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D E C I S I O N
of 2 October 2002

Case Number: T 0315/97 - 3.4.2

Application Number: 86308961.1

Publication Number: 0225103

IPC: G02B 5/128

Language of the proceedings: EN

Title of invention:

Encapsulated-lens retroreflective sheeting and method of making

Patentee:

MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

NIPPON CARBIDE INDUSTRIES CO., LTD.

Headword:

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Relevant legal provisions:

EPC Art. 111(1), 135, 136

Keyword:

"Jurisdictional measure to be taken in response to a request based on the alleged violation of a fundamental procedural principle and aimed at the revision of a final decision taken by a Board of Appeal"

Decisions cited:

G 0001/97

Catchword:

-



Case Number: T 0315/97 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 2 October 2002

Former Respondent: MINNESOTA MINING AND MANUFACTURING COMPANY
(Proprietor of the patent) 3M Center
P.O. Box 33427
St. Paul
Minnesota 55133-3427 (US)

Representative: Wilhelm, Stefan
3M Deutschland GmbH
Carl-Schurz-Strasse 1
D-41453 Neuss (DE)

Decision concerned: Decision of the Board of Appeal 3.4.2 of the
European Patent Office posted 21 June 2002
concerning revocation of European patent
No. 0 225 103.

Composition of the Board:

Chairman: E. Turrini
Members: B. J. Schachenmann
A. G. Klein

Summary of facts and submissions

- I. In appeal case T 315/97 concerning an opposition against European patent No. 0 225 103, the Board of Appeal 3.4.2 issued its final decision revoking the patent on 21 June 2002.

- II. On 5 September 2002 the representative of the former respondent (patentee) filed a petition for review by the Enlarged Board of Appeal of the decision referred to above and asked "to debit our deposit account ... with the EPO with the appropriate amount of the fee for a petition for review, e.g. EUR 2.500 ...". The petition is based on the grounds that a fundamental violation of Article 113 EPC and other fundamental procedural defects occurred during the appeal proceedings and is accompanied by a Legal Opinion prepared by Prof. Joseph Straus.

- III. In the petition referred to above it is requested:
 - A. that the Enlarged Board of Appeal set aside the decision referred to above and re-open proceedings before the Boards of Appeal and that the fee for the petition be reimbursed;

 - B. as an alternative request, that the review proceedings be stayed until new Article 112a EPC is introduced when the Act revising the European Patent Convention of 29 November 2000 enters into force;

 - C. as a further auxiliary request, that oral proceedings under Article 116 EPC shall take place;

D. that the European patent No. 0 225 103 be converted under Articles 135 and 136 EPC into a national patent application for all designated Contracting States, should the Enlarged Board of Appeal (or any other EPO authority) consider the petition not to be justified. The EPO is authorized to debit the representative's deposit account with the appropriate conversion fee.

IV. On 27 September 2002 the Chairman of the Enlarged Board of appeal forwarded the petition referred to above to the present Board of Appeal.

Reasons for the decision

1. *Jurisdiction*

Requests A to C of the petition are addressed to the Enlarged Board of Appeal. They are based on an alleged violation of fundamental procedural principles and aimed at the revision of a final decision taken by the Board of Appeal 3.4.2 pursuant to Article 111(1) EPC, first sentence.

According to the decision G 1/97 of the Enlarged Board of Appeal (OJ EPO 2000, 322, point 6 of the reasons) the responsibility for hearing requests of this kind lies with the Board which took the contested decision, not with any other Board or the Enlarged Board. Thus, it is the Board of Appeal 3.4.2 which has exclusive jurisdiction for hearing the requests A to C referred to above.

Despite the fact that, by the end of the period for

signature of 1 September 2001, the Revision Act containing a new Article 112a EPC concerning petitions for review by the Enlarged Board was signed by several Contracting States, decision G 1/97 is still applicable for the following reasons. As clearly follows from Article 8 of the Revision Act, the revised text shall not enter into force until two years after ratification or accession by the fifteenth Contracting State or the first day of the third month following ratification or accession by the last of all Contracting States. Neither of these conditions has been met until now, nor is new Article 112a EPC open to provisional application under Article 6 of the Revision Act. Thus, as new Article 112a EPC cannot be applied yet, the principles set out in decision G 1/97 are still valid for the present petition.

2. *Request A*

Request A is based on an alleged violation of fundamental procedural principles and is aimed at the revision of the final decision in case T 315/97 issued on 21 June 2002. As follows from decision G 1/97, point 6 of the reasons, the jurisdictional measure to be taken in response to such a request is its refusal as inadmissible.

3. *Requests B and C*

According to request B the review proceedings should be stayed until new Article 112a EPC is introduced when the Act revising the European Patent Convention of 29 November 2000 enters into force. According to the further auxiliary request C oral proceedings under Article 116 EPC shall take place.

Regarding the procedure to be followed by a Board of Appeal for applying jurisdictional measures in response to a request aimed at the revision of its own decision it is stated in decision G 1/97 that the Board concerned will be able to consider such a request immediately and without further procedural formalities. In accordance with this finding the Board rejects the procedural requests B and C.

This is justified all the more as, according to Article 1, point 4 of the decision of the Administrative Council of 28 June 2001 on the transitional provisions under Article 7 of the Revision Act, new Article 112a EPC shall only apply to decisions taken as from the date of its entry into force. Thus, even if the present proceedings were stayed as requested, the new provisions concerning revision could not be applied.

4. *Request D*

Request D is a request for conversion into national patent applications under Articles 135 and 136 EPC. According to Article 136(1) EPC such requests have to be filed with the European Patent Office which shall transmit them to the central industrial property offices of the Contracting States specified therein. Thus, this request will be forwarded to the responsible department of the EPO for further prosecution.

Order

For these reasons it is decided that:

1. The request for re-opening the procedure before the Boards of Appeal is refused as inadmissible.
2. The requests for staying the procedure and for oral proceedings are rejected.
3. The request for conversion pursuant to Articles 135 and 136 EPC will be forwarded to the responsible department of the EPO for further prosecution.

The Registrar:

The Chairman:

P. Martorana

E. Turrini