

Publication in the Official Journal Yes / No

File Number: T 611/90 - 3.3.3 ~~611/90~~  
Application No.: 83 306 484.3  
Publication No.: 0 109 779  
Title of invention: Ethylene copolymer

Classification: C08F 210/16

D E C I S I O N  
of 21 February 1991

Applicant:

Proprietor of the patent: Mitsui Petrochemical Industries, Ltd.

Opponent: DSM Research B.V.

Headword: Fresh Case/MITSUI

EPC Art. 104, 106(1), 108, 114

Keyword: "Admissibility of appeal (affirmed) - reasons unconnected with those of appealed decision, but still within same opposition ground"  
"Remittal to first instance (affirmed) - entirely new case not yet examined before"  
"Apportionment of costs - absence of reasons for his tardiness given by the Opponent"

Headnote

I. Under Article 106(1) EPC, appeals lie from decisions rather than from the grounds of such decisions. Apart from other deficiencies, an appeal raising a case entirely different from that on which the decision under appeal was based is still admissible if it is based on the same opposition ground (point 2 of the Reasons).

II. If there is such an entirely different case, it may, subject to the other circumstances of the case, be inappropriate for an Appeal Board to deal itself with its allowability. The public's and the parties' interest in having the proceedings speedily concluded may then be overridden by the requirement that appeal proceedings should not become a mere continuation of first-instance proceedings (point 3 of the Reasons).

III. In the absence of strong mitigating circumstances for the late filing of such a fresh case, the late-filing party should bear all the additional costs incurred by his tardiness (point 5 of the Reasons).

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Case Number : T 611/90 - 3.3.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 21 February 1991

**Appellant :**  
(Opponent)

DSM Research B.V.  
NL-6160 MA Geleen

**Representative :**

Hoogstraten, Willem Cornelis Roeland  
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**Respondent :**  
(Proprietor of the patent)

Mitsui Petrochemical Industries Ltd.  
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**Representative :**

Myerscough, Philip Boyd  
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**Decision under appeal :**

Decision of Opposition Division of the European  
Patent Office dated 29 May 1990 rejecting the  
opposition filed against European patent  
No. 0 109 779 pursuant to Article 102(2) EPC.

**Composition of the Board :**

**Chairman :** F. Antony  
**Members :** J. Stephens-Ofner  
H. Fessel

## Summary of Facts and Submissions

- I. European patent application No. 83 306 484.3 was filed on 25 October 1983. European patent thereon was granted on 17 December 1986 under No. 109 779.

Opposition against the above patent was filed on 17 September 1987 by DSM, requesting the revocation of the patent on the grounds of lack of novelty and of inventive step, having regard to various prior publications.

- II. By a decision dated 29 May 1990, the Opposition Division held the patent to be both novel and inventive, and therefore rejected the opposition. In the Reasons for its Decision, the Opposition Division relied solely upon the above prior publications in deciding the issues of novelty and obviousness.
- III. The Opponent appealed against the above decision by a notice of appeal filed on 27 July 1990, supported by a statement of grounds of appeal filed on 8 October 1990.
- IV. The statement of grounds, in addition to requesting the cancellation of the decision of the Opposition Division, states as follows: "...In the opposition proceedings it has frequently been stated that the presently (sic) copolymer is not novel, which arguments the Opposition Division has failed to appreciate. Fortunately, Opponent was able to recover a bag of polyethylene produced in 1982...". The statement of grounds then goes on to develop what is in effect an entirely fresh case on lack of novelty, namely, one based on prior public use as opposed to prior publication, this being the sole basis upon which the first instance's decision was arrived at. The statement of grounds of appeal does not give any reasons for this belated change of tactics but, as the above-

quoted passage shows, merely states that the Opponent was "fortunately" able to recover material which he alleges constitutes a prior public use of the patent in suit.

Oral proceedings have not been requested.

#### Reasons for the Decision

1. The first issue that falls to be decided is the admissibility of the appeal. The notice of appeal does meet the requirements of Article 106 and Rule 64 EPC, whilst the statement of grounds of appeal satisfies the requirements set out in Rule 55(c) EPC, which, by virtue of Rule 66(1) EPC, governs the content of formal pleadings in appeal proceedings. Since all other formal procedural requirements, namely those relating to time limits, have been met, the question of the admissibility of the appeal hinges solely on whether or not a statement of ground of appeal that raises a case entirely different from that on which the first instance's decision was based, can be legitimately regarded as a ground of appeal from that decision.
  
2. Under Article 106(1) EPC appeals lie from decisions of, inter alia, the Opposition Division, rather than from the grounds of such decisions. The usual manner of challenging decisions of the first instance is to take issue with the grounds upon which they are based, normally by giving legal and/or factual reasons seeking to demonstrate the unsoundness or invalidity of those grounds and, consequently of the decision to which they gave rise. Legal and factual reasons wholly unconnected with those grounds may be brought forward by Appellants, but such a course of action is clearly tantamount to presenting a fresh case to the Boards of Appeal, thereby inviting them

to adjudicate upon a new opposition, and thus stand in the shoes of the first instance. In the present circumstances, the fresh reasons presented, though unconnected with those in the decision under appeal, are still within the same opposition ground, viz. Article 100(a) EPC. The Board, therefore, considers the appeal admissible, but deems it necessary to investigate the appropriateness of dealing itself with the fresh case presented to it.

3. It is quite clear from Article 21(1) EPC that the function of the Boards of Appeal is to examine appeals rather than to conduct rehearings; cf. decision T 26/88 of 7 July 1989 (to be published), para. 12 of the Reasons of which state as follows: "In the Board's view, within the scheme provided by the 'Appeals Procedure' set out in part VI of the EPC, the essential function of an appeal is to consider whether the decision which has been issued by a first instance department is correct on its merits - see in particular Article 106(1) EPC. It is not normally the function of a Board of Appeal...to examine and decide upon issues in the case which have been raised for the first time during appeal proceedings." Thus, the judicial process of deciding the allowability of an appeal in effect constitutes a judgment on the decision given by the first instance. The Boards do, of course, possess additional powers by virtue of Article 114(1) EPC, but in using these powers they need to exercise their judicial discretion, conferred upon them by Article 114(2) EPC, to disregard matter, e.g. facts and evidence, submitted for the first time in the appeal proceedings. They also have the power (under Article 111(1) EPC) to remit the case to the first instance for further prosecution. In exercising their discretionary powers the Boards need to take into account the public's as well as the parties' common interest that opposition proceedings should be speedily concluded, an interest that clearly encompasses appeal

proceedings as well. This interest is best served if the Patentee is made aware as soon as possible of the full and complete case that he needs to meet in order to keep his patent in force. All these matters should by now be well understood by practitioners before the EPO, for they have been clearly set out in the note on "Opposition Procedure in the EPO" (OJ EPO 1989, 417), and furthermore, they have been consistently applied by the Boards of Appeal; cf. Decisions T 326/87 of 28 August 1990, "Polyamide compositions/DU PONT" (to be published), T 173/89 (unpublished), T 117/86 "Costs/FILMTEC" (OJ EPO 1989, 401) and T 182/89 (to be published).

Late-filed evidence, documents and other matter can be rejected by the Boards of Appeal on the ground of their irrelevance, that is to say on the basis that they are no more "weighty" or cogent than matter which is already in the case. Late-filed material may, however, be admitted into the case (normally subject to an award of costs against the late-submitting party, see Article 104 and Rule 63(1) EPC), particularly if the material is such as to change the centre of gravity of the case presented on appeal compared with that of the one decided by the first instance. In such an event the case presented on appeal should, if fairness to the parties so demands, be remitted to the first instance pursuant to Article 111(1) EPC. It is self-evident that the filing, on appeal, of a new ground of opposition or one based on a fresh category of evidence, not only changes the centre of gravity of the case formally decided by the first instance but, by definition, constitutes a fresh case.

4. It follows that, whilst the appeal in the present case is formally admissible, the statement of grounds of appeal, though still directed at lack of novelty, raises a fresh case (prior public use). In the exercise of its

discretion, and pursuant to Article 111(1) EPC, the Board therefore remits the case to the Opposition Division for its decision on the new case raised by the Appellant. In order to reduce the delay which such course of action is bound to give rise to, the Board has decided to deal with this case ahead of its normal turn, and invites the Opposition Division to do likewise.

5. Late filing of facts and evidence admitted under Art. 114(2) EPC normally leads to an apportionment of costs (Article 104 and Rule 63(1) EPC), and in the absence of strong mitigating circumstances for the late filing of facts, evidence or other matter, the late filing party should bear all the additional costs incurred by his tardiness (cf. T 326/87, loc.cit.). In the present case, no reason whatsoever has been given by the Opponent for his tardiness, and accordingly the Board decides that he should bear all the costs that will be incurred by the Patentees having to deal with the fresh case of prior public use.

#### Order


For the above reasons it is decided that:

1. The appeal is admissible.
2. The Opposition Division's decision is set aside.
3. The case is remitted to the Opposition Division for further prosecution.



4. The costs in the future proceedings before the Opposition Division, and in any subsequent appeal, shall be apportioned so that the Opponent shall pay to the Patentee the whole of the costs which will be legitimately incurred by the Patentee in dealing with the case as remitted as above.

The Registrar:



E. Gorgmayer

The Chairman:



F. Antony