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D E C I S I O N
of 19 July 2005

Case Number: T 0782/04 - 3.2.2

Application Number: 92916254.3

Publication Number: 0595967

IPC: A61B 18/00

Language of the proceedings: EN

Title of invention:
Surgical coagulation device

Patentee:
CANADY, Jerome

Opponent:
Erbe Elektromedizin GmbH

Interveners:
KeyMed (Medical & Industrial Equipment) Limited
ERBE Medical UK Limited

Headword:
-

Relevant legal provisions:
EPC R. 56

Keyword:
"Admissibility of the opposition (yes)"
"Reimbursement of the appeal fee (yes)"

Decisions cited:
T 0222/85, T 0204/91, T 0925/91, T 0199/92, T 0522/94,
T 1069/96, T 0934/99, G 0001/94

Catchword:
-



Case Number: T 0782/04 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 19 July 2005

Appellant:
(Opponent)

Erbe Elektromedizin GmbH
Waldhörnlestr. 17
D-72072 Tübingen (DE)

Representative:

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Meissner, Bolte & Partner
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Intervener I:

KeyMed (Medical and Industrial Equipment)
Limited
KeyMed House
Stock Road
Southend on Sea
Essex SS2 5QH (GB)

Representative:

Alan Johnson
Bristows
3 Lincoln's Inn Fields
London W1H 4EE (GB)

Intervener II:

ERBE Medical UK Limited
The Antler Complex
2 Bruntcliffe Way
Morley
Leeds LS27 0JG (GB)

Representative:

Dr. Johannes Bohnenberger
Meissner, Bolte & Partner GbR
Widenmeyerstrasse 48
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Respondent: CANADY, Jerome
(Proprietor of the patent) 4000 16th Street, N.W.
Washington D.C. 20011 (US)

Representative: von Föner, Nicolai, Dr.
v. Föner Ebbinghaus Finck Hano
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 April 2004
rejecting the opposition filed against European
patent No. 0595967 as inadmissible pursuant to
Rule 56(1) EPC.

Composition of the Board:

Chairman: T. Kriner
Members: D. Valle
A. Pignatelli

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal on 14 June 2004 against the decision of the opposition division posted on 6 April 2004 to reject the opposition against the European patent EP-B-595 967 as inadmissible. The fee for the appeal was paid simultaneously and the statement setting out the grounds for appeal was received on 2 August 2004.
- II. The Opposition division held that the opposition was not admissible since no unambiguous proof was given before the expiry of the opposition period that the brochure
- D3 = Olympus Dyathermic Snare, prospectus
- was part of the prior art for the patent in suit.
- III. An intervention was lodged on behalf of KeyMed (Medical and Industrial Equipment)-Limited, KeyMed House, Stock Road, Southern-on-Sea, Essex (UK) (intervener I) with letter of 20 June 2005, received by fax on 21 June 2005, after the expiry of the opposition period and based on the fact that the patent proprietor instituted infringement proceedings against the intervener on 21 March 2005 before a UK court. A copy of the claim form was filed. An opposition and an appeal fee were paid on the same date.
- IV. A further intervention was lodged on behalf of ERBE Medical UK Limited, The Antler Complex, 2 Bruntcliffe Way, Morley, Leeds LS27 0JG, UK (intervener II) with letter of 20 June 2005, received on 21 June 2005 and

based on the fact that the patent proprietor instituted infringement proceedings against the intervener on 21 March 2005 before a UK court. A copy of the claim form was filed. An opposition fee was paid on the same date.

- V. Oral proceedings took place on 19 July 2005. As announced with letter of 15 July 2005, intervener I was not represented at the oral proceedings.

The written requests of the intervener I were that the patent be revoked, that the case be remitted to the first instance for further prosecution and the reimbursement of the appeal fee.

The appellant and the intervener II requested that the decision under appeal be set aside and that the case be remitted to the department of first instance for further prosecution. The appellant further requested the reimbursement of the appeal fee.

The respondent (patentee) requested that the appeal be dismissed and that the patent be maintained.

- VI. In support of their requests the appellant and the intervener II relied on the following submissions.

The rejection of the opposition as inadmissible constituted a substantial procedural violation. The inadmissibility of the opposition was based on the assertion that no unambiguous proof was given before the expiry of the opposition period that the brochure D3 was part of the prior art for the patent in suit. However, the question of proof did not affect the admissibility of the opposition, since for an

opposition to be admissible all that was required was that the notice of opposition contained a clear and plausible case for the objection raised against the patent in suit. This was the case here, since the notice of opposition and the form filled in by filing the opposition contained an indication that D3 was a publication which belonged to the state of the art and that it was relevant for assessing the inventive step of the patent in suit (see in particular points 4.2 and 4.2.2 of the notice of opposition). The common sense taught that it was highly probable that a brochure dated 1973 was published before the filing date of the patent in suit (1991). According to T 743/89, in order to decide the date of public availability of a document, the criterion of the balance of probabilities had to be used.

VII. The respondent disputed the views of the appellant. His arguments can be summarised as follows:

The decision under appeal was correct. The opponent in the previous proceedings never asserted that D3 was made available to the public before the filing date of the patent in suit. In order to consider an opposition as admissible it was necessary that the grounds brought forward by the opponent contained at least a hint that D3 belonged to the prior art for the patent in suit. The present case was exactly the same as the one dealt with in T 522/94 (see in particular headnotes 3 and 4, and point 27 of the grounds). There the opposition had been rejected as inadmissible since the opponent simply cited two booklets - one of them dated - in support of a prior use without any indication of facts, evidence or arguments as to whether they were published at all

or when, where and to whom they were shown or handed over.

Reasons for the Decision

1. The appeal is admissible according to Article 108 and Rule 65 EPC.
2. The interventions of KeyMed Ltd and Erbe Medical UK are admissible under Article 105 EPC because infringement proceedings have been instituted by the patent proprietor against them, the interventions have been filed within three months of the date on which the infringement proceedings were instituted and the opposition fee has been paid by both interveners within the same time limit. An intervention during appeal proceedings is admissible according to decision G 1/94 (OJ EPO 1994, 787).
3. The decision under appeal considered that the opposition was inadmissible as no unambiguous proof was given that one of the cited brochures(D3) was made available to the public before the priority date.
 - 3.1 A notice of opposition is to be rejected as inadmissible pursuant to Rule 56(1) EPC if it does not comply with the provisions of Article 99(1), Rule 1(1) and Rule 55(c) EPC.

Under Article 99 together with Rule 55(c) EPC the notice of opposition shall contain three items: (a) the extent to which the European patent is opposed, (b) the grounds on which the opposition is based and (c) an

indication of the facts, evidence and arguments presented in support of these grounds.

As to the third requirement of Rule 55 EPC, an established jurisprudence exists according to which this requirement is satisfied if the content of the notice of opposition was sufficient for the opponent's case to be properly understood on an objective basis (T 222/85 (OJ EPO 1988, 128)). In decision T 925/91 (OJ EPO 1995, 469), the board confirmed this view and added that whether the opponent's case could be understood had to be assessed from the point of view of a reasonably skilled person in the art. According to T 199/92 and T 934/99 a certain amount of interpretation when reading the notice of opposition is not excluded. In T 204/91, the board stated that the indication needed to be such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent. According to decision T 1069/96, Rule 55(c) EPC does not prescribe such a "complete" indication as to permit a conclusive examination on that basis alone.

It follows from this jurisprudence that the examination of the admissibility of the notice of opposition consists in evaluating whether the allegations of the opponent, if they are taken as proven, and under application of the criteria set out by the jurisprudence and cited above constitute a proper attack on the patent. If this is the case, the notice of opposition is substantiated and admissible.

In contrast, the examination of whether the allegations are true is a question of evidence that is part of the examination of the allowability of the opposition.

3.2 These criteria are to be applied to the notice of opposition in suit.

In this notice, the opponent argued that the invention was obvious in view of the documents D1, D2 and D3 which belonged to the state of the art. Furthermore, the opponent explained why the invention was obvious in view of D1 and D3.

The notice thus includes a statement

- (i) of the extent to which the European patent is opposed, namely the whole patent,
- (ii) which contains the ground on which the opposition is based, namely inventive step and
- (iii) an indication of the facts and evidence in support of these grounds, namely the fact that documents existed (D1 to D3) in the state of the art (date of the documents) which suggested to the person skilled in the art a teaching from which he could obviously arrive at the invention.

Therefore, the statement of the respondent that the opponent in the previous proceedings never asserted that D3 was made available to the public before the filing date of the patent in suit is not supported by the facts.

The documents were filed (evidence), the reasoning was technical in character and understandable by a person skilled in the art so that, if it is assumed that the alleged facts are true,

- (i) they form an objective basis for the opponent's case,
- (ii) which can be understood from the point of view of a person reasonably skilled in the art,
- (iii) the indication was such as to enable the patentee and the opposition division to see clearly just what attack was being mounted against the patent.

All requirements of Article 99(1) together with Rule 55(c) EPC are fulfilled by the notice of opposition in suit.

The decision under appeal was therefore wrong in refusing the opposition as inadmissible on the basis that no unambiguous proof was given that D3 was made available to the public before the priority date. If the opposition division has doubts about the truth of a statement made by the parties, it has to apply the law of evidence and establish the facts. This activity is part of the examination of the allowability of the opposition.

4. The respondent did not contest that the case was understandable (he could hardly do so since in his answer to the notice of opposition he dealt with the reasoning of the opposition) but he was of the opinion that for an opposition to be admissible, the

availability to the public of all documents cited had to be completely proved in the notice of opposition. He based this assumption on decision T 522/94 (OJ EPO 1998, 421).

In proceedings T 522/94, the opposition was based on a prior use. In order to substantiate the prior use, i.e. to describe the content and the circumstances of this prior use, two booklets were referred to, whereby one of them did not bear any date and the other one was dated, but it was not clearly linked to the object which was pretended to have been made available.

The board held that the party alleging prior use did not produce a case sufficiently detailed (i.e. details about what, where, under which circumstances, in particular to whom the alleged prior use was made available to the public) to substantiate its allegations. That made it impossible for the patentee to understand and reply to the points made against him.

Such detail is, however, not required in cases as the present one where the opposition is based solely on the content of a document which bears a date and is immediately available to the patentee. The ratio of T 522/94 can therefore not be applied to this case and there are thus no further requirements for admissibility of the opposition in the present case.

Even if such further requirements were necessary, this would be the case here since the mere submission of the dated document D3 as relevant document of the state of the art was sufficient to present a clear and proper case and therefore for the opposition to be allowable. The respondent has to apply a reasonable amount of

understanding by reading the notice of opposition as required by the jurisprudence (see above). D3 is a brochure produced by a company to illustrate a product to potential costumers. It bears the notice "printed in Japan 73", whereas the priority date of the patent in suit is 14 July 1991, that is ca. 18 years later. That means that the person looking at D3 understands that such brochure is made to be distributed to the specialized public and it becomes available to the public, as a rule, a reasonably short period after the printing date.

5. The opposition division did not apply the rules of proceedings in the manner prescribed by the EPC insofar as it misinterpreted the meaning of Article 99(1) together with Rule 55(c) EPC.

This represents a procedural violation which had a major influence on the proceedings and is therefore substantial.

6. Since the appeal is allowable all the requirements of Rule 67 EPC are satisfied.
7. The appeal fee paid by the appellant and by intervener I have to be reimbursed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The requests for reimbursement of the appeal fee are allowed.

The Registrar:

The Chairman:

G. Magouliotis

T. Kriner