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D E C I S I O N
of 2 September 2003

Case Number: T 1164/00 - 3.3.6
Application Number: 93310508.2
Publication Number: 0606005
IPC: D21H 17/17
Language of the proceedings: EN

Title of invention:
Fibrous bonded sheet material

Patentee:
DEXTER SPECIALITY MATERIALS LIMITED

Opponent:
Papierfabrik Schoeller & Hoesch GmbH

Headword:
Bonded sheet material/DEXTER

Relevant legal provisions:
EPC Art. 113(1), 114(1), 83, 54, 56
EPC R. 67

Keyword:
"Substantial procedural failure (yes): requirements of Article 113(1) EPC not complied with insufficient time accorded to Appellant (Patent Proprietor) for preparing its case"
"Refund of appeal fee (yes)"
"Novelty and inventive step of main request (yes)"
"New ground of opposition: not validly raised"

Decisions cited:
G 0009/91, G 0010/91, T 0433/93, T 0817/93

Catchword:
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Case Number: T 1164/00 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 2 September 2003

Appellant: DEXTER SPECIALITY MATERIALS LIMITED
(Proprietor of the patent) Erskine House
68-72 Queen Street
Edinburgh EH2 4NF (GB)

Representative: Mercer, Christopher Paul
Carpmaels & Ransford
43, Bloomsbury Square
London WC1A 2RA (GB)

Respondent: Papierfabrik Schoeller & Hoesch GmbH
(Opponent) Postfach 11 55
D-76584 Gernsbach (DE)

Representative: Garkisch, Marcus
Patentanwälte
Henkel, Feiler, Hänzel & Partner
Möhlstrasse 37
D-81675 München (DE)

Decision under appeal: Interlocutory decision of the Opposition
Division of the European Patent Office posted
16 October 2000 concerning maintenance of
European patent No. 0606005 in amended form.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
C. Holtz

Summary of Facts and Submissions

- I. The present appeal is from the decision of the Opposition Division concerning the maintenance in amended form of European patent No. 0 606 005, concerning a fibrous bonded sheet material.

This patent was granted with a set of 18 claims, claim 1 of which reading as follows:

"1. A fibrous bonded sheet material that comprises (a) a polymeric binder in an amount of from 0.5 to 10%, by weight relative to the total dry sheet, (b) a component selected from a wet-strength resin, a cross-linking agent or a mixture thereof, said component being present in an amount of from 0.03 to 1.5%, by weight relative to the total dry sheet, and (c) a ketene dimer in an amount of from 0.0001 to 0.10%, by weight relative to the total dry sheet."

Claims 2 to 14 related to preferred embodiments of the claimed fibrous bonded sheet material, claims 15 to 17 to a process for producing such a sheet material and claim 18 to a filter cigarette with a filter plug wrapped in a tube made of such a sheet material.

- II. One notice of opposition was filed against the patent, wherein the Respondent (Opponent) sought revocation of the patent on the grounds of Article 100(a) EPC, because of lack of both novelty and inventive step of the claimed subject-matter in the light of an alleged prior use.

During the written procedure the Appellant (Patent Proprietor) submitted one auxiliary request.

III. In the annex to the summons to attend oral proceedings of 23 February 2000 the Opposition Division remarked that the discussion at the oral proceedings would deal with the alleged prior use and thus with novelty and inventive step of the claimed subject-matter (points 1 and 3). Moreover, point 2 of this annex read as follows : "Further, is it possible at all to determine for a given paper whether a ketene dimer in the claimed amount has been used during its production? Does the final product still contain ketene dimer as required by claim 1?"

IV. During the oral proceedings held before the Opposition Division on 19 September 2000 in the absence of the Respondent, the Opposition Division stated that the Respondent had not convincingly proven that the composition of the alleged prior use fell under the wording of claim 1.

Furthermore, basing itself on point 2 of the annex to the summons to oral proceedings, the Opposition Division questioned that the claimed fibrous bonded sheet material could be prepared on the basis of the information contained in the patent.

The introduction of the new ground for opposition based on Article 83 EPC was considered to be justified in the light of the decision T 433/93, since it had already been notified in point 2 of the annex to the summons to oral proceedings.

The Appellant requested that the new ground of opposition not be introduced into the proceedings and filed precautionarily two additional auxiliary requests.

- V. The Opposition Division found in its decision that the evidence filed by the Respondent was not sufficient for establishing exactly what had been used in the alleged prior use.

As regards the objections raised under Article 83 EPC it found that

- since claim 1 related to a bonded sheet material comprising highly reactive compounds and was not drafted as a product-by-process claim, the claimed material had to be understood as comprising the mentioned compounds in unreacted form;
- the wording of claim 1 according to the main and to the first auxiliary request was thus directed to a bonded fibrous sheet material still containing highly reactive components such as ketene dimers and cross-linking agents still in unreacted form, whereas the feature "bonded...material" implied that the reactive materials had reacted and were no longer present in their original form. It was therefore not considered possible to prepare a bonded material as claimed containing, e.g., unreacted ketene dimers;

- the filter cigarette of claim 18 could still, similarly, contain highly reactive components and thus would not be suitable for consumption;
- neither the patent in suit nor any of the cited documents contained evidence that the amount of ketene dimers used for the preparation of the bonded sheet material could still be analytically detected in the final product;
- therefore, the patent in suit did not comply with the requirements of Article 83 EPC with regard to the subject-matter of claim 1 and of claim 18, insofar as it referred back to the product of claim 1;
- the main and the first auxiliary request were thus not allowable on this ground.

As to the admissibility of the new ground for opposition, the Opposition Division found that this ground for opposition had already been raised in point 2 of the annex to the summons for oral proceedings, which point had not been addressed in writing by the Appellant in his written replies; it was thus admissible for the Opposition Division to raise during oral proceedings such a new ground by virtue of Article 114(1) EPC.

The second auxiliary request, relating only to the process of preparation of such a bonded product, was found to comply with the requirements of the EPC.

VI. An appeal was filed by the Appellant against this decision.

With the statement of the grounds of appeal the Appellant filed 2 new sets of claims to be considered, respectively, as second and third auxiliary request, and renumbered the second and third auxiliary requests, filed before the Opposition Division, as fourth and fifth auxiliary requests.

The arguments put forward by the Appellant in the statement of the grounds of appeal can be summarised as follows:

- the decision of the Opposition Division with regard to novelty and inventive step in the light of the alleged prior use was correct;
- point 2 of the annex to the summons to attend oral proceedings did not contain any statement that a new ground of opposition was being raised, did not mention specifically Article 83 EPC or Article 100(b) EPC and did not contain any factual or legal reasons that would substantiate the introduction of such a new ground;
- the ground for opposition based on Article 83 EPC was raised for the first time during oral proceedings. The decision of the Opposition Division to introduce the new ground for opposition at this late stage was not supported by the decision T 433/93; the Opposition Division had therefore committed a substantial procedural violation;

- moreover, the skilled person would not have interpreted the claim literally as the Opposition Division did, but would have understood not only that the wording of the claim identified the quantity of reactive compounds absorbed by the fibrous sheet during its preparation, but also that the claim did not mean that these compounds still had to be present in unreacted form in the claimed product.
- VII. The Respondent communicated with a letter dated 5 July 2001 that it did not intend to submit any comments on the statement of the grounds of appeal. No requests were submitted.
- VIII. The Appellant requests that the decision of the first instance be set aside, that the appeal fee be reimbursed because of a substantial procedural violation and that either the patent be maintained as granted (main request) or, alternatively, that the case be remitted to an opposition division having a different constitution from the previous one in order to further discuss the objections raised under Article 83 EPC; alternatively, it requested that the appeal fee be reimbursed because of a substantial procedural violation and that the patent be maintained on the first auxiliary request submitted at first instance or on the basis of any of the second to fifth auxiliary requests filed with the statement of the grounds of appeal.
- Oral proceedings were requested only insofar as any objection to the main request would be upheld.

Reasons for the decision

1. *New ground of opposition and Article 113 EPC*

- 1.1 It is established case law of the Boards of Appeal of the EPO, in accordance with the principles set out by the Enlarged Board in the cases G 9/91 (OJ EPO 1993, 408, point 16 of the reasons for the decision) and G 10/91 (OJ EPO 1993, 420, point 2 of the headnote), that the introduction of a new ground of opposition at a late stage during the opposition proceedings of first instance is only admissible in exceptional cases, for example if it is *prima facie* prejudicial to the maintenance of the patent.

Moreover, if an opposition division wishes to introduce of its own motion a new ground of opposition into the proceedings, the patent proprietor must be informed, possibly in writing, not only of the new ground of opposition but also of the essential legal and factual reasons which could lead to a finding of invalidity and revocation. Thereafter, the patent proprietor must have a proper opportunity to prepare a proper defence and present comments in reply to the new ground and its substantiation. This is mandatory in view of the requirements of Article 113(1) EPC (see T 433/93, OJ EPO 1997, 509, point 3 of the reasons for the decision and T 817/93, unpublished in the OJ EPO, point 5 of the reasons for the decision).

1.2 In the present case an opposition had been raised by the Respondent only on the grounds of Article 100(a) EPC, because of lack of both novelty and inventive step of the claimed subject-matter in the light of an alleged prior use (see point II above). Following the statement of the grounds of opposition dated 15 June 1998 and the written replies of the Appellant and of the Respondent, the parties were summoned to oral proceedings on 23 February 2000.

In the annex to the summons the Opposition Division remarked that the discussion at the oral proceedings would deal with the alleged prior use and thus with novelty and inventive step of the claimed subject-matter (points 1 and 3). In addition, point 2 of this annex read as follows:

"Further, is it possible at all to determine for a given paper whether a ketene dimer in the claimed amount has been used during its production? Does the final product still contain ketene dimer as required by claim 1?"

Since this point 2 does not explicitly indicate if the opposition division intended to raise a new ground of opposition of its own motion and point 3, following point 2, specifies that "provided that the claims are found novel, the discussion of inventive step (Article 56 EPC) will follow in the usual way", the Board finds that the questions contained in point 2 could have been interpreted by the parties only as being directed to the interpretation of the wording of claim 1, in particular whether or not the ketene dimers content could serve as a distinguishing feature, which

appeared important for a final assessment of novelty and inventive step, and thus dealt with the clarity of the claims.

Moreover, the questions contained in the said point 2 did not contain any legal or factual reasoning which could have been interpreted as a serious intention of raising a new ground of opposition.

The Board concludes that the above quoted wording of point 2 could never have been considered to imply an objection against the sufficiency of disclosure of the claimed subject-matter, i.e. an objection which could lead by itself to the revocation of the patent.

- 1.3 As can be deduced from the minutes of the oral proceedings, the Opposition Division informed the Appellant during oral proceedings of its intention to introduce a new ground of opposition based on Article 83 EPC in virtue of Article 114(1) EPC and explained to the Appellant the reasoning upon which this ground was allegedly based.

The Board finds that the Opposition Division was in principle entitled to introduce a new ground of opposition even at such a late stage of the proceedings, since, in its view, it was apparent that the patent in suit did not comply with the requirements of Article 83 EPC.

However, as explained in point 1.2 above, the annex to the summons to oral proceedings did not contain any indication of the intention of the Opposition Division to introduce a new ground of opposition and the

Appellant was made aware of the factual and legal reasons supporting the introduction of this new ground of opposition for the first time during oral proceedings.

The Board finds, therefore, that, contrary to the requirements specified in point 3 of the reasons of the above mentioned decision T 433/93, the Appellant was not notified in writing as early as possible. In the Board's judgment, the Appellant, not having been informed beforehand of such factual and legal reasons, was taken by surprise and did not have a fair possibility during oral proceedings to prepare a proper defence against this new objection.

Under the circumstances of this case, the Opposition Division should have adjourned the oral proceedings in order to give sufficient time to the Appellant, in accordance with the requirements of Article 113 EPC, for preparing a suitable defence against the new objections (see the above cited T 433/93 and T 817/93).

Since this requirement has not been complied with, the Opposition Division committed a substantial procedural failure in rejecting the main and the first auxiliary request on the grounds of the objections raised for the first time during oral proceedings.

2. *The alleged prior use (main request)*

As explained by the Opposition Division in point 2.4.1 of its reasons for the decision, the evidence submitted by the Respondent was not sufficient for proving that the alleged prior use concerned a product as claimed in

the patent in suit (see point V above). The objections raised by the Respondent as to novelty and inventive step were based only on this alleged prior use (point 2.4.2 of the reasons for the decision). The claimed subject-matter thus met the requirements of Articles 52(1), 54 and 56 EPC.

Since no appeal was filed by the Respondent and the Respondent refused to comment on the statement of the grounds of appeal (see point VII above), the Board has no reason to depart from the finding of the first instance.

The Board is thus satisfied that the claimed subject-matter is novel and involves an inventive step in regard to the alleged prior use.

3. *Article 83 EPC (main request)*

As can be deduced from the minutes of oral proceedings (points 4 and 9) and from the decision of first instance (points 2.1.1 and 2.1.2 of the reasons for the decision), the objection raised by the Opposition Division under Article 83 EPC (see also point V above) was not based upon any evidence or argument before the oral proceedings took place.

Consequently, the Board concludes that the objection raised by the Opposition Division was not validly raised and that therefore there are no other valid grounds of opposition filed in due time against the claims according to the main request, which need to be examined by the Board.

4. Since the claims according to the main request, i.e. the claims as granted, comply with the requirements of the EPC, there is no need to discuss the auxiliary requests.

5. *Refund of the appeal fee*

According to Rule 67 EPC the reimbursement of the appeal fee shall be ordered "inter alia" when the Board deems an appeal to be allowable and a reimbursement to be equitable by reason of a substantial procedural violation.

Since in the present case the appeal has been found to be allowable and the first instance has been considered to have committed a substantial procedural failure (point 1.3 above), the Board considers it equitable to refund the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is maintained as granted.
3. The appeal fee is refunded.

The Registrar:

The Chairman:

G. Rauh

P. Krasa