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Aktenzeichen / Case Number / N° du recours : T 323/89 - 3.3.2

Anmeldenummer / Filing No / N° de la demande : 82 306 970.3

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 083 239

Bezeichnung der Erfindung: Multi-layer light-sensitive silver halide  
Title of invention: colour photographic material  
Titre de l'invention :

Klassifikation / Classification / Classement : G03C 7/26

### ENTSCHEIDUNG / DECISION

vom / of / du 24 September 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet :

Konishiroku Photo Industry Co. Ltd.

Einsprechender / Opponent / Opposant : AGFA-GEVAERT AG

Stichwort / Headword / Référence : Photographic material/KONISHIROKU

EPÜ/EPC/CBE Article 104, Rule 63

Schlagwort / Keyword / Mot clé : Apportionment of costs - fixed amount of costs

Leitsatz / Headnote / Sommaire

Headnote follows



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**D E C I S I O N**  
of the Technical Board of Appeal 3.3.2  
of 24 September 1990

**Appellant :** AGFA-GEVAERT AG, Leverkusen  
Postfach  
D-5090 Leverkusen 1

**Respondent :** KONISHIROKU PHOTO INDUSTRY CO. LTD.  
1-26-2, Nishi-shinjuku  
Shinjuku-ku  
Tokyo  
JP

**Representative :** Wood, Anthony, Charles  
Urquhart-Dykes & Lord  
91 Wimpole Street  
London W1M 8AH  
GB

**Decision under appeal :** Decision of the Opposition Division  
of the European Patent Office  
dated 15.3.1989 rejecting the  
opposition filed against European  
patent No. 083 239 pursuant to  
Article 102(2) EPC

**Composition of the Board :**

**Chairman :** P.A.M. Lançon  
**Members :** R. Schulte  
R. Lunzer



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## Summary of Facts and Submissions

- I. European patent No. 083 239 entitled "Multi-layer light-sensitive silver halide color photographic material" was granted to the Respondents on 13 August 1986 on the basis of their application No. 82 306 970.3.
- II. The Appellants filed notice of opposition, requesting that the patent be revoked as not complying with the requirements of Articles 52, 54 and 56 EPC.
- III. The Opposition Division rejected the opposition in accordance with Article 102(2) EPC.
- IV. The Appellants appealed on 10 May 1989 against that decision, citing additional prior art in their statement of grounds. As evidence of emulsion production they referred to their own colour photographic Super-8 film, known in-house as CK 17-6e and marketed as Agfamoviechrome 40 or AM 40. They further submitted two product sheets dated 9 March 1978, the Möller curve of the emulsion SUK of 29 January 1979 and an in-house memo dated 23 November 1979.
- V. The Respondents claimed that the new material presented in the statement of grounds should be disallowed because it had been submitted out of time. They contested the analytic data, arguing that it was extremely unlikely that these could have been obtained from the commercial product.
- VI. A submission from the Appellants dated 16 January 1990 and received on 18 January 1990 was worded as follows:  
  
"Unseren Einspruch gegen das vorstehend genannte Patent ziehen wir hiermit zurück".

In response to an inquiry made by telephone, the Appellants indicated that, so far as they were concerned, the appeal was ended.

VII. On the grounds that they had been put to considerable expense, the Respondents applied for costs under Article 104(1) EPC. The Appellants, who had been notified of this request and whose attention had been drawn to decision T 117/86, (OJ EPO 1989, 401), made no comment.

**Reasons for the Decision**

1. The appeal is admissible.
2. The withdrawal of the opposition by the Appellants and their statement that, so far as they were concerned, the appeal was ended 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 VII 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. Under Article 104(1) EPC, each party to opposition proceedings normally meets his own costs unless the Board, for reasons of equity, orders a different apportionment of costs incurred during taking of evidence or in oral proceedings. The Board considers such an exception from the norm of Article 104(1) EPC to be justified in the present case. It was in their statement of grounds for appeal that the Appellants first drew attention to additional prior art in the form of a particular photographic film produced and distributed by themselves and to various supporting

documents. The introduction of this new prior art more than two years after expiry of the opposition period meant that the Respondents and patent Proprietors once again had to devote time and energy to countering objections which the Appellants could easily have advanced within the opposition period. This put the patent Proprietors to extra expense because commenting on submissions made within a short span of time during the opposition period is less costly than having to consider the material sporadically over a number of years.

4. These additional costs were incurred in connection with "taking of evidence" within the meaning of Article 104(1) EPC. The term "taking of evidence" is used in two ways in the EPC. Sometimes it denotes the procedure following an EPO decision pursuant to Rule 72 EPC on the need to hear parties, witnesses or experts to carry out an inspection. This is not the sense of the term "taking of evidence" as used in Article 104(1) EPC, in which it refers to any of the means of giving or obtaining evidence set out in Article 117(1) EPC (see also T 117/86, see above; T 416/87 of 29 June 1989, OJ 11/1989 in the OJ EPO; T 101/87 of 25 January 1990, unpublished).
  
5. A decision awarding costs under Article 104(1), being an exception to the norm that all parties meet their own costs, only arises if the special circumstances of the case call for it. The Board believes costs should be awarded if a party to proceedings can be held to have caused unnecessary expense that could well have been avoided with normal care. In its opinion, these criteria have been met in the present case since the Appellants could easily have come forward with the above-mentioned prior art during the opposition period - their own prior use, after all, being at issue - rather than wait until filing their statement of grounds. Nor have the Appellants explained why the new

state of the art was only cited so late in the day. It therefore seems equitable to order that the Appellants meet part of the additional costs incurred by the Respondents.

6. Under Rule 63(1) EPC, apportionment of costs must be dealt with in the decision. This may be done by awarding all the additional costs or a fraction thereof (as in T 117/86, OJ EPO 1989, 401) against the party to the proceedings who caused them. In the present case, the Board can more or less estimate those additional costs since the Respondents merely submitted a typescript 1 1/2 pages long containing some relatively brief comments in response to the new prior art. In these circumstances, the Board considers it appropriate to set a fixed amount refund to the Respondents by way of costs. This also has the advantage, both for the parties and for the EPO, that it dispenses with the need for the costs to be established pursuant to Rule 63(2) EPC. The Board considers it equitable that the Appellants should pay the Respondents DEM 200.

#### Order

For these reasons, it is decided that:

The Appellants shall pay the Respondents the sum of DEM 200 to defray part of the latter's expenses.

The Registrar:

The Chairman:

M. Beer

P.A.M. Lançon