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D E C I S I O N
of 26 April 2002

Case Number: T 1022/01 - 3.3.7

Application Number: 95921830.6

Publication Number: 0762935

IPC: B01J 37/02

Language of the proceedings: EN

Title of invention:

FCC Catalyst Comprising Coated Zeolite Particles

Patentee:

Akzo Nobel N.V.

Opponent:

W.R. Grace & Co.-Conn.

Headword:

Inspection of files/GRACE

Relevant legal provisions:

EPC Art. 112, 128, 150
PCT Art. 36(4), 38(1)
PCT R. 94

Keyword:

"Inspection of files - correspondence in PCT-Chapter II proceedings not part of the European file"

Decisions cited:

T 1101/99, J 0028/94

Catchword:

Inspection of the file of the international preliminary examination at the EPO in its function as elected Office is

not possible under Article 128(4) EPC in conjunction with Articles 36(4), 38(1) and Rule 94.3 PCT if the international application was filed before 1 July 1998.



Case Number: T 1022/01 - 3.3.7

D E C I S I O N
of the Technical Board of Appeal 3.3.7
of 26 April 2002

Appellant: W.R. Grace & Co.-Conn.
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Representative: Schalkwijk, Pieter Cornelis
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 23 April 2001
concerning inspection of files of European Patent
No. 0 762 935.

Composition of the Board:

Chairman: R. E. Teschemacher
Members: B. J. M. Struif
B. L. ter Laan

Summary of Facts and Submissions

- I. European patent no. 0 762 935 was granted in response to European patent application no. 95 921 830.6 which resulted from international application no. PCT/EP95/02131. The mention of the grant of the patent was published on 15 April 1998.

- II. Notice of opposition was filed on 15 January 1999. In a letter dated 27 January 1999, the Opponent's representative requested inspection of files in respect of documents arising from the international preliminary examination. On an earlier request, he had already received a copy of the international preliminary examination report (IPER) established by the EPO. In addition, he requested copies of all other letters submitted by the Applicant as well as communications from the International Preliminary Examining Authority (IPEA). In particular, he mentioned the first written opinion of the IPEA under Rule 66.2 PCT and any further correspondence.

- III. In a decision, dated 27 September 1999 and allowing separate appeal, a formalities officer acting for the Opposition Division rejected the request for file inspection. The reason given was that the relevant documents were not part of the public part of the file of the European patent application accessible by file inspection under Article 128(4) EPC. Nor was file inspection available under the PCT. In the present case Rule 94 PCT as in force before 1 July 1998 applied which did not oblige the elected Office to allow access to the documents relating to international preliminary examination.

- IV. On appeal, this Board, in its decision T 1101/99 of 10 April 2001, set the contested decision aside since rejecting a request for file inspection exceeded the competence of a formalities officer.
- V. In a decision, dated 23 April 2001, the first instance again rejected the request for file inspection. The decision was signed by the three members of the Opposition Division in its composition under Article 19(2), first sentence, EPC. For the rest, the decision was identical to the previous decision of the formalities officer.
- VI. On 25 June 2001, a notice of appeal was filed, the prescribed fee being paid on the same day. A statement of grounds of appeal was filed on 16 August 2001.
- VII. The arguments in support of the appeal can be summarized as follows:

The application had been filed as an international application which, under Article 150(3) EPC, was deemed to be a European application. Furthermore, the Applicant's reply to the written opinion was cited in the communication under Rule 51(4) EPC and, also for this reason, was part of the file of the European patent application. In addition, the Proprietor had agreed to the use of the test reports contained in the reply as the basis of proceedings before the EPO as elected Office when using EPO Form 1200 (Section 6.2, last pre-crossed box) for entering into the regional phase. Thus, Article 128(4) EPC applied without restriction and the possible exclusions in Rule 93 EPC were not applicable to this reply. If the reply had been removed from the file this was contrary to Rule

95a EPC which obliged the EPO to preserve the complete file.

Even if access was not justified on this basis, the principle of legal certainty required the EPO to give third parties an opportunity to ascertain on the basis of which technical information the patent had been granted. Such information was of crucial importance also for appeal proceedings and proceedings before national courts relating to the patent. Article 128(4) EPC implemented the above general principle and obliged the EPO to make all relevant documents available. The Applicant's reply to the written opinion was cited in the IPER. Therefore, a copy of this letter should be requested by the EPO on the basis of Article 36(4) PCT and be made available to the public under Article 128(4) EPC. In addition, the EPO had access to the complete file of the international preliminary examination, including all communications and replies, under Article 38(1) PCT. Rule 94 PCT as amended only confirmed the Appellant's right of inspection since it had to be regarded as a clarification of what had been possible already before. There was nothing in the PCT which prevented the EPO from such course of action.

VIII. At the outset of the oral proceedings before the Board, the Appellant objected to the participation of the Proprietor of the patent. He argued that inspection of files had to be granted in *ex parte* proceedings without hearing the Proprietor who had not been a party to the first instance proceedings either.

In reply, the Proprietor argued that he had to be given the opportunity to comment in order to defend his right in keeping information confidential which was not

accessible by the public under the applicable provisions and that this had not been contested until the oral proceedings.

The Board gave the preliminary ruling that the Proprietor was a party to the proceedings.

IX. In substance, the Respondent (Proprietor) argued essentially as follows:

The reply to the first communication of the IPEA had not become part of the file of the European application. Its citation in the communication under Rule 51(4) EPC only identified the claims foreseen for grant and did not relate to the substance of the letter. Nothing in the IPER could be understood as referring to test reports in the letter. If the examiner of the IPEA had been of the view that the letter contained test reports he would have stated so as foreseen in the Guidelines for Examination in the EPO, E-IX, 5.3, which he had not done. The file of the European application did not reveal anything showing that the Examining Division had used the content of the file of the IPEA. Therefore, it had to be assumed that the Examining Division, on the basis of the file of the European application, had taken the position that the claims as amended before the IPEA were ready for grant.

The EPO as elected Office could not make use of Rule 94 PCT as amended since the amended provision only applied to applications filed since 1 July 1998. Therefore, it could not make information, which it had received under Articles 36(4) or 38(1) PCT, available to the public.

X. The Appellant requested that the written opinion

according to Rule 66.2 PCT and the responses thereto as well as further written opinions and responses be made available for inspection. Auxiliarily, and in case the requested documents were not part of the file of the patent, he requested the EPO to inspect the files of the IPEA according to Article 38(1) PCT and to make available the obtainable information.

As a further auxiliary request the Appellant requested that the following questions be referred to the Enlarged Board of Appeal:

1. Does legal certainty for third parties require that the EPO in its function as elected Office, at the request of a third party, makes available any documents of the international phase of a European patent application or European patent which was filed before July 1, 1998 with exception of the documents mentioned in Rule 93 EPC?
2. If the answer to the first question is no, are also documents excluded which are explicitly mentioned in the IPER that contain test reports?
3. If the EPO in its function as elected Office does not keep certain documents of the international preliminary examination of a European patent application or European patent which was filed before July 1, 1998 in its files, does legal certainty for third parties require that the EPO in its function as elected Office inspects the files of the IPEA at the request and the expense of a third party and makes available the obtainable information to the third party?

XI. The Respondent requested dismissal of the appeal.

Reasons for the Decision

1. The Appellant's request is based on Article 128 EPC. Also the reasons for the request make clear that the request is not directed to the IPEA but to the EPO acting, after grant of the patent, outside its PCT functions. Hence, the provisions of the EPC apply. Accordingly, the decision under appeal was not given by the IPEA but by the Opposition Division with which opposition proceedings are pending (*Singer/Stauder*, 2nd ed., Köln 2000, Art. 128 EPC, note 14). The Opposition Division's decision, although not terminating proceedings, is subject to appeal (Article 106(1) and (3) EPC), on which a Board of Appeal in its composition according to Article 21(4)(a) EPC is responsible to decide.
2. The appeal fulfils the formal requirements and is, therefore, admissible.
3. The Proprietor of the patent is a party to these proceedings. It is true that inspection of files under Article 128(4) EPC is normally granted without informing the applicant or proprietor. This is justified because the grant of file inspection after publication normally does not require consideration of the facts of the individual case. The present case is, however, different because additional documents are requested to be included into the file and the extent of file inspection is contested between the requester and the proprietor. The proprietor is a party concerned within the meaning of Article 113(1) EPC because he has

a legitimate interest in keeping the contested documents confidential and the grant of file inspection would affect his rights. In this situation, the proprietor's right to be heard requires that he can take part in the proceedings before a decision is taken. The situation is similar to the case in which the Legal Division has rejected a request for suspension of proceedings without having heard the applicant. Also here the applicant is entitled to defend his interests as respondent if the requester appeals (J 28/94, OJ EPO 1997, 400).

Main request

4. The main request starts from the assumption that the documents the inspection of which is requested are part of the file of the European patent application or of the European patent under Article 128(4) EPC. This is, however, not the case.
- 4.1 The EPO as an elected Office received the IPER in accordance with Article 36(3)(a) and Rule 73 PCT. In this function the EPO was expected to consider the results of the international preliminary examination (Article 31(4)(a) PCT). Accordingly, the IPER was taken into the file of the Euro-PCT application as foreseen in the Guidelines for Examination in the EPO, E-IX, 6.4, 2nd para. The IPER was established on form PCT/IPEA/409 as prescribed in Rule 70 PCT in conjunction with Section 102(a)(v) of the Administrative Instructions under the PCT. It did not contain the documents the inspection of which is requested.
- 4.2 The Appellant's submission that the Applicant's reply

to the written opinion has been mentioned in the communication under Rule 51(4) EPC and, for this reason, forms part of the European patent application is not convincing. The reply is only mentioned for identifying in the usual manner the version of the claims, submitted with that letter, foreseen for grant of the European patent. Corresponding information is given on sheet 1 of the IPER for identifying the same claims which are the basis for and annexed to the report which is contained in the file. Hence, only the claims filed with the reply to the written opinion are part of the file of the European patent application.

- 4.3 The Applicant's use of Form 1200 has not made the above letter part of the file of the European application. There is no need to speculate, on the basis of the vague statements in the IPER, what exactly the content of the letter was. In any case, the examiner has not made a clear reference in the IPER to any comparative test reports; this would have been the proper course of action if the letter had contained such reports in case they were not annexed to or extensively referred to in the IPER (Guidelines for Examination in the EPO, E-IX, 5.3).

Even more important is the fact that the declaration in the pre-crossed box in Form 1200 does not have the immediate consequence that any test reports submitted during the international preliminary examination become part of the file of the European application. The declaration only says that test reports may be used as a basis for the proceedings. This means that the EPO as elected Office may or may not use the test reports. The file does not give any hint that the letter actually has been used and considered as relevant in the

examination of the European application. In the present case the European patent was granted without any preceding communication under Article 96(2) EPC. The only official action in substance was the communication under Rule 51(4) EPC proposing an adaptation of the description to the claims as amended in the international preliminary examination and an indication of additional prior art. In the absence of any dialogue between the Applicant and the Examining Division, there was no discussion of the requirements for patentability from which it could be derived why the patent was granted. If the Examining Division considered supplementary technical information like test reports as relevant for assessing patentability it could have been expected that such information would be mentioned on the cover page of the patent specification (Guidelines for Examination in the EPO, C-VI, 5.7b, last sentence).

- 4.4 The Appellant's reference to Article 150(3) EPC does not help his case. It is true that, according to this provision, an international application, for which the EPO acts as a designated or elected Office, shall be deemed to be a European patent application. This does, however, not convert the file of the international application into the file of the European patent application. On the contrary, the file of an international application rests within the responsibility of the authorities responsible for the application in the international phase (Rule 93 PCT) with the effect that the file of the international examination remains with the IPEA, with the exception of documents transmitted to other authorities (see Rules 61, 71 and 73 PCT) and with the proviso that access may be allowed under Article 38 in conjunction

with Rule 94 PCT. Therefore, Article 128(4) EPC does not apply in the present case. But even if the EPO had taken documents from the file of the international preliminary examination into the file of the European application, the more restrictive provisions of the PCT (see pt. 5 below) would prevail and continue to apply (Article 150(2), third sentence, EPC).

- 4.5 It follows from the preceding observations that the Appellant's argument that Rule 93 EPC contains an exhaustive list of possible exclusions of file inspection is not pertinent. Any document arising from the international preliminary examination received by the EPO as elected Office is part of the file of the European patent application and as part of this file open to public inspection in accordance with Article 128(4) EPC. Therefore, the Appellant's main request must fail.

Auxiliary request

5. According to the auxiliary request the EPO is asked to inspect the file of the IPEA and to make the obtainable information available to the Appellant.

- 5.1 In a first line of argument, this request is based on the submission that the Applicant's reply to the written opinion was cited on sheet 2 of the IPER and was, for this reason, part of the IPER. In this respect, the Appellant refers to Article 36(4) PCT in conjunction with Article 20(3) PCT. Whereas it is true that on the basis of these provisions the elected Office may request to be provided with "copies of any document which is cited in the IPER and which was not cited in the international search report", Article

36(4) PCT does not support the Appellant's claim because any right under Article 36(4) PCT is given to the elected Office but not to third parties.

5.2 The Appellant invokes the principle of legal certainty which in his view requires giving third parties an opportunity to ascertain on the basis of which technical facts presented by the proprietor the patent has been granted.

5.2.1 As set out above (pt. 4.3), the file of the European application does not contain any discussion of the requirements for patentability from which third parties could derive why the patent was granted. However, the same situation exists in all those cases in which an Examining Division does not raise any objections and proceeds directly to grant.

5.2.2 In the absence of information to the contrary, it may be assumed that the Examining Division agreed with the positive result of the IPER drawn up by the first examiner of the Examining Division. Thus, the IPER may be considered as a source of information for assessing the requirements of patentability. The explanations in the IPER refer twice to the Applicant's reply to the IPEA's written opinion. In respect of novelty, structural differences between the claimed subject matter and the disclosure in two pieces of prior art are explicitly identified, also referring to arguments in the Applicant's letter. In respect of inventive step, the report states that none of the three documents of the prior art teaches or suggests the problem as described in the prior art and that one skilled in the art would not have combined the teachings of any two of these documents. For further considerations in favour of

acknowledgement of inventive step the explanations in the IPER refer again to the Applicant's letter. Although the explanations can be considered to contain a formal reasoning for the acknowledgement of inventive step, the reference leaves room for speculation whether the further information in the Applicant's letter may have influenced the examiner's judgment. For the persuasive force of the IPER it would have been preferable either to repeat in the explanations facts and arguments from the rest of the file if they were essential for the statements under Article 35(2) PCT or not to cite them if they were not essential.

In any case, in the proceedings before the elected Office, the Examining Division has not seen the need to supplement the file of the European patent application by making use of Article 38(1) PCT or by inviting the Applicant to file documents in order to come to its decision to grant the patent. The latter decision is not subject of these proceedings and it is not the task of this Board to review whether the Examining Division should have made any further investigations. Furthermore, examining proceedings are no longer pending and the EPO is no longer active in its role as elected Office. A decision of the Opposition Division concerning the proper content of the examination file cannot change the basis for the Examining Division's decision retrospectively. Therefore, the principle of legal certainty as developed by the Appellant is not a legal basis to force the Opposition Division to inspect the files of the IPEA.

5.3 Since access via Article 36(4) PCT is not at the Appellant's disposal, the question may remain undecided whether "any document ... cited in the IPER" within the

meaning of Article 36(4) PCT may be understood as covering documents which have not been published, as argued by the Appellant. Rather the contrary may be suggested by the fact that the instructions on how to identify citations in the IPER only deal with published documents (Rules 70.7 and 43.5 PCT in conjunction with Sections 611 and 503 of the Administrative Instructions under the PCT referring to WIPO Standard St. 14, published in Handbook on Industrial Property Information and Documentation, loose-leaf ed., Geneva).

6. In support of his auxiliary request, the Appellant also cites Rule 94.3 PCT as in force from 1 July 1998 which allows the elected Office to give access to any document relating to the international preliminary examination contained in its file. The Appellant is of the opinion that Rule 94 as amended is only a clarification of what was allowed before.

6.1 The Board cannot share this view. Article 38 PCT is entitled "Confidential Nature of the International Preliminary Examination". In order to implement the principle of confidentiality, the provision stipulates that neither the International Bureau nor the IPEA shall, without agreement of the applicant, allow access to the file of the international preliminary examination by any person or authority at any time, except by the elected Office once the IPER has been established. When Article 38(1) PCT is interpreted in isolation, the unlimited duration of the above restriction for the International Bureau and the IPEA presupposes that the elected Office is only recipient but not distributor of the information obtained under Article 38(1) PCT. It would make no sense to forbid access at the International Bureau and the IPEA "by any

person" and "at any time" if the elected Office could allow access to anybody after issuance of the IPER. Thus, the access to the file of the international preliminary examination for the elected Office is an exception to the principle of confidentiality in Article 38(1) PCT. Hence, it was the position of the international authorities under the PCT that the provision precluded elected Offices from making available to third parties copies of the international examination file (European Patents Handbook, 2nd ed. loose-leaf, note 16.28.23).

- 6.2 This situation has substantially changed as a result of the entry into force of amended Rule 94 PCT. Whereas the previous version of the provision dealt only with the furnishing of copies from the file of the international application with the agreement of the applicant, amended Rule 94 PCT was introduced "with a view to adopting a more liberal interpretation of Article 38(1). In particular, the exception provided for in Article 38(1) allowing access to the file of the international preliminary examination by elected Offices would no longer be interpreted as limiting that access to the elected Offices themselves. Consistent with this interpretation, elected Offices whose national law makes application files publicly accessible should no longer be required to remove the international preliminary examination file when allowing such access to their files." (Doc. PCT/A/XXIV/7, dated 7 August 1997, Twenty-Fourth Session of the PCT Assembly, Proposed amendments of the Regulations under the PCT, note 24: "Access to files"). Accordingly, pursuant to Rule 94.3 PCT as amended the elected Office may allow access to any document relating to the international preliminary examination,

to the same extent as provided by the national law for access to its own examination file. As stated above, this competence was not derivable from the PCT in its previous text and Rule 94.3 cannot be applied retrospectively.

- 6.3 The view of the Appellant is not only in contradiction to the legislative history as indicated above, to the position taken by the Organisations administering the PCT (WIPO's PCT Applicant's Guide, loose-leaf ed., Vol. I/A, note 476; Guidelines for Examination in the EPO, E-IX, 6.5), and to the opinions expressed in specialist literature (Singer/Stauder, *supra*, note 53 on Art. 155 EPC; Gall/Rippe/Weiss, *Die europäische Patentanmeldung und der PCT in Frage und Antwort*, 6th ed. 2002, p. 330), it is also contrary to the decision of the PCT Assembly, taken when adopting the amended Rule, that Rule 94 in its previous version would continue to apply after 1 July 1998 in respect of applications filed before that date (Doc. PCT/A/XXIV/10, dated 1 October 1997, Report of the Twenty-Fourth Session of the PCT Assembly, note 16(iv), reproduced in WIPO's PCT text as editor's note to Rule 94). Finally, the same practice is prescribed in the PCT Preliminary Examination Guidelines, Chapter VI-13 (PCT Gazette, Special Issue 07/1998, Section IV, 1). The transitional provision takes into account the interests of those applicants who during the international preliminary examination had filed information which they could at that time have expected on the basis of consistent practice of the international authorities under the PCT to remain confidential. A retrospective departure from this practice could violate the principle of protection of legitimate expectations as recognised in the case law

of the Boards of Appeal (see Case Law of the Boards of Appeal, 4th ed. 2001, VI.A.1 and 4).

It follows from the preceding observations that the Board does not see any reason to depart from the legal authorities cited above. Thus, there is no need to deal with the question whether Rule 94.3 PCT as amended would oblige the Opposition Division to supplement the files of the application or the patent with any additional documents. Therefore, also the Appellant's auxiliary request must fail.

7. The Board has been in a position to find clear answers to the questions of law relevant for this decision in applying the provisions of the EPC and the PCT. Therefore, there is no reason for referring a question of law to the Enlarged Board of Appeal as requested by the Appellant.

Order

For these reasons it is decided that:

1. The request for referral of questions of law to the Enlarged Board of Appeal is refused.
2. The appeal is dismissed.

The Registrar

The Chairman:

C. Eickhoff

R. Teschemacher