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**Datasheet for the decision
of 12 August 2009**

Case Number: T 0597/07 - 3.3.06

Application Number: 95114383.3

Publication Number: 0702079

IPC: C11D 1/83

Language of the proceedings: EN

Title of invention:

Low-irritant detergent compositions

Patentee:

KAO CORPORATION

Opponent:

BEIERSDORF AG

Headword:

Detergent composition/KAO

Relevant legal provisions:

EPC Art. 106, 107, 108, 54(2), 111(1)
EPC R. 99(2), 76(2)(c)

Relevant legal provisions (EPC 1973):

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Keyword:

"Admissibility of appeal (yes)"
"Admissibility of opposition (yes)"
"Public availability of document D1 on the balance of probabilities (no)"
"New ground of opposition (no)"
"Remittal (yes)"

Decisions cited:

G 0009/91, G 0010/91, T 0001/95, T 0007/95, T 0550/88,
T 0511/02, T 0131/01, T 0416/87

Catchword:

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Case Number: T 0597/07 - 3.3.06

D E C I S I O N
of the Technical Board of Appeal 3.3.06
of 12 August 2009

Appellant: BEIERSDORF AG
(Opponent) Unnastrasse 38
D-20245 Hamburg (DE)

Representative: -

Respondent: KAO CORPORATION
(Patent Proprietor) 14-10, Nihonbashi Kayabacho 1-chome
Chuo-ku
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Representative: Hansen, Bernd
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 8 February 2007
rejecting the opposition filed against European
patent No. 0702079 pursuant to Article 101(2)
EPC.

Composition of the Board:

Chairman: P.-P. Bracke
Members: G. Dischinger-Höppler
J. Van Moer

Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to reject the opposition against European patent No. 0 702 079 which had been granted on the basis of 7 claims, the independent Claim 1 being directed to a detergent composition comprising a component (A) which is a specific glycerine derivative mixture and a component (B)' at defined weight ratios of component (A) to component (B)' and at a defined concentration of components (A) and (B)'.
- II. A notice of opposition had been filed against the granted patent, wherein the Opponent, by ticking the relevant box in EPO form 2300 sought revocation of the patent in its entirety. He based the opposition on the grounds of lack of novelty (Article 54 EPC) and lack of inventive step (Article 56 EPC) by further ticking the relevant boxes in EPO form 2300 and on the following evidence
- D1 Henkel KGaA, Cospha, Düsseldorf (DE), Information Kosmetik Nr. XII/92: "Eine neue Tensidgeneration PLANTAREN[®] 1200 - PLANTAREN[®] 2000", August 1992;
- E1 Letter of Cognis Deutschland GmbH & Co. KG to Beiersdorf AG, dated 12 December 2003, concerning Cetiol HE.

The Opposition also contained the reasons why the claimed subject-matter was held to be anticipated by document D1.

The Proprietor, in response, contested the public availability of document D1 as well as of the products mentioned therein and the admissibility of the opposition.

In reply to the Proprietor's objections, the Opponent presented further documents at later stages of the opposition proceedings.

III. In its decision, the Opposition Division held that the opposition was admissible and that the claimed subject-matter was novel in view of document E1 and the late filed documents. Document D1 was not considered as state of the art according to Article 54 EPC since the Opponent's argument that document D1 was of a type which was usually sent to clients was speculative and since in spite of the date and specific postal code printed on the document, it had not been shown where the document actually had turned up and that it had been made available to the public at a certain date.

As a consequence, the claimed subject-matter could not lack an inventive step in view of that document which was assumed by the Opposition Division to form the Opponent's basis for a non-substantiated attack under Article 56 EPC.

IV. This decision was appealed by the Opponent, now Appellant who filed under cover of a letter dated 8 June 2007 documents

D7 WO-A-94/07458 and

D8 WO-A-93/25650.

V. Upon requests by both parties, oral proceedings before the Board of Appeal were held on 12 August 2009.

VI. The Appellant orally and in writing submitted in essence the following arguments:

- The appeal was based on the Appellant's opinion that the correct standard of proof concerning the issue of public availability of document D1 was on the balance of probabilities. It had been explained in the opposition proceedings, that document D1 was publicly available at the priority date of the patent in suit in all probability.

- The claimed subject-matter was not novel in view of Example 8 of document D7 and not inventive in view of document D8 in combination with document D7.

VII. In its response to the Appellant's appeal and at the oral proceedings, the Proprietor, now Respondent, contested the admissibility of the appeal and maintained its objection to the admissibility of the opposition, both due to insufficient substantiation.

- Concerning admissibility of the appeal, it was argued, that the Appellant had failed to indicate why the decision of the Opposition Division was wrong.

- Concerning admissibility of the opposition, the Appellant had failed to establish that document D1 was made available to the public prior to the priority date of the patent in suit and failed to provide relevant evidence that the product Cetiol HE mentioned in

document D1 corresponds to component (A) of present Claim 1.

- As a consequence of the latter, documents D7 and D8, also cited with respect to compositions containing Cetiol HE, could not anticipate the claimed subject-matter.

- The Respondent was further of the opinion that any objection under Article 56 EPC would constitute an inadmissible new ground of opposition since it had not been substantiated in the notice of opposition.

- Apart from that it had been shown in the examples of the patent that the composition of component (A) was relevant for the performance of the detergent.

VIII. The Appellant requested that the decision under appeal be set aside and that the European patent be revoked. In the alternative he requested the case to be remitted to the first instance for further prosecution.

The Respondent requested that the appeal be dismissed or in the alternative that the decision be set aside and that the case be remitted to the first instance for further prosecution.

Reasons for the Decision

1. *Admissibility of the appeal*

An appeal is admissible if it meets the requirements of Articles 106 to 108 EPC.

- 1.1 In the present case, the Respondent's objection to the admissibility of the appeal is based on the assumption of insufficient substantiation (point VII above) contrary to the requirements set out in the third sentence of Article 108 EPC in combination with Rule 99(2) EPC.
- 1.2 It is established case law (see Case Law of the Board of Appeal of the European Patent Office, 5th edition 2006, chapter VII.D.7.5.1) that an appeal is adequately substantiated, if the grounds of appeal specify the legal or factual reasons why the impugned decision should be set aside. The arguments must be clearly and concisely presented to enable the Board and the other party or parties to understand immediately why the decision is alleged to be incorrect, and on what facts the Appellant bases its arguments, without first having to make investigations of their own.
- 1.3 In the present case, the Appellant in its statement of grounds of appeal repeated briefly its opinion that document D1 was in all probability publicly available at the priority date of the patent in suit.

This point has been extensively discussed by the parties during opposition proceedings and controversially with respect to the proper standard of proof in the present case. The Appellant basically relied on the balance of probabilities whereas the Respondent relied on the higher standard usually applied in cases of a public prior use (see Case Law of the Board of Appeal of the European Patent Office, 5th edition 2006, chapter I.C.1.9.3), namely a proof beyond

any reasonable doubt by answering typical questions like

(a) where the document turned up;

(b) the circumstance under which the information contained in the document was made accessible to the public, including the determination of who was the public; and

(c) the date or time period of the public occurrence of the document.

1.4 The Opposition Division in its decision found the Appellant's arguments speculative and adopted the opinion of the Respondent.

1.5 It is true that the Appellant's statement of grounds of appeal does not contain any particular argument why the contested decision should be wrong and as correctly outlined by the Respondent, references to submissions made during opposition proceedings are normally not sufficient as statement of grounds of appeal.

However, in the present case, it is clear that the Appellant's appeal is based on the argument that the Opposition Division had selected the wrong standard of proof. Hence, the present case is one of those exceptional cases where previous submissions may be considered as sufficient for an admissible appeal since it is self-evident from the arguments already presented before the first instance why the Appellant holds the contested decision to be wrong (see Case Law of the

Board of Appeal of the European Patent Office, 5th edition 2006, chapter VII.D.7.5.4).

Accordingly, the appeal is found to be sufficiently substantiated as required in the third sentence of Article 108 and Rule 99(2) EPC.

1.6 As the appeal undisputedly meets the requirements of Articles 106 and 107 EPC as well as of the first and second sentences of Article 108 EPC and since a statement of grounds of appeal has been filed within the period of time stipulated in the third sentence of Article 108 EPC, the Board concludes that the appeal is admissible.

2. *Admissibility of the opposition*

2.1 Again the Respondent's objection to the admissibility of the opposition is only based on the ground of insufficient substantiation.

2.2 The relevant requirements concerning substantiation of the opposition are set out in Rule 76(2)c) EPC, according to which the notice of opposition shall contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds.

2.3 It is apparent from the EPO form 2300 (point II above) that the Appellant sought revocation of the patent in its entirety and that the opposition is based on the grounds of Article 100(a) EPC, namely lack of novelty

and lack of inventive step. In support of these grounds, documents D1 and E1 are indicated and the opposition contains the reasons why the claimed subject-matter was held to lack novelty in view of document D1.

Therefore the notice of opposition meets the requirements of Rule 76(2)c) EPC.

2.4 At the oral proceedings, the Respondent presented the following three reasons why in its opinion that requirement was not fulfilled:

a) The Appellant had not provided the evidence necessary to show that document D1 was actually available to the public before the priority of the patent in suit.

b) Even if one were to conclude that document D1 was publicly available at the relevant date, the Appellant failed to prove in its notice of opposition that the product Cetiol HE mentioned in document D1 had been publicly available.

c) Finally, the notice of opposition did not contain any relevant evidence that the product Cetiol HE corresponds to component (A) of present Claim 1.

2.5 However, according to the established case law (see Case Law of the Board of Appeal of the European Patent Office, 5th edition 2006, chapter VII.C.4.5.1), it is not required for an opposition to be admissible that the arguments brought in support are conclusive or that the Opponent's statements are true. What is required is that the Patentee and the Opposition Division are put

in a position of understanding clearly the nature of the objections and the evidence and arguments in support.

- 2.6 It is apparent from the decision under appeal (point III above) that the Opposition Division understood the content of the opposition since it decided the respective issues of admissibility of the opposition, of the public availability of document D1 as well as on novelty and inventive step in view of the accepted prior art.

In its reply, the Respondent was also able to address the relevant parts of the notice of opposition in that it was doubted that document D1 was a prior art document and by arguing that document E1 was not suitable to provide information relating to the composition of the product Cetiol HE mentioned in document D1.

Hence, the Respondent understood also the nature of the objections and the evidence and arguments in support.

- 2.7 The Respondent, on the basis of decisions T 550/88 (published in the OJ EPO, 1992, 117) and T 511/02 (not published) argued that it was essential for an opposition to be admissible that the evidence provided is clearly a prior art suitable to support the grounds of opposition.

Decision T 550/88 is restricted to a situation where it was decided that national prior rights as the only evidence indicated in the notice of opposition cannot as a matter of law support the alleged grounds for

opposition. This decision is, however, totally silent on the question of which standard of proof has to be applied in a case like the present one where the document is a company generated paper.

In the case underlying decision T 511/02, codes imprinted on documents concerning fitting instructions and instructions for use and installation of particular product were not accepted as publication dates since it was held that such documents were usually not published but distributed with the product to be fitted and installed. This case cannot be compared with the present situation, where the document in question is a kind of advertising brochure intended to be distributed to clients for commercial reasons, and where a certain probability exists that the brochure has been distributed at or shortly after the date imprinted on the document.

Hence, both decisions are not applicable in the present case. Therefore, the Board does not see any reason to deviate from the jurisprudence considered above (point 2.5) in respect of the requirements of an opposition to be admissible.

2.8 For these reasons, the Board concludes that the opposition is admissible.

3. *Public availability of document D1*

The Opposition Division rejected the Appellant's arguments that papers of the type of document D1 are usually sent to clients and that it was against experience and economic sense to keep such a document

unpublished until after the priority date of the patent in suit (point III above).

In the present case however, even if the issue of the availability of document D1 is assessed on the balance of probabilities, the standard of proof chosen by the Appellant, the outcome is not in the Appellant's favour. The reason is that the subject-matter disclosed in document D1 which is relevant here has been filed on 20 September 1993 in document D7 as an International Application published under the Patent Cooperation Treaty on 14 April 1994 (see document D7, Example 8). This fact alone casts reasonable doubts on a publication of document D1 more than one year earlier, namely in August 1992, the date mentioned on the cover sheet of document D1, since document D1 would have been citable against novelty and inventive step of the subject-matter claimed in document D7.

Therefore the Board holds that even on the balance of probabilities the content of document D1 does not constitute prior art within the meaning of Article 54(2) EPC.

4. *Documents D7 and D8*

Documents D7 and D8 have been filed only with the statement of grounds of appeal, hence at a very late stage of the proceedings. However, as document D1 is no longer considered as a prior art, the disclosure of those documents is more relevant than any other prior art on file. Documents D7 and D8 are therefore admitted into the proceedings which was not objected by the Respondent.

5. *New ground of opposition*

Concerning inadmissibility of the objection of lack of inventive step as ground for opposition, the Respondent relied on decisions G 10/91 (OJ EPO 1993, 420) and G 7/95 (OJ EPO, 1996, 626).

However, G 10/91 is silent on the issue of whether Article 100(a) EPC is to be considered as one single ground for opposition or whether the provisions of Articles 52 to 57 EPC mentioned therein are all different grounds for opposition (see also G 9/91; OJ EPO 1993, 408).

This question has been answered only in G 1/95 (OJ EPO, 1996, 615), the content of which corresponds essentially to G 7/95. Accordingly, an objection of lack of novelty which has not been substantiated in the notice of opposition cannot be introduced into the appeal proceedings without the agreement of the patentee since it is a different legal objection than the objection of lack of inventive step and, therefore, a fresh ground for opposition (point 7.1). However, it is also mentioned that in a case where the closest prior art document destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results in such subject-matter being unallowable on the ground of inventive step (point 7.2 of G 1/95).

The consequence of this latter statement is in the Board's opinion that if a patent has been opposed on

the grounds of lack of novelty and lack of inventive step and if only the ground of novelty has been substantiated, a specific substantiation of the ground of lack of inventive step is not necessary.

The Board further concurs with the conclusion drawn in T 131/01 (OJ EPO, 2003, 115) that under such circumstances a specific substantiation of the ground of lack of inventive step is not even generally possible since - given that novelty, i.e. the presence of a difference between the claimed subject-matter and a prior art, is a prerequisite for determining whether an invention involves an inventive step in view of that prior art - this would contradict the reasons in support of lack of novelty.

Therefore, the Board holds that the objection of lack of inventive step is not a fresh ground for opposition in the present case.

6. *Remittal*

The Respondent argued that in the present circumstances where documents filed for the first time during the appeal stage were considered by the Board as the closest prior art, the Board should decide on the whole case rather than remitting it to the first instance if the decision was in the Respondent's favour. He relied in this respect on decision T 416/87 (OJ EPO, 1990, 415).

However, the case underlying this decision is not comparable with the present one, where it is on account of the late filed document D7 that document D1 which

was initially the most pertinent one is not held to constitute a prior art according to Article 54(2) EPC (point 3 above).

Accordingly, since the Opposition Division has not yet had the opportunity of considering the issue of novelty and inventive step of the claimed subject-matter in view of documents D7 and D8 and since the Appellant as well as eventually the Respondent agreed that the case should be remitted for that purpose, it is considered appropriate, in accordance with Article 111(1) EPC, to remit the case to the department of first instance to ensure that both parties have the opportunity to be heard by two instances on each opposition ground.

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.

The Registrar:

The Chairman:

G. Rauh

P.-P. Bracke