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**Datasheet for the decision
of 19 October 2006**

Case Number: T 0724/03 - 3.3.09

Application Number: 93306378.6

Publication Number: 0583169

IPC: C08J 5/18

Language of the proceedings: EN

Title of invention:

Biaxially oriented film

Patentee:

TORAY INDUSTRIES, INC.

Opponent:

Teijin Limited

Headword:

-

Relevant legal provisions:

EPC Art. 123, 114, 111(1)

Keyword:

"Disclaimer - no technical contribution"

"Document not admitted by Opposition Division - admitted"

"Remittal - yes"

Decisions cited:

G 0001/99, G 0001/03, G 0009/92, T 1002/92, T 0326/87

Catchword:

-



Case Number: T 0724/03 - 3.3.09

DECISION
of the Technical Board of Appeal 3.3.09
of 19 October 2006

Appellant:
(Opponent)

Teijin Limited
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Respondent:
(Patent Proprietor)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
9 May 2003 concerning maintenance of European
patent No. 0583169 in amended form.

Composition of the Board:

Chairman: P. Kitzmantel
Members: J. Jardón Álvarez
K. Garnett

Summary of Facts and Submissions

I. The grant of European patent No. 0 583 169 in respect of European patent application No. 93306378.6 in the name of TORAY INDUSTRIES, INC., which had been filed on 12 August 1993, was announced on 5 January 2000 (Bulletin 2000/01) on the basis of 18 claims. Claim 1 read as follows:

"1. A biaxially oriented film containing organic particles, which organic particles

- (a) are crosslinked polymer particles having a degree of crosslinking not less than 60%;
- (b) have a strength when deformed by 10% (S_{10}) which is in the range of 29 to 294 MPa (3 to 30 kgf/mm²);
- (c) have a thermal decomposition temperature, for causing 10% loss in weight, not lower than 350°C;
- (d) have a weight average diameter in the range of 0.005 to 5 µm; and
- (e) are present in a content of 0.001 to 20% by weight, based on the total weight of the film; and

which biaxially oriented film is other than a film of Comparative Example 4 of EP - A - 0 546 184."

II. A Notice of Opposition was filed against the patent by Teijin Limited on 5 October 2000. The Opponent requested the revocation of the patent in its full scope based on Article 100(a) EPC, due to lack of novelty and inventive step, and on Article 100(c) EPC,

because the subject-matter of the patent extended beyond the content of the application as filed.

With the Notice of Opposition, the Opponent filed fourteen documents, D1 - D14, in support of its arguments. In addition to these documents, the Opponent filed the following documents with letters dated 14 September 2001 and 13 January 2003, and thus after the nine-month opposition period:

D15: EP - A - 0 546 184;

D16: EP - A - 0 401 689 and

D17: EP - A - 0 502 745.

On 3 March 2003, eight days before the oral proceedings before the Opposition Division, the Opponent filed the following further documents and experimental evidence:

D19: EP - A - 0 577 846 (English equivalent of D19A);

D19A:WO - A - 93/15145 (in Japanese);

D20: Experimental Report; example 1 of D19/D19A;

D21: JP - A - 4-309 554;

D21A:Partial English language translation of D21;

D22: JP - A - 5-84819; and

D22A:Partial English language translation of D22.

III. By its interlocutory decision announced orally on 11 March 2003 and issued in writing on 9 May 2003, the Opposition Division decided that the patent as amended in accordance with Claims 1 to 16 as filed during the oral proceedings met the requirements of the EPC.

The Opposition Division decided not to admit into the proceedings the documents D19, D19A, D20, D21, D21A, D22 and D22A. The reason for the non-admission was that D21/D21A and D22/D22A were considered less relevant than the documents already on file and D19/D19A, having been filed at a very late stage without any convincing reason for this, was considered *prima facie* not sufficiently relevant to be admitted.

As to the merits of the case, the Opposition Division held that the claimed subject-matter was novel having regard to the disclosure of D15, because this document did not disclose the use of cross-linked polymer particles having a degree of cross-linking of not less than 60% in combination with agglomerated particles having a primary particle diameter of 5 to 150 nm. In view of these distinguishing features, the claimed subject-matter was also considered inventive over the closest prior art D15, because none of the citations suggested the claimed solution of the existing technical problem, namely the provision of a biaxially oriented film with improved abrasion resistance and improved scratch resistance at high running speed on a magnetic surface coating.

The decision of the Opposition Division was based on a first set of requests including a main request filed during the oral proceedings and four auxiliary requests

filed, in a retyped version, with a letter dated 3 March 2003. The Patent Proprietor also filed during the oral proceedings a second set of requests including a further main request, based on the patent in the form as granted and six auxiliary requests. This second set of requests was to replace the first set in the event that the Opposition Division did not disregard the late filed documents D19 to D22A.

As pointed out above, the Opposition Division did not admit D19 to D22A into the proceedings and took its decision on the first set of requests. Claim 1 of the main request in the version as maintained by the Opposition Division read as follows:

"1. A biaxially oriented film containing organic particles, which organic particles

- (a) are crosslinked polymer particles having a degree of crosslinking not less than 60%;
- (b) have a strength when deformed by 10% (S_{10}) which is in the range of 29 to 294 MPa (3 to 30 kgf/mm²);
- (c) have a thermal decomposition temperature, for causing 10% loss in weight, not lower than 350 °C;
- (d) have a weight average diameter in the range of 0.005 to 5 µm; and
- (e) are present in a content of 0.001 to 20% by weight, based on the total weight of the film; and

which biaxially oriented film

- (f) contains particles other than the said organic particles, which other particles are

agglomerated particles each having a primary particle diameter of 5 to 150 nm; and (g) is other than a film of Comparative Example 4 of EP - A - 0 546 184."

IV. On 4 July 2003 the Opponent (Appellant) lodged an appeal against the decision of the Opposition Division and paid the appeal fee on the same day.

In the Statement of Grounds of Appeal filed on 15 September 2003, the Appellant requested the revocation of the patent in its entirety on the grounds of added subject-matter, lack of novelty and lack of inventive step.

The Appellant considered that the decision of the Opposition Division not to admit document D19 into the proceedings was flawed. The Appellant also filed two further experimental reports:

D23: Experimental Report I. Reworking of example 20 of D19;

D24: Experimental Report II. Evidence showing the inter-relationship between the degree of cross-linking, the S_{10} value and the thermal decomposition temperature of four polydivinylbenzene particles.

This evidence was filed to support the arguments concerning the objection of lack of novelty having regard to document D19.

By letter dated 15 September 2006, the Appellant gave reasons for the late filing of documents during the opposition proceedings and pointed out that D19 was filed during the opposition proceedings at the earliest opportunity, namely shortly after the filing by the Patentee of further experimental evidence.

- V. With its letters of response dated 30 January 2004, 18 September 2006 and 5 October 2006, the Respondent (Patent Proprietor) requested that the appeal be rejected, that documents D19 to D22A be not admitted into the proceedings and that, in the event that D19 was admitted into the proceedings, the case be remitted to the Opposition Division for further prosecution.

The Respondent requested auxiliary that if D19 was admitted into the proceedings, the Respondent be allowed to file broader claims than those allowed by the Opposition Division, in particular it should be permitted to revert to the granted claims in order to regain the entitlement to the earliest priority date claimed - lost by the amendment of the claims underlying the decision under appeal - even if such broader claims were contrary to the principle of "*reformatio in peius*" as laid down in G 09/92 (OJ EPO 1994, 875).

The Respondent requested further auxiliary that two questions be referred to the Enlarged Board of Appeal concerning the principle of *reformatio in peius*. The questions reading as follows:

Question 1: "According to G01/99 (OJ EPO 2001, 381), an exception to the principle of *reformatio in peius* may

be made in order to meet an objection put forward by the opponent/appellant or the Board during the appeal proceedings, in circumstances where the patent as maintained in amended form would otherwise have to be revoked as a direct consequence of an inadmissible amendment held allowable by the Opposition Division in its interlocutory decision. Does this apply where the amendment is a disclaimer held allowable by the Opposition Division at least when the interlocutory decision [had been] issued before issuance of decision G01/03 (OJ EPO 2004, 413)?"

Question 2: "In the event that a Board of Appeal should overturn a decision of the Opposition Division not to admit a late filed document into the proceedings, is it ever permissible for the Appeal Board to allow the patentee on appeal to return to broader claims which could have been submitted before the Opposition Division?"

VI. The arguments presented by the Appellant in its written submissions and at the oral proceedings held on 19 October 2006 may be summarized as follows:

- Claim 1 contravened Article 123(2) EPC because a disclaimer was only allowable if the cited document containing the prior disclosure had no relevance for further examination of the claimed invention. In the present case, as the patent was no longer entitled to its earliest priority date, document D15 was relevant not only with regard to novelty but also with regard to inventive step and its overlapping disclosure could therefore not be excluded by means

of a disclaimer without any basis in the application as originally filed.

- The Appellant further argued that the Opposition Division's decision not to admit D19 was flawed because its disclosure was highly relevant and even novelty destroying for the claimed subject-matter.

- Document D19, although relatively late filed, was actually filed at the earliest opportunity because (i) its relevance could not have been appreciated before the Patent Proprietor amended the claims and thereby lost the priority entitlement and (ii) the potential need for this document only became apparent after the filing on 10th January 2003 of an Experimental Report by the Patentee. Moreover D19 could not have come as a surprise to the Patentee as it was a document from the Patentee itself.

- Concerning the relevance of D19, the Appellant argued that this document disclosed biaxially oriented films comprising alumina particles, as per feature (f) of the claims, and further comprising cross-linked polymeric particles which displayed features (a) to (e). Although D19 did not explicitly disclose preferred generic ranges for the S_{10} values, this feature was implicit, because there were very sound technical reasons for believing that the S_{10} requirement was met by the particles of Example 20 of D19. He also filed experimental evidence, D23, to finally confirm this lack of novelty objection.

- In any event, the claimed invention was not inventive either over D19 alone, or over D19 in combination with D15 or D22, or over a combination of D17 with D22.
- VII. The arguments presented by the Respondent in its written submissions and at the oral proceedings may be summarized as follows:
- The Respondent argued that the presence in Claim 1 of the disclaimer relying on comparative example 4 of D15 was not objectionable under Article 123(2) EPC because the additional feature (feature (f) of Claim 1) added to the claim during the opposition proceedings rendered the disclaimer redundant. It argued further that D15, although lying in the same technical field, actually taught away from the invention because the (disclaimed) overlapping disclosure was part of a comparative example representing an accidental anticipation beyond the inventive concept of D15, thus not preventing its exclusion in the form of a disclaimer (cf. Headnote 2.1 of G 1/03).
 - The admission of D19 into the appeal proceedings could hardly be reconciled with the contrary decision of the Opposition Division, which was fully justified, and would create a totally new opposition at this late stage. If D19 was nevertheless admitted, the case should be remitted to the Opposition Division. In any event, if D19 was admitted, the Respondent should be allowed to revert to the claims as granted in order to regain the priority entitlement lost by the amendment made before the

Opposition Division. This was not at variance with the concept of *reformatio in peius*, because G 9/92 left some margin of flexibility and did not prohibit amendments which, in the circumstances, were appropriate and necessary.

- As to the merits of D19, the Respondent pointed out that the S_{10} parameter was not mentioned at all in D19. He also contested the relevance of the experimental evidence, D23. D19 in fact disclosed five different polymerization processes for the preparation of the crosslinked polymer particles and the S_{10} values respectively obtained would depend on the polymerization process and the polymerization conditions. The Appellant had intentionally chosen from the host of possibilities for its experimental report such polymerization conditions as would give a S_{10} value falling within the scope of the patent in suit. This was far from meeting the strict requirement for a novelty destroying disclosure to be directly and unambiguously derivable from the prior art.

VIII. The Appellant requested that:

- the decision under appeal be set aside;
- the documents whose admission into the proceedings had been denied by the Opposition Division, in particular D19 and D22, should be admitted into the proceedings, as well as the newly filed experimental reports D23 and D24; and
- the European patent No. 0 583 169 be revoked.

IX. The Respondent requested that:

- the appeal be dismissed;
- none of the documents whose admission had been denied by the Opposition Division, in particular D19 and D22, nor D23 or D24, should be admitted at this stage into the proceedings;
- in the event that D19 was admitted, the case be remitted to the Opposition Division, and/or the Set of Requests 2, filed with the letter dated 18 September 2006 be admitted for consideration; and
- auxiliary, the Set of Requests 1, filed with letter dated 18 September 2006 be admitted in amended form according to one of the sets of claims therein comprised.

Reasons for the Decision

1. The appeal is admissible.
2. *Amendments (Article 123 EPC)*
 - 2.1 Claim 1 of the granted patent comprises the statement "which biaxially oriented film is other than a film of comparative Example 4 of EP - A - 0 546 184". This disclaimer had been added during the examination proceedings in order to prevent an otherwise novelty

destroying overlap with this EP patent (D15 in the present proceedings).

2.2 Claim 1 of the granted patent had a valid priority date of 12 August 1992 (P1) and document D15, published on 15 October 1992, was thus to be considered as state of the art under Article 54(3) and (4) EPC.

2.3 During the opposition proceedings, the Patent Proprietor amended Claim 1 to include the feature of granted Claim 4. As a consequence, the amended Claim 1 was no longer entitled to the above priority date P1 but could only rely on the filing date of the application, 12 August 1993, as the effective date for this amended Claim 1. Document D15 thus became state of the art under Article 54(2) EPC for the subject-matter of amended Claim 1. Since it concerned very closely related polyester films, it was considered by the Opposition Division as highly relevant prior art and not as a purely accidental anticipation allowing exclusion by means of a disclaimer without contravention of Article 123(2) EPC as defined in G 1/03 (OJ EPO 2005, 344; point 2.2.2 of the reasons).

2.4 Notwithstanding this, the Board concludes that the disclaimer does not infringe Article 123(2) EPC for the following reasons:

2.4.1 As explained under 2.1 above, the disclaimer had been introduced as an amendment during the examination proceedings. According to decision G 1/99 (OJ 2001, 381), a claim comprising an inadmissible amendment can still be rescued by introducing one or more originally disclosed features which limit the scope of the patent

as maintained, rendering the otherwise inadmissible amendment redundant.

2.4.2 This situation applies in the present case. The feature introduced into Claim 1, namely the requirement that the biaxially oriented film contains further agglomerated particles having a primary particle diameter of 5 to 150 nm, feature (f), limits the scope of the granted claim and ensures that the film of comparative example 4 of D15 is no longer comprised by the claimed subject-matter because the film of this example does not contain such agglomerated particles.

2.4.3 Under these circumstances, the disclaimer merely excludes subject-matter which is in any case already excluded from the scope of the claim by virtue of the further amendment and the disclaimer does not therefore provide any technical contribution.

2.4.4 The (superfluous) presence of the disclaimer in the claim does not therefore contravene Article 123(2) EPC. This finding is confirmed by the fact that the deletion of the disclaimer would not modify the scope of the claim.

2.5 Concerning Article 123(3), it is not disputed that the amendment made to the claims during the opposition proceedings, namely the introduction of the features of Claim 4 into Claim 1, restricts the scope of Claim 1.

The subject-matter of the claims therefore also meets the requirements of Article 123(3) EPC.

3. *Documents not submitted in due time (Article 114 EPC)*
- 3.1 Documents D15 - D17, D19 - D22 (and its respective English translations), as well as documents D23 and D24, were not submitted during the nine month period allowed for opposition pursuant to Article 99(1) EPC and to this extent must be regarded as not submitted in due time under Article 114(2) EPC. Nevertheless, it is within the discretion of the deciding organ of the European Patent Office under Article 114(1) to consider whether the documents are of such relevance as to justify their admission to the proceedings at a later stage.
- 3.2 The Opposition Division considered documents D15, D16 and D17 as sufficiently relevant for the claimed subject-matter and decided to admit them into the proceedings. This decision has not been disputed by the Respondent and the Board thus considers these documents as admitted into the opposition proceedings.
- 3.3 On the other hand, the Opposition Division decided not to admit documents D19 - D22 into the proceedings. The reason for the non-admissibility was that the Opposition Division considered documents D21 and D22 as being less relevant than the documents already on file. Concerning D19 (and the Experimental report D20), the Opposition Division stated that it could not be considered as *prima facie* relevant due to the absence of a disclosure in D19 of feature (b) of Claim 1 of the patent in suit, i.e. the strength (S_{10}) of the particles when deformed by 10%. The Opposition Division did not find the arguments of the Appellant concerning the implicit disclosure of this parameter convincing. The

Opposition Division further considered that the late filing, shortly before the oral proceedings, without any plausible excuse for such late filing, put an undue burden on the other party and decided not to admit D19 and D20 into the proceedings.

3.4 The Appellant filed with its Statement of Grounds of Appeal further experimental evidence, D23 and D24, in order to support its previous arguments. The Appellant argued that, at least in the light of this new information, the decision not to admit D19 and D22 into the proceedings should not be upheld.

3.5 According to the case law of the Boards of Appeal, the decision whether or not a late filed document should be admitted into the proceedings falls under the discretion of the deciding body. This discretion is to be exercised having regard to *inter alia* the stage of the proceedings, the degree of relevance of the document and whether the party attempting to introduce it has acted in good faith.

3.6 The Respondent argued that the late filing of D19 - D22, shortly before the oral proceedings before the Opposition Division and after the previous late filing of other prior art documents, showed a piecemeal development of the case by the Appellant which amounted to a procedural abuse.

3.6.1 The Board cannot accept this argument of the Respondent. It is true that these documents were filed more than two years after the filing of amended claims by the Respondent (a time lapse, in the Respondent's view, showing an inexcusable negligence on the part of the

Appellant), but they were filed only shortly after the filing of further experimental evidence by the Respondent. While the late filing of a document is always regrettable as it can result in an unnecessary delay and further costs for the other party in the preparation of its case, in the present case the Board sees no evidence for an intentional protracting of the opposition proceedings which would imply a procedural abuse. D19 is a document published after the (then valid) priority date P1 of the patent in suit and as such a prior art not suitable for attacking Claim 1 of the patent as granted. The Appellant had, however, overlooked that Claim 4 of the patent did not enjoy the claimed priority date P1 and that D19 was therefore relevant for said claim. Only the introduction of Claim 4 into Claim 1, entailing the loss of the priority entitlement P1, made D19 a relevant document for the subject-matter of the thus amended main claim.

3.6.2 For these reasons the Board sees no reason to believe that the Appellant deliberately withheld these documents for tactical reasons, such as would amount to an abuse of procedure.

3.7 In absence of an abuse of procedure, the admission of the documents D19 to D22 depends mainly on their relevance and the stage of the proceedings at which they were submitted. As to the degree of relevance required for a document to be admitted into the proceedings at a late stage, in accordance with the established case law of the Boards of Appeal such material should be *prima facie* highly relevant in the sense that it can reasonably be expected to change the eventual result and is thus highly likely to prejudice

the maintenance of the European patent (see e.g. T 1002/92, OJ EPO 1995, 605, Reasons, point 3.4).

3.8 Admissibility of D19 and D23

- 3.8.1 As pointed out in the decision of the Opposition Division and not disputed by the Parties, D19 explicitly discloses features (a), (c), (d), (e) and (f) of Claim 1, but is silent about feature (b).

The decisive issue for the question whether document D19 is sufficiently relevant to justify its admission at a late stage is thus the correctness of the Appellant's contention that, although not part of D19's explicit disclosure, feature (b) is nevertheless implicitly disclosed.

- 3.8.2 Feature (b), the S_{10} value, relates to the strength of the crosslinked organic polymeric particles when deformed by 10% and which must be in the range of 3 to 30 kgf/mm² (29.4 to 294 MPa). It is thus an index representing the hardness of the particles (see [0024] to [0029] of the specification).

The Appellant tried to establish before the Opposition Division that D19 implicitly disclosed this feature. It compared example 20 of D19 with example 26 of the opposed patent and argued that the respective divinylbenzene- and ethylvinylbenzene-comprising particles having a degree of cross-linking of 80% and having respectively a mean diameter of 0.43 μm and 0,45 μm must have the same S_{10} value, namely 7.5 kgf/mm². It supported this conclusion by pointing out that according to the measurement method given at paragraph

[0029] of the specification, the slight difference in the mean diameters would have no effect on the S_{10} value.

3.8.3 The Opposition Division considered that the comparison was not a valid one, because the particles compared were not identical, the particles of example 20 of D19 being surface-modified by a sodium carboxylate functional group, whereas the particles of example 26 of the patent were not modified at the surface. Consequently, the Opposition Division did not consider D19 as a document implicitly disclosing feature (b) of Claim 1 and, also taking into account that it had been filed at a very late stage where it was hardly possible for the Patent Proprietor to react appropriately, decided not to admit it into the proceedings.

3.8.4 The Appellant in its Statement of Grounds of Appeal insisted on the relevance of D19. In addition to the theoretical considerations for saying that the S_{10} requirement was implicitly met by the particles of example 20 of D19, the Appellant submitted a reworking of example 20 of D19 comprising actual measurements of the S_{10} value of the crosslinked polymer particles. This value was reported to be 7.8 kgf/mm^2 for the particles of example 20 of D19 (see Table 1 of D23), thus confirming the Appellant's theoretical analysis concerning the S_{10} value.

Taking account of this experimental evidence, the Board does not need to comment on the concerns of the Opposition Division regarding the influence of the surface treatment on the S_{10} value of the polymer particles.

- 3.8.5 The Board does not share the doubts of the Respondent concerning the reworking conditions of example 20 of D19, which the Respondent said had been unfairly chosen by the Appellant with the intention of achieving the desired hardness of the particles.

While there is some truth in the argument that varying the polymerisation conditions (temperature, time, etc) might have some impact on the resulting polymerisate, the by far most important factor for the hardness property of the polymer particles - and it is this property which is reflected by the S_{10} value (see [0025] of the specification) - is the kind of the monomer components and the amount of the cross linking agent. In this respect the Appellant's reworking did not deviate from example 20 of D19. Moreover, the polymerisation conditions chosen do not differ from what the skilled practitioner would consider an appropriate choice, an approach conforming to the teaching of the patent in suit, which is silent on any special measures to be respected in order to attain the desired S_{10} values. There is therefore no reason to question the experimental evidence submitted by the Appellant.

- 3.8.6 The decision of the Opposition Division concerning the non-admittance of D19 was *inter alia* based on the assumption that this document was not sufficiently relevant because the S_{10} requirement (feature (b) of Claim 1) was not proven to be fulfilled by the Appellant.

Since, as explained above, D19 in combination with the further experimental evidence D23 shows that this

assumption is no longer valid, it follows that D19 is *prima facie* highly relevant in the sense that its introduction into the proceedings is highly likely to prejudice the maintenance of the European patent in the form as maintained by the Opposition Division. Accordingly, the Board decides to introduce this document, together with the experimental report D23, into the proceedings under Article 114(1) EPC.

3.9 Admissibility of D24

Document D24 is a further experimental report made by the Appellant for the purpose of clarification of the interrelation between the degree of cross-linking, the S_{10} value and the thermal decomposition temperature. It shows that the S_{10} value and the thermal decomposition temperature of several divinylbenzene/ethylbenzene crosslinked particles increase as the degree of cross-linking increases.

This document supports further the theoretical arguments made by the Appellant concerning D19, but it is not more relevant than document D23 discussed above and consequently the Board decided not to admit it into the proceedings.

3.10 Admissibility of D22

3.10.1 D22 was not admitted into the proceedings by the Opposition Division because it was considered less relevant than the documents already on file (D15).

D22 discloses biaxially oriented laminated films comprising features (a) to (e) of Claim 1 of the patent,

but it is silent about the use of agglomerated particles other than the organic particles (feature (f)).

3.10.2 The Appellant requested the introduction of this document into the proceedings in connection with the degree of cross linking of the polymer particles, feature (a) of Claim 1. D22 specifically discloses organic particles having a degree of cross-linking of 60% [0014], while in D15 a generic disclosure having no upper limit for this feature is mentioned and the highest specified value is 50% (D15, page 5, lines 48 - 51). The Board notes, however, that the preferred degree of cross-linking in D22 is lower than 60% and considers that D22 is not of such relevance that its introduction would be highly likely to prejudice the maintenance of the patent.

3.10.3 The Board accordingly concludes that D22 is not so relevant as to justify its admission into the proceedings at this stage.

4. *Remittal (Article 111(1) EPC)*

4.1 After admitting the documents D19 and D23 into the proceedings, the Board has to consider its discretion under Article 111(1) EPC to remit the case to the Opposition Division for further prosecution, as requested by the Respondent.

4.2 It is established jurisprudence of the Boards of Appeal that any necessary fresh assessment of a case should normally be carried out at the first level (cf. T 326/87, OJ EPO 1992, 522, point 2.2). This is

especially so when, as in the present case, having regard to the high degree of relevance of the late-filed documents, the maintenance of the patent in suit would be at risk. In such a situation, further examination should be undertaken by the Opposition Division so as to afford the parties two levels of jurisdiction, all the more so when, as in the present case, the Respondent has expressly asked for this and the Appellant has not objected to such remittal.

- 4.3 Accordingly, the Board decides that it is appropriate to remit the case to the Opposition Division for further consideration.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. D19 and D23 are admitted into the proceedings.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar

The Chairman

D. Sauter

P. Kitzmantel