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**Datasheet for the decision
of 21 November 2008**

Case Number: T 0931/06 - 3.4.01

Application Number: 97921189.3

Publication Number: 0894312

IPC: G06K 19/06

Language of the proceedings: EN

Title of invention:

System and apparatus for smart card personalization

Patentee:

Ubiq Incorporated

Opponent:

GIESECKE & DEVRIENT GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 111(1), 104(1)

Relevant legal provisions (EPC 1973):

EPC Art. 100(a), 100(b), 56, 83, 114(2)

RPBA Art. 12(2)

EPC R. 27(1)(c), (e)

Keyword:

"Disclosure - sufficiency (yes)"

"Late-submitted material - admitted (yes)"

"Decision - remittal (yes)"

"Costs - apportionment - equity (yes)"

Decisions cited:

T 0860/93, T 1002/92, T 0097/90, T 0212/91, T 0633/97,
T 0874/03

Catchword:

-



Case Number: T 0931/06 - 3.4.01

D E C I S I O N
of the Technical Board of Appeal 3.4.01
of 21 November 2008

Appellant: GIESECKE & DEVRIENT GmbH
(Opponent) Prinzregentenstr. 159
D-81677 München (DE)

Representative: -

Respondent: Ubiq Incorporated
(Patent Proprietor) Suite 580
5909 Baker Road
Minneapolis, MN 55345 (US)

Representative: Beresford, Keith Denis Lewis
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 19 April 2006
rejecting the opposition filed against European
patent No. 0894312 pursuant to Article 102(2)
EPC 1973.

Composition of the Board:

Chairman: B. Schachenmann
Members: G. Assi
F. Neumann

Summary of Facts and Submissions

I. An opposition was filed against the European patent No. 0 894 312 (application number 97921189.3) as a whole. The opposition was based on the ground pursuant to Article 100(a) EPC 1973 that the subject-matter of the patent was not patentable within the terms of Articles 52(1) and 56 EPC 1973 with regard to document WO-A-89/01413 (E2). The opposition was also based on the further ground pursuant to Article 100(b) EPC 1973.

In its decision, the opposition division held that the grounds for opposition did not prejudice the maintenance of the patent as granted. Hence, the opposition was rejected as unsubstantiated.

On the cover page of the appealed decision, however, the "*additional decision*" that the opposition was rejected "*as inadmissible*" was also given.

II. The opponent (appellant) lodged an appeal against the decision of the opposition division.

III. With a letter dated 20 October 2008 the appellant filed a further document JP-A-7-311871 (E3) with an automatic translation thereof into English. With a letter of 31 October 2008 the appellant filed another English translation of E3 prepared by a translation bureau.

IV. Oral proceedings before the Board were held on 21 November 2008.

The appellant requested that the decision under appeal be set aside and the patent be revoked.

The proprietor of the patent (respondent) requested that the appeal be rejected.

V. The wording of the claim 1 of the contested patent reads as follows:

"A method of issuing portable programmed data carriers (160) using a personalization system (100) operable as an interface between a card issuer management system (150) and a personalization equipment (130) and performing the steps of:

- *acquiring (815, 805) personalization data relating to a user of the data carrier by the personalization system (100) from the card issuer management system (150),*
- *transferring the personalization data relating to the user of the data carrier to the personalization equipment (130) in a manner specified by equipment characteristic data, and*
- *personalising and issuing of the data carrier at the personalization equipment (130),*

*further **characterised by** the steps of:*

- *acquiring (801) a personalization equipment identifier from the card issuer management system (150), and*
- *acquiring the equipment characteristic data for a personalization equipment type corresponding to said personalization equipment from a record in a database (126) identified by the personalization equipment identifier."*

The wording of the independent claim 12 of the contested patent reads as follows:

"A personalization system (100) for use in issuing portable programmed data carriers (160), the

personalization system having means for connection in use as an interface between a card issuer management system (150) and personalization equipment (130) for issuing the data carriers, the personalization system comprising:

a card issuer management system interface (101) for acquiring from the card issuer management system personalization data for a user of the data carrier;

and

a personalization equipment interface (107) for transferring to the personalization equipment the personalization data in a manner defined by equipment characteristic data;

characterised by *the system interface being further operable to acquire a personalization equipment identifier from the card issuer management system, and to acquire the equipment characteristic data for a personalization equipment type corresponding to the personalization equipment from a record in a database (126) identified by the personalization equipment identifier."*

The wording of the independent claim 19 of the contested patent reads as follows:

"A data structure (152) stored on a storage device for producing portable programmed data carriers (160) comprising a plurality of personalization equipment elements, wherein each personalization equipment element is addressed by a unique personalization equipment identifier and specifies operating parameters for a type of personalization equipment such that the personalization data is properly formatted for transmission to personalization equipment of the type used to issue the data carrier."

The wording of the independent claim 24 of the contested patent reads as follows:

"A computer program comprising computer executable instructions for executing all of the steps of a method for issuing portable programmed data carriers according to any one of claims 1 to 11 when executed by a computer."

The remaining claims 2-11, 13-18 and 20-23 of the contested patent are dependent claims.

VI. In the present decision, reference will be made to "EPC 1973" or "EPC" for EPC 2000 (EPC, 13th edition, July 2007, Citation practice, pages 4-6) depending on the version to be applied according to Article 7(1) of the Revision Act dated 29 November 2000 (Special Edition No. 1 OJ EPO, 196) and the decisions of the Administrative Council dated 28 June 2001 (Special Edition No. 1 OJ EPO 2007, 197) and 7 December 2006 (Special Edition No. 1 OJ EPO 2007, 89).

Reasons for the Decision

1. With regard to the cover page of the appealed decision the Board considers that the mention of an "*additional decision*" that the opposition was rejected as inadmissible represents an obvious inadvertence in view of point 1 of the Reasons of the appealed decision. It can therefore be disregarded.

2. *Ground for opposition pursuant to Article 100(b) EPC 1973*

2.1 The ground for opposition under Article 100(b) EPC 1973 is only directed against claim 19 of the patent.

In the notice of opposition (reasons, point III.3.1) the appellant submitted that claim 19 concerned a data structure comprising a plurality of personalization equipment elements, each of which was addressed by an undefined personalization equipment identifier and specified undefined operating parameters for a type of personalization equipment. Moreover, it was not clear how the personalization data had to be properly formatted for transmission to a personalization equipment of the type used. Thus, claim 19 recited results to be achieved rather than a way for realizing the data structure.

In the grounds of appeal (point III.3.1) the appellant further noted that, during the opposition procedure, the opposition division interpreted the subject-matter of claim 19 in two different ways. Indeed, having regard to the reference sign "152" in claim 19, the opposition division first considered (communication of 21 June 2005, point 1.1) that the claimed data structure concerned the database 152 containing cardholder data (Figures 1B, 1C and 2-7). In contradiction to its own view, the opposition division then noted (minutes of the oral proceedings on 9 March 2006, point 11; decision under appeal, point 3) that the claimed data structure should rather be interpreted as relating to the personalization equipment database 126, 926 (Figures 1B, 1C, 2-7 and 9) and not to the

database containing cardholder data as wrongly indicated by the reference sign 152 in claim 19. These contradictory interpretations showed that claim 19 was obscure. Moreover, the fact that it was not clear from claim 19 whether the data structure was really the personalization equipment database 126, 926, as finally held by the opposition division, or the database 152 containing cardholder data, as specifically implied by the use of the reference sign 152, meant that the subject-matter of claim 19 was not disclosed in a manner sufficiently clear for it to be carried out by a skilled person.

The appellant, therefore, held that the provision of Article 100(b) EPC 1973 justified the revocation of the patent.

2.2 The appellant's argumentation is not convincing.

2.3 The ground for opposition pursuant to Article 100(b) EPC 1973 is related to the requirement of Article 83 EPC 1973 according to which the patent application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

The requirement of Article 83 EPC 1973 should be read in connection with the provisions concerning the description of the application. In particular, the description shall disclose the invention as claimed in such terms that the technical problem and its solution can be understood, and state any advantageous effects of the invention with reference to the background art (Rule 27(1)(c) EPC 1973). The description shall also

describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any (Rule 27(1)(e) EPC 1973).

Moreover, Article 83 EPC 1973 implies the fact that the application is addressed to the person skilled in the art who will then read and interpret it using his/her general technical knowledge. Normally, "*the proper interpretation of any document, and more specifically any part of a document, is to be derived by having regard to the document as a whole*" (T 860/93 (OJ EPO 1995, 047); Reasons, point 5.1).

- 2.4 With regard to the claims, the reference signs, if any, shall not be construed as limiting the claims (Rule 29(7) EPC 1973).
- 2.5 In the present case (published application, Figures 1-7 and 9; the published application will hereafter be used for citations, unless otherwise mentioned), the system for issuing smart cards comprises a card issuer management system 150, a smart card personalization system 100 and a personalization equipment 130. The card issuer management system 150 manages cardholder data 152 and determines the type of card to issue, the card applications to embed in the card, and what personalization equipment to use in order to issue the card for a particular cardholder (page 10, lines 5-13). The smart card personalization system 100 receives data from the card issuer management system 150, translates the data into a data stream, and outputs the data stream to the personalization equipment 130 which personalizes the smart cards. Thus, the smart card

personalization system 100 acts as an interface between the card issuer management system 150 and the personalization equipment 130. The smart card personalization system 100 controls different devices like, for example, card printers or embossing devices collectively represented in Figure 1A as the personalization equipment 130 (page 10, line 30 to page 11, line 5). The smart card personalization system 100 relies on databases residing in a computer storage medium to organise the data necessary to issue the smart cards. In particular, there are four main databases in the system 100: a data format database 120, a card operating system database 122, an application program database 124, and a personalization equipment database 126. The data structure uses indices or identifiers to quickly access the specific data in the databases (page 5, lines 19-25).

The issuing process is initiated by the card issuer management system 150 by sending a data format identifier (optionally), a card operating system identifier, an application program identifier, a personalization equipment identifier and cardholder data to the smart card personalization system 100. The identifiers permit the card personalization system 100 to address data stored in its underlying databases depending on each card to be issued. With this information, the smart card personalization system 100 instructs the personalisation equipment 130 to issue the smart card for each cardholder (page 3, lines 15-21; page 4, lines 5-8). Thus, the smart card personalization system 100 can combine multiple types of issuer data formats, card operating systems, card

applications and personalization equipment when issuing the smart cards (page 13, lines 5-8).

2.6 The data structure of claim 19 essentially comprises "*a plurality of personalisation equipment elements, wherein each personalisation equipment element is addressed by a unique personalisation equipment identifier*". When considering the whole disclosure of the present invention, as summarized above, it may be clearly concluded that the claimed data structure indeed relates to the database underlying the smart card personalization system, in particular the personalisation equipment database 126 (Figures 1C-7) and 926 (Figure 9). The other interpretation that the claimed data structure would rather relate to the cardholder database 152 (Figures 1C-7) and 952 (Figure 9) derives solely from the use of the reference sign 152 in claim 19, which the above discussion reveals to be incorrect, and is not consistent with the disclosure of the invention as a whole. As a result, the alleged obscurity on which the objection of insufficient disclosure relied is unfounded. The conclusions drawn by the appellant are consequently flawed in this respect because there is no doubt that the skilled person is able to implement the claimed data structure comprising a plurality of elements, each element being addressed by a unique identifier, whereby the meaning to be given to the terms "*element*" and "*identifier*" clearly results from the whole context of the invention.

2.7 The description of the published application indicates the technical field to which the invention relates (page 1, lines 5-8), the background art (page 1, line 9

to page 3, line 2), the technical problem (page 3, lines 3-7) and its solution (claims). Moreover, it describes three embodiments (Figures 1C, 3 and 9) of the smart card personalisation system shown in Figure 1B. Alternative embodiments are shown in Figures 2 and 4-8 with the addition of further modules of the smart card personalisation system. Flow charts for computer software which implements the functions of the smart card personalisation system are shown in Figures 8 and 10. An example describing the processing performed by the embodiment of the smart card personalisation system shown in Figures 9 and 10 is described (page 26, line 8 to page 33, line 30). All this information enables the skilled person to carry out the invention in a reproducible way and without any undue burden.

2.8 In the light of the foregoing, the provision of Article 83 EPC 1973 is met. The ground for opposition pursuant to Article 100(b) EPC 1973 does not prejudice the maintenance of the patent unamended.

3. *Document E3*

3.1 Pursuant to Article 114(2) EPC 1973 the European Patent Office may disregard facts or evidence which are not submitted in due time by the parties concerned. The issue thus has to be considered whether the appellant submitted the document E3 in due time.

3.2 Article 12(2) RPBA prescribes that the statement of grounds of appeal shall contain a party's complete case. It shall set out clearly and concisely the reasons why it is requested that the decision under appeal be

reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.

The requirement that the statement of grounds of appeal shall contain a party's complete case entails that the appellant should have filed the document E3 with the grounds of appeal. The appellant, however, filed the document E3 at a later date, namely with the letter of 20 October 2008 in reply to a Board's communication of 25 August 2008.

- 3.3 This did not constitute, in the appellant's view, an abuse of the procedure in the sense of a deliberate withholding of information for the following reasons. The appellant understood the comments made by the Board in its communication as implying that the document E2, on which the appellant's argumentation on inventive step had been based until then, might not be regarded as being detrimental to the maintenance of the patent because, in contrast to the present invention, the document E2 disclosed a single personalization equipment device identified as the embosser shown in Figure 1. In reaction thereto, the appellant considered it necessary to carry out an additional search that turned out to be difficult as far as Japanese applications were concerned. Once a document, i.e. E3, was eventually found that avoided the alleged drawback of the document E2 on file, it was promptly submitted together with an automatic English translation. As this translation was of an admittedly poor quality, a professional translation was immediately commissioned and was filed as soon as it became available.

3.4 The Board has no reason to doubt the submissions made by the appellant. However, the Board holds that they are not sufficient for concluding that the document E3 was filed in due time.

During the opposition procedure, while dealing with the issue of inventive step with respect to the document E2 in a communication dated 21 June 2005 accompanying the summons to oral proceedings (points 2.1-2.9), the opposition division notified the appellant of the argument that the document E2 could be regarded as disclosing a single personalization equipment device. The appellant did not react to the opposition division's communication, although it had an opportunity to present its comments pursuant to Rule 71a EPC 1973 in response to the summons. In the oral proceedings on 9 March 2006, the appellant was again confronted with the interpretation of the document E2 mentioned above (minutes, point 19 relating to the discussion of claim 19; points 21, 25 and 27 relating to the discussion of claims 1 and 12). During the discussion on the interpretation of claim 19, the opponent requested continuation of the proceedings in writing such that an additional search for documents which might be relevant could be performed (minutes, point 13). This request was, however, refused by the opposition division (minutes, point 14). The decision rejecting the opposition was then dispatched on 19 April 2006.

It results from the foregoing that, if the appellant intended to provide new evidence in order to overcome the opposition division's arguments, it had sufficient time for producing such evidence up until the expiry of

the time limit for filing the grounds of appeal (Article 12(2) RPBA). Instead, the appellant, without giving any convincing justification, filed the document E3 together with an automatic translation at a late stage of the appeal proceedings, with the letter of 20 October 2008.

A further aspect should also be considered. The Board received the letter of 20 October 2008 with the automatic translation on the following day. However, as the appellant itself admitted, the automatic translation was hardly readable. For this reason, the appellant filed a new translation prepared by a translation bureau with the letter of 31 October 2008. The Board received this letter on 3 November 2008. Although the appellant directly sent the new translation to the representative of the respondent, as it results from the letter of 31 October 2008, the latter had hardly sufficient time for studying the new rather complex document, discussing it with his American client and obtaining instructions from the same before the date of the oral proceedings.

All this amounts to the conclusion that the appellant did not produce cogent reasons justifying the late submission of the document E3. Therefore, the Board agrees with the respondent's view that the document E3 and both translations thereof were not filed in due time.

3.5 Pursuant to Article 114(2) EPC 1973 the Board has a discretionary power to admit into the procedure evidence which is not submitted in due time. This

discretion must be exercised equitably after an appraisal of the entire situation.

In the jurisprudence of the boards of appeal, the technical relevance of late filed documents has been considered to represent a criterion for their admissibility which is as decisive as other criteria of procedural nature, such as how late the documents were filed or whether their submission constituted a procedural abuse.

The issue concerning the technical relevance was considered in T 1002/92 (OJ EPO 1995, 605). The Headnote (point 2) reads as follows: *"In proceedings before the Boards of Appeal, new facts, evidence and related arguments, which go beyond the "indication of facts, evidence and arguments" presented in the notice of opposition pursuant to Rule 55(c) EPC in support of the grounds of opposition on which the opposition is based, should only very exceptionally be admitted into the proceedings in the appropriate exercise of the Board's discretion, if such new material is 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 maintenance of the European patent; and having regard also to other relevant factors in the case, in particular whether the patentee objects to the admissibility of the new material and the reasons for any such objection, and the degree of procedural complication that its admission is likely to cause"*.

3.6 In the present case, the document E3 (the English translation filed with the letter of 31 October 2008 is

hereafter referred to) relates to a device for providing personal information to a system issuing a personal information recording medium. In particular, the device provides personal information to a plurality of systems issuing different personal information recording media (paragraphs [0001] and [0005]). Figure 1 (paragraphs [0010]-[0014]) shows a system which incorporates a device according to one embodiment. A device 50 for providing personal information comprises a main body 51, a display 52, an equipment 53 for entering instructions, a data storage 54 for storing uploaded personal information and a data uploading equipment 55 for uploading personal information by means of a magnetic tape reader 55a, a floppy disk drive 55b and an on-line interface 55c. The device 50 provides personal information via a network 100 to an IC card issuing system 10, a colour print card issuing system 20, an emboss card issuing system 30 and a form print issuing system 40. Each of these systems is an independent computer system which records personal information on a predetermined medium. With regard to the uploaded data (paragraph [0009]), data representing information of a person constitutes a record, whereby each record consists of a plurality of fields. A form attribute specifies the form of data for each field of a record. Moreover, an issuing attribute is set for each field of a record, so that data can be provided to different issuing systems via the network on the basis of the issuing attributes.

- 3.7 The parties disagreed on the prima facie relevance of the document E3.

According to the appellant, the relevance of the document E3 was immediately evident in view of the similarities between the system of the document E3 (Figure 1) and the personalization system of the contested patent (Figure 1B, for example). In particular, the device 50 for providing personal information of the document E3 corresponded to the personalization system 100 of the patent, the systems 10-40 of the document E3 to the personalization equipment 130 of the patent, the data uploading equipment 55 of the document E3 to the card issuer management system 150 of the patent, the issuing attribute of the document E3 to the personalization equipment identifier of the patent. Thus, the system disclosed by the document E3 avoided the alleged drawback of the system of the document E2 comprising a single personalization equipment, i.e. an embosser.

The respondent contested the appellant's conclusions. The document E3 did not show a card issuer management system (150 in Figure 1B of the patent) controlling a card personalization system (100 in Figure 1B of the patent) acting as an interface for a personalization equipment (130 in Figure 1B of the patent). Indeed, in the document E3 (Figure 1) the device 50 only had the function of providing information to the issuing systems 10, 20, 30, 40, each of which was controlled by an own main body 11, 21, 31, 41 and not by a common interface. In other words, the issuing systems of the document E3 had their own controlling intelligence, whereas according to the contested patent the card personalization system represented a single intelligent interface controlling the passive personalization equipment.

The appellant, however, noted that the alleged difference based on the controlling intelligence did not result from the wording of the independent claims of the contested patent.

- 3.8 In the Board's view, when assessing inventive step, a late filed document may be considered if it belongs to the same or a closely related technical field and discloses subject-matter conceived for the same or a similar purpose as the contested patent. In the light of T 1002/92 (above) such a document would then be prima facie relevant in the sense that it might prejudice the maintenance of the patent, at least in unamended form.

The contested patent (paragraph [0001]) and the document E3 (Abstract) both relate to the same technical field concerning the production of personalized portable data carriers. Moreover, both of them deal with the same purpose essentially consisting in the provision of a card issuing system able to handle multiple types of personalized cards (contested patent, paragraph [0009]; E3, paragraph [0005]). The document E3 may thus be considered at least as relevant as the other prior art E2 cited with the notice of opposition. The document E3 would even appear to come closer to the present invention from the point of view that it discloses a device with a plurality of issuing systems whereas the document E2 relates to a system with a single embosser.

3.9 For these reasons, the Board considers it equitable to introduce the document E3 in the procedure, even if it is late filed.

4. Ground for opposition pursuant to Article 100(a) EPC 1973 in connection with Articles 52(1) and 56 EPC 1973

4.1 In the oral proceedings before the opposition division (minutes, point 15) the appellant considered that the subject-matter of independent claim 19 merely concerned a database comprising addressable records. As such, the claimed data structure was known at the priority date of the contested patent. This view was only based on general knowledge. No specific documentary evidence needed to be cited in its support.

4.2 This argumentation was further developed in the oral proceedings before the Board. The appellant stated that, in the assessment of inventive step, non-technical features could not support the presence of an inventive step. Thus, if only the features having a technical character were considered, claim 19 concerned a usual database holding a plurality of records which could be selectively accessed by simply addressing a particular record using a unique address for that record (letter of 22 December 2006, page 4, middle of second paragraph).

4.3 The Board does not comment on the issue of inventive step because it holds that the remittal of the case to the opposition division for further prosecution is equitable for the following reasons.

5. *Remittal of the case*

- 5.1 If a new document is filed during opposition appeal proceedings, the question arises whether the case should be remitted to the opposition division. Remittal is at the discretion of the board (Article 111(1) EPC).

In the jurisprudence of the boards of appeal (Case Law, 5th Edition 2006, point VI.F.7.1, first paragraph), the prevailing view is that, if a document filed for the first time in opposition appeal proceedings is relevant enough to be taken into consideration, the case should as a rule be remitted under Article 111(1) EPC to the department of first instance so that the document can be examined at two levels of jurisdiction and the patent proprietor is not deprived of the possibility of subsequent review.

In the light of this jurisprudence, the present case should be remitted to the opposition division because the document E3 has been found *prima facie* relevant in the sense that it might prejudice the maintenance of the unamended patent.

- 5.2 Moreover, the remittal of the case appears to be justified from a second point of view, namely having regard to the argumentation submitted by the appellant against claim 19 in the oral proceedings before the Board (above). This argumentation relied for the first time on the distinction between technical and non-technical features. This issue, the complex and controversial nature of which has been addressed at length in the jurisprudence of the boards of appeal, needs due consideration when examining whether the

appellant's argumentation is well-founded. It would be unfair to expect from the respondent that counter-arguments taking full account of the jurisprudence could be presented in the oral proceedings without adequate preparation.

- 5.3 Both the admission of the late filed document E3 and the new argumentation against claim 19 produce a fresh factual and legal framework that substantially differs from that underlying the decision under appeal.

According to T 97/90 (OJ EPO 1993, 719), "*Article 114(2) as well as Article 111(1) EPC set a clear limit to the scope of any new matter that may be introduced into an appeal by the parties so that cases on appeal must be, and remain, identical or closely similar to those on which first instance decisions have been rendered*" (Headnote, point 1). This decision was based on the principle that the essential function of the appeal procedure was to determine whether the decision issued by a department of first instance was correct on its merits.

In T 212/91 (unpublished) the board confirmed that "*cases decided by the Boards of Appeal should have the same, or substantially the same, legal and factual framework as the case on the basis of which the first instance's decision had been rendered*" (Reasons, point 2).

For these reasons, the Board considers that the remittal of the present case to the opposition division for further prosecution is equitable. The Board is thereby aware of the decision T 633/97 (unpublished),

in which the aspect of the complexity of the technical or legal issues has been addressed. In that case, the board held that, *"Once oral proceedings have been arranged in appeal cases, the decision to admit new evidence or requests into the procedure should be governed primarily by a general interest in the appeal proceedings being conducted in an effective manner, i.e. in dealing with as many of the issues raised by the parties as possible, while still being brought to a close within a reasonable time"* (Catchword, point 1). *"In these circumstances, new submissions should normally be disregarded if the complexity of the technical or legal issues raised is such that neither the Board nor the other party can be clearly expected to deal with them without adjournment of the oral proceedings. Complex fresh subject matter filed at short notice before or during oral proceedings thus runs the risk of being not admitted to the proceedings without any consideration of its relevance or allowability"* (Catchword, point 2).

The Board, however, considers that a balance has to be found between the interest that the appeal proceedings rapidly lead to a final decision and the interest that only valid patents are maintained. In the present case, the remittal represents an equitable compromise. Indeed, would the Board disregard the late-filed document E3 and the fresh argumentation based on the distinction between technical and non-technical features, the appeal procedure could be closed with a final decision. In this way, however, legal certainty could hardly be achieved because the appellant could still present the late-filed document E3 and the fresh argumentation against claim 19 in national revocation proceedings.

Conversely, would the Board examine the relevant fresh subject-matter without remittal, the respondent would have the disadvantage of having to deal with it in only one instance.

5.4 In conclusion, the Board remits the case to the opposition division for further prosecution (Article 111(1) EPC 1973, second sentence, second alternative).

6. Apportionment of costs

6.1 Pursuant to Article 104(1) EPC, each party to the opposition proceedings shall bear the costs it has incurred, unless the opposition division (the board in view of Article 111(1) EPC, second sentence, first alternative), for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs.

6.2 According to the jurisprudence of the boards of appeal, if a party introduces relevant facts or evidence at a late stage of the proceedings, without cogent reasons for the delay, this may be taken into account in the apportionment of costs (Case Law, 5th Edition 2006, point VI.F.8, first paragraph).

This was confirmed in T 874/03 (unpublished) by ruling that *"When late filing of facts and evidence necessitates the remittal of the case to the department of the first instance, the costs of any oral proceedings in the appeal proceedings should normally be borne by the party responsible for the late filing"* (Reasons, point 5).

6.3 In the present case, it results from the foregoing that the appellant filed a relevant document at a late stage of the appeal proceedings without cogent reasons for doing so.

6.4 Hence, the Board holds it equitable that the costs incurred by the respondent in connection with the oral proceedings of 21 November 2008 be borne by the appellant.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the opposition division for further prosecution.
3. The appellant (opponent) shall bear the costs incurred by the respondent (proprietor of the patent) in the oral proceedings of 21 November 2008.

The Registrar:

The Chairman:

R. Schumacher

B. Schachenmann