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File Number: T 506/91 - 3.3.2

Application No.: 84 201 228.8

Publication No.: 0 139 318

Title of invention: An ampoule containing a wood preservative composition fixed to a closure cup for closing a recess in wood for receiving said ampoule and a suitable closure cap of this type.

Classification: B27K 3/00

Interlocutory D E C I S I O N
of 3 April 1992

Proprietor of the patent: Woodcap B.V.

Opponent: 01) Woudsma, Jacob
02) Sikkens B.V.

Headword: Appeal of proprietor/WOODCAP

EPC

Keyword: "Decision corresponding to request - proprietor not adversely affected". "No procedural violation". "Appeal inadmissible".
T 123/85 followed, T 155/88 differentiated.

Headnote



Case Number : T 506/91 - 3.3.2

Interlocutory D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 3 April 1992

Appellant :
(Opponent)

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Respondent :
(Proprietor of the patent)

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Decision under appeal :

Interlocutory decision of the Opposition Division
of the European Patent Office dated 26.04.91
concerning maintenance of European patent
No. 0 139 318 in amended form.

Composition of the Board :

Chairman : P.A.M. Lançon
Members : E.M.C. Holtz
I.A. Holliday

Summary of Facts and Submissions

- I. By the Interlocutory decision under appeal, the Opposition Division maintained European patent No. 139 318 (application No. 84 201 228.8) in amended form on the basis of 9 claims (combining Claims 1 and 2 of the patent as granted) submitted in the oral procedure by the Patentee as his single request, replacing all previous requests.
- II. The Patentee, as well as both Opponents, appealed the Opposition Division decision. From the appeal lodged by the Patentee the issue arises whether he is to be considered adversely affected, as required by Article 107 EPC, for his appeal to be admissible.
- III. In a communication, the Board of Appeal provisionally held the appeal by the Patentee not to be admissible under Article 107 EPC, holding that under the circumstances as they were before the Opposition Division, a request to reinstate the patent would constitute an abuse of proceedings. Reference was made to decision T 123/85, OJ EPO 1989, 336, in this context.
- IV. The Patentee has submitted mainly the following arguments with regard to the admissibility question.

The agreement to the more narrow scope of the patent was made under the pressing circumstances of a hearing and in the expectation that a separate appeal would be allowed as appears from the EPO Notice of 14 July 1989 (OJ EPO 1989, 393). Point 2.2 of this Notice indicates that an appeal is admissible even if the opponent has declared his approval of the text. This Notice is ignored by the Board of Appeal when declaring that the Patentee is not entitled to appeal

because of an approval of the text given during oral proceedings. Objectively the Patentee is also adversely affected because the decision under appeal restricted the patent. The agreement to such a restriction does not take away the fact that the Patentee is adversely affected thereby.

Further, the Patentee had asked - prior to the end of the term for appeal against the decision - the Opposition Division to consider some alternative claims in addition to the main claim as agreed to, referring to T 123/85. No answer was received from the Opposition Division. The Patentee therefore had no option but to appeal.

T 123/85 refers to possible abuse of opposition proceedings, whereas the request to reinstate partly the patent as granted on appeal is not touched by this decision. According to this decision, the Board of Appeal is the only authority which is capable to limit the patent retrospectively; a limitation by the Patentee by surrendering part of it is not possible (paragraph 3.1.1 of the decision).

The provisional opinion of the Board of Appeal therefore is contrary to both the 1989 Notice and T 123/85. The admissibility of the Patentee's appeal raises an important point of law which justifies a referral of a question to the Enlarged Board.

- V. The Opponents have both indicated that their understanding of what happened during the oral proceedings was that the Patentee, upon being advised that the main claim was not patentable, agreed to a more limited scope, and that the representative of the Patentee, in the presence of his client's managing director, signed the amendment.

The Patentee has not contradicted the above, but the representative has added that it was his understanding that the Opposition Division would include its conclusions on the non-patentability of the patent as granted in its decision. As this turned out not to be the case, the Patentee filed the request to have further claims considered.

VI. The Patentee requests a reasoned decision on the admissibility issue, as well as the referral of a question to the Enlarged Board.

The Opponents request rejection of the Patentee appeal.

Reasons for the Decision

1. The appeal by the Patentee meets the requirements of Articles 106, 108 and Rule 64(b) EPC. The only admissibility issue remaining to be decided with regard to this appeal is the requirement of being adversely affected in accordance with Article 107 EPC.
2. Pertinent issues
 - 2.1 The nature of appeals

The appeal review is not a re-examination of the patent application (see i.a. G 1/84, OJ EPO 1985, 299, T 26/88, OJ EPO 1991, 30 and T 611/90 of 21 February 1991, not published in OJ EPO). As observed in T 34/90 of 15 October 1991, to be published, the appeal procedure is separate from the first instance proceedings, and its function is to decide the correctness of a separate earlier decision of the first instance. The appellate instance is concerned

with reviewing the case on the basis of the content of the statement of grounds, which essentially means considering the first instance decision on its merits, although it is not limited to the facts or arguments as presented before that instance (T 153/85, OJ EPO 1988, 1). The contention by the Patentee of the present case that the reference in T 123/85 to possible abuse of opposition proceedings has no relevance for the appeal is therefore based on a misconception.

2.2 The 1989 Notice on Rule 58(4) EPC

The Notice from the European Patent Office dated 14 July 1989 concerning the application of Rule 58(4) EPC in opposition proceedings resulted from a decision by the Enlarged Board of Appeal which necessitated a change of procedure before the EPO (G 1/88, OJ EPO 1989, 189). The Enlarged Board took the view, having regard to i.a. the proper more narrow scope of Rule 58(4) as not requiring the opponent to state his objections against the maintenance of the patent, but rather any disagreement with the text presented (i.e. any formal objections, e.g. under Article 123), that the silence of an opponent could not be taken to mean that he had effectively withdrawn his opposition. The narrow scope of Rule 58(4) EPC could not be allowed to interfere with the right of appeal under Articles 106 and 107 EPC (points 2-4 of the decision).

As indicated by the Enlarged Board of Appeal the legal situation of the applicant differs from that of the opponent. Thus should the proprietor object to a text, the proceedings not only may, but must be continued (Article 113 EPC).

This Board of Appeal therefore cannot follow the Patentee when claiming that a preclusion of his right to appeal

would run contrary to the 1989 Notice. There is nothing in the said Notice applicable to the legal situation of an applicant.

2.3 The significance of requests

The decisions directly concerned with the requirement of "adversely affected" all focus on the need to compare the outcome of the case with what the party in question had formally requested. From this it can be concluded that the parties mainly dispose of the proceedings by way of their requests, or in other words that these requests constitute a basis and framework for the case (except for any examination made under Article 114 EPC, see point 2.7). Said request sets the limits for the appeal review.

In J 12/85, OJ EPO 1986, 155, the applicant who had not previously disapproved a text for grant (under the version of Rule 51(4) then in effect) was considered not adversely affected and the appeal was therefore rejected as inadmissible. The opponent in T 299/89 of 31 January 1991, not published in OJ EPO, had only requested a partial revocation of the patent. The Board concluded that this opponent could only appeal to the extent of his original request, as a result of which the appeal request to revoke the patent entirely was disregarded insofar as it exceeded this original request. In T 156/90 of 9 September 1991, not published in OJ EPO, the Board likewise established that a prior approval by the opponent to a proposed amendment could not be retracted by a later disapproval, and that consequently the opponent was not adversely affected by the decision to maintain the patent with this amendment. Finally, an applicant who had approved the text for grant under the new version of Rule 51(4), in force as of 1 September 1987, according to which express approval is required, was not considered adversely affected and

his appeal consequently rejected as inadmissible under Article 107 (T 831/90 of 29 July 1991, not published in OJ EPO).

In T 234/86, OJ EPO 1989, 79, the issue of several requests in descending order and the obligation of the Opposition Division to consider them in the order chosen by the patentee was discussed. Firstly, it was established that the Opposition Division must not require the patentee to have only one request on file in order to be able to grant a patent. In this context Legal advice No. 15/84 was criticised as being misleading at best. Secondly, and more important for the present case, it was concluded that the patent proprietor is adversely affected by the rejection of a request or requests preceding an auxiliary request which is allowed (point 5.8).

The above examples of the consistent case-law of the Boards of Appeal make it clear that it is a basic task for the parties to take active part in the proceedings. Filing requests and deciding if several alternative requests are appropriate or not is a matter that in the end can only be decided by the party concerned, although the responsible body of the EPO, as a matter of voluntary service, may offer to help by suggesting amendments which it considers allowable. By now, having regard to the fact that the EPC is well into its second decade of application in practice, it should be routine for representatives to decide independently how to pursue their cases, including what requests to submit.

2.4 The proprietor

T 123/85 and T 155/88 (of 14 July 1989, not published in OJ EPO) are two examples of cases where the status of patent proprietors is analysed in more detail. As a

starting point, it is recognised by both decisions that as a rule a patent proprietor does not surrender or abandon any subject-matter of his patent by limiting it. However, the Board of Appeal in T 123/85 went on to say that any amendment to reinstate the patent as granted must not constitute abuse of proceedings (point 3.1.2).

As in T 123/85 the addition of a feature at the opposition stage had been prompted by a suggestion from the Opposition Division, which then rejected it as contravening Article 123(3) EPC, the request at the appellate stage to reinstate subject-matter (by deleting the same feature) was considered not to constitute any such abuse (points 3.1.2 and 3.1.3).

T 123/85 therefore does not allow reinstatement of broader subject-matter unconditionally, as the Patentee seems to contend. Nor does T 123/85 detract from the finding of T 234/86, that a proprietor is adversely affected by a rejection of requests preceding the one allowed.

T 155/88 turned on whether the voluntary withdrawal by the patentee of his main request and all auxiliary requests but one prevented him from reinstating the subject-matter of the withdrawn requests into the proceedings. The respondent submitted that the patentee had abandoned such subject-matter. The Board, however, while referring to T 123/85, took the view that a limitation should only be interpreted as an irrevocable abandonment of the broader subject-matter, if the circumstances make it absolutely clear that such was the real and unambiguous intention of the patentee. As a reason for this conclusion the Board referred specifically to the interest of an efficient opposition procedure that patentees feel free to propose limiting amendments in order to meet objections raised without putting at risk their freedom to reinstate their

earlier broader claims in order that a decision should be issued on the allowability of such broader claims.

While it is to be noted that the question of admissibility did not arise in T 155/88 because the Opposition Division had revoked the patent entirely (as a result of which the proprietor was adversely affected anyway), T 123/85, T 155/88 and the one now before this Board of Appeal all share the common procedural situation that the proprietor requests, after having limited his patent before the Opposition Division without keeping any broader subject-matter "on hand" by way of one or several preceding requests in descending order, as an appellant to reinstate such broader subject-matter.

What happened before the Opposition Division as outlined in both T 155/88 and the present case probably reflects quite closely what might be rather frequent situations in oral proceedings, when the opposition has been discussed and a consensus is about to emerge on where the limits of patentability might be drawn. This Board cannot, however, agree with the statement of T 155/88 that the proprietor must have freedom to be able to reinstate his patent as granted, at least not if this statement is to be interpreted to mean that the proprietor should be free to do so even if he explicitly and unconditionally has withdrawn all requests but the one finally allowed.

The present Board is however confident that such a broad interpretation was not intended by T 155/88. It must be kept in mind that the procedural situation of that case was different from the present one, in that the Opposition Division had even rejected the remaining limited request, as a result of which the proprietor was entitled to appeal independently for being adversely affected, whereas in the present case the decision of the Opposition Division fully

corresponded to the request submitted. Under these conditions, the present Board finds the conclusions in T 155/88 that the proprietor in that case would be entitled to reinstate his original claims justified.

The main reason for the difference in outcome is the fact that in the present case the request as finally decided by the Patentee was allowed by the Opposition Division. This decisive effect of requests submitted cannot be offset by the general obligation of the Board of Appeal to consider any issues of its own motion. This obligation will only be taken into account when it has been established that there is an admissible appeal in existence, as in the present case by way of the appeals filed by the opponents, but is of no significance when considering the admissibility issue in itself. If the appeal is declared admissible, then and only then would the Board of Appeal be prepared to listen to arguments from the proprietor as to why he is entitled to a patent broader than the one he had requested before the first instance (see also point 2.7 below). On the other hand, a party to the proceedings as of right but who is not an appellant is dependent upon the appellants. Should they withdraw their appeal, that party no longer has a right to pursue his case (cf. the Enlarged Board of Appeal, G 2/91, Headnote I, OJ EPO 1992, 1-2).

2.5 Article 113 EPC

With respect to Article 113 EPC, whether or not the party concerned happens to be the proprietor or the opponent has different effects on the procedure to be followed, and the results of their respective positions on relevant issues of the case. As already noted in G 1/88, this follows from the fact that the contenders are in a different situation, each pursuing different objects.

As noted in points 2.3 and 2.4, the proprietor is required to submit clear requests, and in the course of the proceedings to take express position to any suggestions from the EPO. Conversely, non-existing requests cannot be considered (cf. Article 113(2) EPC). Applied to the present case this means that, if the Patentee were to contend that he was advised differently - as he seems to indicate when saying that he was under the impression that he would be entitled to further amendments to his limited patent - he must at least claim that he was being misled, in order for him to be able to obviate the result of having withdrawn his original requests.

The legal situation of the opponent is quite different in respect of Article 113. Whereas he is obliged to state his grounds for opposition, which then form the basis and framework for the opposition procedure, also at the appellate stage, the stringencies of Article 113(2) EPC do not apply to him.

2.6 Article 114 EPC

The procedure before the EPO differs from that of a civil court in that, although civil property rights are at stake, there is an element of administrative examination in the procedure. This is result of the fact that, although a proprietary right, a patent is granted on the basis of data in the patent application supplied by the proprietor himself, data which have to be scrutinized in accordance with given provisions to ensure that the patent emerging will be valid.

Article 114(1) EPC gives the key provision on this administrative element for the examination in the EPO. Although the procedure is largely governed by party requests, EPO organs are not bound by them, but free to

pursue a course of investigation of their own motion. This general obligation on the part of the EPO should however not be misunderstood to include a corresponding right for the parties to be free at all times to change their requests (points 2.3 and 2.4).

The obligation under Articles 4(3) and 52 EPC to issue patents for inventions which meet the requirements of the Convention is balanced by an obligation not to issue patents that are not valid (Article 97 EPC).

This balancing means that the Boards of Appeal are obliged to look to the interests of the general public, as well as to that of the patentee. Although at the appellate stage this general obligation does not have the same force as at the true examination or opposition stage, the Boards are frequently called upon to decide whether or not to admit late filed documents or requests, and as frequently apply Article 114(2) EPC to solve the situation.

In the view of this Board, the significance of Article 114 EPC for the position of the proprietor is that, when it has been established that an appeal is admissible, the full extent of the original patent might be argued.

As already noted above, point 2.4, the consequence of a failure to maintain any requests covering broader subject-matter than the request as finally submitted cannot be remedied through the application of Article 114 on the admissibility issue.

2.7 Good faith - Procedural violation

It is of course imperative for any officer of the EPO suggesting amendments or asking if a patentee is maintaining one or several requests to ensure that that

party is given appropriate time to consider the legal situation and that, self-evidently, no pressure at any time may be put on a party to withdraw requests, especially not by way of referring to them as not allowable in advance. This would be prejudicial to the decision to be taken. It must be borne in mind that any such withdrawal may irrevocably change the procedural situation for that party, not only with regard to the possibility to appeal, but also to effects on any later infringement or invalidity litigation at the national level.

This Board would conclude with regard to the oral proceedings before the Opposition Division in the present case that it sees no procedural violation therein as the circumstances have been described by the parties themselves, although the file is not complete as it does not contain the submitted amendment in original. The representative for the Patentee was in a position to consider the amendment directly with his client, whose managing director was present at the hearing. Although complaining that it was done under the pressure of a hearing, the Patentee has not contended that there was any procedural violation in the manner in which the amendment was brought about.

The fact that an oral hearing necessarily makes the time available for reflection short is not in itself a violation of proper procedure. As already remarked in point 2.3, it is expected from the parties to decide what procedural position to take on various proposals. It is precisely in order to avoid loss of procedural rights as a result of "pressure", for example due to an oral hearing, and indeed to take that very pressure out of such hearings, that a party always is entitled to maintain his original and/or any auxiliary requests. Should he decide -

e.g. after having received the written decision - that the proposed limitation was unjustified, the right to appeal is preserved. This is well established routine procedure before the EPO.

2.8 Conclusions

What has been said under points 2.1-2.7 above leads the Board to conclude that the Convention in the light of the case-law should be interpreted as excluding appeals where the decision is consistent with what the party in question has requested (cf. J 12/85), unless a procedural violation caused this party to withdraw already pending requests covering broader subject-matter.

The Board of Appeal must therefore conclude that the Patentee is not adversely affected for the purposes of Article 107 EPC, as the decision under appeal is fully consistent with what he requested and no procedural violation occurred.

3. Requests for corrections submitted to the Opposition Division

The Patentee claims to have been forced to appeal by the silence of the Opposition Division to his proposals for further amendments. The Board cannot follow this line of reasoning. The Opposition Division had taken a final decision on the substantive matter of patentability. This means that for all intents and purposes this matter was no longer pending before that Division (cf. W 53/91 of 19 February 1992, point 6).

4. Referral to the Enlarged Board of Appeal

The Patentee has requested that the Board refer a question to the Enlarged Board on the issue of admissibility.

However, the Board has found no inconsistency in the case-law pertinent to the issue of admissibility of the Patentee appeal under Article 107, nor are the Board's conclusions as to the inadmissibility of this appeal deviating from this case-law.

Although procedural matters may raise important points of law, the Board does not find a referral required in this particular case (Article 112(1)(a) EPC).

5. Under the circumstances as described above in points 2-4, the appeal of the Patentee is inadmissible.

Order

For these reasons, it is decided that:

The appeal of the Patentee is rejected as inadmissible.

The Registrar:

The Chairman:

M. Martorana

P. Lançon