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File No.: T 0765/89 - 3.2.1
Application No.: 80 902 295.7
Publication No.: 0 041 512
Classification: B65D 6/30, B65D 25/14, B21D 51/26
Title of invention: Containers

D E C I S I O N
of 8 July 1993

Applicant:

Proprietor of the patent: CMB Foodcan PLC

Opponent: I) Schmalbach-Lubeca AG
II) Rasselstein AG

Headword:

EPC: Art. 104(1); R. 63(1)

Keyword: "Apportionment of costs after withdrawal of the appeal
(refused)"

Headnote
Catchwords



Case Number: T 0765/89 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 8 July 1993

Appellant: CMB Foodcan PLC
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Perry Wood Walk
Worcester WR5 1EQ (GB)

Representative: Griffin, Kenneth David, et al
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Respondent I: Schmalbach-Lubeca AG
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W - 3300 Braunschweig 1 (DE)

Representative: Fricke, Joachim, Dr.
Dr. R. Döring, Dr. J. Fricke, Patentanwälte
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Respondent II: Rasselstein AG
(Opponent II) Postfach 20 20
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Representative: Liebau, Gerhard, Dipl.-Ing.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office given on 13 September 1989
and posted in writing on 19 October 1989 revoking
European patent No. 0 041 512 pursuant to
Article 102(1) EPC.

Composition of the Board:

Chairman: F. Gumbel
Members: W. Moser
S. Crane

Summary of Facts and Submissions

- I. The mention of the grant of the European patent No. 0 041 512 was published in the European Patent Bulletin on 8 May 1985.
- II. Notices of opposition have been filed by the Respondents (Opponents) on 21 January 1986 and 4 February 1986, respectively.
- III. In a decision given at the oral proceedings of 13 September 1989 and posted in writing on 19 October 1989, the Opposition Division revoked the European patent.
- IV. The Appellants (Patent Proprietors) lodged a Notice of Appeal against the decision of the Opposition Division on 11 December 1989 and paid the appropriate fee at the same time. The Statement of the Grounds of Appeal was filed on 12 February 1990. The Appellants requested the maintenance of the patent in suit on the basis of new claims enclosed in their Statement of the Grounds of Appeal.

On the other hand, both Respondents requested that the appeal be dismissed.

- V. In its communication dated 7 January 1991, the Board made some preliminary observations in preparation for the oral proceedings.

In answer to it, the Appellants filed new patent documents on 16 July 1991.

- VI. Oral proceedings were to be held on 14 August 1991.

However, on 12 August 1991, the Appellants informed the Board of their withdrawal of the appeal. As a result, the oral proceedings were cancelled and the Respondents notified accordingly by telefax on 13 August 1991.

According to the Appellants, the appeal was withdrawn in view of a citation made against the corresponding Japanese patent application. Since the Appellants had obtained a full translation of this citation only on the afternoon of Friday, 9 August 1991, they had been unable to make a decision to withdraw the appeal any earlier than on 12 August 1991.

VII. Both Respondents requested that the costs for their preparations made in view of the oral proceedings be imposed on the Appellants. The reasons given in support of these requests can be summarised as follows:

- The extensive preparation for oral proceedings, due to the size of the file, the late filing by the Appellants of completely new documents as well as the importance of the patent in suit, had already been finished when the Respondents were informed of the withdrawal of the appeal.
- The costs accruing from this extensive preparation could have been avoided if the withdrawal of the appeal had taken place well before the date oral proceedings were to be held.
- The document (citation) giving rise to the withdrawal of the appeal had been known by the Appellants a long time before the date oral proceedings were to be held.

Both Respondents asked the Appellants to submit an English translation of said document.

VIII. In letters dated 22 October and 4 November 1991, the Appellants argued as follows:

- The appeal had been withdrawn in view of the disclosure in JP-A-52-54588. The relevance of this citation had not been appreciated until 9 August 1991 for the reasons indicated hereinafter:

- JP-A-52-54588 had been cited in a final rejection on the corresponding Japanese patent application. The final rejection had been reported to the Appellants by their Japanese associates in a letter dated 1 March 1991. On the basis of the information given by the Japanese associates, a partial translation of JP-A-52-54588 (Section F) had been procured by the Appellants. In this partial translation, it had been stated that the end members were **bonded** to the can bodies, whereas Claim 1 of the patent in suit specifically stated that the can end was double seamed to the can body **without bonding**. In view of the reference to bonding in the partial translation, the Appellants had thus come to the conclusion in March 1991 that this citation did not anticipate their invention.

- The Appellants had subsequently filed an appeal against the final rejection of the Japanese patent application. On studying the instructions given in this context by the Appellants, the Japanese associates had felt that JP-A-52-54588 was more relevant than suggested by the Appellants. Consequently, in a letter dated 23 July 1991, they had asked the Appellants for further clarification. However, as there had been no immediate urgency to file the appeal brief on the Japanese patent application, it had been decided that a detailed study

of the Japanese associates' letter could wait until the return from holiday of the Appellants' representative on 6 August 1991.

- After the Appellants had realised that JP-A-52-54588 might be of greater relevance than originally appreciated and that it might also be relevant to the oral proceedings then scheduled for 14 August 1991, they had immediately procured a full translation of this citation as a matter of urgency. The Appellants had received the full translation on 9 August 1991.

- In the full translation at lines 6 to 14 on page 6, it had been stated that a double seam could be formed without solder, rubber or adhesives and by relying on pressure bonding to obtain a seal. However, this passage had not been included in the above-mentioned partial translation.

As regards the alleged late filing of completely new documents rendering the preparation for oral proceedings more extensive for the Respondents, the Appellants pointed out that these documents had been received by the EPO on 16 July 1991, i.e. about one month before the scheduled oral proceedings, and that in the Board's communication dated 7 January 1991 it had been stated that further observations or amendments could be filed at any time up to two weeks before the date scheduled for oral proceedings.

IX. The Respondents made no further comments on these arguments and on the text of the full English translation of JP-A-52-54588.

Reasons for the Decision

1. As a consequence of the withdrawal of the appeal by the Appellants, the appeal procedure is terminated as far as it is concerned with the decision on the merits of the Opposition Division (cf. decision of the Enlarged Board of Appeal G 8/91 "Rücknahme der Beschwerde/BELL" of 5 November 1992, OJ EPO 1993, 346). However, in the exercise of its inherent original jurisdiction to consider requests made to it in matters arising out of or in connection with the former appeal procedure, the Board still has to decide on the Respondents' requests to impose on the Appellants the costs for the preparations made in view of oral proceedings.
2. By reason of Rule 66(1) EPC, the provisions of Article 104(1) EPC and Rule 63(1) EPC are applicable to appeal proceedings *mutatis mutandis*.
3. In principle, each party to the appeal procedure shall bear his own costs. However, according to Article 104(1) EPC in conjunction with Rule 66(1) EPC, a Board, for reasons of equity, may order a different apportionment of costs incurred *inter alia* in oral proceedings. This applies in cases where such costs arise in whole or in part as a result of the conduct of one party which is not in keeping with the care required to assure the effective exercise of the rights involved or which stems from culpable actions of an irresponsible or even malicious nature (cf. Singer, "Europäisches Patentübereinkommen", Carl Heymanns Verlag KG, Köln, Berlin, Bonn, München, 1989, Article 104, No. 6).
4. In the present case, this consideration does not apply for the following reasons:

As pointed out correctly by the Appellants, the new patent documents filed in answer to the Board's communication dated 7 January 1991 have been received by the EPO within the time limit set by the Board. Consequently, no late filing occurred in the present case as alleged by the Respondents.

Furthermore, the fact that the Appellants filed new patent documents in answer to the Board's communication is clearly in keeping with the principle that responsibility must be exercised in the defence of rights, since these documents were submitted in order to overcome some objections formulated in said communication.

The Board agrees with the Appellants that the partial translation of JP-A-52-54588 does not anticipate their invention. Since this document had originally not been cited in the present appeal procedure, there was no reason why the Appellants should have procured a full translation thereof before having been informed by their Japanese associates of its probable relevance in the appeal procedure in Japan concerning the corresponding Japanese patent application. Contrary to the opinion expressed by the Respondents, the Board therefore takes the view that the whole content of this document had been known to the Appellants only shortly before the date oral proceedings were to be held and that, moreover, no criticism of the Appellants can be made in this respect.

5. From the preceding remarks it follows that the Respondents' requests that the costs incurred in preparation for the oral proceedings be awarded against the Appellants have therefore to be refused.

Order

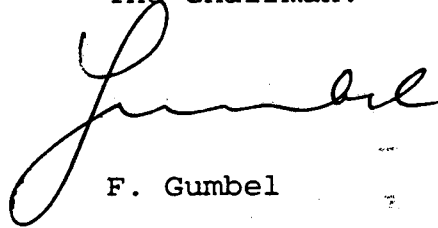
For these reasons, it is decided that:

The requests for the refund of costs are refused.

The Registrar:


S. Fabiani

The Chairman:


F. Gumbel