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**Datasheet for the decision
of 15 January 2025**

Case Number: T 0733/23 - 3.3.06

Application Number: 18204682.1

Publication Number: 3483221

IPC: C09C1/28, C01B33/22, C08K3/34,
C08K9/04

Language of the proceedings: EN

Title of invention:
TALC PARTICULATE AND USES THEREOF

Patent Proprietor:
IMERTECH SAS

Opponent:
IMI Fabi S.p.A.

Headword:
IMERTECH/TALC

Relevant legal provisions:
RPBA 2020 Art. 11, 12(4), 12(6)
EPC Art. 113(1)
EPC R. 103(1)(a)

Keyword:

Remittal - (yes) - fundamental deficiency in first-instance proceedings (yes)

Amendment to case - admitted (yes)

Right to be heard - substantial procedural violation (yes)

Reimbursement of appeal fee - (yes)

Late-filed evidence - error in use of discretion at first instance (yes)

Decisions cited:

T 0287/86, T 0743/89, T 0804/05, T 0278/09, T 2139/09,

T 0146/13, T 1138/20

Catchword:



Beschwerdekammern
Boards of Appeal
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Case Number: T 0733/23 - 3.3.06

D E C I S I O N
of Technical Board of Appeal 3.3.06
of 15 January 2025

Appellant: IMI Fabi S.p.A.
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Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
17 February 2023 concerning maintenance of the
European Patent No. 3483221 in amended form.**

Composition of the Board:

Chairman J.-M. Schwaller
Members: S. Arrojo
C. Heath

Summary of Facts and Submissions

I. An appeal was filed by the opponent against the decision of the opposition division to maintain European patent No. 3 483 221 in amended form on the basis of the claims according to the main request filed with letter of 30 August 2021, claim 1 thereof reading as follows:

"1. A talc particulate having a d_{50} of from 0.5 to 5.0 μm and a lamellarity index of from 2.8 to 45.0, and comprising less than 500 ppm of particles having a particle size of equal to or greater than 45 μm ."

II. To avoid any confusion and for the sake of consistency with the decision under appeal, the board will hereinafter refer to the cited documents using the nomenclature 'D-Number' (instead of the 'B-Number' used by the appellant, e.g. D2 instead of B2).

III. In its statement of grounds of appeal, the appellant contested the decision and put forward that the non-admission of documents D2-D4, D7-D12, D16 and D19 represented a substantial procedural violation, so that these documents, as well as the newly filed D22-D25, should be admitted into the proceedings. Further, it argued that the invention according to the request upheld by the opposition division was insufficiently disclosed, extended beyond the content of the application as filed, was not novel or not inventive in view of the data sheets D2, D4 and D7 to D9 and/or the newly filed documents D23 and D24, and not inventive when starting from D5/D5a or D6 as the closest prior art.

- IV. In its reply, the patentee and respondent rebutted the appellant's arguments and requested that documents D2-D4, D7-D12, D19 and D22 to D25 not be admitted into the proceedings. If they were admitted or if its main request were not allowed, it requested that the case be remitted to the first instance or, as an auxiliary measure, that the patent be maintained on the basis of the claims according to one of auxiliary requests 1 to 19 filed with the reply.
- V. In its preliminary opinion, the board held that at least the data sheets D2, D4, and D7 to D9 should have been considered part of the first instance proceedings and that D19 should have been admitted into the opposition proceedings. Given the high relevance of these documents for novelty and inventive step, the board concluded that their admittance would likely lead to the revocation of the patent.
- VI. In reply thereto, the patentee submitted further observations in a letter dated 13 December 2024, in which it specifically requested that the case be remitted to the opposition division should the board decide to admit any of the documents D2, D4, D19, D23, or D24.
- VII. At the oral proceedings, which took place by videoconference on 15 January 2025, the final requests of the parties were the following:

The appellant requested that the decision under appeal be set aside and the patent be revoked in its entirety. Furthermore, the case should not be remitted and all substantive matters should be addressed at the oral proceedings. However, if the case were remitted, the appeal fee should be reimbursed.

The respondent requested that the appeal be dismissed and, in the event that any of the documents not admitted during the first instance proceedings were admitted, that the case be remitted to the first instance for further prosecution. Alternatively, as an auxiliary measure, it requested that the patent be maintained based on one of auxiliary requests 1 to 19 filed with its reply to the appeal.

Reasons for the Decision

1. The board has concluded that the decision of the opposition division not to admit documents D2, D4, D7-D9, and D19 constituted a substantial procedural violation and that the case should therefore be remitted to the first instance for further prosecution. To support these conclusions, the board will first present some key considerations regarding the question of public availability of advertising brochures and data sheets, as well as the standard of proof to be applied.
2. Public availability of products in brochures and data sheets
 - 2.1 There are a number of decisions in the case law addressing the question of the public availability of documents that do not provide a clear indication of their publication date (see Case Law, 10th ed., I.C. 3.2.1 (a) to (c)).
 - 2.2 The first issue to consider is whether the document in question was intended for public distribution and if so, whether it was actually made available to the public before the relevant priority or filing date of the patent.

- 2.3 When a document is clearly intended to be publicly distributed, as is the case with advertising or commercial brochures, the presence of a printing, editing, revision, or copyright date has been deemed sufficient to establish public availability, provided it predates the priority or filing date by a reasonable margin (in **T 743/89** 7 months were considered sufficient and 24 months in **T 146/13**), allowing the assumption that the document was distributed in that time to customers or potential customers (see also **T 287/86**, **T 804/05**, **T 2139/09**, and **T 146/13**).
- 2.4 It is therefore clear that the absence of a specific publication or distribution date, a situation quite common in this type of document, is not in itself sufficient to conclude that the document does not constitute prior art. As with any other type of evidence, the key question is not whether the exact date of publication can be determined, but whether it can be established that the relevant subject-matter was made available to the public before the priority or filing date of the patent in question.
- 2.5 Data sheets often represent an intermediate case between internal documents and advertising brochures, as they are often conceived for distribution to customers or potential customers, but their content may also be covered by explicit or implicit secrecy agreements (see **T 278/09**, Reasons 1.3.1).
- 2.6 The public availability of data sheets is not always straightforward and often requires considering information from different sources, such as an expert or witness testimony, as well as evidence of whether the products in question were commercially available or discussed in public forums.

- 2.7 Where no publication date is present, it should first be assessed whether the document was intended for public distribution. If so, additional sources must be examined to establish whether the relevant subject-matter was publicly accessible before the patent's filing or priority date. Moreover, a document with no publication date may also contribute to a chain of evidence for establishing the public availability of the relevant subject-matter described therein.
3. Standard of proof when assessing public availability of data sheet products
- 3.1 A number of decisions suggest that different standards of proof should be applied when assessing the public availability of evidence, depending on whether the relevant documents are within the exclusive sphere of one of the parties or equally accessible to all parties. When the evidence is exclusively within the control of one of the parties, the Boards have generally deemed it appropriate to apply the 'up-to-the-hilt' or 'beyond reasonable doubt' standard. Conversely, when both parties have equal access to the evidence, the lower standard of 'balance of probabilities' has normally been applied.
- 3.2 The present board concurs with the position in decision **T 1138/20** (see Reasons 1.2.1) that there is only one standard of proof: the deciding body must be convinced, based on the underlying circumstances, that the relevant subject-matter was made available to the public before the priority or filing date of the patent.
- 3.3 This does not imply that all cases are treated identically, as in practice the degree of proof

required to establish credibility (i.e. to persuade the board that the evidence was made available to the public before the filing/priority date) may vary depending on the specific circumstances of each case. In other words, it is not the standard of proof that adjusts with the circumstances, but rather the credibility of the arguments made by the different parties.

- 3.4 For example, when the evidence is exclusively controlled by one party, any gaps in the relevant information may significantly undermine that party's credibility, as such omissions may suggest that evidence has been purposefully withheld, that books were not well kept or that no significant efforts were made to come up with such evidence - all factors that speak against the credibility of the party meant to come up with such evidence. Conversely, when the information is equally accessible to both parties but only one party submits evidence, merely raising doubts may not be sufficient to challenge the credibility of that information. In such cases, it can usually be assumed that if the other party had found information supporting its position, it would have submitted it.
- 3.5 In the present case, the conclusions of the opposition division suggest that the standard of proof 'up-to-the-hilt' was applied to determine the public availability of the data sheets. Even if the board agreed that different standards should be applied, this would not be justified in the present case, as the relevant information to prove the public availability of the data sheets was not within the exclusive sphere of the appellant.

- 3.6 In fact, it could be argued that in the present case, the relevant information would more likely be within the sphere of the patentee, since after acquiring the company that issued these data sheets, it may have gained access to any information concerning the data sheets and/or the commercialisation of the relevant products. In any case, even if the patentee had no access to additional relevant information in this regard, the evidence would still be equally accessible to both parties. Therefore, there is no basis for applying the strict standard of 'up-to-the-hilt' or, following the position in this decision, for questioning the credibility of the appellant solely on the grounds that some information is missing.
- 3.7 It is also noted that at the oral hearing, the patentee advanced the argument that when in doubt about the conclusiveness of the evidence, the patent should be upheld. The board finds this wrong on two counts:
- 3.7.1 First, fact-finding boils down to a binary exercise: Either something has been proven, or it has not. The board concurs in this regard with **House of Lords, Re B (Children) [2008] UKHL 35**, Reasons 2: *"If a legal rule requires a fact to be proved (a 'fact in issue'), a judge or jury must decide whether or not it happened. There is no room for a finding that it might have happened. The law operates a binary system in which the only values are 0 and 1. The fact either happened or it did not. [...] [T]he standard of proof [...] is [...] the degree of persuasion which the tribunal must feel before it decides that the fact in issue did happen."*
- 3.7.2 Second, there is no presumption of patent validity in proceedings meant to re-assess the validity of this very patent. Different from re-assessing a

discretionary decision, the question of patentability must be assessed *de novo* in opposition or appeal proceedings. While there is a presumption of validity in all legal acts where the patent's validity is not challenged, where it is challenged, the assessing body must undertake an examination of validity no different from the one in examination. Therefore, in opposition and appeal proceedings, there is no room for the rule "when in doubt, the patent should be upheld." This is also correct on a macro-economic level: Patents are a (recognised) encumbrance and exception to free trade and such needs justification in that a body entrusted with the substantive examination of patent applications must ascertain the requirements of patentability. The European Patent Office thereby acts as a *Portcullis* to separate the weed from the chaff and to grant only those patents that fulfil the requirements as established by the EPC.

4. Substantial procedural violation

4.1 The data sheets D2, D4 and D7-D9 were filed by the opponent with the notice of opposition to support the objections under novelty and inventive step.

4.1.1 In the response to the notice of opposition, the patentee contested the public availability of the data sheets prior to the filing date of the patent.

4.1.2 In its preliminary opinion, the opposition division considered the dates printed on the front page of these documents as evidence that they had been made available to the public before the filing date of the patent, and concluded that the content of these documents was highly relevant to the discussion on patentability.

- 4.1.3 During the oral proceedings, the opposition division revised its preliminary opinion and concluded that there was insufficient evidence to prove that the data sheets D2, D4, and D7 to D9 had been made available to the public before the filing date. Consequently, these documents could not be regarded as prior art under Article 54(1) and (2) EPC.
- 4.1.4 However, rather than concluding that, as a result of the data sheets not being considered state of the art under Article 54 EPC, the subject-matter of the claims was novel, the opposition division decided (point 16 of the minutes) not to admit D2, D4, and D7 to D9 into the opposition proceedings. As a result, the opposition division did not issue a decision on the question of novelty.
- 4.2 The board, however, has concluded that the data sheets D2, D4, and D7 to D9 were incontestably part of the opposition proceedings and that disregarding them constituted a substantial procedural violation for the following reasons:
- 4.2.1 First and foremost, the discretion to disregard evidence under Article 114(2) EPC is explicitly limited to documents "not submitted in due time by the parties concerned". Since D2, D4, and D7 to D9 were filed with the notice of opposition, they were clearly filed in due time, so the opposition division had no discretion to disregard them under Article 114(2) EPC.
- 4.2.2 In this regard, the opposition division appears to have conflated the issue of the alleged lack of public availability of the documents with the question of their admissibility.

4.2.3 Since the documents in question were incontestably part of the opposition proceedings, they should have been examined on their merits. In particular, the opposition division should have explained why the date printed on the first page of the data sheets and/or any other information offered by the opponent (e.g. D19) was deemed insufficient to conclude that the data sheets were publicly available before the filing date of the patent. Instead, the decision under appeal simply concludes (points 2.3.4 and 2.3.7 in the discussion on admissibility) that the dates on the documents were not considered publication dates, without further analysis as to why these dates should be deemed irrelevant for the assessment of public availability.

4.2.4 As discussed in point 2. above, the issue of public availability is not straightforward and would have required an assessment that took into account the cited case law and/or the relevant passages in the guidelines (see for example G-IV 7.4). Moreover, a decision should have been issued on the question of novelty, even if this was only based on the argument that none of the cited documents were considered to represent prior art under Article 54 EPC.

4.2.5 In view of the above, the board concludes that the decision to disregard the data sheets and to refrain from analysing or discussing their public availability based on the information at hand constituted a procedural violation of the opponent's right to be heard under Article 113(1) EPC.

4.3 As to the affidavit D19, this was filed within the deadline set by Rule 116(1) EPC in response to the patentee's argument that the dates on the data sheets did not provide sufficient evidence that these had been

made available to the public before the filing date of the patent.

- 4.3.1 At the oral proceedings, the opposition division decided not to admit D19 into the proceedings, arguing that it was late filed and not *prima facie* relevant, because it did not "*bring any light regarding the publication dates of documents D2 and D4*" (see points 2.3.9 to 2.3.12 of the decision under appeal).
- 4.3.2 The board has concluded that D19 should have been admitted into the opposition proceedings, and that not admitting it also constituted a substantial procedural violation for the following reasons:
- 4.3.3 Document D19 was submitted within the time limit set under Rule 116(1) EPC in response to the patentee's argument in the reply to the notice of opposition that the date printed on the data sheets was insufficient to prove the public availability of these documents before the filing date of the patent.
- 4.3.4 Although any document filed after the opposition period may potentially be considered late filed, a document submitted after this period can still be deemed timely if it is filed within the relevant deadline in response to an argument raised during the opposition proceedings. In the present case, it is undisputed that D19 was filed in response to the patentee's submissions in the reply to the notice of opposition. Therefore, the relevant deadline for assessing whether the document was filed in due time is that established under Rule 116(1) EPC. Since D19 was filed within this time limit, it was not late filed, so the opposition division had no discretion to disregard its content.

- 4.3.5 Since the argument to which D19 intended to respond (i.e. that the date on the data sheets did not prove that they had been made available to the public before the filing date of the patent) ultimately led to the decision under appeal, disregarding this document is also considered to represent a substantial procedural violation of the opponent's right to be heard under Article 113(1) EPC.
- 4.4 For the sake of completeness, the board also observes that the decisions to exclude the data sheets and D19 appear to stem from the same chain of erroneous assumptions. In particular, by excluding the data sheets D2, D4, and D7 to D9 from the proceedings, the opposition division failed to provide a reasoned decision on their public availability, giving no weight to the dates printed on their front pages. Building on this flawed premise and on the erroneous assumption that the public availability of the data sheets could only be established with a specific publication date, the division further concluded that the information in D19 was *prima facie* irrelevant and should also be disregarded. In other words, in the absence of a detailed analysis and a reasoned decision on the question of public availability of the data sheets, the division wrongly assumed that any information failing to establish the exact date of publication or distribution of the data sheets would be irrelevant and should be disregarded. As a result, even though part of the information in the affidavit D19 was clearly intended to clarify the question of public availability of the data sheets, or at least of the products described therein, the division concluded that the document was *prima facie* irrelevant.

4.5 There was also no decision or comment from the division on the possibility of resolving the outstanding doubts by accepting the opponent's offer to hear the author of affidavit D19 as a witness or expert (as requested by the opponent), which might have been the appropriate alternative given the circumstances.

5. Admittance of D2, D4, D7 to D9, D19, D23 and D24

5.1 As indicated above, documents D2, D4 and D7-D9 were part of the opposition proceedings, so there is no need to discuss the question of their admittance. These documents are therefore part of the proceedings.

5.2 Since document D19 was not part of the proceedings and was not admitted by the opposition division, its admittance is governed by Article 12(6) RPBA.

5.3 As discussed above, the board has concluded that the decision not to admit D19 suffered from an error in the use of the division's discretion. Moreover, the content of this document is considered to be *prima facie* relevant both for determining whether the data sheets were made available to the public before the filing date and for other substantive questions. Document D19 is thus admitted into the proceedings under Article 12(6) RPBA.

5.4 Documents D23 and D24 were filed for the first time during the appeal proceedings, so their admittance is governed by Article 12(4) RPBA.

5.5 These documents are intended to shed light on the question of the public availability of the data sheets and/or the products described therein before the filing date of the patent. The content of D23 and D24 is not

complex, as these documents simply intend to demonstrate that both the products referenced in the relevant data sheets and their properties were being discussed in public forums several years before the filing date of the patent (in fact, in the same years printed on the data sheets). This information is clearly relevant, not only because it reinforces the argument that the data sheets, or at least the products they describe, were publicly available before the filing date of the patent, but also because the open discussion of certain product characteristics may suggest that these were not subject to confidentiality agreements.

- 5.6 The board has therefore concluded that D23 and D24 should be admitted into the proceedings under Article 12(4) RPBA.

- 6. Remittal of the case to the opposition division
 - 6.1 According to Article 11 RPBA, the board should not remit a case to the first instance unless special reasons, such as fundamental deficiencies, justify doing so.

 - 6.2 As discussed above, the board has found that the decision to disregard documents D2, D4, D7 to D9, and D19 constituted a substantial procedural violation. This would, in principle, warrant a remittal under Article 11 RPBA.

 - 6.3 However, the appellant expressly requested that the case not be remitted to the first instance, and that the issue of patentability be decided directly by the board. The appellant argued that a remittal would cause unnecessary delays, as all relevant facts, evidence,

and arguments had already been submitted in writing. Given this, a final decision could be reached without remitting the case.

6.4 The proprietor contended that the decision under appeal was not based on any of the documents identified as relevant in the preliminary opinion of the board. Furthermore, this opinion relied on the content of affidavit D19, which contained statements requiring further scrutiny, potentially through the examination of the author as a witness or expert. However, such an examination could not be conducted at short notice during the oral proceedings. Moreover, there was ambiguity regarding the basis of the opponent's patentability objections. In particular, it was unclear whether these were founded on the data sheets themselves or rather on an alleged public prior use of the products described therein. While the original objections were based on the alleged public availability of the data sheets, the information in D19, D23, and D24 appeared to be aimed at establishing prior use of the products described in the data sheets. The proprietor thus concluded that if any of these documents were admitted into the proceedings, the case should be remitted to the first instance for further prosecution.

6.5 The board has concluded that, given the underlying circumstances, not remitting the case and instead addressing the question of public availability would have resulted in an inequitable situation for at least one of the parties for the following reasons:

6.5.1 As explained in point 2. above, the discussion on the public availability of data sheets is complex and may require consulting multiple sources and conducting a

thorough analysis of the underlying circumstances. In the present case, documents D19, D23, and D24 provide the basis for this analysis.

- 6.5.2 Although, as explained above, the board considers the information in D19 to be *prima facie* relevant to the discussion on public availability, the proprietor is correct that the statements in this affidavit should not be accepted at face value without further scrutiny. This is particularly true given that the proprietor has explicitly contested these statements and that the opponent offered to hear the author of D19 as a witness or as an expert to solve any outstanding doubts.
- 6.5.3 The proprietor is also correct in stating that such a hearing could not have been properly organised and conducted without prior notice during the oral proceedings before the board, as without adequate preparation time, the proprietor would not have been able to prepare their questions or arrange for the presence of their own experts to provide counterarguments.
- 6.5.4 It follows that the only viable way for the board to consider the content of D19 as evidence of the public availability of D2 or D4 would have been to postpone the oral proceedings to a later date, allowing the parties sufficient time to prepare for the examination of the author of D19 as a witness or expert. However, this approach offered no significant advantage in terms of procedural efficiency compared to remitting the case to the first instance and would have also precluded the appellant from obtaining a reimbursement of the appeal fee. Moreover, neither party requested such a postponement.

- 6.5.5 A second alternative to reaching a final decision on the case would have been to admit D23 and D24 and rely on these documents as independent evidence (i.e. separate from the information in D19) to establish that the products in D2 and D4 were publicly available before the filing date.
- 6.5.6 However, as the proprietor argued, it has not been properly clarified whether the content of D23 and D24 should be considered for analysing the (alleged) public availability of the written documents D2 and D4 themselves, the products described in these documents, or both.
- 6.5.7 Although, as stated in the preliminary opinion, the board is convinced that D23 and D24 provide strong evidence that the products described in D2 and D4 were publicly available years before the filing of the contested patent, the opponent explicitly denied at the oral proceedings that the intention was to substantiate the public availability of the products. Instead, D23 and D24 were submitted to further support the public availability of the data sheets D2 and D4. It was therefore apparent that the discussion at the oral proceedings would have been focused on the public availability of the data sheets and not that of the products.
- 6.5.8 While the board considers that the content of D23 and D24 is not only relevant for demonstrating the public availability of the products but also indirectly supports the public availability of the data sheets, it was anticipated that certain critical questions (e.g. whether the information in the data sheets was implicitly protected by a confidentiality agreement or whether the discussions in public forums were

sufficient to demonstrate that the data sheets were being distributed to the public) would have required a more in-depth analysis and/or the hearing of the author of D19 as witness or expert.

6.5.9 All in all, the board found that even after admitting D19, D23, and D24 into the proceedings, the discussion on the public availability of the data sheets would have required further analysis or examination of the alleged facts, for which the parties were not adequately prepared. Moreover, avoiding this additional examination would have been possible only in one of two ways, namely either by disregarding certain alleged facts in D19 to the detriment of the opponent or by overlooking the legitimate doubts raised by the proprietor without further scrutiny, which would have been inequitable to the proprietor.

6.6 The board thus concluded that the case should be remitted to the first instance for further prosecution.

6.7 In doing so and in accordance with the principle of evaluating evidence as set out in decision **T 1138/20**, the opposition division is reminded that rather than focusing on specific shortcomings in the chain of evidence, it should assess public availability by considering the case as a whole. After all, whether the discussion concerns the substantiation of a prior use or the availability of the data sheets, the assessment of the evidence should recognise that real-world scenarios are inherently more complex, colourful, multidimensional, and less rigid than the structured nature of patent documents.

7. In summary, the opposition division should prosecute the case within the new substantive framework arising

from the admittance of D2, D4, D7 to D9, D19, D23 and D24. Moreover, if required, the division should hear the author of D19 as a witness or as an expert to clarify any outstanding issues. The public availability should be assessed taking into account the relevant passages of the guidelines and, if applicable, the relevant case law.

Order

For these reasons it is decided that:

1. The case is remitted to the opposition division for further prosecution.
2. The appeal fee is reimbursed.

The Registrar:

The Chairman:



A. Wille

J.-M. Schwaller

Decision electronically authenticated