**BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS**

**BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE**

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# D E C I S I O N
# of 18 October 1994

**Case Number:** T 0133/92 - 3.3.1

**Application Number:** 86200688.9

**Publication Number:** 0202698

**IPC:** C07C 143/44

**Language of the proceedings:** EN

**Title of invention:**
P-sulphophenyl alkyl carbonates and their use as bleaching activators

**Patentee:**
Akzo Nobel N.V.

**Opponent:**
Unilever PLC/Unilever N.V.

**Headword:**
Bleaching activators/AKZO

**Relevant legal provisions:**
EPC Art. 54, 56, 113(1), 125

**Keyword:**
"Novelty (no; for main and first auxiliary request) - selection of a group of compounds"
"Novelty (yes; second auxiliary request) - selection of individualised compounds"
"Inventive step (yes)"
"Right to be heard (yes) - decision based on new claims filed during oral proceedings at which the Opponent was not represented"
"Not new fact: G 4/92 distinguished"
"Principle of legal certainty: Art. 125 EPC"

**Decisions cited:**
G 0004/92

**Catchword:**
A claimed group of compounds essentially resulting from omitting those parts of a larger group of compounds which a skilled person would have immediately considered as being less interesting than the rest, cannot be selectively novel.

**Case Number:** T 0133/92 - 3.3.1

**D E C I S I O N**
**of the Technical Board of Appeal 3.3.1**
**of 18 October 1994**

**Appellants:** (Opponents)
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**Decision under appeal:** **Decision of the Opposition Division of the European Patent Office pronounced on 3 December 1991 with written reasons notified on 11 December 1991 rejecting the opposition filed against European patent No. 0 202 698 pursuant to Article 102(2) EPC.**

**Composition of the Board:**

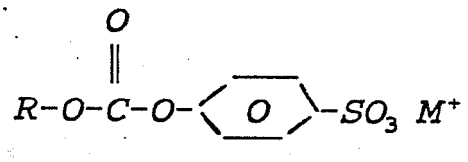
**Chairman:** A. Jahn
**Members:** J. M. Jonk

J. A. Stephens-Ofner

## Summary of Facts and Submissions

I. The grant of European patent No. 0 202 698 in respect of European patent application No. 86 200 688.9 was announced on 25 October 1989 (cf. Bulletin 89/43). The patent was based on 5 claims for the contracting states BE, CH, DE, FR, GB, IT, LI, LU, NL and SE, independent Claim 1 reading as follows:

"A compound of the general structural formula

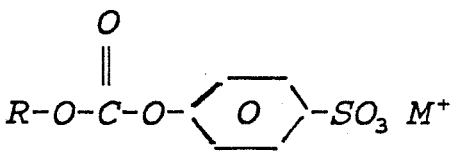


where R is an alkyl group and $M^+$ represents a cation, characterized in that the alkyl group contains 6 to 10 carbon atoms, with the proviso that the $C_6$-alkyl group is n-hexyl."

Independent Claims 3 and 5 concerned a detergent additive and a detergent composition comprising a compound according to Claim 1 as a bleaching activator.

In addition the patent was based on 5 claims for the contracting state AT, Claim 1 reading as follows:

"A process for the preparation of a compound of the general structural formula



where R is an alkyl group and $M^+$ represents a cation, characterized in that the alkyl group contains 6 to 10 carbon atoms, with the proviso that the $C_6$-alkyl group is n-hexyl."

The composition Claims 3 to 5 for this contracting state corresponded to those for the other designated contracting states indicated above.

II. A Notice of Opposition was filed on 25 July 1990 by Unilever N.V. and Unilever PLC, requesting the revocation of the patent on the grounds of lack of novelty and inventive step. The opposition was supported by the following documents:

(1) EP-A-0 166 571
(2) US-A-3 256 198
(3) US-A-4 412 934 (EP-A-0 098 021) and
(4) US-A-3 272 750.

III. By a decision pronounced on 3 December 1991 with written reasons notified on 11 December 1991, the opposition was rejected.

The Opposition Division held that the subject-matter of the disputed patent was novel. It also held that the subject-matter of the claims involved an inventive step, because, surprisingly, the claimed compounds showed an improved bleaching activity compared with those of the closest prior art, namely document (4). In addition, it was apparent from this document that sodium p-sulphophenyl n-butyl carbonate had an inferior activity compared with the corresponding ethyl and n-propyl compounds, so that a skilled person would not

have been directed to try the higher ($C_6$-$C_{10}$) alkyl compounds, but would, on the contrary, have been led away from such a course of action.

IV. An appeal was lodged against this decision on 10 February 1992 by the Opponents, and the appeal fee was paid on the same day. A Statement of Grounds of Appeal was submitted on 7 April 1992.

V. The Appellants maintained their novelty objection based on document (1). In this connection, they referred to decision T 666/89 indicating that in examining novelty the disclosure of a document had to be considered in its entirety. Moreover, they raised, for the first time in the appeal proceedings, a novelty objection based on document (2).

They also argued that, if the subject-matter of the claims were novel, it would not involve an inventive step in the light of the combined teaching of documents (4) and (3). In particular, they argued that the test results disclosed in document (4) did not support the proposition the skilled person would have been lead away from preparing p-sulphophenyl carbonates with higher, i.e. $C_6$-$C_{10}$, alkyl groups. Moreover, document (3) clearly described the benefits, in terms of efficient bleaching, of $C_6$-$C_{10}$ alkyl peroxy acid precursors over shorter alkyl chain compounds. Whilst this document was concerned with esters and not carbonates, as claimed in the patent in suit, these classes of compounds were similar enough for the skilled person to consider teachings concerning esters to be applicable to carbonates. They also contended that the claimed sub-

ject-matter lacked inventive step over the disclosure of document (2) as well.

VI. The Respondent denied that the subject-matter of the claims lacked novelty arguing that the claimed compounds represented, with respect to both documents, a small but "purposive" selection from a very broad class of compounds.

He also fully agreed with the reasoning of the Opposition Division regarding inventive step. In this connection, he submitted that esters showed different properties than carbonates did, so that a skilled person would not have considered the teaching of document (3) as being relevant.

VII. In a communication of 13 September 1994 the Board informed the parties that, in their preliminary view, the group of compounds as claimed in Claim 1 of the disputed patent appeared to lack novelty in the light of the disclosure of document (1).

VIII. Oral proceedings, at which the Appellants, as announced by a facsimile of 6 May 1994, were not represented, took place before the Board on 18 October 1994.

IX. At this hearing the Board also objected to Claim 1 for the contracting state AT as it then stood because it did not indicate the measures for the preparation of the compounds in question contrary to Rule 29 (1) and (3) EPC.

In response to this objection the Respondent filed as a main request in the course of the oral proceedings new

claims consisting of a set of Claims 1 to 5 for the contracting states other than AT and a set of Claims 1 to 5 for the contracting state AT.

The claims of this main request only differed from those of the patent in suit in that in Claim 1 for AT the process for the preparation of the compounds was specified by inserting after "n-hexyl":

> ", by reacting the corresponding alkylchloroformate with 4-hydroxybenzene sulphonic acid"

In addition he filed two auxiliary requests.

The first auxiliary request (Auxiliary Request I) only differed from the main request in that in Claim 1 for the states other than AT and also in Claim 1 for AT the range of carbon atoms in the alkyl group of "6 to 10" was restricted to "6 to 8".

The second auxiliary request (Auxiliary Request A) differed from the main request essentially in that in Claim 1 for the states other than AT and in Claim 1 for AT the statement " R is ..... n-hexyl" was replaced by

> "R is n-hexyl, n-octyl, 2-ethylhexyl, 3,5,5-trimethylhexyl or n-decyl group and $M^+$ represents a cation"

and both dependent Claims 2 for AT and for the other designated contracting states were deleted.

The Respondent defended novelty and inventive step for the claimed subject-matter essentially in line with his written submissions. Moreover, in reliance on decision T 666/89 he sought to convince the Board that the legally correct approach for deciding selection novelty is identical or closely similar to that used for determining inventive step. In particular, he put forward the proposition that in cases of overlapping ranges of compounds, a claim to a narrower range as compared with a broader prior range was always selectively novel if it could be demonstrated that the narrow range was inventive over the broader range. In this connection, he filed, in the course of the oral proceedings, a declaration by a Mr. Ploumen comprising a test report showing that the selected compounds as claimed showed an unexpectedly higher bleaching activity compared to closely similar compounds.

X. The Appellants (Opponents) requested, in line with their written submissions, that the decision under appeal be set aside and that the patent be revoked.

The Respondent (Patentee) requested (main request) that the appeal be dismissed and the patent be maintained with the claims submitted in the course of oral proceedings, or with the claims as set out in the auxiliary requests "I" and "A" respectively, also both submitted in the course of oral proceedings.

XI. At the conclusion of the oral proceedings the Board’s decision to allow the appeal was pronounced on the basis of the Respondent's auxiliary request "A".

## Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.

2. *Main request*

2.1 Regarding Claim 1 for the contracting states other than AT of this request, which corresponds to Claim 1 of the disputed patent as granted for the same states, novelty objections were raised on the basis of the disclosures of documents (1) and (2).

2.1.1 Document (1), which concerns state of the art in the sense of Article 54 (3) and (4) EPC for the contracting states designated in the disputed patent save LU, describes a sub-group of compounds of the formula

$$RO\text{-}CO\text{-}OC_6H_4SO_3Na$$

where R represents a $C_1$-$C_{20}$ hydrocarbyl and especially preferred a $C_6$-$C_{15}$ alkyl, and the $NaSO_3$ group on the benzene ring is preferably in the p-position (cf. page 16, line 25, page 4, 2d paragraph, and page 18, lines 1 to 3 and the formula under a) in combination with page 6, lines 26 to 29 and Claim 15). Thus, the question to be answered in examining novelty is whether the selection of the alkyl group as defined in present Claim 1 of the disputed patent, namely $C_6$-$C_{10}$ with the proviso that the $C_6$-alkyl group is n-hexyl, has been made available to the public in the sense of Article 54 EPC, having regard to the disclosure of document (1).

2.1.2 It is established jurisprudence of the Boards of Appeal that a sub-range selected from a broad class of compounds or a broad range of numbers may be novel in

respect of the latter (cf. "Case Law of the Boards of Appeal of the EPO 1987-1992", part C, sections 3.1 and 3.2). In examining novelty in such cases, the Boards of Appeal developed some principles, in particular that it was not sufficient merely for the wording of the definition of the subject-matter as claimed to be different, but that what had to be established was whether the state of the art was such as to make the subject-matter of the invention available to the skilled person in a technical teaching. Moreover, the Boards found that the proper approach was to consider availability in the light of a particular document and that conceptual tools such as difficulties in carrying out prior art teaching in the range of overlap between two ranges or of seriously contemplating applying a technical teaching of a prior art document in the range of overlap were merely helpful tools but not determinant factors in deciding selection novelty. In addition, it has been consistently emphasised by the Boards of Appeal that a sub-range singled out of a larger range is new not by virtue of a newly discovered effect occurring within it, but must be new per se, and that an effect of this kind only permits the interference that the selected sub-range is not an arbitrarily chosen specimen from the prior art.

2.1.3 In the present case, the group of compounds as defined in Claim 1, i.e. containing a $C_6$-$C_{10}$ alkyl group with the proviso that $C_6$ is n-hexyl, forms a relatively large part of the preferred group of compounds having 6 to 15 carbon atoms in the alkyl moiety disclosed in document (1) and, therefore, represents a mere partial copy of the known group of compounds without adding a novel element. Moreover, in the Board's judgment, a person

skilled in the art would, in the light of all the technical facts at his disposal, seriously contemplate applying the technical teaching of this prior art document in the range of overlap. Thus, having regard to these considerations, the Board concludes that the "selected" group of compounds as defined in Claim 1 of the main request lacks novelty pursuant to Article 54(3) and (4) EPC for all the designated contracting states except LU.

2.1.4 In reliance on decision T 666/89 the Respondent sought to convince the Board that the legally correct approach for deciding selection novelty was identical or closely similar to that employed in determining obviousness. In particular, he put forward the proposition that in cases of overlapping ranges of compounds, a claim to a narrower range as compared with a broader prior art range was always selectively novel if it could be demonstrated that the narrow range was inventive over the broader range. However, in the above cited case, the Board repeatedly emphasised that selection novelty was no different from any other type of novelty under Articles 52 and 54 EPC, so that the proper approach was to consider availability in the light of a particular document and that conceptual tools such as difficulties of carrying out prior art teaching in the range of overlap between two ranges or of seriously contemplating applying a technical teaching within the range of overlap were merely helpful tools, and not determinant factors, in deciding selection novelty. Whereas it is undoubtedly true that there can be no selection novelty in a range of overlap where the choice of moving into that overlapping range from the prior art one is obvious, it doesn't either as a matter

of law or as a matter of logic follow that the converse is true, namely that if a choice of a narrower range is inventive, then there must of necessity be selective novelty in it. For the above reasons, the Respondent's argument in this respect cannot be accepted.

2.1.5 Since the Board can only decide on a request in its entirety, the Respondent's request comprising the maintenance of the patent for all the contracting states must fail for these reasons.

3. *Auxiliary Request I*

3.1 The Board has no formal objections with respect to the claims of this auxiliary request. Since this request is refused by the Board for the reasons indicated below, there is no need to give detailed reasons for this finding.

3.2 The subject-matter of Claim 1 for all the designated contracting states except AT according to this request differs from that of the main request in that the definition of R is restricted to a $C_6$-$C_8$ alkyl with the proviso that $C_6$ is n-hexyl. Thus, the question to be answered is whether the now claimed narrower defined group of overlapping compounds as compared with the broader group of compounds disclosed in document (1), in which R is preferably a $C_6$-$C_{15}$ alkyl, is selectively novel.

3.2.1 Document (1) describes, as indicated above, that the preferred p-sulphophenyl alkyl carbonates are compounds having a $C_6$-$C_{15}$ alkyl group, so that the group of

p-sulphophenyl $C_6$-alkyl carbonates is concretely disclosed in this document.

The group of overlapping compounds as defined in Claim 1 of the present auxiliary request, comprising corresponding compounds having a $C_6$-$C_8$ alkyl group excluding the branched $C_6$ alkyl derivatives, therefore, immediately appends to the known group of preferred compounds having $C_6$ moieties.

Moreover, it is the Board's position that a person skilled in the art, having regard to his common general knowledge, would consider those compounds containing the lower alkyl groups of the range of $C_6$-$C_{15}$ alkyl moieties disclosed in document (1) as being the most preferred compounds because of their easier accessibility and their better solubility in water.

In the Board's judgment, in a case where a claimed group of compounds essentially results from omitting those parts of a larger group of compounds which a skilled person would have immediately considered as being less interesting than the rest cannot be selectively novel.

In addition, in the Board's opinion, a skilled person would, having regard to these considerations, seriously contemplate applying the technical teaching of this prior art document in the range of overlap.

3.2.2 Thus, the Board concludes that the subject-matter of Claim 1 of this auxiliary request also lacks novelty in the light of the disclosure of document (1) pursuant to

Article 54 (3) and (4) EPC for all the designated contracting states with the exception of LU.

3.2.3 It follows that the Respondent's auxiliary request I, like his main request, also has to be rejected.

4. *Auxiliary Request A*

4.1 The subject-matters of Claims 1 to 4 of this request for the contracting states other than AT are based on Claims 1, 3, 4 and 5 in combination with page 2, lines 42 and 43, of the patent in suit, and are also supported by Claims 1 to 5 in combination with page 2, last paragraph of the originally filed patent application.

Claim 1 for the contracting state AT is based on the corresponding claim of the disputed patent in combination with page 2, lines 42 to 48 and page 3, lines 31 to 35, of the patent in suit, and also supported by Claims 1 to 5 and page 2, last paragraph as well as page 5, paragraphs 1 and 2, of the patent application as filed.

Thus, all claims of this auxiliary request filed during oral proceedings comply with the requirements of Article 123 EPC.

4.2 Again the first issue to be dealt with is whether the subject-matters of these claims are novel in the light of documents (1) and (2).

4.2.1 The subject-matter of Claim 1 of this request for the contracting states other than AT is further restricted with respect to the corresponding claim of the auxiliary request I to specific compounds where R of the general structural formula is a n-hexyl, n-octyl, 2-ethylhexyl, 3,5,5-trimethylhexyl or n-decyl group.

4.2.2 According to the established case law of the Boards of Appeal a distinction must be drawn between the novelty of a group of compounds defined by a general formula, and the novelty of particular individual compounds, because of the concept of individualisation which only applies to the structural definition of a single compound (cf., for instance, "Case Law of the Boards of Appeal of the EPO 1987-1992", page 33, paragraph 3 to the last but one paragraph). The Boards considered in particular that if the claimed subject-matter concerned a particular compound, whereas the prior art disclosed a family of compounds defined by a general structural formula covering this particular compound but not describing it explicitly, the claimed subject-matter had to be considered novel.

4.2.3 In the present case, after examination of the disclosure of document (1), the Board has reached the conclusion that this document does not describe any one of the particular compounds as claimed. Therefore, having regard to the considerations in the preceding paragraph, the subject-matter of the present Claim 1 and also that of the other claims, including those for the contracting state AT, is novel with respect to document (1).

4.2.4 Furthermore, after examination of the disclosure of document (2), the Board also concludes that document (2) does not disclose any of the now claimed particular compounds either. Thus, for the same reasons as indicated above regarding document (1), the subject-matters of all the claims of this request are also novel with respect to document (2).

5. The remaining issue to be dealt with is whether the subject-matter of the claims involves an inventive step.

5.1 The Board considers document (4) as the closest state of the art. It relates to esters of carbonic acid having the general formula $R_1O\text{-}CO\text{-}OR_2$, wherein each of $R_1$ and $R_2$ is an organic radical, $R_1$ exerting an electron attracting effect (cf. Claim 1). The compounds possess bleaching activating properties and apparently preferred compounds are p-carboxyphenyl alkyl carbonates and p-sulphophenyl alkyl carbonates (cf. column 1, lines 31 to 34, and column 2, lines 6 to 33). The only specified p-sulphophenyl alkyl carbonates are, however, compounds wherein the alkyl group is methyl, ethyl, n-propyl and n-butyl.

The Respondent argued that these prior art bleaching activators provided in combination with conventional bleaching agents, such as percarbonates and perborates, unsatisfactory bleaching action at lower washing temperatures.

5.1.1 The Board sees the technical problem underlying the disputed patent, in the light of the closest state of the art as represented by document (4), in providing

compounds which, as compared with the known p-sulphophenyl alkyl carbonates, are more effective bleaching activators (cf. also page 2, lines 22 to 24, of the specification of the disputed patent).

5.1.2 According to the patent in suit, this technical problem is solved by the provision of the particular p-sulphophenyl alkyl carbonates specified in present Claim 1.

5.1.3 The experimental results of the examples in the disputed patent (cf. the Table on page 5) demonstrate that the particular claimed p-sulphophenyl alkyl carbonates, wherein alkyl is n-hexyl, n-octyl and 2-ethylhexyl, giving an increase in reflectance of 7.0 to 11.4, show an improved bleaching effect at low washing temperatures compared with the corresponding ethyl and butyl compounds mentioned in document (4), which produce an increase of reflectance of 0.6 to 5.8. Thus, having regard to these unchallenged test-results and the fact that the Appellant did not dispute the asserted improved bleaching activity with respect to the non-tested compounds as claimed in Claim 1 of the disputed patent as granted, the Board finds it credible that the technical problem as defined above has been solved. Moreover, the test-report in the declaration of Mr. Ploumen submitted during oral proceedings (cf. in particular the Table in section 7) confirms this finding.

5.1.4 The issue of inventive step hinges on the question of whether there was any incentive in the cited documents for the skilled person to improve the bleaching activity of conventional bleaching systems comprising

bleaching agents and bleaching activators by using the particular claimed carbonates as bleaching activators.

5.1.5 Document (4) relates - as indicated above - to a broad group of bleaching activating compounds, in particular p-carboxyphenyl alkyl carbonates and p-sulphophenyl alkyl carbonates. The only specified p-sulphophenyl alkyl carbonates are the compounds wherein the alkyl means methyl, ethyl, n-propyl and n-butyl. The results of experimental tests demonstrate, that, within this group, the n-butyl derivative showed the lowest increase of reflectance compared with the corresponding ethyl and n-propyl compound (cf. the table in column 4). Therefore, in the Board's judgment, this document does not hold out any prospect that the higher homologues of these compounds would provide an improved activity with respect to the known bleaching activating carbonates and rather leads away from the present invention.

5.1.6 Document (2) also relates to bleaching activating carbonates. It discloses in particular carbonates having the formula R-O-CO-O-R where R is selected from like or dissimilar organic radicals, at least one of such radicals being characterised in that its corresponding alcohol (ROH) has a $Pk_a$ below about 11.7 (cf. column 2, lines 1 to 36). It also discloses a sub-group of compounds where one R is a branched chain aliphatic groups having from 3 to about 10 carbon atoms or an aromatic radical and the other R is an aliphatic or aromatic radical (cf. column 4, lines 27 to 38). An example of such branched aliphatic groups is among many others 2-ethylhexyl (column 3, lines 3 to 7) and in relation to the upper limit of about 10 carbon atoms it

is indicated that higher alkyl containing carbonates often have an insufficient solubility in water (cf. column 3, lines 11 to 16). With respect to the aromatic groups which may be applied it discloses that such groups can be substituted with, for example, halo-, nitro-, sulpho- and alkyl-substituted groups or radicals without any indication of the position of such groups or radicals on the aromatic moieties (cf. column 3, lines 17 to 25). It also describes that in certain instances one of the groups R may also represent a straight chain unsubstituted aliphatic radical including methyl, ethyl, n-propyl, ..... n-hexyl, n-heptyl, n-octyl, etc. (cf. column 3, lines 26 to 34). This document, therefore, discloses an extremely large group of compounds without specifying entities which come structurally close to those as claimed in the patent in suit. Moreover, in the Board's view, having regard to the provided technical information that compounds wherein both groups R are aromatic radicals or aliphatic radicals are preferred and the fact that in the examples only such carbonates are used where both R's of the general formula have the same meaning (cf. column 4, lines 44 to 50; Claims 2 to 7; and the Tables 1 and 5), the skilled person would have been rather lead away from the application of the present compounds as claimed. In any case, in the Board's judgment, this document does not give any pointer to the skilled person to the solution of the existing problem.

5.1.7 Document (3) concerns bleaching activators having the general formula R-CO-L, wherein R is an alkyl group containing from about 5 to about 18 carbon atoms wherein the longest linear alkyl chain extending from

and including the carbonyl carbon contains from about 6 to about 10 carbon atoms and L is a leaving group, the "conjugate" acid of which has a specific $Pk_a$ value (cf. column 5, lines 41 to 53). In particular it discloses that the most preferred bleaching activators have the general structural formula $R\text{-}CO\text{-}O\text{-}C_6H_4\text{-}SO_3^-M^+$, wherein R is a linear alkyl chain containing preferably from about 6 to about 8 carbon atoms and the sulpho group is in the p-position on the benzene ring and M is sodium or potassium (cf. column 7, lines 45 to 55).

Although these compounds disclosed in document (3) concern esters instead of carbonates, the Appellants argued that, because of the close similarity between the carbonates described in document (4) and these particular esters, a person skilled in the art would have expected that the carbonates having a linear alkyl group containing 6 to 8 carbon atoms - like the esters of document (3) - would show optimum bleaching activities. However, the alleged close similarity of these classes of compounds was disputed by the Respondent and was not substantiated by the Appellants who have - according to the established jurisprudence of the Boards of Appeal - the burden of proof. Therefore, the Board cannot accept the Appellants submission in this respect. Moreover, in the Board's judgment, in view of the experimental results in the examples of document (4) demonstrating that the p-sulphophenyl n-butyl carbonate has a lower bleaching activity than the corresponding ethyl and n-propyl compounds, even the combined teaching of documents (3) and (4) does not give any pointer to the skilled person that the present technical problem could be solved by the specific carbonates as claimed.

5.1.8 Finally, document (1) concerns as indicated above state of the art in the sense of Article 54(3) and (4) EPC and is, therefore, not relevant to the examination of inventive step.

5.1.9 In conclusion, the Board finds that the specified carbonates according to Claim 1 involve an inventive step, because it would not have been obvious to the skilled person to solve the above defined technical problem by the use of these particular compounds as bleaching activators.

6. Claim 1 for the contracting state AT, which concerns the preparation of the present carbonates, as well as Claims 2 to 4 for the contracting states other than AT and (the same claims) for AT, which relate to detergent additives and detergent compositions containing the present particular carbonates, represent other embodiments of the same inventive concept in different patent categories and are also allowable.

7. Finally, the Board finds that considering and deciding in substance on the maintenance of the patent on the basis of the present claims as amended during oral proceedings in the absence of the Appellants does not conflict with the decision of the Enlarged Board of Appeal G 4/92 (OJ EPC 1994, 149). According to this decision, a party who fails to appear at oral proceedings must have the opportunity, in accordance with Article 113(1) EPC, to comment on new (and therefore surprising) facts and evidence submitted in these proceedings. In the present case, the Respondent's restrictions to the claims removed objections already raised by the Appellants with

respect to novelty, as well as some formal deficiencies. In such a situation, the Appellants (Opponents) could not have been taken by surprise, because they had reasonably to expect that the Respondent (Patentee) would try to overcome all objections. The submission of auxiliary requests is, clearly, not a "fact" within the meaning of the above decision. Were it otherwise, no decision could ever be issued at the end of a hearing where, as is usually the case, auxiliary requests are filed and, as is also frequently the case, the Opponent does not attend the hearing, thereby rendering such hearings pointless and a waste of time, as well as offending the general principle of legal certainty, i.e. the general interest of the public in the termination of legal disputes ("expedit reipublicae ut sit finis litium").

## 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 with the order to maintain the patent with the claims as submitted during the oral proceedings as auxiliary request A, after corresponding amendments of the description.

The Registrar: The Chairman:

E. Görgmaier A. Jahn