

Publication in the Official Journal Yes / ~~No~~

File Number: T 326/87 - 3.3.3
Application No.: 81 305 448.3
Publication No.: 0 055 893
Title of invention: Flame-retardant polyamide compositions

Classification: C08L 77/00

D E C I S I O N
of 28 August 1990

Proprietor of the patent: E.I. Du Pont de Nemours and Company

Opponent: 01 BASF AG
02 Bayer AG

Headword: Polyamide compositions/DU PONT

EPC Art. 99(1), 104, 111(1), 114(1) and (2)
Rule 55(c), 63

Keyword: "General Principles for Opposition Procedure in the EPO"
"Late-filed document admitted" - "remittal to Opposition Division
in exercise of discretion under Article 111(1)"
"Right to two instances of jurisdiction"
"Apportionment of costs: mitigating circumstances - former GDR
document"

Headnote

I. The public's as well as the parties' interests require that opposition proceedings should be speedily concluded. This requirement clearly extends to appeal proceedings as well. Article 99(1) and Rules 55(c) EPC, read in the light of Rule 66 EPC, seeks to ensure this by requiring the full presentation in the Notice of Opposition of the case that a patentee needs to meet in order to keep his patent in force (see paragraph 2.1.1 of the Reasons for the Decision).

II. Matter, e.g. facts and evidence, submitted for the first time in appeal proceedings may be disregarded by the Boards of Appeal as a matter of discretion and pursuant to Article 114(2) EPC, which sets the legal limit upon the inquisitorial duties of the Board under Article 114(1) EPC (see paragraph 2.1.2 of the Reasons for the Decision).

III. If the evidential weight of late filed documents in relation to those already in the case ("their relevance") warrants their admission into the proceedings, the case should normally be remitted to the first instance (Article 111(1) EPC), particularly if the late filed material puts the maintenance of the patent at risk (see paragraph 2.2 of the Reasons for the Decision).

IV. In such a case, costs between the parties should be apportioned under Article 104 and Rule 63(1) EPC, in such a way that the late filing party should normally bear all the additional costs caused by his tardiness (see paragraph 2.3 of the Reasons for the Decision).

V. Costs should only be shared between the parties if there exist strong mitigating circumstances for the late filing of facts, evidence or other matter (see final sentence of paragraph 2.3 and paragraph 5 of the Reasons for the Decision).



Case Number : T 326/87 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 28 August 1990

Appellant :
(Opponent 01)

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Other Party:
(Opponent 02)

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Respondent :
(Proprietor of the patent)

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Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 5 May 1987, issued on
30 June 1987, rejecting the opposition filed
against European patent No. 0 055 893 pursuant to
Article 102(2) EPC.

Composition of the Board :

Chairman : F. Antony

Members : S. Schödel

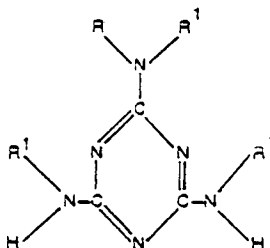
J. Stephens-Ofner

Summary of Facts and Submissions

- I. European patent 55983 was granted on 13 February 1985 with five claims in response to European patent application No. 81 305 448.3. Claim 1 read as follows:

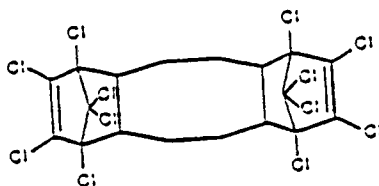
"A reinforced, flame-retardant, arc track resistant composition comprising a polyamide, glass fibers, a zinc compound and a halogenated flame retardant, characterised by consisting essentially of

- (a) 40 to 65 weight percent of a polyamide of film-forming molecular weight;
- (b) 16 to 35 weight percent of melamine, melam, melamine cyanurate or a melamine derivative of the formula



where R and R¹ are the same or different and represent hydrogen, alkyl of 1 to 6 carbons, phenyl, tolyl or halo-phenyl, provided that not all the R and R¹ symbols can represent hydrogen;

- (c) 1 to 7 weight percent of a chlorine-containing compound of the formula



or a brominated polystyrene;

- (d) 1 to 4.9 weight percent of zinc borate or zinc oxide;
and
- (e) 5 to 30 weight percent of glass fibers; the total amount of components (a) to (e) being 100 percent based on their combined weights."

Claims 2 to 4 were dependent on Claim 1 and Claim 5 was directed to articles fabricated from the compositions as claimed in the previous claims.

- II. Notices of oppositions were filed by the Appellants (Opponents) requesting revocation of the patent on the grounds of Articles 100(a) and (b) EPC.

- III. By a decision delivered orally on 5 May 1987, with written reasons issued on 30 June 1987, the Opposition Division rejected the oppositions holding that the arguments based on the documents then on file, in particular
 - (1) US-A-4 105 621
 - (4) GB-A-1 235 813and the late filed, but admitted document
 - (9) JP-A-77/60845 (abstract in English)did not prejudice the maintenance of the contested patent.

Citation (1) was the only document dealing with GF-PA compositions (GF = glass fibre; PA = polyamide) which were designed to have both a flame retardancy of V-1 or better (determined by using the Underwriters Laboratories Test Standard UL94) and a good tracking resistance. As compared with this, Claim 1 under consideration provided for melamine (or certain derivatives thereof) as an additional flame retardant, used less zinc borate, avoided the

obligatory presence of an oxide such as antimony oxide and had, as a selected halogenated flame retardant, the compound $C_{18}H_{12}Cl_{12}$ (= FR 1, "Dechlorane") or brominated polystyrenes (= FR 2).

The expert could not from document (4) deduce that melamine would help in achieving a V-1 fire retardancy, because it reported the synergistic effect between certain halogenated flame retardants (other than FR-1 and FR-2) and melamine.

Lastly, document (9) taught the combined use of FR-1, melamine and iron-III-oxide, and whilst the resulting compositions met the UL94 rating V-0, nothing was said in this abstract about tracking resistance.

Thus, there was no hint in the cited prior art as a whole that melamine enhanced the tracking resistance, and that the use of smaller amounts of halogenated flame-retardant would automatically have entailed the use of less zinc borate. The fact that control examples A, B and C of the contested patent, which contained melamine, showed a favourable influence on tracking resistance did not indicate that this knowledge was in the public domain and could not, therefore, be utilised to attack the inventiveness of the patent in suit.

The Opposition Division also found that the terms "film-forming molecular weight" of the PA and "zinc borate" met the requirements of sufficiency (Article 83 EPC), since the description contained the necessary information for the expert to make the PA and zinc borate applicable for the objects envisaged.

IV. Notice of appeal was lodged by one of the Appellants (Opponent 1) on 28 August 1987, the appeal fee being paid

on the same day. The Statement of Grounds was received on 30 October 1987, in which, for the first time, document (10) DD-A-143 918 was cited.

The Appellant argued, in essence, that (10) was concerned with GF-PA compositions which were free from any halogenated ingredient and from antimony oxide, contained melamine as the fire-retardant, and also showed good tracking resistance.

It followed, so the Appellant argued, that by combining (1) and (10), the claimed subject-matter became obvious. The Appellant sought to support this allegation by comparative data submitted on 2 February 1989, demonstrating that the results achieved following the teaching of the patent in suit were in no way better than those resulting from (10).

- V. In his observations in reply to the Statement of Grounds of Appeal, the Respondent challenged the Appellant's arguments, pointing out that the claimed subject-matter was inventive, especially since both the data in Table IV of the specification as granted, and the further data submitted on 6 August 1990, showed an unexpected effect of the patent in suit over the compositions of (10).
- VI. On 28 August 1990, oral proceedings took place. The central issue raised by the Board was the admissibility of (10) into the appeal proceedings under Article 114 EPC.

The Appellant gave as the reason for the belated submission of (10) the fact that (10) was not available to him at the time the opposition was filed. Patent specifications from countries such as the former GDR were

not usually part of the manual search stock, and only being aware that he was unlikely to succeed on the point of inventive step at the appeal stage with the prior art material then on file, he carried out a belated computer search, which brought (10) to light - just in time for the appeal proceedings.

Furthermore, the Appellant pointed out that it was common general knowledge that GF-PA compositions containing halogenated fire retardants would evolve corrosive gases when subjected to heat, and that this disadvantage could be minimised by reducing the amount of halogenated material. Document (10) recommended the application of melamine, which is a halogen-free fire retardant. Moreover, the examples of (10) demonstrated how to attain a good tracking resistance.

Thus, even without a detailed consideration of the experimental results and admitted that the compositions of the patent in suit might show some advantage over (10), document (10) had to be considered as being at least as relevant as (1).

The Respondent, by contrast, argued strongly that (10) was not of sufficient weight to be admitted at this late stage of the proceedings. In support of this, he stressed that the compositions of (10) did not satisfy the stringent requirements laid down in the patent in suit; this was in particular true for the UL94 rating of V-1 at low and high temperatures.

He also pointed out, in this connection, that since GF-PA compositions containing melamine as a fire retardant belonged to another category of compositions than those based on halogenated materials, the teachings of (10) and (1) could not be combined. Document (10) represented just

a further example of a failure by the prior art to appreciate the advantages that could be gained by operating in accordance with the patent in suit. Therefore, (10) could not be considered to be more relevant than any of the other citations. However, should the Board admit document (10) into the proceedings, then the case should be remitted to the Opposition Division for further examination.

Having heard the parties' arguments, the Board expressed its willingness in principle to remit the case to the first instance should document (10) be admitted into the appeal.

- VII. The Appellant requested that the decision under appeal be set aside and the patent in suit be revoked.

The Respondent requested that the appeal be dismissed.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. **General Procedural Considerations**
 - 2.1 The central issue to be decided by the Board is whether reference (10), filed by the Appellant for the first time in the appeal stage, should be admitted into the proceedings, or be disregarded pursuant to Article 114(2) EPC, as not having been submitted in due time. The Respondent urged that the Appellant should not be allowed to introduce this newly cited document into the proceedings because of its lateness and insufficient relevance. The Appellant sought to justify its

introduction on the ground that it constituted cogent and weighty evidence of common general knowledge at the time of filing of the patent in suit.

- 2.1.1 Article 99(1) EPC in conjunction with Rule 55(c) EPC, clearly lays down that the due time for filing evidence in opposition cases is at the date of filing of the Notice of Opposition.

In addition, the note on "Opposition Procedure in the EPO" published in OJ EPO 1989, 417 gives further guidance in relation to the time and manner in which the parties' cases in opposition proceedings should be presented. Thus, in paragraph 2 of the above document, it is stated: "The EPO's aim remains to establish as rapidly as possible in the interests of both the public and the parties to the opposition proceedings whether or not the patent may be maintained given the Opponent's submissions. It seeks to achieve this by means of a speedy and streamlined procedure .." (emphasis added).

Paragraph 8 goes on to state: "Under Rule 55(c), the Notice of Opposition must contain an indication of the facts, evidence and arguments in support of the grounds of opposition. This requirement is to be interpreted as meaning that the Notice of Opposition must at least indicate clearly to the proprietor the case he has to answer .." (emphasis added).

Paragraph 13, in dealing with facts and evidence not submitted in due time, lays down: "In order to expedite proceedings, parties should in principle submit all facts, evidence and requests at the beginning of the procedure. Where this is not possible, the facts, evidence or requests must be submitted at the earliest opportunity. If relevant facts or evidence are submitted by a party

only at a late stage of proceedings without very good reason (emphasis added) and if as a consequence unnecessary costs are incurred by another party, this will be taken into account in apportionment of costs ..".

2.1.2 Thus, the underlying principle, clearly recognised and implemented by the Boards of Appeal, e.g. in T 117/86, "Costs/FILMTEC", OJ EPO 1989, 401; T 182/89, "Extent of opposition/SUMITOMO" (to be published), is one of early and complete presentation of the parties' case as opposed to the piecemeal and tardy introduction of the arguments and supporting evidence. It is this jurisprudence, together with the express wording of Article 114(2) EPC, a wording which is clear and unambiguous in all the three languages, that sets the legal limit upon the inquisitorial duties of the Boards of Appeal, which duty, therefore, should not be interpreted as extending to carrying out a roving inquiry into facts alleged and evidence adduced at a late stage of the proceedings. In deciding upon the admissibility of a late filed document in the light of the above principles, the Board must clearly be strongly influenced by what is frequently referred to as the relevance of the document sought to be introduced, by which is meant the evidential weight of that document in relation to other documents already in the case.

2.2 If a document is sufficiently relevant in this sense to be admitted, then, in the exercise of the Board's discretion under Article 111(1) EPC, the case, together with the document admitted, should normally be referred back to the first instance so as to allow the case to be examined in the light of the new document at two levels of jurisdiction so as not to deprive the patent proprietor of one such level of jurisdiction. Such a procedure is clearly desirable when the Board considers that the newly

introduced document is of such relevance that it puts the maintenance of the patent at risk, whilst if this is not the case, then it is open to the Board to deal with the matter itself.

- 2.3 Regardless of the course of action the Board decides to adopt in the exercise of its discretion under Article 111(1) EPC, it is clear that the late filing by one party of a document or documents which are admitted into the proceedings, must increase the costs incurred by the other party in comparison with the situation if all the facts, evidence and documents had been filed, as they should be filed, within the nine-month opposition period. Article 104 EPC, in conjunction with Rule 63(1) EPC, is designed to redress the equity of the situation by the apportionment of costs incurred during the taking of evidence or in oral proceedings. As provided in Rule 63(1) EPC, such costs include the remuneration of the representatives of the parties; see decision T 117/86 supra and T 416/87 (to be published), Headnote published in OJ EPO 1989, No. 11.

The degree of apportionment must depend on the circumstances of each case, but where a document successfully introduced at a late stage is of such relevance that the Board decides to remit the case to the first instance in order to allow the patentee to have his case decided by two instances of jurisdiction, then in the absence of any convincing explanation for the late introduction of that document, the costs of any oral proceedings in the appeal should normally be borne in toto by the party responsible for its late introduction. The reason for this is clear, namely that the decision to remit to the first instance, and therefore not to deal with the matter in the course of the oral proceedings in the appeal, renders those proceedings superfluous in the

overall sense, and the responsibility for this should, as expressed in costs, be borne wholly by the late-filing party.

Naturally, there may be mitigating circumstances in the above case, for example, where the document introduced was obscure and therefore difficult to get hold of.

3. Admission of Document (10)

In all the circumstances of the present case, the Board has decided to admit citation (10) into the appeal.

3.1 It is immediately clear from a prima facie consideration of document (10) that this citation cannot be regarded as a mere complement to references already considered by the Opposition Division as alleged by the Respondent. Indeed, document (10) relates to a process for the manufacture of flame-proof moulding compositions which are based on GF reinforced PA-6, melamine (or a condensation product thereof such as melam) as the fire-retardant and a reactive inorganic glass-forming additive such as zinc borate ($2ZnO \cdot 3B_2O_3 \cdot 3.5H_2O$), the latter acting synergistically with the melamine compound. These compositions are reported to be self-extinguishing and non-dripping. They do not contain any halogenated fire-retardants which are known to give off corrosive gaseous decomposition products during processing and contribute to a high level of mechanical and electrical properties, in particular tracking resistance.

3.2 The flame-retardant GF-PA-compositions of Claim 1 of the patent in suit (first alternative), on the other hand, comprise two types of flame-retardants, namely melamine or certain derivatives thereof, e.g. melam, which are halogen-free compounds; and additionally "Dechlorane",

which is a well-known chlorine-containing compound, together with zinc borate (e.g. $2\text{ZnO} \cdot 3\text{B}_2\text{O}_3 \cdot 3.5\text{H}_2\text{O}$). These compositions can be applied in articles which are said to satisfy the dual requirement of good fire-retardancy and good resistance to carbonisation when subjected to electrical discharge. Thus, it seems that the technical aims envisaged by the patent in suit (which are outlined in more detail in the patent specification; cf. page 2, paragraph 4 and page 4, paragraph 5) can be solved by the provisions of the claimed GF-PA compositions having minimum amounts of organic halogenated materials and zinc borate, at the same time maintaining the high levels of desired properties.

- 3.3 There can thus be no doubt that the close technical relationship of the known compositions to the claimed subject-matter raises new issues of inventiveness in the light of the prior art already cited and, more particularly, the belatedly filed citation (10), which require a fresh assessment of the case.

4. Remittal to Opposition Division

In deciding on this appeal, the Board may, in accordance with Article 111(1) EPC, either exercise any power within the competence of the Opposition Division (which was responsible for the decision appealed) or remit the case to that department for further prosecution. It is thus at the Board's discretion whether it examines and decides the case or remits the case to the first instance.

However, any necessary fresh assessment of a case should normally be carried out by the first instance, as set forth in section 2.2 above. This is especially so when, as in the present case, having regard to the high degree of relevance of the belated citation (10), the maintenance of

the patent in suit would be at risk. In such a situation, further examination should be undertaken by the Opposition Division so as to afford the parties two levels of jurisdiction, all the more so when, as in the present case, the Respondent has expressly asked for this.

5. Apportionment of Costs

As set out in section 2.3 above, when late submittal of a document necessitates remittal of a case to the first instance, the costs of any oral proceedings in the appeal should normally be borne in toto by the responsible party.

In the present case, the reason given by the Appellant for the belated submission of document (10) was the relative difficulty of obtaining it by reason of its being a GDR patent and not, in consequence, being part of their normal manual search stock. The Board finds this reason plausible to some extent and is, therefore, prepared to accept it as a valid reason for departing from what should be the normal practice of awarding the whole of the costs of the oral proceedings in the appeal against the Appellant.

In exercising its discretion, the Board will order the Appellant to pay half of the Respondent's costs for the oral proceedings in the appeal.

Order

For these reasons, it is decided that:

1. Late filed document (10) is formally admitted into the appeal proceedings.

2. The decision under appeal is set aside.
3. The case is remitted to the Opposition Division for further examination of the opposition.
4. The costs in the appeal procedure shall be apportioned so that the Appellant shall pay to the Respondent 50% of the costs which were incurred by the Respondent's representative in connection with the oral proceedings in the appeal, and were charged to the Respondent.

The Registrar:

The Chairman:

M. Beer

F. Antony