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File Number: T 439/91 - 3.2.2
Application No.: 85 905 493.4
Publication No.: 0 233 875
Title of invention: Clutch Alignment Tool

Classification: B25B 27/00

DECISION
of 21 July 1991

Proprietor of the patent: HAUBUS, Waldemar
Opponent: Klann Spezial-Werkzeugbau GmbH

Headword: Inviting observations/HAUBUS

EPC Articles 101(2), 113(1), Rule 67

Keyword: "Misleading EPO communication" - "no invitation to file observations" - "decision based on evidence without inviting observations" - "substantial procedural violation" - "refund of appeal fee"



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Boards of Appeal

Chambres de recours

Case Number : T 439/91 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 21 July 1992

Appellant :
(Proprietor of the patent)

HAUBUS, Waldemar
24 Federal Parade
Bookvale, NSW 2100 (AU)

Representative :

Powell, Stephen David
WILLIAMS, POWELL & ASSOCIATES
34 Tavistock Street
London WC2E 7PB (GB)

Respondent :
(Opponent)

Klann Spezial-Werkzeugbau GmbH
Allensteinstr. 1
W - 7710 Donaueschingen (DE)

Representative :

Neymeyer, Franz, Dipl.-Ing. (FH)
Haselweg 20
W - 7730 Villingen 24 (DE)

Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 18 April 1991
revoking European patent No. 0 233 875 pursuant
to Article 102(1) EPC.

Composition of the Board :

Chairman : G. Szabo
Members : F. Benussi
J. Kollar

Summary of Facts and Submissions

I. The Appellant is Proprietor of European patent No. 0 233 875.

II. Claim 1 reads as follows:

"A tool (8) for use in centering a clutch plate (5) and clutch pressure plate (2), comprising an elongate tube (10); an axially slidable bolt (19) extending therethrough and having a draw nut (21) at one end and a head (20) at its other end; the bore (15) of said tube (10) being stepped (28) along its length; an insert (22) being provided and having a resiliently deformable enlargement (26) at one end thereof; the other end of said insert (22) being located against the step of (28) of the bore (15); the head (20) of said bolt (19) being adapted to be drawn into the interior of said enlargement (26) on tightening of said draw nut (21), such as to temporarily radially expand said enlargement (26); and including adjustable clamping means (13) which is axially displaceable along the outside of tube (10).

Dependent Claims 2 to 5 contain features which define further embodiments of the invention.

III. An opposition was filed on the grounds of lack of novelty in consequence of prior use and inadequate support by the alleged Australian priority document dated 30 October 1984.

In the Statement of Grounds for opposition the Respondent (Opponent) submitted that conforming to Article 88(3) EPC, the right of priority could only cover those elements of the European patent application which were included in the application whose priority is claimed.

IV. According to the Respondent, not all of the elements of the claims of the European patent application were included in the Australian application; therefore a right of priority in respect of the elements of the European patent application could not be claimed in respect of the Australian patent application of 30 October 1984 but only in respect of the international patent application filed on 30 October 1985. This was even admitted by the Appellant (Patentee).

Furthermore, the Respondent submitted that the tool according to the patent in suit had been advertised, manufactured, presented to exhibitions and sold prior to the date of filing of the international patent application (30 October 1985) by both the Appellant and by the Respondent himself as Licensee; consequently, the invention claimed in the European patent No. 0 233 875 lacked novelty at the international filing date.

V. During the opposition proceedings, the Appellant contested the submissions of the Respondent and asserted that even if any sale or disclosure was made without the authority or licence of the Patentee, the sale or disclosure was an evident abuse of his rights and thus by virtue of Article 55(1)(a) EPC is to be disregarded. In support of these assertions the Appellant presented an affidavit.

VI. By a letter dated on 4 December 1990 the Respondent contested the statements of the Patentee and those in the submitted affidavit, and presented at the same time a copy of a letter forwarded by the patent attorneys H.R. Hodgkinson & Co to the Patentee dated 31 March 1988 (Doc. E 9) and a copy of a letter from the Respondent to the patent attorneys H.R. Hodgkinsons & Co dated 26 April 1988 (Doc. E 10), from which it could be seen that there

was an agreement for manufacture and sale between the Respondent and the Appellant.

- VII. By a communication on Form 2937.2 on 14 December 1990, the observations of the Respondents in reply to the letter of the Appellant were sent by the EPO to the Patentee without indication of a time limit for filing further observations. In fact, the alternative boxes in the form "Take note" or "File observations with the period" were left uncrossed.
- VIII. On 18 April 1991 the Opposition Division revoked the patent on the grounds that a tool according to Claim 1 of the patent was available to the public in the International Automobil Show (IAA) in Frankfurt a/M before the filing date of the European patent application.
- IX. An appeal against this decision was lodged by the Appellant (Patentee) on 21 June 1991. The appeal fee and the Statement of Grounds were filed in due course. Oral proceedings took place on 21 July 1992.
- X. In support of his appeal, the Appellant argued in his submission and during the oral proceedings substantially as follows:
- (a) in violation of Article 113(1) EPC, in the present case, the Appellant had not been asked for a response to the Opponent's submission contained in the letter dated 4 December 1990;
 - (b) in violation of Article 101(2) EPC, the Opposition Division, before taking a decision, had not invited the Appellant to file observations relating to the Opponent's submissions.

XI. The Respondent made the following observations:

- (a) it is part of the discretionary powers of the Opposition Division to decide if it is necessary to invite a party to file observations on submissions presented from another party;
- (b) the documents cited in and enclosed with the letter dated 4 December 1990 referred to correspondence kept up between the parties. Therefore the Appellant could not assert that these documents were new to him.

XII. The Appellant requests that the decision of the Opposition Division be set aside and that the patent be maintained.

The Respondent requests that the appeal be dismissed.

Reasons for the Decision

1. The appeal complies with the requirements of Articles 106 to 108 and Rules 1(1) and 64 EPC. It is therefore admissible.
2. As set out in paragraph IX above, the Appellant argued that the Opposition Division had committed a substantial procedural violation, in that the observations of the Respondent dated 4 December 1990, based upon new documents introduced in the procedure, were sent to the Appellant without any invitation to file observations in reply prior to the issue of the decision adverse to the Appellant and said decision was founded upon documents whose content the Appellant did not have the opportunity to contest.

3. Regarding the above requests of the Appellant, the Board considers it appropriate to enquire whether a procedural irregularity has occurred on the part of the Opposition Division which would justify remitting the case to the latter instance and reimbursement of the appeal fee.
4. The examination of an opposition is governed by Article 101(2) EPC, which requires that "the Opposition Division shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself".

In the present case, no invitation to file observations in reply to the Respondent's observations dated 4 December 1990 was issued by the Opposition Division prior to the issue of its decision.

The Appellant has contended that it was in fact "necessary" in the circumstances of the case for the Opposition Division to invite observations from him, before issuing a decision revoking the patent on the basis of such observations and the new documents referred to therein.

5. In these circumstances, the preliminary concern is to consider the relationship between Article 101(2) EPC and Article 113(1) EPC.

The provision in Article 113(1) that "decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments" was recognised in Decision J 20/85 (OJ 1987, 102) as being "of fundamental importance for ensuring a fair procedure between the EPO and parties conducting proceedings before it". Nevertheless, the fact that in a

particular case Article 113(1) EPC has been complied with does not necessarily mean that the procedure in that case has been "fair".

The right to fair procedure and a fair hearing is one of the principles of procedural law generally recognised in the Contracting States, and has to be taken into account by the EPO under Article 125 EPC.

In the opinion of the Board, even if Article 113(1) EPC has been literally complied within a particular case, it is "necessary" for the EPO to invite a party pursuant to Article 101(2) EPC to file observations on a communication from another party or issued by itself, if the failure so to invite that party would result in unfair procedure or a violation of the principle of good faith. In this connection, it is of fundamental importance that a party to proceedings should not be taken by surprise by the grounds or evidence on which an adverse decision is based (see Decision T 669/90, OJ EPO 1992, 739, for example).

6. In the present case, as far as document E-9 filed by the Respondent with a letter dated 4 December 1990 is concerned, the Board is of the opinion that the communication issued on 14 December 1990 disclosing copies of this document and of the enclosed letter under cover of EPO Form 2937.1 with the boxes "Take note", and "File observations within a period" left uncrossed, could have misled the Appellant into believing that there was no need to defend his interests by filing observations in reply to this communication.

If the EPO intends to consider any evidence in view of its relevance in a decision, then in the absence of observations upon such document by the Patentee, the EPO should invite him, pursuant to Article 101(2) EPC, to

present his comments by filing observations, before the case can be decided on the basis of such evidence (Article 113(1) EPC).

In the Board's view the procedure followed by the Opposition Division in the present case was not a fair procedure, and the general principle of good faith governing the relationship between the EPO and parties to proceedings before it was violated in the particular circumstances of this case, having regard to the failure by the Opposition Division to invite the Appellant to file observations before the decision dated 18 April 1991 was issued.

7. For the reasons set out above, the Board deems the appeal to be allowable and orders reimbursement of the appeal fees under Rule 67 EPC in view of the substantial procedural violation which occurred.

Order

For these reasons, it is decided that:

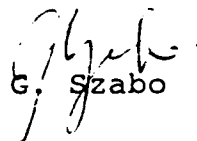
1. The decision of the Opposition Division is set aside.
2. The case is remitted to the first instance for further consideration.
3. The appeal fee is to be refunded.

The Registrar:



S. Fabiani

The Chairman:



G. Szabo

