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Aktenzeichen

File Number

Numéro du dossier

T0925 191 -3.42

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Anmeldung Nr. / Patent Nr.:

(soweit nicht aus der Anlage
ersichtlich)

Application No. / Patent No.:

8490 4275.9

(if not apparent from enclosure)

Demande n° / Brevet n°:

(si le n° n'apparaît pas sur l'an-
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Internal distribution code:

- (A) Publication in OJ
(B) To Chairmen and Members
(C) To Chairmen

D E C I S I O N
of 26 April 1994

Case Number: T 0925/91 - 3.4.2

Application Number: 84904275.9

Publication Number: 0162893.

IPC: B01D 53/34

Language of the proceedings: EN

Title of invention:

Non-Catalytic method for reducing the concentration of Nitrogen Oxide in combustion effluents

Patentee:

Exxon Research and Engineering Company

Opponent:

Siemens AG

Headword:

-

Relevant legal norms:

EPC Art. 108, 99(1)

EPC R. 65(1), 64(b), 56(1), 55(c), 67

Keyword:

"Form of appeal - admissible (yes)"

"Examination of opposition - admissibility (yes)"

"Reimbursement of appeal fee (no)"

"Substantial procedural violation (no)"

Decisions cited:

T 0213/85, T 0169/89, T 0534/89, T 0328/87, T 0289/91,

T 0182/89, G 0005/88, G 0001/86, G 0001/84

Headnote follows



Case Number: T 0925/91 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 26 April 1994

Appellant: Siemens AG
(Opponent) Postfach 22 16 34
D-80506 München (DE)

Representative: -

Respondent: Exxon Research and Engineering Company
(Proprietor of the patent) P.O. Box 390
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Representative: Somers, Harold Arnold
ESSO Engineering (Europe) Ltd.
Patents & Licences
Mailpoint 72
Esso House
Ermyrn Way
Leatherhead
Surrey KT22 8XE (UK)

Other party: -
(Opponent) -

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 4 October 1991
rejecting the opposition filed against European
patent No. 0162893 pursuant to Rule 56(1) EPC
as inadmissible.

Composition of the Board:

Chairman: E. Turrini
Members: R. Zottmann
B. J. Schachenmann

Summary of Facts and Submissions

- I. The Appellant (Opponent) lodged an appeal against the decision of the Opposition Division of 4 October 1991 rejecting the opposition against the European patent No. 0 162 893 as inadmissible.

The Opposition Division held that the notice of opposition did not comply with the provisions of Rule 56(1) EPC in conjunction with Rule 55(c) EPC and was, therefore, inadmissible.

- II. The Appellant requested that the decision under appeal be set aside and the opposition considered admissible. Furthermore, it requested oral proceedings, as auxiliary request.

In the written statement setting out the grounds of appeal dated 4 February 1992 the issue of admissibility of the opposition was not explicitly dealt with. Instead the Appellant focused on the questions of novelty and inventive step.

- III. The Respondent requested that the appeal be dismissed. Furthermore, it requested oral proceedings, as auxiliary request.

In its written submissions the Respondent essentially argued on substantive matters only.

- IV. Oral proceedings were held on 26 April 1994. The Respondent summoned with a communication of 11 February 1994 did not appear.

V. The Appellant, in the oral proceedings, argued as follows:

The decision under appeal deals not only with the admissibility of the opposition, but also with the questions of novelty and inventive step.

The statement setting out the grounds of appeal, dated 4 February 1992, refers at least implicitly to the issue of admissibility of the opposition. Attention is, in this respect, drawn to page 6, second paragraph, of the statement referring to page 4, first paragraph, of the decision under appeal. The appeal is thus admissible.

As to the admissibility of the opposition, it should be noted that the Enlarged Board of Appeal, in its decision G 1/84, held that "except in cases of manifest abuse of procedure, the overwhelming public interest lies in each opposition being examined on its merits". In the present case, the notice of opposition of 17 October 1989 is considered as fulfilling the requirements of admissibility. In the statement setting out the grounds of opposition all the features of Claim 1 and of the dependent claims have been discussed in the light of the cited prior art. The "kinetic model" mentioned in Claim 1 as granted is considered as belonging to the general technical knowledge of the skilled person. Even though evidence therefore is not necessary, it was subsequently filed with the letter of 02 January 1991.

Reasons for the Decision

1. *Admissibility of the appeal*

Pursuant to Rule 65(1) EPC, an appeal shall be rejected as inadmissible if it does not comply with Articles 106

to 108 EPC and with Rules 1(1) and 64(b) EPC, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 EPC has expired.

- 1.1 In the present case, a first issue to be considered is whether the appeal complies with the provisions of Rule 64(b) EPC. According to this Rule, the notice of appeal shall contain a statement identifying the decision which is appealed and the extent to which amendment or cancellation of the decision is requested.

Although in the notice of appeal, dated 3 December 1991, which is drafted in German, it would have been correct to identify the appealed decision as "Verwerfung des Einspruchs als unzulässig" rather than as "Zurückweisung des Einspruchs", it may nevertheless be admitted that the requirement of Rule 64(b) EPC concerning the identification of the appealed decision is met.

As to the extent to which amendment or cancellation of the decision is requested, the notice of appeal does not contain any detailed statement. However, it can be derived from its wording that the appeal was lodged against the decision in its entirety. Thereby, the extent of the appeal within the meaning of Rule 64(b) EPC is sufficiently identified (see T 007/81, OJ EPO 1983, 98).

The Board is, therefore, satisfied that the requirements of Rule 64(b) EPC are met.

- 1.2 A second issue to be considered is whether the appeal was adequately substantiated in the written statement setting out the grounds of appeal (Article 108 EPC).

The present case, at first sight, appears to fit quite well with the decision T 0213/85 (OJ EPO 1987, 482) confirmed in the meantime by the decisions T 0169/89 (EPOR 91, 262) and T 0534/89 (to be published).

According to these decisions, an appeal is to be rejected as inadmissible for lack of adequate substantiation, if an opposition has been dismissed on the grounds of insufficient substantiation and the grounds of appeal merely dispute patentability without elaborating on the admissibility of the opposition.

However, the facts underlying the present case seem to comprise additional aspects which were not present in the cases referred to above.

Whereas in case T 0213/85 the appealed decision of the first instance was limited to the issue of inadmissibility of the opposition, the Opposition Division, in the present case, did not confine itself to reject the opposition as inadmissible but, in addition, expressed its opinion on the validity of the patent (see point 8 of the appealed decision).

The proceedings of the first instance are deficient in that they were not terminated with the rejection of the opposition as inadmissible. Instead, the Opposition Division went on to examine the opposition as to the substance. According to the decision T 0328/87 (OJ EPO 1992, 701) an opposition cannot, however, be examined as to its substance, when it has been declared inadmissible. As soon as rejection occurs, the opposition procedure is legally terminated and substantive examination cannot be initiated. The inadmissibility of an opposition (when finally decided) or of an appeal has the effect of transferring the European patent to the national jurisdiction of the

Designated States, which then assume sole responsibility for assessing the patent's validity with reference to their own legislation (see point 4 of the quoted decision).

The contested decision, therefore, appears to be misleading with regard to its basis. The reasons of the decision are not limited to the issue of inadmissibility, but also deal with the opposition as to its substance (see the reasons, point 8, but also point 5 referring to arguments submitted after the opposition period and point 9 referring to a requested amendment in the description). Therefore, the lack of a clear distinction in the statement of appeal between the issue of inadmissibility and arguments referring to substantial examination of the opposition merely reflects the formal deficiency of the appealed decision itself. Another indication for the misleading nature of the opposition proceedings may be seen in the fact that the Respondent also, in its answer to the appeal, did not distinguish between the issues of inadmissibility of the opposition and patentability of the invention.

For these reasons, when applying the principle of good faith governing the relations between the EPO and its users (see G 5/88, OJ EPO 1991, 137), the appeal should be considered admissible. The Appellant, even though it did not clearly distinguish between the two issues of the decision under appeal, at least challenged those parts of the ratio decidendi which, from the standpoint of the parties, seemed to be most relevant.

It should also be considered that point 8 of the reasons of the appealed decision might have caused the Appellant to believe that the issue of inadmissibility would have

been examined by the Board of Appeal of its own motion and that, therefore, no comment was necessary on this issue in the appeal.

- 1.3 The remarks in the appealed decision on substantive matters are insignificant and have no legal effect, once the opposition has been deemed to be inadmissible. However, in the judgement of the Board, such remarks should, on principle, be avoided for the following reasons.

The admissibility of an opposition is an essential procedural prerequisite ("unverzichtbare prozessuale Voraussetzung" in T 0289/91, not published) for the examination of the opposition as to its substance (Article 101(1) EPC). If an opposition is rejected as inadmissible, the respective proceedings are legally terminated without a decision as to the substance of the opposition being issued (see T 0328/87, OJ EPO 1992, 701). A decision rejecting an opposition as inadmissible and, at the same time, considering the merits of the (inadmissible) opposition, appears to be inconsistent with the procedural principles referred to above.

Moreover, a procedural deficiency of this kind could result in legal uncertainty during the national phase and could disadvantage either the proprietor or the opponent. If, for instance, the Opposition Division rejected an opposition as inadmissible (with the effect that the patent is maintained as granted) and expressed, in the same decision, its opinion that, nevertheless, the maintenance of the patent appeared to be prejudiced for lack of patentability, such statement could be harmful to the proprietor when trying to enforce his patent in a contracting state. Even if a national court would not consider the Opposition Division's statement regarding lack of patentability as legally binding, it

could, in practice, influence national proceedings to the proprietor's detriment. The opponent as well as third parties could, furthermore, be misled by the reasons of the decision to believe that the patent had been declared invalid and could, therefore, be ignored by them.

Though, in the present case, the Opposition Division did not consider the (maintained) patent to be invalid but, in contrast, considered it to be valid, the situation does not, on principle, differ from the circumstances referred to above. From the standpoint of procedural law, it cannot, in this context, be relevant whether the Opposition Division's statement was in favour of or against the validity of the patent in suit (due to the principle of equal treatment of the proprietor and the opponent in opposition proceedings - see G 1/86, OJ EPO 1987, 447).

In order to avoid any misunderstanding, it should be noted that the Board agrees with the practice of the Opposition Division to decide at the same time all grounds of opposition which were properly supported by the opponent in order to achieve a speedy and streamlined procedure (see T 0182/89, OJ EPO 1991, 391). However, this practice appears not to be appropriate if an opposition is held inadmissible.

1.4 In view of the foregoing, the appeal is deemed to be admissible.

2. *Admissibility of the opposition*

2.1 A notice of opposition shall be rejected as inadmissible pursuant to Rule 56(1) EPC, if it does not comply with the provisions of Article 99(1), Rule 1(1) and Rule 55(c) EPC or does not provide sufficient

identification of the patent opposed, unless these deficiencies have been remedied before expiry of the opposition period.

In the present case, the opposition was filed against the patent as a whole (see page 5 of the notice of opposition, second paragraph) and based on the ground for opposition of Article 100(a) EPC (see page 2, first paragraph). Although the notice of opposition does not contain an explicit statement, within the terms of which of the Articles 52 to 57 EPC the subject-matter of the patent should not be considered as patentable, it nevertheless follows from the context that lack of inventive step is the only ground, on which the opposition is based. In relation to this ground, prior art documents are relied upon.

The Opposition Division held in the appealed decision that the requirement under Rule 55(c) EPC was not met according to which the notice of opposition shall, inter alia, contain an indication of facts, evidence and arguments presented in support of the grounds. In particular, the Opposition Division came to the conclusion that the allegations of the opponent with regard to the "kinetic model" in Claim 1 were only speculative and devoid of any proper evidence. Even if the documents submitted after expiry of the opposition period were taken into account, the opponent's argumentation failed to indicate why different sources of prior art should suggest any lack of inventiveness.

2.2 Following the decision T 0222/85 (OJ EPO 1988, 128, point 4), the purpose of Rule 55(c) EPC 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. The requirement of Rule 55(c) EPC, that the notice of

opposition shall contain an indication of the facts, evidence and arguments presented in support of the grounds, 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.

The requirement of Rule 55(c) EPC concerning the indication of the facts, evidence and arguments presented in support of the grounds, 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 reasonably skilled man in the art to which the opposed patent relates.

In the present case, the opponent subdivided the subject-matter of Claim 1, for the purpose of analysis, into a plurality of features which are listed on page 2 of the notice of opposition. Each of these features was discussed in detail with regard to the cited prior art. As to the last feature mentioned regarding the "kinetic model", it was stated on page 4 that it belonged to the general technical knowledge of the skilled person at the relevant date and that evidence therefor would be filed later on. This was done with the letter of 2 January 1991. It thus appears that a sufficient indication of the relevant facts, evidence and arguments was available for the opponent's case to be properly understood on an objective basis. The sufficiency of the notice of opposition must, in this respect, be distinguished from the strength of the opponent's case, which is not under discussion here.

Moreover, even in cases in which the sufficiency of the indication of facts, evidence and arguments as required by Rule 55(c) EPC is not beyond any shadow of doubt, the overwhelming public interest may lie in the opposition being examined on its merits, as underlined by the Enlarged Board of Appeal in the decision G 1/84 (OJ EPO 1985, 299). This means that, in such cases, the benefit of the doubt as regards the issue of admissibility of the opposition should be given to the opponent.

2.3 For these reasons, the opposition is deemed to be admissible.

3. *Reimbursement of the appeal fee*

3.1 Though reimbursement of the appeal fee has not been requested, it shall be ordered, pursuant to Rule 67 EPC, where the Board deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation.

In the present case, the following has to be considered. On EPO form 2307, notified to the parties as front page of the decision under appeal, it was stated that the notice of opposition is rejected as inadmissible on the basis of Rule 56(1) EPC. The substance of the appealed decision is thus clearly indicated despite of the misleading nature of the statements in points 8 and 9 of the reasons, as underlined above. These points, however, cannot be considered as res judicata since they clearly refer to issues on which the Opposition Division did not decide.

The remarks on the substantive issues in the decision under appeal did not, therefore, adversely affect the opponent owing to the fact that they have no legal effect.

It follows that, although the misleading nature of a part of the reasons is considered to be a vice of procedure, this vice is not, in the Board's judgment, substantial within the meaning of Rule 67 EPC.

For these reasons, the appeal fee shall not be reimbursed.

Order

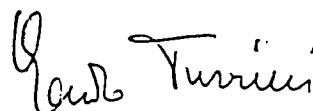
For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution on the basis that the opposition is admissible.

The Registrar:


P. Martorana

The Chairman:


E. Turrini

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(C) To Chairmen

D E C I S I O N
of 26 April 1994

Case Number: T 0925/91 - 3.4.2

Application Number: 84904275.9

Publication Number: 0162893

IPC: B01D 53/34

Language of the proceedings: EN

Title of invention:

Non-Catalytic method for reducing the concentration of Nitrogen Oxide in combustion effluents

Patentee:

Exxon Research and Engineering Company

Opponent:

Siemens AG

Headword:

Combustion effluents/EXXON

Relevant legal norms:

EPC Art. 108, 99(1)

EPC R. 65(1), 64(b), 56(1), 55(c), 67

Keyword:

"Form of appeal - admissible (yes)"

"Examination of opposition - admissibility (yes)"

"Reimbursement of appeal fee (no)"

"Substantial procedural violation (no)"

Decisions cited:

T 0213/85, T 0169/89, T 0534/89, T 0328/87, T 0289/91,

T 0182/89, G 0005/88, G 0001/86, G 0001/84

Headnote:

- I. If a notice of opposition is rejected as inadmissible by the first instance, the opposition proceedings are legally terminated without a decision as to the substance of the opposition being issued. It is inconsistent with the procedural principle referred to above for the decision rejecting the opposition as inadmissible to consider its merits.

- II. Remarks on substantive matters in a decision rejecting the opposition as inadmissible, have no legal effect. Even if misleading, they do not represent a substantial procedural violation justifying the reimbursement of the appeal fee.



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T 925 191 -342

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Application No. / Patent No.:

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Case Number: T 0925/91 - 3.4.2

Decision of 11 August 1994
correcting errors in the
D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 26 April 1994

Appellant: Siemens AG
(Opponent) Postfach 22 16 34
D-80506 München (DE)

Representative: -

Respondent: Exxon Research and Engineering Company
(Proprietor of the patent) P.O. Box 390
180 Park Avenue
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New Jersey 07932-0390 (US)

Representative: Somers, Harold Arnold
ESSO Engineering (Europe) Ltd.
Patents & Licences
Mailpoint 72
Esso House
Ermyrn Way
Leatherhead
Surey KT22 8XE (UK)

Other party: -
(Opponent) -

Representative: -

Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 4 October 1991
rejecting the opposition filed against European
patent No. 0162893 pursuant to Rule 56(1) EPC
as inadmissible.

Composition of the Board:

Chairman: E. Turrini
Members: R. Zottmann
B. J. Schachenmann

In application of Rule 89 EPC the Decision given on 26 April 1994 is hereby ordered to be corrected as follows:

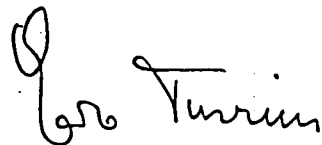
Paragraph one on page 11 is substituted by

It follows that, although the misleading nature of a part of the reasons is considered to be procedurally incorrect, it is not, in the Board's judgment, a substantial procedural violation within the meaning of Rule 67 EPC.

The Registrar:


E. Gorgmaier

The Chairman:


E. Turrini