

Decision of Technical Board of Appeal 3.4.1 dated 6 December 1996

T 433/93 - 3.4.1

(Language of the proceedings)

Composition of the board:

Chairman: G. D. Paterson

Members: R. K. Shukla

Y. J. F. van Henden

Patent proprietor/Appellant: ATOTECH UK LIMITED

Opponent/Respondent: Isola Werke AG

Headword: Rehearing/ATOTECH

Article: 100(a), 100(b), 113(1) EPC

Rule: 67 EPC

**Keyword: "Opposition substantiated on ground of lack of inventive step" -
"New ground of lack of novelty introduced by opposition division during oral
proceedings" - "Patent revoked by opposition division on grounds of lack of
novelty and insufficiency (Article 100(b) EPC)" - "No opportunity for proprietor
to comment on ground of insufficiency" - "Substantial procedural violation" -
"Remittal to department of first instance for rehearing before different
composition of opposition division"**

Headnote

I. If an opposition division wishes to introduce a new ground of opposition into the proceedings in addition to the ground(s) substantiated in the notice of opposition, either of its own motion or upon request by an opponent, the patent proprietor must be informed (normally in writing) not only of the new ground of opposition (ie the new legal basis for the opposition), but also of the essential legal and factual reasons (ie its substantiation) which could lead to a finding of invalidity and revocation. Thereafter the patent proprietor must have a proper opportunity to present comments in reply to the new ground and its substantiation.

II. Following a substantial procedural violation in connection with a decision issued by a first instance department, at the request of a party, such decision has to be set aside. If a party has reasonable grounds to suspect that the same composition of opposition division would be tainted by the previous decision and therefore partial, at the request of that party the case should be reheard before a different composition of opposition division.

Summary of facts and submissions

I. An opposition was filed against European patent No. 0 198 835. The notice of opposition stated that the patent was opposed to its full extent, on the single ground that the subject-matter of the patent is not patentable (Article 100(a) EPC) because of lack of inventive step (Article 52(1): 56 EPC), having regard to documents D1 and D2. Oral proceedings were requested by the opponent on an auxiliary basis. During the written procedure before the opposition division, documents D3, D4 and D5 were filed by the opponent in further substantiation of the opposition, and the meaning of the claimed feature concerning "destruction of adhesion" between a press plate and a first copper layer was discussed between the parties.

In a communication accompanying a summons to oral proceedings, the opposition division stated in particular that the meaning of "destruction of adhesion" would be the subject of discussion at the oral proceedings.

II. During the oral proceedings before the opposition division, on 25 November 1992 the proprietor requested maintenance of the patent as granted as his main request including process claims 1 to 7 and product claims 8 to 10, and requested maintenance of the patent in amended form with product claims 8 to 10 deleted, as his auxiliary request.

According to the minutes of the oral proceedings before the opposition division, the ground of lack of novelty of claim 8 of the patent in view of document D2 was raised by the opposition division during the oral proceedings, and was thus introduced into the proceedings, and oral submissions in respect of this new ground were subsequently made by the representatives of both parties -in addition to submissions on behalf of both parties with respect to the ground of lack of inventive step. The feature of overcoming the adhesion between the press plate and the first copper layer was discussed by the parties and the opposition division during the oral proceedings in the context of lack of novelty and lack of inventive step, but the minutes contain no indication that the ground of insufficiency (Article 100(b) EPC) was either mentioned or raised or introduced into the proceedings.

The minutes state that at the conclusion of the oral proceedings, the decision was announced that the patent was revoked. The minutes end with brief grounds for the decision, namely that "The invention as claimed in claim 1 does not include all the features necessary for producing (i) a micropore-free first copper layer, and (ii) the destruction of adhesion effect."

III. The written decision of the opposition division is dated 25 February 1993. Claim 8 was held to lack novelty in view of document D2. As regards claim 1, the decision

states that the subject-matter of this claim differs from the state of the art only in the "destruction of adhesion" effect, and held that this effect is not known or indicated in the cited state of the art.

The decision goes on to state that it is not clear to the opposition division which feature(s) of the process cause the destruction of adhesion, and that it is not clear that claim 1 includes all the necessary features to obtain (a) the pinhole-free layer, (b) the effect of the destruction of adhesion. On this basis, it was held that the disclosure of the invention was insufficient (Article 100(b) EPC), and both the main and auxiliary requests were therefore not allowable.

IV. The proprietor duly filed an appeal against this decision. In the statement of grounds of appeal it was contended that the description and claims of the patent taken as a whole do give sufficient instructions to enable the invention to be carried out, and furthermore that the appeal fee should be refunded in view of the substantial procedural violation by the opposition division in issuing its decision revoking the patent on the ground of insufficiency without giving the proprietor an opportunity to consider and to comment on this ground, or to respond to it, contrary to Article 113(1) EPC.

In reply, the opponent requested that the appeal should be dismissed, or alternatively that the case should be remitted to the opposition division for consideration of the substantiated ground of opposition of lack of inventive step, which ground had not been dealt with in the opposition division's decision.

In a communication on behalf of the board, it was explained that the appeal had been examined on a preliminary, primarily procedural basis, and that it seemed clear from the file record that the ground of insufficiency (Article 100(b) EPC) was never specifically raised by the opponent or by the opposition division during the proceedings before the opposition division. However, although the only ground of

opposition which was raised and substantiated in the notice of opposition was that of lack of inventive step, the patent had been revoked on the grounds of lack of novelty and insufficiency (lack of novelty having been discussed during the oral proceedings in addition to lack of inventive step). The board expressed the preliminary opinion that since the proprietor had not been given an opportunity to comment upon the ground of insufficiency prior to issue of the decision, it appeared that the issue of the decision was contrary to Article 113(1) EPC, and that a substantial procedural violation had occurred. The communication stated that "if the case is remitted to the first instance, the Board would set aside the decision of the opposition division, and could either order the opposition division to consider the further submissions of both parties on both lack of inventive step and insufficiency (if necessary with further oral proceedings) before issuing a further decision, or it could order that the case be reheard before a different composition of opposition division. Either of these courses would involve considerable delay. Alternatively, the board could examine and decide the issues of novelty, inventive step and insufficiency itself, but this would deprive the opponent of a first instance decision on inventive step, and would also deprive the proprietor of a fair hearing before a first instance in relation to the ground of insufficiency." Both parties were asked to indicate their preferred future course for the proceedings.

In reply, the opponent requested that the board of appeal should proceed to decide the issues of novelty, inventive step and insufficiency, after appointing oral proceedings.

Also in reply, the proprietor noted the board's preliminary opinion set out above, and that this did not appear to be disputed by the opponent, and submitted that any decision of the board should remedy the substantial procedural violation.

He agreed with the board of appeal that if the board proceeded to decide the issues of novelty, inventive step and insufficiency, this would deprive the proprietor of a fair

hearing before a first instance in relation to the ground of insufficiency, and consequently he stated his preference that the case should be remitted to an opposition division of different composition, for reconsideration of all submissions made so far in connection with the above three grounds of novelty, inventive step and insufficiency.

Reasons for the decision

1. The ground of "insufficiency" (Article 100(b) EPC) was neither alleged nor substantiated in the notice of opposition (paragraph I above), and there is nothing in the file record of this case to suggest that it was specifically raised and introduced into the opposition during the oral proceedings by the opposition division (paragraph II above). The above facts appear not to be in dispute between the parties (paragraph IV above).

Consequently, the first time that the proprietor was made aware that insufficiency was being raised as a ground of opposition to the patent was upon receipt of the decision of the opposition division in which the patent was revoked on this ground. It necessarily follows that the issue of this decision was directly contrary to the requirement of Article 113(1) EPC, which states that "The decisions of the European Patent Office may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments".

As stated in decision T 951/92 (OJ EPO 1996, 53), this provision "has been recognised in a number of previous board of appeal decisions as being of fundamental importance for ensuring a fair procedure between the EPO and parties conducting proceedings before it (see in particular opinion G 4/92, OJ EPO 1994, 149, decision J 20/85, OJ EPO 1987, 102, and decision J 3/90, OJ EPO 1991, 550), and reflects the generally recognised principle of procedural law that a party to proceedings has "a right to be heard" before a decision is issued".

Furthermore, this decision states that "the term 'grounds or evidence' in Article 113(1) EPC should not be narrowly interpreted. In particular, in the context of examination procedure the word 'grounds' does not refer merely to a ground of objection to the application in the narrow sense of a requirement of the EPC which is considered not to be met. The word 'grounds' should rather be interpreted as referring to the essential reasoning, both legal and factual, which leads to refusal of the application. In other words, before a decision is issued an applicant must be informed of the case which he has to meet, and must have an opportunity of meeting it".

This interpretation of Article 113(1) EPC is equally applicable in the context of opposition proceedings.

In a case such as the present, in order to satisfy Article 113(1) EPC, before issuing the decision it would have been necessary to inform the proprietor not only of the new ground of opposition being raised and introduced into the proceedings (ie Article 100(b) EPC), this being the legal basis on which the patent was being challenged (see decisions G 1 and 7/95, OJ EPO 1996, 615, 626), but also of the essential legal and factual reasons which could lead to a finding of invalidity and revocation. Thereafter it would have been necessary to ensure that the proprietor had a proper opportunity to present comments in reply to this new ground.

In the proceedings before the opposition division in the present case, the board is satisfied that Article 113(1) EPC was violated, and that a substantial procedural violation occurred, which justifies setting aside the decision of the opposition division.

2. The further matter to be decided is the future course of these proceedings. As set out in paragraph IV above, the parties have expressed different views on this.

In the board's view, when deciding the future course of these proceedings, the most important factor to be taken into account is the fact that the proprietor has not had a fair hearing before a first instance in relation to the ground of insufficiency prior to the issue of a decision purporting to revoke the patent on this ground. All parties to opposition proceedings are entitled as a matter of legal right to a fair hearing before each of two instances, before the case is finally decided against such a party.

On this basis, it follows in the first place that the decision of the opposition division should be set aside, and that the case should be remitted to the first instance for rehearing (as requested by the proprietor) and should not be decided by the board of appeal (as requested by the opponent).

Furthermore, in the second place, in the board's view it also necessarily follows that following such remittal to the first instance, the case should be examined and decided by a different composition of opposition division (that is, by a composition of three new members), in relation to the three grounds of opposition (novelty, inventive step (Article 100(a) EPC) and sufficiency (Article 100(b) EPC) that have been raised and introduced into the proceedings.

If the case was to be heard further and re-decided by the same composition of opposition division, the members of the opposition division would have to attempt to put out of their minds the result of the previous decision that they issued, before rehearing and re-deciding the case.

If a party is to receive a fair hearing before a tribunal, such a party should have no reasonable ground (on an objective basis) to **suspect** that any member of the tribunal is partial or prejudiced in relation to deciding the case. As stated by the Enlarged Board of Appeal in decision G 5/91 (OJ EPO 1992, 617), "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". The Enlarged Board

held that this principle applies to "employees of the departments of first instance of the EPO taking part in decision-making activities affecting the rights of any party".

Thus, in a case such as the present, the important point is not whether the file record shows any previous evidence of actual partiality by the members of the opposition division during the previous conduct of the case (see decision T 261/88, 16 February 1993), nor whether the present members of the opposition division would in fact be unprejudiced or impartial if they reheard the case, but whether a party (in this case the proprietor) would have reasonable ground to suspect that they would not receive a fair hearing if the case was reheard before the same composition of opposition division (whether because of possible prejudice as to how the case should be decided, or because of possible partiality, or otherwise).

In the present case, since the opposition division has already issued a written decision containing reasons for revoking the patent, in the board's judgment the proprietor has reasonable grounds to suspect that the same composition of opposition division would have difficulty in rehearing and deciding the case without being tainted by its previous decision (as reflected by the proprietor's request for rehearing before a different composition). It is therefore clearly in the interest of the proper administration of justice within the EPO that this case should be reheard and re-decided by a different composition of opposition division.

3. According to opinion G 10/91 (OJ EPO 1993, 408, 420), an opposition division has the power under Article 114 EPC to introduce a new ground of opposition into the opposition proceedings after the nine-months period for filing a notice of opposition has expired, either upon request by an opponent or of its own motion," in cases where, prima facie, there are clear reasons to believe that such grounds are relevant and would in whole or in part prejudice the maintenance of the European patent".

In the board's view, in all normal cases, if an opposition division decides to introduce a new ground of opposition into the proceedings in addition to the ground(s) of opposition which the opponent has raised and substantiated in the notice of opposition, this should be done in writing as early as possible in the proceedings. The written notification to the patent proprietor from the opposition division which informs the proprietor that a new ground of opposition will be introduced into the proceedings should at the same time ensure that the proprietor is informed not only of the new ground or legal basis (eg insufficiency under Article 100(b) EPC), but also of the legal and factual reasons which would in effect substantiate the new ground, so that the proprietor is fully informed of the case which he has to meet, and has a proper opportunity to present comments in reply.

If in a very exceptional case, an opposition division decides for the first time during oral proceedings that a new ground of opposition should be introduced into the proceedings, in the board's view it would in principle be appropriate that, even during oral proceedings, the opposition division should notify the proprietor in writing both of the introduction of the new ground and of the legal and factual reasons which substantiate such new ground. In this way possible misunderstandings would be avoided, and the notification would be part of the written file record of the case.

4. The appeal of the proprietor is allowed, and the appeal fee shall be refunded to the proprietor pursuant to Rule 67 EPC.

5. In the notice of appeal, the proprietor requested that the decision of the opposition division be amended so that the patent is maintained with claims 1 to 7 only.

However, since the decision of the opposition division will be set aside, the requests of the proprietor as set out in paragraph II above still stand. Any different requests which the proprietor wishes to make should be filed during the further proceedings before the new composition of opposition division.

Order

For these reasons it is decided that:

1. The decision of the opposition division is set aside and the appeal is allowed.

2. The case is remitted to the opposition division with an order that the grounds of opposition of lack of novelty and lack of inventive step (Article 100(a) EPC) and of insufficient disclosure (Article 100(b) EPC) be examined by a different composition of opposition division.

3. The appeal fee shall be refunded to the proprietor pursuant to Rule 67 EPC.