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D E C I S I O N
of 8 July 2002

Case Number: T 0435/00 - 3.2.2

Application Number: 89910571.2

Publication Number: 0433376

IPC: A61B 17/36

Language of the proceedings: EN

Title of invention:
Cauterizing Apparatus

Patentee:
GYNELAB PRODUCTS, INC.

Opponent:
Wallstén Medical S.A.

Headword:
Admissibility of the opposition/WALLSTÉN MEDICAL

Relevant legal provisions:
EPC R. 55(c), 67

Keyword:
"Sufficiency of substantiation of the opposition (yes)"
"Right to be heard - substantial procedural violation (yes)"

Decisions cited:
G 0004/92, T 0934/99

Catchword:
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Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0435/00 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 8 July 2002

Appellant: (Opponent)
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Representative:
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Respondent: (Proprietor of the patent)
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Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 9 February 2000 rejecting the opposition filed against European patent No. 0 433 376 as inadmissible.**

Composition of the Board:

Chairman: W. D. Weiß
Members: J. C. M. De Preter
M. G. Noël

Summary of Facts and Submissions

1. The respondent is proprietor of European patent No. 0 433 376 (application No. 89 910 571.2).

II. The patent was opposed by the appellant on the ground of Article 100(a) EPC (lack of inventive step) and of Article 100(c) EPC. In the notice of opposition the appellant made general comments concerning the state of the art and referred thereto to Annexes 2 to 4. It further contested inventive step on the one hand on the basis of documents D1 and D2, respectively which had already been considered during the examination procedure and on the other hand on the basis of the combination of Annexes 7 and 8 with document D1. Two declarations (Annexes 5 and 6) were added to support the appellant's interpretation of document D1.

As to Article 100(c) the appellant explained that it could not find any descriptive support for two amendments of claim 1 which had been made in the course of the examination procedure.

III. In its ample reply the respondent refuted the appellant's arguments and referred to some figures in relation with passages of the description insofar Article 100(c) EPC was concerned.

IV. In a communication accompanying the summons to attend oral proceedings the Opposition Division summarised the grounds of opposition and pointed *inter alia* out that although the subject-matter of claim 1 of the contested patent could be regarded upon as a combination of the teachings given in documents D1 and D2, for example, during the oral proceedings the question should be

discussed whether that combination was obvious at all.

V. At the opening of the oral proceedings the Chairman of the Opposition Division asked the parties to confirm their requests. Points 2 to 9 of the minutes of the oral proceedings read as follows:

"2. The chairman moved then to the question of admissibility of the Opposition and asked the Patentee for comments, whereupon the Patentee did not contest admissibility. The Chairman proceeded in explaining the objections of the Opposition division and performed a complete analysis of Annex 1 to the Notice of Opposition dated 30 December 1997. In this respect he cited the Guidelines D-1V, 12.2.1 (v). In particular he asked the Opponent to indicate in the aforementioned Annex, where the following information is mentioned therein:
(regarding the substantiation of the Ground mentioned in Article 100(a) EPC)

- which features of Claim 1 of the patent in suit are known and from which document(s),
- which passages of the cited documents are indicated,
- why should any alleged combination of documents be obvious and
- which document is considered the closest prior art document; and (regarding the substantiation of the Ground mentioned in Art. 100(c) EPC, referring to page 5 of the Annex)
- any arguments brought forward apart from the allegation that the original application documents did not contain descriptive support for the features added to Claim 1.

3. The Opponent asked for a break of 20 minutes to prepare himself and the Chairman interrupted the Oral Proceedings to give him time.

4. After resumption of the proceedings, the Opponent stated that he focussed in the admissibility of Opposition only as far as the Ground of Opposition relating to Art. 100(c) was concerned. In this context he stated that, if the Opponent finds no support in the text, the burden of the proof should be with the Patentee to establish a support for disclosure of the features added to Claim 1, the Opponent having therefore confined his search in the wording of the application, the drawings not including any wordings. He further stated that the Opponent should not be supposed to argue against his own interests by indicating support for the added features.

5. The Opponent requested as main request that the Opposition concerning Art. 100(c) be regarded as substantiated, as first auxiliary request adjournment of Oral Proceedings and as second auxiliary request an additional break in order to prepare his argument because arguing on admissibility in relation to substantiation on the Ground of Art. 100(a) is complicated.

6. At this stage the Patentee requested as main request the rejection of the Opposition as inadmissible and as first auxiliary request the rejection of the Opposition pursuant Art. 102(2) EPC.

7. The Oral Proceedings were interrupted for

deliberation.

8. After resumption of the proceedings, the Chairman announced the opinion of the Opposition Division that the Notice of Opposition did not contain sufficient substantiation neither regarding Art. 100(a) nor Art. 100(c) to enable the Opposition Division to examine the alleged grounds without recourse to independent enquiries. The first and second auxiliary requests of the Opponent were rejected, since the Opposition Division considers that the Opponent should be in position within the time already allowed in agreement with the Opponent during the oral proceedings to merely indicate passages of his Notice of Opposition, being solely 7 pages long, where this latter refers to parts of the cited documents and to conclusions the Opponent has drawn therefrom.

9. The chairman announced the decision."

VI. In the decision under appeal dated 9 February 2000 the ground based on Article 100(c) EPC was considered as being insufficiently substantiated as the notice of opposition did not contain any concrete reasoning why the opponent was of the opinion that the added subject-matter went beyond the content of the application as originally filed. Moreover the opponent had failed to give any comment concerning the figures at all although the burden of proof lied on him.

As to Article 100(a) EPC the Opposition Division set out that it could not be deduced from the notice of opposition which features of claim 1 were effectively

known from which prior art documents, which one of the cited prior documents should be regarded as the closest prior art, which are the relevant passages of the cited documents and why the skilled man would combine some of the cited documents.

Moreover, no consistent logical chain of argumentation was to be found that would have allowed the Opposition Division to extract a valid reasoning substantiating the opposition in respect of said article.

Thus the opposition was rejected as inadmissible.

It was further observed that the opponent had had sufficient opportunity in the 20 minutes break requested by him at the oral proceedings to prepare a defence in respect of admissibility of the opposition and that a grant of time over and above the accorded break would not have been useful.

VII. On 14 April 2000 the opponent lodged an appeal; the appeal fee was paid on the same day.

In the statement of grounds filed on 30 May 2000 and in its further submissions the appellant set out that its right to be heard had been violated as no sufficient time had been given at the oral proceedings to prepare its defence concerning the new objection based on the inadmissibility of the opposition. Thus a substantial procedural violation had been committed which justified the reimbursement of the appeal fee and the remittal of the case to the Opposition Division. The appellant explained further why the notice of opposition had been sufficiently substantiated as is at best illustrated by the extensive reply of the respondent to the notice of

opposition and also by the content of the Opposition Division's own communication.

As to Article 100(c) EPC it was emphasised that when amendments to a claim did not result from the text of a description it was not the task of an opponent to make further investigations.

VIII. According to the respondent neither it nor the Opposition Division had been put in a position to understand clearly the nature of the objections submitted and the evidence and arguments in their support. In particular insofar as Article 100(c) EPC is concerned the content of the notice of opposition boiled down to the mere submission that the patent extended beyond the originally filed application.

As to Article 100(a) EPC it had been impossible for the respondent and the Opposition Division to know where to start with the examination of the appellant's allegations. Finally the respondent was of the opinion that the appellant had had sufficient opportunity to comment on the Opposition Division's objections during the oral proceedings.

IX. The appellant requested that the decision under appeal be set aside and that the case be remitted to the Opposition Division for further prosecution without decision about the admissibility of the opposition (main request) or auxiliarily that the opposition be found admissible and the case be remitted to the Opposition Division for further prosecution, and in both cases that the appeal fee be refunded. The respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

2. As no objection as to the admissibility of the opposition had been made by the respondent nor by the Opposition Division in its communication accompanying the summons to attend the oral proceedings it is clear that the appellant was taken by surprise when that objection was raised for the first time at the oral proceedings.

It is true that the appellant first requested only a break of 20 minutes which was allowed and that after the break the appellant limited its comment to Article 100(c) EPC.

However, the appellant was fully entitled to act in that way as an opposition is admissible when one ground is sufficiently substantiated. Moreover, under the exceptional circumstances of the case it was not unreasonable to auxiliarily request an additional break if the appellant felt the need to have more time for preparing its defence as to Article 100(a) EPC.

Nevertheless an additional break was not allowed for the mere reason, as indicated in the decision under appeal, that it would not have been useful.

Such a reason cannot be accepted as it shows a biased attitude of the Opposition Division towards the outcome of the case.

Moreover, such a behaviour unnecessarily deprived the appellant of its right to be heard. A lengthening of

the procedure by a second break of e.g. 20 minutes would have been quite normal in the present case and would merely have been the result of the Opposition Division's own late action (cf. G 4/92, OJ EPO 1994, 149, point 8 of the reasons).

However, taking into account the reason given by the Opposition Division for refusing a second break and also the fact that both parties commented at length on the question of the admissibility of the opposition in the course of the appeal proceedings, there are sufficient reasons for not remitting the case to the Opposition Division for further prosecution of that question.

3. As to Article 100(c) EPC the appellant stated in its notice of opposition that no descriptive support for the amendments of claim 1 could be found in the specification.

As it is not contested by the respondent that there is no explicit support for said amendments in the description, the Board does not see how the appellant could have been more concrete insofar as the description is concerned.

It has, however, no bearing for the decision that no comment was given in the notice of opposition concerning the figures since underestimating the possible importance of the figures does not render on itself an opposition based on Article 100(c) inadmissible.

4. As to Article 100(a) EPC the Board states that the case does not involve any complicated matter, that the

grounds of opposition were clearly indicated, that the ground of lack of inventive step was twofold and that the documents referred to are short.

Moreover, the extensive and full reply of the respondent to the notice of opposition and the content of the Opposition Division's communication accompanying the summons to attend the oral proceedings indicate clearly that as well the respondent as the Opposition Division (the latter at least as far as documents D1 and D2 are concerned) were able to understand the appellant's case without undue burden (cf. T 934/99, last paragraph of point 6 of the reasons, cf. also point 5 concerning the citation of the closest prior art as not being a precondition for the admissibility of an opposition).

It rather appears that the opposition did not correctly distinguish the sufficiency of the notice of opposition from the strength of the appellant's case as results *inter alia* from point 2 of the reasons for the decision under appeal where it was concluded that there was no "valid reasoning" substantiating the opposition (cf. T 934/99, first paragraph of point 6 of the reasons). The same applies to the respondent who, in particular at the oral proceedings before the Board, argued essentially that the notice of opposition was not "conclusive".

5. Taking into account that the appeal is allowed and that a substantial procedural violation took place, it is equitable to order the reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The opposition is admissible.

3. The case is remitted to the Opposition Division for further prosecution.

4. The reimbursement of the appeal fee is ordered.

The Registrar: The Chairman:

V. Commare W. D. Weiß