

Publication in the Official Journal Yes / No

File Number: T 196/91 - 3.2.1

Application No.: 81 305 689.2

Publication No.: 0 081 012

Title of invention: Method and apparatus for preventing stratification of
liquefied gases in a storage tank

Classification: F17C 6/00, F17C 13/92

D E C I S I O N
of 5 December 1991

Proprietor of the patent: NIPPON KOKAN KABUSHIKI KAISHA

Opponent: Linde Aktiengesellschaft, Wiesbaden

Headword:

EPC Article 113(2), Rule 60(1)

Keyword: Surrender or lapse of patent for all designated States (not
established), request for revocation (granted).

Headnote



Case Number : T 196/91 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 5 December 1991

Appellant :
(Opponent)

Linde Aktiengesellschaft, Wiesbaden
Zentrale Patentabteilung
W - 8023 Höllriegelskreuth (DE)

Respondent :
(Proprietor of the patent)

NIPPON KOKAN KABUSHIKI KAISHA
1-2 Marunouchi 1-chome
Chiyoda-ku
Tokyo 100 (JP)

Representative :

Wood, Anthony Charles
Urquhart-Dykes & Lord
91 Wimpole Street
London W1M 8AH (GB)

Decision under appeal :

Decision of Opposition Division of the European
Patent Office dated 20 December 1990.

Composition of the Board :

Chairman : F.A. Gumbel
Members : M. Schar
S. Crane

Summary of Facts and Submissions

- I. On 3 November 1988 the Appellant filed a notice of opposition to the European patent No. 0 081 012 granted to the Respondent.
- II. Following the summons to oral proceedings by the Opposition Division, the Respondent and Proprietor of the patent through his duly appointed professional representative filed a Statement dated 22 August 1990 reading essentially as follows:

"We are replying to the summons of 14 August 1990 to oral proceedings on 25 October 1990.

We are informed by the patent Proprietor that he is unable to justify further expense in defending the patent against the opposition.

Accordingly we are not able to attend the oral proceedings on his behalf or present to you any proposals for improvement of the text of the specification.

On behalf of the patent Proprietor, we hereby surrender the patent."

- III. By Form 2344.2 the Formalities Officer of the Opposition Division informed the Respondent on 14 September 1990, that the surrender and lapse of a European patent are matters for which the Contracting States are competent, that however a European patent may be revoked in pending opposition proceedings and that the Proprietor has the opportunity to request that the patent be revoked or to state that he no longer approves the text in which the patent was granted.

IV. On 25 September 1990 the Chairman of the Opposition Division consulted the representative of the Opponent (Appellant) by telephone. He confirmed the result of the consultation by sending the following minutes of the conversation on EPO Form 2036 to the representative:

"Although the Proprietor has surrendered the patent, the oral proceedings for 25/10/90 have not yet been cancelled. The Opponent's representative should phone again in two weeks' time in case the patent can be revoked by the Opposition Division prior to oral proceedings."

V. By telecopy dated 23 October 1990 the parties were informed by the Formalities Officer of the Opposition Division that the oral proceedings were cancelled and that the proceedings would be continued in writing.

VI. By a decision on termination of the opposition proceedings dated 20 December 1990 on Form 2352 signed by the Formalities Officer of the Opposition Division it was stated by a cross in the appropriate box in the mentioned form:

"The Proprietor of the patent has surrendered the European patent for all the designated states or the European patent has lapsed for all those States."

Furthermore it was stated inter alia:

"The Opponent has filed no request for the proceedings to be continued (Rule 60(1) EPC).

This decision is open to appeal (Article 106(1) EPC)."

VII. On 20 February 1991 the Opponent filed an appeal against the said decision and requested:

1. To set aside the contested decision and to revoke the patent in question;
2. To rectify the contested decision by way of an interlocutory revision;
3. To reimburse the appeal fee.

He based these requests on the following reasons filed together with the Notice of Appeal: By his Statement of 22 August 1990 the Respondent had not surrendered his patent in the sense of Rule 60(1) EPC. According to the "Patentrolle" of the German Patent Office and INPADOC the patent in question had not lapsed for any of the designated States. If the information received by him from these authorities were incorrect, then the first instance had violated Rule 60(1) by not inviting him to file a request for continuation of the proceedings. Since the appeal was admissible and well founded and the Appellant was not opposed by another party in the sense of the second sentence of Article 109(1), although the Opponent was a party to the proceedings, the first instance should rectify its decision according to Article 109(1). In the light of the jurisprudence of the Board of Appeal, namely in the case T 237/86, the declaration of the patent Proprietor to surrender the patent should be construed as a request for revocation.

VIII. By reply dated 8 May 1991 the Respondent stated that he did not understand the basis of the appeal due to the fact that neither the EPO nor the Appellant seemed to have taken account of his letter of 25 September 1990, of which he enclosed a copy and, in which he had requested that the patent be revoked.

IX. By letter dated 27 May 1991 the Appellant replied that he had neither received a copy of the communication of the Opposition Division of 14 September 1990 (see point III above) nor a copy of the submission of the Respondent of 25 September 1990.

Again the Appellant mentioned his opinion that the Respondent's declaration had to be construed as request for revocation of the patent.

Reasons for the Decision

1. The appeal is admissible.
2. The contested decision held that the opposition proceedings were to terminate due to surrender or lapse of the European patent No. 0 081 012 for all the designated States. It followed the declaration by the Patentee's representative: "On behalf of the patent Proprietor, we hereby surrender the patent." No explicit request for revocation by the Patentee was present on the file by that time.

According to Article 2(2) EPC the grant of a European patent results in national patent rights of the designated States. Their surrender is a matter of national patent law. Surrendering the patent by declaration to the EPO is consequently not provided for in the EPC and not possible (G 1/90, OJ EPO 1991, 275, Point 8; T 296/87, OJ EPO 1990, 195). It follows that a declaration to surrender a European patent before an Opposition Division of the EPO cannot be taken as a reason to terminate the pending proceedings. In the present case the Opposition Division

gave the declaration made by the Respondent a meaning that it could not have.

Furthermore and contrary to the statement in the contested decision it was not established that the patent in question had been surrendered for all the designated states (Rule 60(1) EPC). According to the European Patent Register it was still valid in several designated States at the date of the decision.

Clearly, therefore, the Formalities Officer of the Opposition Division should not have taken the contested decision. This constitutes a substantial procedural error. The contested decision must be set aside.

3. With his letter of 8 May 1991 the Respondent has confirmed his request for revocation of his own patent. This request can be granted (T 677/90 of 17 May 1991).
4. Following the conclusion reached under points 2 and 3 above the request referring to the question whether in the particular circumstances of the present case the department whose decision is contested had had the power to issue an interlocutory revision under Article 109 EPC need not be dealt with.
5. The Appellant further requests reimbursement of the appeal fee. Under Rule 67 EPC he is entitled to such reimbursement if the appeal is allowable and if it is equitable by reason of a substantial procedural violation. These conditions are fulfilled here so that reimbursement has to be granted.

Order

For these reasons, it is decided that:

1. The contested decision is set aside and European patent No. 0 081 012 is revoked.

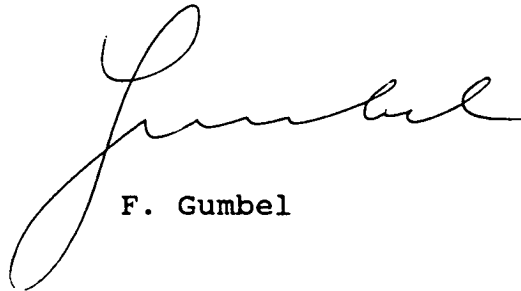
2. The appeal fee is reimbursed.

The Registrar:

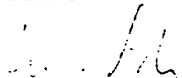


S. Fabiani

The Chairman:



F. Gumbel



Proc.