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**Datasheet for the decision
of 20 February 2009**

Case Number: T 0099/08 - 3.2.03

Application Number: 02003289.2

Publication Number: 1236960

IPC: F25D 3/00

Language of the proceedings: EN

Title of invention:

Preservation apparatus particularly for perishable products at a preset temperature

Patentee:

High Technology Participation S.A.

Opponent:

EMMERRE s.r.l.

Headword:

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Relevant legal provisions:

EPC Art. 113(1)
EPC R. 76(2), 124(1)

Relevant legal provisions (EPC 1973):

EPC R. 55(c), 56(1), 76(1)

Keyword:

"Admissibility of notice of opposition (no)"
"Violation of right to be heard (no)"

Decisions cited:

T 0002/89, T 0092/92, T 0199/92, T 0212/97, T 0642/97,
T 0653/99, T 0934/99, T 0065/00, T 1556/06

Catchword:

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Case Number: T 0099/08 - 3.2.03

D E C I S I O N
of the Technical Board of Appeal 3.2.03
of 20 February 2009

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office posted 16 November 2007
rejecting the notice of opposition filed
against European patent No. 1236960 as
inadmissible pursuant to Rule 56(1) EPC 1973.

Composition of the Board:

Chairman: U. Krause
Members: K. Garnett
C. Donnelly

Summary of Facts and Submissions

- I. This is an appeal by the opponent (hereafter "the appellant") against the decision of the Opposition Division dated 16 November 2007 whereby the notice of opposition was rejected as inadmissible. The notice of appeal was filed on 15 January 2008. The appeal fee was paid on the same day and the grounds of appeal were filed on 21 March 2008.
- II. The granted patent, No. 1 236 960, comprising 17 claims, relates to an apparatus particularly for preserving perishable products at a preset temperature. Notice of opposition to the patent was filed by the appellant on 10 February 2006. The opposition grounds were based on Articles 100(a) (lack of novelty and inventive step), 100(b) and 100(c) EPC. As far as novelty and inventive step were concerned, the opponent relied on two separate instances of alleged prior public use, said to be substantiated by Annexes A10 and A12 to the notice of opposition. In relation to the various claims, it was alleged that:
- (a) A10 and/or A12 was novelty destroying (as regards claims 1,5,8,14 and claims 1,5, respectively);
 - (b) the subject matter of the claims was obvious, on the following basis:
 - (i) taking A12 as representing the closest prior art and combining it with A5, (claim 1);
 - (ii) taking either A10 or A12 as representing the closest prior art in combination either with

A3 (claim 4) or with common general knowledge (claims 2,3,6,15);

(iii) taking A12 as representing the closest prior art and combining it with A10 (claim 5);

(iv) taking A10 as representing the closest prior art (claims 8, 14).

(v) Claims 7,9,10,11,12,13,16,17, which are all dependent on one or more of the above claims, were additionally said to be obvious to try for the person skilled in the art.

III. In a communication sent with the summons to oral proceedings, the Opposition Division indicated its view that the public prior use according to both A10 and A12 had not been substantiated within the opposition period, in particular as regards the date of the alleged prior public use, and that the notice of opposition as a whole appeared to be inadmissible.

IV. In response, on 19 September 2007, after expiry of the opposition period, the opponent filed various further materials and submissions.

V. Following oral proceedings, the Opposition Division rejected the opposition as inadmissible, holding that none of the grounds of opposition had been substantiated within the opposition period, substantially for the reasons given in its earlier communication.

- VI. In a communication from the Board dated 25 November 2008 pursuant to Articles 12(1) and 17 of the Rules of Procedure of Boards of Appeal (OJ EPO 2007, 536), and with a view to safeguarding the appellant's right to be heard, the Board notified the parties of its provisional opinion that the decision of the Opposition Division was correct.
- VII. On 14 January 2009 the appellant filed further submissions in response to the Board's communication.
- VIII. The submissions of the appellant as contained in its grounds of appeal and the submissions filed on 14 January 2009 can be summarised as follows:
- (a) For an opposition to be admissible, it is sufficient if one of the grounds of opposition satisfies the requirements of Rule 76(2)(c) EPC 2000 (previously Rule 55(c) EPC 1973); the concept of admissibility is applicable to the notice of opposition as a whole (see T 653/99, T 212/97 and T 65/00). The facts presented in support of the grounds of opposition must be sufficient for a person skilled in the art to understand the case without further investigation (see T 2/89, OJ EPO 1991, 51), although this does not rule out that he may have to do a certain amount of interpretation (see T 199/92). Rule 55(c) EPC 1973 did not require the notice of opposition to contain a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition be cogent or convincing (see T 934/99).

- (b) Although A12 was found by the Opposition to be "inadmissible", an opposition ground based on lack of inventive step, starting from A5 and combining it either with common general knowledge, or with either A4, or A6, A7 or A8 and common general knowledge, had been substantiated within the opposition period. The appellant accepts that this was a new argument which it had tried to advance for the first time at the oral proceedings before the Opposition Division (see next paragraph), but says that it is one which was based on documents already in the opposition proceedings. All these prior art documents relate to the same technical field and disclose in combination most of the features of claim 1, the remaining features being well known to the skilled person.
- (c) A substantial violation of the right to be heard under Article 113(1) EPC took place before the Opposition Division, consisting of the refusal by the Opposition Division to hear the new argument referred to in paragraph (b) above. Merely because an argument is presented for the first time in oral proceedings does not mean that it should be disregarded. See T 92/92.
- (c) The minutes do not record this new argument, as they ought to have done. Although generally the minutes need not contain the full arguments of the parties, this is true only where the arguments are apparent from the earlier written submissions. See T 642/97. Here, the submission based on A5 as the closest prior art was new and ought to have been recorded in the minutes.

IX. The relevant submissions of the respondent as contained in its reply to the grounds of appeal dated 3 September 2008 can be summarised as follows. Rule 55(c) EPC 1973 required that the notice of opposition should contain "grounds ... as well as an indication of the facts and evidence presented in support of these grounds." This requirement is only satisfied if there is sufficient indication of the relevant facts, evidence and arguments for the reasoning of the opponent's case to be properly understood by the Opposition Division and the patentee. In the present case no indication or argument was provided in the notice of opposition by which it could be understood that the patent was being attacked for lack of inventive step starting from A5 as representing the closest prior art. The only attack involving A5 hinted at in the notice of opposition was an attack based on A12 as representing the closest prior art in combination with A5. The decisions T 2/89 and T 199/92 cited by the appellant concern only the strength of the opponent's case. Decision T 934/99 was concerned with the disclosure of the documents referred to in the notice of opposition and not with the grounds themselves.

X. The appellant requests that the decision be set aside and the case be remitted to the Opposition Division for substantive examination. Oral proceedings were not requested by the appellant. The respondent requests that the appeal be dismissed and, in the event of this request not being fully granted, oral proceedings.

XI. Since, for the reasons given below, the Board reached the conclusion that the appeal should be dismissed in accordance with the request of the respondent, no oral proceedings were held by the Board.

Reasons for the Decision

1. The appeal is admissible.
2. The appellant has not argued in the appeal that any of the opposition grounds based on lack of novelty or inventive step based on either A10 or A12 were substantiated within the opposition period. The appellant has also not suggested that any other opposition ground (i.e. under Articles 100(b) or 100(c) EPC) were substantiated either. The Board has no reason to depart from the decision of the Opposition Division in respect of these issues.
3. The only ground on which it is now said that the notice of opposition was admissible is that an opposition ground based on lack of inventive step, starting from A5 and combining it either with common general knowledge, or with either A4, or A6, A7 or A8 and common general knowledge, had been substantiated within the opposition period.
4. The appellant complains that the Opposition Division refused to hear this argument during the oral proceedings. The Board will address this complaint later in this decision but will first consider the merits of the argument based on A5.

5. The Board does not dispute that for the opposition to be admissible, it is sufficient if only one of the grounds of opposition raised satisfied the requirements of Rule 55(c) EPC 1973 (now Rule 76(2)(c) EPC 2000). See the decisions T 653/99, T 212/97 and T 65/00 cited by the appellant. The Board also accepts that Rule 55(c) EPC 1973 did not require the notice of opposition to contain a logical line of reasoning in the sense that the arguments brought forward in the notice of opposition needed to be cogent or convincing (see T 934/99, point 6 of the reasons). Nor does the Board dispute the proposition that although the facts presented in support of the grounds of opposition must be sufficient for a person skilled in the art to understand the case without further investigation (see T 2/89, OJ EPO 1991, 51, point 3 of the reasons), this requirement does not rule out that a patentee may have to undertake a certain amount of interpretation, as is made clear in T 199/92, point 1.2 of the reasons, cited by the appellant. However the same passage of this decision makes it clear, as also submitted by the respondent, that Rule 55(c) EPC 1973 precluded an attack against a patent in a manner that leaves a patentee either at a complete loss to understand it, or imposes an undue mental burden upon him.
6. In this respect the Board would point out that the notice of opposition, and particularly the documents cited therein, are not to be regarded as a pool of items of information in which the opponent can at some later stage fish in order to formulate new arguments which neither the proprietor nor the Opposition Division could, even using reasonable interpretive effort, previously have divined.

7. In the present case it was alleged in the notice of opposition that the subject matters of the claims of the patent were not new in the light of separate prior public uses said to be evidenced by A10 and A12 respectively, or alternatively were not inventive in the light of either A10 or A12 as representing the closest prior art, variously coupled with A3, A5 or common general knowledge (see paragraph III, above). More specifically, the only reference to A5 in the notice of opposition was in the context of an argument that claim 1 was obvious when taking the public prior use evidenced by A12 as representing the closest prior art and coupling it with A5.

8. As regards this latter argument, the relevant information and arguments in the notice of opposition were as follows. A12 consisted of a letter with annexed technical drawings with information about a refrigeration unit said to have been ordered for installation on board a ship. The letter provided a brief description of the unit and its installation. This alleged prior public use was said to be novelty destroying of claim 1 since "all the inherently disclosed features are comprised in claim 1." Various other features of the claim were also said to be directly and unambiguously derivable from the various drawings annexed to A12. As to inventive step, A12 was said to represent the closest prior art as it related to the same technical field and had the same technical and structural features as the claimed invention. It was then said that A12 should be combined with A5, which is a paper describing the development of a refrigerated railroad car in China, the refrigeration

system being based upon "eutectic plates". Starting from A12, it was said that the person skilled in the art would find from A5 "how to apply the essentially explicitly disclosed features to a containment body with an internal chamber, said chamber being formed inside said containment body constituted by a container . . .".

9. What is now said is that A5 either alone or in combination with general knowledge, or with either A4, or A6, A7 or A8 and common general knowledge, makes the subject matter of claim 1 obvious. The Board cannot, however, accept that the skilled person would have had any inkling that this was also being argued in the notice of opposition. All that the appellant says by way of justification of this submission is that the new argument is one based on documents already in the proceedings, that they relate to the same technical field and that they disclose in combination most of the features of claim 1, the remaining features being well known to the skilled person. Even if all this were true, it would still not mean that the skilled person would have understood that it was being said that A5 could just as well be taken as representing the closest prior art, or further that in such a case the subject matter of claim 1 was obvious, not in the light of A3, A5 or common general knowledge as originally had been said in relation to A10 or A12 as representing the closest prior art, but now in the light of A4, or A6, A7 or A8 and common general knowledge.

10. The Board therefore concludes that the notice of opposition did not contain any indication of facts, evidence or arguments in support of a ground of

- opposition based on lack of inventive step starting from A5 as representing the closest prior art.
11. The appellant also complains that a substantial violation of the right to be heard under Article 113(1) EPC took place before the Opposition Division, consisting of the refusal of the Opposition Division to hear its argument based on A5 as representing the closest prior art, and also that the minutes do not record this new argument. In this respect the appellant refers to decisions T 642/97 and T 92/92.
 12. It is correct that the minutes do not contain such a record - they are concerned mostly with the opponent's arguments in relation to the documents filed after the end of the opposition period. See paragraph IV, above. The Board would first observe, however, that if a party considers that the minutes are incomplete or wrong in that essential submissions are not reflected at all in the file it may request the Opposition Division to correct the minutes to preserve its rights. In the absence of such a request, the allegation of a procedural violation based on such an alleged failure cannot be substantiated. See T 642/97.
 13. In any event, the content of the minutes is generally a matter of discretion for the Opposition Division, provided that the minutes comply with Rule 124(1) EPC 2000 (formerly Rule 76(1) EPC 1973) and, in particular, contain the essentials of the *relevant* statements made by the parties.

14. The Board is nevertheless prepared to accept for the purposes of argument that the appellant did indeed attempt to raise the new argument based on A5 as the closest prior art but was to some extent prevented from making full submissions.

15. As to whether, on the above assumption, the Opposition Division *should* have allowed the appellant to develop its argument based on A5 as representing the closest prior art, the Board accepts that unless procedural rules provide to the contrary a party should in general not be prevented from raising new arguments during oral proceedings. See T 92/92, point 2:

"One of the principles of procedural law generally recognised in the Contracting States is the parties' right to a fair hearing. It includes the right of each party to present the facts, evidence and arguments it thinks relevant to the decision to be made and the duty of the deciding instance to duly consider what is put forward by each party."

16. However, as the Board pointed out in the same passage, this procedural right is not without limits. In that case, the Opposition Division was not concerned with the admissibility of the notice of opposition but with the substantive merits of the opposition itself, and was confronted with a new argument on inventive step based on facts and evidence already in the opposition proceedings. As the decision in T 92/92 makes clear, a party is not precluded from raising such an argument in these circumstances. In the present case, the Opposition Division had to decide under Rule 56(1) EPC 1973 whether the notice of opposition complied with

Rule 55(c) EPC 1973, in particular, whether it contained a sufficient indication of the "facts, evidence and *arguments*" in support of the grounds of opposition relied on. This involved examining the notice of opposition to see whether, *inter alia*, the arguments in the notice of opposition were sufficient to substantiate the ground of opposition of lack of inventive step. In this appeal the appellant has not argued that in the absence of its new argument based on A5 the notice of opposition would have complied with Rule 55(c) EPC 1973. Of course, a submission that the notice of opposition in fact contains a particular argument should be heard but in the present case this was palpably not so. It was not and is not the appellant's case that this new argument could be found somewhere in the notice of opposition, although perhaps couched in different terms.

17. The Opposition Division has a discretion in the conduct of oral proceedings, particularly having regard to the need for procedural economy and fairness to the parties. See T 1556/06, paragraph 5.2.4. In the present context, this includes the discretion to limit the submissions of the parties, in particular where the submissions can clearly be seen to be irrelevant. The Board has no way of knowing how far the appellant was allowed to develop its new argument before the Opposition Division but it would have soon been apparent that the argument was irrelevant, and the Board can see no procedural violation in the Opposition Division cutting the appellant short, if this is what indeed happened.

18. In any event, even if the Opposition Division had listened to the new argument at greater length, it would not, for the reasons given in paragraphs 7 to 9 above, have meant that the notice of opposition should have been held to be admissible.

19. For these reasons, the appeal will be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:

A. Counillon

U. Krause