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Datasheet for the decision of the Enlarged Board of Appeal of 25 October 2013

Case Number: R 0014/12

Appeal Number: T 0834/09 - 3.3.05

Application Number: 97923437.4

Publication Number: 904607

IPC: H01M 4/58, C01B 25/26, C01B 25/45

Language of the proceedings: EN

Title of invention:
Cathode materials for secondary (rechargeable) lithium batteries

Patent Proprietor:
Hydro-Québec

Opponent:
VALENCE TECHNOLOGY, INC.

Headword: Petition for review/Hydro-Québec
-

Relevant legal provisions:
EPC Art. 112a(1),(2)c),(4), 113(1), 54(2)
EPC R. 106, 109(2)(a)(b)

Keyword:
"Objection under Rule 106 EPC could not not be raised"
"Violation of right to be heard (no)"
"Petition unallowable"

Catchword:
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Große Beschwerdekammer | Enlarged Board of Appeal | Grande Chambre de recours

Case Number: R 0014/12

D E C I S I O N
of the Enlarged Board of Appeal
of 25 October 2013

Petitioner: (Patent Proprietor)	Hydro-Québec 75 René-Lévesque Blvd. West Montréal, QC H2Z 1A4 (CA)
Representative:	Bublak, Wolfgang Bardehle Pagenberg Partnerschaft Patentanwälte, Rechtsanwälte Postfach 86 06 20 D-81633 München (DE)
Other Party: (Opponent)	VALENCE TECHNOLOGY, INC. 301 Conestoga Way Henderson, NV 89015 (US)
Representative:	Beckmann, Claus Kraus & Weisert Patent- und Rechtsanwälte Thomas-Wimmer-Ring 15 D-80539 München (DE)
Decision under review:	**Decision of the Technical Board of Appeal 3.3.05 of the European Patent Office of 2 February 2012.**

Composition of the Board:

Chairman: W. van der Eijk
Members: M. J. Vogel
W. Sieber
E. Dufrasne
M.-B. Tardo-Dino

Summary of Facts and Submissions

I. This petition for review, filed on 9 July 2012, concerns decision T 834/09 of Technical Board of Appeal 3.3.05, posted on 2 May 2012, dismissing the appeal against the opposition division's decision revoking European patent No. 0 904 607 based on application No. 97923437.4 and entitled "Cathode materials for secondary (rechargeable) lithium batteries". The petitioner is the appellant/patent proprietor.

II. In the opposition proceedings, the opponent attacked the patent inter alia on the grounds that the subject-matter of claim 1 lacked novelty in view of document D1, which is Abstract No. 58 (page 73) of the spring meeting (5 to 10 May 1996) of the Electrochemical Society Inc. and undisputedly discloses the invention in its entirety. The patent proprietor however argued that D1 had not been made available to the public before the priority date (23 April 1996), because it was not proven that it had been catalogued and shelved in public libraries before that date. On the basis of affidavits and documents presented by the opponent, the opposition division concluded that D1 had been received by several libraries and that at least one of them had catalogued it electronically on 9 April 1996, well before the priority date. The Opposition Division held that once a document had been registered electronically and could be retrieved by the public, even if it had not been shelved it formed part of the state of the art within the meaning of Article 54(1) and (2) EPC.

III. The proprietor filed an appeal. In its statement of grounds it argued that the affidavits and other documents on file did not conclusively prove that D1 had been catalogued and shelved before the priority date, which were the criteria consistently applied in the case law of the Boards of Appeal to verify whether an invention was made publicly available. A librarian working in a library was not a member of the public. Thus, D1 had not been made available to the public within the meaning of Article 54(2) EPC.

The opponent submitted in the appeal proceedings that the evidence on file proved that D1 had been catalogued by at least one library two weeks before the priority date of the opposed patent, and was therefore available to any user of the library. In addition, library staff also had to be regarded as members of the public. If at least one person (a librarian) theoretically had access to a printed document and was free to pass on to anybody else the information it contained, then the document was made available to the public within the meaning of Article 54(2) EPC. The proprietor was mistaken in arguing that cataloguing and shelving were absolute prerequisites for the public availability of documents in libraries.

IV. The Board of Appeal summoned to oral proceedings, held on 2 February 2012, without giving its provisional, non-binding opinion under Article 15(1) RPBA. During the oral proceedings the chairman summarised the relevant facts and the matter was discussed with the parties. After closure of the debate, and deliberation by the Board, the chairman announced the decision that the appeal was dismissed.

V. In its written decision, notified on 2 May 2012, the Board noted that it was uncontested that D1 had been received and date-stamped by the University of California Libraries San Diego on 3 April 1996; the appellant was only arguing that it had not been catalogued and shelved before the priority date. However the Board of Appeal argued that, according to the Boards' case law (see T 1081/01 and T 1510/06), information is to be considered publicly available if a single member of the public not bound by any explicit or implicit secrecy agreement had the theoretical possibility of gaining access to it and was free to pass it on to others. If that was the case, the document's content could be freely reproduced, distributed, transmitted, or otherwise exploited. A librarian was in a position to do that, regardless of whether or not he could understand what was in the document. Thus, contrary to the arguments of the appellant, the act of receiving and date-stamping an incoming document by such a person was already enough to make it publicly available.

VI. On 9 July 2012 the appellant filed a petition for review of this decision under Article 112a EPC, arguing that the Board had committed a fundamental violation of its right to be heard (Article 112a(2)(c) EPC). Only when the written decision was notified had it learned that the Board took the view that a librarian receiving and date-stamping a document was a member of the public and that this made the document available to the public under Article 54(2) EPC. This was a surprising decision which it could not have expected given the consistent case law, the concept of public availability as laid

down in Article 54(2) EPC, and the course taken by the appeal proceedings up to that point. It had therefore also been unable to raise its objections within the meaning of Rule 106 EPC.

The petitioner argued in detail that, according to the Boards' established case law since decision T 381/87, a document was not made publicly available in a library if it had not been catalogued and shelved; mere storage was not enough. In addition, librarians were not members of the public, and not all publications in public libraries were unrestrictedly available to everybody. Besides, librarians were not allowed to read publications during work time and – last but not least – in most cases could not understand them anyway.

As the opposition division had, in the absence of conclusive evidence, accepted on the balance of probabilities, that D1 had been shelved and thereby made available to the public, it was to be expected that the Board of Appeal would focus on this point during the oral proceedings. It was true that the opponent had argued that a librarian was a member of the public, but it had relied on case law which had nothing to do with public availability in a library. In addition, as the Board had not issued a communication under Article 15(1) RPBA, it had seemed that no special matters would be discussed at the oral proceedings, and that the Board did not intend to depart from the established case law on public availability of documents in libraries; there had been no indication at all that the question as to whether or not librarians were members of the public would be relevant. This impression had been confirmed when the chairman gave

his introduction and mentioned the public availability of D1, including the requirement of cataloguing and shelving, and the applicable standard of proof. Nothing had been said at that time about librarians possibly being members of the public.

Moreover, the petitioner submitted that at the end of the main presentation of the appellant's case the Board's legally qualified member had asked why, if a single consumer could be considered to represent the public, a librarian could not likewise be so considered, and what the reaction would be if the librarian took the document and filed a patent application. However, the Board had not made it clear which legal criteria it intended to use to assess novelty and had not provided the parties with guidance on which points submissions might turn to be relevant. That was a breach of its obligation under Article 113 EPC, because a decision must not be based on grounds on which the party concerned did not have an opportunity to present its comments. The right to be heard requires that the proprietor is given an opportunity to comment a deficiency on which the decision is based (letter of the petitioner dated 9 July 2012, p. 10). This required that any ground for revocation be brought in due time and form to the attention of the party concerned. Parties were entitled to rely on the Boards' consistent case law for guidance, and the Board had given no indication that it would depart in substance from this established case law on the criteria for public availability in a public library. Even in the written decision the Board had not mentioned, as required by Article 20 RPBA, that it was departing from established case law.

VII. The Enlarged Board in a three-member panel under Rule 109(2)(a) EPC summoned to oral proceedings on 23 April 2013. After closure of the debate and deliberation, it decided to submit the petition to a five-member board under Rule 109(2)(b) EPC, in which composition it held further oral proceedings on 25 October 2013.

During these oral proceedings the petitioner expanded on its written arguments, maintaining in particular that the boards' case law followed a clear line on public availability in libraries, namely that documents became public when catalogued and shelved. It had not received a clear indication during the oral proceedings before the Technical Board of Appeal that another issue – whether the librarian was himself a member of the public – might be decisive. The Board should have expressly raised and extensively discussed that issue, but had given the parties no hint as to what the case would hinge on. Thus, it had misled the petitioner in a way that had fundamentally violated its right to be heard. Because it had become aware of this fundamental procedural defect only on receipt of the written decision, it could not have raised this objection during the oral proceedings (Rule 106 EPC).

Reasons for the Decision

1. *Admissibility of the petition for review*

1.1 The petitioner is adversely affected by decision T 834/09 revoking European patent No. 0 904 607. The

petition for review was filed on the grounds referred to in Article 112a(2)(c) EPC and therefore complies with Article 112a(1) and (2) EPC.

1.2 The written decision was notified to the parties by registered letter, with advice of delivery, posted on 2 May 2012. The two-month period for submitting the petition for review therefore expired on 12 July 2012. As the petition was filed, and the fee paid, on 9 July 2012, it also complies with Article 112a(4) EPC.

1.3 The petitioner argues that, during the debate at the oral proceedings on 2 February 2012, the Board gave no indication of the crucial issue on which the decision under review was to be based. It was therefore surprised by that decision, and only on receiving it became aware of the reasons for it and of the fact that the Board had violated its right to be heard. The Enlarged Board assumes that this is so, and will proceed on the basis that the petitioner could not have raised its objection during the appeal proceedings. Thus the stipulation at the end of Rule 106 EPC is met.

1.4 The petition for review is therefore admissible.

2. *Allowability*

2.1 The petitioner argues that the Board committed a fundamental violation of its right to be heard under Article 113 EPC, because it did not make it sufficiently clear during the proceedings that the Board was inclined to follow a reasoning other than the established case law in finding that document D1 was publicly available before the priority date.

2.2 Regarding the petitioner's complaint that the Board did not issue a communication under Article 15(1) RPBA, the Enlarged Board can see no breach of the procedural rules. That provision does not oblige a Board to issue communications drawing attention to matters of special significance; it merely gives it discretion to do so. If the Board decided not to issue a communication, it can be assumed that it regards the whole file – i.e. in particular all points of view present in the appeal proceedings about the requirements for public availability of documents in libraries – as relevant for the discussion at the oral proceedings. Consequently, both the Board and the parties are entitled to stress aspects which in their view require consideration.

2.3 It is obvious from the file of the appeal proceedings that the opponent expressed the view that a librarian receiving, date-stamping and cataloguing a document in a library counted as a member of the public within the meaning of Article 54(2) EPC if he was not bound by a secrecy agreement (see point 4.1 of its letter dated 19 November 2009). Therefore the petitioner had to be aware that this argument was part of the appeal proceedings and could come up for discussion with the Board during the oral proceedings. Consequently it had every reason to be prepared to address this point, put its own position, and explain why it thought the opponent was wrong.

2.4 Furthermore, it is clear from both the grounds of the petition and the observations of the petitioner during the oral proceedings before the Enlarged Board that the

crucial question was discussed by the Technical Board. This follows from the specific questions asked by the legal member namely what the reaction would be if the librarian took the document and filed a patent application and why, if a single consumer could be considered to represent the public, could a librarian not likewise be so considered? For the petitioner's professional representative, it had to be clear that the legal issue addressed by these questions was whether a single individual, in particular a librarian not bound by a secrecy agreement, could be considered as constituting the public? And it is clear that he did indeed understand the reasons for these queries, because he answered that the librarian would not be an end user, that he could neither read nor understand the document, and that he would be bound by an implicit confidentiality agreement. All these arguments were an attempt on his part to refute the underlying premise that an individual librarian could inherently be considered a member of the public within the meaning of Article 54(2) EPC.

2.5 Whether or not the petitioner's representative formed the impression that the Board did not consider that premise to be crucial for its decision does not affect the petitioner's right to be heard. If he opted not to dwell on this point any longer than the Board did, and not to expand on it – without being hindered by the Board from doing so – then it was his own personal decision to present his case in that way.

2.6 For this reason, the petitioner could not, from an objective point of view, have been surprised that the Board based its decision on the argument that the

librarian in the University of California Libraries San Diego who had received and date-stamped D1 was a member of the public. As mentioned above, the opponent had already submitted that argument in its response to the statement of grounds for appeal, i.e. before the oral proceedings before the Technical Board which, moreover, implicitly raised it in those proceedings. Lastly, it is obvious from the grounds for the petition and from the submissions during the oral proceedings that the petitioner was not prevented or hindered to present its case on the legal aspects of the questions raised by the legal member of the Board.

2.7 The Enlarged Board is not convinced by the petitioner's assertion that the Technical Board failed to discuss the question of public availability of documents in public libraries in terms of purportedly established and consistent case law. Contrary to the submissions of the petitioner, the Enlarged Board has difficulty to speak of established case law about a notion whose definition depends on the evaluation of factual circumstances and not on the application of a principle of law. Then, even though the Enlarged Board has no competence to evaluate the merits of the reasons given by the Board to come to its conclusion about the availability to the public, it nevertheless notes that the Board pointed out the factual circumstance which in this particular case led it to its conclusion.

2.8 Besides, in view of its obligation to be impartial the Board could not give further detailed hints to the petitioner without giving it an unfair advantage.

2.9 Thus the Enlarged Board of Appeal concludes that the petitioner's representative was never prevented in any way from addressing these questions as he wished. There is nothing on file to suggest that the Board stopped him from presenting his case. That he seems not to have made further elaborations on the legal member's questions during the oral proceedings does not mean that the petitioner's right to be heard under Article 113 EPC was infringed.

Order

For these reasons it is decided that:

The petition for review is rejected as being unallowable.

The Registrar: The Chairman:

P. Martorana W. van der Eijk