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Aktenzeichen / Case Number / N<sup>o</sup> du recours : T 716/89 - 3.3.2

Anmeldenummer / Filing No / N<sup>o</sup> de la demande : 85 303 946.9

Veröffentlichungs-Nr. / Publication No / N<sup>o</sup> de la publication : 0 165 001

Bezeichnung der Erfindung: Method for identifying streptococcal grouping  
Title of invention:  
Titre de l'invention :

Klassifikation / Classification / Classement : C 12Q 1/14

### ENTSCHEIDUNG / DECISION

vom / of / du 22 February 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

UNILEVER PLC and UNILEVER NV

Einsprechender / Opponent / Opposant :

UNILEVER PLC

Stichwort / Headword / Référence : Right to be heard/UNILEVER

EPÜ / EPC / CBE Articles 113(1), 101(2); Rules 57(1) and (3) and 58

Schlagwort / Keyword / Mot clé : "Right to be heard in opposition proceedings" -  
"Opponent being the proprietor" -  
"Communication of opposition to proprietor" -

### Leitsatz / Headnote / Sommaire

The principle that parties have a right to be heard in accordance with due process of law requires that under Rule 57(1) EPC an opposition must be communicated to the patent proprietor before a decision is taken to revoke the patent, even where the proprietor is himself the opponent.



Case Number : T 716/89 - 3.3.2

DECISION  
of the Technical Board of Appeal 3.3.2  
of 22 February 1990

Appellant :  
(Proprietor of the  
patent 01)

Unilever PLC  
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Blackfriars  
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Appellant :  
(Proprietor of the  
patent 02)

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Representative :

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Respondent :  
(Opponent)

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Representative :

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Decision under appeal :

Decision of the Opposition Division of the European  
Patent Office dated 7 September 1989 revoking  
European patent No. 0 165 001 pursuant to  
Article 102(1) EPC.

Composition of the Board :

Chairman : P. Lançon

Members : A. Nuss

R. Schulte

## Summary of Facts and Submissions

- I. By a decision of 25 January 1988 European patent No. 165 001 was granted for designated Contracting States DE, FR, GB, IT and SE on the basis of Euro-PCT patent application No. 85 303 946.9 filed on 4 June 1985.
- II. In a communication dated 13 April 1988 notice was given in accordance with Rule 20 EPC that the European patent had as requested been transferred with effect from 25 January 1988 from the previous proprietors to UNILEVER PLC, London in respect of designated Contracting State GB and to UNILEVER NV, Rotterdam in respect of designated Contracting States DE, FR, IT and SE, and that the transfer had been recorded in the Register of European Patents and published in the European Patent Bulletin.
- III. In a letter filed on 23 November 1988 UNILEVER PLC, London filed opposition to the European patent, calling for its revocation insofar as it designated the Contracting States DE, FR, GB and IT. The opposition fee was paid at the same time. In their statement of grounds the opponents cited European patent application No. 151 783 published on 21 August 1985 with US priority from 27 January 1984 and designating the Contracting States, BE, DE, FR, GB and IT.
- IV. By a decision of 7 September 1989 the Opposition Division revoked European patent No. 165 001 for designated Contracting States DE, FR, GB and IT, and maintained it unamended for designated Contracting State SE.
- V. The opponents (UNILEVER PLC) and the co-proprietors (UNILEVER NV) lodged an appeal on 3.11.1989 by telecopy against the decision to revoke the patent. In the grounds for their appeal they stated that shortly after the patent

had been granted they had become aware of some relevant prior art, and wished to delimit their patent vis-à-vis that prior art in order to obtain a sound patent of narrower scope. Amendments which had been considered had not in fact been submitted with the statement of grounds for the opposition since it was possible that third parties might also file oppositions on the basis of other prior art, necessitating further amendments. The Opposition Division had been expected to follow the normal procedure and invite the parties to file observations (Article 101(2), Rules 57(1) and (3) and 58 EPC). Instead it had taken the decision to revoke without first contacting the parties. The contested decision ought therefore to be set aside and the appeal fee reimbursed. The case should also be remitted to the Opposition Division with the amended claims filed on 5 January 1990 together with the statement of grounds.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.
2. Under Article 113(1) EPC, decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. Rule 57(1) EPC applies this principle specifically to opposition proceedings: the Opposition Division shall communicate the opposition to the proprietor of the patent and shall invite him to file his observations and to file amendments, where appropriate, to the description, claims and drawings within a fixed period. The Opposition Division failed to meet this obligation. The contested decision to revoke the patent was in breach of the right of parties to be heard in accordance with due process of law.

3. According to a decision of the Enlarged Board of Appeal dated 24 July 1985 (Gr 01/84, OJ EPO 1985, 299) the patent proprietor himself is entitled to file opposition to his own patent. Rule 57(1) EPC lays down in general terms that the Opposition Division shall communicate the opposition to the proprietor of the patent and invite him to file his observations. It does not provide for any exception to this obligation where the proprietor himself is the opponent. The Board therefore considers that even in these circumstances the proprietor must be informed of his own opposition before any decision is taken. This is a fundamental requirement of the principle that parties have the right to be heard in accordance with due process of law and that no person may be deprived of a right without first having the opportunity to comment in his capacity as holder of that right - in this case as proprietor of the patent.
4. As the contested decision shows, the Opposition Division had erroneously assumed opponent and proprietor to be one and the same. If, nevertheless, it had invited the proprietors to comment before taking its decision, the error - obviously due to the close similarity of the two proprietors' names - would have been corrected. This shows how important it is to grant all parties the right to be heard before delivering an unfavourable decision.
5. In the present case there can be no doubt that the Opposition Division was obliged under Rule 57(1) EPC, before delivering its decision to revoke the patent, to communicate the opposition to the proprietors - the opponent, contrary to its false assumption, not being the sole proprietor. Thus even if the Opposition Division thought it unnecessary to communicate the opposition under Rule 57(1) EPC to the proprietor filing the notice of opposition (UNILEVER PLC), it ought nevertheless to have communicated it at least to the second proprietor (UNILEVER NV) - who had not lodged an

opposition - and invited them to file their observations. Furthermore, the opponent stated in its notice of opposition that the patent "in the absence of an amendment to overcome this prior art" should be revoked. This shows that the opponent expected a communication from the Office before a final decision. Since it failed to do so, its decision is in breach of Rule 57(1) EPC and the contested decision must thus be set aside and the case remitted to the Opposition Division.

6. The appeal fee is to be reimbursed in accordance with Rule 67 EPC since a breach of the right to be heard in accordance with due process of law constitutes a substantial procedural violation.

#### Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for continuation of the opposition proceedings on the basis of the amended claims filed on 5 January 1990.
3. Reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Beer

P. Lançon