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D E C I S I O N
of 27 July 2000

Case Number: T 0292/98 - 3.2.6

Application Number: 90917389.0

Publication Number: 0468000

IPC: B23K 1/008

Language of the proceedings: EN

Title of invention:
TUNNEL FOR FLUXLESS SOLDERING

Patentee:
ELECTROVERT LIMITED

Opponent:
I SEHO Seitz & Hohnerlein GmbH
II Siemens Nixdorf Informationssysteme AG

Headword:
-

Relevant legal provisions:
EPC Art. 113(2)
EPC R. 67

Keyword:
"Failure to clarify request"
"Substantial procedural violation - yes"
"Reimbursement of appeal fee - yes"

Decisions cited:
-

Catchword:
-

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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0292/98 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 27 July 2000

Appellant: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 22 January 1998 revoking European patent No. 0 468 000 pursuant to Article 102(1) EPC.**

Composition of the Board:

Chairman: P. Alting van Geusau
Members: T. Kriner
J. C. M. de Preter

Summary of facts and submissions

I. The appellant (patent proprietor) lodged an appeal, received at the EPO on 20 March 1998, against the decision of the Opposition Division dispatched on 22 January 1998 concerning the revocation of the European patent No. 0 468 000. The appeal fee was paid simultaneously and the statement setting out the grounds of appeal was received at the EPO on 15 May 1998.

II. Opposition was filed against the patent as a whole by respondents I and II (opponents I and II) and based on Article 100(a) EPC in conjunction with Articles 52(1) and 56 EPC.

III. In its letter dated 23 October 1995, the appellant requested dismissal of the oppositions and maintenance of the patent on the basis of the granted text.

IV. In a communication dated 31 January 1996, the Opposition Division informed the parties that it appeared not to be possible to maintain the patent as granted.

While independent claims 1 - 5 of the patent in suit were regarded as meeting the requirements of the EPC, the subject-matter of independent claim 6 and its dependent claim 7 was considered as not involving an inventive step.

However, it was pointed out that the subject-matter of claims 8 - 16 which were also dependent on claim 6 could be seen to involve an inventive step.

Therefore the Opposition Division suggested that the appellant file an amended claim 6 and related dependent claims which could form the basis for maintenance of the patent in amended form.

V. With letter dated 4 April 1996, the appellant filed new claims amended along the lines suggested by the Opposition Division. New claim 6 was restricted to the subject-matter of claim 8 of the patent specification and the remaining dependent claims were renumbered with appropriate alterations of the dependencies. Furthermore, the description was adapted to the new claims.

The appellant requested that the patent be maintained on the basis of the amended documents.

VI. In a further letter dated 9 August 1996 the appellant refuted the observations filed by the respondents with letters of 27 March 1996 (respondent I) and 10 May 1996 (respondent II) in reply to the Opposition Division's communication and the amended claims.

Although the appellant exclusively referred to the amended claims filed with letter of 4 April 1996, in the last sentence of this letter, the request made in the observations dated 23 October 1995 was reiterated.

VII. In the annex to the summons for oral proceedings dated 12 June 1997 the Opposition Division pointed out that it was the purpose of the oral proceedings to give the parties the opportunity to present their arguments concerning the inventive step of the subject-matter of the amended claims filed with letter dated 4 April 1996.

VIII. With facsimile of 2 June 1997 (respondent II) and during conversations by telephone on 12 December 1997 (appellant and respondent I) the parties informed the Opposition Division that they would not attend the oral proceedings.

IX. At the oral proceedings held on 4 December 1997 which was in fact not attended by any of the parties, the patent was revoked on the basis of the documents according to the patent specification.

X. With the statement of grounds of appeal the appellant filed amended claims 1 - 6 and new columns 1 and 2 of the description. The amended documents correspond to those filed in the opposition proceedings with letter of 4 April 1996.

The appellant requests

- that the Decision of the Opposition be set aside and the opposed patent be maintained on the basis of amended claims 6 to 15 with claims 1 to 5 as granted;

- that oral proceedings be appointed before a decision is reached should the Board be minded to dismiss the appeal; and

- that the appeal fee be reimbursed for reason of a substantial procedural violation committed by the Opposition Division.

Respondent I requests

- to dismiss the appeal; and

- auxiliary, to hold oral proceedings.

Respondent II did not file any submission in the appeal proceedings.

XI. In support of its request for reimbursement of the appeal fee the appellant relied essentially on the following submissions:

It was true that the last submissions filed with letter of 9 August 1996 ended in a clause reiterating the request filed with letter of 23 October 1995, i.e. maintenance of the patent in granted form. However, it should have been obvious to a reasonable person in the circumstances that it had been the patentee's intention to request maintenance of the patent in amended form as requested in its letter of 4 April 1996, in particular having regard to the fact that all arguments had been directed to the amended claims.

Furthermore, even the annex to the summons to attend oral proceedings noted that their purpose was to give the parties the opportunity to present their arguments concerning the inventive step of the subject matter of patent claims 1 - 5 and amended claims 6 - 15 filed with letter of 4 April 1996.

In the event that it had not been obvious that it was the patentee's intention to seek maintenance of the patent on the basis of the amended claims, then there had been a clear ambiguity in the requests made by the patentee which should have been resolved prior to the oral proceedings by warning the patentee of an impending loss of rights.

The disregard of the patentees obvious intention and the failure to clarify the patentee's requests before the revocation of the patent was a violation of the principle of good faith governing the relations between the EPO and the applicant.

XII. Respondent I did not comment on the appellant's submissions concerning the request for reimbursement of the appeal fee.

XIII. In the communication of 24 March 2000 the Board informed the parties that the appellant's request for reimbursement of the appeal fee appeared to be justified and that the Board considered the remittal of the case to the first instance for further prosecution.

Furthermore the parties were requested to inform the Board whether the requests for oral proceedings were maintained in the light of these conclusions.

XIV. The appellant waived its request for oral proceedings with facsimile of 24 May 2000, and respondent I informed the Board with letter of 29 May 2000 that the auxiliary request for oral proceedings was not maintained.

Reasons for the decision

1. The appeal is admissible.

2. *Procedural violation*

2.1 From a formal point of view, the last sentence of the appellant's letter dated 9 August 1996 according to which the request made in the last paragraph of the

observations dated 23 October 1995 was reiterated could be understood as a fall back to the appellant's first requests to dismiss the oppositions and to maintain the patent on the basis of the granted text, and an abandonment of its request to maintain the patent in amended form filed with letter of 4 April 1996.

However, when this sentence is read in context with the remaining text of the letter dated 9 August 1996 which exclusively refers to the amended claims filed with letter of 4 April 1996 (see in particular points 2.6 and 2.7), it would seem more likely that the appellant intended to request the maintenance of the patent in amended form and only erroneously reiterated the request made in the letter dated 23 October 1995.

Having regard to the summons to attend oral proceedings dated 12 June 1997, it appears that even the Opposition Division was of the opinion that the appellant's pending request was to maintain the patent in amended form. At least the Opposition Division indicated in this summons that it was the purpose of the oral proceeding to give the parties the opportunity to present their arguments concerning the inventive step of the subject-matter of patent claims 1 - 5 and amended claims 6 - 15 filed on 4 April 1996.

With respect to the considerations above, the appellant's intention was at least not clear. Therefore, the pending requests should have been clarified by the Opposition Division before a decision was taken. Only if the appellant's requests had been clear, the Opposition Division could have been able to decide upon the patent in the text submitted to it or agreed by the patent proprietor as required by Article 113(2) EPC.

The failure to clarify the appellant's request before the decision must therefore be regarded as a violation of Article 113(2) EPC.

2.2 The indication in the summons to attend oral proceedings that it was the purpose of the oral proceeding to give the parties the opportunity to present their arguments concerning the inventive step of the subject-matter of patent claims 1 - 5 and amended claims 6 - 15 received on 9 April 1996 let the parties go on believing that the appellant's pending request was to maintain the patent in amended form and that this request was the basis for the oral proceedings. However, in contradiction to that indication in the summons, the decision at the oral proceedings was based on the appellant's former request to maintain the patent as granted.

Having regard to the summons, the parties could not expect that in their absence a decision would be taken on the basis of the text of the patent specification. They could only expect a decision on the basis of the amended documents filed with letter of 4 April 1996.

Since the parties should have been able to rely on the indication in the summons, the misleading procedure of the Opposition Division has to be regarded as a violation of the principle of good faith governing the relations between the EPO and its clients.

2.3 In the opinion of the Board the above facts show clearly that a substantial procedural violation has been committed. Not only did the Opposition Division fail to clarify the content of the appellant's request, but it decided on subject-matter which was different from that referred to in the annex to the summons for oral

proceedings without informing the parties, who had announced that they would not attend the oral proceedings.

Under these circumstances reimbursement of the appeal fee is justified.

3. *Procedural matter*

The Opposition Division did not yet examine the amended claims filed with letter dated 4 April 1996 on their merits. Therefore, with the further prosecution of the opposition proceedings, both the admissibility and patentability of the new claims should be examined.

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. Reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

M. Patin P. Alting van Geusau