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D E C I S I O N
of 21 September 1995

Case Number: T 0514/92 - 3.2.2

Application Number: 85305391.6

Publication Number: 0170512

IPC: A61B 17/08

Language of the proceedings: EN

Title of invention:
Coated surgical staple

Patentee:
ETHICON INC.

Opponent:
United States Surgical Corporation

Headword:
-

Relevant legal provisions:
EPC Art. 52(1), 100, 112(1)(a)

Keyword:
"New ground for opposition introduced during the appeal proceedings"
"Referral to the Enlarged Board of Appeal"

Decisions cited:
G 0010/91, T 0937/91 (Ref. No. G 0001/95), T 0796/90,
T 0646/91, T 0018/93



Case Number: T 0514/92 - 3.2.2

D E C I S I O N
of the Technical Board of Appeal 3.2.2
of 21 September 1995

Appellant: United States Surgical Corporation
(Opponent) 150 Glover Avenue
Norwalk, Connecticut 06856 (US)

Representative: Marsh, Roy David
Hoffmann Eitle & Partner
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Respondent: ETHICON INC.
(Proprietor of the patent) U. S. Route 22
Somerville
New Jersey 08876 (US)

Representative: Jones, Alan John
CARPMAELS & RANSFORD
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office dated 2 April 1992
rejecting the opposition filed against European
patent No. 0 170 512 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: H. J. Seidenschwarz
Members: P. W. Dropmann
J. H. van Moer

Summary of Facts and Submissions

- I. According to the "Notice of Opposition against a European patent" dated 16 July 1990, the opposition filed against European patent No. 0 170 512 as a whole was based on the **grounds** that the subject-matter of the European patent opposed was not patentable (Art. 100(a) EPC) because it did not involve an inventive step (Art. 52(1); 56 EPC) and the patent opposed did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 100(b) EPC; see Art. 83 EPC).
- II. The Opposition Division issued on 2 April 1992 a decision rejecting the opposition in accordance with Article 102(2) EPC considering the grounds of opposition did not prejudice maintenance of the patent.
- III. The Appellant (Opponent) duly filed an appeal requesting reversal of the decision and revocation of the patent. The fee for appeal was paid and the Statement of Grounds was filed in due time.
- IV. In its letter of 17 December 1993 the Appellant raised an objection of lack of novelty (Art. 52(1); 54 EPC) for the first time and filed four new documents.
- V. The Respondent (Patentee) considered the new objection to be a new and inadmissible ground of opposition since it was raised three years after the end of the Opposition period and since it was based on document EP-A-0 092 383 (D4) which was in the proceedings from the beginning. Therefore, it requested that the Board of Appeal excluded this ground from the appeal proceedings (see letter of 2 November 1994, point 5).

- VI. The Appellant replied (see letter of 13 January 1995) that it all depended on what constitutes a "new" ground and that the starting point (document D4) had not changed and therefore the ground was not new. New documents were only used to clarify what was meant by the statement on page 2 (lines 11 to 14) of document D4.
- VII. In a communication of 23 February 1995 the Board of Appeal considering the interlocutory decision T 937/91 (to be published, referral: OJ EPO 1995, 171) according to which the question whether introduction, during appeal proceedings, of an opposition ground under Article 52(2) EPC, when the opposition had been based on Articles 54 and 56 EPC was allowable, had been referred to the Enlarged Board (ref. no. G 1/95), deemed it necessary not to proceed further until the Enlarged Board had issued a decision on case T 937/91.
- VIII. By letter of 10 March 1995, the Respondent requested two supplementary questions be put to the Enlarged Board so all three questions could be addressed simultaneously.
- IX. In response to the communication of the Board of Appeal, the Appellant referred in his letter of 12 April 1995 to the decision T 796/90, in particular to point 2.1 of the reasons of this decision. According to the Appellant, document D4 on which the new attack concerning lack of novelty has been based, was in the proceedings from the beginning of the opposition procedure, and was the basis of a ground of opposition within the meaning of Article 100(a) EPC. Therefore, the present case differed from the cases dealt with in the decisions T 937/91 and T 796/90.
- X. By a communication of 27 June 1995 the Board of Appeal considered it appropriate to put the second proposed question including an addition to the Enlarged Board.

- XI. The parties agreed that the proceedings in the present case should be stayed until the question had been answered by the Enlarged Board.

Reasons for the Decision

1. In the opinion G 10/91 (OJ EPO 1993, 420) the Enlarged Board ruled that a new ground for opposition may, **in principle**, not be introduced at the appeal stage and that fresh grounds for opposition may be considered in appeal proceedings only with the approval of the patentee.

The concept of "**grounds for opposition**" was, however, not further elaborated.

2. Decision T 937/91 has given in this respect two possible interpretations (see reasons for the decision: points 3 to 7).

A broad interpretation would imply that Articles 52 to 57 EPC can be considered as being a single ground for opposition.

According to decisions of Boards of Appeal (e.g. T 796/90, point 2.1; T 18/93, point 3.2 and T 646/91, point 3), an objection against novelty as well as an objection against inventive step fall under the **ground** for opposition pursuant to Article 100(a) EPC.

A narrow interpretation of this concept could lead, in the present case, to the situation that the Board would have to decide on inventiveness of the subject-matter of Claim 1 without having first decided on whether the subject-matter is novel or not.

3. The Notice of Opposition itself, under heading VI, does not make an unambiguous classification of the grounds for opposition.
4. This Board therefore considers the definition of the legal concept "**grounds for opposition**" to be an important point of law (Art. 112(1) EPC) justifying reference to the Enlarged Board.

Order

For these reasons it is decided that:

The following question of law is referred to the Enlarged Board of Appeal under Article 112(1)(a) EPC:

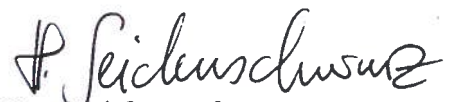
"In the case where a patent has been opposed under Article 100(a) EPC, on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the Opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a Board of Appeal exclude the new allegation because it introduces a new ground of opposition?"

The Registrar:



S. Fabiani

The Chairman:



H. Seidenschwarz