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DECISION
of 13 August 2004

Case Number: T 0481/00 - 3.3.2

Application Number: 93304910.8

Publication Number: 0576270

IPC: A01N 25/34

Language of the proceedings: EN

Title of invention:
Fabric protectants

Patentee:
SUMITOMO CHEMICAL COMPANY LIMITED

Opponent:
Bayer AG

Headword:
"Fabric protectants"/SUMITOMO

Relevant legal provisions:
EPC Art. 52, 54, 56, 83, 100, 101(1), 113(1), 114, 117, 125
EPC R. 55(c)

Keyword:
"Admissibility of opposition (yes): requirements of Rule 55(c)
fulfilled"
"Admissibility of late-filed evidence of public prior use
(yes): evidence is prima facie highly relevant in the sense
that is highly likely to prejudice maintenance of the patent"
"Main request, novelty (no): public prior use destroys novelty
of the claimed subject-matter"
"Auxiliary request idem"

Decisions cited:
G 0009/91, G 0010/91, T 0328/87, T 0534/89, G 0028/90,
T 0017/91, T 0212/91, T 0951/91, T 0472/92, T 1002/92,
T 0150/93, T 0255/93, T 0356/94, T 0558/95, T 0947/99

Catchword:
-



Case Number: T 0481/00 - 3.3.2

DECISION
of the Technical Board of Appeal 3.3.2
of 13 August 2004

Appellant: SUMITOMO CHEMICAL COMPANY LIMITED
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Respondent: Bayer AG
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Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 March 2003
revoking European patent No. 0576270 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: U. Oswald
Members: G. F. E. Rampold
P. Mühlens

Summary of Facts and Submissions

I. European patent No. 576 270 ("the patent"), based on European application No. 93 304 910.8 and concerning fabric protectants, was granted to its proprietor (hereinafter referred to as the "appellant") on 27 November 1996. The claims as granted read as follows:

- "1. A fabric protectant comprising a cellulosic material having a bulk density of 0.2 to 0.7 g/cm³ and a thickness of 0.1 to 4 mm and a composition containing as an active ingredient 2,3,5,6-tetrafluorobenzyl (+)-1R,trans-2,2-dimethyl-3-(2,2-dichlorovinyl)cyclopropanecarboxylate, said cellulosic material having the composition supported thereon or being impregnated with the composition.
2. A fabric protectant according to Claim 1, wherein the amount of the active ingredient is 1 to 100 mg/cm³ of the cellulosic material.
3. A fabric protectant according to claims 1 or 2 in the form of a tablet or sheet.
4. A method for protecting fabrics, which comprises applying a fabric protectant as claimed in any one of claims 1 to 3 to pest insects or fabric or to an environment in which fabric is stored.
5. A method for controlling pest insects, which comprises applying the fabric protectant as claimed in any one of claims 1 to 3 to pest insects or fabrics or to an environment in which fabric is stored.
6. Use of a fabric protectant as claimed in any one of claims 1 to 3 for protecting fabric from attack by insects.

7. Use of a fabric protectant as claimed in any one of claims 1 to 3 for controlling pest insects."

II. The opponent (hereinafter referred to as the "respondent") opposed the patent requesting its revocation in full on the ground that the claimed subject-matter in the patent did not relate to an invention which satisfied the requirements of Articles 52 to 56 and 83 EPC. In its notice of opposition, the respondent relied on the following citations to support its contention that the subject-matter of the claims did not meet the requirements for patentability:

(1) EP-A-279 325;

(2) DE-A-3 531 795.

The appellant submitted arguments in support of its request for the opposition to be rejected, with its letter of 2 April 1998, enclosing the following document:

(3) New Polymer Dictionary, 1989, pages 111 and 286, together with an English translation of the relevant parts.

In its letter of 29 June 1998, received on 1 July 1999, the respondent for the first time raised an objection of lack of novelty and inventive step on account of alleged public prior use and submitted in support of this objection the following pieces of evidence:

- (4) Formulation sheet ("Formulierungs-Spezifikation") for Baygon® moth-papers ("Baygon® Mottenpapier") dated 28 September 1990;
- (5) Sheet "Specification - Basispapier für Beschichtungen";
- (6) Sheet of Baygon® sales folder dated 1/91;
- (7) Sheet of Baygon® sales folder dated 1/92;

III. In its communication of 14 October 1998, the opposition division communicated *inter alia* its view that the conditions which have to be satisfied by an allegation of prior public use had not been totally fulfilled by the evidence submitted. From the sales brochures (6) and (7) it seemed, in the opposition division's judgment, clear that Baygon® moth-papers of the type described in (4) were on public sale in and/or before 1991 and thus before the priority date of the patent. The opposition division found, however, that in (4) the paper was not specified as being that of (5) and concluded therefrom that the mere fact that both the paper mentioned in (4) and the paper described in (5) were of a quality 80 g/m² did not prove such a connection. In the opposition division's preliminary opinion, none of the pieces of evidence (1) to (7) prejudiced novelty according to the requirements of Article 54 EPC.

With its reply of 13 April 1999, received on 15 April 1999, the respondent filed further evidence supporting its assertion of public prior use as follows:

- (8) Statutory declaration ("eidesstattliche Erklärung") by Mr Manfred Schütte concerning the parameters and production process and sale of Baygon® moth-papers in the period from their introduction on the market in 1991 up to 29 March 1999, the date of signing the declaration.

By a letter dated 7 December 1999, received on 13 December 1999, the appellant filed further submissions and in particular objected to the admissibility of the opponent's allegation of prior use on the grounds that it had been filed too late and was also insufficiently substantiated by the evidence submitted.

IV. Oral proceedings before the opposition division were held on 9 February 2000. At the hearing, the respondent introduced new evidence. This consisted of:

- (9) a green pad of blotting paper (Brunnen Art.-Nr. 41 556);
- (10) a blue pad of blotting paper (Brunnen Art.-Nr. 41 550);
- (11) two diagrams comparing the claimed article with Baygon® moth-papers and each of the blotting papers referred to under (9) and (10).

V. The opposition division, in its decision pronounced at the close of the oral proceedings and posted on 14 March 2000, revoked the patent pursuant to Article 102(1) EPC.

It found that the opposition under Article 100(b) EPC on the ground of insufficiency of disclosure was unfounded because document (3) provided adequate evidence that the term "bulk density" in claim 1 referred to a parameter which was readily comprehensible to those skilled in the art.

Further, it pointed out that the respondent's assertion of public prior use was submitted after expiry of the opposition period and emphasised that this assertion was based on one of the respondent's own products offered for commercial sale under the brand name Baygon® moth-papers ("Baygon® Mottenpapier") [see the pieces of evidence (4) to (8)]. The opposition division concluded that in the circumstances of the case the late-filing represented an abuse of the proceedings and breach of "good faith". It further concluded that this kind of assertion of prior use could thus not be deemed to have been submitted in due time and should therefore be disregarded under Article 114(2) EPC.

As regards novelty, the opposition division did not share the respondent's opinion that the prior art of citation (1) or (2) anticipated the claimed subject-matter in the patent in suit.

The stated ground for the revocation of the patent was lack of inventive step of the appellant's main request and of all its auxiliary requests before the opposition division, in the light of citations (1) and (2) in conjunction with the pieces of evidence (9) to (11) filed at the oral proceedings and common general knowledge. In particular, the opposition division pointed out that the active principle of the claimed

fabric protectants, namely the insecticide 2,3,5,6-tetrafluorobenzyl(+)-1R,trans-2,2-dimethyl-3-(2,2-dichlorovinyl)cyclopropanecarboxylate (hereinafter referred to under its common names "benfluthrin" or "bayothrin"), and its use in prolonged release formulations in general and specifically in moth papers was already disclosed in citation (1). Citation (2) disclosed the use of absorbent paper in the impregnating process for the production of mothproofing papers. The opposition division concluded therefrom that it would be a trivial matter to arrive at the claimed ranges of the parameters of the cellulosic material used as the carrier for the fabric protectant specified in claim 1 of the patent. The selection of a cellulosic carrier having a bulk density and a thickness within the ranges specified in claim 1 was, in the opposition division's judgment, the result of a logical technical deduction obvious to the skilled person, familiar with the cited state of the art and faced with the problem of finding an optimum release system for "benfluthrin", when using common general knowledge in the art.

VI. The appellant filed an appeal against this decision and paid the appeal fee on 16 May 2000. A statement of grounds for the appeal was filed on 21 July 2000.

On 31 January 2001, the respondent filed a reply to the appellant's statement of grounds of appeal and submitted on 6 February 2001 further evidence as follows:

(12) Statement of the producer of the blotting papers (9) and (10) regarding their relevant parameters, including their bulk density and thickness.

VII. Oral proceedings before the board took place on 13 August 2004. Although duly summoned, the respondent did not attend these proceedings.

During the oral proceedings, the appellant withdrew its request for a refund of the appeal fee. It filed a new auxiliary request wherein the alternative in claim 1 "said cellulosic material having the composition supported thereon" had been deleted and the claim had been restricted to the alternative "said cellulosic material being impregnated with the composition" (see I above).

VIII. The appellant's written and oral submissions, so far as relevant to this decision, can be summarised as follows:

In the appellant's opinion, the requirement under Rule 55(c) EPC for the grounds on which the opposition was based and for evidence in support of these grounds to be indicated in the notice of opposition was not fulfilled. The opening sentence contained a blanket reference to there being no invention meeting the requirements of Articles 52 to 56 and 83 EPC. However, this could not be regarded as an allegation of any particular ground of opposition.

The first two paragraphs of the section headed "Begründung" related to an alleged lack of clarity in the use of the term "bulk density". This allegation did not relate to any ground of opposition mentioned in

Article 100 EPC and was, moreover, in itself manifestly incorrect. It would also seem, from the respondent's own calculations regarding standard copying paper, and from its comments on the prior art, that it was in itself in no real doubt as to the meaning of the disputed claims.

As regards the substantive issues of the patent, the appellant admitted that the notice of opposition went on to say that citation (1) was relevant to novelty. It was, however, clear from the account in (1) given in the notice of opposition that this citation entirely failed to disclose important features recited in claim 1 of the patent. An attempt was made to remedy this deficiency by reference to a packet of standard copying paper. Plainly this did not provide, in the appellant's judgment, even a *prima facie* case of lack of novelty against claim 1. Citation (2) was brought in apparently to allege that claim 3 lacked novelty. Claim 3 was appendant on claim 1, and there was no suggestion that (2) deprived claim 1 of novelty. In fact, citation (2) did not disclose the active ingredient or the thickness or the bulk density of the cellulosic material recited in claim 1.

Although the notice of opposition cited only one ground of opposition, namely lack of novelty, during the opposition proceedings, the ground of lack of inventive step somehow came to be considered. It was accepted by the appellant that, in some, limited circumstances, an opposition division could investigate of its own motion grounds of opposition not covered by the notice of opposition. However, in accordance with decision G 10/91 (OJ EPO 1993, 420), this should only take place

where, *prima facie*, there were clear reasons to believe that such grounds were relevant and would prejudice the maintenance of the patent. Since citation (2) was clearly irrelevant and citation (1) clearly failed to disclose significant features of the invention as claimed, this was plainly not a case where, *prima facie*, there were clear reasons to believe that such grounds would prejudice the maintenance of the patent. Thus, the opposition division should not have considered inventive step in the written proceedings or at the oral proceedings.

The opposition was filed near the end of the period allowed by the EPC for doing so. Nearly a year after the end of the opposition period the opponent had written to the EPO putting forward an allegation of prior use, based on one of its own products. In fact the material in that letter was clearly insufficient to substantiate an allegation of prior use, and the opponent therefore filed further material with a letter dated 13 April 1999. In the present case the respondent was seeking, in the appellant's opinion, to add an entirely new ground of opposition far outside the period for opposition and to remedy deficiencies in that late-filed ground at an even later date. In the present case the opposition division was correct to decide that the opposition, insofar as it related to the allegation of prior use, was inadmissible.

The introduction of the respondent's new evidence (9) to (11) during the oral proceedings before the opposition division was clearly contrary to proper procedure. There was no opportunity for the appellant to consider this new material and formulate a proper

response. Furthermore, this new material strongly influenced the decision of the opposition division to revoke the patent. It was clearly impossible for the appellant, during the oral proceedings, to produce counter-evidence. It did not know on what basis the respondent selected the blotting paper samples. It was quite conceivable, for example, that the two blotting paper samples were very unusual. It was certainly likely that blotting papers covered a wide range, some of which might meet the criteria of the patent and some of which might not. Such matter would require careful investigation. Instead, the opposition division allowed new, unchecked, evidence to be used and, in consequence, decided to revoke the patent. This was clearly an abuse of the appellant's rights.

IX. The respondent's written submissions, as far as they are relevant for the present decision, can be summarised as follows:

With regard to the disputed admissibility of its notice of opposition, the respondent essentially argued that opposition had been filed against the patent as a whole and based on the grounds of Article 100(a) and (b) EPC. It had been substantiated by invoking in the notice of opposition lack of novelty and inventive step (Articles 52, 54 and 56 EPC) as well as lack of sufficiency of disclosure (Article 83 EPC) as grounds for opposition. In support of these grounds the respondent had relied, *inter alia*, on the prior art of citations (1) and (2) in conjunction with the broad common general knowledge concerning various types of papers which might be less suitable for use in moth-proofing compositions, such as, for example, standard

copying paper, and other types which might be more suitable, such as blotting paper.

The respondent submitted that the objection of insufficiency of disclosure was concerned with the term "bulk density" in claim 1. It argued that this term failed to provide an enabling disclosure of one of the essential features of the claimed fabric protectant in the patent, contrary to the requirements of Article 83 EPC.

Citation (1) disclosed the active insecticidal agent of the patent, namely "benfluthrin", and indicated in claim 4 its use as an insecticide. The respondent went on to say that the paragraph in (1) concerning ready-to-use formulations of the known insecticide "benfluthrin" (page 5, lines 34-41) included a reference to moth-papers. The respondent's basis in the notice of opposition for its assertion of lack of novelty of the claimed subject-matter over the prior art of citation (1) was essentially that moth-papers were fabric protectants which were generally known to be in the form of a cellulosic material having a bulk density of 0.2 to 0.7 g/cm³ and a thickness of 0.1 to 4 mm and which had been impregnated or soaked in the active ingredient. In support of its assertion, the respondent submitted calculations, based on standard copying paper, in an attempt to show that citation (1) inevitably implied a known cellulosic carrier of the form used in the patent.

Citation (2) was directed to insecticidal compositions for the control of textile pests consisting of a carrier material and having at least one insecticidal

substance deposited thereon. Since citation (2) referred in its introductory portion to insecticidal papers as being the most widely used moth-proofing compositions and disclosed in this context that the insecticidal substance could be applied to cellulosic carrier materials, in particular to absorbent papers, for example by an impregnation process, the disclosure of (2) was, in the respondent's opinion, similarly either novelty destroying or, at least, detrimental to inventive step.

The pieces of evidence (4) to (7) were, in the respondent's opinion, appropriate and sufficient to prove beyond all reasonable doubt that the product Baygon® moth-papers ("Baygon® Mottenpapier") had been offered for public sale in several countries before the priority date of the patent and that this product anticipated the subject-matter of all claims of the patent. The statutory declaration (8) filled the missing link between documents (4) and (5) which the opposition division had complained about in its communication.

The respondent protested against the appellant's allegation that it had presented new facts and evidence for the first time during the oral proceedings before the opposition division. In this respect, it submitted that the relevant parameters of Baygon® moth-papers ("Baygon® Mottenpapier") had already been brought to the appellant's attention with its letter 29 June 1998 and that the notice of opposition already contained references to blotting papers and copying paper. The diagrams (11) merely showed a summary of information which had, in the respondent's opinion, already been

introduced at a much earlier stage of the overall opposition procedure. The appellant's objection that the samples (9) and (10) had been *ex post facto* purposely selected to attack inventive step, was not substantiated and could not stand. On the contrary, the two types of blotting paper presented during the oral proceedings were ordinary samples handed out to customers in a paper shop asking for blotting paper.

- X. The appellant requested that the decision under appeal be set aside and that the patent be maintained as granted, or, as an auxiliary request, that the patent be maintained on the basis of the auxiliary request filed in the oral proceedings.

The respondent had requested in writing that the appeal be dismissed.

Reasons for the Decision

1. The appeal is admissible.

Admissibility of opposition

2. The board of appeal is obliged, by virtue of Article 101(1) EPC, to examine the admissibility of an opposition, even if the patent proprietors have not raised the question of its inadmissibility during either opposition or appeal proceedings. In the present case, the appellant strongly challenged the admissibility of the opposition during the opposition proceedings and continued in the course of the appeal

proceedings in its written and oral submissions to press for the inadmissibility of the opposition.

- 2.1 Under Rule 55(c) EPC the notice of opposition must contain three components: a statement (a) of the extent to which the European patent is opposed and (b) of the grounds on which the opposition is based as well as (c) an "indication of the facts, evidence and arguments" presented in support of these grounds.
- 2.2 No question arises in relation to component (a) in the present case, since the notice of opposition contains in the opening sentence an explicit statement that the opposition is filed against *the patent as a whole* and that *revocation in full* of the patent is sought.
- 2.3 As to requirement (b), in the introductory portion of the notice of opposition it is stated that, in the respondent's opinion, the patent does not relate to an invention satisfying the requirements of **Articles 52 to 56 and 83 EPC**. This express reference to **Articles 52, 56 and 83 EPC**, coupled with the appellant's explicit assertion in the notice of opposition that the content of citations (1) and (2) is **prejudicial to the novelty** of the claimed subject-matter in the patent (see notice of opposition, page 2, penultimate paragraph, and page 3, third full paragraph), makes it sufficiently clear for the purposes of Rule 55(c) EPC that the grounds of opposition invoked by the respondent in its notice of opposition are **lack of novelty and inventive step** (Articles 100(a), 52, 54 and 56 EPC) and **insufficiency of disclosure** (Articles 100(b) and 83 EPC).

2.4 Turning now to requirement (c): according to the established case law of the boards of appeal (see, for example, Case Law, 4th edition 2001, VII.C.8.5, pages 468-475), requirement (c) of Rule 55(c) EPC is satisfied if the contents of the notice of opposition are sufficient for the opponent's case to be properly understood on an objective basis by the patentee and the opposition division. In other words, the contents of a notice of opposition are considered sufficient if the proprietor and the opposition division are able to form a definitive opinion on *at least one ground of opposition* invoked by the opponent.

Contrary to what the appellant appeared to suggest in its written and oral submissions, for an opposition to be admissible it is not necessary that the patent could have been revoked on the basis of the facts, evidence and arguments presented in the notice of opposition before the expiry of the nine-month opposition period. Rule 55(c) EPC does not prescribe such a complete indication of the facts, evidence and arguments as to permit a conclusive examination on that basis alone. If these principles are applied to the present case it is found that:

- In the second paragraph on page 2 of the notice of opposition, the respondent gives a reasonable explanation why it considers the indication of the "bulk density" as one of the relevant parameters of the cellulosic carrier material in claim 1 as insufficient to disclose the claimed invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art as stipulated by Article 83 EPC.

- The patent relates to a fabric protectant comprising a cellulosic material, having a bulk density of 0.2 to 0.7 g/cm³ and a thickness of 0.1 to 4 mm, and having "benfluthrin" as the active insecticidal ingredient supported thereon or being impregnated with "benfluthrin". In the present case, the respondent made it sufficiently clear that it challenges the novelty and inventive step of the subject-matter of all of claims 1 to 7 by its finding that the insecticidal agent "benfluthrin" and its use as the active ingredient for moth-papers are already disclosed in citation (1) and by attempting to show that moth-papers are fabric protectants generally comprising a cellulosic carrier having a bulk density and thickness within the ranges specified in claim 1 and having the active principle (insecticide) supported thereon or being impregnated with an active insecticidal agent.

- Further, adequate reasons are given in the notice of opposition as to why the respondent considers that the disclosure of citation (2) is likewise prejudicial to the novelty of dependent claim 3 and thus also to claim 1 on which claim 3 depends and which thus necessarily includes the subject-matter of claim 3.

- Moreover, reasonable arguments are given in the notice of opposition showing that, in the respondent's judgment, dependent claims 2 and 4 to 7 merely relate to conventional properties and uses of moth-papers either disclosed in citation

(1) or (2) or known from the general specialist knowledge and that such claims are thus devoid of an inventive step.

2.5 In conclusion, the question whether an opposition fulfils the requirements of Rule 55(c) EPC must be distinguished from the question of the strength of the opponent's case. Where - as in this case - such an opposition is supported by sufficient facts, evidence and arguments, that is to say the respondent's allegation of insufficiency and lack of novelty or inventive step is based on certain *prima facie* relevant pieces of the state of the art and reference is made to the relevant passages thereof and to common general knowledge, there is no doubt as to the admissibility of such an opposition. It is quite another question whether that case, as made out in the notice of opposition, is also sufficient to bring about the patent's revocation.

Admissibility of the respondent's assertion of public prior use

3. As set out in II and V above, during the written proceedings before the opposition division, more specifically about 19 months after the grant of the opposed patent, the respondent attempted unsuccessfully to introduce the pieces of evidence (4) to (7) to substantiate its assertion of lack of novelty and inventive step on account of its own public prior use based on the production and commercial sale of Baygon® moth-papers prior to the priority date of the patent. This evidence was completed later in these proceedings, as set out in III above, by a statutory declaration

("eidesstattliche Erklärung") by Mr Manfred Schütte (8), filed with the respondent's letter of 13 April 1999, received on 15 April 1999.

3.1 Certain previous decisions of the boards of appeal have established that if an opponent wishes to rely upon prior use as being part of the state of the art for the purpose of Article 54(2) EPC and as part of the legal and factual framework within which the substantive examination of the opposition is to be conducted, the notice of opposition should indicate within the opposition period all the facts which make it possible to determine the date of prior use, what has been used, and the circumstances relating to the prior use. Prior use is only adequately substantiated if specific details are given of what was made available to the public, where, when, how and by whom (see eg decisions T 328/87, OJ EPO, 1992, 701; T 93/89, OJ EPO 1992, 718; T 1002/92 OJ EPO 1995, 605). The notice of opposition should also indicate the evidence and arguments supporting the grounds of opposition on account of public prior use.

3.2 Although adherence of an opponent to the general principles set forth in the above-mentioned decisions would be highly desirable in the interest of the proper conduct and administration of proceedings before the EPO, the boards of appeal have generated a substantial body of case law related to the question of admissibility of late submissions, including late-filed facts and evidence concerning public prior use (see Case Law, 4th edition 2001, VI.F.2 to VI.F.5, pages 324-334)

In accordance with this case law, allegations of public prior use, even if based on late-filed facts, evidence and related arguments (whether "late" is taken to mean after the end of the opposition period or after the end of the opposition proceedings), were taken into account, mainly because of their possible relevance to the validity of the granted European patent. Thus, for example, in T 628/90 of 25 November 1991 (not published in the OJ EPO, referred to in Case Law, 4th edition 2001, VI.F.3.1.4, page 331], an allegation of public prior use which was filed for the first time in appeal proceedings and was adequately substantiated, was taken into account because of its possible relevance to enable thorough consideration to be given to the patentability of the subject-matter of the patent (confirmed by T 150/93 of 6 March 1995 and T 947/99 of 27 November 2003).

- 3.3 On the other hand, the board is aware that in some board of appeal decisions, prior use allegations based on late-filed facts, evidence and arguments have been held inadmissible regardless of their relevance. Thus in decision T 951/91 (OJ EPO 1995, 202), the board of appeal held that if a party fails to submit facts, evidence and arguments until after appeal proceedings have been commenced, without adequate excuse, such late-filed material may be held to be inadmissible regardless of its relevance. Similarly, in cases of abuse of procedure, late-filed material has been held inadmissible regardless of its relevance (see, for example, decisions T 534/89, OJ EPO 1994, 464, and T 17/91, not published in the OJ EPO, referred to in Case Law, 4th edition 2001, VI.F.3.1.4, page 330).

3.4 In the present case, the notice of opposition filed with the opposition period contains an indication of the facts, evidence and arguments relied upon in support of the alleged grounds of lack of novelty and inventive step in the light of citations (1) and (2) and common general knowledge (see 2.2, 2.3 and 2.4 above).

However, it contains no indication of facts, evidence or arguments and therefore no substantiation of the alleged prior use of the claimed fabric protectant by the production and sale of Baygon® moth-papers. Such facts, evidence and arguments were filed for the first time on 1 July 1998, ie about ten months after expiry of the opposition period, and were held to be inadmissible by the opposition division.

3.5 In item 24 of the decision under appeal the opposition division pointed out "that the fresh grounds of opposition filed in relation to the prior use of the product Baygon® were inadmissible not on the grounds of their being filed late [emphasis added by the board] but primarily on the grounds that the late filing was considered to be an abuse of the procedure very similar to that mentioned in T 17/91 (loc. cit.) i.e. the prior use which formed the basis of the fresh grounds of opposition was based on the opponent's own activities". The opposition division went on to say that "this decision [to disregard the alleged prior use] was reached despite the obvious relevance of the fresh grounds for opposition to the validity of the patent-in-suit" [emphasis added by the board].

3.6 From the procedural point of view, therefore, in the circumstances of the present case the following two separate questions have to be decided by the board concerning the admissibility of the facts and evidence relating to the opponent's assertion of public prior use:

(i) should the finding of the opposition division that the evidence relating to the alleged prior use first filed on 1 July 1998 and completed on 15 April 1999 was inadmissible be overruled by the board?

(ii) should the evidence referred to in (i) above be admitted into the appeal proceedings?

3.7 In seeking answers to both these questions, the board considers the conclusions reached in decision T 1002/92 (*loc. cit.*) to be relevant to the present case. This decision concerns the extent to which the principles set out by the Enlarged Board of Appeal in G 9/91 and G 10/91 (OJ EPO, 1993, 408, 420) with regard to the admissibility of fresh grounds of opposition influence the admissibility of late-filed new "facts, evidence and arguments" in support of grounds of opposition already contained in the notice of opposition. The first conclusion was as follows (see especially Reasons, point 3.3):

In proceedings before the opposition division, late-filed facts, evidence and related arguments which go beyond the "indication of the facts evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of grounds of

opposition on which the opposition is based should only exceptionally be admitted into the proceedings by the opposition division if **prima facie** there are clear reasons to suspect that such late-filed material would prejudice the maintenance of the European patent in suit. Such **consideration of relevance as the principal factor** follows from the administrative character of the opposition proceedings.

The second conclusion was as follows (see especially Reasons, point 3.4):

In contrast to the first-instance procedure, the **appeal procedure** is a judicial procedure and therefore "less investigative". Therefore, as regards proceedings before the **boards of appeal**, new facts, evidence and related arguments which go beyond the "indication of the facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only **very exceptionally** be admitted into the proceedings, if such new material is **prima facie highly relevant** in the sense that it is **highly likely to prejudice maintenance of the European patent**. Also, other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection and the degree of procedural complication that its admission is likely to cause should be taken into account. In general, the later that such new material is filed the greater the degree of procedural complication that it is likely to cause (confirmed in T 212/91 of 16 June 1995, T 951/91, OJ EPO, 1995, 2002), T 255/93 of 27 September 1994).

3.8 Before going into a detailed consideration of the decision under appeal, some clarification needs to be made regarding the opposition division's repeated statement in the contested decision, namely that the respondent's allegation of public prior use constituted the introduction of "*fresh grounds of opposition*" after expiry of the opposition period (see 3.5 above). On the contrary, the opponent's prior use allegation substantiated by the pieces of evidence (4) to (8) was in fact the attempt to introduce into the proceedings late-filed facts, evidence and related arguments, which go beyond the "indication of the facts evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC, in support of grounds of opposition on which the opposition was already based in the notice of opposition, namely lack of novelty and inventive step (see 2.2 above).

3.9 With regard to the decision under appeal, the board has considered the following relevant criteria:

- (a) the relevance of the respondent's evidence filed on 1 July 1998 and 15 April 1999,
- (b) the opposition division's decision that such evidence was inadmissible;
- (c) the procedural circumstances which led to the opposition division's decision to revoke the patent on the ground of lack of inventive step.

ad (a):

The board concurs with the opinion of the opposition division in the contested decision that the totality of the facts, evidence and arguments concerning the respondent's assertion of public prior use is already ***prima facie*** sufficiently highly relevant to prejudice maintenance of the patent (see decision under appeal: "*despite the obvious relevance <.....> to the validity of the patent-in suit*").

ad (b):

Although the opposition division clearly held in the contested decision that the late-filed materials (4) to (8) are ***prima facie*** sufficiently highly relevant to prejudice the validity of the granted patent (see 3.5 above), it did not give priority to the relevance as the decisive criterion and principal factor for answering the question whether or not this material should be admitted. Because of its decision to revoke the patent on other grounds, it does not at first glance appear to be crucial to the decision under appeal that the opposition division has disregarded the respondent's assertion of public prior use, in spite of its high relevance to the validity of the patent. Nevertheless, on closer inspection of the **procedural circumstances** which led to the revocation of the patent on the ground of lack of inventive step, the board reached the conclusion that the opposition division's finding concerning the inadmissibility of the facts and evidence relating to the opponent's prior use assertion needs to be reconsidered, in the light of the observations in following point (c).

ad (c):

As is apparent from IV above and page 1, paragraph 3, of the minutes, at the oral proceedings before the opposition division the respondent introduced, without warning, the new pieces of evidence (9) to (11). These consisted of two pads of blotting paper (9) and (10) and two diagrams (11) purportedly comparing the claimed article in the patent with Baygon moth-paper and each of the two samples of blotting paper.

On the first sheet of the sample of blotting paper from the blue pad (10), it is indicated in hand-writing that this sheet has

- a basis weight 136 g/m²,
- a thickness 0.15 mm
- a bulk density 0.545 g/cm³

Apart from the fact that it was clearly impossible for the appellant, during the oral proceedings to verify the above-mentioned parameters, which are the result of a rather labourious calculation, requiring the measurement and determination of the weight and thickness of one page of each blotting paper, the new evidence was internally inconsistent and misleading. On the basis of the above-mentioned parameters, the bulk density would be calculated at 0.907 g/cm³. This differs substantially from the quoted figure of 0.545 g/cm³, and is well outside the range specified in the patent.

The respondent admitted as late as in its reply to the statement of the grounds of appeal that the basis weight of 136 g/m² indicated on the blotting paper handed out during oral proceedings before the opposition division was incorrect and should have read,

for whatever reason, 81.79 g/m^2 . Moreover, at the appeal stage a third, different value for the bulk density of 0.45 g/cm^3 was produced in document (12).

On the first sheet of the sample of blotting paper from the green pad (9), it is indicated in hand-writing that this sheet has

- a basis weight 129.8 g/m^2 ,
- a thickness 0.258 mm
- a bulk density 0.47 g/cm^3

Incidentally, the values given for the bulk density of this blotting paper are similarly confusing in themselves. Thus, the value calculated by the respondent was 0.503 g/cm^3 and as such different from that of 0.47 g/cm^3 indicated on the sheet of blotting paper, handed out during oral proceedings before the opposition division, and also different from the value of 0.46 g/cm^3 communicated by the producer of the blotting papers in (12).

In spite of the filing during the oral proceedings, ie at the latest stage possible, and the irregularities and inconsistencies mentioned above, the opposition division decided to admit the late-filed material (9) to (11) into the proceedings without giving any reason or explanation for this decision. Moreover, from the comments in paragraph 29 of the decision under appeal it is clear that this late-filed evidence strongly influenced the opposition division in its decision to revoke the patent.

As stated on page 1 of the minutes, the appellant maintained during the hearing before the opposition division that "the additional evidence presented by the opponent during oral proceedings was filed late and should therefore be disregarded". During the appeal proceedings, it continued to object strongly to the admission of the late-filed evidence (9) to (11).

In the circumstances of the case, it was clearly impossible for the appellant, during the oral proceedings before the opposition division, to verify the proprietor's confusing calculations of the relevant parameters and to produce counter-evidence. The taking into consideration by the opposition division of this evidence presented on the same day as oral proceedings were held constitutes in the present case a clear infringement of the appellant's right to be heard, as guaranteed by Article 113(1) EPC, since the latter had no material opportunity to check this evidence.

3.10 To summarise, with regard to question (i) set out in paragraph 3.6 above, the board has reached the conclusion that the opposition division's finding of inadmissibility of the late-filed facts, evidence and argument relating to the respondent's assertion of prior use should be reconsidered, based on the principles of decision T 1002/92 (*loc. cit.*), and should not be upheld in the light of the criteria (a), (b) and (c) as set forth in 3.9 above.

3.11 With regard to question (ii) set out in paragraph 3.6 above, although the board does not condone such lateness *per se*, it is satisfied that all the late-filed pieces of evidence (4) to (8) are already *prima*

facie sufficiently highly relevant in the sense set out in decision T 1002/92 (*loc. cit.*) to justify their admissibility into the present proceedings even at such a late stage in the overall opposition procedure since it necessarily leads to a finding of invalidity and revocation of the patent, as set out in detail below.

3.12 When exercising in the present case its discretion under Article 114(2) EPC, the board has in mind not only the degree of relevance of the late-filed material (4) to (8). In deciding to admit this material into the proceedings, the board also takes into account and gives due weight to the following factors in the case which all are similarly relevant to the exercise of such discretion:

- The pieces of evidence (4) to (7) and the related facts and arguments were brought to the appellant's attention with the opposition division's communication of 13 July 1998 and evidence (8) with the opposition division's communication of 21 April 1999. Oral proceedings before the opposition division were held on 9 February 2000. The appellant had thus **more than nine months** in which to consider and prepare arguments in reply to the complete late evidence (4) to (8) and had indeed the opportunity to present its comments and counter-evidence in writing and later during the oral proceedings before the opposition division. Its right to be heard concerning the allegation of prior use in the proceedings before the opposition division has therefore been observed. This applies all the more to the appeal proceedings where oral proceedings

did not take place until 13 August 2004. Thus, for example, in decision T 356/94 (cited in Case Law, 4th edition 2001, VI.F.5, page 333), the board held that late-filed facts or evidence could be admitted into the opposition proceedings in so far as such facts or evidence were subsequently discussed by the parties concerned in accordance with Article 113(1) EPC, which meant allowing the parties sufficient time, depending on the nature of the facts or evidence submitted, to provide explanations. This was the case here;

- The nature of the late-filed material (4) to (8) is such that the skilled person could readily and immediately recognise the novelty destroying character of this material and the appellant must have been aware from the moment of its filing that this material was highly likely to put maintenance of the patent at risk at the opposition or appeal stage. In the board's view, the appellant could not thus be surprised by a decision to revoke the patent;

- The admission of the late-filed material did not, in view of its immediately recognisable relevance, cause any procedural complications and uncertainty for the appellant during the appeal stage of opposition proceedings.

- Nor did the admission cause any delay in the proceedings and did not prevent the present case from being ready for the final decision at the conclusion of the oral proceedings before the board;

- As regards the admissibility of late-filed facts and evidence concerning the allegation of a public prior use, the jurisprudence of the boards of appeal is inconsistent, as shown in 3.1 and 3.2 above. For example, decision T 17/91 (relied on by the opposition division to justify its decision to disregard the late-filed evidence) states that an *assertion of public prior use, based on the opponent's own activities and after expiry of the opposition period and in the absence of good reasons for the delay, represents an abuse of the proceedings and breach of the principle of "good faith" which all parties are expected to observe. Therefore, this kind of assertion cannot be deemed to have been submitted in due time and is to be disregarded under Article 114(2) EPC, irrespective of its potential relevance*". In the board's view, this may be regarded as a mere *obiter dictum* because from the reasoning of T 17/91 it is not derivable whether or not the alleged prior use was indeed prejudicial to the validity of the patent in the circumstances of that case and whether or not the board would have taken the same decision, had the prior use indeed turned out to be prejudicial.

- Finally, maintenance of a *prima facie* clearly invalid patent as the legal consequence of the late submission of a clearly novelty-destroying prior use allegation in opposition proceedings, albeit still submitted in time - as in the present case - to guarantee the patentee's right to be heard, would, in the board's judgment, in the

specific circumstances of this case amount to an inappropriate sanction without a sufficient legal basis in the Convention or in the general principles of procedural law applicable under Article 125 EPC.

- 3.13 For the above reasons, the board has decided to admit the late-filed facts, evidence and related arguments (4) to (8) concerning the alleged prior use into the proceedings.

Main request; novelty

4. Having regard to the sales brochures (6) and (7), there cannot be any dispute concerning the fact that Baygon® moth-papers ("Baygon® Mottenpapier") were introduced on the market in Germany and some other countries by the respondent company without implicit or explicit secrecy provisions and offered for public sale and actually sold in and/or before 1991. Thus, the introduction on to the market and the first sale occurred before 26 June 1992, the priority date of the patent.

- 4.1 Furthermore, it was not disputed either by the opposition division or by the appellant that according to (4) [see Formulation sheet ("Formulierungs-Spezifikation") for Baygon® moth-papers ("Baygon® Mottenpapier") dated 28 September 1990] "Baygon® Mottenpapier" was produced by impregnation of 88.8% paper 80 g/cm² with 11.2% of a solution containing 2,3,5,6-tetrafluorobenzyl(+)-1R,trans-2,2-dimethyl-3-(2,2-dichlorovinyl)cyclopropanecarboxylate ("bayothrin" or "benfluthrin") to obtain a moth-paper containing after drying 0.498% "bayothrin".

- 4.2 There was a dispute, however, as to whether the evidence (4) to (7) was sufficient to prove the respondent's assertions that the paper described in (5) is that used in (4) or, differently expressed, whether there is a clear and unequivocal connection between document (5) entitled "Specification - Basispapier für Beschichtungen" and the "Mottenpapier 80 g/m²" referred to in (4). In this respect the appellant emphasised that "Mottenpapier" would seem to be a specialised product suitable for impregnation whereas "Basispapier für Beschichtungen" would be expected to be more usual paper, not particularly suited to impregnation.
- 4.3 By the submission of the further piece of evidence, the respondent succeeded in furnishing the alleged missing links in the chain of evidence relating to the exact composition of Baygon® moth-papers prior to the priority date and in clearing any remaining doubts as to the identity of the paper described in (5) and that used in (4), if such doubts really existed. To this end, the respondent submitted document (8) which is a statutory declaration ("eidesstattliche Erklärung") signed on 29 March 1999 by the declarant, Dr Manfred Schütte, who is an employee of the respondent.
- 4.4 Article 117(1) of the Convention provides, among other means of giving or obtaining evidence, for the production of sworn statements in writing. In decision T 558/95 of 10 February 1997 (cited in Case Law, 4th edition 2001, VI.J.1.1, pages 351 and 352, and confirmed in T 947/99, *loc. cit.*) the deciding board stated that a statutory declaration ("eidesstattliche Erklärung") was evidence within the meaning of

Article 117(1) EPC and as such subject to free evaluation of evidence. It took the place of sworn statements in writing referred to in Article 117(1)(g) EPC which did not exist as evidence under German law. In the cited decision, the board further held that the fact that the statutory declarations provided by the opponent were to some extent identical in wording and drawn up by employees of the opponent did not rule them out as admissible evidence. It was rather a question of the board's evaluation to see whether the evidence provided was sufficient.

4.5 In his statutory declaration (8), Dr Manfred Schütte states that

- (a) he has been an employee of the respondent company located in D-51368 Leverkusen since 1975;
- (b) he was involved in the development of the respondent's product line "Baygon®", including Baygon® moth-paper;
- (c) the products shown in (6) and (7) have been on the market and publicly offered for sale since 1991, for example, in the public factory outlet for the employees of the respondent company located at Kaiser-Wilhelm-Allee in Leverkusen;
- (d) the formulation sheet ("Formulierungs-Spezifikation") for "Baygon Mottenpapier" dated 28 September 1990 (4) relates to the production of Baygon® moth-papers shown in the sales folders (6) and (7) and offered for commercial sale since 1991;

- (e) "Baygon® Mottenpapier" is produced by impregnating 88.8% moth-paper 80 g/cm² with 11.2% of a solution containing "bayothrin", to obtain after drying a moth-paper containing 0.498% "bayothrin";
- (f) the moth-paper used in (4) for impregnation with "bayothrin" is that designated in the Sheet "Specification" (5) as "Basispapier für Beschichtungen: 80 g/m² Novo-Standard". This paper has a thickness of approx. 0.125 mm, a basic weight of 80 g/m² and a volume of 1.60 cm³/g [corresponding to a bulk density of 0.625 g/cm³].
- (g) neither the production process nor the formulation of "Baygon Mottenpapier" have ever been changed between its introduction on the market in 1991 and now.

4.6 It is thus clear that Dr Schütte's statements in his statutory declaration (8) are fully consistent with the data which can be derived from the pieces of evidence (4) to (7). To summarise, free evaluation of the combined evidence available in these proceedings leads the board to the conclusion that the probative value of the evidence (4) to (8) produced by the respondent is sufficient to prove "up to the hilt", within the meaning of decision T 472/92 (OJ EPO, 1998, 161),

- (i) that Baygon® moth-papers ("Baygon® Mottenpapier") were made available to the public by use within the meaning of Article 54(2) EPC prior to the priority date of the patent and

(ii) that Baygon® moth-papers ("Baygon® Mottenpapier") had, before the priority date with regard to both the active insecticidal ingredient and the cellulosic carrier material, a composition falling within the terms of the claimed fabric protectant in the patent.

4.7 It follows that "Baygon® Mottenpapier" which forms part of the state of the art under Article 54(2) EPC destroys the novelty of claim 1 and prejudices the maintenance of the European patent as granted. The main request must therefore fail.

Auxiliary request - novelty

5. As can be derived from VI above, the proposed restriction of claim 1 of the auxiliary request cannot dispel the conclusion of lack of novelty arising from the study of the main request in the light of the relevant state of the art.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:



A. Townend

The Chairman:



U. Oswald

