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Datasheet for the decision of 2 October 2019

Case Number: T 2893/18 - 3.3.09

Application Number: 10719080.3

Publication Number: 2410871

IPC: A23K1/18, A23K1/16, C11C3/02

Language of the proceedings: EN

Title of invention:
COMPOSITIONS CONTAINING C1 TO C7 ORGANIC ACID MONOGLYCERIDES AND GLYCEROL,THEIR PREPARATION AND USE AS ANTIBACTERIALS AND ANTI-MOULD AGENTS

Applicant:
BASF SE

Opponents:
Perstorp Waspik B.V.
Framelco B.V.
Perstorp AB

Headword:

Relevant legal provisions:
EPC Art. 106(1), 106(2), 107
EPC R. 144(d)
Art. 1(2) of the decision of the President of the EPO dated 12 July 2007

Keyword:
Party status to appeal proceedings
Exclusion from file inspection
Admissibility of appeal - (no)

Decisions cited:
T 1839/11, T 1691/15

Catchword:

Europäisches Patentamt
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Office européen des brevets

Beschwerdekammern

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Case Number: T 2893/18 - 3.3.09

D E C I S I O N
of Technical Board of Appeal 3.3.09
of 2 October 2019

Appellant: (Patent Proprietor)	BASF SE Carl-Bosch-Strasse 38 67056 Ludwigshafen am Rhein (DE)
Representative:	Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB Postfach 31 02 60 80102 München (DE)
Respondent: (Opponent 1)	Perstorp Waspik B.V. Industrieweg 8 5165NH Waspik (NL)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)
Respondent: (Opponent 2)	Framelco B.V. Ramgatseweg 48 4941 VS Raamsdonksveer (NL)
Representative:	van Kooij, Adriaan Arnold & Siedsma Bezuidenhoutseweg 57 2594 AC The Hague (NL)
Respondent: (Opponent 3)	Perstorp AB S-284 80 Perstorp (SE)
Representative:	Hoffmann Eitle Patent- und Rechtsanwälte PartmbB Arabellastraße 30 81925 München (DE)

Decision under appeal: **Communication of the opposition division dated 31 August 2018**

Composition of the Board:

Chairman W. Sieber
Members: E. Kossonakou
F. Rinaldi
A. Veronese
F. Blumer

Summary of Facts and Submissions

I. The present appeal was filed by the patent proprietor following a communication annexed to the summons to second oral proceedings in opposition proceedings.

II. By registered letter dated 27 July 2017, the patent proprietor and the three opponents were summoned to oral proceedings before the opposition division scheduled for 20 February 2018. A communication setting out the preliminary opinion of the opposition division was annexed to the summons.

III. By letter dated 18 December 2017, the patent proprietor indicated that it had been informed that opponent 2 intended to make written submissions in preparation for the oral proceedings. Invoking Article 1(2)(a) and (b) of the decision of the President of the EPO dated 12 July 2007 (OJ EPO 2007, Special edition No. 3, J.3, p. 125), it requested

"1. to exclude this letter and its annex from filed inspection,

2. to exclude any letter, including annexes of any kind, of

Opponent O2 Framelco BV
or their respective representatives

sent in response to the summons to oral proceedings from file inspection,

3. not to forward this letter and any letter and annexes of opponent O2 to any other opponent or their representatives."

The exclusion from file inspection would have to be maintained at least until the oral proceedings on 20 February 2018.

IV. By letter dated 20 December 2017, opponent 2 replied to the opposition division's communication and filed new documents D15 to D37.

V. Although the opposition division provisionally acceded to the patent proprietor's request for exclusion from file inspection (communication dated 22 December 2017), it explained in its communication dated 3 January 2018 that only the proprietor's letter itself (request) could be excluded from file inspection according to Article 1(1)(b) of the Decision of the President of the EPO concerning documents excluded from file inspection. The opposition division further explained that documents filed by the parties in *inter partes* proceedings must be notified to the other parties in those proceedings and should, as a rule, be accessible to the public, the exclusion being a strictly regulated exception.

VI. Oral proceedings took place as scheduled before the opposition division on 20 February 2018. During the discussion of novelty of the subject-matter of auxiliary request 1a, it became necessary to decide on the admission/inclusion of the disputed documents (D15 to D41) into the proceedings and on the public availability of certain documents among them. At the end of the discussion, the opposition division concluded, according to the minutes issued on 3 August 2018, that D15 to D41 were *prima facie* relevant. Hence, these documents were admitted into the proceedings. The proceedings were adjourned as a hearing of witnesses appeared to be necessary, and the

continuation of the proceedings in writing was announced.

VII. Summons to second oral proceedings were issued on 31 August 2018 together with an order to take evidence, summons of witnesses and a communication of the opposition division. The communication summarised the issues already discussed on which the debate would not be reopened and pointed out the outstanding issues still to be discussed at the oral proceedings of 6 and 7 June 2019. Under point 3.1 (page 15, 2nd paragraph) it was stated that "*The patent proprietor contested the admissibility of D18-D37 as late-filed. The opposition division however considered the documents as prima facie relevant and admitted them into the proceedings during the oral proceedings on 20.02.2018*".

VIII. By letter dated 12 November 2018 the patent proprietor (the appellant) filed a notice of appeal against the decision purportedly entailed in the summons to attend oral proceedings dated 31 August 2018, although this decision was not further defined in the letter.

IX. The requests "defining the subject of the appeal" according to the notice of appeal were that:

- the case be referred back to the opposition division with the instruction to hold "annex proceedings" concerning the exclusion from public file inspection of D18-D37 to which opponents O1 and O3 would not be party;
- the content of the summons of 31 August 2018 be removed from public file inspection until a decision by the opposition division on the request to exclude D18-D37 from public file inspection was reached;

- the appeal fee be reimbursed because of substantial procedural violations.

In the alternative, that
- oral proceedings be appointed (first auxiliary request) and
- "in case the Board considers the contents of the Summons as a decision on the merits of the request for exclusion from public file inspection, ... to set aside this decision and to remit the case for further prosecution to the opposition division".

X. Opponents 1 and 3 (respondents 1 and 3) reacted with requests for the dismissal of the appeal. In the alternative, they requested oral proceedings (letters of 19 and 20 December 2018 respectively).

XI. The statement setting out the grounds of appeal was filed by letter dated 10 January 2019. The appellant pointed out that the opposition division had decided in the first oral proceedings to admit D18-D37 into the proceedings. Since only documents that were not excluded from public file inspection could be used to substantiate a ground of opposition, this procedural decision incidentally caused the documents to no longer be excluded from file inspection. Although not expressly stated, the opposition division had in fact rejected the appellant's request that D18-D37 be excluded from public file inspection. The contested decision was therefore incidental but nevertheless an appealable decision ("implicit decision"). The decision had been communicated with the summons to the second oral proceedings dated 31 August 2018 (annexed communication, point 3.1). Thus, according to the appellant, the appeal had been filed in good time.

The appellant argued that only opponent 2 could be acknowledged as party to the appeal proceedings as the appeal was only concerned with the exclusion from the proceedings of certain documents submitted by that party.
Participation of the other opponents would invalidate the need to keep the documents unavailable to the public.

Forwarding the documents to the opponents even before the request was decided at the oral proceedings constituted a substantial procedural violation warranting the reimbursement of the appeal fee.
A further substantial procedural violation, also warranting the reimbursement of the appeal fee, constituted the fact that the request for exclusion was not decided upon in ancillary proceedings.
Finally, the request was decided upon without hearing the witness proposed by the appellant.

In point 4.1 of its letter, the appellant then formulated the following requests replacing those submitted with the notice of appeal:

- that documents D18 to D37,
  - alternatively, documents D18, D19 and D21 to D37,
  - further alternatively documents D18, D19, D21, D23 and D25 to D37,
  - even further alternatively documents D25 to D37

  be excluded from file inspection;
- that the substantive part of the opposition division's communication dated 31 August 2018 be excluded from public file inspection until the previous request has been decided upon;
- that the appeal fee be reimbursed.

XII. In their replies to the statement setting out the grounds of appeal, respondents 1 (letter of 16 April 2019) and 3 (letter of 26 April 2019) requested acceleration of proceedings and that the appeal be found inadmissible or, if admissible, be dismissed. They further requested apportionment of their legal costs relating to the appeal proceedings.

Respondents 1 and 3 argued that the opposition division only gave a preliminary opinion on still outstanding issues. The exclusion from file inspection did not figure at all among the points addressed. Therefore, even if the communication annexed to the summons to the second oral proceedings were to be understood as a decision, it did not seem to be concerned with the issue central to the appeal. Moreover, there was no mention of a separate appeal being allowed; the Guidelines, D-VI-3.2, and decision T 1954/14 were cited in support.

XIII. By letter dated 16 May 2019 filed in reply to the grounds of appeal, respondent 2 requested acceleration of proceedings, rejection of the appeal as inadmissible or, if deemed admissible, dismissal of the appeal, remittal to the opposition division for further prosecution and apportionment of the appeal costs due to abuse of procedure by the appellant.

(a) As regards admissibility, respondent 2 pointed out that no decision on the exclusion of the contested documents appeared to have been taken, no separate appeal had been allowed nor was a final decision on the case reached. Furthermore, the appellant was not adversely affected since the crucial decision hinged on the testimonies of the appellant's own witnesses, and their hearing depended on the

appellant's actions. Finally, pursuant to Article 119 EPC, a summons could not be a decision. The only potential implicit decision were the minutes of the first oral proceedings. However, under this assumption, the appeal would have been filed after expiry of the relevant time limit.

(b) Respondent 2 also provided grounds for not excluding the contested documents from file inspection.

(c) An apportionment of costs was justified because the appellant had caused the delay in the opposition procedure by not ensuring that the witnesses could be heard and by filing a clearly inadmissible appeal, the latter causing even more unnecessary and avoidable costs.

XIV. The board summoned the parties to an oral hearing. In its communication pursuant to Article 15(1) RPBA dated 3 July 2019, the board provided the parties with its preliminary assessment of the case indicating that the appeal appeared to be inadmissible, so the appeal's admissibility would be the core issue at the oral proceedings.

XV. In a letter dated 3 July 2019, which crossed in the post with the board's aforementioned communication, the appellant argued extensively on the issue of party status in the present appeal proceedings. The appeal was incidental and not directly concerned or indeed linked to the opposition proceedings, so opponents 1 and 3 could not obtain party status. If the board were to find against the appellant's position, both on the procedure to be followed when deciding on a request for exclusion from file inspection and on party status, it

was requested that questions be referred to the Enlarged Board of Appeal.

XVI. By letters dated 2 September 2019, the appellant and respondents 1 and 3 submitted comments to the preliminary opinion of the board, as did respondent 2 by letter dated 17 September 2019. All three respondents also submitted the invoices documenting their respective requests for apportionment of costs.

XVII. On 2 October 2019, oral proceedings took place before the board. At the end of the oral proceedings the board announced its decision. For the details of the discussion at the oral proceedings, reference is made to the minutes issued on 11 October 2019. The final requests of the parties were as follows:

The **appellant** requested that the board ordered the exclusion from file inspection of

- the following documents:
(i) documents D18 to D37;
(ii) alternatively, documents D18, D19 and D21 to D37;
(iii) further alternatively, documents D18, D19, D21, D23 and D25 to D37;
(iv) or, at least, documents D25 to D37; and

- the substantive parts of the communication annexed to the summons of 31 August 2018 until a final decision was rendered on the previous request.

The appellant further requested that the appeal fee be refunded.

By letter dated 3 July 2019, the appellant further requested that questions be referred to the Enlarged Board of Appeal regarding the procedure to be followed when applying Rule 144 d) EPC.

In case the appeal was found inadmissible, the appellant requested that the case be remitted to the opposition division with the order to conduct ancillary proceedings or to at least issue a separate appealable decision on the appellant's request for exclusion from file inspection.

The appellant requested that the respondents' requests for apportionment of costs be refused.

Finally, the appellant requested that a decision be taken on the party status of respondents 1 and 3.

All **respondents** requested that the appeal be rejected as inadmissible or, if found admissible, that the appeal be dismissed.

All respondents requested apportionment of costs.

Respondents 1 and 3 requested that the board acknowledge their party status.

The respondents finally requested that the four invoices filed by respondents 1 and 3 by letter dated 2 September 2019 and the two invoices filed by respondent 2 by letter dated 17 September 2019 be excluded from file inspection.

Reasons for the Decision

Party status of opponents 1 and 3

1. The appellant argued, in its submissions of 3 July 2019, that the issues to be considered in the present appeal warrant the participation of only opponent 2 in the proceedings and the exclusion of the other two opponents. The appellant reasoned that opponents 1 and 3 should not have party status since the appeal was not concerned with the opposition itself but with the incidental issue of the exclusion from file inspection of documents submitted by opponent 2 and the correct procedure to be applied when deciding it. They should even have been excluded from participation in the discussion of this issue during the opposition proceedings to safeguard that the contested documents remained unavailable to the public.

2. As the opposition division correctly pointed out in its communication dated 22 December 2017, all documents submitted in the course of opposition proceedings and all exchanges between one party and the opposition division have to be communicated to all parties due to the *inter partes* nature of opposition proceedings (see also 5.2 below).

   Regarding the appeal, as foreseen in Article 107, second sentence, EPC "any other parties to the proceedings shall be parties to the appeal proceedings as of right". The provision contains no exception and allows no different interpretation, nor could the appellant's arguments shed a different light or lead to a different understanding. Thus, the opponents are parties to the present proceedings.

Admissibility of the appeal

3. The appellant's case rests on the argument that the opposition division's communication dated 31 August 2018 contains the implicit decision to reject its request for the exclusion of documents D18-D37 from public file inspection.

The appellant then uses the date of issuance of this communication as the basis for the calculation of the relevant time limits as regards the appeal.

4. The board cannot accept this interpretation.

4.1 As set out in the board's communication in preparation of the oral proceedings, although an *implicit* decision is not acknowledged as such in the Convention, its possible existence cannot be excluded either because there are circumstances where a decision can be inferred from the context rather than based on the form of a document.

4.2 Following this line of thought, the board considered whether the opposition division's communication dated 3 January 2018 (dealing exclusively with the issues of file inspection, exclusion therefrom and forwarding of documents to the other parties in opposition proceedings) was such a decision. The communication contained at least the clear statement "The general request to exclude any letter, including annexes, of opponent O2 filed in response to the summons to oral proceedings from file inspection **cannot be granted.**" (emphasis added by the board), an equivalent for which is nowhere to be found in the communication of 31 August 2018. However, the communication of 3 January 2018 contained neither a proper reasoning nor

any mention that the deciding body had allowed the separate appeal, as foreseen in Article 106(2) EPC for a decision not terminating proceedings regarding one of the parties (intermediate or ancillary decision) to be appealable on its own. The communication had therefore to be discounted as a potential implicit decision.

4.3 The board then considered whether the communication identified by the appellant qualified as an appealable decision. Its provisional opinion was that also that communication was inadequate to stand *in lieu* of a proper decision. It was clear that the communication was intended as preparation for the second oral proceedings to be held before the opposition division. Its content - as all respondents pointed out - merely identified a number of issues that the division considered had been conclusively discussed during the first oral proceedings, so that there was no apparent need to reopen the respective discussions (point 2, " topics already discussed ...", pages 7 to 14).

4.4 The appellant argued at the oral proceedings that the contested documents were not only listed in this communication but were also commented upon. Therefore, their content was - at least indirectly - made available to any third party reading the communication.

Although the board acknowledges the logic supporting this argument, it can nonetheless not draw the same conclusion as the appellant. The substantive details contained in the communication mainly serve the purpose of justifying the admission of the documents in the proceedings (decided upon during the first oral proceedings), explaining their relevance to the claimed subject-matter and setting out the issues relating to

their public availability on which the witnesses are to be summoned and heard.

There is no mention at all of the request for their exclusion from file inspection, let alone a decision rejecting such a request. Indeed, the communication appears to only contain the opposition division's provisional opinion on the therein identified outstanding issues and does not seem to even hint at a decision on any issue. Moreover, the contested documents are still in the non-public part of the file.

4.5 The appellant also argued on the basis of the necessity to formally and definitively clarify which documents are part of the file and can be taken into account to decide the broader matter at hand.

It is true that the Decision of the President of the EPO on the exclusion of documents from public inspection hints at a decision on the issue having to be taken and that the relevant part of the Guidelines for Examination certainly indicates that regarding such requests ancillary proceedings may be appropriate. However, there appears to be no obligation on the competent EPO body to take such ancillary decision susceptible of separate appeal. Indeed, there may be circumstances, where other issues need to be clarified first, and a decision might only be appropriate together with the decision concluding the relevant procedure.

4.6 Prejudice to the legitimate personal or economical interests of natural or legal persons is a necessary requirement for the exclusion of documents from file inspection pursuant to Article 1(2)(a) and (b) of the Decision of the President dated 12 July 2007. However,

this prejudice is still subject to the overriding principle set out in Rule 144(d) EPC, namely, that documents may be withheld from public inspection (only) if such inspection would not serve the purpose of informing the public about the patent (see also T 1839/11, point 3.2 of the reasons). If the opposition division had had to decide the case on its substantive merits, i.e. regarding the maintenance of the patent, and such documents were considered relevant, the reasons for the decision, which would have been published, would inevitably have contained references to the objected documents as they concerned the validity of the patent. Thus, documents mentioned in a decision of an opposition division must in the end be open to public file inspection because they serve the purpose of informing the public about the European patent.

5. It appears in the present case that the opposition division indeed intended to decide this issue together with its final decision on the oppositions themselves as only then they would have known which documents would have had to be mentioned in the written decision and could therefore no longer be excluded from public file inspection. Thus, the opposition division at least provisionally excluded the contested documents from file inspection - as requested and foreseen in the aforementioned Decision of the President - and examined their relevance for admission into the proceedings (already decided), their public availability and their exact influence on the patentability of the opposed patent (still outstanding) before ultimately deciding on the issue of public file inspection.

6. The fact that the documents were communicated to the other opponents is not in contradiction with their provisional exclusion from public inspection.

As explained in decision T 1691/15 (OJ EPO 2017, A15), in point 3.3 of the Reasons:

> "Rule 79(2) EPC states that in case there is more than one opponent, the other opponents will receive a copy of the others' opposition. Rule 79(3) EPC requires the EPO to send any observations and amendments filed by the patent proprietor to the other parties. Rule 81(2) EPC requires the EPO to send any communication under Article 101(1) EPC and any reply thereto to all parties.
>
> The principle as established by the above is that in opposition proceedings, which are inter-partes proceedings, all exchanges have to be notified to all parties. This is also acknowledged in the Notice of the EPO dated 3 June 2009, OJ EPO 2009, 434."

7. Thus, the present appeal was filed in the absence of a decision and therefore has to be rejected as inadmissible (Article 106(1) and (2) EPC). As a consequence, certain requests of the appellant are either rendered moot or have to be refused, namely:

- the request for remittal of the case as the case will revert automatically to the opposition division;
- the request for the issuance of specific instructions to the opposition division, in particular for the exclusion of certain parts of the purported decision/communication in preparation

for the oral proceedings before the division, since there is no admissible appeal to consider;
- the request for referral of questions to the Enlarged Board of Appeal;
- the request for the reimbursement of the appeal fee.

Apportionment of costs

8. For an apportionment of the respondents' costs relating to the present procedure in accordance with their respective requests, it would have been necessary for the board to be able to establish an abusive behaviour on the part of the appellant.

However, filing an appeal is the legal means of redress when a party perceives that a negative decision has been issued against it. Even though other courses of action were available which might have allowed the appellant to seek redressing the perceived wrong more effectively, the board could neither establish, nor was it convinced by the respondents, that the appellant's actions were dictated by malice.

In the absence of an abuse of procedure, the principle of each party covering its own costs remains applicable. The respondents' requests are thus refused.

9. Thus, the documents filed by the respondents in support of their respective requests no longer need to be in the public part of the file. Following a request by each of the respondents to this end, the board decides to exclude this evidence from file inspection.

Order

For these reasons it is decided that:

1. The appeal is rejected as inadmissible.
2. The request for reimbursement of the appeal fee is refused.
3. The respondents' requests for apportionment of costs are refused.
4. The four invoices filed by respondents 1 and 3 by letter dated 2 September 2019 and the two invoices filed by respondent 2 by letter dated 17 September 2019 are excluded from file inspection.

The Registrar: The Chairman:

D. Magliano W. Sieber

Decision electronically authenticated