

Internal distribution code:

- (A) [] Publication in OJ
(B) [] To Chairmen and Members
(C) [X] To Chairmen

D E C I S I O N
of 16 December 1996

Case Number: T 0211/96 - 3.2.2

Application Number: 89102310.3

Publication Number: 0348594

IPC: B23H 7/08

Language of the proceedings: EN

Title of invention:

A wire electrode for wire cut electric discharge machining

Patentee:

mitsubishi denki kabushiki kaisha

Opponent:

Berkenhoff GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 113, Rule 67

Keyword:

"Substantial procedural violation - remittal to first instance"
"Reimbursement of appeal fee"

Decisions cited:

-

Catchword:

-



Case Number: T 0211/96 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 16 December 1996

Appellant: MITSUBISHI DENKI KABUSHIKI KAISHA
(Proprietor of the patent) 2-3, Marunouchi 2-chome
Chiyoda-ku
JP - Tokyo (JP)

Representative: Liesegang, Roland, Dr. -Ing.
Boehmert & Boehmert, Nordemann und Partner
Franz-Joseph-Strasse 38
DE - 80801 München (DE)

Respondent: Berkenhoff GmbH
(Opponent) Berkenhoffstrasse 14
DE - 6301 Huechelheim (DE)

Representative: Missling, Arne, Dipl. -Ing.
Patentanwalt
Bismarckstrasse 3
DE - 35390 Giessen (DE)

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 02 January 1996
revoking European patent No. 0 348 594 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: H. J. Seidenschwarz
Members: C. Holtz
M. G. Noel

Summary of Facts and Submissions

- I. The appeal lies from the decision dated 2 January 1996 of the Opposition Division to revoke the appellant's patent.
- II. The appellant requests that the case be remitted to the first instance (main request) or auxiliary that the decision under appeal be set aside and the patent maintained as granted.
- III. The grounds and arguments in support of the appeal are in summary as follows.

During the written proceedings, the Opposition Division had twice issued communications in favour of the patent. During the oral proceedings, the Opposition Division never hinted at or put any questions to indicate any doubts with respect to inventive step. The decision to revoke the patent which was announced at the end of the hearing was therefore totally unexpected and surprising for both parties. The Opposition Division had thus violated Article 113 EPC. The EPO had also made an investigation into the matter and in a letter to the appellant dated 16 February 1996 it was admitted that the Guidelines for the Examination in the European Patent Office, Part E, Chapter III, 8.7 had not been applied as intended.

As regards the technical subject-matter and the issue of inventive step, after discussing the significance of the state of the art, the appellant maintained that the patent should not have been revoked.

- IV. On 10 July 1996 the opponent submitted their withdrawal of the opposition.

- V. The Board indicated in a communication dated 30 July 1996 that in its provisional opinion the decision under appeal should be set aside and the case remitted to the first instance in accordance with the main request of the appellant. The appellant did not respond to the communication.

Reasons for the Decision

1. The appeal is admissible.
2. From the facts on file, including the minutes of the oral proceedings held on 2 January 1996 before the Opposition Division, it is clear that the reasons for revoking the patent had never been brought to the attention of either party before the written reasoned decision was issued. As this failure constitutes a substantial violation of Article 113 EPC, the appellant's main request is allowable. Applying Rule 67 EPC, the Board finds it equitable to reimburse the appeal fee.

Order

For these reasons it is decided that:

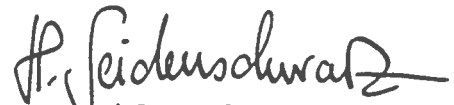
1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The appeal fee is reimbursed.

The Registrar:



S. Fabiani

The Chairman:



H. Seidenschwarz

The first part of the report is a detailed study

of the various methods used in the study

The second part of the report is a detailed study

of the results

The third part of the report is a detailed study

of the results

of the results

[Handwritten signature]

[Handwritten signature]