissible pursuant to Rule 56(2) EPC. On 27 May 1986 the Opponent submitted written confirmation of the telex and explained that he had made minor corrections to his notice of opposition by means of another telex which had likewise not been confirmed. In both cases he had assumed that confirmation was not needed for corrections of this kind.

VI. By decision dated 16 July 1986 the formalities officer rejected Opponent 01's notice of opposition as inadmissible on the basis of Rule 56(2) EPC, the reason given being essentially that a deficiency complained of could not be remedied by an unconfirmed telex. The requirement to supply the title of the patent in Rule 55(b) EPC was a formal one which could not be replaced by stating the subject-matter of the patent somewhere in the notice of opposition. What was required was a designation conforming to Rule 26(2)(b) EPC in the sense of "title" or "name"

of the invention appearing on the patent specification under INID code "54" in accordance with WIPO Standard St.9.

VII. Opponent 01 appealed against this decision on 13 September 1986, paying the required fee. In his statement of grounds, received on 13 November 1986, he referred to the Decision of Opposition Division 024 of 15 June 1983 (OJ EPO 3/1984, p. 118) and to the Guidelines Part D-IV, 1.2.2.1 (c), according to which, even if the title were not mentioned, there would still be an adequate description of the contested patent for the opposition to be admissible. The absence of information required only for secondary purposes (e.g. bibliography) could not lead to the opposition being deemed inadmissible. The telex only served to confirm a piece of information already in the hands of the Office. To invoke the fiction in Rule 36(5) EPC whereby documents would be deemed not to have been received if not confirmed within a period of two weeks would be to overemphasise the formal aspects. Rule 36 EPC was applicable to the opposition under Rule 61a EPC, but such application was not justified since notification of the title did not constitute an independent communication: it represented only the confirmation of a piece of information already known to the Office.

VIII. Opponent 01 requests that the contested decision be set aside and that his notice of opposition be treated as admissible. For the reasons stated in the formalities officer's decision, the patent proprietor considers the notice of opposition to be inadmissible and accordingly requests that the appeal be rejected.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is therefore admissible.
2. In accordance with point 6 of 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 15 June 1984 (OJ EPO 7/1984, p. 319), the formalities officer was responsible for taking a decision of the kind involved here.
3. The formalities officer's action cannot unhesitatingly be described as unjustifiably formal. He did after all apply Rules 55(b), 56(2) and 36(5) EPC to the letter. And the Guidelines for Examination, Part D-IV, 1.2.2.2 (b), second paragraph ("Each of the particulars ... must be supplied") point the way to such action. It should also be remembered that patent proprietors can legitimately take the view - as here - that even failure to meet a purely formal requirement on time will make a notice of opposition definitely inadmissible. It was in just such a way that in the consolidated cases T 114/82 and T 115/82 (OJ EPO 8/1983, p. 323) a patent proprietor had - solely because the opponent had mixed up the publication numbers of two patents belonging to that same patent proprietor - resisted any move to regard the notice of opposition in question as having been entered against the patent intended by the opponent. The case was remitted to Opposition Division 024 which on 15 June 1983 gave the Decision already referred to (OJ EPO 3/1984, p. 118).

4. However, in the aforementioned case before the Opposition Division the matter at issue was whether the patent was "sufficiently identified" under Rule 56, paragraph (1) EPC "before expiry of the opposition period". It was not - as in the present case - a matter of what further information (i.e. bibliographical data) still had to be supplied in accordance with Rule 56, paragraph (2) in conjunction with Rule 55(b) EPC - provided that the patent was identifiable under Rule 56, paragraph (1) EPC (as is undoubtedly the case here). Two kinds of identification of the contested patent have thus to be distinguished. This becomes clearer if Rules 55 and 56 are interpreted against the background of Article 99(1) EPC which they are intended to implement.

5. Article 99(1) EPC says, inter alia, that "any person" may give notice of opposition to the European patent. Such opposition institutes new proceedings before the EPO, the subject of which, i.e. the patent concerned and the parties, must be established unequivocally and definitively.

6. As regards the identity of the opponent, which is not the point at issue here, it would be contrary to Article 99(1) EPC to interpret Rule 55(a) in conjunction with Rule 56 EPC, solely on the basis of their wording, as meaning that for the purpose of pointing out deficiencies that identity need only be ascertained later. An interpretation sticking solely to the letter of Rule 55(a) and divorcing this Rule from Article 99(1) EPC could lead to such a conclusion. However, it has already been clarified that the name of the opponent - contrary to the letter of Rules 55(a) and 56(2) EPC - cannot be freely added later on (see

in this connection T 10/82, OJ EPO 10/1983, p. 407 and, in the wake of this, the Decision of an Opposition Division in OJ EPO 2/1986, p. 56; also: T 25/85, OJ EPO 3/1986, p. 81, and T 219/86, scheduled for publication).

In all these Decisions it is a matter with regard to the identity of the opponent of interpreting the wording of Rule 55(a) in conjunction with the meaning of Article 99(1) EPC. The question is therefore what requirements must definitely be fulfilled by the end of the period for opposition and which of them can be complied with later.

7. Article 99(1) EPC is concerned only with the contested European patent itself, making no mention at all of the patent proprietor, to whom Rule 55(b) EPC does refer. This shows that one of the requirements specified in this latter Rule, i.e. the name of the patent proprietor, is not so decisively important, since the identity of the latter automatically emerges once it has been established which patent is being contested. The identity of the patent proprietor could also have changed through a transfer having been made in the meantime, in which case it cannot and need not be notified to the EPO by the opponent under Rule 55(b) EPC (cf. Guidelines Part D-IV, 1.2.2.2 (b), second sentence of second paragraph). This shows that the details required from the opponent under Rule 55(b) EPC are only bibliographical data used to identify the contested patent and lose their significance once they are no longer needed for the purpose for which they are intended.

8. In the opposition proceedings, besides unequivocal identification of the person of the opponent (see point 5 above)

the important factor is unequivocal identification of the contested patent. For this purpose alone the contents of the statement of grounds for the opposition suffice. If this statement is in accordance with Article 100 and Rule 55(c) EPC it can be valid only for one specific European patent, even if that patent must still be ascertained. Therefore Rule 56(1) EPC requires more than just a statement of grounds for opposition in order to identify the patent: it requires that the notice of opposition "provide sufficient identification of the patent". This does not, however, mean that Rules 55(b) and 56(1) and (2) EPC can be interpreted to mean that all the particulars specified in Rule 55(b) EPC must be furnished in order for the patent to be identifiable under Rule 56(1) EPC. Since individual deficiencies can in principle be remedied, it follows that certain particulars required under Rule 56(2) EPC can be supplied later. The aforementioned Decision of Opposition Division 024 that "a patent is sufficiently identified under Rule 56(1) EPC if the particulars in the notice enable the Office, without undue effort, to identify with certainty the contested patent before expiry of the opposition period" therefore has to be agreed with. Even particulars other than those contained in Rule 55(b) EPC, for example the date on which mention of the grant of patent appeared in the European Patent Bulletin and other bibliographical data, may contribute to "enable the Office to establish the contested patent with certainty and without undue effort before expiry of the opposition period".

9. So when Rule 56(2) EPC requires deficiencies in the particulars required under Rule 55(b) to be notified by the Office and remedied by the opponent it can no longer be a matter

here of providing identification under Rule 56 paragraph (1) EPC. The purport of Rule 56 paragraph (2) in conjunction with Rule 55(b) can therefore only be that the EPO has to be enabled to identify the contested patent without difficulty; therefore as soon as the particulars available concerning the patent are together sufficient to identify that patent easily and beyond doubt a situation is no longer present in which there is still a "deficiency" within the meaning of Rule 56(2) EPC to complain of and to be remedied.

10. The publication number or application number will normally suffice to trace and consult a specific file, and the number of the European patent under Rule 55(b) EPC first drafted in 1964 and 1970 can be either of those numbers, since it was only in later administrative practice that they became differentiated. The second number and other bibliographical data are of course not only useful but essential in order to eliminate doubt and to enable any errors to be corrected (cf. the aforementioned Decision of Opposition Division 024 of 15 June 1983).

11. It should moreover be pointed out that the requirement to state the title of the invention can prove to be an unintended pitfall for the opponent if under Rule 1 EPC he uses an official language other than the language of the proceedings as defined in Article 14(3) EPC. For if the language of the opposition differs from that of the contested patent, he runs a considerable risk of not reproducing the title of the invention as printed on the

patent. The intent of Rule 55(b) EPC in requiring the title of the invention is to identify the contested patent and not to set the opponent a linguistic trap; since the Claims are also given in the two other official languages the function of that title as an identifying feature can as a rule also be fulfilled in those languages. It is therefore wrong to set the "title of the invention" under Rule 55(b) EPC on a par with WIPO Standard St.9 and the INID code "54" entry. In diverging from this, either in language or form, the title does not cease to serve as an identifying feature under Rule 55(b) EPC. Those responsible for drafting the Implementing Regulations of 1964 (EEC Doc. 4419/IV/63 dated 20 January 1964, Re Art. 88, No. 1) and the Implementing Regulations of 1970 (Second Preliminary Draft of the EPC of 1971, Re Art. 101, No. 1) would hardly have had any such links and consequences in mind.

12. Finally, there is the question as to whether the appeal fee can be reimbursed. The answer is that it cannot, since no "substantial procedural violation" within the meaning of Rule 67 EPC is present for the reasons stated under point 3 above.

Order

For these reasons, it is decided that:

The contested decision is set aside and the case remitted to the first instance.

The Registrar:

(S. Fabiani)

The Chairman:

(P. Delbecque)