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Bezeichnung der Erfindung: Process for the preparation of light hydrocarbon  
Title of invention: fractions  
Titre de l'invention :

Klassifikation / Classification / Classement : C 10 G 47/20

### ENTSCHEIDUNG / DECISION

vom / of / du 17 November 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Shell Internationale Research  
Maatschappij B.V.

Einsprechender / Opponent / Opposant :

01 BASF AG  
02 Bayer AG

Stichwort / Headword / Référence : Changed composition of Division/Shell

EPO / EPC / CBE Articles 15, 19, 101, 102, 113, 116, Rules 58, 68

Kennwort / Keyword / Mot clé : Oral decision - subsequent written decision  
signed by persons who did not make oral  
decision - decision invalid.

#### Leitsatz / Headnote / Sommaire

I. An Opposition Division has power to give a final substantive decision (here, relating to the patentability of individual claims) before sending a communication under Rule 58(4) EPC.

II. In a case where a final substantive decision has been given, an Opposition division has no power thereafter to continue examination of the opposition in relation to the issues which are the subject of that decision, either under Rule 58(5) EPC or at all. Further submissions from the parties relating to such issues are inadmissible.

III. A decision must be written on behalf of and represent the views of the members appointed to decide the proceedings, and must bear signatures which indicate this.

Europäisches  
Patentamt

Beschwerdekammern

European Patent  
Office

Boards of Appeal

Office européen  
des brevets

Chambres de recours



Case Number : T 390 /86

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 17 November 1987

**Appellant :**  
(Opponent 01)

BASF Aktiengesellschaft  
Carl-Bosch-Strasse 38  
D-6700 Ludwigshafen

**Appellant :**  
(Opponent 02)

Bayer AG, Leverkusen  
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D-5090 Leverkusen

**Respondent :**  
(Proprietor of the patent)

SHELL INTERNATIONALE RESEARCH  
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**Representative :**

Puister, Antonius Tonnis  
PO Box 302  
NL-2501 CH The Hague

**Decision under appeal :**

Interlocutory decision of the Opposition Division of  
the European Patent Office dated 11 September 1986  
concerning maintenance of European Patent  
No. 0 019 959 in amended form.

**Composition of the Board :**

**Chairman :** K. Jahn

**Members :** G.D. Paterson

F. Antony

### Summary of facts and submissions

I. Notices of opposition to European patent No. 19 959 were filed by two opponents. Opponent I conditionally requested oral proceedings. In due course oral proceedings were appointed and took place on 8 October 1985, before three members of the Opposition Division. All three parties were represented at the oral proceedings and submissions were made on their behalf in relation to the substantive issues which were raised by both opponents. At the end of the oral proceedings, the Chairman announced that the Decision of the Opposition Division was:

- (i) that the main request of the patent proprietor to maintain the patent in unamended form was not allowed;
- (ii) that the auxiliary request of the proprietor to introduce the features of Claim 2 into Claim 1 is allowable;
- (iii) that the further procedure would be that the Opposition Division would issue a communication under Rule 58(4) EPC, indicating the text of the patent in which it was intended to maintain the patent.

On 20 December 1985 a Communication was duly issued pursuant to Rule 58(4) EPC, signed by a Formalities Officer, which indicated the text of the patent which the Opposition Division intended to maintain, and which enclosed Minutes of the oral proceedings (pursuant to Rule 76) which recorded the Decision as set out above, and which were signed by two of the three members of the Opposition Division, namely the Chairman and the Second Member acting as minute writer, before whom the oral proceedings had taken place. Both

opponents duly stated that they disapproved of the text in which it was intended to maintain the patent, on 13 and 17 January 1986 respectively, and furthermore continued to make submissions that the patent should not be maintained at all.

- II. On 11 September 1986 an Interlocutory Decision within the meaning of Article 106(3) EPC was issued by the Opposition Division, which was signed by three members of that Division, and which set out reasons for Claim 1 of the patent as unamended not being allowed, and for the allowability of the auxiliary request of the proprietor and for the allowability of the maintenance of the patent in consequently amended form. These three members were not the three members before whom the oral proceedings took place, and as far as the file of the proceedings indicates, none of these three members had taken any part in the proceedings, except to sign such written Decision.
- III. On 29 October and 10 November 1986 respectively, the two opponents filed notices of appeal and paid the appeal fees. Opponent I pointed in his notice of appeal to the fact that the Interlocutory Decision was signed and issued in the names of three persons who had neither taken part in the oral proceedings on 8 October 1985, nor otherwise dealt with the case previously; and he asked whether in these circumstances the Interlocutory Decision was legally valid. Both opponents duly filed statements of grounds of appeal.

#### **Reasons for the Decision**

1. The appeals comply with Articles 106 to 108 and Rule 64 EPC and are admissible.

2. The Minutes of the oral proceedings clearly indicate that the decision of the Opposition Division in respect of the main and auxiliary requests of the patent proprietor (i.e. the substantive decision in respect of the opposition), was given orally by the Chairman at the oral proceedings on 8 October 1985, in accordance with Rule 68(1) EPC, first sentence, on behalf of the three members who took part in the oral proceedings. Procedure in accordance with Article 102(3) and Rule 58(4) EPC then took place.

Rule 68(1) EPC provides that when such a decision has been given orally, "Subsequently the decision in writing shall be notified to the parties". Furthermore, Rule 68(2) EPC requires that "Decisions of the EPO which are open to appeal shall be reasoned ...".

These requirements of Rule 68 EPC are clearly additional to Rule 76 EPC concerning the drawing up of minutes of oral proceedings, and the provision of copies of such minutes of the parties. Thus, in a case such as the present when a substantive decision is given orally during oral proceedings, such substantive decision must be formally notified to the parties in writing (Rule 68(1) EPC), and the substantive decision must be formally completed by the giving of reasons for the decision in writing (Rule 68(2) EPC). It is clear from Rule 68 EPC and Article 108 EPC that until a substantive oral decision is formally completed in writing in this way, and notified to the parties, the two months period within which a notice of appeal must be filed does not begin.

In the present case, in accordance with Rule 68(1) EPC the substantive oral Decision given on 8 October 1985 was intended to be formally completed by the notification of the written Interlocutory Decision dated 11 September 1986.

This written decision sets out reasons for the substantive oral decision not to allow the main request but to allow the auxiliary request of the Respondent, and also sets out the formal decision to maintain the patent in amended form, with a text in the form which is specified in the Communication under Rule 58(4) EPC.

3. The Board has in the first place considered whether the Opposition Division had power to give a substantive oral decision of the kind which was announced at the conclusion of the oral proceedings; i.e. which is "final" in respect of the matters decided (if a decision is "final" it cannot be changed by the same instance and if it falls within Article 106(1) EPC, it is subject to appeal). This depends upon a consideration of Article 102 and Rule 58 EPC.

- 3.1. Paragraphs (1) and (2) of Article 102 EPC provide that, depending upon the opinion of the Opposition Division in relation to the grounds of opposition which have been raised, it may revoke the patent or it may reject the opposition. Paragraph 102(3) EPC deals with the situation where the Opposition Division takes the intermediate course and is prepared to maintain the patent in an amended form.

Clearly Article 102 EPC applies to oppositions in which there are oral proceedings as well as to proceedings in which there are none. Equally clearly in the case of oppositions where paragraphs (1) and (2) of Article 102 EPC are applicable, the Opposition Division has the power under Rule 68 EPC to give its (final) decision (either to revoke the patent or to reject the opposition) during the oral proceedings.

In the case of an opposition where the first part of Article 102(3) EPC is applicable, the Article goes on to provide that it (the Opposition Division) shall decide to maintain the patent as amended, provided that:

- (a) it is established (in accordance with Rule 58(4) EPC) that the proprietor approves the text in which the Opposition Division intends to maintain the patent; and
- (b) the printing fee is paid in due time.

Pursuant to these provisions, Rule 58(4) EPC provides that "Before the Opposition Division decides on the maintenance of the European patent in the amended form, it shall inform the parties ..." of its intention to do so, and shall invite observations; and in accordance with this Rule a written Communication under Rule 58(4) EPC is usually issued.

However, the above-mentioned provisions of Article 102(3) and Rule 58(4) EPC do not preclude that an Opposition Division may, in the course of an opposition proceeding, make a (final) interlocutory decision in respect of a substantive issue which is raised by the opposition, before the sending of any Rule 58(4) EPC communication. What is precluded by Rule 58(4) EPC is that the Opposition Division should "decide on the maintenance of the European patent" in an amended form without first informing the parties of the amended text in which it is intended to maintain the patent and inviting their observations. However, neither Article 102(3) nor Rule 58(4) EPC preclude an Opposition Division from giving decisions on substantive issues in the opposition before sending a communication under Rule 58(4) EPC, and before "deciding to maintain the patent in amended form". For example, an Opposition Division may during the course of an opposition make a (final) interlocutory

decision (either orally or in writing) that a particular proposed amendment contravenes Article 123 EPC. Similarly, in the Board's view, an Opposition Division may make a (final) interlocutory decision during the course of an opposition that the main claim, for example, of the opposed patent cannot be maintained. Such a substantive interlocutory decision is not a decision actually to maintain the patent in amended form, but is preliminary to such a decision.

The making of such substantive interlocutory decisions during the course of opposition proceedings is desirable both in order to move the proceedings forward towards a conclusion, and, in appropriate cases as envisaged in Article 106(3) EPC, to allow a party to appeal such an interlocutory decision before the opposition proceedings are terminated.

In this connection, it is clearly desirable (in similar circumstances) that the procedure of the Opposition Division and of the Boards of Appeal is generally the same. This is reflected in Rule 66(1) EPC which provides that "Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*". As far as proceedings before the Boards of Appeal are concerned, it is the current practice to announce the Board's decision in accordance with any of paragraphs (1) to (3) of Article 102 EPC at the conclusion of oral proceedings.

If the decision of a Board is in accordance with Article 102(3) EPC, that is, the decision is to maintain the patent in an amended form, then in accordance with Decision T 219/83, "Zeolites/BASF" (OJ EPO 1/1986, page 211), in each



individual case it is considered whether or not a written communication under Rule 58(4) EPC should be sent before the text is finalised.

- 3.2. The Board notes that Rule 58(5) EPC provides that if a party expresses disapproval of the text specified in a communication issued under Rule 58(4) EPC, "examination of the opposition may be continued". In the Board's view, for the reasons set out below, this should be interpreted in the sense that any continuation of examination under Rule 58(5) EPC should only be to the extent necessary to deal with the disapproval of the text itself.

The purpose of Rules 58(4) and (5) EPC is to implement Article 102(3)(a) EPC. Thus the main purpose of sending a communication under Rule 58(4) EPC is to inform the parties that the Opposition Division "intends to maintain the patent as amended", and to establish thereby that in the first place, the proprietor of the patent approves the proposed text. Such approval of the text by the proprietor is required by Article 102(3)(a) EPC (having regard to the provision in Article 113(2) EPC) before the formal decision to maintain the patent with an amended text is made.

Clearly, the examination of the substantive grounds of the opposition will normally be completed prior to the sending of a Rule 58(4) EPC communication - within the procedure of Article 101 EPC and the corresponding Rules which implement Article 101 EPC, namely Rules 57 and 58(1) to (3) EPC. Provided that a substantive decision on the issues in the opposition has not previously been given, after the sending of a Rule 58(4) EPC communication an Opposition Division still has the power to consider the substantive grounds of

opposition; but such power is provided under Article 101 EPC, and when appropriate under Article 114(1) EPC, not by Rule 58(5) EPC - and should only be exercised exceptionally.

Although Rule 58(4) EPC provides equality of treatment of the parties in that opponents as well as the proprietor are invited to state their observations if they disapprove of the text, this provision should be interpreted within its context, and in particular within the context of Article 102(3)(a) EPC. Thus any such observations filed under Rule 58(4) EPC, whether by the proprietor or by an opponent, should be confined to the proposed wording of the text and its formal allowability.

The interpretation of Rule 58(4) and (5) EPC set out above is consistent with the interpretation of the word "disapproval" in the context of Rule 51(4) EPC (before its amendment which entered into force on 1 September 1987), which was considered in Decision J 22/86 "Disapproval/Medical Biological" (OJ EPO 7/1987, page 280) at paragraph 4.

4. Having regard to paragraph 3 above, in the present case the Board considers that the Opposition Division clearly had power to give the oral decision as set out in paragraph I above. As soon as it was issued at the oral proceedings on 8 October 1985, the oral decision was final in respect of the substantive issues in the opposition proceedings with which it dealt (i.e. (i) and (ii)). The decision also stated in (iii) the subsequent procedure which would be followed. Thus it was decided that Claim 1 was not allowed, but that the patent was maintainable with the subject-matter of Claim 2 as the main claim, provided that the text was suitably amended (i.e. in accordance with the auxiliary request).

Within such further procedure, as mentioned at the end of paragraph I above both opponents stated that they disapproved of the text. Opponent I also set out written "grounds", immediately following the statement of disapproval. These grounds did not deal with the question whether the amended text which was communicated under Rule 58(4) properly conformed with the decision to maintain the patent with a text which corresponded to the auxiliary request, but rather continued to submit reasons why the patent should not be maintained at all. Similarly, Opponent II submitted that the new main claim of the amended text should not be maintained on substantive grounds. These "grounds" and submissions of Opponents I and II were directed to issues which had already been finally decided against the Opponents by the Opposition Division. After the substantive oral decision had been given, the Opposition Division had no power thereafter to continue examination of the opposition in relation to the substantive issues the subject of that decision, either under Rule 58(5) EPC or at all. The Opponents' submissions were therefore redundant and inadmissible within these proceedings before the Opposition Division.

5. The further question raised in the appeal is whether the decision of the Opposition Division was valid having regard to the facts set out in paragraph II above.

Although Rule 70 EPC states that "Any communication from the EPO is to be signed by and to state the name of the competent employee", there is nothing in Rule 68 EPC or elsewhere in the EPC which specifically requires a decision of a first instance of the EPO (i.e. a decision which is open to appeal) to be signed by the competent employee(s).

In order to decide upon the question of the validity of the written decision dated 11 September 1986, having regard to the point raised by Opponent I as set out in paragraph III above, the Board must consider the basic principles which are applicable.

6. Article 15 EPC sets up within the EPO various departments for "implementing the procedures laid down in" the EPC.

A decision of a department of the EPO concerning the grant or maintenance of a European patent, such as the decision in the present opposition proceedings, is a decision which has immediate binding effect upon the civil rights of the parties and the public in the designated Contracting States. The power of a department of the EPO to issue a decision, and the authority which underlies such a decision, is derived from the EPC.

7. In the case of opposition proceedings, Article 19(1) EPC provides that "An Opposition Division shall be responsible for the examination of oppositions against any European patent"; Article 19(2) EPC provides that "An Opposition Division shall consist of three technical examiners...", and goes on to set out provisions concerning the constitution of such an Opposition Division. It is quite clear from such provisions that an opposition in respect of a particular European patent is in all cases to be conducted and decided by three technical examiners who are appointed on a personal basis in respect of a particular opposition (in some cases an additional legal examiner may also be appointed). Thus it is provided that at least two of the three examiners shall not have taken part in proceedings for grant of the patent, and that one of those two examiners shall be the Chairman. It is also specifically provided that

"Oral proceedings shall be before the Opposition Division itself"; that is, before the three technical examiners who were personally appointed to form the Opposition Division for the examination of the particular opposition.

Furthermore, the reference to voting in the final sentence of Article 19(2) EPC makes it clear that an opposition should be decided on the basis of the personal votes of the individual examiners who have been appointed to constitute a particular Opposition Division.

It is thus clear from Article 19 EPC that the power to examine and decide an opposition pursuant to Articles 101 and 102 EPC must at all times be exercised personally by the examiners who are appointed to decide it.

Furthermore, in accordance with the well-known principle "delegatus non potest delegare", the power of a department of the EPO such as an Opposition Division to issue a decision must not only be exercised personally but also be seen to be exercised personally, both by the parties and by the public. This is clearly to be implied from the provisions of Articles 113(1) and 116 EPC.

Thus when oral proceedings pursuant to Article 116 EPC are held within opposition proceedings, such oral proceedings should ensure that the subsequent decision is based on grounds or evidence on which the parties have had a proper opportunity to present their comments. In order that this is so, clearly such oral proceedings should be held before all the appointed examiners, and if a decision is given orally, it will be given in the presence of all such examiners. Similarly with respect to a decision in writing setting out reasons for the oral decision, the parties and the public

should be able to see from the written decision that it has been made by the examiners who were appointed to the particular Opposition Division responsible for that oral decision.

It is of course possible that not all the appointed members are able to sign a written decision (for example through illness). However, in the Board's view, having regard to the principles discussed above, if a decision of a particular Division is to be legally valid, it must have been written on behalf of and represent the views of the members who were appointed to that Division to decide the issue(s) the subject of the decision, and it must bear signatures which indicate this.

In accordance with the procedure of the EPO in relation to opposition proceedings, a written decision such as the interlocutory decision which was given in the present case is issued under the cover of Form 2339, and it is this Form which is signed by the members of the Opposition Division. The original signed Form remains in the file of the opposition, open to public inspection, and provides the authentication of the decision which is attached thereto. Copies of the written decision showing the names of the members who have signed Form 2339 are sent to the parties.

8. In the present case the oral proceedings took place in the presence of the three examiners appointed to the Opposition Division to decide the issues raised in this opposition, and the Chairman announced its Decision on such issues during such oral proceedings in the presence of the other two examiners. Form 2339, which was attached to the front of the written decision, was signed by three persons who had not been appointed to that Opposition Division at the date of the oral proceedings, and who had no power to decide and did not decide the opposition. The presence of their

signatures on the written decision indicates prima facie that the decision sets out their views, rather than the views of the examiners who were appointed to decide the opposition and who did decide it at the end of the oral hearing. In the judgement of the Board, such written decision is not legally valid, because of the wrong composition of the Opposition Division which signed it, and must be set aside as having no legal effect.

Since the written decision dated 11 September 1986 has no legal effect, it follows that Rule 68(1), second sentence, has not been complied with, because the substantive oral decision given at the oral proceedings on 8 October 1985 has not subsequently been completed by a valid written decision. Therefore, in the Board's judgement the substantive decision given on 8 October 1985 must be considered as void and having no legal effect.

Furthermore, in the circumstances of the present case, where the oral proceedings took place more than two years ago and the (invalid) written decision was given more than one year ago (almost one year after the oral decision), in the Board's view the requirements of Rule 68(1) EPC cannot now be properly complied with, and the substantive decision is therefore incurably void.

The opposition must therefore be re-examined.

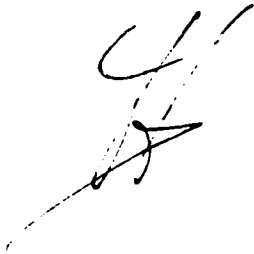
10. For the reasons set out above, the appeal of both Appellants will be formally allowed. As to the question of reimbursement of the appeal fees, in the Board's view the facts discussed above represent a substantial procedural violation, and in the circumstances it would be clearly equitable to reimburse the appeal fees of both Appellants.

**Order**

**For these reasons it is decided that**


1. The Decision of the Opposition Division given orally on 8 October 1985, and the written decision dated 11 September 1986 are set aside.
2. The appeal fees of both Appellants are to be reimbursed.
3. The case is remitted to the Opposition Division for re-examination.

The Registrar



F.Klein

The Chairman



K.Jahn