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**Datasheet for the decision
of 10 February 2015**

Case Number: T 2190/10 - 3.2.06

Application Number: 98119003.6

Publication Number: 0893184

IPC: B23B3/06, B23Q39/04

Language of the proceedings: EN

Title of invention:

Automatic lathe

Patent Proprietor:

STAR MICRONICS CO., LTD.

Opponent:

TORNOS-BECHLER SA

Headword:

Relevant legal provisions:

EPC Art. 123(2), 123(3), 104(1)

EPC 1973 Art. 100(c)

RPBA Art. 11, 16(1)

Keyword:

Apportionment of costs - not equitable
Substantial procedural violation - (no)
Amendments - extension beyond the content of the application
as filed (yes) - main request, auxiliary request 1 -
broadening of claim (yes) - auxiliary request 2

Decisions cited:

Catchword:



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Case Number: T 2190/10 - 3.2.06

D E C I S I O N
of Technical Board of Appeal 3.2.06
of 10 February 2015

Appellant: STAR MICRONICS CO., LTD.
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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 31 August 2010
revoking European patent No. 0893184 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman M. Harrison
Members: T. Rosenblatt
W. Ungler
M. Hannam
W. Sekretaruk

Summary of Facts and Submissions

I. European patent No. 0 893 184 was granted with the following two independent claims:

"1. An automatic lathe comprising:
a pair of gang tool posts (5,7) disposed on opposite sides with a headstock (1) in between, said headstock (1) having a main spindle and being movable in an axial direction of said main spindle, **characterized in that** said automatic lathe further comprises
a first mechanism for controlling movement of one (5) of said pair of gang tool posts (5,7) in an X-axial direction and a Y-axial direction both perpendicular to said axial direction of said main spindle and perpendicular to each other in order to perform tool selection and machining, and
a second mechanism for controlling movement of the other (7) of said pair of gang tool posts (5,7) in an X'-axial direction and a Y'-axial direction both perpendicular to said axial direction of said main spindle and perpendicular to each other to perform tool selection and machining independently of said control of movement of said one (5) of said pair of gang tool posts (5,7) by said first mechanism, wherein while a workpiece is machined by a tool of one gang tool post (5), the other gang tool post (7) can be moved under the control of the second mechanism in the Y'-axial direction to select and bring a tool of the other gang tool post to a position adjacent the workpiece from where the tool can be brought to a machining position by movement solely in the X'-axial direction under the control of the second mechanism."

"8. A method of machining a workpiece using a lathe according to any of the preceding claims, the method comprising:

- i) mounting a workpiece in said headstock (1);
- ii) moving the one gang tool post (5) in one or both of the X-axial and Y-axial directions to bring a tool to a machining position and operating the tool to machine the workpiece;
- iii) during the machining part of step (ii), moving the other gang tool post (7) in the Y'-axial direction to bring a tool to a position adjacent the workpiece; and then
- iv) moving the other gang tool post (7) solely in the X'-axial direction to bring the tool on the other gang tool post to a machining position and operating the tool to machine the workpiece."

II. The patent was opposed on the grounds of Article 100(a) and 100(c) EPC 1973, whereby the ground of extension of subject-matter was raised in regard to the granted dependent product claims 3 and 7.

III. Oral proceedings before the opposition division took place on 6 to 8 October 2009 during which a number of witnesses were heard in regard to several alleged prior uses. The minutes report the following:

At the beginning of the oral proceedings, the parties were asked to present their arguments in regard to the opposition ground under Article 100(c) EPC 1973. The parties only referred to their written submissions (item 7 of the minutes). The witnesses were heard (items 8-26). On the third day, after an evaluation of the evidence and of the testimony of the witnesses heard on the previous day in regard to one of the alleged prior uses, the opposition division gave its preliminary

opinion on novelty of the subject-matter of claim 1 in regard to certain documents and to the alleged public prior uses (items 27-31). The patent proprietor then requested clarification of exactly which features were considered by the opposition division to be comprised in the state of the art constituted by one of the prior uses. The opposition division informed the proprietor that this question appeared to relate to the interpretation of the claims and/or the prior use, which would be part of the substantive matters (novelty and/or inventive step) which had yet to be discussed (items 32-34). Thereafter the opponent made further objections under the opposition ground of Article 100(c) EPC 1973 to the independent claims as granted. The proprietor requested that the "extension" of the opposition ground in this way should not be allowed. However, the opposition division considered it admissible (items 35-39). The opponent raised objections under Article 100(c) and (a) EPC 1973 (item 40). The proprietor requested more time to respond to these late filed submissions as well as a different apportionment of costs (item 41). The oral proceedings were adjourned and the procedure continued in writing (item 43).

- IV. The parties were then summoned to a second oral proceedings. In the annex to the summons, the opposition division stated that the conclusions presented therein constituted "a preliminary opinion that does not prejudice the final decision". The opposition division stated that the granted independent claims contained subject-matter extending beyond the content of the application as filed. It also considered the subject-matter of claim 1 as lacking novelty in view of some of the alleged prior uses. It also stated the features it considered to be disclosed in some of the other pieces of evidence on file. The patent proprietor replied in

writing that it would not attend the oral proceedings, requesting instead a decision based on the written submissions. It also provided further arguments in regard to the issue of added subject-matter. The proprietor additionally took issue with the division's approach to the assessment of novelty since it had already decided which features were known from the prior uses without the proprietor having been given an opportunity to present its arguments on claim construction. The proprietor also maintained its request for a different apportionment of costs. The opposition division subsequently cancelled the summons to the second oral proceedings.

V. By its decision posted on 31 August 2010, the opposition division revoked European patent No. 0 893 184.

VI. The reasons underlying the impugned decision are essentially the following:

Item 2 of the reasons contains a discussion of the arguments of the parties on the issue of "Extension of scope beyond the content of the application as filed". The opposition division concludes that the specific sequence of movements defined in granted claim 1 by the last feature, "while a workpiece is machined by a tool of one gang tool post (5), the other gang tool post (7) can be moved under the control of the second mechanism in the Y'-axial direction to select and bring a tool of the other gang tool post to a position adjacent the workpiece from where the tool can be brought to a machining position by movement solely in the X'-axial direction under the control of the second mechanism", was not disclosed in the application as filed.

In item 3, the opposition division states (emphasis

added by the opposition division): **"The European patent is therefore revoked** on the ground of Article 100(c) EPC because it contains subject-matter which extends beyond the content of the application as filed, contrary to the requirement of Art. 123(2) EPC (Article 101(2) EPC), the same also applying when taking account of the amendments made by the patent proprietor during opposition proceedings in accordance with the auxiliary request (Article 101(3) (b) EPC)."

Item 4 is headed "Additional observations". In item 4.1 another issue in regard to the extension of subject-matter is considered in favour of the patent proprietor. Item 4.2 comprises considerations concerning novelty and inventive step. The introductory statement thereto reads: "Furthermore, if it could be concluded that Article 123(2) EPC is met, the subject-matter of claim 1 as granted would not be considered new within the meaning of Article 54(1) and (2) EPC, and therefore the requirements of Article 52(1) EPC would not be met." Item 4.2.1, "State of the art", then contains an evaluation of the evidence and of the witness testimonies, item 4.2.2 a discussion of novelty in regard of one of the alleged public prior uses which it previously, in item 4.2.1, found to be made available to the public.

Item 5 of the reasons for the impugned decision is directed to "Procedural matters".

Item 6 contains the reasons for the rejection of the proprietor's request for a different apportionment of costs under Article 104(1) EPC, based on criteria set out in the Guidelines for Examination, D-IX, 1.4.

VII. The appellant (patent proprietor) filed an appeal against this decision and in the appeal grounds argued essentially as follows:

- Main request - Article 100(c) EPC 1973

The person skilled in the art of automatic lathes would understand from the description of automatic lathes of the prior art and the drawbacks they involved (no independent movement of the gang tool posts of the known machine), explained in column 1 of the application, and from the outlining of the invention in column 3, that the aim of the invention underlying the patent in suit was to shorten the machining time, thus improving the productivity. Two examples of the resulting capabilities of the new machine design were explained in column 4, the first being simultaneous machining of the workpiece. The second was the movement described in column 4, lines 4 to 6, which allowed that "while one tool is machining a workpiece, another tool can be positioned at a predetermined position to be ready for machining". The skilled person would have understood that the independent movement of the two gang tool posts allowed for simultaneous actions of the gang tool posts, resulting in the productivity increase. From Figures 1, 8 and 9 and the description in column 8, lines 4 to 18, it was implicit that in order to select a tool at the second gang tool post this had to be moved along the Y' direction while the first gang tool post was machining the workpiece. Only by these steps (disregarding the possibility for simultaneous machining which was explicitly excluded by the claim) the productivity increase could be achieved compared to prior art lathes where the gang tool posts were unable to move independently from each other.

- Auxiliary request 1

The request was identical to the main request, except that the apparatus claims were replaced by method claims. It therefore met the requirements of Article 123(2) EPC for the same reasons as outlined in relation to the main request.

- Auxiliary request 2

The specific sequence of movements defined by the deleted feature was provided for by the more general requirement of independent movement of the two gang tool posts defined in the preceding and remaining features in claim 1. It was impossible to design a machine with gang tool posts which were truly independently movable of each other, as defined by the remaining features of claim 1, but which could not perform this sequence of movements. The feature thus only added information to the claim, but did not provide any additional limitation. It could therefore be deleted without infringing the requirement of Article 123(3) EPC.

- Request for remittal to the opposition division

The opposition division took a final decision on substantiation of the alleged prior uses without having given the appellant sufficient opportunity to argue on claim construction, novelty and inventive step. By stating which features it considered to be disclosed by the prior use when using the language of the claims but without construing the meaning of the claim, the opposition division had already pre-judged the outcome of the novelty objection. The appellant was therefore deprived of its right to be heard under Article 113 EPC on the issues of claim construction, novelty and

inventive step. Due to this fundamental procedural deficiency, the case should be remitted to the opposition division according to Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA).

- Request for an apportionment of costs

To be able to order a different apportionment of costs under Article 104(1) EPC, irresponsible or malicious behaviour on the part of one party was not a requirement. Inequity could also arise through an honest mistake by one party too. The EPC moreover did not foresee any mechanism for gathering evidence on the question as to whether an honest mistake had been made or whether a party had deliberately manipulated and abused the procedure. Also, from Article 16 RPBA, it was apparent that reasons other than only irresponsible or malicious behaviour, such as "acts or omissions prejudicing the timely and efficient conduct of oral proceedings", which applied particularly well to the present case, could give rise to an order for a different cost apportionment under Article 104(1) EPC. Furthermore, decisions T 970/93, T 117/86, T 867/92 or T 705/92 confirmed that irresponsible or malicious behaviour by a party was not a general prerequisite. All that was required was that the act or omission of one party caused an increase of costs for the other party.

Even if malicious or irresponsible behaviour were seen to be required for the Board to order a different apportionment of costs, raising the objection so late in the proceedings of the present case could be qualified as such. The objection under Article 100(c) EPC could and should have been spotted from the prosecution history of the amendments carried out during examination of the application. If this check had been omitted by

the opponent, or the result thereof considered as not *prima facie* highly relevant, the opponent's action then lacked the required care and it could be judged that it had therefore behaved negligently and irresponsibly, to the detriment of the proprietor. If, on the other hand, the check had indeed been carried out but the result thereof had been deliberately withheld, the opponent's action would have been clearly malicious. The appellant had no reason to doubt the opponent's statements during the oral proceedings of 6 to 8 October 2009 that its actions simply resulted from an error, nor were there any mechanisms in the EPC allowing this to be investigated in case of doubt. It was nevertheless the case that the opponent's behaviour lacked the required care due in the circumstances, thereby justifying an apportionment of costs in favour of the appellant.

The opponent had filed a substantial number of documents concerning alleged prior uses as well as new arguments after the opposition period, without any explanation as to why these submissions could not have been filed in time. These arguments and documents, amongst which a number were ultimately not admitted into the proceedings, resulted in a large amount of additional work compared to the work involved with the original notice of opposition. Had the objection under Article 100(c) EPC been raised during the opposition period, the costs involved with hearing the witnesses and presenting arguments in respect of the prior uses would not have been incurred.

In the present case it followed from the mistake of the opponent that the proprietor had to bear substantial additional costs. For the oral proceedings, the appellant had employed two professional representatives and a trainee. A representative from the appellant

company had also attended the oral proceedings. Similarly, the costs incurred by the appellant resulting from the discussions of the prior uses in the impugned decision, which had to be dealt with in the appeal grounds, as well as those arising from the appellant's submissions between the oral proceedings before the opposition division and the written decision, could have been avoided.

VIII. In its reply to the appeal grounds the respondent (opponent) refuted the appellant's arguments.

IX. In the communication annexed to a summons to oral proceedings before the Board, the Board informed the parties of its provisional opinion on the case.

In regard to the main request, the Board noted the following:

- a) "As a basis for the disclosure of the added feature defining the sequence of method steps which the lathe should be adapted to perform (in the following also "sequence feature"), the appellant appears to rely *inter alia* on the statement in column 4, lines 4 to 6, of the A-specification. This statement is seemingly interpreted differently by the parties. Whereas the appellant seemingly understands the expression "can be positioned at a predetermined position" in the sense of "can be moved..." (cf. granted claim 1), the respondent seemingly understands the same wording as disclosing a stationary state of the "another tool" while the first tool is machining (cf. "*an einer bestimmten Position positioniert sein kann*" in the last paragraph of page 8 of the letter of 17.5.2011). This latter interpretation

appears to be in line with the disclosure in column 8, line 8, where the expression "is held" is employed (see also further down line 32). It appears therefore that Y-axial movement of the second gang tool post while machining with a tool at the first gang tool post is not directly and unambiguously derivable from the above passages relied upon by the appellant.

It may be a matter of discussion whether the other passages cited by the appellant disclose the sequence feature. In this respect, the appellant also argued that it would be implicit to the skilled person from the desired increase of productivity that this Y-axial movement of the second gang tool post would be performed during the machining with a tool from the first post. It could therefore be discussed whether, based on the passages cited by the appellant in support of its argument (in col. 1, 3, 4 and 8), Y-axial movement of the second gang tool post during the machining at the first post is implicitly disclosed. It presently appears to the Board that also a positioning of the second gang tool post before starting machining on the first post and holding the second post during machining at that predetermined position would also allow machining to start immediately on the second post.

As a consequence the Board is of the provisional opinion that the subject-matter of claim 1 appears to extend beyond the content of the application as filed for this reason. Similar considerations would appear to apply to claim 8."

With respect to the amendments made by way of the first auxiliary request, the Board considered that these did not appear to remedy the deficiency.

Concerning the second auxiliary request, the Board noted *inter alia* the following:

- b) "Discussion appears however to be required in respect of at least the requirement of Article 123(3) EPC. The arguments of the appellant seemingly are based on the understanding that the contentious sequence feature does not imply any additional limitation to the claimed automatic lathe since otherwise such machine could not "truly be described as a machine that can perform tool selection and machining on one gang tool post independently of the control of movement of the other gang tool post" (cf. item 36 of the appeal grounds). The Board notes that claim 1 defines the second mechanism for controlling the X- and Y-axial movements of the second post so as "to perform tool selection and machining independently of said control of movement of said one of said pair of gang tool posts by said first mechanism" (emphasis added by the Board). It could be discussed whether the sequence feature of granted claim 1 would be understood by the person skilled in the art as merely explicitly defining a result of the claimed movement independence which is implicit from the preceding definition of the two mechanisms (see also item 72 of the appeal grounds) or as implying additional structural limitations to an automatic lathe. The Board is of the provisional opinion that the sequence of method steps defined in granted claim 1 could be implemented by appropriate hardware or software in

a control unit of an automatic lathe. Such control unit could command both mechanisms without necessarily compromising their independence of movements. An automatic lathe with "independent first and second movement control mechanisms" as defined in claim 1 but with a control unit implementing a different sequence, for example in which the movement of the second post would be carried out after having driven the first post to a machining position but before starting machining at the first post would not fall within the scope of granted claim 1. Such lathe would however fall under the scope of the amended claim 1 according to the second auxiliary request. It appears therefore that the deletion of the sequence feature has indeed extended the scope of protection."

By referring to Article 11 RPBA, the Board also opined that the appellant's argument concerning a procedural deficiency allegedly made by the opposition division did not justify an immediate remittal of the case to the opposition division.

Having regard to the appellant's request for a different apportionment of costs, the Board indicated that the decision of the opposition division rejecting the request appeared to have been correct. The Board also stated the following in this regard:

- c) "By extending its objections under Article 100(c) EPC to the subject-matter of independent claim 1 and 8, the opponent did not seemingly introduce any new facts or evidence into the proceedings, contrary to the case law referred to by the appellant. The objection could also have arisen at any moment in the procedure; it could also have

been raised by the opposition division of its own motion (Article 114(1) EPC) even after a discussion on novelty or inventive step had been concluded. The Board therefore currently considers that it would not be equitable to order a different apportionment of costs."

- X. In reply to the Board's communication, the appellant indicated that it would not attend the oral proceedings. Upon an enquiry by the Board, the appellant confirmed that its request for oral proceedings was maintained.

The appellant did not provide any argument in response to the Board's preliminary opinion.

- XI. The respondent also did not submit further arguments in reply to the Board's preliminary opinion.

- XII. Oral proceedings before the Board were held on 10 February 2015 in the absence of the appellant.

- XIII. The appellant requested in writing that the decision under appeal be set aside and the patent be maintained as granted, auxiliarily that the patent be maintained in amended form on the basis of the claims of the first auxiliary request filed with letter dated 20 March 2008, or on the basis of the claims of the second auxiliary request filed with letter dated 24 December 2010. It was also requested that the file should be remitted to the opposition division for further prosecution. Additionally, the appellant requested an apportionment of costs in its favour.

- XIV. The respondent requested that the appeal be dismissed.

- XV. Claim 1 of auxiliary request 1 is based on claim 1 as granted and comprises the following amendments: the designation of the invention is changed to "A method of machining a workpiece using an automatic lathe comprising...", the expression "characterised in that" is replaced by the term "wherein", and the method steps defined in granted claim 8 have been added at the end of the claim.
- XVI. Claim 1 of auxiliary request 2 is based on claim 1 as granted, but with the feature "wherein while a workpiece is machined by... X'-axial direction under the control of the second mechanism" being deleted.

Reasons for the Decision

1. Alleged procedural deficiency and request for remittal
- 1.1 According to Article 11 of the Rules of Procedure of the Boards of Appeal (RPBA), a Board shall remit a case to the department of first instance if fundamental deficiencies are apparent in the first instance proceedings, unless special reasons present themselves for doing otherwise.

In the present case, the alleged procedural deficiency is not causally linked to the impugned decision of the opposition division to revoke the patent. Items 2 and 3 of the reasons of the impugned decision (see item VI. above) clearly indicate that the patent was revoked because it was considered to contain subject-matter extending beyond the content of the application as filed. It is not apparent to the Board from the history of the case that the right to be heard was denied in

this regard. After the adjournment of the first oral proceedings, the appellant-proprietor filed its comments in reply to the division's opinion on this objection comprised in the annex to the summons to the second oral proceedings (see item IV. above) and requested a decision in writing. The appellant was thus given sufficient opportunity to comment on the objection leading to the revocation. The appellant also did not contest this. The procedure before the opposition division in regard to the opposition ground of added subject-matter can therefore not be considered deficient in regard to the appellant's right to be heard.

Item 4 of the impugned decision is entitled "Additional observations". Although the opposition division indeed drew a number of further conclusions in regard to *inter alia* the prior uses (see item 4.2 of the decision and also point VI. above), and even in regard to what it considered to be comprised in the state of the art, as well as on novelty and inventive step matters, these considerations do not constitute grounds for the revocation of the patent. These considerations are also not considered to constitute a final decision of the opposition division. Whether or not in regard to these specific considerations in the impugned decision and, in view of the statements made by the opposition division during the oral proceedings in regard to claim construction, novelty and inventive step (see above point III., summary concerning items 27-34), the appellant had sufficient opportunity to defend its case is therefore not relevant.

The Board thus has no reason to remit the case to the opposition division on the ground of a procedural deficiency (Article 11 RPBA).

1.2 In view of the Board's conclusions below on the allowability of the claims of the main request and of auxiliary requests 1 and 2 in regard to the requirements of Article 123 EPC, the conditional requests for remittal of both parties do not require further consideration.

2. Main request - Article 100(c) EPC 1973

The question to be decided in the present case is whether the maintenance of the patent as granted is prejudiced on the ground that the subject-matter of granted claim 1 resulting from the addition of the functional feature "wherein while a workpiece is machined by... X'-axial direction under the control of the second mechanism", to the originally filed claim 1, extends beyond the content of the application as filed.

The Board's preliminary opinion on this question had already been notified to the parties (see item IX.a) above), provisionally concluding that this amendment resulted in subject-matter extending beyond the content of the application as originally filed. The appellant did not provide any counter-argument. The Board thus has no reason to change its preliminary conclusion and hereby confirms that opinion, for the reasons already given in the Board's communication.

Consequently the appellant's main request cannot be allowed.

3. Auxiliary request 1 - Article 123(2) EPC

Claim 1 according to this request is based on the wording of granted claims 1 and 8, and is now directed to a "method of machining a workpiece using an automatic

lathe", which lathe is further defined by the identical features as defined in granted claim 1. The features of claim 1 have further been supplemented with the method steps of granted claim 8. The contentious feature is however still comprised in the claim. The redrafting of the claim and the addition of the method steps from claim 8, which was provisionally also considered to comprise added subject-matter (cf. item IX.a) above), has thus not remedied the deficiency with respect to the disclosure of the sequence feature. The appellant did not provide any supporting argument in this respect. Therefore the Board does not see any reason to change its provisional opinion.

The Board thus confirms its provisional opinion and finds that the subject-matter of claim 1 of auxiliary request 1 extends beyond the content of the application as filed, so that this auxiliary request is also not allowable.

4. Auxiliary request 2 - Article 123(3) EPC

4.1 This request was submitted with the appeal grounds and thus forms part of the appellant's case (cf. Article 12(2) RPBA).

The respondent objected to the admission of this request on the ground that it had not been filed before the opposition division although it could have been filed earlier. The Board however informed the parties in its communication in preparation for the oral proceedings that it did not intend to make use of its power according to Article 12(4) RPBA to hold this request inadmissible. The respondent did not submit any further comment in this regard so that the Board has no reason to change its preliminary view.

4.2 Claim 1 of this request is again directed to an automatic lathe as defined in granted claim 1 but with the contentious sequence feature deleted. This amendment therefore raises the question of whether, by this deletion, the scope of protection conferred by the amended claim is extended compared to the scope of protection conferred by granted claim 1 (Article 123(3) EPC). Also on this question, the Board's preliminary opinion had been notified to the parties (see item IX.b) above), provisionally concluding that this amendment resulted in extension of the scope of protection. The appellant, again, did not provide any counter-argument as to why the Board might be incorrect, so that the Board has no reason to change its preliminary conclusion and confirms same herewith for the reasons mentioned in the Board's communication.

The appellant's second auxiliary request is therefore also not allowable.

5. Apportionment of costs - Article 104 EPC

5.1 Article 104(1) EPC sets out that each party to opposition proceedings shall bear the costs it has incurred, unless the opposition division, for reasons of equity, orders a different apportionment of costs.

5.2 The appellant essentially claims that such different apportionment is equitable in the present case since it had incurred additional costs due to the admitted mistake of the respondent-opponent during the opposition procedure, irrespective of whether this mistake could be qualified as an honest mistake or as irresponsible or even malicious behaviour. The additional costs were those incurred for the unnecessary hearing of the

witnesses and those arising from the additional written submissions subsequent to the adjournment of the oral proceedings, as well as those arising from having to deal with the analysis of the prior uses in the impugned decision.

5.3 It is undisputed that the respondent-opponent did not raise the fatal objection against the independent claims, which finally led to the revocation of the patent in suit, in the notice of opposition. Nor was this objection even raised at the beginning of the oral proceedings before the opposition division when the chairman asked the parties to comment on the ground of opposition under Article 100(c) EPC. Indeed, both parties relied only on their written statements (see item III. above). The Board however cannot see anything in the procedure before the opposition division suggesting that the fatal objection was raised deliberately at such a late stage of the proceedings. Whether the respondent-opponent's mistake was an "honest" mistake or whether it could be considered as negligent or irresponsible behaviour is irrelevant here. What has to be considered is whether, as a direct consequence of the respondent-opponent's acts or omissions, of not having raised that objection earlier, the appellant incurred additional costs.

5.4 As had been noted in the Board's preliminary opinion (see item IX.c) above), contrary to the case law cited by the appellant, no new facts or evidence were introduced into the present opposition proceedings which would have belonged to the exclusive knowledge of the respondent-opponent or which could have been withheld from being presented to the opposition division and the appellant-proprietor until the respondent-opponent considered it appropriate for its purposes. All facts

and evidence relevant for this objection, i.e. the patent in suit and its underlying application, were at all times accessible to the opposition division and the appellant-proprietor. The fatal objection could thus have been raised at any time by anybody, for example by the opposition division of its own motion (Article 114(1) EPC), even after a discussion on novelty or inventive step had been concluded. Additional costs incurred by the appellant can thus not be considered as a direct consequence of the respondent-opponent's acts or omissions. The Board did not receive any further comment on behalf of the appellant to its preliminary opinion. Again, the Board sees no reason to change its preliminary opinion in this regard either.

5.5 The appellant further relied on Article 16(1)(c) and (e) RPBA. The facts on which the appellant based its request for a different apportionment of costs occurred during the procedure before the opposition division. Article 16 RPBA does however not apply to such proceedings. As has been set out above, the omission of not having raised the fatal objection earlier in the proceedings cannot be charged exclusively to the respondent-opponent. The opposition division chose to admit the objection. Nor can any clear sign of procedural abuse be seen.

5.6 Moreover, it remains nothing more than mere speculation whether, if the fatal objection had been raised earlier, this would have avoided additional costs. It cannot be excluded that the hearing of the witnesses and the evaluation of their testimony could for example have changed the opposition division's substantive appreciation of the matters to be decided. Therefore, irrespective of the fact that the objection had been raised only after the hearings, this objection was considered so highly relevant for the decision that it

was admitted into the proceedings and led to adjournment of the oral proceedings and to the revocation of the patent. This does not automatically mean that the opposition division would necessarily have reached the same conclusion before the hearings. Nor can it necessarily be concluded that the hearings would have been cancelled. The Board therefore does not accept the appellant's argument that the costs for representation at the oral proceedings or those linked to the work for preparing a response to that objection in the subsequent written procedure would clearly have been unnecessary if the objection had been raised earlier.

- 5.7 The Board therefore concludes that additional costs the appellant-proprietor might have incurred were not causally and exclusively linked to the opponent's behaviour. It is thus not equitable to order a different apportionment of costs. The request is therefore rejected.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



N. Schneider

M. Harrison

Decision electronically authenticated