

Beschwerdekammern des
Europäischen Patentamts

Boards of Appeal of the
European Patent Office

Chambres de recours de
l'Office européen des brevets

Geschäftsstelle

Registry

Greffe

Als Anlage erhalten Sie den Leitsatz zur Entscheidung / -

Please find enclosed the headnote of the decision 10843, 91 - 3.3.1

Veillez trouver en annexe une copie du sommaire de la décision / -

EPA/EPO/OEB Form 3035 08.89

17.2.92 - CD-1099 S11
5.8.92 - CD-1099 S32

**Beschwerdekammern des
Europäischen Patentamts**

**Boards of Appeal of the
European Patent Office**

**Chambres de recours de
l'Office européen des brevets**

Geschäftsstelle

Registry

Grefte

Als Anlage erhalten Sie den Leitsatz zur Entscheidung / -

Please find enclosed the headnote of the decision *T0843 1 91 - 3.3.1*

Veillez trouver en annexe une copie du sommaire de la décision / -

A	X	E		C	
---	---	---	--	---	--

File No.: T 0843/91 - 3.3.1
Application No.: 82 306 197.3
Publication No.: 0 080 355
Classification: G03C 7/32
Title of invention: Photographic elements containing aryloxy substituted
photographic couplers

· D E C I S I O N
of 17 March 1993

Applicant: Eastman Kodak Company
Proprietor of the patent: -
Opponent: Fuji Photo Film Co., Ltd.

Headword: -

EPC: Art. 21(1), 24, 104, 106(1), 108, 111(1), (2), 117, 133, 134;
R. 67

Keyword: "All the members of a Board of Appeal objected to" - "new
members nominated under Article 24 EPC" - "Admissibility of the
objection (yes)" - "Suspected partiality (no)" - "Intervention
of an expert common practice of the Boards of Appeal" - "End of
the appeal proceedings" - "Documents submitted subsequent to the
decision" - "Loss of instance (no)" - "Rights of a party
disregarded (no)" - "Award of costs (no)"

Headnote
Catchwords

Headnote follows



Case Number: T 0843/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 17 March 1993

Appellant:
(Opponent) Fuji Photo Film Co., Ltd.
No. 210, Nakanuma
Minami Ashigara-shi
Kanagawa (JP)

Representative: Hansen, Bernd, Dr.rer.nat.
Hoffmann, Eitle & Partner
Patentanwälte
Arabellastrasse 4
Postfach 81 04 20
W-8000 München 81 (DE)

Respondent:
(Proprietor of the patent) Eastman Kodak Company
(a New Jersey Corporation)
343 State Street
Rochester
New York, N.Y. 14650 (US)

Representative: Baron, Paul Alexander Clifford
Kodak Limited
Patent Department
Headstone Drive
Harrow
Middlesex HA1 4TY (GB)

Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office dated 17 September
1991 concerning maintenance of European patent
No. 0 080 355 in amended form.

Composition of the Board:

Chairman: R.W. Andrews
Members: J-C. Saisset
P. Krasa

A	X	B		C	
---	---	---	--	---	--

File No.: T 0843/91 - 3.3.1
Application No.: 82 306 197.3
Publication No.: 0 080 355
Classification: G03C 7/32
Title of invention: Photographic elements containing aryloxy substituted
photographic couplers

DECISION
of 17 March 1993

Proprietor of the patent: Eastman Kodak Company
Opponent: Fuji Photo Film Co., Ltd.

Headword: Partiality/EASTMAN KODAK COMPANY

EPC: Art. 21(1), 24, 104, 106(1), 108, 111(1), (2), 117, 133, 134
R. 67

Keyword: "All members of a Board of Appeal objected to" - "new members
nominated under Article 24 EPC" - "Admissibility of the
objection (yes)" - "Suspected partiality (no)" - "Intervention of
an expert common practice of the Boards of Appeal" - "End of the
appeal proceedings" - "Documents submitted subsequent to the
decision" - "Loss of instance (no)" - "Rights of a party
disregarded (no)" - "Award of costs (no)".

Headnote

- I. *The wording of Article 24 EPC and procedural considerations imply that an objection to the members of a Board of Appeal can only be made in the course of an appeal pending before that Board of Appeal.*
- II. *Article 24(3) EPC states that "Members" of a Board of Appeal may be objected to by any party. This implies that objection may be made against each or all the Members of that Board.*
- III. *The Boards of Appeal are the final instance and their decisions become final once they have been delivered, with the effect that the appeal proceedings are terminated.*
- IV. *In proceedings, partiality would be to willingly favour the party by granting it rights to which it is not entitled or by intentionally disregarding the rights of another party.*

- V. *After the decision has been taken a Board is no longer empowered or competent to take any further action apart from drafting the written decision (apart also Rule 88 EPC). Any further action which in the light of the decision becomes necessary, is the responsibility of the internal administration.EPC.*

Summary of Facts and Submissions

I. European patent No. 80 355, granted in respect of European patent application No. 82 306 197.3, was revoked by the Opposition Division. On appeal, by the decision T 215/88 dated 9 October 1990, the Board of Appeal 3.3.1 allowed the appeal and remitted the case to the Opposition Division with the order to maintain the patent on the basis of an amended set of claims.

On 8 February 1991 the patent proprietor filed an amended description which had been adapted to the above set of claims.

II. By a decision dispatched on 17 September 1991, the Opposition Division maintained the patent on the basis of the above claims and the amended description.

In this decision it was stated that the Opponent's objections against the amended text only related to matters already considered and finally decided by the Board of Appeal in the decision T 215/88, and that such matters are not open to reconsideration by the Opposition Division, pursuant to Article 111(2) EPC.

III. On 17 October 1991 the Appellant (Opponent) gave notice of appeal against this decision and paid the appropriate fee. A statement of grounds of appeal was received on 7 January 1992.

IV. To hear this appeal, numbered T 843/91, a Board having the same composition as in case T 215/88 was nominated.

However, the Appellant alleged that, "because they had participated in the decision under appeal, one could not expect that a Board of the same composition would critically review the step they themselves had

undertaken to the Opponent's disadvantage"; thus, he requested inter alia to have, pursuant to Article 24 EPC, the appeal submitted for further prosecution to a competent Board of Appeal composed only of Members who had not participated in "the decision under appeal".

- V. By a new order dated 9 June 1992, for the sole purpose of taking a decision under Article 24 EPC, the three Members objected to were replaced by their alternatives according to Article 1(1) of the Rules of Procedure of the Boards of Appeal and the Business distribution scheme, in order to "hear the issue arising under Article 24(4) EPC and no other issue".

Consequently all the following procedural steps relating to the present issue, including the present decision, were taken by the newly nominated Board.

- VI. In accordance with Article 24 EPC and Article 3(3) of the Rules of Procedure of the Boards of Appeal, the newly nominated Board sent a communication dated 13 July 1992 to inform the parties that there would be no further proceedings in the case before the issue of a decision on the exclusion of the first three nominated Members.

- VII. In his statement of grounds of appeal the Appellant referred to formal or legal deficiencies which, in his view, independently but particularly in combination, seriously interfered with his right to be heard and to obtain a fair final decision. He contended, in particular, that during oral proceedings held in case T 215/88 the Board allowed an unauthorised representative to make legal submissions and accepted new definitions suggested by him. In the Appellant's opinion, the Board then failed to transmit to the Opposition Division and the patent proprietor

submissions made by the Respondent in the appeal T 215/88 after the decision had been announced. He further submitted that the Board had failed to order expressis verbis the adaptation of the description to the amended Claim 1 and that, for this reason, the Opposition Division could not take into account the objections raised in the Opponent's letter dated 12 August 1991.

The Appellant alleged that "the members of the Board who had taken the decision under appeal", have a personal interest in the subject-matter of the new appeal since they could not be expected to critically review the steps they themselves undertook to the Appellant's disadvantage. They should therefore be excluded from deciding the case T 843/91.

VIII. By letter received on 8 May 1992, the Respondent (patent proprietor) disagreed that any formal or legal deficiencies had occurred and observed that, during oral proceedings in the appeal T 215/88, the present Appellant had not objected to the unauthorised representative making submissions during the said oral proceedings.

He also emphasised that, in his view, it was desirable for the same Board to decide the appeal since only this Board is familiar with the technical details of the case.

IX. According to Article 3(2) of the Rules of Procedure of the Boards of Appeal an invitation was issued to the three members objected to under Article 24 EPC in order to give them the opportunity to present their comments as to whether there were any reasons for their exclusion. Their responses were transmitted to the parties on 19 January 1993.

X. The three Members concerned asserted essentially that they had no personal interest in the case and, despite the allegations of partiality, they were prepared to judge it without a preconceived attitude towards the parties.

XI. By letter dated 1 February 1993 and during the oral proceedings held on 17 March 1993, the Appellant acknowledged that these Members, to the best of their knowledge and capabilities, have the firm intention to act fairly and impartially in evaluating the cases assigned to them. Nevertheless, he maintained that their declarations were such that doubts still exist as to whether they could treat the present specific case impartially. He emphasised in particular that the atmosphere during the oral proceedings appeared very unusual because of the obvious sympathy shown for the patentee's attorney, whereas the Chairman had requested that the Representative of the Opponent be short and non-repetitive in his presentation. He added that the development which had occurred in this file after the conclusion of the hearing was such that the doubt whether this specific case would be handled impartially remains and explained that, as it was not apparent to him who within the Board was responsible, he requested that an entirely new Board should decide the matter.

Stressing that central to the Appellant's allegation was the implication that an unauthorised Representative was unduly allowed to make submissions before the Board on behalf of the Patentee, the Representative of the Respondent asserted that he personally presented the case and that it was only after the authorised Representatives for both parties had expressed their views that Mr Levitt, who was not an authorised Representative, was allowed to make observations, which were essentially of a technical nature. In his view, any

legal submission made by this person was incidental and did not change the legal petition already made by the authorised Representative at the outset of the hearing. Thus, he denied that Mr Levitt made the major pleadings at the hearing and emphasised that Mr Levitt was known to the Opponent's Representative because he had participated in the hearing held before the Opposition Division.

- XII. Relating to the present issue the Appellant maintained as his main request that the further prosecution of the appeal be submitted to a competent Board of Appeal only composed of Members who had not participated in previous decision T 215/88. As an auxiliary request, he requested that the further prosecution of the appeal be submitted to a competent Board of Appeal in which only the previous Chairman and the previous legal Member are replaced. He requested also an award of costs.

The Respondent requested that the request under Article 24 EPC be rejected and an award of costs.

- XIII. At the conclusion of the oral proceedings, the Board announced its decision to reject the main and auxiliary requests under Article 24 EPC and the requests of both parties for awards of costs.

Reasons for the Decision

1. According to the Order dated 9 June 1992 the only subject-matter of the present decision is to decide, within the framework of Article 24 EPC, whether the three Members nominated in the Order dated 13 January 1992 to examine the case T 843/91 could be suspected of partiality.

2. The wording of Article 24 EPC and the coherence of the proceedings imply that an objection can only be made in the course of an appeal pending before a Board of Appeal.

The present case fulfils this condition because it is clear from point III of the Summary of Facts and Submissions that the appeal T 843/91 which was lodged against the decision of the Opposition Division dispatched on 17 September 1991 fulfils the requirements of Article 108 EPC relating to the filing of a notice of appeal and the payment of the appeal fee. Therefore an appeal is in existence.

3. Article 24(3) EPC states that "Members" of a Board of Appeal may be objected to by any party. In the Board's judgment, this implies that in cases like the present one all the Members of a Board may be objected to, together or separately.

The objections raised by the Appellant are neither based upon the nationality of the Members nor were they filed after he had taken a procedural step (see decision of the Enlarged Board of Appeal G 5/91, point 3 of the Reasons, page 11, OJ EPO 1992, 617), consequently these objections meet the formal requirements of Article 24 EPC and are, therefore, admissible.

4. Initially, the present Board considers that none of the Members first nominated to examine and decide the case T 843/91 participated in the decision of the Opposition Division dispatched on 17 September 1991 which is the sole subject of the appeal T 843/91.

5. However, it appears from the notice of appeal T 843/91 and from the statements of grounds that the Appellant requests the cancellation of the Opposition Division's decision on the grounds that:
 1. the Opposition Division refused to revoke the patent relying on the fact that the decision T 215/88 was final;
 2. the adaptation of the description as decided by the Opposition Division was wrong.

6. As regards the first ground above, the Opposition Division is correct in stating that decisions of the Boards of Appeal are final. This derives from the fact that a decision can only be contested where it is expressly provided for under statute and there are no provisions in the European Patent Convention allowing an appeal to be filed against a decision of a Board of Appeal. Articles 21(1) and 106(1) EPC state that the only decisions which are subject to appeal are those of the Receiving Section, Examining Division, Opposition Division and Legal Division. The Boards of Appeal are thus the final instance and their decisions become final once they have been delivered with the effect that the appeal proceedings are terminated. Therefore, the objections raised by the Appellant against the decision T 215/88 are not admissible.
 - 6.1 This finding is confirmed by the reasons of the decision T 757/91 (to be published) in which it was decided, in considering an appeal against a decision of the Opposition Division where that decision was based on a decision of a Board of Appeal remitting the case to the Opposition Division, there was no possibility to re-examine questions which the Board of Appeal had already settled when the case was first heard. However, if after

the case was remitted, the issue still outstanding is the adaptation of the description to the amended claims which were held valid in the first appeal proceedings, this issue is the only one which could be considered in further appeal proceedings. When the first Board of Appeal delivered its decision, the content and text of the patent claims became res judicata and could no longer be amended in proceedings before the EPO (see also T 934/91 (headnote published in OJ EPO 1993/03) and T 113/92 of 4 December 1992).

6.2 The decision of the Enlarged Board G 1/83 (OJ EPO 1985, 60), (and implicitly T 17/81, OJ EPO 1983, 266 and T 297/88 to be published) cited by the Appellant is not in conflict with the above reasons. All these decisions make it clear that any decision taken in the examining proceedings could not be binding in subsequent proceedings which may concern the same subject-matter, but with different parties involved and, therefore, Article 111(2) EPC was not applicable. In contrast thereto, the present appeal arises directly from a case remitted to the Opposition Division pursuant to Article 111(1) EPC and in this situation Article 111(2) not only applies to the Opposition Division, but must also apply to any Board of Appeal dealing with the case "within the competence of the department which was responsible for the decision appealed" (Article 111(1) EPC).

6.3 Since, as pointed out above, the decision T 215/88 is final, it is now impossible to modify its contents and thus, it cannot be said that the first three nominated Members (including the Chairman) have a personal interest insofar as they would be partial in order to try to maintain their own decision.

7. However, the Appellant also objects to the adaptation of the description as decided by the Opposition Division.

Thus, in the appeal T 843/91 it still must be decided whether or not the description of the patent meets the requirements of the EPC. This is within the jurisdiction of the Board 3.3.1 because, as stated above in point 6.1, objections to the amendments made to the description after remittal of the case to the Opposition Division by a Board of Appeal which had issued a decision relating to the claims are admissible.

- 7.1 Therefore, the Board nominated under Article 24 EPC must decide whether or not the Members nominated in the first order could be suspected of partiality in hearing the case T 843/91, not, as alleged by the Appellant because they participated in the "decision under appeal", but because these Members participated in an earlier decision (T 215/88) in which the Appellant asserts they showed partiality and because this decision is related to the case T 843/91, insofar as the two cases relate to the maintenance or revocation of the same patent.

This follows from the first sentence of Article 24(3) EPC, and from the decision of the Enlarged Board of Appeal G 5/91 in which it is stated that it must be considered as a general principle of law that nobody should decide a case in respect of which a party may have good reasons to assume partiality. This is the meaning of Article 24(3) EPC, first sentence.

8. The present Board agrees with the view held in decision T 261/88 dated 16 February 1993 (to be published) that disqualifying partiality presumes a preconceived attitude on the part of a deciding person towards a party. More precisely, in the present Board's view partiality would be to wittingly favour one party by

granting it rights to which it is not entitled, or by intentionally disregarding the rights of the other party. This is the reason why, in the decision G 5/91 the Enlarged Board of Appeal states that the question whether or not an objection to members on the ground of suspected partiality is to be considered justified can only be decided upon in the light of the particular circumstances of each individual case. Thus, whatever their gravity, deficiencies, erroneous practices or procedural violations cannot be regarded as forming a basis for an objection on the ground of partiality if they do not result from such a preconceived attitude or deliberate intention.

9. Relating to the intervention of an unauthorised Representative, it is clear from the minutes of the oral proceedings held on 9 October 1990 that the Appellant (Patentee) was duly represented by Mr Nunney an authorised Representative, accompanied by Mr Clark, Mr Levitt and Mr Brandes. The Respondent (Opponent), who is the Appellant in the present case, was represented by Mr Lethem, an authorised Representative, accompanied by Mr Hansen and Mr Polz. The authorisations and identifications of all those present had been checked before the Chairman declared the hearing open.

9.1 The Appellant suggested that, at the beginning of a hearing, it could be useful for the parties to the oral proceedings to be systematically informed about the status of those persons present. However, except for the authorised Representative, it is not common general practice of the Boards of Appeal in general and of the Board 3.3.1 in particular to announce the status of the others participant but only to cite their names and to present them as accompanying the authorised Representative. Therefore, when the Board did not

announce the status of Mr Levitt it did not intentionally affect the rights of the Respondent, since it only followed its usual procedure.

9.2 Although Mr Levitt was also present at the oral proceedings held in February 1988 before the Opposition Division and that his status was apparent from the front of a document (US patent No. 4 248 962) cited by the Opponent during the first opposition and appeal proceedings, the present Board notes from the minutes or the oral proceedings and the decision T 215/88 that none of the parties contested either his presence or his addressing the Board so that the Board objected to was not aware that the status of Mr Levitt was unknown to the Respondent.

9.3 It is also common practice of the Boards of Appeal to allow contributions by experts under the control of the authorised Representative when it considers it would be useful for the good understanding of the case. This is based on the provisions of Article 117 EPC which enables the Boards to request information. This does not contravene decision T 80/84 OJ EPO 1985, 269 which states that an unqualified and unauthorised person who is not entitled to represent a party in accordance with Article 133 or 134 EPC may not present the case of a party in oral proceedings even under the direct supervision of that party's authorised Representative. In this latter case the duly authorised Representative of the Appellant had informed the Board that he intended to present the Appellant's requests formally and then to leave the detailed viva voce presentation of his client's case to an unqualified and unauthorised person who accompanied him and who was training to be a German Patentanwalt.

9.4 On the contrary, in the case T 215/88, even if it is admitted that Mr Levitt made use of all his professional skills in a long oral presentation he was not acting instead of the authorised Representative, the latter having personally presented the case and the then Appellant's requests. The legal basis for the contribution of Mr Levitt are the provisions of Article 117 EPC.

9.5 In the light of the above, the present Board does not consider that the previous Board's decision to allow Mr Levitt the opportunity to address it during the oral proceedings before it was a result of a preconceived attitude on its part or a prejudice against the Respondent. In this Board's judgment, the sole intention of that Board in allowing Mr Levitt to address it was to ensure that it had a good understanding of the technical subject-matter of the disputed patent before reaching its decision on the merits of the case.

10. The Appellant also contended that the Board under consideration failed to transmit to the other party and the Opposition Division submissions made by him after the decision T 215/88 had been announced.

The decision in the file T 215/88 was issued orally on 9 October 1990 and, as previously stated, once issued, a decision becomes final with the effect that appeal proceedings are terminated and the appeal file is closed. Therefore, after the decision had been taken the Board nominated to decide the case T 215/88 was no longer empowered or competent to take any further action apart from writing the reasons for the decision. Any further action which in the light of the decision became necessary, i.e. remitting the case together with the written decision to the Opposition Division, becomes the responsibility of the internal administration.

Therefore, any failure at the administrative stage of the proceedings cannot be attributed to the Members of the Board who participated in the decision.

In other words, even if the former Respondent's submission had been brought to the attention of the Members of the Board in the appeal T 215/88, they would have been powerless to take any action in response to those submissions since the appeal had passed out of their jurisdiction.

11. In the view of the Appellant, another deficiency arose from the fact that in its decision the Board failed to mention in the order that the Opposition Division should ensure that the description should be adapted to the newly adopted claims. He asserted that, presumably because of this omission, his arguments and experimental report submitted on 12 August 1991 were ignored.

However, in the order of the decision T 215/88 it is stated that "the case is remitted to the Opposition Division with the order to maintain the patent on the basis of the Appellant's main request". The main request of the Appellant was that the patent be maintained on the basis of Claim 1 filed on 7 February 1990 and Claims 2 to 7 as granted. In deciding in this way the Board did not take a position on an eventual adaptation of the description. As stated before, the first instance to which the case was remitted was only bound by the ratio decidendi of the Board of Appeal's decision and thus, was entitled to adapt the description, if necessary. The Opponent has the possibility to contest this adaptation before the Opposition Division and then the right to lodge an appeal against the new decision of the Opposition Division, exactly as he did in the present case. Thus, despite the assertions of the Appellant and because, as stated above, the only

possible remaining issue to be dealt with after the decision T 215/88 was the adaptation of the description, there is no loss of instance for him.

12. Relating to the atmosphere of the oral proceedings held on 9 October 1990, i.e. to the remarks and the request to be short and non-repetitive aimed by the Chairman at the Opponent's Representative, it is to be noted that, even if the latter considers the Chairman's remarks to be lacking in courtesy, in fact he has never alleged that he was not in a position to present and develop his argumentation in the manner he wished. Therefore, the present Board do not consider that the attitude of the Chairman resulted in the rights of the Opponent being disregarded or infringed.
13. The Appellant also complained about the Board's attitude to him in dealing with his submission of new matter shortly before the oral proceedings of 9 October 1990. The admission of such matter into the proceedings lies in the discretion of the Board and, in exercising its discretion in the then Respondent's favour, the Board wanted to ensure that there had been no abuse of the appeal proceedings by deliberately delaying the filing of this matter until a late state in the proceedings.

The Board did not show partiality insofar as it did not question the former Appellant about the filing of a document, which was considered by the Board to represent the closest state of the art, with his statement of grounds of appeal. In the first place, the Board considered that this document merely represented the state of the art already acknowledged in the patent in suit and, in the second place, the statement of grounds of appeal was filed over two years before the date of the oral proceedings.

14. Therefore, in the Board's judgment, none of the rights of the Opponent (Respondent) in the appeal T 215/88 were disregarded or infringed by the Chairman or by the other two members of the Board. Hence, the grounds brought forward by the present Appellant are not sufficient to exclude the first three nominated members from deciding the appeal T 843/91.

15. Having regard to Article 104 EPC, the Board has decided that no reasons of equity exist which would justify the awarding of costs to either party to the proceedings under Article 24 EPC. Accordingly, each party shall meet the costs it has incurred relating to these proceedings.

Order

For these reasons, it is decided that:

1. The main and auxiliary requests under Article 24 EPC are rejected.


2. The requests of both parties for an award of costs are rejected.

The Registrar:



E. Gorgmaier

The Chairman:



R.W. Andrews