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# Datasheet for the decision of 8 November 2010

**Case Number:** T 2291/08 - 3.2.03

**Application Number:** 98929636.3

**Publication Number:** 1007248

**IPC:** B22D 11/06

**Language of the proceedings:** EN

**Title of invention:**
Continuous casting process for producing low carbon steel strips and strips so obtainable with good as cast mechanical properties

**Patentee:**
ThyssenKrupp Acciai Speciali Terni S.p.A., et al

**Opponent:**
Castrip, LLC

**Headword:**
-

**Relevant legal provisions:**
EPC Art. 114(1), 100(c)
EPC R. 81(1), 103(1)(a)

**Keyword:**
"Introduction of a new ground of opposition by the opposition division - substantial procedural violation (yes)"
"Reimbursement of appeal fee (yes)"

**Decisions cited:**
G 0009/91, G 0010/91, T 1190/01, T 1099/06, T 0167/93

**Catchword:**
A ground of opposition (in this case Article 100(c) EPC) introduced by an opposition division under Article 114(1) EPC must be prima facie highly relevant. Given that, firstly, a previous board of appeal had expressly stated that the amendments were supported by the application as originally filed, and secondly, it is plausible from the application as a whole that the amendments are disclosed, it cannot be said that the allegations under Article 100(c) EPC are prima facie highly relevant. In these circumstances introduction of the new ground by the opposition division amounts to a serious procedural violation justifying reimbursement of the appeal fee.

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Beschwerdekammern | Boards of Appeal | Chambres de recours

**Case Number:** T 2291/08 **-** 3.2.03

# D E C I S I O N
**of the Technical Board of Appeal 3.2.03**
**of 8 November 2010**

**Appellants**: (Patent proprietors)
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**Representative**:
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**Respondent**: (Opponent)
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**Representative**:
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**Decision under appeal:**
**Decision of the Opposition Division of the European Patent Office posted 17 October 2008 revoking European patent No. 1007248 pursuant to Article 101(1) EPC.**

**Composition of the Board:**

**Chairman:** U. Krause
**Members:** G. Ashley
J.-P. Seitz

## Summary of Facts and Submissions

I. The European application for the contested patent (EP-B1-1 007 248) was initially refused by the Examining Division for lack of novelty (Article 54 EPC). The decision of the Examining Division was appealed by the applicants and overturned in T 1190/01, with the Board ordering a patent to be granted on the basis of a set of claims submitted during oral proceedings before the Board.

II. Grant of the patent was opposed on the grounds of lack of novelty and inventive step (Article 100(a) EPC) and for insufficiency of disclosure (Article 100(b) EPC).

III. In a communication dated 30 November 2007 the Opposition Division introduced of its own motion a new ground of opposition, namely that of extended subject-matter under Article 100(c) EPC together with Article 123(2) EPC.

IV. At the oral proceedings held on 1 October 2008, which was not attended by any of the parties, the Opposition Division took the decision to revoke the patent, as it concluded that the subject-matter of granted claim 1 extended beyond the application as originally filed (Article 100(c) EPC). The decision was posted on 17 October 2008.

V. The Patent Proprietors (Appellants) filed notice of appeal against this decision on 11 December 2008, paying the appeal fee on the same day. A statement containing the grounds of appeal was filed on 16 February 2009.

VI. Requests

The Appellants' (Patent Proprietors) requests are as follows:

(a) Main request:

The decision be set aside and the granted patent be examined with respect to the grounds cited by the Opponent, without remittal of the case to the Opposition Division.

(b) First Auxiliary Request:

The decision be set aside and the patent be maintained on the basis of the amended claims filed with the grounds of appeal, without remittal of the case to the Opposition Division.

(c) Second Auxiliary Request:

The decision be set aside and the patent as granted or amended according to the claims of the first auxiliary request be remitted to an Opposition Division having a different composition.

(d) Third Auxiliary Request:

The decision be set aside and the patent as granted or amended according to the claims of the first auxiliary request be remitted to the Opposition Division.

(e) Reimbursement of the appeal fee.

(f) Oral Proceedings:

Appointment of oral proceedings should the Board be considering rejection of the main, first, second and third requests.

The Respondent (Opponent) has not explicitly filed any requests, but it is assumed that rejection of the appeal is requested.

VII. Claims

(a) Claim 1 of the patent application as originally filed reads as follows:

"1. A process for the production of low carbon steel strips having a good combination of strength and formability, as cast, and a good weldability after the pickling by usual processes, comprising the following steps:

- casting, in a twin rolls continuous casting machine (1) comprising pinch rolls (3), a strip with a thickness comprised between 1 and 8 mm, having the following composition as weight percentage of the total weight:

C 0,02 - 0,10; Mn 0,1 - 0,6; Si 0,02 - 0,35; Al 0,01 - 0,05; S < 0,015; P < 0,02; Cr 0,05 - 0,35; Ni 0,05 - 0,3; N 0,003 - 0,012; and, optionally, Ti < 0,03; V < 0,10; Nb < 0,035, the remaining part being substantially Fe;

- cooling the strip in the area comprised between the casting-rolls and the pinch rolls (3);

- hot deforming the strip cast through said pinch rolls (3) at a temperature comprised between 1000 and 1300°C until reaching a thickness reduction less than 15%, in order to encourage the closing of the shrinkage porosities;

- cooling the strip at a speed comprised between 5 and 80 °C/s down to a temperature (Tavv) comprised between 500 and 850 °C; and

- coiling in to a reel (5) the so obtainable strip."

(b) Claim 1 of the granted patent reads as follows; compared with claim 1 of the application, it was amended by adding text (shown underlined) and deleting text (shown by strikethrough).

"1. A process for the production of low carbon steel strips having a good combination of strength and formability, ~~as cast,~~ and a good weldability after the pickling by usual processes, comprising the following steps:

- casting, in a twin rolls continuous casting machine (1) comprising pinch rolls (3), a strip with a thickness comprised between 1 and 8 mm, having the following composition as weight percentage of the total weight:

C 0.02 - 0.10; Mn 0.1 - 0.6; Si 0.02 - 0.35; Al 0.01 - 0.05; S < 0.015; P < 0.02; Cr 0.05 - 0.35; Ni 0.05 -

0.3; N 0.003 - 0.012; and, optionally, Ti < 0.03; V < 0.10; Nb < 0.035, the remaining part being ~~substantially~~ Fe apart from unavoidable impurities;

- cooling on both sides the strip in the area comprised between the casting-rolls and the pinch rolls (3), immediately downstream the casting rolls, the cooling being selected from the group consisting of water cooling and mixed water-gas cooling;

- hot deforming the strip cast through said pinch rolls (3) at a temperature comprised between 1000 and 1300°C until reaching a thickness reduction sufficient to encourage the closing of the shrinkage porosities maintaining the austenite grain dimensions larger than 150 µm, said reduction being less than 15%~~, in order to encourage the closing of the shrinkage porosities~~;

- cooling the strip at a speed > 10°C/s ~~comprised between 5 and 80 °C/s~~ down to a temperature (Tavv) comprised between 480 and 750°C ~~500 and 850 °C~~; and

- coiling in to a reel (5) the so obtainable strip."

VIII. Arguments of the Opposition Division and Submissions of the Parties

(a) New Ground for Opposition

(i) Arguments of the Opposition Division:

The Opposition Division is of the opinion that there is no support for the feature in granted claim 1 of cooling the strip at a speed of ">10°C/s down to a

temperature (Tavv) comprised between 480 and 750°C". It reasons that there is no disclosure in the original application of, firstly, cooling rates higher than 80°C/s, and secondly, of cooling at >10°C/s down to the defined temperature range. The Opposition Division is also of the view that there is no support for the amendment of the claim to include the feature of "maintaining the austenite grain dimensions larger than 150 µm" in the hot deforming step. Regarding claims 2 and 3, the Opposition Division holds that the omission of the expressions "as cast" and "a continuous pattern of the stress-strain diagram of the material" amounts to an unallowable generalisation contrary to Article 123(2) EPC.

Given that these amendments are *prima facie* open to objections under Article 123(2) EPC, the Opposition Division introduced a new ground of opposition under Article 100(c) EPC.

(ii) Appellants' Submissions

The Appellants argue that the introduction by the Opposition Division of a new ground for opposition amounts to a substantial procedural violation. In accordance with G 10/91, an Opposition Division can only exceptionally introduce a ground not raised in the notice of opposition if the ground *prima facie* would prejudice maintenance of the patent. Article 100(c) EPC is not *prima facie* relevant for the following reasons.

- The Board of Appeal in T 1190/01 had explicitly indicated in its decision support for the amendments; consequently the new ground is deprived of the self

evidence - ie the *prima facie* - character necessary to justify its late introduction into the proceedings.

- Since Article 100(c) EPC was not referred to in the notice of opposition, and since no new fact in relation to the amendment has arisen, the issue should be treated as *res judicata* under Article 111(2) EPC.

- G 10/91 establishes a distinction between cases where the opposition is filed at an early stage in the life of the patent and cases where it is filed at a late stage. G 10/91 recommends that an opposition division should not abuse Article 114(1) EPC by introducing a new ground when the opposition takes place many years after the filing of the patent application. In the present case the opposition was initiated more than ten years after the filing date of the application, and given that the case had already been before a board of appeal, this should have been taken into account by the opposition division when exercising its discretion under Article 114(1) EPC.

(b) Failure to Examine the Grounds of Opposition invoked by the Opponent.

By basing the refusal only on the new ground for opposition, the Appellants argue that the Opposition Division was in breach of Article 101(1)(2) and Rule 81(1) EPC, which stipulate that the grounds of opposition invoked by an opponent must be considered in any case. In particular, Rule 81 EPC requires that an opposition *shall examine* grounds invoked in the opponent's statement, whilst grounds not invoked by the opponent *may be examined*. This, read in conjunction

with G 10/91, establishes that a ground introduced under Article 114(1) EPC cannot replace the grounds invoked by the opponent, but may only be examined in addition thereto.

(c) Partiality

The Appellants submit that the behaviour of the Opposition Division in introducing the new ground amounts to a violation of the principle of impartiality.

The Appellants allege that the first examiner of the opposition division had manifested an incontestable negative attitude against the patentability of the invention; this examiner was also the first examiner of the examination division. Therefore, if the case is remitted to the department of first instance, it should be allocated to a different opposition division.

(d) Respondent's Case

The Respondent submitted no further written arguments, but agreed with the reasons given by the Opposition Division for revoking the patent.

## Reasons for the Decision

1. The appeal is admissible.

*New Ground of Appeal according to Article 100(c) EPC*

2. The contested patent has been revoked for containing subject-matter that extends beyond the content of the

application as originally filed (Article 100(c) EPC). This ground had not been raised by the Opponent in the notice of opposition, but had been introduced into the proceedings by the Opposition Division exercising its discretion under Article 114(1) EPC. The question facing the Board in the present case is whether the Opposition Division had exercised its discretion correctly.

3. Whilst the Opposition Division is entitled, pursuant to Rule 81(1) EPC to examine grounds for opposition not invoked by the opponent, the circumstances in which an opposition division should consider raising a ground of its own volition are set out in the decisions of the Enlarged Board G 9/91 and G 10/91. The view held by the Enlarged Board is that the notice of opposition, which includes a statement of the grounds on which the opposition is based (Rule 76(2) EPC), has the purpose of establishing the legal and factual framework within which the substantive examination of the opposition in principle is to be conducted. This was considered important in order to give the patentee a fair chance to consider its position at an early stage of the opposition proceedings (see paragraph 6 of G 9/91).

4. The Enlarged Board emphasised that consideration of grounds not covered in the notice of opposition is an exception to the above principle, and should only take place where *prima facie* there are clear reasons to believe such grounds are relevant and would in whole or in part prejudice the maintenance of the patent (paragraph 16 of G 9/91).

5. The Appellants in the present case argue that the ground under Article 100(c) EPC vis-à-vis Article 123(2) EPC was not *prima facie* relevant, and thus should not have been admitted.

6. It is relevant here that the application for the contested patent had initially been refused, and the decision appealed and heard as T 1190/01 before a different board of appeal from the present one. The Board in T 1190/01 concluded that the disputed claim met the requirements of Article 123(2) EPC (see point 2 of the Reasons).

7. It is well established case law of the boards of appeal that a decision taken in examination appeal proceedings is not binding in subsequent opposition proceedings (see Case Law of the Boards of Appeal of the EPO, VII.E.1, penultimate paragraph). This means that, contrary to the suggestion of the Appellant, the board's decision concerning Article 123(2) EPC is not *res judicata* and was open to challenge, for example by an opponent citing Article 100(c) EPC in the notice of opposition; this would be comparable to the situations arising in T 1099/06 and T 167/93. The question though is whether the Opposition Division was right to raise the ground later of its own volition.

8. The message of the Enlarged Board in G 9,10/91 is clear; as stated above, new ground can only be introduced by an opposition division in exceptional circumstances and only when *prima facie* relevant. The Appellants are correct in stating that the expression "*prima facie*" means "at first sight" or "on the face of it". This indicates that it should not be necessary to conduct a

detailed examination of the new ground before determining whether or not it is relevant.

9. The Board in T 1190/01 concluded that the amendments met the requirements of both Article 123(2) and Article 84 EPC. This is expressly stated in paragraph 2 of the Reasons for the Decision, which gives page 7, lines 28 to 30 as the basis for the amended feature "cooling at >10°C/s down to 480 and 750°C". The cited passage in the description of the original application is part of a discussion about the different types of microstructures that can be achieved, and states that a "cooling speed of >10°C/s in the temperature interval 750-480°C encourages the formation of non equiaxed ferrite grains". Thus, a cooling rate of >10°C/s from the hot deforming temperature down to the defined temperature range (Tavv), where coiling takes place, is not expressly defined in the original application. Nevertheless, examples of cooling rates >10°C/s down to this temperature range are disclosed (see for example Figure 2), with the maximum being 80°C/s. Although the claim does not now define an upper limit for the cooling rate, it might be argued that an appropriate value in practice would be readily apparent to the skilled person.

10. The Opposition Division was also of the view that there was no support for the amendment of the claim to include the feature of "maintaining the austenite grain dimensions larger than 150 µm" in the hot deforming step. As indicated by the Board in T 1190/01, this feature is disclosed in the original application on page 7 (lines 30 to 31), where it is said to encourage the formation of non equiaxed grains. It would seem

that this feature is indeed presented as being of relevance to all the steels contemplated by the application.

11. Regarding claims 2 and 3, the Opposition Division was of the view that the omission of the expressions "as cast" and "a continuous pattern of the stress-strain diagram of the material" amounts to an unallowable generalisation contrary to Article 123(2) EPC. The Appellants argue that the invention only concerns as cast structures (see page 1, lines 5 to 7), and hence the claimed subject-matter must also relate to such steel strip, whether or not it is explicitly defined. The feature of "a continuous pattern of…" describes a property inherent to the steel product, hence failure to mention of this property neither adds nor detracts from the claimed subject-matter. There are thus plausible reasons why these amendments may be allowable.

*Summary*

12. It is of no concern here whether, after detailed consideration, a claim has been amended to contain added subject-matter, but rather whether, given the exceptional circumstances of the late stage of the proceedings, the alleged objection is *prima facie* highly relevant.

13. Given that the previous Board had expressly stated, together with a reference to a passage in the original application, that the amendments find support, and in addition, when the application as a whole is considered it is also plausible that the amended features were

disclosed, it cannot be said that the allegations under Article 100(c) EPC are *prima facie* highly relevant.

14. Consequently, the Board is of the view that introduction of the ground for opposition under Article 100(c) by the Opposition Division of its own volition is contrary to G 9,10/91 and, given the circumstances of the present case, constitutes a procedural violation.

15. Since this was the sole ground cited by the Opposition Division for revocation of the patent, it is serious and justifies reimbursement of the appeal fee (Rule 103(1)(a) EPC).

*Main and First Auxiliary Requests*

16. The Appellants request that the decision under appeal be set aside and the granted patent (main request) or the claims filed with the grounds of appeal (first auxiliary request) be examined with respect to the grounds cited by the Opponent, without remittal of the case to the Opposition Division.

17. Grant of the patent was opposed for lack of novelty and inventive step (Article 100(a) EPC) and for insufficient disclosure (Article 100(b) EPC). None of these grounds has been dealt with by the Opposition Division, and it is not the function of an appeal board to decide upon issues arising for the first time during the appeal proceedings. The case can only receive procedurally correct treatment if it is remitted to the department of first instance.

18. Consequently, the main and first auxiliary requests of the Appellant are not allowed.

*Second Auxiliary Request*

19. The Appellants request that the decision be set aside and the patent as granted or amended according to the first auxiliary request be remitted to an Opposition Division having a different composition. The reason given by the Appellants for this request is that the first examiner of the Opposition Division had "manifested an incontestable negative attitude against the patentability of the invention", and that this examiner was also the first examiner of the Examination Division that had dealt with the contested patent.

20. The mere fact that the view held by an examiner on any particular issue differs from that of a party is *per se* insufficient for requesting a change in composition. In addition, the appointment of examiners to an opposition division is primarily an administrative function for which the director of the relevant department of first instance is responsible; the boards of appeal are limited to merely reviewing a case to establish whether the requirement of impartiality has been fulfilled (see T 838/02, point 8 of Reasons).

21. Nevertheless justice must not only be done, but it must be seen to be done, and it is well established case law of the boards of appeal that a suspicion of partiality or bias may be sufficient to invalidate a first instance decision (see Case Law of the Boards of Appeal of the EPO, 6th edition 2010, VI.J.3), even though in the vast majority of cases in which suspicion of

partiality is raised, no actual bias is established (see T 900/02 point 4 of the Reasons).

In the present case, the combination of the following facts cast serious doubt on the impartiality of the Opposition Division:

- the merits of the disputed amendment had already been decided by a board of appeal;
- the ground under Article 100(c) EPC which led to revocation of the patent had not been raised by the Opponent, but was introduced *ex officio* by the Opposition Division;
- the same primary examiner had acted in both decisions under appeal.

Such doubts are sufficient to declare the impugned decision null and void *ab initio*.

In addition, there should be no ground for dissatisfaction with the conduct of the further proceedings in this case, such as might be if the same Opposition Division were to revoke again the patent, even after an impeccably conducted proceedings.

22. For these reasons the Board considers it appropriate to recommend that the case be heard by an opposition division having a different composition.

23. The present case gives grounds for questioning whether the current arrangement, in which the same examiner may be responsible for drawing up the search report, drafting the European search opinion, and then carries out the function of first examiner in both the

examination and opposition divisions, can be considered judicially fair. In particular, opposition is an independent procedure and is not to be seen as a continuation or extension of the examination procedure (see G 1/84, Reasons Point 9 and G 9,10/91).
Article 19(2) EPC requires that at least two members of the examining division are replaced, and that the first examiner of the examining division cannot become the chairman of the opposition division. However, this does not prevent the same examiner from carrying out the primary task of examining in both examination and opposition, which may lead to a continuity of views that blurs the independence of the two procedures.

*Reimbursement of the appeal fee.*

24. For the reasons given in paragraph 15 above, the Board agrees that it is appropriate to reimburse the appeal fee.

*Further Requests*

25. Since the Board intends to grant the Appellant's second auxiliary request, it is not necessary to consider the third auxiliary request or appoint oral proceedings.

## Order

**For these reasons it is decided that:**

1. The decision under appeal is set aside.

2. The case is remitted to an opposition division for further prosecution, with a recommendation to change the composition of the opposition division.

3. The appeal fee is reimbursed.

The Registrar: The Chairman:

A. Counillon U. Krause