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Bezeichnung der Erfindung: Interfacially synthesized reverse osmosis membrane,  
Title of invention: process for the preparation thereof and its use in a  
Titre de l'invention : process for removing solute from solute-containing  
water

Klassifikation / Classification / Classement : B01D 13/04

### ENTSCHEIDUNG / DECISION

vom / of / du 1 August 1988

Anmelder / Applicant / Demandeur : FilmTec Corporation

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet : E.I. Du Pont de Nemours and Company

Einsprechender / Opponent / Opposant :

Stichwort / Headword / Référence : Costs/Filmtec

EPÜ / EPC / CBE Articles 99, 104, 117, Rule 63

Schlagwort / Keyword / Mot clé : "Late-filed documents" - "withdrawal of  
opposition" - "different apportionment of costs  
in the appeal"

#### Leitsatz / Headnote / Sommaire

I. The phrase "taking of evidence" in Article 104(1) EPC refers generally to the receiving of evidence during opposition proceedings by an Opposition Division or a Board of Appeal, whatever the form of such evidence (see Reasons, paragraph 3).

II. Facts and evidence in support of an opposition which are presented after the nine-month period for filing an opposition and which cause the incurring of additional costs by another party may for reasons of equity justify an order for apportionment of costs (see Reasons, paragraphs 4 to 7).

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Patentamt

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Boards of Appeal

Chambres de recours

Case Number : T 117/86 - 3.3.1



**D E C I S I O N**  
of the Technical Board of Appeal 3.3.1  
of 1 August 1988

**Appellant :**  
(Opponent)

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**Respondent :**  
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**Decision under appeal :**

Decision of the Opposition Division of the European Patent Office dated 3 October 1985, posted on 31 January 1986, rejecting the opposition filed against European patent No. 0 015 149 pursuant to Article 102(2) EPC.

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** G.D. Paterson  
C. Gérardin

## Summary of Facts and Submissions

- I. European patent 0 015 149 was granted on 22 June 1983. A notice of opposition was filed on 22 March 1984 by the Appellant, in which revocation of the patent was requested on the grounds set out in Article 100(a) EPC, and in particular on the ground of lack of inventive step. The notice of opposition relied on three published documents in support of this ground. The Respondent contested the submissions contained in the notice of opposition, in a reply filed on 10 January 1985. By letter issued on 8 May 1985 the parties were summoned to oral proceedings on 3 October 1985.
- II. In a letter filed on 3 September 1985, the Appellant submitted that the patent should be revoked on the grounds of lack of novelty having regard to one further document, and lack of inventive step having regard to five further patent specifications.
- III. At oral proceedings held on 3 October 1985, it appears from the minutes that the Appellant presented no further arguments based on the originally filed documents, but sought to rely in particular on one of the newly filed patent specifications in support of the opposition. The Opposition Division decided not to admit the new documents relied upon in the letter dated 3 September 1985, and decided to reject the opposition. Reasons for the decision were issued on 31 January 1986.
- IV. A notice of appeal was filed on 3 April 1986 and the appeal fee was paid. A statement of grounds of appeal was filed on 3 June 1986. This statement did not directly challenge the reasoning set out in the decision of the Opposition Division rejecting the opposition, but relied upon two new

patent specifications and an affidavit in support of the contention that the opposed patent lacked an inventive step, as well as one of the patent specifications which was originally cited in the notice of opposition.

In a communication from the Board of Appeal dated 23 September 1986, it was pointed out that the statement of grounds of appeal relied on three documents, the two patent specifications and the affidavit, which were being cited for the first time more than two years after expiry of the nine-month opposition period provided by Article 99(1) EPC, and that it was likely that before admitting these three documents into the proceedings the Board would require to be satisfied that each of them is likely to be crucial to the making of the decision in the case. It was also pointed out that no reasons had been given by the Appellant for the belated reliance upon these documents.

In reply, the Appellant stated that one of the new patent specifications had been mentioned in the opposed patent; that the citation of the other new patent specification had been necessary to refute a statement in the challenged decision as to the teaching of the prior art; and that the affidavit was intended to refute the statement in the decision that the invention provides outstanding results.

- V. In a statement in reply filed on 23 December 1986, the Respondent contended that in the statement of grounds of appeal, by relying on the new combination of three patent specifications and the affidavit, the Appellant had produced virtually a new opposition, because the arguments and documents now bear little relation to those filed with the original notice of opposition. This was submitted to be an abuse of the opposition procedure, justifying a finding either that the appeal was inadmissible, or that the newly

filed documents were inadmissible having regard to Article 114(2) EPC.

The Respondent also submitted a substantive reply to the contentions set out in the grounds of appeal.

Finally, the Respondent requested that as a matter of equity and in accordance with Article 104 and Rule 63 EPC, the Appellant should be ordered to reimburse the Respondent for all costs incurred in the appeal.

- VI. The Appellant submitted further observations going to the substance of the opposition in August and October 1987. By summons dated 24 March 1988, oral proceedings were appointed on 28 June 1988. In an accompanying communication of the same date, the Rapporteur stated that the documents filed by the Appellant in support of the appeal had been studied, and that in the light of the communication dated 23 September 1986 and the subsequent observations of the parties, the Board's present intention was that the new documents cited in the grounds of appeal should not be admitted into the appeal.

By letter dated 30 May 1988, the Appellant again submitted that the affidavit filed with the grounds of appeal had proved that the decision of the Opposition Division was wrong in its finding that the claimed invention always provided superior properties. The Appellant further stated that in view of the communication dated 24 March 1988, the opposition was withdrawn.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is admissible.

2. The withdrawal of the opposition by the Appellant is treated by the Board as a withdrawal of the appeal, so that the grounds for opposing the maintenance of the European patent are no longer to be considered. Nevertheless, as set out in paragraph V above, the Respondent requested during the appeal proceedings an award of costs incurred in the appeal under Article 104 and Rule 63 EPC, and this request remains to be decided by the Board.
  
3. Article 104(1) EPC is concerned with the costs of opposition proceedings, and provides:

"Each party to the proceedings shall meet the costs he has incurred unless a decision of an Opposition Division or a Board of Appeal, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs incurred during taking of evidence or in oral proceedings".

No oral proceedings took place during the appeal proceedings.

The question to be decided is whether the Board should order "a different apportionment of costs incurred during taking of evidence".

As to the phrase "taking of evidence" used in Article 104(1) EPC, this refers generally to the receiving of evidence during opposition proceedings by an Opposition Division or a Board of Appeal. This is confirmed by Article 117 EPC, where the same phrase constitutes the title. The wording of Article 117(1) EPC makes it clear that the phrase "taking of evidence" covers the giving or obtaining of evidence generally in proceedings before

departments of the EPO, whatever the form of such evidence, and includes in particular the "production of documents" and "sworn statements in writing".

Thus, in the appeal proceedings in the present case, the taking of evidence included the production of the new documents and affidavit by the Appellant, and the filing by the Respondent of a statement in writing in reply. The Board is therefore empowered by Article 104(1) EPC to order an apportionment of costs incurred during the taking of such evidence, for reasons of equity.

4. The further question to be considered is whether in the present case, reasons of equity justify an apportionment of costs in the Respondent's favour.

In this connection, it is important to recall the procedural scheme of opposition proceedings before the EPO as provided by the EPC. In particular, under Article 99(1) EPC, within the nine month period from grant of a European patent, a notice of opposition must be filed in a written reasoned statement, and under Rule 55(c) EPC, the notice of opposition shall contain a statement of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds.

When the requirements of Article 99(1) and Rule 55(c) EPC are considered in context, in the first place it is important to note that opposition proceedings constitute an exception to the general rule under the EPC that a European patent after grant is no longer within the competence of the EPO but becomes a bundle of national patents within the jurisdiction of the designated Contracting States. Opposition proceedings are an exceptional procedure by

which, during a limited period of time only, a centralised action for revocation of a European patent may be brought before and decided by the EPO.

Article 99(1) and Rule 55(c) EPC thus clearly require that as a general rule an opponent's case against an opposed patent should be set out fully and completely in the notice of opposition, and should not be presented and developed piece-meal. Facts and evidence in support of an opposition which are presented after the nine month period has expired are out of time and late, and may or may not be admitted into the proceedings as a matter of discretion under Article 114(2) EPC.

5. Irrespective of whether or not facts or evidence which are presented after expiry of the nine month period are admitted into the proceedings, such late-filed material may clearly cause the incurring of additional costs by another party, which would not have been incurred if such material had been presented within the nine month period. Such late-filed facts and evidence may, therefore, justify an order for apportionment of costs.

In the present case, as the opposition has been withdrawn by the Appellant, the Board is no longer required to decide whether the new material filed with the grounds of appeal should be admitted into the appeal proceedings.

Nevertheless, the Board has inherent power to decide any application made to it which arises out of the appeal (see Decision J 12/86 "Shell cutter/Linville", 6 February 1987, paragraph 5, and Decision T 41/82, "Reimbursement of appeal fees/Sandoz", OJ EPO 7/1982, 256, paragraph 6); such as, in the present case, the Respondent's application for an apportionment of costs.



6. In the Board's view, the late filing of this new material must have considerably increased the costs incurred by the Respondent, in comparison with the situation if all such material had been presented as part of the notice of opposition.

The Board does not accept the Appellant's argument to the effect that the late filing of this material, or some of it, was justified in order to refute certain statements made by the Opposition Division in its decision. In the Board's view, if the Appellant wished to contend, as part of his attack on the opposed patent on the ground of lack of invention, that the claims of the patent cover areas which do not have advantageous properties, he should have produced all evidence in support of that contention during the nine month opposition period. Furthermore, in the Board's view, the fact that a document such as a patent specification is mentioned in the opposed patent does not provide any justification for citing such a document for the first time in support of a contention of lack of invention outside the nine month opposition period (in the present case, during the appeal stage and more than two years after expiry of the opposition period).

7. Having regard to what is set out above, in the Board's judgement reasons of equity justify an order for apportionment of costs in the present case.

Rule 63(1) EPC provides that "apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties". Bearing this in mind, and having carefully considered all the relevant circumstances of the case, the Board has decided to order an apportionment of costs by which the Appellant shall pay to the Respondent fifty per cent of the

costs which were incurred by the Respondent's representative and charged to the Respondent in preparing and filing the reply to the appeal dated 22 December 1986.

**Order**

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

The costs in the appeal procedure shall be apportioned so that the Appellant shall pay to the Respondent fifty per cent of the costs which were incurred by the Respondent's representative and charged to the Respondent in preparing and filing the Respondent's reply to the appeal dated 22 December 1986.

**The Registrar:**



F. Klein

**The Chairman:**



F. Antony