

Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N^o du recours : T 285/88 - 322

Anmeldenummer / Filing No / N^o de la demande : 80 303 922.1

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 028 529

Bezeichnung der Erfindung: Scaling tip for dental scaler
Title of invention:
Titre de l'invention :

Klassifikation / Classification / Classement : A61C 3/00

ENTSCHEIDUNG / DECISION
vom / of / du 31 October 1989

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Sertich, Antony T.

Einsprechender / Opponent / Opposant : Siemens A.G.

Stichwort / Headword / Référence :

EPÜ / EPC / CBE Rule 58(4)

Schlagwort / Keyword / Mot clé : "Auxiliary requests - Opposition procedure"

Leitsatz / Headnote / Sommaire



Case Number : T 285/88

D E C I S I O N
of the Technical Board of Appeal
of 31 October 1989

Appellant : Sertich, Antony Tomislar
(Proprietor of the patent) Allendale, New Jersey (US)

Representative : Armitage, Ian Michael
MEWBURN ELLIS & CO.
2/3 Cursitor Street
London EC4A 1BQ
(GB)

Respondent : Siemens Aktiengesellschaft
(Opponent) Berlin und München
Postfach 22 16 34
D-8000 München 22
(DE)

Representative :

Decision under appeal : Decision of the Opposition Division of the European
Patent Office dated 14 April 1988 revoking
European patent No. 28 529 pursuant to
Article 102(1) EPC.

Composition of the Board :

Chairman : G. Szabo

Members : O. Bossung

C. Andries

Summary of Facts and Submissions

- I. The Appellant is the Proprietor of European patent No. 28 529 (application No. 80 303 922.1), against which the Respondent had filed an opposition. During the opposition proceedings the patent proprietor had initially sought to have the opposition rejected and the patent maintained unamended in his main request. Alternatively, he asked for the patent to be maintained in amended versions A to D. In the oral proceedings on 30 March 1987 (see page 3 of the minutes) the Opposition Division informed the patent proprietor that only a request in respect of version B was likely to succeed; if the main request were maintained the patent would have to be revoked. The patent proprietor thereupon confined himself to the request that the patent be maintained on the basis of version B.

- II. On 5 June 1987 the minutes of the hearing on 30 March 1987 were sent to the Proprietor of the patent who was informed under Rule 58(4) EPC that the Opposition Division intended to maintain the patent in the version requested. In a letter dated 9 July 1987 he replied that he could no longer agree to this version and requested a different one.

- III. On 12 November 1987 the Opposition Division sent a communication informing the patent proprietor that at this stage, i.e. after oral proceedings, amending the request required the approval of the Opposition Division (Article 123(1) and Rules 57(1) and 58(2) EPC). As there was no legitimate reason why that approval should be forthcoming, the request had to be refused. Unless the patent proprietor reverted to the request made during oral proceedings the patent would have to be revoked. The patent proprietor, however, insisted in his reply that he no

longer agreed to the version requested in oral proceedings. He was now obliged to safeguard his rights by filing an appeal in accordance with Legal Advice No. 15/84 (OJ EPO 1984, 491, point 4.3).

- IV. In a decision dated 14 April 1988 the Opposition Division revoked the European patent on the grounds that its approval was required for any amendment to the request filed during oral proceedings, as suggested in the Communication. There were no grounds for amending the request at this stage. Since the most recent amendment had not been approved in accordance with Article 123(1) EPC that version was at variance with the Convention. The patent therefore had to be revoked.
- V. The Proprietor of the patent filed a Notice of Appeal against this decision on 20 June 1988 with the simultaneous payment of the fee, and submitted his Ground of Appeal on 22 August 1988. The Appellant requested that the decision of the Opposition Division be set aside and the opposition rejected, i.e. the patent maintained as granted, in accordance with the main request. He subsequently filed six auxiliary requests relating to more restricted versions. Citing solely substantive grounds for patentability and not the procedural grounds on which the first instance revoked the patent, the Respondent (Opponent) requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.
2. There is no need for the Board of Appeal to comment in the present case on the general question of when would a request by the proprietor of the patent for amendments to

the text of a patent require the approval of the Opposition Division, on the circumstances justifying refusal of such a request, or on the action to be taken following refusal. This is because the first instance had been unable to take into consideration the relatively recent decision T 234/86 (Therapy with interference currents/SOMARTEC) dated 23 November 1987 (OJ EPO 1989, 79). According to that decision, the Opposition Division may not ignore an auxiliary request by the patent proprietor simply because the latter pursues a main request which the Opposition Division rejects. This judgment altered the whole procedural position.

3. In oral proceedings on 30 March 1987 the Opposition Division (cf. I above) had notified the applicants' representative that it was not possible to deliver a decision rejecting the "main request and allowing the auxiliary one". This information was consistent with EPO Legal Advice No. 15/84, mentioned above, according to which the patent proprietor cannot have a decision on both the main and the auxiliary request but has to settle for one or the other from the outset. However, this manner of resolving such a situation was superseded by the above decision T 234/86. Furthermore, the contested decision was delivered before any principles had been evolved on how decisions concerning various requests should be handled in respect of Rule 58(4) EPC. However, the procedure under that rule has meanwhile been rendered superfluous according to decision G 1/88 (Opponent's silence/HOECHST) dated 27 January 1989 (OJ EPO 1989, 189), at any rate where oral proceedings have taken place. In the new procedural situation created by these two decisions the Opposition Division should not have revoked the patent on purely formal and procedural grounds but would have been able to take a substantive decision based on the patentability of the subject-matter in the main or in the auxiliary request. Under these circumstances

it would not have come to a decision solely on the basis of the new version, which had only been requested in the letter dated 9 July 1987. Furthermore, the patent proprietor would have been able to appeal against the refusal of his main request (text in which the patent was granted) and then also request instead the grant of the amended version of 9 July 1987 in the appeal proceedings (see also T 123/85, "Incrustation inhibitors/BASF", OJ EPO 1989, 336).

4. It is the view of the Board that as long as a patent has not been finally revoked, the department before which the proceedings are pending may allow a justified request that the text be amended and the proceedings resumed.

Under these special circumstances it should not be necessary to go into the question of whether the Opposition Division acted correctly in view of earlier practice. The original decision has to be set aside and the matter be remitted to the first instance, thereby reverting to the stage reached at the beginning of the oral proceedings on 30 March 1987. Thus, the first instance will now also be able to arrive at a decision in the light of the main or auxiliary requests.

5. Oral proceedings have not been necessary since the Board of Appeal has not delivered a decision on any of the Appellant's requests.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.

- 2. The matter is remitted to the first instance for further consideration.

The Registrar:

The Chairman:

S. Fabiani

S. Fabiani

G. Szabo
G. Szabo

8/10/88
[Signature]
B. 20.10.