

## **DECISIONS OF THE BOARDS OF APPEAL**

### **Decision of Technical Board of Appeal 3.3.3 dated 15 July 1997**

**T 97/94 - 3.3.3\***

(Translation)

Composition of the board:

Chairman: C. Gérardin

Members: B. ter Laan

J.A. Stephens-Ofner

**Patent proprietor/appellant: CECA S.A.**

**Opponent/respondent: (01) Bayer AG**

**(02) Grace GmbH**

**Headword: Procedural timetable/CECA**

**Article: 54, 114(2), 117(1)(d) EPC**

**Rule: 71a(1), 72(1), 72(2) EPC**

**Keyword: "Late designation of witnesses - request for hearing refused" -**

**"Public prior use (no) - insufficient probative value of evidence submitted -**

**missing links in the chain of evidence submitted"**

*Headnote*

*I. If, in accordance with decision G 6/95, Rule 71a(1) EPC is not binding on the boards of appeal in the sense that it gives them full scope in the preparation of oral proceedings, it is nevertheless binding on the parties. Thus, when a board of appeal decides to send the parties a communication under Rule 71a(1) EPC, the latter are obliged to comply with it, in particular as far as the final date for reply is concerned (reasons, 3.5.1).*

*II. If an attorney is replaced at a late stage in the proceedings for reasons other than force majeure, the new representative is obliged to continue the proceedings from the stage they had reached when he took over from his predecessor. This change may not be used by a party, in the present instance a respondent/opponent, as an opportunity to adopt a new defence strategy based on a hearing of witnesses which was unforeseeable in the light of the arguments and requests previously submitted (reasons, 3.5.3).*

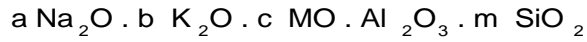
*III. Where public prior use is cited, the assessment of probability which normally underlies the boards' opinion must cede to a stricter criterion close to absolute conviction. In other words, there should be a degree of certainty which is beyond all reasonable doubt (reasons, 5.1).*

### **Summary of facts and submissions**

I. European patent application No. 86 402 042.5, filed on 18 September 1986 and claiming priority of 20 September 1985 by virtue of an earlier filing in France (FR 8513951), led on 3 January 1990 to the grant of European patent No. 0 239 706 on the basis of six claims, of which independent claims 1 and 4 read as follows:

"1. Method of preparation of polyurethanes free from gaseous inclusion, by mixing two components capable of being stored separately without major change in reactivity, the component including the hydroxylated reactant containing a

dehydrating agent consisting of a zeolite, characterised in that the zeolite, in its anhydrous form, corresponds to the general formula:



where b is a number between 0.1 and 0.5,

c is a number between 0.1 and 0.5;

where a is a number such that

$$a + b + c = 1;$$

where m is a number between 1.35 and 2.35;

where M denotes calcium or magnesium."

"4. Storage-stable component, for polyurethanes free from gaseous inclusion, consisting of at least one polyhydroxylated organic reactant and a zeolite, characterised in that the zeolite, in its anhydrous form, corresponds to the general formula:



where b is a number between 0.1 and 0.5,

c is a number between 0.1 and 0.5;

where a is a number such that

$$a + b + c = 1;$$

where m is a number between 1.35 and 2.35;

where M denotes calcium or magnesium."

Claims 2 and 3 are dependent claims relating to particular embodiments of the method according to claim 1.

Claims 5 and 6 are dependent claims relating to preferred components of the component for polyurethane according to claim 4.

II. On 2 October 1990, oppositions were filed by Bayer (opponent 1) and Grace (opponent 2) against the above-mentioned European patent, in which the patent's revocation was requested for the reasons given in Article 100(a) EPC.

(i) The objections of lack of novelty, on the grounds of public prior use, and lack of an inventive step were based on the following documents in particular:

...

III. By a decision notified on 7 December 1993, the opposition division revoked the patent on the grounds that the subject-matter of all the claims lacked novelty.

It was considered as established

...

(v) that, as a consequence, the invention as claimed in the patent in suit must be considered as having been in the public domain before the date of priority.

IV. On 1 February 1994, the appellant (patent proprietor) lodged an appeal against this decision and paid the prescribed fee. The arguments submitted in the statement of grounds of appeal filed on 21 March 1994, and in a reply received later, emphasised the difference between the compositions described in the commercial brochures and the analysis reports produced by the opponents.

...

V. In its replies of 2 August 1994 and 21 February 1995, respondent 1 (opponent 1) asserted that

(i) the "Zeolith L" product, specifically developed as a dehydrating agent for two-component polyurethane compositions, had originally been of the Na-K type, but from 1975 onwards had also contained calcium ions. The composition of this product, which had been on the market in the form of both a powder and a paste, had not changed between 1975 and 1986. Documents B1 to B3 and the various affidavits produced before the department of first instance clearly showed that the name "Baylith L", used from 1980 onwards, did not in fact relate to a new formulation,

(ii) the lack of any reference to calcium in documents C1 to C3 could not be interpreted as meaning that this element was not contained in the product itself. C1 to C3 were technical information leaflets destined for users traditionally more interested in the properties and fields of use of materials than in their precise nature,

...

VI. The summons to oral proceedings on 15 July 1997 was sent to the parties on 13 February 1997. It was followed by a communication dated 18 March 1997 in which the board defined the standards which it intended to apply when judging the validity of the objection concerning prior use, and referred to decision T 472/92 of 20 November 1996 (to be published in OJ EPO).

As for the organisation of the oral proceedings, the board explicitly invited the representatives of the various parties to inform the board and the other parties, at least one month in advance of the date of the proceedings, if they intended to be accompanied or assisted by other persons.

VII. In a letter of 10 June 1997, the appellant provided the names of its two representatives. Respondent 2, which had not responded in substance to the statement of grounds (letter of 19 July 1994 - request for extension of the period for reply; letter of 6 June 1995 - conditional request for oral proceedings) also provided the name of its representative in a letter dated 9 June 1997.

In a letter of 30 June 1997, respondent 1 said that it intended to hear witnesses at the oral proceedings and communicated the identity of these witnesses to the board on 7 July 1997:

...

VIII. Following a letter from the appellant dated 9 July 1997 protesting against the late designation of witnesses, the representative of respondent 1 on the same day justified not keeping to the procedural timetable fixed by the board by referring to Rule 71a(1) EPC, quoting decision G 6/95 (OJ EPO 1996, 649) and asserting that he had only just been appointed by Bayer to represent them at the hearing.

IX. At the beginning of the oral proceedings the appellant asked by way of a preliminary request that any statements by persons apparently accompanying the representatives of respondent 1 as witnesses should not be accepted. ...

For their part, the respondents first of all presented various arguments to justify the late designation of the witnesses and their presence (respondent 1), and then suggested that the oral proceedings be postponed in order to permit a formal hearing of these witnesses (respondent 2). As to the merits, they sought in particular to establish that there was an unbroken chain of evidence relating to (i) the nature of the Zeolith L/Baylith L product, (ii) the correspondence between the analysed product and the marketed product, and (iii) the correspondence between the product delivered and the product used in the preparation of polyurethanes. To this end,

respondent 1 submitted original despatch note No. A109/094818H31 (document B3, annex 3a).

X. The appellant requested that the impugned decision be set aside and the patent maintained without amendment.

The respondents requested that the appeal be rejected.

### **Reasons for the decision**

1. The appeal is admissible.

#### *Late designation of witnesses*

2. It is common in both ex parte and inter partes proceedings for a party to have recourse to oral proceedings to develop arguments which have already been submitted in writing (Article 116(1) EPC).

2.1 This oral presentation of a case may take the form of explanations relating to certain technical aspects of the invention, a statement as to what a person skilled in the art would or would not have done at a certain time to solve a particular problem, or an account of the difficulties which a skilled person would or would not have encountered when implementing the invention.

2.2 Such a means of giving or obtaining evidence is a relatively flexible procedure which is left to the initiative of the parties up to an advanced stage in the appeal proceedings. In practice, in order to ensure fair and balanced proceedings (Articles 113(1) and 125 EPC), each party is normally obliged to inform the other parties, within a reasonable period of time, of its intention to call in experts to take part in discussions about a particular issue (G 4/95, OJ EPO 1996, 412, reasons,

10). This is particularly appropriate where, as in the present case, a procedural timetable is fixed by the board in a communication addressed to the parties in preparation for the oral proceedings, expressly inviting the said parties to inform the board of their intentions in this respect.

2.3 Alternatively, Article 117(1)(d) of the Convention provides, amongst other means of giving or obtaining evidence, for the hearing of witnesses, which necessitates the implementation of a relatively rigid and complex procedure as provided for in Rules 72 to 76 EPC and which for this reason is rarely used. This means of giving or obtaining evidence is used in particular if the EPO deems it necessary to hear a witness or if one party has specifically requested this.

2.4 Rule 72(1) EPC reads as follows: "Where the European Patent Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved, and the date, time and place of the investigation. If oral evidence of witnesses and experts is requested by a party, the decision of the European Patent Office shall determine the period of time within which the party filing the request must make known to the European Patent Office the names and addresses of the witnesses and experts whom it wishes to be heard".

Rule 72(2), first sentence, EPC further stipulates that "at least two months' notice of a summons issued to a party, witness or expert to give evidence shall be given unless they agree to a shorter period".

3. In the present case, the designation one week before the date of the hearing of three witnesses to accompany the representative of respondent 1 raises a procedural problem.



3.1 A preliminary study of the file having shown that the arguments presented by the parties in their statements did not call for any particular comments over and above the counter-arguments already submitted by the other party/parties, that is those already considered by the department of first instance, the board on 18 March 1997 sent the parties a communication which:

- pointed out that the only question to be dealt with during the oral proceedings was the objection concerning public prior use

- indicated that the standards which the board intended to use to assess the validity of the objection had been set out in decision T 472/92 (as mentioned above)

- explicitly mentioned in conclusion that where the representatives of the various parties intended to be accompanied or assisted by other persons at the oral proceedings, they should inform the board and the other parties of this at least one month before the date of the hearing.

This formulation was intentionally broad enough to include all persons likely to contribute to the clarification of points being debated, that is not only persons who furnished affidavits in the opposition proceedings, but also, in view of the possible discussion and interpretation of the results of the analyses submitted by the two respondents, experts in the preparation of zeolites, and the inventors themselves.

3.2 ...

3.3 Independently of the date of the summons to oral proceedings sent to the parties on 13 February 1997, it had been obvious for more than two years, in view of the requests to this end made by the three parties (the appellant on 21 October 1994, respondent 1 on 2 August 1994, respondent 2 on 6 June 1995), that oral proceedings would be taking place and that it was thus up to respondent 1, as far as

it was concerned, to take the necessary preliminary measures to ensure that the persons who had furnished affidavits would be present at the hearing at the given time. It was in particular under an obligation, in case it actually intended to hear witnesses as provided for in Article 117(1)(d) EPC, to impart this information without waiting for the summons to oral proceedings, so that the board for its part could take a decision about this and fix the period of time within which respondent 1 would have to give the EPO the names and addresses of the witnesses concerned (Rule 72(1) EPC). Respondent 1's reply of 21 February 1995, which was the last statement filed by the parties prior to the summons to oral proceedings and which it concluded by repeating its request for oral proceedings and expressing the wish that these would take place soon, would have been the ideal opportunity to request a hearing of the witnesses. Indeed, the procedural timetable fixed by the board still allowed for the measures envisaged for this purpose in the EPC to be carried out after receipt of the summons to oral proceedings.

3.4 It goes without saying that the designation of three witnesses one week before the oral proceedings took the board by surprise: in the circumstances, it could no longer follow the provisions of either Rule 72(1) or, given the appellant's preliminary request not to accept any statements by the said witnesses, Rule 72(2) EPC. It also made it practically impossible for the appellant to respond appropriately by basing its own defence on statements by technical experts and/or explanations by the inventors, or even to produce counter-witnesses. Such an imbalance in the level of representation manifestly violates the procedural principles generally recognised in the contracting states (Article 125 EPC), whereby each party must be able to conduct its defence in as fair a manner as possible.

3.5 The arguments put forward by respondent 1 to justify its failure to meet the time limit for reply fixed by the board are not acceptable for the reasons set out below.

3.5.1 As the board explained at the oral proceedings, the references to Rule 71a(1)

EPC and decision G 6/95 (as mentioned above) in the respondent's letter of 9 July 1997 are not appropriate. In this decision, which related solely to the question of whether the boards of appeal are obliged to send a communication under Rule 71a(1) EPC when they summon parties to oral proceedings, the Enlarged Board held that this rule's mandatory procedural requirements were applicable to the first instance departments of the EPO, but not to the boards of appeal (reasons, 5). If the Enlarged Board's decision says that Rule 71a(1) EPC is not binding on the boards of appeal in the sense that it gives them full scope in the preparation of oral proceedings, it is nevertheless binding on the parties, like the other rules in the Implementing Regulations. Thus, when a board of appeal, as in the present case, decides to send the parties a communication under Rule 71a(1) EPC, the latter are obliged to comply with it, in particular as far as the procedural timetable is concerned.

3.5.2 With regard to the reference to decision G 6/95 (as mentioned above), it should also be pointed out that Rule 71a(1) EPC is not the only text relating to the admissibility of new evidence presented at a late stage in the proceedings. Thus the present board's decision at the oral proceedings not to hear the witnesses was based not on this rule, but on Article 114(2) EPC, which stipulates that evidence not submitted in due time by the parties concerned may be disregarded. The jurisprudence of the boards of appeal has established that evidence produced late may be deemed inadmissible for lack of relevancy (see, for example, decisions T 207/91 of 2 February 1993, T 713/91 of 26 January 1993 and T 141/92 of 29 July 1993, none of which were published in the OJ EPO), or for non-observance of the equity requirement (see, for example, decisions T 939/90 of 16 December 1993 and T 685/91 of 5 January 1993, not published in OJ EPO, and T 270/90, OJ EPO 1993, 725).

3.5.3 The other explanation given by the representative of respondent 1, namely that he communicated the identity of the witnesses as soon as he was appointed by

Bayer to represent them at the oral proceedings and that it had been practically impossible for him to act sooner, cannot be accepted either. The board finds it was not shown that the change of representative at such a late stage of the procedure was due to force majeure. The change, which was simply the wish of the client, does not mean that the considerations in point 3.5.2 above can be dismissed. The new representative was thus obliged to continue the proceedings from the stage they had reached when he took over from his predecessor. In any event, Bayer could not use its designation of a new representative around two weeks before the date of the oral proceedings as an opportunity to adopt at short notice a new defence strategy which was not only unforeseeable in view of the arguments and requests previously submitted, but also incompatible with the procedural timetable drawn up by the board and contrary to the provisions of the EPC.

3.6 Finding it impossible to consider the persons accompanying respondent 1's representative to be witnesses within the meaning of Article 117(1)(d) EPC, the board finally decided, after intermediary deliberations, that these persons would remain at its disposal, but outside the room in which the oral proceedings were taking place, in order that any statements they might make would not be influenced by what had already been said. However, the arguments put forward by the respondents during the hearing, which were based on the results of the analyses and the affidavits submitted earlier, shed no new light on the facts already on file, so there was no point in these persons participating. Moreover, respondent 1 no longer even wanted them to do so during the discussions which followed the intermediary deliberations.

3.7 The opposite solution, which had been advocated by respondent 2 and consisted in postponing the oral proceedings in order to allow a formal hearing of the witnesses at a later stage, was not accepted by the board for two reasons.

The first was that examination of the opposition and appeal files produced no a priori

evidence that it was necessary to supplement the written information by evidence from these witnesses. The outcome of the oral proceedings bore this out.

The second was that the designation of witnesses one week before oral proceedings is an abuse of procedure, the delaying effect of which would simply have penalised the appellant by prolonging the appeal proceedings and, by the same token, the public's uncertainty as regards the novelty of the subject-matter of the claims of the patent concerned. Faced with such a situation, the board held that the interests of the appellant as proprietor of the patent must clearly prevail.

4. ...

*Criteria for assessing the evidence furnished by the respondents*

5. The conditions for asserting prior public use have been defined in a large number of board of appeal decisions, for example T 194/86 (as mentioned above).

Accordingly, in order to determine whether an invention has been made available to the public by prior use, the following information must be provided:

- (a) the date of the prior use
- (b) the precise object of the prior use
- (c) the circumstances of the prior use.

5.1 In its communication of 18 March 1997 the board referred to decision T 472/92 (as mentioned above) in order to specify the degree of conviction it intended to apply as a criterion in the oral proceedings when assessing the evidence furnished by the respondents. According to this decision, where practically all the evidence lies within the power of the opponent, the assessment of probability which normally underlies the boards' opinion must cede to a stricter criterion close to absolute conviction. In other words, there should be a degree of certainty which is beyond all

reasonable doubt. This approach to assessing the validity of an objection on the grounds of public prior use, which was recently confirmed in decision T 848/94 of 3 June 1997 (not published in OJ EPO), was not contested by any of the parties, including the respondents.

5.2 Transposed to the context of the present case, these considerations led the board, in order to establish that there was an unbroken chain of evidence relating to the nature of the zeolites up to and including the preparation of the polyurethanes, to concentrate on the following points at the oral proceedings:

- composition of the zeolite manufactured by respondent 1
- correspondence between the manufactured product and the marketed product
- correspondence between the marketed product and the product used.

6. ...

7. ...

8. ...

### *Conclusion*

9. It has thus successively been established that

- the Baylith L product is a commercial product whose composition is capable of varying within certain limits such that  $a + b + c$ , subject to experimental measurement errors, is between around 0.9 and around 1. Only samples N13.85 and N14.85 analysed by respondent 2 are products as used in the patent in suit ( $a + b + c = 1$ )(first link);

- there is no evidence that a product as analysed by respondent 2 was sent to Giessharzwerk Frechen or to Rütgerswerke, and there is no trace of receipt by them of Baylith L products as identified by Bayer, so no conclusion can be drawn as to the nature of the zeolites which were marketed and thus available for subsequent use (second link);

- even if use of the Baylith L products under the required conditions has been effectively demonstrated (third link), they are products of indeterminate composition which do not permit any conclusions to be drawn.

Besides the uncertainty as regards the precise nature of the marketed zeolites, it is clear from these partial conclusions that the common designation Baylith L for both the analysed product, the marketed product and the product used is not proof of identity as far as the composition of these various zeolites is concerned, nor therefore of the continuity of the chain of evidence furnished by the respondents. Consequently, the probative value of the various affidavits and documents produced is in no way sufficient to prove with the degree of certainty defined in decision T 472/92 (as mentioned above) that products as used in the patent in suit as a dehydrating agent for the polyol component were available to Gießharzwerk Frechen and Rütgerswerke for the manufacture of polyurethanes by mixing two components. It follows that the allegation of public prior use is without foundation and that, consequently, the novelty requirement is satisfied as regards the subject-matter of all the claims.

...

10. ...

**Order**

**For these reasons it is decided that:**

1. The impugned decision is set aside.
  
2. The case is remitted to the department of first instance for further prosecution.

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\* This is an abridged version of the decision. A copy of the full text in the language of proceedings may be obtained from the EPO Information Office in Munich on payment of a photocopying fee of DEM 1.30 per page.