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D E C I S I O N
of 11 April 1996

Case Number: T 0227/95 - 3.5.1

Application Number: 85307532.3

Publication Number: 0179625

IPC: B60H 1/00

Language of the proceedings: EN

Title of invention:
Air conditioner for automobiles

Patentee:
NIPPONDENSO CO., LTD.

Opponent:
Robert Bosch GmbH
Rodacher Autoklima GmbH
Behr GmbH & Co.

Headword:
Air conditioner/NIPPONDENSO

Relevant legal provisions:
EPC Art. 107, 111(1), 113(1)
EPC R. 58(4), 67, 68(2)

Keyword:
"The order of the Board's decision not carried out by the
Opposition Division - procedural violation"
"Remittal of the case and reimbursement of the fee"

Decisions cited:
T 0527/92, T 0892/92

Catchword:

I. An opponent who did not appeal the first decision by the Opposition Division to reject the oppositions may still be considered adversely affected in accordance with Article 107 EPC by a second decision of that division (after remittal) maintaining the patent in amended form. Such an opponent is entitled to appeal said second decision, if he originally had requested the revocation of the patent in its entirety.

II. For a decision to be properly reasoned as required under Rule 68(2) EPC, the reasons must clarify the standpoints of the body responsible for the decision and be adequately connected to the resulting order. Where a remittal has taken place with the order to prosecute the case further, it is incumbent upon the first instance to examine all the patentability issues arising from this order, and give adequate reasons on each such issue.



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Boards of Appeal

Chambres de recours

Case Number: T 0227/95 - 3.5.1

DECISION
of the Technical Board of Appeal 3.5.1
of 11 April 1996

~~Appellant~~/other party:
(Opponent) 01

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Representative:

Respondent:
(Proprietor of the patent)

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1-1, Showa-cho
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Representative:

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Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office dated 12 January
1995 concerning maintenance of the European patent
No. 0 179 625 in amended form.

Composition of the Board:

Chairman: W. B. Oettinger
Members: R. Randes
C. Holtz

Summary of Facts and Submissions

- I. European patent 179 625 was granted on patent application No. 85 307 532.3 filed on 18 October 1985. Three oppositions, based on Article 100(a) EPC, were filed against it, requesting that the patent be revoked in its entirety. By decision taken at oral proceedings on 22 January 1992 the opposition division rejected the oppositions maintaining the patent as granted.

- II. Opponents 1 lodged an appeal against this decision. The appeal (T 0527/92), which was first allocated to TBA 3.2.1 but then transferred to TBA 3.5.1 because of particular technical aspects of the claimed subject-matter, was decided at oral proceedings on 24 January 1994. The Board set aside the opposition division's decision, refused the patentees' main request and remitted the case to the department of the first instance for further prosecution on the basis of claims 1-9 according to an auxiliary request. These claims had been filed at the oral proceedings.

- III. The opposition division's first official action after re-starting the prosecution was to send out a communication, which stated inter alia that "the case has been remitted to the Opposition Division for carrying out the publication of a new specification of the contested European patent on the basis of claims 1-9 according to the auxiliary request filed by the patentee". The patentees were invited to file fair copies of all claims and encouraged to file also translations of the claims into German and French. Amendments to the description and the drawings were said not to be necessary. The patentees were given 4 months to file observations.

IV. On 12 January 1995 the opposition division issued a decision, based on claims filed on 9 December 1994 in reply to the official communication, finding that, account being taken of the amendments made, the patent and the invention to which it related would meet the requirements of the EPC. According to the "Conclusion" of the written decision, "the grounds of opposition do not prejudice maintenance of the contested European patent as amended... For the reasons it is referred to the decision of the Board of appeal dated 24.01.94".

V. On 3 March 1995 opponents 2 (present appellants) filed a notice of appeal against this decision together with a statement of grounds and paid the prescribed appeal fee.

It was submitted that the opposition division's decision to maintain the patent in amended form was not reasoned in the meaning of Rule 68(2) EPC. This deficiency amounted to a substantial procedural violation. Furthermore, the decision should not have been taken without oral proceedings, which opponents 2 had requested in their notice of opposition filed on 6 December 1990. This failure to give the parties an opportunity to present their comments contravened Article 113(1) EPC and constituted a further substantial procedural violation.

It was requested that the contested decision be set aside and that the appeal fee be reimbursed. Oral proceedings were requested as an auxiliary measure.

VI. In a further submission, filed on 5 April 1995, the appellants observed that the present appeal case had been transferred from TBA 3.2.1 to TBA 3.5.1 and submitted that the appeal should be dealt with by the same appeal board as had issued the decision T 0527/92.

VII. With letter filed on 28 July 1995 the patentees (respondents) requested that the appeal be rejected. It was submitted that it was clear that the opposition division had indeed re-examined the case since the patent and its subject-matter had been found to meet the requirements of the EPC. Furthermore, the appellants had already been given an opportunity to comment on the auxiliary request in the first appeal proceedings. The opposition division was not obliged to grant further oral proceedings before the same department where the parties and the subject of the proceedings were the same.

Reasons for the Decision

1. Admissibility of the appeal

The opposition division's first decision, which was to reject the oppositions, was appealed only by opponents 1. The opposition division's subsequent decision concerning maintenance of the patent in amended, and limited, form, which decision is the subject of the present appeal, was however appealed by opponents 2.

Although opponents 2 did not appeal the first decision issued by the opposition division, they are adversely affected in accordance with Article 107 EPC by the second decision since the original request was to have the patent revoked in its entirety.

The appeal is therefore admissible.

2. *The responsible board of appeal*

The appellants have questioned the transferral of the present appeal from TBA 3.2.1 to TBA 3.5.1 and demanded that the appeal should be handled by the board which decided the previous case T 0527/92. This is in fact the very effect of the transferral since TBA 3.5.1 decided the previous case. However, to ensure independence of judgement the present appeal has been examined by members of the board who did not participate in the case T 0527/92.

3. The reasoning in the appealed decision

The appellants submit that the decision of the opposition division to maintain the patent in amended form was not reasoned in the meaning of Rule 68(2) EPC. The Board agrees with this view. The decision contains no reasons on the merits of the case. Instead, it is stated that "for the reasons it is referred to the decision of the Board of appeal dated 24.01.94". However, decision T 0527/92 contains no such reasons since the case was remitted to the opposition division **for further prosecution**. The Board in that case decided **only** that the patent could not be maintained in accordance with the patentees' (then) main request. The examination of the auxiliary request was left entirely to the department of the first instance. This is very clearly stated in the Board's decision: "The Board would like to emphasize that the new claims will have to be examined with respect to all relevant requirements of the EPC..." (point 5.2).

The lack of reasoning seems to be the result of a misunderstanding of the Board's order, in spite of the above indication to said reasons. It is noted in

particular that the Board did not remit the case for the mere "publication of a new specification", as assumed by the division.

The opposition division therefore has not carried out the Board's order as intended, which amounts to a substantial procedural violation. The decision under appeal must therefore be set aside, the case remitted again to the first instance department and the appeal fee reimbursed.

4. The Board furthermore notes that the opposition division's single communication was directed to the patentees only, setting a time limit for filing fair copies of the claims; the box indicating that the other parties had an opportunity to file observations within this time limit had not been crossed. This procedure seems to contravene Article 113 as well as Rule 58(4) EPC. However, the Board does not need to go into this matter further, as there is already cause to remit the case, and reimburse the fee, as stated in point 3 above.

The request for oral proceedings (cf. point V) need also not to be examined. The Board would only like to mention that oral proceedings did take place (cf. point I above) and this would seem to distinguish the present case from T 892/92, referred to by the appellants.

5. Since the appellants' requests that the appealed decision be set aside and the appeal fee be reimbursed are granted, there is no need to hold oral proceedings before the Board in accordance with their auxiliary request.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of the first instance for further prosecution, taking point 5.2 of T 0527/92 into consideration.
3. The reimbursement of the appeal fee is ordered.

The Registrar:

The Chairman:

M. Kiehl

W. B. Oettinger