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Aktenzeichen

File Number

Numéro du dossier

T 0 4 6 0 1 8 9 - 3 2 2

In der Anlage erhalten Sie

- eine Kopie des Berichtigungsbeschlusses
- ein korrigiertes Vorblatt (Form 3030)
- einen Leitsatz / Orientierungssatz (Form 3030)
- _____

Please find enclosed

- a copy of the decision correcting errors
- a corrected covering page (Form 3030)
- a headnote / catchword (Form 3030)
- _____

Veuillez trouver en annexe

- une copie de la décision rectifiant des erreurs
- une page de garde (Form 3030) corrigée
- un sommaire / une phrase vedette (Form 3030)
- _____

Anmeldung Nr. / Patent Nr.:

Application No. / Patent No.:

Demande n° / Brevet n°:

(soweit nicht aus der Anlage ersichtlich)

(if not apparent from enclosure)

(si le n° n'apparaît pas sur l'annexe)

A	X	B		C	
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File No.: T 0760/89 - 3.2.2
Application No.: 80 107 165.5
Publication No.: 0 029 248
Classification: B29D 29/00
Title of invention: Method of producing cover fabrics for V belts and cover fabrics so produced

D E C I S I O N
of 6 September 1993

Applicant: -
Proprietor of the patent: Burlington Industries, Inc.
Opponent: Dayco Products, Inc.

Headword: Return of documents/BURLINGTON

EPC: Art. 114, 117 and 128; R. 93 and 95

Keyword: "Return of documents of evidence" - "Return of submissions" -
"Confidentiality agreement; Court order"

Headnote

I. Documents filed as evidence during opposition proceedings and submissions referring to them in principle remain in the file until the end of the proceedings and for at least five more years.

II. Documents filed as evidence may only exceptionally and on substantiated request remain unconsidered and returned. Such an exception exists if the interests of the filing party in having them returned unconsidered clearly prevail over the interests of any other party and the public interest.

This may be the case if the documents were filed in breach of a confidentiality agreement and if they did not belong to the state of the art but were third party statements filed in defence to the opposition, and if the other parties involved agreed with the request. The same applies to submissions referring to such documents.

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Headnote

Headnote follows



Case Number: T 0760/89 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 6 September 1993

Appellant:
(Proprietor of the patent) Burlington Industries, Inc.
3000 West Friendly Avenue
Greensboro
North Carolina (US)

Representative:
Uexküll & Stolberg
Patentanwälte
Beselerstraße 4
D - 22607 Hamburg (DE)

Respondent:
(Opponent) Dayco Products, Inc.
333 West First Street
Dayton, Ohio 45402 (US)

Representative:
Jackisch, Walter, Dipl.-Ing.
Menzelstraße 40
D - 70192 Stuttgart (DE)

Decision under appeal: Interim decision of the Opposition Division of the European Patent Office dated 28 September 1989 rejecting the request of the patentee to return certain documents.

Composition of the Board:

Chairman: G.S.A. Szabo
Members: W.M. Schar
W.D. Weiß
J. du Pouget de Nadaillac
L.C. Mancini

Summary of Facts and Submissions

- I. The Appellants are proprietors of European Patent No. 0 029 248.
- II. On 22 April 1986 the Respondents filed an opposition against this patent on the ground of lack of inventive step referring *inter alia* to the prior art document US-4 116 159 (D1).
- III. On 14 December 1987 the Opposition Division issued a communication referring to D1 and preliminarily saying that the patented method seemed to be anticipated by D1.
- IV. The Appellants replied with a letter dated 14 April 1988 and received at the EPO on 19 April 1988 stating *inter alia* that the method according to document D1 had produced unsatisfactory products. As a proof for the said allegation they filed a title page and pages 79, 80, 90 and 91 of a deposition dated 23 April 1987. This deposition stemmed from a US patent-infringement-case between the Appellants and the Opponents before a United States District Court.
- V. By letter dated 24 May 1988 the Appellants filed a request for the return of the filed pages of the said deposition and the submission dated 14 April 1988, because the reposition had previously been put under a protective order by the US-Court due to their confidentiality, and because they were consequently filed in error. If the document could not be returned, the Appellants requested auxiliarily their exclusion from public inspection on the basis of Rule 93(d) EPC until the US-Court lifted the protective order for these pages.

VI. By letter dated 27 May 1988 the Appellants requested the Opposition Division to return the entire reply dated 14 April 1988 on the grounds of an alleged new court order of the same said US-Court.

VII. On 13 June 1988 the Formalities Officer of the Opposition Division sent a communication to the Appellants wherein it was stated that the "pages in question will not be accessible to third parties. A decision will probably not be taken before July."

VIII. By a letter dated 8 February 1989 the Opponents agreed with the Appellants' request for the return of the documents in question and stated that they were themselves interested in keeping them confidential.

By letter dated 21 March 1989 and received on 25 March 1989, the Appellants filed further comments referring to the communication of 14 December 1987 (see point III).

IX. By a letter dated 14 June 1989 the Appellants filed new requests as follows:

1. the return of the entire response dated 14 April 1988 with enclosures and pages 2 to 4 of the submission dated 21 March 1989; or
2. (first auxiliary request) the return of the entire response dated 14 April 1988 with enclosures; or
3. (second auxiliary request) the return of the filed pages of the deposition, submitted with the letter dated 14 April 1988.

X. On 21 July 1989 the Formalities Officer of the Opposition Division issued a communication refusing the requests made by the Appellants (Patentees). It was held

that the documents in question served for the purpose of informing the public about the European patent and that they were therefore not included in the class of documents mentioned in Rule 93 EPC but formed an essential part of the opposition procedure. The US-court order was binding only on the parties involved and not on the Opposition Division of the EPO. There was a reference to the basic principle that all documents filed after the publication of the application should be open to public inspection and that the only restriction to that principle according to Article 128(4) EPC was laid down in the Implementing Regulations.

XI. By a submission dated 25 July 1989 the Appellants requested a separate decision within the meaning of Article 106(3) on their requests of 14 June 1989.

XII. On 28 September 1989 the Formalities Officer acting for the Opposition Division issued the following decision:

"The request of the patent proprietor dated 24 May 1988 for the return or at least the removal from the public file of parts of the deposition dated 23 April 1987, submitted as an annex to the patent proprietor's letter dated 14 April 1988, is rejected."

In the Reasons for the Decision it is held that "All three requests filed on 15 June 1989 must be rejected for the reasons stated in the communication of 21 July 1989. Reference was made to this communication in order to avoid repetition. For the same reasons, the submissions of the patent proprietor filed on 14 April 1988 and on 21 March 1989 have to remain in their entirety in the public part of the opposition file."

XIII. By letter dated 23 November 1989 the Appellants filed an appeal requesting the cancellation of the above decision

and furthermore containing the same requests as filed before the Opposition Division (letter of 14 June 1989) and the same reasons as given there (see point V above).

XIV. On 6 February 1990 the Board of Appeal issued an "Interim Decision". It was held therein that it was "not practical to decide this appeal immediately" because the "interests of the parties may be irreparably damaged and the purpose of the appeal frustrated" and that all documents in question would be placed in the non-public part of the file until a final decision had been reached and that each party would be at liberty to apply in writing at any time prior to final Decision or further order for this order to be varied or discharged". No such requests were made.

XV. The questions raised by the Board's communication of 24 August 1992 whether or not the alleged confidentiality agreement and court order were still in force were answered affirmatively by submission dated 3 November 1992 of the Appellants and by submission dated 23 November 1992 of the Respondents. The Respondents again declared their agreement to the requests of the Appellants.

XVI. As regards the pending requests of the Appellants reference is made to points IX and XIII above.

Reasons for the Decision

1. As to the admissibility of the appeal, the interim decision by the Board taken in its prior composition, dated 6 February 1990, already decided, by implication, that there was no objection in this respect.

2. The Appellants assert that the deposition of 23 April 1987 stemmed from infringement proceedings before a US District Court, that it was made by the inventor of a technical solution belonging to the state of the art, that it was a confidential document and that they filed certain pages of it in error, not being aware that they themselves had agreed not to file them elsewhere than in the US-infringement-proceedings according to a court order of 5 December 1986 and thus committed a breach of said agreement and court order.

It follows from this that the Appellants request the return of the deposition and the submissions relying on it because they do not want them to be considered by the Opposition Division or the Board of Appeal. The Appellants' requests (see point IX above) are therefore to be understood as follows:

- (i) (main request) not to consider and to return (a) the entire submission dated 14 April 1988 and (b) the enclosed pages (title page and pages 79/80 and 90/91) of the deposition dated 23 April 1987 and (c) part of the submission dated 21 March 1989 (pages 2 to 4);
- (ii) (first auxiliary request) not to consider and to return (a) the entire submission dated 14 April 1988 and (b) the enclosed pages as mentioned in the main request;
- (iii) (second auxiliary request) not to consider and to return the title page and pages 79/80 and 90/91 of the deposition dated 23 April 1987 filed with the submission dated 14 April 1988.

The Respondent concurred with these requests (see points VIII and XV above).

3. There is no doubt that the said deposition stems from infringement proceedings before a United States District Court (see also point 5 below) and that it was filed in the opposition proceedings as evidence. It is in principle admissible under the EPC to consider evidence obtained by a foreign court because the list of means of evidence enumerated in Article 117(1) EPC is non-exhaustive and because the principle of free evaluation of evidence applies (T 482/89, point 2.1, OJ EPO 1992, 646).

4. If the said deposition is found to correspond to a document according to Article 117(1)(c) EPC it follows from the above that it constitutes evidence which is in principle admissible. The Appellants' requests however raise the question whether such a document may be left unconsidered and returned to the Appellant.
 - 4.1. It is the Articles of the European Patent Convention and the Rules of the Implementing Regulations to the Convention which govern the proceedings before the EPO including the control over evidence and deciding whether any evidence may be left unconsidered and thus returned.

 - 4.2. The main purpose of making up the file of the opposition proceedings is to collect the necessary and useful material for taking a decision in these proceedings. It is for this purpose that the Opposition Division examines the file of its own motion, not being restricted to the facts, evidence and arguments provided by the parties (Article 114(1) EPC). Moreover, it is in the Opposition Division's jurisdiction to freely examine evidence produced by the parties under Article 117(1)(c) EPC (see: T 382/87, OJ EPO 1990, 213) or to invite parties to file new or other evidence.

Parties on the other hand are free to file requests and submissions and to withdraw them depending on their own interests, sometimes with the consequence of a loss of rights and with the exception according to Article 94 EPC, which excludes the withdrawal of the request for examination. They are normally even free to withdraw, i.e. abandon, a patent by requesting its revocation (see: Legal Advice No. 11/82, OJ EPO 1982, 57 and T 677/90 of 17 May 1991).

However the present proceedings are not only governed by the parties' interests but also by the interests of the public (see Article 114(1) EPC, and also: G 10/91 to be published; T 156/84, OJ EPO 1988, 372; T 789/89, to be published, point 2.2).

- 4.3. It follows from the above that evidence which has been filed with the Opposition Division ought normally to be considered by the Opposition Division and thus belongs to the file in view of its potential relevance. Normally, it is not returned to the filing party either before a final decision is taken or for at least five years thereafter (Rule 95(a)(1) EPC).

In view of the Board, it follows further from the above that evidence may exceptionally remain unconsidered and be returned if the interests of the filing party in having them returned unconsidered clearly prevail over the public interest.

- 4.4. The same applies also to submissions referring to such documents of evidence.
- 4.5. The finding in point 4.3 above applies equally if the said deposition were to be considered as corresponding to a statement of a witness according to

Article 117(1)(d) EPC or to a sworn statement in writing according to Article 117(1)(g) EPC.

5. In the light of the concurring requests and comments of both the Appellants and the Respondents there is no doubt that the parties involved in the present proceedings had concluded a **confidentiality agreement** with regard to the deposition in question. This happened in the course of their infringement case conducted under US-Law before a United States District Court. It was enacted in a still valid "Protective Order Regarding Confidential Information" of 5 December 1986 by the said court (see: Introduction, third sentence). This order was based *inter alia* on the following facts (see preamble): ... that "each party believes that certain answers to interrogatories ... contain technical and/or business secrets within the meaning of Rule 26(c) of the Federal Rules of Civil Procedure", - that the parties "have agreed to the terms for such order as set forth below, and have requested the Court's approval thereof".
6. In view of both parties' concurring statements and requests (see point XV above) the Board considers that the Appellants committed a breach of the said confidentiality agreement, and also of the said court order and the Board accepts that they had filed it in error. Therefore the Board finds that the use of the mentioned documents as evidence in the present proceedings could harm the Appellants' and the Respondents' and also third parties' (the deponent's) substantive rights and interests.
7. The deposition in question is a third party statement about written state of the art. It was made on 23 April 1987. This was after the priority date of the application (19 November 1979) and after the application date of the patent in suit (18 November 1980). It cannot

therefore belong itself to the state of the art concerning the patent in suit in any case.

Furthermore the submissions referring to the said deposition and the deposition itself were filed by the patentees in defence to the opposition. If the patentee chooses not to pursue a point of defence, the public interest is, in principle, not at stake because in the proceedings before the EPO the public interest is mainly directed at avoiding unlawful monopoly rights.

8. In view of the above, the parties' concurring requests and the parties' interest in having said documents unconsidered and thus removed from the file clearly prevail over the public interest in the present case and therefore the deposition in question and the submissions insofar as they refer to it may be left unconsidered and thus returned to the Appellants.
9. It may therefore be left open whether the filed documents could be held incomplete and unsuitable as evidence in the present case from the outset because the Appellants had filed only unrelated parts of said deposition namely the title page, pages 79/80 and 90/91 without any specific reference.
10. The conclusion reached here essentially corresponds to earlier decisions of the Board referring to the returning of documents. In T 811/90, points 5 to 7 (to be published), the Board returned requests and submissions (an amended claim and an amended description and the submission referring to that) of a party having erroneously filed them and requesting they be considered withdrawn. The error was caused by a procedural violation of the Opposition Division. As the documents in question were considered not to belong to the documents falling under Rule 93(a) to (d) EPC, they

could not be put into the non-public part of the file and so the Board returned them. In T 516/89 of 19 December 1990 a Board returned documents without "taking notice", i.e. without considering them. The documents were filed with the mark "confidential" together with a request to put them into the non-public part of the file. They were returned because they could not be put into the part of the file not open to public inspection according to Rule 93 EPC. The present case is different from the cited case T 811/90 insofar as it deals with evidence and as the erroneous filing was not caused by a procedural violation of the Opposition Division. It is different from the case T 516/89 insofar as the request to return documents was filed in the present case more than one month after the documents were received. In both prior cases the Board relied primarily on the requests of the parties and furthermore on the question whether documents could be kept in the non-public part of the file according to Rule 93(a) to (d). Although in view of the above the question here is whether documents may be left unconsidered and removed from the file at all and not whether they belong to the non-public part of the file, it may nevertheless be added that they could not be put into that part of the file in any case because they do not fall either under Rule 93(a) to (d) EPC or the decision of the President of the EPO dated 16 September 1985 (OJ EPC 1985, 316).

11. The Board wishes to underline in the present context that the submission dated 14 April 1988, its annex (the five pages of the said deposition) and pages 2 to 4 of the submission dated 21 March 1989 were but briefly open to public inspection, namely between the dates of filing of 19 April 1988 and 25 March 1989 respectively and the date of filing of the requests to return them of 25 May 1988 and 15 June 1989 respectively and that the file

contains no indication that a third party has inspected them (see also points VII and XIV above).

The Board furthermore wishes to add that evidence may cease to be available in certain cases. The Board is aware that thus for example Opposition Divisions do not necessarily keep samples or models in the file even if they are declared as an item of inspection. Finally the file itself may be destroyed after a certain time (see: Rule 95a(1) EPC). The consequences of such temporary or limited availability have to be considered in each case according to its own merit and circumstances. Whilst there is in principle a public interest to retain documents which were once on file there cannot be a bar to returning the same in the stated special circumstances.

12. In view of all this the main request of the Appellant is to be granted. The five pages (title page, and pages 79, 80, 90 and 91) of the deposition in question and the submissions of the Appellants (Patentee) dated 14 April 1988 and 21 March 1989 are thus to be returned in their entirety. The Appellants (Patentee) are to be given a short period of time in which to amend them, but only with regard to the passages that refer to the said deposition. They are then to refile the submissions with the otherwise unamended text, with short but precise references to the places where text passages have been deleted and with a remark on the title pages mentioning the first and the second filing date.

Order:

For these reasons, it is decided that :

1. The contested decision is set aside.

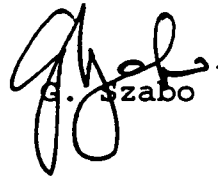
2. The case is remitted to the Opposition Division for further prosecution on the basis of the file which does not contain the deposition dated 23 April 1987 and the submissions referring to it which are to be removed and returned in the manner set out in point 12 above.

The Registrar:



S. Fabiani

The Chairman:



G. Szabo