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D E C I S I O N
of 28 September 1994

Case Number: T 0621/91 - 3.2.3

Application Number: 84114244.1

Publication Number: 0144882

IPC: E05F 15/20, E05F 15/12

Language of the proceedings: EN

Title of invention:

Traffic responsive control system for automatic swinging door

Patentee:

THE STANLEY WORKS

Opponent:

BESAM AB/Jönsson, Bert Ove

Headword:

Inadmissible opposition/BESAM AB

Relevant legal provisions:

EPC Art. 99(1)

EPC R. 55(c), 56(1), 67

Keyword:

"Sufficiency of Notice of Opposition - no"

"Notice of Opposition - Admissibility - no"

Decisions cited:

T 0222/85, T 0161/82, T 0019/87

Catchword:

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Case Number: T 0621/91 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 28 September 1994

Appellant: BESAM AB/Jönsson, Bert Ove
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 11 June 1991
rejecting the Notice of Opposition filed against
European patent No. 0 144 882 as inadmissible on
the basis of Rule 56(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: J. B. F. Kollar
W. Moser
F. Brösamle
L. C. Mancini

Summary of Facts and Submissions

I. European patent No. 0 144 882 was granted on 20 July 1988 with 32 claims in response to the European patent application No. 84 114 244.1 filed on 26 November 1984 claiming the priorities of the earlier applications (US 555 565 and US 587 407) of 28 November 1983 and 8 March 1984, respectively. Claim 1 is worded as follows:

"1. Automatic door installation (8) having a swinging door (12), a power operator (14) for swinging the door (12) between a closed position thereof closing a doorway opening and an open position thereof on a swing side of the doorway opening, and a traffic responsive control system (10) comprising radiant energy emitter and receiver means (28-32, 70, 72, 74, 76, 80, 106, 108, 110, 114, 116) for sensing traffic along a traffic path of travel through the doorway opening, and door control means (20, 124, 126) operated by the traffic sensing means to automatically open the door for traffic to pass along said traffic path of travel through the doorway opening, characterized in that the traffic sensing means comprises at least one multiple emitter sensor (28 or 29) having a bank of a plurality of radiant energy emitters (34) for emitting radiant energy beams having axes angularly spaced along said traffic path of travel and collectively providing an effective emitted energy coverage area intersecting the said traffic path of travel and radiant energy receiver means (36) mounted adjacent the bank of emitters (34) for receiving reflected radiant energy emitted from the bank of emitters (34), the said one multiple emitter sensor (28 or 29) being a swing side sensor (28 or 29) mounted at one side of said traffic path of travel to provide a said effective coverage area which intersects said traffic path of travel on the swing side of the doorway

opening when the door (12) is in its said closed position, and wherein the traffic responsive control system (10) further comprises door position responsive means (84, 86, 94, 96, 98, 100, 102, 104, 105) for selectively operating the emitters (34) of the said swing side sensor (28 or 29) to vary its said effective coverage as the door is swung between its said closed and open positions."

II. The Appellant (Opponent) filed a Notice of Opposition to the European patent granted by way of two telefax messages on 19 and 20 April 1989, respectively, confirmed by a letter received on 24 April 1989 - a part of said submissions was filed in Swedish. A translation of these submissions into English, received 16 May 1989, sets out the following, under the heading "FACTS AND ARGUMENTS":

"1 (see for translation) discloses under "Function" an installation completely in agreement with the preamble of claim 1, page 9.

1(2) discloses, especially under "Function" and in Figs 1-3 an installation completely in agreement with the characterising clause of claim 1.

3A-3H clearly disclose especially the last feature "door position responsive means ... open positions" in claim 1.

4 describes a photoelectric installation for sensing obstacles in machines, automatically operated doors, self-propelled trucks and the like. This installation has at any rate the features in claim 1 recited from line 14 to line 19, ending in "emitters 34".

5 discloses an installation similar to the installation in 4, applied to a swinging door, see last paragraph in col. 4, which discloses the preamble of claim 1 and the features in claim 1 following upon the above-mentioned features and ending in "closed position" in line 22.

Claim 1 lacks novelty^t or, at any rate, inventive step over 1(2), 3A-3H and 6, respectively, at any rate inventive step over 4 or 5 and 3A-3H.

Claims 2-7, 10-14, 18, 25 lack novelty or, at any rate, inventive step over 1(2), 3A-3H and 6, respectively, at any rate inventive step over 4 or 5 and 3A-3H.

The other claims lack inventive step over 1(2)-6.

1-5 are so brief that the portions therein relevant to the claims of the patent can be readily located.

Against the claims relating to individual and sequential pulsation of transmitters is cited

7. US-3,746,863 - especially the Abstract."

On 24 April 1989 the afore-mentioned seven documents were transmitted together with confirmation of the telefax.

- III. On 1 June 1989, a communication under Rule 57(1) EPC (EPO Form 2317) was issued stating that a Notice of Opposition had been filed and inviting observations from the Respondent (Patentee) within a specified period.
- IV. The Respondent duly filed observations on the Notice of Opposition on 29 September 1989, in which he firstly challenged the admissibility of the opposition and requested its rejection under Rule 56 EPC, particularly

on the basis that the Notice of Opposition failed to satisfy the requirements of Rule 55(c) EPC in that it did not set forth "any facts why and in which manner the combination of groups of features known from certain citations shall be obvious".

- V. On 15 December 1989 the Opposition Division invited the parties to oral proceedings pursuant to Rule 71(1) EPC (EPO Form 2310). However, this invitation was followed by a brief communication (EPO Form 2937) issued on 15 March 1990 which informed the parties that the oral proceedings scheduled to take place on 27 March 1990 at 09.00 had been cancelled.
- VI. On 27 February 1990 and on 2 March 1990 the Appellant filed further facts, evidence and arguments.
- VII. On 15 March 1990 and 19 March 1990 the Respondent filed two submissions.
- VIII. A communication pursuant to Article 101(2) and Rule 58(1) to (4) EPC (EPO Form 2323) was issued on 5 October 1990 in which the Opposition Division, after having been enlarged by the addition of a legally qualified examiner, stated "that in considering whether a Notice of Opposition fulfils the requirements under Rule 55(c) EPC only those submissions filed before the end of the opposition period (here: 20 April 1989) can be taken into account". The Opposition Division further explained its opinion that because of "absence of any specific guidance as to which particular statements in the cited documents are alleged to form the basis for an argument of obviousness, the notice of opposition is insufficient at the level of facts and evidence" (cf. paragraph 6 of the communication) and expressed its view that the notice in question is insufficient in respect of arguments as well since it lacked any reasoning

indicating "why such numerous documents, which are different in nature and partly rather complex, should suggest any lack of inventive step" (cf. paragraph 7 of the communication). At the end of the communication the Opposition Division arrived at the conclusion that the Notice of Opposition was incurably deficient and inadmissible (Rule 56(1) EPC) and that a decision could be reached without oral proceedings, which in any event would have to be limited to the discussion of admissibility.

- IX. In his letter dated 7 December 1990 - received on 10 December 1990 - the Appellant stated *inter alia* that he could not understand why the Opposition Division considered the opposition to be inadmissible when by issuing EPO Form 2317 (issued on 1 June 1989) and EPO Form 2310 it had implied that the opposition was admissible. After an analysis and additional comments on the "FACTS AND ARGUMENTS" specified in Section II above the Appellant arrived at the conclusion that "it is quite clear that the opposition sets out the Opponents' case sufficiently to the Patentee and to the Opposition Division such that both parties know what the case is and such that the alleged grounds for revocation indeed enabled the parties to examine those grounds without recourse to independent enquirers." Furthermore, the Appellant informed the Opposition Division that "the Opponents do not wish to have any oral proceedings if these are directed, entirely or largely, to a discussion of the issue of admissibility of the Notice of Opposition".
- X. The Respondent submitted on 31 January 1991 a letter dated 30 January 1991.
- XI. In its decision dated 11 June 1991, the Opposition Division rejected the Notice of Opposition as

inadmissible in accordance with Rule 56(1) EPC on the ground that the Notice of Opposition did not comply with the provisions of Rule 55(c) EPC. In particular the Opposition Division considered that the Notice of Opposition did not meet the third provisions of Rule 55(c) EPC requiring that a Notice of Opposition shall contain an indication of the facts, evidence and arguments presented in support of the grounds on which the opposition is based.

The decision set out all the relevant parts of the Notice of Opposition as summarised in Section II above, and considered whether, in respect of grounds of opposition (lack of an inventive step - a ground which remained in the opposition after withdrawal of the petition based on Articles 52(1), 54 EPC in accordance with Section 2 of the Appellant's letter received on 2 March 1990) relied upon, the Notice of Opposition contained an adequate indication of facts, evidence and arguments as required by Rule 55(c) EPC. In relation to each feature of the claimed subject-matter as set out in the notice of opposition, the Opposition Division concluded that the indication of facts was inadequate to support the ground invoked.

The reason for the decision was therefore stated to be that "the Notice of Opposition does not sufficiently indicate the facts, evidence and arguments in support of the ground (lack of an inventive step) of opposition."

XII. The Appellant thereafter filed a Notice of Appeal on 12 August 1991 and paid the appeal fee on the same day. He filed a Statement of Grounds of Appeal on 15 October 1991.

The Respondent filed his submission in reply on 10 February 1992.

XIII. In the Statement of Grounds of Appeal the Appellant made essentially the following submissions:

- Once the opposition had been declared admissible by way of the official actions specified in Sections III and V above, there is no basis in the EPC to reverse such declaration and consider the opposition inadmissible.

- Contrary to the reasoning of the Opposition Division, the facts submitted at the time of filing the Notice of Opposition (in spite of alleged great number of complex documents and the non understanding of Swedish) enabled examination by the Respondent and the Opposition Division of the alleged grounds for revocation **without recourse to independent enquirers**, and therefore satisfied the requirements of Rule 55(c) EPC.

- The Opposition Division put forward arguments in the decision which have never been raised before and which the Appellant has never been given an opportunity to meet. Such arguments related to a comparison of the cited documents with each other (II. 6, 2nd paragraph of the decision) and to the statement that "the Opponent neither explained which subject-matter had been used and on which date that use had occurred, nor did he explain the circumstances relating to the use" (II. 6, 1st paragraph of the decision).

Such statements of the decision contravene Article 113(1) EPC and constitute a substantial procedural violation justifying the reimbursement of the appeal fee (Rule 67 EPC).

XIV. The Respondent argued substantially as follows:

- The Notice of Opposition and the documents submitted by the Appellant before the nine-month opposition period expired disclosed unsubstantiated assertions concerning availability to the public and relevance of these submissions to inventive step which assertions did not, as stated in the contested decision, allow the Respondent to understand the arguments of the opposition.

- The Notice of Appeal does not contain any arguments according to which the decision of the Opposition Division would appear unjustified. Particularly, no material nor formal errors can be seen in the contested decision which would justify the reimbursement of the appeal fee.

XV. In a communication annexed to a summons to oral proceedings, the Board expressed its provisional opinion that the Notice of Opposition did not comply with the requirements of Article 99(1) and Rule 55(c) EPC because of insufficiency of its disclosure at the expiry of the opposition period and that the alleged procedural violations during opposition proceedings, referred to by the Appellant in the Statement of Grounds of Appeal, did not seem to be substantial within the meaning of Rule 67 EPC.

In his response sent by telefax on 4 August 1994 the Appellant asked for the Board's preliminary opinion on the lack of novelty issue in connection with prior use and the relevant documents relied upon in the Notice of Opposition. In a communication issued 7 September 1994 the Board expressed its provisional opinion that the documents referred to in the Appellant's comments did

not meet the third requirement of Rule 55(c) EPC for the reasons already put forward in Section II. 6 of the impugned decision.

XVI. In the submissions sent by telefax on 19 and 26 September 1994, respectively, the Appellant claimed that a procedural violation had occurred during the opposition procedure since the Respondent's letters dated 12 March 1990, 15 March 1990 and 30 January 1991, respectively, were not sent to him and referred to his request based on Article 113(1) EPC. Furthermore, he informed the Board that he would not attend oral proceedings.

XVII. Oral proceedings were duly held on 28 September 1994.

The Appellant did not attend the oral proceedings, but requested that the decision under appeal be set aside and

1. that the opposition be deemed admissible on the grounds stated in the Notice of Opposition,
2. that the writs and Exhibits 8 to 22 filed on 27 February 1990 and 27 December 1990 be deemed to be relevant facts and evidence and admissible to the opposition proceedings,
3. that the case be remitted to the Opposition Division for examination as to the substantive merits of the Opposition,
4. that the appeal fee be deemed reimbursable on the grounds stated in paragraphs IV. 4, 6, 9, 11, 12 and 13 of the Appellant's letter dated 11 October 1991, separately, and

5. that oral proceedings be appointed in the event that the opposition is not to be deemed admissible as requested on the written submissions.

The Respondent requested that the appeal be dismissed and the patent be maintained as granted.

Reasons for the Decision

1. The appeal is admissible.
2. The Opposition Division had power to decide that the Notice of Opposition was inadmissible because it did not meet the requirements of Rule 55(c) EPC, irrespective of the fact that the official actions issued on 1 June 1989, 15 December 1989 and 5 October 1990 (cf. paragraphs III, V and VIII supra) in accordance with the provisions of Rules 57(1), 71(1) and 58(1) to (4) EPC, respectively, were taken by the Opposition Division before issuing the decision under appeal. Indeed, a communication related to any of the above-mentioned official actions is not a decision (Article 106(1) EPC) of the Opposition Division, and the sending of such a communication to the parties does not prevent the subsequent rejection of the Notice of Opposition as inadmissible under Rule 56(1) EPC, for example if the admissibility is challenged by the Proprietor of the patent in such proceedings (cf. T 222/85 (OJ EPO 1988, 128)). The latter clearly applies in the present case because the Respondent, in his observations filed on 29 September 1989, did explicitly challenge the admissibility of the Notice of Opposition.

The Appellant's submission that, after said official actions had been issued, there was no legal basis in the Convention to consider the Notice of Opposition inadmissible is therefore not correct.

3. The second question to be decided is whether, having regard to the contents of the Notice of Opposition filed by telefaxes on 19 and 20 April 1989, respectively, the Opposition Division correctly rejected it as inadmissible in its decision dated 11 June 1991.

- 3.1 As regards the contents of the Notice of Opposition, the requirements of the EPC are as follows:

Article 99(1) EPC: "Notice of Opposition shall be filed in a written reasoned statement".

Under Rule 55(c) EPC, the Notice of Opposition shall contain:

- (i) a statement of the extent to which the European patent is opposed;
- (ii) and of the grounds on which the opposition is based;
- (iii) as well as indication of the facts, evidence and arguments presented in support of these grounds.

Article 99(1) EPC: The notice must be filed within "nine months from the publication of the mention of grant of the European patent". Thus, within the nine month period, the contents of this notice must be such as to satisfy Rule 55(c) EPC. This is further made clear by Rule 56(1) EPC, which inter alia requires that a Notice

of Opposition be rejected as inadmissible where deficiencies existing in respect of Rule 55(c) EPC are not remedied within said nine month period.

3.2 Rule 57(1) EPC requires that the Patentee be invited "to file his observations and to file amendments, where appropriate", in response to the communication of the Notice of Opposition. It ensues that the purpose of requirement (iii) of Rule 55(c) EPC (in combination with requirements (i) and (ii)) is to ensure that the Notice of Opposition sets out the Opponent's case sufficiently so that both the Patentee and the Opposition Division know what that case is.

3.3 It is important that, whereas the requirements of Rule 55(1)(a) and (b) EPC and the requirements (i) and (ii) of Rule 55(c) EPC can be considered as formal in nature, requirement (iii) of Rule 55(c) EPC, in combination with Article 99(1) EPC, is substantive in nature, and calls for reasoning which goes to the merits of the Opponent's case. A well-drafted Notice of Opposition should thus contain reasoning that is full but concise. And in general the less reasoning that a Notice of Opposition contains, the greater the risk that it will be rejected as inadmissible.

4. The question whether a particular Notice of Opposition meets the minimum substantive requirements of Article 99(1) and Rule 55(c) EPC can only be decided in the context of that particular case (since various relevant factors, such as the complexity of the issues raised, vary from case to case).

4.1 When in relation to the grounds of lack of novelty or obviousness, prior published documents are relied upon, then, depending upon the circumstances of each individual case, requirement (iii) of Rule 55(c) will

only be satisfied if there is **sufficient** indication of the **relevant** "facts, evidence and arguments" (i.e. relevant to the extent of the patent which is opposed), for the reasoning and merits of the Opponent's case in relation to the grounds of opposition relied upon to be properly understood by the Opposition Division and the Patentee. This must be assessed on an objective basis, from the point of view of a person reasonably skilled in the art to which the opposed patent relates.

4.2 The sufficiency of the Notice of Opposition in this respect must be distinguished from the strength of the Opponent's case. On the one hand, an unconvincing ground of opposition might have been clearly presented and argued. Conversely, a deficient submission may be rejected as inadmissible even though if properly drafted it would have succeeded. The desirability that European patents are granted for patentable inventions only must in this context be balanced against the desirability of an efficient procedure in opposition proceedings, and in appropriate cases the consequences of non-compliance with the requirements of Article 99(1) EPC and Rule 55(c) EPC must be enforced.

5. In the absence of any specific guidance in the present case as to what particular statements in the cited documents are alleged to destroy the novelty of the claimed invention or to form the basis for an argument on obviousness, the Opposition Division and the Respondent are at a loss as to where to start with their examination of the Appellant's allegations in respect of the features set out in Claim 1. In the Board's judgment, the Notice of Opposition is therefore insufficient at the level of facts and evidence in this respect. What the Appellant did was no more than to invite the Opposition Division to carry out further searches in these documents **ex officio**, in the hope that

it would formulate some arguments of its own accord on the basis of its findings. This task, however, was that of the Appellant within the available nine month period for filing the Notice of Opposition. Opposition must be filed and pursued in good faith so as to avoid procrastination and uncertainty.

6. In the Board's view, the decision of the Opposition Division was correct. Without facts and proper evidence, the allegations have no real basis and are only speculations. In addition, there is no reasoning in the Notice of Opposition to indicate **why** such numerous documents, including those submitted with letters dated 25 February 1990 and 7 December 1990, which may or may not between them contain all the relevant features of the claims, should support any lack of inventive step, let alone lack of novelty.
7. After all, inventions are usually combinations of known features or components. Any suggestion that the mere presence of some or all of these features in various different documents should, in the absence of reasoning, mean anything at all in relation to the invalidity of the patent, is contrary to the principles of patent law and practice. The Board therefore considers that the Notice of Opposition is insufficient in respect of arguments as well.
8. In view of the above, in the Board's judgment the Notice of Opposition was incurably deficient and the decision of the Opposition Division in rejecting the opposition as inadmissible must therefore be confirmed.
9. The decision under appeal is not based on grounds and evidence which are solely disclosed in the Respondent's letters dated 12 March 1990, 15 March 1990 and 30 January 1991, respectively. The fact that these

letters were not transmitted to the Appellant does therefore not constitute a substantial procedural violation within the meaning of Rule 67 EPC justifying the reimbursement of the appeal fee. Neither do the other facts submitted by the Appellant in his letter dated 11 October 1991 under paragraphs IV. 4, 6, 9, 11 to 13, according to which the impugned decision was issued in violation of Articles 113(1), 114(1) and (2) EPC.

The arguments concerning the absence of sufficiently indicated facts, evidence and arguments in support of the grounds of opposition were based, both in the communication and the impugned decision, on the same reasons and differ only in that the reasoning in the impugned decision has been adapted and amplified in order to take into account the arguments provided by the Appellant in his reply to the communication. The Board is unable, however, to perceive an essential difference between the two reasonings and would like to remind the Appellant that Article 113(1) EPC does not require that the party be given a repeated opportunity to comment on argumentation of the EPO body so long as the decisive objection against the contested procedural action, as in the present case, remains the same (cf. T 161/82, OJ EPO 1984, 551). Therefore, the Board considers that in the present case the Opposition Division in deciding to reject the opposition immediately after replying to the communication did not abuse its power of discretion which would have constituted a substantial procedural violation in the sense of Rule 67 EPC.

Even if, as the Appellant alleges in the aforementioned paragraphs, the reasoning in the impugned decision would have been at least partially based on an incorrect interpretation of the Appellant's submissions filed after the opposition period by the Opposition Division,

this would not change the situation as an error in interpreting a document could not possibly be regarded as a procedural violation. A misinterpretation of a letter directed to the EPO body concerned constitutes an error of judgment and not a substantial procedural violation and does therefore not provide a basis for ordering reimbursement of the appeal fee (cf. T 19/87, OJ EPO 1988, 268). The requirements for reimbursement under Rule 67 EPC are thus not fulfilled.

10. The appeal has therefore to be dismissed.

Order

For these reasons it is decided that:

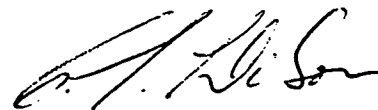
The appeal is dismissed.

The Registrar:



N. Maslin

The Chairman:



C. T. Wilson

Bv.

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W. Maslin
[Signature]