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**Datasheet for the decision
of 9 August 2012**

Case Number: T 1856/11 - 3.2.07
Application Number: 06005936.7
Publication Number: 1707513
IPC: B65G 47/90, B65G 47/52
Language of the proceedings: EN

Title of invention:

Method and apparatus for transferring articles from a first conveyor to a second conveyor

Patentee:

Marchesini Group S.p.A.

Opponent:

ABB AB

Headword:

-

Relevant legal provisions:

EPC Art. 111(1)
EPC R. 76(2)(c)

Keyword:

"Admissibility of the opposition: yes"
"Remittal: yes"

Decisions cited:

T 0222/85, T 0328/87, T 1096/96

Catchword:

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Case Number: T 1856/11 - 3.2.07

DECISION
of the Technical Board of Appeal 3.2.07
of 9 August 2012

Appellant: ABB AB
(Opponent) Kopparbergsvägen 2
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Respondent: Marchesini Group S.p.A.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 June 2011
concerning the inadmissibility of the opposition
(Rule 77 EPC) filed against the European Patent
No. 1707513.

Composition of the Board:

Chairman: H. Meinders
Members: K. Poalas
E. Kossonakou

Summary of Facts and Submissions

- I. The appellant (opponent) lodged an appeal against the decision of the Opposition Division rejecting the opposition against the European patent No. 1 707 513 as inadmissible. It was namely held that the notice of opposition did not comply with the provisions of Rule 77(1) EPC in conjunction with Rule 76(2)c) EPC.
- II. The appellant requested in the notice of appeal that "it be decided that the opposition is admissible". Oral proceedings were requested as an auxiliary measure.

With the statement of grounds of appeal the appellant submits the requests ("claims") that:

1. "the ... opposition is found admissible in accordance with Rule 76(2) EPC",
2. "the decision from the Opposition Division is set aside so that European patent 1707513 can be revoked [*sic*] in view of the extensive and *prima facie* relevant prior art",
3. "the decision from the Opposition Division is set aside and the case remitted to the first instance for reconsideration of the validity of the patent in view of all cited prior art in the interest of the public".

The respondent (patent proprietor) requested the dismissal of the appeal and, in case the Board would find that the opposition is admissible, the remittal of the case to the first instance for further prosecution. No oral proceedings were requested.

- III. The following documents of the opposition proceedings filed during the opposition period are mentioned in the

present decision:

- D1: User's Guide for PickMaster™ 2002 Version 2.30
(Pages 1-6, 20, 24, 31-33, 70, 129-131)
- D2: WO 2004 113030 A1
- D3: Order Confirmation for Vipal S/AGB-A-593 278.

IV. The appellant argued essentially as follows:

Admissibility of the opposition

The question is whether the notice of opposition gives an indication of facts and evidence in support of the grounds of lack of novelty and of inventive step.

Documents D1 to D3 have been presented in the notice of opposition together with argumentation. In the notice of opposition it was explained how and why D1 and D2 are believed to be relevant for the validity of the patent in relation to the grounds of lack of novelty and of inventive step.

In its decision, the opposition division focused only on the evidence D1 and D3 in combination and its sufficiency to substantiate a public prior use considering the latter to be the only determining factor for novelty and inventive step (the grounds raised in the opposition) and thereby the basis on which the opposition's admissibility had to be evaluated. The opposition division's approach is not correct. They should also have considered D2 alone for the assessment of novelty or for inventive step in combination with common general knowledge or prior art acknowledged in the opposed patent and not restrict

themselves to the opponent's argumentation, who had cited D2 only in combination with D1 and only against inventive step.

V. The respondent argued essentially as follows:

Admissibility of the opposition

The notice of opposition clearly indicated that the ground of lack of novelty was put forward only on the basis of document D1.

Subordinately, in the notice of opposition it was indicated that the subject-matter of claim 1 and claim 12 would not have been inventive in view of a combination of the teachings of D1 with D2.

The opposition division based its decision on the fact that in the notice of opposition the opponent did not adequately substantiate any of the circumstances relating to **the alleged public prior use of D1**.

In this respect it has to be noted that the only detail that the opponent indicated in the notice of opposition relating to the alleged public prior use of D1 was "we enclose an order confirmation showing that a PickMaster 2002, version 2.30 was delivered 08.10.2004 to a customer". It is crystal clear that only this detail is not sufficient to adequately substantiate a public prior use which, moreover, lies solely within the power and knowledge of the opponent.

Public prior use is only adequately substantiated if specific details are given of what was made available,

where, when, how and by whom.

In the notice of opposition have not been indicated at all the facts relating to the alleged public prior use, because it could not be found any indication at all of:

- what the Brazilian company Vipal effectively received, i.e. whether Vipal indeed received the user's guide, and when they received it;
- what the company Vipal made available to the public, and which were the circumstances of the alleged act of prior use;
- when Vipal made the use;
- where Vipal made the use;
- in which manner Vipal made the alleged prior use, i.e. in which manner Vipal made use of the information contained in the user's guide.

Thus, without due substantiation of a public prior use of D1, neither lack of novelty nor lack of inventive step has been substantiated.

The opposition is therefore clearly inadmissible.

Reasons for the decision

1. Admissibility of the opposition

1.1 According to the Case Law of the Boards of Appeal, 6th edition 2010, VII.D.2.3.2, the requirement of Rule 76(2)(c) EPC is fulfilled if the contents of the notice of opposition are sufficient for the opponent's case to be properly understood on an objective basis, so that both the patent proprietor and the opposition division

know what that case is, see T 222/85, OJ EPO 1988, 128, Nr. 4 of the Reasons.

- 1.2 As is further stated in T 222/85 (*supra*), see point 5 of the reasons, the sufficiency of the notice of opposition as far as it concerns the fulfilment of the minimum substantive requirements of Article 99(1) and Rule 76(2)(c) EPC in this respect must be distinguished from the strength of the opponent's case. Indeed, Rule 76(2)(c) EPC does not prescribe a complete "indication of the facts, evidence and arguments presented in support" so as to permit a conclusive examination on that basis alone, see T 1069/96, not published in OJ EPO.
- 1.3 It follows that, for the admissibility of an opposition, the statements made in the opponent's pleadings need not even be true nor the arguments conclusive in themselves. It is merely necessary that the opposition division and the patent proprietor are able to follow them.
- 1.4 On the one hand, an (unfounded) ground of opposition might have been clearly presented and argued. Conversely, an unconvincing submission may be rejected as not allowable even though, if properly drafted, it would have succeeded. Whether such is the case, however, is no longer an issue of admissibility but purely a question of the merits of the case.
- 1.5 The notice of opposition indicates two grounds of opposition: lack of novelty, based on D1 alone, and lack of inventive step, starting from D2 and using D1 to show that the skilled person would apply a certain

teaching from that document in the method of D2. D1 is a "User guide for PickMaster 2002, version 2.30". Both attacks therefore hinge on this document and the opposition division was correct in concentrating the admissibility discussion on this document.

1.6 The public availability of patent documents is usually not a problem. Where, however, an opposition is based on another type of document such as a doctorate thesis or a scientific journal arriving at a certain library at a certain date or - as in this case - a user's guide allegedly sent with a product to the customer, the question of its public availability before the effective date of the patent needs to be addressed. In this respect, the same details that apply to an alleged public prior use need to be determined.

1.7 According to T 328/87, OJ EPO 1992, 701, point 3.3, when an opposition ground is based on an allegation of prior use, the requirements of Rule 76(2)c) EPC are fulfilled if the notice of opposition indicates, within the opposition period, the facts which make it possible to determine the date of prior use ("when"), in order to ascertain its "prior" character; the object of the use ("what") in order to examine its relevance, and the circumstances relating to the alleged use ("how") in order to confirm its availability to the public. The notice of opposition must also indicate the arguments presented in support of this ground of opposition and indicate the evidence in support of the alleged prior use (the latter needs however not be conclusive for the purposes of the admissibility of the opposition, see points 1.1-1.3 above).

- 1.8 In the present case the public availability of the user guide D1 is only indirectly argued via the reference in the notice of opposition "we also enclose an order confirmation showing that the PickMaster 2002, version 2.30 was delivered [sic] 08.10.2004 to a customer". The order confirmation is D3 (*supra*, point III).
- 1.9 As concerns the details (see point 1.7 above) that need to be determinable from the notice of opposition, the supporting documents D1 and D3 allow the following to be established:
- 1.9.1 As far as it concerns the "when", the opponent stated on page 1, lines 11 and 12 of its notice of opposition that a PickMaster 2002, version 2.30 had been delivered on 8.10.2004 to a customer. D3, page 5, mentions a "PickMaster 2.30" and a "user's guide, English".
- 1.9.2 As far as it concerns the "what", the opponent presented a complete analysis of the features of claim 1 with respect to D1, the user's guide Pickmaster version 2.30 with copyright notice "2002", see page 2, line 15 to page 4, line 12 of the notice of opposition.
- 1.9.3 As far as it concerns the "circumstances", the opponent referred to the sale and delivery of the above mentioned machine and, by implication also via D3, of its "user's guide" to the customer "Vipal S/A" on 8.10.2004, see page 1, lines 11 and 12 of the notice of opposition, i.e. implicitly without any obligation of secrecy.
- 1.10 In the present case the Board considers that this is all the patent proprietor and the opposition division

need to understand the case of the opponent, i.e. to make the opposition admissible. The rest is a question of what is sufficiently proven also taking account of what has further been filed in the proceedings and what the consequences thereof are, i.e. the case's allowability.

The Board notes that the additional details required by the respondent (whether and which part of the user's guide was made public by Vipal, when and how this took place, or how Vipal made use of the user's guide) are not relevant for deciding the opposition's admissibility.

1.11 For the reasons set out above the Board considers the opposition to be admissible.

2. *Procedural matters*

2.1 In view of the Board's finding that the opposition is admissible, the impugned decision has to be set aside. The only issue of this decision is the admissibility of the opposition. In order not to deprive the parties of the opportunity to argue their case before two instances, following also the corresponding requests (see below) of both parties for remittal in case the opposition were considered admissible, the Board considers it appropriate to make use of its power under Article 111(1) EPC to remit the case to the department of first instance for further prosecution.

2.2 As mentioned under point II above, the appellant presented his request (that the opposition be found admissible) in its Notice of Appeal. Oral proceedings

were requested only in case the Board would decide against this request.

In its letter setting out its grounds of appeal, the appellant added to this request only that:

2. "the decision from the Opposition Division is set aside so that European patent 1707513 can be revoked [*sic*] in view of the extensive and prima facie relevant prior art ", and

3. "the decision from the Opposition Division is set aside and the case remitted to the first instance for reconsideration of the validity of the patent in view of all cited prior art in the interest of the public".

The request for oral proceedings was not repeated.

As the respondent has not requested oral proceedings, this decision could be arrived at without holding oral proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.

The Registrar:

The Chairman:

G. Nachtigall

H. Meinders