

DECISIONS OF THE BOARDS OF APPEAL

Decision of Technical Board of Appeal 3.2.5 dated

22 September 1997

T 522/94 - 3.2.5

(Language of the proceedings)

Composition of the board:

Chairman: G. Gall

Members: H. P. Ostertag

A. Burkhart

Patent proprietor/Appellant: TECHMO Car S.p.A.

Opponent/Respondent: GLAMA Maschinenbau GmbH

Headword: Powered vehicle for operation of ladles/TECHMO

Article: 99 EPC

Rule: 55(c), 56(1) EPC

Keyword: "Admissibility of opposition" - "Substantiation of grounds of opposition" - "Made available by use or in any other way" - "Instances of state of the art made available in any other way"

Headnote

I. The admissibility of the opposition must be checked ex officio in every phase of the opposition and ensuing appeal proceedings. It can and, where appropriate, must be raised by the board in appeal proceedings even if this is the first time this matter is addressed (T 289/91, OJ EPO 1994, 649; T 28/93, reasons, 2, not published in the OJ EPO).

II. Admissibility of the opposition has to be judged on the basis of the content of the notice of opposition as filed, taking account of additional documents filed before the expiry of the opposition period as far as they remedy any deficiency fatal to the admissibility. Such a defect cannot be remedied outside the period for opposition (Rule 56(1) EPC, in fine).

III. On the basis of statements contained in the notice of opposition it must be possible to qualify whether the "instance" or "aspect of the state of the art" was made available to the public by means of a written or oral description, by use, or in another way (Article 54(2) EPC) and of what it consists.

IV. In order to be substantiated pursuant to Rule 55(c) EPC the notice of opposition must indicate "when", "what" and under what circumstances, in particular "to whom", the alleged piece of state of the art was made available.

V. The overall purpose of the admissibility requirement is to allow the proprietor of the patent and the opposition division to examine the alleged ground for revocation without recourse to independent enquiries.

Summary of facts and submissions

I. The appellant (proprietor) lodged an appeal against the decision of the opposition division revoking European patent No. 211 846 following an opposition filed against the patent as a whole and based on Article 100(a) EPC, in conjunction with Articles 52(1), 54 (lack of novelty) and 56 (lack of inventive step).

II. The opponent invoked in the notice of opposition lack of novelty and inventive step (Article 52(1) in conjunction with Articles 54 and 56 EPC) and referred, "further to documents already taken into account in the granting procedure", to two booklets, both bearing the name Techmo, namely

(a) "TRUCKS FOR ALUMINIUM INDUSTRY TECHMO - TAPPING TRUCK mod. 7.167" (referred to in the decision under appeal as document E1), and

(b) "TAPPING TRUCK FOR ALUMINIUM (and molten bath)" dated July 1984 and containing the reference on the first page:

"TAPPING TRUCK TECHMO

Techmo has designed a set of tapping trucks with maximum loads for 3.5 to 6.5 t/Al, suitable for side by side and end by end pots.

With TECHMO's tapping truck (see leaflet enclosed) following advantages can be obtained:" (referred to in the decisions under appeal as document E2).

In the view of the opponent, the last sentence ("With TECHMO's tapping truck see leaflet enclosed" - line 24 of E2) constitutes a clear link between E1 and E2. The two documents do not contain any indication of confidentiality.

III. The opponent furthermore made the following statement in the notice of opposition:

The introductory part of claim 1 is known from US-A-356 720. It can be drawn from figures 1 and 2 of US-A-399 481 that the crucible 6 (Pfanne 6) has claws (Pratzen) which lie on projections of the frame 30 (Vorsprüngen des Rahmens 30).

The vehicle described in E1 and E2 serves the purpose of handling a crucible with a removable lid when tapping liquid aluminium.

The opponent then analyses the features contained in E1 and finishes with the conclusion: "All features of claim 1 of the patent in suit are known."

As to the sub-claims the notice of opposition contains the following statement:

In accordance with claim 3 of the patent in suit, in paragraph 6 of the description of the machine in E1, the lid (Deckel) of the crucible is an integral part of the vehicle. In accordance with claim 4, the tapping tube (Abstichrohr) of the vehicle is fixed at the lid and revolves together with it (see paragraph 7 of E1).

IV. Apart from copies of E1 and E2, no evidence was invoked or brought forward.

Within the period of opposition nothing was added by the opponent.

V. The opposition division held that the opposition complied with Articles 99 and 100 EPC and Rule 55 EPC and was therefore admissible.

VI. On the merits of the case it came to the conclusion that claim 1 lacked novelty vis-à-vis the undated booklet E1. On the basis of an affidavit by Mr Vohmann which was filed after the notice of opposition the decision under appeal stated that "the document E1 was shown and handed over to him (= Mr Vohmann) at LGM without any obligation of secrecy." Neither the date nor the circumstances of Mr Vohmann's visit are indicated. It is up to the reader of the affidavit to deduce that it should be 6 February 1985.

VII. There is also an inconsistency between Mr Vohmann's letter of 26 April 1989 to Mr Lachnit of GLAMA, stating that he could inspect the Techmo papers E1 and E2 ["Bei unserem Projektgespräch im Hause LMG konnten wir TECHMO-Unterlagen (Druckschrift und technische Beschreibung) einsehen") and the affidavit of 10 June 1991 which stated that the documents were handed over ("zur Kenntnisnahme übergeben"). This inconsistency could possibly have been removed either by calling Mr Vohmann as a witness (as was offered by the opponent) or by requesting the production of the report "42" on Mr Vohmann's visit to LMG, Essen. However this was not done.

VIII. The proprietor objected that making E1 available constituted an abuse because the matter was handled by the Aluminium Rheinfelden Company confidentially. This could be inferred from the fact that both Aluminium Rheinfelden and LGM belonged to the ALUSUISSE-LONZA group, and so passing on information to Mr Vohmann without any secrecy obligation was therefore an evident abuse and E1 was therefore a non-prejudicial disclosure under Article 55(1) a EPC.

IX. This objection was not accepted by the opposition division. E1 was considered to form part of the state of the art under Article 54(2) EPC, thus prejudicing the novelty of claim 1 of the patent in suit. The opposition division revoked the patent.

X. The appellant (proprietor) requested in its appeal that the decision of the opposition division be set aside and the patent be maintained unamended. The evaluation of the evidence (affidavit of Mr Vohmann) was questioned (a) because Mr Vohmann is a consultant of the opponent, (b) the affidavit was given at the specific request of the opposition division and (c) because the statement by Mr Vohmann was vague and in direct contrast to allegations of the patentee. The appellant provides further evidence in support of his allegation that there was a secrecy obligation; if not met this would constitute an evident abuse (Article 55(1)(a) EPC).

XI. The respondent challenged the allegations of the appellant.

XII. In a first communication the board raised doubts about the evaluation of the evidence by the opposition division and the weight that was given to the absence of written agreements of confidentiality and, consequently, whether there was an absence of a confidentiality agreement. Persons invited to the demonstration of the truck would have realised that it was under a confidentiality obligation. Such obligation would reasonably cover written material distributed on the occasion of this demonstration.

XIII. The respondent reacted by stating that, as far as the witness Mr Vohmann recalled, Mr Fletcher was attending the demonstration at Aluminium Rheinfelden on 15 November 1984 as a future managing director of a company belonging to the Alusuisse Group which he joined shortly after the demonstration. Mr Fletcher was obviously not acting as a representative of LGM. He requested that the decision under attack be confirmed.

XIV. In a second communication the board confronted the parties with the question of the admissibility of the notice of opposition setting out in detail that the basic requirements of Rule 55(c) EPC seemed not to be met.

XV. Oral proceedings were held on the question of admissibility.

XVI. The respondent contended that the Board had criticised the opposition division for not calling Mr Vohmann as witness, thus admitting that there was actually evidence in the person of Mr Vohmann as a witness. Mr Vohmann would have been able to make statements and to answer all questions in connection with the booklets presented by the opponent.

Until now the only point that was disputed was the publishing date of one of the booklets. It had been made clear by the opponent that the two booklets obviously belonged together as "clearly stated (but slightly misprinted) on page 1 of document E2". The design and layout of the booklets were typical of advertising material. It could have been confirmed without doubt, by calling Mr Vohmann as witness, that documents E1 and E2 were both handed over at the same time to the witness under circumstances where an offer to supply a tapping truck like the one shown in document E1 was made. The fact that the witness was not heard cannot be blamed on the opponent.

XVII. The Chairman stated that the notice of opposition did not mention Mr Vohmann nor any facts concerning the distribution of documents E1 and E2.

XVIII. The appellant requested that the decision under appeal be set aside and the opposition be rejected.

XIX. The respondent requested that the appeal be dismissed, alternatively that the following question be referred to the Enlarged Board of Appeal:

"If in one document E2 there is contained a reference to the same subject-matter stating "(see leaflet enclosed)", ie document E1, is this enough for substantiation of document E1 for a publication date?"

Reasons for the decision

1. The appeal is admissible.
2. The first point to decide is the admissibility of the notice of opposition.

3. The admissibility of the opposition must be checked *ex officio* in every phase of the opposition and ensuing appeal proceedings. It can and, where appropriate, must be raised by the board in appeal proceedings even if this is the first time this matter is addressed (T 289/91, OJ EPO 1994, 649; T 28/93, reasons 2, not published in the OJ EPO). Admissibility has to be judged on the basis of the content of the notice of opposition as filed, taking account of additional documents filed before the expiry of the opposition period as far as they remedy any deficiency fatal to the admissibility. Such a defect cannot be remedied outside the period for opposition (Rule 56(1) EPC, *in fine*).

The significance of admissibility

4. As an *obiter dictum* the board comments upon the ensuing procedure because it contributes to the understanding of the concept of admissibility and its impact on proceedings.

5. This is a classic example of a case where turning a blind eye to procedural requirements leads to an impasse. The opponent did not set out enough facts for the opposition division to be able to determine the issues of novelty and inventive step. The opposition division tried hard to find the facts, and sent a series of communications culminating in the request for the opponent to file an affidavit. The affidavit filed thereupon contained a minimum set of assertions tailored to the request of the opposition division, which did not have the opportunity of seeing the facts in their context and evaluating the strength of the evidence in a proper manner. Both parties then concentrated on the objection of unprejudicial disclosure under Article 55(1)(a) EPC before it was clearly established whether there was novelty-destroying prior art at all. Counter-evidence on non-prejudiciality was filed by the proprietor as late as at the appeal stage. There is not yet a clear statement of facts nor conclusive evaluation of evidence. The piecemeal approach of the parties, a primary source of delay, started with the lack of substantiation of the opposition,

thus blurring the issue to be decided, and continued with the insufficient reactions of the parties to communications from the opposition division.

6. There is also a widespread lack of recognition of the interdependence between the requirement of substantiation of the opposition and the content of the decision by the opposition division. Substantiation is not a requirement per se, but has a clear purpose: that the opposition division can clearly set out the case just on the points at issue. On the other hand, the (minimum) requirements for substantiation of the opposition have their counter-part in the (minimum) requirements for the reasons to be given in the decision of the opposition division. There is insufficient reasoning of a decision if the "when, where and what" is not set out in detail, leaving the reader to guess what the facts underlying the decision are, why and on what evidence they were based, and how the evidence was evaluated. The latter plays a role in particular when an affidavit was requested by the opposition division relating to facts which occurred some years previously, where it would not be appropriate to base the decision on a written document only, without giving the other party the opportunity to challenge the evidence.

7. It cannot be the legitimate object of filing an opposition just to "keep the case open" and hold one's cards to one's chest. There is every reason to disapprove such practices. Admissibility of the opposition is an important aspect when checking the opposition as to formal requirements. To go into the merits of the case where there is a lack of admissibility cannot be justified by the theory "that a patent cannot be maintained when its lack of validity strikes the eye". There is no such "eye-striking case" if the facts, evidence and arguments are insufficient. The requirement of admissibility must not be circumvented by overemphasising the ex officio principle and shifting the burden of establishing the case from the opponent to the opposition division. This concludes the obiter dictum on the conduct of proceedings.

Requirements for admissibility

8. In order to be admissible the opposition has to meet inter alia the requirements of Article 99(1) EPC in conjunction with Rule 56(1) and Rule 55(c) EPC, third requirement (indication of facts, evidence and arguments in support of the grounds for opposition).

9. The present case raises some basic issues as to how to deal with cases where it is necessary to look more closely into the interpretation of the terms used in Article 54(2) EPC to circumscribe what is to be considered as the state of the art. In most cases documents published by an official authority like a patent office (published patent applications, patent specifications) or generally accepted technical books invoked to show what is prior art under Article 54(2) EPC clearly qualify as prior art. In such ordinary cases no question arises as to where, when and what was made available to the public.

10. There is a substantial amount of case law relating to the conditions an opposition must meet in order to be admissible when the opponent invokes prior use. T 328/87, OJ EPO 1992, 701, Reasons 3.3 ff approves in principle the "three-requirements" rule laid down in the Guidelines for Examination in the EPO (for the then existing version of the Guidelines, Part D, Chapter IV, 1.2.2.1 (f), which text is now contained in letter (e)). The same requirements are postulated in T 541/92 and T 538/89, neither published in the OJ EPO. No such decision could be recognised for borderline cases which may qualify under the concept of availability "by any other means".

11. The relevant parts of the Guidelines in their present version (pages dated "December 1994") are as follows:

Part D, Chapter IV

"1.2.2 Deficiencies which, if not remedied [annotation: before expiry of the opposition period] lead to the opposition being rejected as inadmissible

...

1.2.2.1 Deficiencies under Rule 56(1)

The following deficiencies fall into this category:

...

(e) The notice of opposition does not indicate the facts, evidence and arguments presented in support of the opposition

An opposition is *adequately substantiated* only if in respect of at least one of his grounds for opposition the opponent *adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC.* He must indicate the technical context and the conclusions he has drawn from it. *The content of the statement of grounds must be such as to enable the patent proprietor and the opposition division to examine the alleged ground for revocation without recourse to independent enquiries.* Unsubstantiated assertions do not meet this requirement. Nor as a rule is mere reference to patent documents enough; unless the document is very short the opponent must indicate on which parts his opposition is based. Where there are allegations that use or oral description are comprised in the state of the art, the opposition division must be supplied with an indication of the facts, evidence and arguments necessary for determination of the matters set out under V, 3.1.2 and 3.2.3.

...

An indication of the grounds and of the facts, evidence and arguments on which they are based fulfils the prerequisites for admissibility of the opposition in this

respect. The evidence and arguments themselves can also be produced after the expiry of the opposition period...."

[part of the text is set in italics for the purposes of clarity.]

Guidelines D-V, 3.1.2 and 3.2.3, relate to the substantive examination of the opposition. These points are cited in chapter D-IV ((Opposition) procedure up to substantive examination) in point 1.2.2.1 (e) at the top of page 12, in the context of the aim and purposes of the requirement to supply an indication of the facts, evidence and arguments as a prerequisite of admissibility of the opposition, namely that it should be possible for the (examination or) opposition division to examine the alleged grounds for opposition "without recourse to independent enquiries." 3.1.2, "Matters to be determined by the opposition division as regards use" and 3.2.3, "Matters to be determined by the opposition division in cases of oral description", does not relate to the conditions of admissibility of the opposition as such; it is the possibility to determine such issues without recourse to independent enquiries that represents an indispensable prerequisite for the opposition to be admissible. In order to be properly understood in their context the pertinent provisions of the Guidelines are recited more fully as follows:

Guidelines D-V, 3:

"3. Non-patentability pursuant to Articles 52 to 57

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Articles 52 to 57 as in the examination procedure. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Article 54(2)).

...

3.1 State of the art made available to the public "by use or in any other way"

3.1.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering or marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

3.1.2 Matters to be determined by the Opposition Division as regards use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art, the Opposition Division will have to determine the following details:

(a) the date on which the alleged use occurred, ie whether there was any instance of use before the relevant date (prior use),

(b) what has been used, in order to determine any substantive similarity between the object used and the subject-matter of the European patent.,

(c) all the circumstances relating to the use, by which it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, inspection of a manufacturing process in a factory or the delivery and sale of a product may well provide information as regards the possibility of the subject-matter being available to the public.

...

3.2.1 Cases of oral description

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation, a lecture, or by means of radio, television or sound reproduction equipment (tapes and records).

3.2.2 Non-prejudicial oral description

...

3.2.3 Matters to be determined by the opposition division in cases of oral description

Once again, in such cases the following details will have to be determined:

(a) when the oral description took place,

(b) what was described orally,

(c) whether the oral description was made available to the public: this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also V, 3.1.2 (c))."

12. T 328/87 in effect combines Guidelines D-IV, 1.2.2.1(e), first paragraph, with D-V, 3.1.2, and, interpreting Rule 55(c) EPC, third condition (indication of facts, evidence and arguments) in relation to prior use, establishes a test involving three requirements for the admissibility of the opposition. If prior use is invoked under Article 54(2) EPC the indication of facts, evidence and arguments must comply with the following (wording of reasons, 3.3 of T 328/87 slightly adapted):

The opposition division (and the proprietor of the patent in suit) must be supplied with an indication of the facts, evidence and arguments which make it possible for it to determine

(a) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use),

(b) what has been used, in order to determine any substantive similarity between the object used and the subject-matter of the European patent,

(c) all the circumstances relating to the use, by which it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, inspection of a manufacturing process in a factory or the delivery and sale of a product may well provide information as regards the possibility of the subject-matter being available to the public.

13. The Guidelines are intended to cover normal occurrences and are to be considered as general instructions as to the practice and procedure to be followed in the various aspects of the examination of European applications and patents in accordance with the European Patent Convention (and its Implementing Regulations). They are addressed to the staff of the EPO, in particular the examiners acting as members of the examining division (Article 18 EPC) or

opposition division (Article 19 EPC) (cf. General Introduction to the Guidelines, point 1.2).

14. They are not binding upon the members of the boards of appeal (Article 23(3) EPC). The Rules of Procedure for the Boards of Appeal are enacted according to Article 23(4) EPC. According to Article 15(2) of these Rules, reasons may be given in the decision of the board for an interpretation of the Convention which differs from that of the Guidelines if it might contribute to the understanding of the decision. This provision reflects the general principle that the boards of appeal as second instance may look to the Guidelines because they heavily influence as general instructions the interpretation of the EPC by the first-instance. Such reasons might then trigger amendments to the Guidelines by the competent authority under Article 10(2) and (3) EPC. As rightly underlined in the general introduction to the Guidelines for Examination in the European Patent Office the Guidelines do not constitute legal provisions; for the ultimate authority on practice in the EPO it is necessary to refer firstly to the EPC and secondly to the interpretation put upon the Convention by the boards of appeal and the Enlarged Board of Appeal. This in no way affects the importance of the Guidelines as general instructions to the first-instance for the purpose of harmonising first instance practice on the basis of the EPC and interpretations given by the boards and the Enlarged Board, and - by way of publishing the Guidelines - to inform the public thereof.

15. In the present case the general line adopted by the Guidelines on the requirements for admissibility of oppositions invoking prior use or prior availability "in any other way" (Rule 55(c) EPC, third requirement) does not meet any objections. It was not contested in commentaries on the EPC, or in articles in pertinent legal reviews in the field of industrial property. On the contrary it was confirmed by the case law of the boards (see Case Law Report up to 1996, page 288, in particular decision T 328/87 analysed above).

16. Care must be taken to distinguish between the different kinds of instances of the state of the art. If there is an official document, ie issued by a patent office, the "who", "when" and "what" pose no problem. On the other hand, certain cases may require a deeper analysis. Under Article 54(2) EPC, "everything" made available to the public qualifies as forming part of the state of the art. In his intention to give it a meaning as wide as possible the "legislator" avoided the use of a specific term which might be construed as an inappropriate limitation. This leaves a gap - at least from the linguistic point of view. A noun circumscribing the "everything" would sometimes be needed in order to render a sentence relating to the state of the art more comprehensible. The Guidelines use the following wording to denote what is included within the concept of "everything": "instance" or "aspect of the state of the art concerned" (D-V, 3.1.1, heading and last paragraph).

17. "Everything" refers back to the state of the art and therefore implies that a specific item, in order to qualify as part of the state of the art, must be pertinent to the state of the art in its proper sense. It is a piece of information addressed to the person skilled in the art, as construed by him under the specific circumstances. It has to be pertinent to the skills of the person skilled in the art and to the grounds of opposition invoked - judged on the basis of the allegations of the opponent. It need not be in relation to a feature of a claim but it may relate to circumstances which might be relevant as such in judging inventive step. In the same way as information contained in a patent document concerning the effect of a technical measure or an opinion expressed in such a document which might cause prejudice, such aspects made available "by other means" can qualify as aspects pertaining to the state of the art.

18. The non-exhaustive list of which the state of the art consists pursuant to Article 54(2) EPC does not help in finding a general term (Oberbegriff) that covers "means of written or oral description, use, or any other way". The Guidelines employ the term "instances of the state of the art" in the heading of D-V, 3.1.1, to cover the

lack of a noun to be used for "any other way". The term "instances of the state of the art" can conveniently be used to cover all items of the state of the art.

19. It might be useful to consider a list of points (requirements) to be taken into account when analysing whether an "aspect" of the state of the art, ie a concrete set of facts, is invoked by the opponent. Such a list obviously cannot serve in all circumstances, but should cover even somewhat more involved cases.

20. Point (a)

As follows from the above, under the "what" heading the opponent must first state what information carrier was used (written document, object used, conversation, lecture, offer on Internet, etc.), in order to allow determination of what the "instance of state of the art" is.

21. Point (b)

Then the opponent must indicate what items of information - in his view - were obtainable from the alleged instance of state of the art. Here the opponent has to describe objectively the body of information, the facts in their context as they were recognisable. If it was a matter of prior use of an object, this would be the indication of features and properties that were recognisable. Its counterpart for a written document would be the text of the document.

22. Point (c)

A further item of the "what" element is the list of features at such a level of abstraction as is appropriate to determine any substantive identity or similarity of the alleged piece of the art (eg object used, content of a conversation, a lecture, etc.) with the subject-matter of the patent under attack. Its counterpart for a written

document is the extraction of relevant passages and features, the concrete citation of relevant passages from the document (see T 279/88, reasons 2, not published in the OJ EPO). These form the basic body of facts.

23. Point (d)

The basic body of facts must then be compared with the features of the patent under attack, taking into account other elements required for a complete setting out of the case which - in the view of the opponent - jeopardise the novelty or inventive step of the patent under attack.

24. Point (e)

The "where" element comprises all the facts relating to where the alleged state of the art surfaced, and the circumstances which allow the determination whether the above-mentioned items of information were made accessible to the public, including the determination of who was the public in the specific case and that there was no explicit or implicit confidentiality.

25. Point (f)

The "when" is very close to the "where" determination and should allow the specific instance of prior art to be identified by the date or the period of its occurrence.

26. These points must be identifiable from the notice of opposition. They are not set out as an aim in itself. The Rule 55(c) requirements aim at legal certainty and at allowing the proprietor to adequately defend his case.

Lack of substantiation in the present case.

27. In the present case the opponent simply cited two booklets (prospectus containing the name of the firm Techmo) without any indication of facts, evidence or arguments as to whether they were published at all, or when, where and to whom they were shown or handed over. Nor was there any indication why the citation of a tapping truck ("see leaflet enclosed" which should read: "leaflet" enclosed) in E2 was a reference to the specific model 7.167 dealt with in E1. None of these facts were stated, nor was evidence produced or offered. The booklets were dealt with as if the main points of "what", "where" and "when" were undisputable or undisputed facts, and the booklets contained indications that they were published on a specific date, at a specific location, by an official authority like a patent office. It was not even mentioned whether and if so, where and under what circumstances the booklets were distributed or otherwise made available to the public. They were simply qualified as written papers containing no confidentiality clause and therefore suited for distribution to an unlimited number of clients ("so aufgemacht, daß sie für die Verteilung an einen nicht begrenzten Kundenkreis geeignet sind"). Thereby the concept of availability to the public which applies in a different context, namely where a document is placed in a public library, thereby giving members of the public the opportunity to inspect it, was confused with a situation where it was merely "possible" that the written document had been distributed ie it was possible that it had been made available to the public. In the absence of any facts or evidence that it was really made available at a certain date, at a certain place to specific members of the public there is not even an allegation of an instance pertaining to the state of the art. The two booklets were simply put forward as if they were patent documents emanating from an official authority like a patent office.

28. On the basis of the statements contained in the notice of opposition it is not even possible to qualify the booklets pursuant to Article 54(2) EPC either as written documents which were put to one or more members of the public so that they came into possession of it or as piece of the state of the art having been made available to the public "in any other way", eg that a member of the public could inspect by

reading and handing them back to the provider. In the latter case it would not be the document which was made available to the public but the knowledge obtained by the reader under the specific circumstances of the case. This could make a considerable difference as far as the content of that piece of prior art is concerned. A written document in the possession of the public can be thoroughly analysed as there is ample opportunity to read it again and again. In the latter case the content of the state of the art is determined by what the memory of the reader could retain from a single reading which itself depends upon the specific circumstances (restriction in time, detracting circumstances, etc.).

29. Document E1, which was invoked as destroying novelty and inventive step, does not bear a date. It refers to a tapping truck "mod. 7.167". The second booklet, dated July 1984, merely refers to a "tapping truck Techmo" leaving it open whether the same model as E1 was meant. No further allegations were made and also no evidence offered. Specific facts on the mode of distribution of the documents and the name of a witness were only given later.

30. The notice of opposition is therefore insufficient under Article 99(1) EPC in conjunction with Rules 56(1) and Rule 55(c) EPC as it lacks substantiation as far as facts, evidence and arguments are concerned. The contents of the notice of opposition neither allowed the proprietor of the patent nor the opposition division to examine the alleged ground for revocation without recourse to independent enquiries. The opposition is therefore inadmissible.

31. The question to be referred to the Enlarged Board of Appeal at the respondent's request (see XIX. above) does not qualify as a question of law pursuant to Article 112(1)(a) EPC because it is merely factual. The request has therefore to be rejected.

32. In exercising the discretion conferred on it under Article 111(1) EPC, second sentence, the decision on the admissibility of the opposition is taken by the board. To refer the case back to the first instance for a decision on admissibility does not seem appropriate, because the issue has to be decided on the basis of the notice of opposition as filed, taking into account corrections and additions up to the expiry of the opposition period (Rule 56(1) EPC, last part of the sentence; but there was no such change). If the case were referred to the first instance, it could only follow the interpretation given by the board, and thus referring the case back to the first instance would serve no purpose.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The notice of opposition is rejected as inadmissible.