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D E C I S I O N
of 30 November 1993

Case Number: T 0832/90 - 3.3.3

Application Number: 84110107.4

Publication Number: 0143194

IPC: C08L 27/06

Language of the proceedings: EN

Title of invention:

Graft copolymers of alkyl methacrylates - alkyl acrylates onto diene-alkyl acrylate copolymers and their use as impact modifiers

Patentee:

Société Nationale Elf Aquitaine, et al

Opponent:

BASF Aktiengesellschaft

Headword:

-

Relevant legal norms:

EPC Art. 54(1), (2), 56, 111(1)

Keyword:

"New document in appeal"
"Fresh case"
"Remittal"

Decisions cited:

T 0117/86, T0326/87, T0611/90, T0110/91

Catchword:

-



Case Number: T 0832/90 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 30 November 1993

Appellant:
(Opponent) BASF Aktiengesellschaft
-Patentabteilung - C6-
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Representative: -

Respondent:
(Proprietor of the patent) Société Nationale Elf Aquitaine
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Representative: Boillot, Marc
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 5 September 1990
rejecting the opposition filed against European
patent No. 0 143 194 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: F. Antony
Members: R. Young
M.K.S. Aúz Castro

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 143 194 in respect of European patent application No. 84 110 107.4, filed on 24 August 1984 and claiming a priority of 31 August 1983 (FR 8313997) was announced on 10 August 1988 (cf. Bulletin 88/32).

II. Notice of Opposition was filed on 8 May 1989 on the ground of Article 100(a) EPC. The opposition was supported *inter alia* by the documents:

(1): DE-A-1 964 156 and

(2): DE-C-2 815 201.

III. By a decision which was issued on 5 September 1990 the Opposition Division rejected the opposition.

According to the decision, none of the citations disclosed all the specific components of the synthetic resin compositions according to Claim 1, or the method for improving the impact resistance of thermoplastic resins according to Claim 18 or of the graft copolymer according to Claim 30 of the patent in suit.

Furthermore, the argumentation brought could not serve as a substantiated objection which convincingly showed that the skilled worker would have been led to consider the subject-matter of the disputed patent as obvious.

IV. On 26 October 1990 a Notice of Appeal against the above decision was filed, together with payment of the prescribed fee.

In the Grounds of Appeal filed on 22 December 1990, the Appellant (Opponent) cited for the first time the document:

(7): JP-A-155009/80, published on 3 December 1980, together with a full translation into German, as well as a brief abstract in English,

and argued essentially as follows:

(i) The disclosure of (7) was novelty destroying for Claim 1 of the disputed patent;

(ii) Documents (1) and (2) previously cited in the opposition proceedings were also novelty destroying for the subject-matter claimed in the patent in suit.

V. The Respondent (Patentee) filed new, more restricted claims on 5 May 1991.

VI. On 7 May 1993, the Board issued a communication in which it indicated *inter alia* that document (7) would be admitted to the proceedings on account of its relevance and the appeal probably remitted to the first instance with costs awarded to the Respondent.

VII. In a submission filed on 25 May 1993, the Appellant argued, on the question of costs, (i) that it was only following the decision of the Opposition Division in September 1990 that it had been found necessary to carry out a further search, requiring about two months, as well the time to obtain the original documents corresponding to the more immediately available Japanese Abstracts, and translate them, and (ii) that a preliminary communication would have clarified the situation earlier.

The submission also contained a number of arguments of lack of inventive step, but the allegation of lack of novelty in the light of (1) and (2) was no longer

pursued. On the other hand, a further document was cited for the first time.

- VIII. A further set of amended claims was filed by the Respondent with a letter dated 6 July 1993.
- IX. The Appellant requests as main request that the decision under appeal be set aside and the patent in suit revoked, and, as an auxiliary request, oral proceedings. He also requests that the case be remitted to the Opposition Division so as not to lose an instance, and that no award of costs be made against him.

The Respondent requests in effect maintenance of the patent on the basis of the set of claims filed with the letter dated 6 July 1993.

Reasons for the Decision

1. The appeal is admissible.
2. The evidential weight of document (7) was considered by the Board to be sufficiently great to merit its admission to the proceedings despite its lateness (cf. communication dated 7 May 1993).

Although the reasons presented in connection with this document (lack of novelty) are still within the same opposition ground, viz. Article 100(a) EPC, they are in substance unconnected with those in the decision under appeal, since they not only stem from a document not previously considered, but also relate essentially to a part of that document - a comparative example - which does not directly illustrate the general teaching of the document.

Since the advent of document (7), moreover, two successive sets of amended claims have been filed by the Respondent and the Appellant has apparently ceased to pursue the original line of argument (lack of novelty) based on the disclosures of documents (1) and (2). Thus the Board is effectively confronted with a fresh case to consider.

3. In such a situation it is the established jurisprudence that the case, together with the document admitted, should normally be referred back to the first instance so as to allow the case to be examined in the light of the new document at two levels of jurisdiction so as not to deprive the patent proprietor of one such level (cf. the decisions T 326/87, OJ EPO 1992, 522, and T 611/90, OJ EPO 1993, 050).

This has furthermore been requested by the Appellant, and the Respondent has indicated in his letter dated 6 July 1993 that he would have no objection to such remittal.

Thus, the Board will exercise its discretion under Article 111(1) EPC to this effect.

4. In addressing the remitted case, it will be necessary for the Opposition Division to consider not only the formal acceptability of the latest set of claims (whether, for instance, the values of the torque of the Brabender rheometer given in Claims 1, 17, 28, 29 and 37 filed with the letter dated 6 July 1993 are adequately supported by the passage of description relied upon, which refers only to the case of a thermoplastic copolymer comprising at least 80% by weight of polymerized vinyl chloride), and the substantive merits of the case in the light of the newly developed aspects,

but also any action to be taken as a consequence of the late filing of evidence (7).

The late filing of facts and evidence admitted under Article 114(2) EPC should normally lead 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. the decisions T 611/90, loc. cit., and T 110/91 of 24 April 1992, not published in OJ EPO).

5.

The carrying out of a further search by the Appellant in September 1990, i.e. not only after the end of the nine-month opposition period, but even after the decision to reject the opposition, is not regarded as compatible with the general aim of establishing "as rapidly as possible, in the interests of both the public and the parties to the proceedings, whether or not the patent may be maintained given the opponent's submissions", as stated in "Opposition Procedure in the EPO" (OJ EPO, 1989, 417), let alone with the more specific requirement as a general rule to set out the case against the patent in suit fully and completely in the Notice of Opposition in accordance with Article 99(1) and Rule 55(c) EPC (cf. T 117/86, OJ EPO 1989, 401; Reasons for the decision, paragraph 4). Thus the Appellant's belated further search is not regarded as a mitigating circumstance but amounts rather to an indication of earlier negligence.

5.1

The evidently over-optimistic assessment on the part of the Appellant of the outcome of the opposition proceedings furthermore cannot be regarded as justifying a failure to present the complete case against the patent until after an unfavourable decision had issued, much less as placing an obligation on the Opposition

5.2

Division to issue a communication beforehand, as apparently wished for by the Appellant (cf. letter dated 19 May 1993, page 8, last paragraph).

These matters should be taken into consideration by the Opposition Division in any decision apportioning costs.

6. Since no decision has been taken against the Appellant, however, the Board sees no reason to appoint oral proceedings.

Order

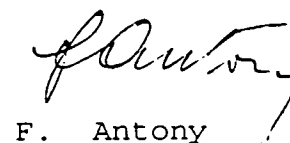
For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the basis of the set of claims filed with the letter dated 6 July 1993.

The Registrar:


E. Gorgmaier

The Chairman:


F. Antony