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D E C I S I O N
of 19 July 1995

Case Number: T 0803/93 - 3.4.1

Application Number: 85304219.0

Publication Number: 0169649

IPC: G07G 1/06

Language of the proceedings: EN

Title of invention:
Apparatus and method for reducing theft from a store

Patentee:
Bogasky, John J.

Opponent:
Sensormatic Electronics Corp.

Headword:
Representation/BOGASKY

Relevant legal provisions:
EPC Art. 112, 117, 133, 134

Keyword:
"Oral proceedings before Opposition Division"
"Presentation of Opponent's entire case by person unqualified
in accordance with Article 134 EPC"
"Objection of substantial procedural violation by Proprietor"
"Referral of questions to Enlarged Board of Appeal"

Decisions cited:
J 0011/94

Headnote:

The following questions are referred to the Enlarged Board of Appeal:

I. During oral proceedings before the EPO under Article 116 EPC, and in the context of opposition or opposition appeal proceedings, having regard to the provisions of Article 133 EPC, may a person who is not qualified in accordance with Article 134 EPC to represent parties to proceedings before the EPO, but who is accompanied by a person who is both qualified and authorised to represent a party to the proceedings, make oral submissions on behalf of that party on legal issues which arise in the case?

II. During oral proceedings before the EPO under Article 116 EPC, and in the context of opposition or opposition appeal proceedings, having regard to the provisions of Articles 117 and 133 EPC, may a person who is not qualified in accordance with Article 134 EPC to represent parties to proceedings before the EPO, but who is accompanied by a person who is both qualified and authorised to represent a party to the proceedings, make oral submissions on behalf of that party on technical issues which arise in the case, otherwise than by giving evidence orally in accordance with the provisions of Article 117(3) EPC?

III. In relation to each of questions (1) and (2) above taken separately:

(a) If the answer is "yes", can such oral submissions be made on behalf of the party as a matter of right, or can they only be made with the permission of and under the discretion of the EPO?

(b) If such oral submissions can only be made under the discretion of the EPO, what criteria should be considered when exercising such discretion?

(c) Do special criteria apply to qualified patent lawyers of countries which are not Contracting States to the EPC?



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Boards of Appeal

Chambres de recours

Case Number: T 0803/93 - 3.4.1

DECISION
of the Technical Board of Appeal 3.4.1
of 19 July 1995

Appellant:
(Proprietor of the patent) Bogasky, John J.
8350 Greenboro Drive
Building 1
Apartment 412
McLean
Virginia, 22102 (US)

Representative: Skone James, Robert Edmund
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Respondent:
(Opponent) Sensormatic Electronics Corp.
500 Northwest 12th Avenue
Deerfield Beach
Florida 33442-1795 (US)

Representative: Hafner, Dieter, Dr.rer.nat., Dipl.-Phys.
Dr. Hafner & Stippl,
Patentanwälte
Ostendstrasse 132
D-90482 Nürnberg (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 2 August 1993
revoking European patent No. 0 169 649 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: G. D. Paterson
Members: R. K. Shukla
Y. van Henden

Summary of Facts and Submissions

- I. European patent No. 0 169 649 was opposed under Article 100(a) EPC on the grounds of lack of novelty and inventive step, and under Article 100(b) EPC. Its subject-matter is concerned with an apparatus and a method for reducing theft in a store.

- II. During the proceedings before the Opposition Division, oral proceedings were held on 20 July 1993. The minutes of the oral proceedings state that Mr Skone James, accompanied by Ms Payne, were present for the Proprietor (Mr Skone James being an authorised professional representative), and that Mr Hafner, accompanied by Mr Blecker and Mr Engdahl, were present for the Opponent (Mr Hafner being an authorised professional representative).

The minutes also state that after the oral proceedings were opened, Mr Hafner "requested revocation of the patent both as granted and also as amended by the Patentee's auxiliary request", and "asked that Mr Herbert Blecker from New York US, who is an expert in shop security, presents the technical aspects of the case". Mr Blecker's business card is attached to the minutes, and indicates that Mr Blecker is a member of a firm Robin, Blecker, Daley and Driscoll, of Madison Avenue, New York.

It appears from the minutes that thereafter, essentially the entire case of the Opponent was presented by Mr Blecker, while that of the Proprietor was presented by Mr Skone James. Just before the adjournment for deliberation by the Opposition Division, the minutes record that Mr Hafner confirmed the Opponent's request for revocation.

At the end of the oral proceedings, the decision was announced that the patent was revoked on the ground of lack of inventive step.

A written decision was issued on 2 August 1993, setting out the reasons why Claim 1 as granted, and Claim 1 of the auxiliary request, were considered not to involve an inventive step.

III. On 3 August 1993, according to a note in the file recording a telephone consultation between Mr Skone James and an examiner who had not been a member of the Opposition Division, Mr Skone James questioned the presence of Mr Blecker as well as his performance during the oral proceedings held on 20 July 1993. According to this note, the examiner informed Mr Skone James, on the basis of the Guidelines and a conversation with the chairman of the Opposition Division, that:

"A European patent attorney can, and often does, have a technical expert who presents the technical argumentation.

The expert can in theory present some or all of the technical aspects.

The patent matters e.g. entering the pleas, ... should be done by the European attorney.

Whether the "expert" is a patent attorney does not matter, he has to confine his part to technical matters and does not present the "patent" aspects.

The decision stands. If a party feels aggrieved then his only recourse is an appeal".

IV. The Proprietor duly filed an appeal. The Notice of Appeal requested cancellation of the decision to reject Claims 1 to 12 as granted. The Statement of Grounds of Appeal contains submissions essentially as follows:-

(1) There was a substantial procedural violation at the oral proceedings before the Opposition Division which were held on 20 July 1993, for the following reasons:

(a) Dr Hafner and Mr Blecker represented the Opponent at the oral proceedings. The Opponent has its place of residence and business in the USA and has no principal place of business within the Contracting States. Mr Blecker is a United States patent attorney, and is not a European patent attorney. Mr Blecker was not eligible to speak as representative of the Opponent having regard to the provisions of Articles 133 and 134 EPC. In particular, Article 133(2) EPC states that "natural or legal persons not having either a residence or their principal place of business within the territory of one of the Contracting States must be represented by a professional representative and act through him in all proceedings ..." under the EPC. Article 134(1) EPC states that "Professional representation of natural or legal persons ... may only be undertaken by professional representatives. Article 134(7) EPC states that "Professional representation ... may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in one of the Contracting States ..." etc. Mr Blecker fulfils neither of these conditions.

Decision T 80/84 (OJ EPO 1985, 269) is directly relevant to the present case.

Furthermore, Mr Blecker is not in fact an "expert in shop security". The decision of the Opposition Division was reached on the basis of statements and arguments made by Mr Blecker, but since he is neither an authorised representative nor a technical expert, no reliance can be placed on what he said.

- (b) If, contrary to the above, Mr Blecker can be considered to be a technical expert, the requirements of Rule 72 EPC concerning the taking of oral evidence of experts were not carried out. No notification was given by the Opponent to the Proprietor that an expert would give evidence.

Furthermore, Mr Blecker did not simply give a technical assessment of the cited documents, but effectively presented the entire case of the Opponent.

- (2) In view of the above substantial procedural violations which occurred before the Opposition Division, if the patent cannot be maintained in accordance with the Proprietor's current main request, the case should be remitted to the Opposition Division for a re-hearing before a newly composed Opposition Division, the previous decision being annulled.

In any event, the costs incurred by the Proprietor in the oral proceedings held on 20 July 1993 should be paid by the Opponent, and the appeal fee should be refunded.

V. In reply, the Opponent contended inter alia that there had been no substantial procedural violation at the oral proceedings, for the following reasons:-

- (1) The Opposition Division was asked for and gave permission for Mr Blecker to speak. The Proprietor did not object.
- (2) Mr Blecker is a United States patent attorney, and has acted for the Opponent for more than 20 years, and is therefore very familiar with theft deterrent systems. He was introduced to the Opposition Division in such capacity.
- (3) Decision T 80/84 is not applicable to the present case. In particular, in the present case the Opposition Division allowed Mr Blecker to speak, and the Proprietor did not object.

VI. In a reply filed on 15 September 1994, the Proprietor stated inter alia as follows:

- (1) The Proprietor was given no opportunity to object. If the Opposition Division should have given such an opportunity to object, there was a substantial procedural violation for this reason also.
- (2) The Proprietor has no recollection that Mr Blecker was introduced to the Opposition Division as the Opponent's United States patent attorney. As the minutes show, he was introduced only as an "expert in shop security".

Furthermore, "whether or not there has been a substantial procedural violation depends upon a proper interpretation of Articles 133, 134 and 117 EPC". In addition to Decision T 80/84 previously referred to, Decisions T 598/91 dated 3 June 1993, T 227/92 dated 1 July 1993, and T 451/89 dated 1 April 1993 are also relevant. There is a divergence of view as to the proper practice, as exemplified by Decision T 80/84 which adopted a relatively strict approach and Decision T 598/91 which adopted a very liberal approach. Other decisions adopted some form of intermediate approach.

The Proprietor submitted:

- (a) Mr Blecker is not entitled to act as a representative because he does not meet any of the requirements of Article 134 EPC.
- (b) Mr Blecker was also not entitled to give evidence under the relevant provisions of Article 117 EPC, because he was neither a party, a witness of fact, nor an expert in the relevant art.

Mr Blecker's contribution at the oral hearing should be struck out and the case remitted for re-hearing.

If it is decided that there is a discretion to hear somebody like Mr Blecker, such discretion should be exercised to balance the interests of the parties and the intention of the EPC, and should not be exercised in favour of Mr Blecker in this case inter alia because:

- (a) The effect would be to give full rights of audience to a non-qualified attorney to act as an attorney and not as an expert. It is believed that such a right does not exist in any other country in the world.
- (b) The Opponent misrepresented the status and/or expertise of Mr Blecker.
- (c) The Proprietor was not given an opportunity to object to Mr Blecker presenting the Opponent's case.

Finally, the Proprietor requested that if the Board of Appeal cannot resolve this matter, a question should be referred to the Enlarged Board of Appeal as follows:

"Is it in accordance with Articles 133 and 134 EPC that a person not meeting the requirements of Article 134 EPC be permitted to present legal argument and make legal submissions in oral proceedings before an Opposition Division or in written documents?"

VII. In reply the Opponent asserted that there had been no procedural violation, inter alia because Mr Blecker's position and experience had been known by everyone at the hearing, and the Proprietor could have objected at any time during the hearing if he had wished to.

VIII. On 1 June 1995 the Proprietor filed copies of the observations which he had forwarded to the Enlarged Board of Appeal in case G 2/94, as a third party statement in that case, and stated the belief that the issues raised in case G 2/94 are directly relevant to the issues in the present case. The Proprietor requested

that further action in the present case be deferred pending issue of the decision of the Enlarged Board in case G 2/94.

Reasons for the Decision

1. In Decision J 11/94 (to be published in OJ EPO), the question arose whether, during oral proceedings before the Legal Board of Appeal under Article 116 EPC, a former member of the Boards of Appeal, accompanying the professional representative of a party but not himself being qualified to represent parties under Article 134 EPC - i.e. an "accompanying unqualified person", may make oral submissions on behalf of the party to the appeal proceedings concerning the legal issues in the case. The written decision refers to the different views on this question which were expressed in Decisions T 80/84 (OJ EPO 1985, 269) and T 598/91 (OJ EPO 1994, 912), and also refers to what was stated in Decision T 843/91 (OJ EPO 1994, 818). In its decision, the Legal Board of Appeal referred the following questions to the Enlarged Board of Appeal:-

"(1) May a Board of Appeal exercise discretion in deciding whether or not a person not entitled under Article 134(1) and (7) EPC to represent parties to proceedings before the EPO may make submissions during oral proceedings in addition to the pleading by the professional representative?

(2) If the answer to question 1 is "yes":

(a) What criteria must the Board observe when exercising this discretion?

(b) Do special criteria apply to former Board of Appeal members?"

The case is pending as G 2/94.

Clearly question (1) above is similar in content to the question which was proposed for referral to the Enlarged Board of Appeal by the Proprietor in the present case - see paragraph VI above.

In fact, although Decision J 11/94 is concerned with a case in which only legal issues arise, question (1) above is broad enough to cover a case, such as the present, where an "accompanying unqualified person" makes oral submissions on both legal and technical issues which arise in the case. Thus question (1) above is also applicable to the present case.

2. In the present appeal proceedings, the grounds of lack of novelty and lack of inventive step are raised against the patent in suit. Both legal and technical issues arise in the context of these grounds of opposition. The question which is set out in paragraph VI above and which was proposed for referral to the Enlarged Board of Appeal is only concerned with "legal submissions". However, the submissions which have been made in the present case on behalf of the Proprietor, and which are summarised in paragraphs IV and VI above, do not only put in question whether an "accompanying unqualified person" can make legal submissions during oral proceedings before the EPO, but also put in question whether such a person can make oral technical submissions during such proceedings. In this context, reference has been made to the requirements of Article 117 EPC concerning the "taking of evidence" in proceedings before the EPO.

Implicit in the submissions of the Proprietor which are summarised in paragraph VI above is the idea that an "accompanying unqualified person" (not being qualified to act as a representative) is only entitled to give oral evidence in accordance with Article 117 EPC if he is a party, a witness of fact or an expert, and if he is none of these things he is not entitled to make oral submissions either on legal or on technical matters.

Thus in the present case the question specifically arises as to whether, and if so in what circumstances, during opposition or opposition appeal proceedings an "accompanying unqualified person" may make oral submissions on technical matters, other than in accordance with the provisions of Article 117 EPC. This question thus goes beyond the circumstances of Decision J 11/94, where the case is concerned with ex parte proceedings involving only legal issues.

A further question is raised by the Proprietor in the present case as to whether, having regard in particular to the provisions of Articles 133 and 134 EPC, a person who is not qualified in accordance with Article 134 EPC but is a qualified patent lawyer in a country which is not a Contracting State to the EPC may present some or all of a party's case as if he was qualified under Article 134 EPC.

3. Since, as set out in paragraph VIII above, the Proprietor in the present case has presented a "third party statement" to the Enlarged Board of Appeal in case G 2/94, pursuant to Article 11(b) of the Rules of Procedure of the Enlarged Board of Appeal, it seems sensible that questions of law as set out below should be referred to the Enlarged Board of Appeal in the

context of the present case, in order that both parties to the present case will have an opportunity to present their comments directly to the Enlarged Board.

In the Board's view, it is desirable that whenever possible, important questions of law should be considered by the Enlarged Board of Appeal in the context of proceedings involving parties having opposing interests in relation to the questions of law, so that the Enlarged Board can hear arguments in favour of both sides of the questions before deciding them.

Order

For these reasons it is decided that:

The following important questions of law shall be referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC:-

1. During oral proceedings before the EPO under Article 116 EPC, and in the context of opposition or opposition appeal proceedings, having regard to the provisions of Article 133 EPC, may a person who is not qualified in accordance with Article 134 EPC to represent parties to proceedings before the EPO, but who is accompanied by a person who is both qualified and authorised to represent a party to the proceedings, make oral submissions on behalf of that party on legal issues which arise in the case?

2. During oral proceedings before the EPO under Article 116 EPC, and in the context of opposition or opposition appeal proceedings, having regard to the provisions of Articles 117 and 133 EPC, may a person who is not qualified in accordance with Article 134 EPC to

represent parties to proceedings before the EPO, but who is accompanied by a person who is both qualified and authorised to represent a party to the proceedings, make oral submissions on behalf of that party on technical issues which arise in the case, otherwise than by giving evidence orally in accordance with the provisions of Article 117(3) EPC?

3. In relation to each of questions (1) and (2) above taken separately:

- (a) If the answer is "yes", can such oral submissions be made on behalf of the party as a matter of right, or can they only be made with the permission of and under the discretion of the EPO?
- (b) If such oral submissions can only be made under the discretion of the EPO, what criteria should be considered when exercising such discretion?
- (c) Do special criteria apply to qualified patent lawyers of countries which are not Contracting States to the EPC?

The Registrar:

The Chairman:

J. Rückerl

G. D. Paterson