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File Number: T 534/89 - 3.2.2  
Application No.: 84 300 954.9  
Publication No.: 0 119 021  
Title of invention: Improved dental cleaning system  
  
Classification: A61C 17/02

**D E C I S I O N**  
**of 2 February 1993**

Applicant: Dentsply Research and Development Corporation

Opponent: EMS S.A. Electro Medical Systems

Headword: Inadmissible late filing/EMS

**EPC** Articles 99, 108 and 114; Rules 55(c) and 65(1)

Keyword: "Late submission - abuse of procedure" - "Discretion under Article 114(2) EPC" - "Disregard of late submission irrespective of relevance"

**Headnote**

*1. Whereas the apportioning of costs between parties may be appropriate in cases of neglect or ignorance, when a late submission is caused by deliberate manipulation the justification for exercising the discretion under Article 114(2) EPC against a party who willfully acted contrary to good faith should be considered (point 2.3 of the Reasons).*

*2. When abuse of procedure is manifest in view of the fact that a party deliberately abstained from raising an issue even when the evidence in its*

*support was available, it would be contrary to the principle of good faith to admit such evidence by applying Article 114(2) EPC in favour of that party. Consequently, in exercising its discretion under Article 114 EPC, the Board finds it justified to dismiss the objection of prior use irrespective of its potential relevance (point 2.7 of the Reasons).*



Case Number: T 534/89 - 3.2.2

**D E C I S I O N**  
**of the Technical Board of Appeal 3.2.2**  
**of 2 February 1993**

**Appellant :** EMS S.A. Electro Medical Systems  
(Opponent) G. - H. Piguet 17  
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**Representative :** Gauger, Hans-Peter, Dipl.-Ing.  
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**Respondent :** Dentsply Research and Development  
(Proprietor of the patent) Corporation  
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**Representative :** Woodcraft, David Charles  
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**Decision under appeal :** Interlocutory decision of the Opposition Division  
of the European Patent Office dated 29 June 1989  
concerning maintenance of European patent  
No. 0 119 021 in amended form.

**Composition of the Board :**

**Chairman :** G.S.A. Szabo  
**Members :** E.M.C. Holtz  
J.B.F. Kollar



## Summary of Facts and Submissions

- I. The appeal lies against the decision of 29 June 1989 by the Opposition Division to maintain European patent No. 0 119 021 in amended form.
- II. The Appellant (Opponent) filed a Notice of Appeal on 10 August 1989 and paid the appeal fee on the same day. A Statement of Grounds was filed on 27 October 1989.
- III. An objection of prior use was invoked for the first time in the Statement of Grounds for the appeal, related to sales on the open market by the Appellant himself. Apart from this prior use, the Statement of Grounds only refers in general terms to submissions made by the Appellant in the opposition proceedings. A communication explaining the preliminary views of the Board was issued with the summons to oral proceedings appointed for 2 February 1993.
- IV. The representative for the Appellant stated in the oral proceedings that he had only come to know about the prior use (the Appellant had branches in various countries) about a month before expiry of the period for opposition. It was therefore decided not to raise this issue in the opposition proceedings. After the decision under appeal - due to difficulties in defining the invention - it was however thought that the prior use might help in defining the relevant prior art and hence the invention, in accordance with the whole contents approach.
- V. The Respondent (Proprietor of the patent) contended that the issue of prior use should not be admitted as

there had been no good reason why it had not been raised before in the proceedings. Furthermore, the remainder of the Statement of Grounds was insufficient under Article 108 EPC, since it neither stated in what way the decision under appeal was faulty, nor discussed what the arguments were upon which the Appellant was going to rely in the appeal proceedings.

VI. The Appellant requests that the decision under appeal be set aside and the patent revoked.

The Respondent requests that the appeal be rejected as inadmissible.

### **Reasons for the Decision**

1. The basic issue to be decided is whether or not the appeal meets the requirement under Article 108, third sentence, EPC of being adequately defined. There are two different kinds of admissibility involved, the first related to the admissibility of the late filed objection of prior use. Depending on the outcome of this, a question of admissibility of the appeal as such might arise, in view of the possibly inadequate contents of the Notice of Appeal.

2. *Admissibility of the objection of prior use*

2.1 From the established jurisprudence of the Boards of Appeal with regard to admittance of late filing of grounds, arguments and evidence (Article 114 EPC) the following principles emerge.

The purpose of Rule 55(c) EPC is to allow the patentee and the Opposition Division (or the Board on appeal) at once to understand the opponent's case properly on an objective basis without having to consult the documentation on file (T 222/85, OJ EPO 1988, 128). In the exercise of discretion under Article 114(2) EPC, however, an extremely pertinent document may still be admitted later on in the proceedings (T 142/84, OJ 1987, 112, subsequently confirmed by e.g. T 271/84, OJ EPO 1987, 405 and T 416/87, OJ EPO 1990, 415, see also General Principles for Opposition Procedure in the EPO, OJ EPO 1989, 417). A party invoking a late item has to set out the reasons that prevented him from submitting it earlier (T 156/84, OJ EPO 1988, 372, which also declared that paragraph 1 of Article 114 EPC had precedence over paragraph 2 as a result of the EPO's duty not to grant or maintain patents which it is convinced are not valid).

The apparent abuse of procedure through a non-excusable failure in presenting cases fully at the earliest possible stage was addressed in case T 416/87, but the Board settled for an apportionment of costs, because the late filed document was considered the closest prior art and therefore admissible. The same balancing "remedy" by way of apportioning costs was used in T 611/90, cf. headnote in OJ EPO 1992, No. 3.

- 2.2 To conclude from this jurisprudence, a late filed item relevant to the question of novelty or inventive step will normally be accepted under Article 114(2) EPC, provided that this may become critically relevant to the outcome of the case. Thus, a claim to prior use would only be admitted under this "principle of relevance", if it represents prior art within or closer



to the claimed subject-matter compared to documentation already available in the case, thereby potentially changing the outcome of the procedure.

However, no prior decision has addressed the possible applicability of Article 114(2) EPC independently of Article 114(1) EPC. The reluctance of the Boards of Appeal to disregard late-filed items under Article 114(2) EPC without first provisionally having considered their relevancy, may stem from the G 1/84 opinion (OJ EPO 1985, 299, point 3) that the overwhelming interest of the public lies in each opposition being examined on its merits, except in manifest cases of abuse.

- 2.3 The Board takes the view that whereas the apportioning of costs between parties may be appropriate in cases of neglect or ignorance, when a late submission is caused by deliberate manipulation the justification for exercising the discretion under Article 114(2) EPC **against** a party who willfully acted contrary to good faith should be considered.
- 2.4 The particular circumstances of the present case first require consideration of whether or not the Appellant has given valid reasons for the delay. If not, it has to be decided whether or not the absence of a valid excuse constitutes abuse of procedure. If abuse is confirmed, it has finally to be decided whether the graveness of the circumstances justifies disregarding the late filed material.
- 2.5 The Appellant has frankly admitted that the information about the prior use was available before expiry of the period for opposition and that it was a deliberate

choice not to raise this issue in the opposition proceedings, partly because the time for obtaining the necessary evidence was deemed too short.

However, as established by the jurisprudence of the Boards of Appeal, in order for an objection to be validly raised in a notice of opposition it is not necessary to present the evidence itself in the same submission (see *inter alia* J 22/86, OJ EPO 1987, 280). It is normally sufficient to submit this evidence as soon as it is in fact available. In this context there is a distinction to be made between raising the issue at all, which is required under Article 99 in conjunction with Rule 55(c) EPC, and submitting such evidence in its support as to make the argument convincing, the latter not being required under Articles 99 or 108 EPC (cf. T 222/85, point 5). Thus in the present case nothing would have prevented the Appellant from referring to prior use as one of the arguments to be considered with regard to novelty, stating that evidence in its support would be submitted in due course.

The fact that there may have been uncertainty as to the exact nature of the invention is no excuse, since any claim to prior use necessarily has to be examined on its merits (cf. e.g. T 328/87, OJ EPO 1992, 701) regardless of when raised. The argument that the prior use was only "needed" later on to define prior art or the invention, in particular with reference to the whole contents approach, if making any sense at all, would equally apply to the proceedings before the first instance. Any deliberate withholding of information relevant to the validity of the patent - so-called "salami tactics" - is not only against the direct

interest of the public at large but may also be recognised as possibly leading to a deception through a conspiratorial compromise between the parties on the point in question.

The Respondent, as well as the EPO and the public at large, was left ignorant as to the full extent of the Appellant's objections until the appeal proceedings. As already mentioned in the Board's communication, a delay of this length puts an unreasonable demand on the Respondent, who would be called upon to find evidence after several years after the fact in order to refute the allegation.

- 2.6 An objection based on the Opponent's own prior use which is raised only after expiry of the opposition period under Article 99(1) EPC, although the factual circumstances were known to the Opponent and nothing prevented this objection from being raised during that period, constitutes abuse of procedure.
- 2.7 It is therefore the view of the Board that, when abuse of procedure is manifest in view of the fact that a party knowingly abstained from raising an issue even when the evidence in its support had become fully available, it would be contrary to the principle of good faith to admit such evidence by applying Article 114(2) EPC in favour of that party. Consequently, in exercising its discretion under Article 114 EPC, the Board finds it justified to discard the objection of prior use irrespective of its potential relevance.
- 2.8 It has been declared and emphasised many times that expeditious proceedings are aimed at by the European

Patent Office in the interest of legal certainty. The Board finds that the parties should be aware of the risks of not complying with the principles laid down to ensure such expediency, and that they must face more serious consequences than apportionment of costs, which at least to some powerful participants does not seem to be an effective deterrent.

2.9 The objection of prior use having been found inadmissible, those parts of the Statement of Grounds devoted thereto are consequently to be ignored.

### 3. *Adequacy of Grounds*

3.1 The requirement of Article 108 EPC for a statement of grounds serves a number of purposes. Firstly, the appeal procedure is basically a review of the decision under appeal, not a re-examination of the application or patent. Therefore, the statement should set out the legal and factual reasons why the decision under appeal should be set aside and the appeal allowed. Secondly, the grounds must put the respondent in a position to enable him to react adequately to the appeal, and the EPO to conduct the proceedings properly. Thirdly, the public interest requires that the possibility to challenge a decision by the first instance expire at a specific date given by law. As an appeal under the EPC is subject to submissions in two stages, with a given separate time period for each action to be taken, the public interest necessitates a complete Statement of Grounds within that period (cf. T 220/83, OJ EPO 1986, 249, T 213/85, OJ EPO 1987, 482, J 22/86, OJ EPO 1987, 280 and T 145/88, OJ EPO 1991, 251).

3.2 The Appellant has only made a general reference to submissions made before the Opposition Division, without any analysis of the reasons why these observations should overturn the decision under appeal. As was pointed out in decision T 432/88 of 15 June 1989 (unpublished), such a vague reference leaves it to the Board and Respondent to conjecture in what respect the Appellant considers the decision under appeal to be defective. This is just what the requirement of grounds for appeal is designed to prevent. Otherwise the Respondent is at a loss to know how to prepare his case and the Board cannot direct the appeal proceedings in an efficient way.

In the present case, the earlier submissions referred to consist of rather lengthy and complicated technical observations made in the Appellant's Notice of Opposition, filed on 5 January 1988. It would therefore neither be possible, as required under the EPO jurisprudence, to understand the appeal by just reading the Statement of Grounds for the appeal and the decision under appeal, nor to ascertain without further investigation into the technical details as presented before the Opposition Division and on record in that file in what respect the decision under appeal might be attacked.

3.3 This Board therefore concurs in the observation of T 432/88 that the mere reference to what has been set out in the opposition proceedings does not comply with the requirement of Article 108, third sentence EPC, at least not where as in the present case extensive investigation would be required in order to define the appeal.

4. *Conclusion*

In consequence of the inadmissibility of the prior use objection as well as of the inadequacy of the remaining references in the Statement of Grounds, nothing remains, either in the Notice of Appeal or in the Statement of Grounds, to indicate what the appeal is about. The appeal as a whole must therefore be rejected as inadmissible in accordance with Rule 65(1) EPC.

**Order**

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

The appeal is rejected as inadmissible.

The Registrar:

The Chairman:

S. Fabiani

G. Szabo