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D E C I S I O N
of 13 April 1994

Case Number: T 0867/92 - 3.5.2

Application Number: 85304218.2

Publication Number: 0168962

IPC: G11B 5/72

Language of the proceedings: EN

Title of invention:
Magnetic recording medium

Patentee:
Konica Corporation

Opponent:
01) N.V. Philips' Gloeilampenfabrieken
02) Agfa-Gevaert AG
03) Fuji Photo Film Co., Ltd.

Headword:
Late citation, risk of costs/KONICA

Relevant legal norms:
EPC Art. 104(1), 111(1), 114(2)

Keyword:
"New prior art cited with considerable delay after claims had been amended - considered relevant"
"Oral proceedings could not bring case to an end because of late citation"
"Remittal of case to Opposition Division"
"Apportionment of costs"

Decisions cited:
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Headnote:

The EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, an opponent who cites new prior art with a considerable delay (in the present case some 18 months after the claims had been amended) with no special reason justifying the delay, runs the risk of having to bear some or all of the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation.



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Boards of Appeal

Chambres de recours

Case Number: T 0867/92 - 3.5.2

D E C I S I O N
of the Technical Board of Appeal 3.5.2
of 13 April 1994

Other party:
(Opponent 01)

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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office dated 27 July 1992
concerning maintenance of European patent
No. 0 168 962 in amended form.

Composition of the Board:

Chairman: R.E. Persson
Members: W.J.L. Wheeler
A.G. Hagenbucher

Summary of Facts and Submissions

I. The Appellant (Opponent III) lodged an appeal against the interlocutory decision of the Opposition Division that account being taken of the amendments made during the opposition proceedings, European Patent No. 0 168 962 and the invention to which it related met the requirements of the EPC.

II. Claim 1 as decided on by the Opposition Division reads as follows:

"1. A magnetic recording medium comprising a support, a magnetic recording layer and optionally a back-coating layer, at least one of said magnetic recording layer and said back-coating layer containing a urethane resin characterised in that the urethane resin has a yield point which is in the stress range of from 50 kg/cm² to 600 kg/cm² (4900 to 58840 kPa), said magnetic recording layer and/or said back-coating layer contains at least one of a vinyl chloride copolymer and a phenoxy resin, and said magnetic recording layer contains a magnetic particle having a specific surface area in terms of BET value of 30 m²/g or higher."

III. In the notice of appeal the Appellant requested revocation of the patent and also made an unconditional request for oral proceedings. In the Statement of Grounds of Appeal the Appellant cited a new prior art document,

D14: EP-A-0 112 925 (corresponding to WO 84/00241, which was published on 19 January 1984),

and argued, *inter alia*, that the subject-matter of Claim 1 of the amended patent lacked novelty in view of

Example 10 described in D14. The Appellant had conducted tests and found that the polyurethane resin N-3022 used in Example 10 had a yield point of 80 kg/cm².

IV. In written reply, the Respondent requested that the case be remitted to the Opposition Division to consider the new matter, and also requested an award of costs, citing the decision in case T 611/90 (OJ EPO, 1993, 50). Regarding the Appellant's tests, the Respondent argued that there was no proof that the sample of the resin N-3022 used in the Appellant's tests was identical to the material referred to in Example 10 of D14, since the composition of commercial products may change over the years.

V. The Appellant filed a certificate (in Japanese) issued by the manufacturer of the resin N-3022 and an English translation thereof. In the translation, the yield point for Nippollan 3022 is given as 95 kgf/cm². At the end of the translation, it is stated: "I confirm that our product has not been altered since the beginning of its manufacture."

VI. In oral proceedings held on 13 April 1994, the Respondent argued that if D14 was to be considered the case should be remitted to the Opposition Division. The primary purpose of the appeal procedure was to review decisions of the first instance and so far the first instance had taken no decision regarding D14. The Respondent criticised the translation of the Japanese certificate, submitting that the last sentence should have said: "... the composition of our product has been the same ..." and arguing that the properties of a resin depended not only on its composition but also on the way in which it had been processed during manufacture. According to the translation, the properties given in the certificate were described as representative. This

indicated that they were subject to variation. The value of the yield point given in the certificate (95) differed significantly from that found by the Appellant's tests (80). There was sufficient doubt for the Board not to be able to decide immediately.

- VII. Regarding the value of the yield point of the resin N-3022, the Appellant replied that both the values 80 and 95 were within the range specified in the claim and argued that it was unlikely that the yield point had gone outside that range.
- VIII. Regarding costs, the Appellant pointed out that the claims had been amended and argued that an opponent must be able to cite new documents in such circumstances. The Appellant would prefer the Board to deal with everything itself. The Respondent accepted that it was reasonable for an opponent to cite new documents after an amendment of the claims in which a feature not previously mentioned in any claim had been taken from the description, but did not see why this should be allowed more than nine months (the time limit for filing an opposition) after the amendment had been made. The Respondent's representative had had to prepare himself for the hearing, not only to the extent necessary for arguing for remittal of the case to the Opposition Division, but more thoroughly, so as to have been able, if necessary, to defend the patent in the hearing against attacks based on D14.
- IX. The Appellant requested that the decision under appeal be set aside and that the patent be revoked.
- X. The Respondent requested that the appeal be dismissed (main request), or, if the Board admitted D14 into the proceedings, that the case be remitted to the Opposition

Division for further prosecution (auxiliary request),
with an award of costs.

Reasons for the Decision

1. The appeal is admissible.
2. In the Board's opinion, the direction the present appeal takes depends first of all on whether the new citation D14 is of such limited relevance that it could be disregarded, since, if D14 were not of sufficient relevance to deserve consideration, the appeal could follow the "normal" course of reviewing the decision of the Opposition Division.
 - 2.1 D14 discloses a magnetic recording tape (Example 10 on pages 14 and 15, which is stated to have been prepared in a manner similar to Example 1, whose manner of preparation is described on page 12) which appears to be in accordance with Claim 1 of the patent in suit as amended before the Opposition Division if the polyurethane resin N-3022 has a yield point in the range of 50 to 600 kg/cm². D14 does not mention that the resin N-3022 has a yield point. The Appellant has filed some test results and a certificate issued by the manufacturer of the resin, which indicate that the resin has a yield point and that its value may be around 80 or 95 kg/cm². It does not seem to be disputed that the resin has a yield point, although there is some doubt as to the exact value, or range of values, of the yield point of the resin N-3022. In the opinion of the Board, it is doubtful whether the patent in suit could be maintained with the present Claim 1, if D14 is taken into account. The Board therefore considers that D14 should not be disregarded.

3. Although, in the interests of procedural expediency, the Board would have been prepared to consider and decide on all aspects of the case itself without remitting it to the Opposition Division, if, as sometimes happens, both parties had been in favour of this, the Respondent has maintained the request for remittal in order to have the new case arising from the citation of D14 considered by two instances. The Board agrees with the Respondent that the circumstances of the present case are such that the Respondent should not be denied the opportunity of being heard twice, especially as the doubts concerning the value of the yield point of the resin N-3022 still have to be resolved. The case should therefore be remitted to the Opposition Division for further prosecution.

4. Regarding the question of costs, the Board notes that the claims of the patent in suit were last amended in May 1991, over a year before the date of the oral proceedings held before the Opposition Division. Although it is in general reasonable for an opponent who, as in the present case, has raised an objection of lack of novelty and/or lack of an inventive step in the notice of opposition, to cite new material in response to a substantial amendment of the claims, especially when, as in the present case, a feature has been taken into Claim 1 from the description, the delay in doing so was considerable and even exceeded the time limit for filing an opposition. There is no suggestion that the Appellant deliberately withheld D14 for tactical reasons, which would amount to an abuse of the procedure, but nevertheless it is true that if D14 had been cited within, say, nine months of the amendment, it could have been considered by the Opposition Division.
 - 4.1 The EPC does not impose a time limit for citing new prior art in response to an amendment of the claims. However, in the opinion of the Board, an opponent who

cites new prior art with a considerable delay (in the present case some 18 months after the claims had been amended) with no special reason justifying the delay, runs the risk of having to bear some or all of the proprietor's costs incurred in attending oral proceedings which cannot bring the case to an end because of the new citation.

- 4.2 Furthermore, it was the Appellant's unconditional request for oral proceedings which made such proceedings before the Board unavoidable. The fact that it was the Respondent and not the Appellant who requested remittal of the case to the Opposition Division is not material. The Respondent cannot be expected to forgo the chance to be heard twice just in order to save the Appellant costs. However, as there is no suggestion that the Appellant wilfully abused the procedure in the present case, the Board considers that the Appellant should not have to pay all the costs incurred by the Respondent's representative in attending the oral proceedings held before the Board, but that it would be equitable to order the Appellant to pay half those costs.

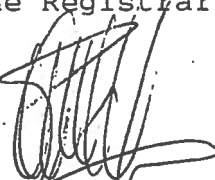
Order

For these reasons, it is decided that:

1. The decision of the Opposition Division is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

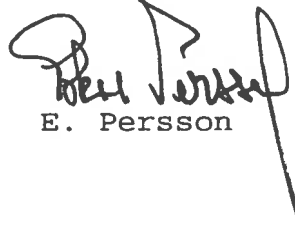
3. The Appellant shall bear 50% of the costs of the Respondent's representative incurred in attending the oral proceedings held before the Board on 13 April 1994.

The Registrar:



M. Kiehl

The Chairman:



E. Persson



