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D E C I S I O N
of 23 May 2005

Case Number: T 1083/01 - 3.3.3

Application Number: 95650033.4

Publication Number: 0705852

IPC: C08F 220/04

Language of the proceedings: EN

Title of invention:

High performance alkali - swellable rheological additives for aqueous systems

Patentee:

RHEOX INTERNATIONAL, INC.

Opponent:

Coatex S.A.

Headword:

-

Relevant legal provisions:

EPC Art. 113(1), 114(1)

EPC R. 67

Keyword:

"Substantial procedural violation (yes)"

"Refund of appeal fee (yes)"

Decisions cited:

T 0506/91, T 0552/97, T 1164/00

Catchword:

-



Case Number: T 1083/01 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 23 May 2005

Appellant I:
(Opponent)

Coatex S.A.
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F-69730 Genay (FR)

Representative:

Richebourg, Michel François
Cabinet Michel Richebourg
"Le Clos du Golf"
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Appellant II:
(Proprietor of the patent)

RHEOX INTERNATIONAL, INC.
Wyckoffs Mill Road
Hightstown
New Jersey 08520 (US)

Representative:

Duffy, Assumpta Dympna
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Ballsbridge
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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office dated
23 July 2001 and posted 3 August 2001
concerning maintenance of European patent
No. 0705852 in amended form.

Composition of the Board:

Chairman: R. Young
Members: C. Idez
A. Pignatelli

Summary of Facts and Submissions

- I. The grant of the European patent No. 0 705 852 in the name of Rheox International, Inc., in respect of European patent application No. 95 650 033.4 filed on 15 September 1995 and claiming priority of the US patent application No. 315000 filed on 29 September 1994 was announced on 16 December 1998 (Bulletin 1998/51).
- II. A Notice of Opposition was filed against the patent by Coatex S.A. on 10 September 1999.

The opposition was supported *inter alia* by the following documents:

- D1: FR-A-2 693 203;
- D2: US-A-4 384 096;
- D3: US-A-5 292 828;
- D4: EP-A-0 349 383;
- D5: US-A-4 507 426;
- D6: EP-A-0 350 414; and
- D7: US-A-5 082 591.

While requesting the revocation of the patent as a whole on the grounds of lack of inventive step alone (Article 100(a) EPC), the Opponent further indicated in the Notice of Opposition (cf. page 14 thereof), that none of the documents cited destroyed the novelty of the claimed subject-matter.

- III. In the annex to the summons to oral proceedings to be held on 23 July 2001 issued on 2 October 2000 (cf. point 1 thereof), the Opposition Division stated that

"during oral proceedings **only** the inventive step of the challenged subject-matter will be discussed in accordance with the problem/solution approach as established by the case law of the Boards of Appeal." (emphasis by the Opposition Division).

- IV. According to the minutes of the oral proceedings of 23 July 2001, after the opening of the oral proceedings, the Proprietor and the Opponent having maintained their respective requests, the Chairman of the Opposition Division drew the Proprietor's attention to document D6 and explained that this document appeared to disclose the product as claimed in Claim 1 of the contested patent. According to the minutes of the oral proceedings, this objection had not yet been raised by the Opponent but should be discussed within the meaning of Article 114 EPC. As further indicated in the minutes, the Proprietor was given time to deliberate this novelty objection, and thereafter, the Proprietor filed a new set of Claims 1 to 11 that replaced the set of claims as granted.
- V. By its decision announced orally on 23 July 2001 and issued in writing on 3 August 2001, the Opposition Division decided to maintain the patent on the basis of Claims 1 to 11 submitted during the oral proceedings of 23 July 2001. According to the decision, this set of claims was considered as the main request of the Proprietor, and the decision dealt only with this request.

VI. Notices of Appeal were filed

- (i) on 2 October 2001 by Appellant I (Opponent) with simultaneous payment of the prescribed fee; and
- (ii) on 10 October 2001 by Appellant II (Patent Proprietor) with simultaneous payment of the prescribed fee.

VII. In its Statement of Grounds of Appeal filed on 28 November 2001, Appellant I submitted that the opposed patent lacked novelty over document D6 and that the subject-matter of all the pending claims lacked inventive step in view of documents D1 to D7.

VIII. With its Statement of Grounds of Appeal filed on 7 December 2001, Appellant II submitted a set of 11 claims as main request. It also argued essentially as follows:

- (i) The decision of the Opposition Division incorrectly stated that the patent was maintained on the basis on the main request rather than an auxiliary request as was the case.
- (ii) The main request of the Proprietor had been maintenance of the patent as granted, and it had never been the intention of the Proprietor to abandon it.
- (iii) The Proprietor was confronted for the first time, at the commencement of the oral proceedings, with an objection of lack of novelty of granted

Claim 1 over document D6 raised by the Opposition Division.

- (iv) In preparing amendments in the relatively short time (about 30 minutes) allowed by the Opposition Division, the scope of Claim 1 was unintentionally restricted so as to exclude one of the preferred embodiments of the invention.
- (v) Thus, the Claim 1 of the annexed main request reintroduced specific poly(ethyleneoxy)ethyl acrylates in the definition of the hydrophobic surfactant monomer, which had been inadvertently omitted in the request presented at the oral proceedings before the Opposition Division.

IX. In its letter dated 9 April 2002, Appellant I contested the submission made by Appellant II in the Statement of Grounds of Appeal that it had never been the intention of the Proprietor to abandon the main request for the following reasons:

- (i) The Patentee had accepted the assessment of lack of novelty of the subject-matter of granted Claim 1.
- (ii) The Proprietor had proposed the amendment to the claims and had modified twice the formula set out in Claim 1 with the sole objective to get the amended claims granted.
- (iii) Thus, there was no option left to the Proprietor, but to abandon the novelty lacking granted Claim 1.

- X. In its letter dated 21 June 2002, Appellant II submitted that the subject-matter of the set of Claims 1 to 11 filed with the Statement of Grounds of Appeal was novel over document D6 and involved an inventive step in view of documents D1 to D7. It also argued that the objection of lack of novelty had been raised for the first time at the oral proceedings by the Opposition Division, and that, in the haste, it had submitted amendments to the claims which unintentionally excluded one of the preferred embodiments of the invention.
- XI. In a communication dated 18 December 2003, the Board took the provisional view that the Proprietor had been taken by surprise by this new objection of lack of novelty raised for the first time at the oral proceedings by the Opposition Division, and did not have a fair possibility during oral proceedings to prepare a proper defence against it, so that the requirements of Article 113(1) EPC could not be considered as having been complied with. The Board was thus of the provisional opinion that the decision of the Opposition Division should be set aside, that the case be remitted to the first instance with an order that the grounds of lack of novelty and lack of inventive step be examined, and that both appeal fees be refunded. Consequently, the Parties were invited to confirm or withdraw their respective requests for oral proceedings before the Board.
- XII. In its letter dated 7 April 2004, Appellant II withdrew its request for oral proceedings provided the case would be remitted to the Opposition Division.

XIII. Communications were issued by the Board on 24 September 2004 and on 2 December 2004, in response of letter of 12 July 2004 and of letter of 15 October 2004 of Appellant I, respectively.

XIV. Following the communication of the Board dated 2 December 2004 in which it reiterated its provisional view expressed in the communication dated 18 December 2003, Appellant II (in its letter dated 16 March 2005) confirmed, and Appellant I (in its letter dated 30 March 2005) indicated that they agreed that the case be remitted to the first instance with an order that the grounds of lack of novelty and lack of inventive step be examined, and that both appeal fees be refunded.

Reasons for the Decision

1. The appeal filed by the Opponent is admissible.
2. *Admissibility of the appeal filed by the Proprietor*
 - 2.1 As can be deduced from the minutes of the oral proceedings of 23 July 2001, the Opposition Division, at the commencement of the oral proceedings, introduced a new ground of opposition, i.e. an objection of lack of novelty of granted Claim 1 in view of document D6.
 - 2.2 While the Opposition Division was, according to Article 114(1) EPC, entitled to introduce a new ground of opposition at such a late stage of the proceedings, 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. On the contrary, the annex clearly stated that only inventive step would be discussed at the oral proceedings (cf. Section III, above).

2.3 Consequently, the Patent Proprietor was made aware of the factual and legal reasons supporting the introduction of this new ground of opposition for the first time at the beginning of the oral proceedings.

2.4 According to the decision T 1164/00 of 2 September 2003 (not published in OJ EPO, point 1.1 of the Reasons), 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 and 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.

2.5 Since in the present case it is evident (cf. in particular Sections III and IV, above), that the Patent Proprietor, not having been informed beforehand of such factual and legal reasons, was taken by surprise and did not have a fair possibility (cf. Section VIII, above) to prepare a proper defence against this new objection, the Board, in accordance with the principles set out in T 1164/00, comes to the conclusion that the requirements of Article 113(1) EPC have not been complied with.

- 2.6 Since this requirement has not been complied with, the Opposition Division committed a substantial procedural violation.
- 2.7 It was, furthermore, under the adverse circumstances created by this substantial procedural violation (see Section X, above) that the Proprietor submitted a restricted set of claims. In other words, the substantial procedural violation caused the Proprietor to submit the restricted set of claims.
- 2.8 In the light of the above finding, the question of whether the filing of this amended set of claims was indeed accompanied or not by the abandonment of the request of maintenance of the claims as granted (Sections VIII and IX, above) is immaterial to the question of whether the Proprietor was adversely affected by the decision under appeal.
- 2.9 This is because, having regard to the substantial procedural violation, the Proprietor was in any case adversely affected by the decision of the Opposition Division to maintain the patent on the basis of Claims 1 to 11 submitted at the oral proceedings for the following reasons:
- (i) should the Proprietor have abandoned the claims as granted (as could be implied by the term "replaced" used in the minutes of the oral proceedings), it was the substantial procedural violation which caused the Proprietor to abandon this request covering broader subject-matter, so that it would be adversely affected by the

decision of the Opposition Division for the purposes of Article 107 EPC (cf. also T 506/91 of 3 April 1992 (not published in OJ EPO; Reasons point 2.8),

and

- (ii) should the Proprietor not have abandoned the claims as granted (as submitted by the Patent Proprietor) in the Statement of Grounds of Appeal), it would be in any case be adversely affected by the decision of the Opposition Division not to grant his main request.

- 2.10 Thus, there is no necessity for the Board to investigate whether the filing of this amended set of claims was indeed accompanied or not by the abandonment of the request of maintenance of the claims as granted. On the contrary, it follows from the nature of the substantial procedural violation that the appeal of the Proprietor must be considered as admissible.
- 3. This substantial procedural violation justifies setting aside the decision of the Opposition Division and the remittal of the case to the first instance.
- 4. Since the appeal of the Proprietor is successful to the extent that the decision under appeal is to be set aside and since, in view of the foregoing, reimbursement of the appeal fee is equitable because of a substantial procedural violation, the requirements of Rule 67 EPC are met and the appeal fee should be reimbursed to the Patentee (Rule 67 EPC). The reimbursement of the appeal fee of the Opponent shall

also be ordered, since its case cannot be heard in view of this substantial procedural violation (cf. also T 552/97 of 4 November 1997 (not published in OJ EPO); Reasons, point 6).

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis of Claims 1 to 11 submitted by the Patent Proprietor with its Statement of Grounds of Appeal filed on 7 December 2001 in relation to the grounds of lack of novelty and lack of inventive step.
3. The reimbursement of the appeal fee of both the Patent Proprietor and the Opponent is ordered.

The Registrar:

The Chairman:

E. Görgmaier

R. Young