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D E C I S I O N
of 7 November 2002

Case Number: T 0012/00 - 3.4.2

Application Number: 94109180.3

Publication Number: 0632301

IPC: G02B 6/44

Language of the proceedings: EN

Title of invention:

Hydrogen-absorbing composition for optical fiber cables and optical fiber cables incorporating such compositions

Patentee:

PIRELLI CAVI E SISTEMI S.p.A.

Opponent:

Alcatel Kabel Beteiligungs-AG

Headword:

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Relevant legal provisions:

EPC Art. 52(1), 54, 56, 111(1), 114(2)

Keyword:

"Late submitted material - appeal"
"Public opinion use"
"Third parties"
"Decision re appeals - remittal (yes)"

Decisions cited:

G 0010/91, G 0001/95, G 0007/95, T 0220/83, T 0482/89,
T 0472/92, T 0782/92, T 1002/92, T 0097/94, T 0301/94,
T 1007/95, T 0254/98

Catchword:

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Case Number: T 0012/00 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 7 November 2002

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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 9 November 1999
rejecting the opposition filed against European
patent No. 0 632 301 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: E. Turrini
Members: A. G. M. Maaswinkel
V. Di Cerbo

Summary of Facts and Submissions

- I. The appellants (opponents) lodged an appeal, received on 3 January 2000, against the decision of the opposition division, dispatched on 9 November 1999, to reject the opposition against the European patent No. 0 632 301. The fee for the appeal was paid on 3 January 2000. The statement setting out the grounds of appeal was received on 1 March 2000.
- II. Opposition had been filed against the patent as a whole on the basis of Article 100(a) EPC, and in particular on the grounds that the subject-matter of the patent was not patentable within the terms of Articles 52 to 57 EPC because it did not involve an inventive step. To support their objections the opponents referred to documents D1 to D16. After expiration of the nine month period according to Article 99(1) EPC the opponents filed the further documents D18 and D19. These late-filed documents were accepted by the opposition division, because in its opinion D18 was considered as the closest prior art.
- III. In the statement of grounds of appeal the appellants cited new documents E1-a to E1-f; E2; E3-a to E3-c; E4 and E5 which should prove public prior use. The appellants concluded that the subject-matter of claim 1 of the patent lacked novelty and therefore, inevitably, also lacked an inventive step. The appellants furthermore objected to lack of inventive step of claim 1 in the light of the combination of documents D18 and D3 or D18 and newly filed document E2.

IV. In response to a Communication of the board pursuant to Article 11(2) of the Rules of Procedure of the Boards of Appeal the appellants submitted two documents E1-g and E1-h with translations into English to further support their objection pertaining to public prior use.

V. On 7 November 2002 oral proceedings were conducted according to the auxiliary requests of both parties.

At the oral proceedings the appellants requested that the decision under appeal be set aside; that the documents submitted during the appeal proceedings be considered as admissible; and that the case be remitted to the first instance for further prosecution.

The respondents requested that the appeal be dismissed as inadmissible. The respondents further requested that the late filed documents be considered as inadmissible and that the case be decided by the board without remittal.

VI. The numbering of the documents referred to in the appeal proceedings reads:

(D3) GB-A-2 144 559

(D6) US-A-4 741 592

(D18) FR-A-2 607 311

(D19) Römpf-Chemie-Lexikon, Georg Thieme Verlag
Stuttgart, 1990, entries for "Alkene" and
"Hydrierung"

(E1-a) Letter dated 18 July 1991 from Seppic to Teleco

- (E1-b) Telefax dated 19 November 1992 from Seppic to SAI
- (E1-c) Telefax dated 3 December 1992 from SAI to Seppic
- (E1-d) International Consignment Note dated 12 January 1993 from Transport Company Albert Frères to Rindi
- (E1-e) Invoice dated 31 March 1993 from Rindi to Albert Frères
- (E1-f) Invoice dated 21 January 1993 from Seppic to Teleco
- (E1-g) Telex dated 1 December 1992 from Teleco to Seppic
- (E1-h) Delivery note dated 15 January 1993 from Teleco to Seppic
- (E2) Provisional data sheet Sepigel H400, bearing a reference "07/1019/02, C/SIL/GB, 04/93"
- (E3-a) Letter dated 1 February 1993 from SAI to Ceat Cavi Industrie
- (E3-b) Letter dated 1 February 1993 from SAI to Cavicel
- (E3-c) Letter dated 1 February 1993 from SAI to Tratos Cavi
- (E4) Copy of a technical report, dated 13 November 1992, deposited at the office of M^e Passelac, notary in Castres (Tarn), FR

(E5) Data sheet "BP Chimie Polybutenes Napvis", bearing a reference "PHD/CH - 5.11.81"

VII. The wording of independent claim 1 reads as follows:

"A hydrogen-absorbing composition for optical fiber cables, comprising:

- a hydrocarbon compound comprising at least 90% by weight of a silicon-free non-aromatic unsaturated hydrocarbon;
- a catalyst selected from a group including the transition metals, salts and organic and inorganic complexes of the transition metals;

characterized in that said silicon-free non-aromatic hydrocarbon compound comprises an unsaturated hydrocarbon which is not obtained by polymerization of monomers including conjugate dienes, said unsaturated hydrocarbon having:

- i) a molecular weight distribution about a mean value varying within a limited range such that it will show no significant phase separation phenomena by decantation or chromatography on a fibrous support;
- ii) a viscosity at room temperature in the range of from 500 to 70,000 cSt,
- iii) a viscosity at room temperature below 70,000 cSt, after ageing by exposure to air in thin layer for at least 7 days at 100°C;

said hydrocarbon compound having double bonds reactive to hydrogen at room temperature, in a corresponding amount to a iodine value in the 7 to 100 g/100g range."

The wording of independent claim 13 reads as follows:

"An optical fiber telecommunications cable comprising a

core (1) provided with at least one optical fiber (3) received in a respective housing (2) of said core (1) characterized in that the cable comprises, in at least a portion (Z1, Z2) of its internal volume, a hydrogen-absorbing composition according to anyone of claims 1 - 12."

Claims 2 to 12 and 14 to 19 are dependent claims.

VIII. The arguments of the appellants may be summarised as follows.

The objection from the respondents that the appeal would be inadmissible because of lack of substantiation in the grounds of appeal was unfounded. In the grounds of appeal it was discussed why the view of the opposition division was erroneous that a combination of the disclosure in document D3, which taught the usefulness of palladium as a hydrogen absorbing substance in optical fiber cables with the teachings of documents D18, D13 or D14, disclosing optical fiber cables with hydrogen-absorbing substances with the features (i), (ii) and (iii) as defined in claim 1 was not obvious. In addition, for further substantiation that the introduction of palladium in a synthetic oil for absorbing hydrogen is obvious, document E2 was cited in the grounds of appeal.

Documents E1-a to E1-g and E2 to E5 showed that the subject-matter of claim 1 was not novel because of public prior use, and therefore necessarily could not involve an inventive step. In particular document E1-a proved the shipment of a sample of the material Sepigel H400 from the company Seppic to the company Teleco. In this respect it was pointed out that Seppic was a third

party which was not related to the appellants' company (Alcatel), therefore the situation differed from the one addressed in decisions T 472/92 and T 97/94, in which cases the opponent itself was involved in a prior use, and which lead the board to require a very strict proof for prior use. As documented by E4 and E5, the product Sepigel H400 had the same composition as the material defined in claim 1. Since it was the material itself which before priority date of the patent in suit was traded between third companies and which material could easily be analysed by the buyer (Teleco) and since these transactions were not confidential, the presence itself of the material before priority date of the patent destroyed the novelty of the subject-matter of claim 1. Therefore it was irrelevant that the contents of document E4 were secret. Furthermore documents E1-b to E1-h constituted a conclusive proof of a commercial delivery of an amount of 200kg Sepigel H400 from Seppic to Teleco, its payment and the acceptance of the material by Teleco. Since from these documents it was evident that this was an ordinary commercial order, including invoice and payment, and from which no confidentiality restrictions were known, these documents also proved public prior use, as ruled in decisions T 482/89 and T 301/94. The quantity of 200kg could not be regarded as a "sample" within the meaning of the decision T 782/92, because this quantity would be sufficient for manufacturing some tens of kilometres of optical cable. Should there still be any doubt as to the question whether the sold material of documents E1-a to E1-h had the same composition as that documented in E4 it was requested to remit the case to the first instance for further prosecution.

IX. The arguments of the respondents may be summarised as

follows:

The appeal was not admissible because the statement of grounds of appeal did not discuss why the decision of the opposition division was wrong and nor did it specify the legal and factual reasons for setting aside the appealed decision, whence the conditions for admissibility formulated in decision T 220/83 and confirmed in many decisions of the boards of appeal were not fulfilled. Furthermore, in line with the decisions G 1/95, G 7/95 and in particular T 1007/95, the introduction at the appeal stage of a new ground of opposition together with new documents had to be considered as a non-allowable new opposition. As to the late-filed documents E1-a to E1-h and E2 to E5, these should not be admitted into the appeal procedure, because according to the relevant case law, for instance T 1002/92, late-filed materials should only be admitted if these were *prima facie* highly relevant, which condition was not met in the present case. According to the established case law, see the decisions T 472/92 and T 97/94, an opponent alleging prior public use must prove his case up to the hilt in order to establish a degree of certainty beyond all reasonable doubt. The late-filed documents did not meet these criteria, since documents E1-a to E1-h only related to the shipment of a sample or of a quite small amount of the material compared to the usual quantities needed for application on an industrial scale. These shipments should therefore be regarded as for test purposes which did not render the material freely available, in agreement with decision T 782/92. Furthermore although

decision T 482/89 ruled that a single sale was sufficient to render an article sold available to the public within the meaning of Article 54(2) EPC, according to this decision this was under the condition that the buyer was not bound by an obligation to maintain secrecy. Such an obligation could be based on an explicit agreement or could be implicit, stemming from the particular circumstances of the sale. For the alleged transactions between Seppic and Teleco the second case applied, because Seppic wished to keep the composition of the material secret, as documented by the secret document E4, and similarly Teleco had clearly an interest in keeping this composition and its application in fiber cables secret for its competitors in order not to lose the technological advantage.

With respect to the further documents, document E2 was a provisional data sheet which merely mentioned a composition of a synthetic oil and filler with 250 pp palladium, where in any case it was not clear whether and when this document had been distributed. Documents E3-a to E3-c were copies of letters without any technical information about the products referred to. Document E4 was a secret document and document E5 was of no relevance.

As to the issue of remitting the case to the first instance, the respondents could not agree with this, because this would cause a long delay in the procedure, which would imply a delay in legal certainty unacceptable to the proprietors.

Reasons for the Decision

1. *Admissibility of the appeal*

1.1 With respect to the respondents' objection that the appeal is not admissible because of lack of substantiation, the board observes the following. In the statement of grounds of appeal the appellants argued that chemical compositions with the features (i), (ii) and (iii) of the material defined in claim 1 for use in optical fibers had been known (*documents D18, D13 and D14, these compositions being commercially offered under the designations "Hyvis3", "Napvis DE2" and "Napvis DE3"*). The appellants furthermore disagreed with the opinion of the opposition division that the introduction of palladium in the above compositions was not obvious. To substantiate their view concerning the obviousness of such introduction they referred in the statement of grounds to document D3, which *inter alia* provided for the use of palladium in optical fiber cables. As a further proof of obviousness for using palladium they referred to the new document E2.

1.2 In the opinion of the board, the present case is in contrast to the one addressed in decision T 220/83 referred to by the respondents, in which case the appellants (*patent proprietors*) in the notice of appeal had merely *asserted* that the claimed subject-matter involved an inventive step because of a selection invention overcoming a technical prejudice, without, however, providing the necessary facts showing such a prejudice.

1.3 Therefore, the board is satisfied that the appeal is sufficiently substantiated and that it meets the

requirements of Articles 106 to 108 EPC and Rule 64 EPC.

2. *Documents E1-a to E1-h and E2 to E5*

2.1 Admissibility of a new ground of opposition

2.1.1 In the notice of opposition the only ground referred to in the context of Article 100(a) EPC had been that the subject-matter of the patent was not patentable because it did not involve an inventive step within the meaning of Article 56 EPC.

2.1.2 In the statement of grounds of appeal the appellants concluded that because the newly cited documents demonstrated prior use, the subject-matter of claim 1 was not novel and, by way of inevitable consequence, did not involve an inventive step.

2.1.3 In the letter dated 18 July 2000 the respondents requested that the introduction of a new ground of opposition should not be allowed. They repeated this request during the oral proceedings.

2.1.4 As to the new ground of opposition reference is made to the decisions G 10/91 and G 7/95. In the latter decision the Enlarged Board ruled that "*In a case where a patent has been opposed under Article 100(a) EPC on the ground that the claims lack an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Articles 52(1) and 54 EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee*". Therefore, since the respondents do not agree with the

introduction of this new ground the board has no power to consider novelty as a ground in the proceedings.

2.2 Admissibility of documents E1-a to E1-h and E2 to E5

2.2.1 In the board's view, taking into account that, apart from the objection of lack of novelty, the appellants have also objected that as an inevitable consequence of the alleged prior public use the claimed subject-matter lacks an inventive step, the non-admittance of the ground of appeal based on lack of novelty in the proceedings for the reasons set out under point 2.1 above does not constitute *per se* a reason for not admitting the above listed documents for the purpose of assessing inventive step of the claimed subject-matter.

2.2.2 According to the respondents' submissions said late filed documents should be considered as inadmissible because they were not *prima facie* highly relevant as set out as a criterium for admissibility of late-filed documents in decision T 1002/92. They further referred to the decisions T 472/92 and T 97/94, according to which the appellants should have proven the alleged prior public use up to the hilt.

2.2.3 With respect to the criterium "prima facie highly relevant", the cited decision T 1002/92 defines this concept in the sense "...that it is highly likely to prejudice maintenance of the European patent in suit".

Without going into the merits of the documents filed by the appellants during the appeal proceedings, it is clear that if, after careful assessment of their contents, these would indeed be able to destroy inventive step, as being the proof of public prior use,

the patentability of the claimed subject-matter would be questionable. Therefore the above criterium for admissibility into the proceedings appears to be fulfilled.

2.2.4 In the decisions T 472/92 and T 97/94 cited by the respondents the boards indeed applied as a standard of proof in the particular cases of prior public use then under decision a very strict criterium that the opponent must prove his case up to the hilt. However, as explained in decision T 472/92, point 3.1 of the Reasons of the Decision, the application of this criterium was motivated by the fact that the opponent had been involved in the prior use and that in such a case practically all the evidence in support of the alleged prior public use lied within the power and knowledge of the opponent. The board ruled that for this *particular* situation the standard of proof used in objections under Article 100 EPC, *i.e.* the balance of probability, should *exceptionally* not be applied. The same strict criterium motivated by an alleged prior public use by the opponent was applied in the decision T 97/94, point 5.1 of the Reasons.

2.2.5 Similarly in the decision T 782/92 the board observed that in the case under decision all evidence documenting the alleged prior use originated from the opponent's company, whence it ruled (point 2.2 of the Reasons, last paragraph) "...that the burden of proof is with the Opponent, in particular to demonstrate beyond any reasonable doubt that the circumstances of alleged prior use allow the conclusion that the information concerned was freely available to the public...".

2.2.6 The present appeal case differs from the above cases in that the material (Sepigel H400) on the basis of which prior public use was claimed originated from a third party (Seppic) which was not related to the appellants' company. Although it would still be the task of the party alleging a prior public use to furnish sufficient proof, it could be expected that in a case wherein third parties are involved in principle both parties could collect evidence in order to prove their views. Therefore in the opinion of the board, for assessing the standard of proof to be applied in such a case it would appear more appropriate to apply the principle of balance of probability. In this respect reference is made to decision T 254/98, where with reference to the question of prior public use by a third party the board ruled in point 2.7 of the Reasons "A party cannot relieve itself of the burden of providing counter-evidence for facts it alleges simply by referring to the above mentioned decision (*i.e.* T 472/92) and stating that all the evidence is within the power of its adversary, without bringing proof that not he but only the Respondent was able to collect the evidence in support of the respective contention".

2.2.7 Therefore in the board's opinion the issue of *procedural admissibility* for the newly filed documents would appear to be fulfilled, without, however, the board taking any position with respect to the actual decisive character of these documents.

3. *Further prosecution*

3.1 Since by the admitted newly filed documents the evidence forming the basis of the appeal proceedings has substantially changed and the board in this respect

has been presented with a completely fresh case, the board follows the accepted practice of the case law of the boards of appeal to remit the case to the first instance in accordance with Article 111(2) EPC for the assessment of inventive step of the claimed subject-matter.

3.2 It is noted that the appellants had filed a request for remittal during the oral proceedings.

3.3 Furthermore, although at the oral proceedings the respondents requested that the board should decide the case without remittal, this request was made in connection to their request not to admit the newly filed documents. Indeed, should these documents not have been admitted, there would have been no necessity for remittal.

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 the assessment of inventive step taking into account also the documents filed by the appellant during the appeal proceedings.

The Registrar:

The Chairman:

P. Martorana

E. Turrini