

Decision of Technical Board of Appeal 3.4.1 dated 2 February 1996

T 274/95 - 3.4.1*

(Official text)

Composition of the board:

Chairman: G. D. Paterson

Members: Y. J. F. van Henden

R. K. Shukla

Patent proprietor/Respondent: Mars Incorporated

Opponent/Appellant: WH Münzprüfer Dietmar Trenner GmbH

Headword: Re-introduced ground of opposition/MARS INCORPORATED

Article: 56, 100(c), 114(1), 123(2) EPC

Keyword: "Ground of opposition (Article 100(c) EPC) substantiated in the notice of opposition but not maintained before the opposition division" - "Re-introduction into appeal proceedings in the discretion of the board of appeal" - "Subject-matter which extends beyond the content of the application as filed (no)" - "Inventive step (yes)"

Headnote

I. If a ground of opposition is substantiated in the notice of opposition but is subsequently not maintained during the opposition division proceedings (here: a

statement to that effect is made by the opponent during oral proceedings), the opposition division is under no obligation to consider this ground further or to deal with it in its decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent (following opinion G 10/91).

II. A ground of opposition which is substantiated in the notice of opposition but which is subsequently not maintained before the opposition division, if sought to be re-introduced during appeal proceedings is not a "fresh ground of opposition" within the meaning of opinion G 10/91, and may consequently be re-introduced into the appeal proceedings without the agreement of the patent proprietor, in the exercise of the board of appeal's discretion.

Summary of facts and submissions

I. European patent No. 0 184 393 comprising twenty-two claims was granted to the respondent.

Independent claim 1 of that patent reads as follows:

"1. Apparatus for checking the validity of coins (8), comprising means (2, 6, 22) defining a coin path, electrically powered coin checking circuitry (58, 60) adapted to check the validity of a coin passing along said coin path, a coin impact surface (on 16) arranged to be hit by each coin passing along the coin path, the coin impact surface being on a member (16) which suffers the force imposed by the coin hitting and being deflected by the impact surface, means for generating an electrical signal (36) when a coin arrives for checking, and switching means (56) operable by said

electrical signal to power-up the coin checking circuitry (58) whereby to enable the coin checking circuitry to check the validity of said coin, characterised in that said means for generating an electrical signal (36) comprises a piezoelectric element (36, 36a) which is located so as not to suffer said force, but to which vibrations caused by a coin (8) hitting said impact surface are transmitted on a vibration transmission path, whereby the piezoelectric element (36, 36a) generates said electrical signal in response to the vibrations, in that the piezoelectric element is mounted into the apparatus by being secured to a fixed part of the apparatus lying on said vibration transmission path, and in that all other structural components (if any) located along the vibration transmission path also are firmly secured to each other, whereby the transmission path comprises continuous solid material which is firmly secured at any interfaces along the vibration transmission path."

Claim 22 relates to a coin operated equipment, and includes the coin checking apparatus as claimed in any one of the preceding claims.

Claims 2 to 21 of the patent are dependent upon claim 1.

II. The European patent was opposed on the grounds that

(i) its subject-matter is not patentable in accordance with Articles 52 to 57 EPC having regard to the state of the art disclosed in documents:

D1: EP-A-0 058 094,

D2: DE-A-3 415 273,

D3: CH-A-645 210 and

D4: US-A-3 776 338,

(ii) the subject-matter of the patent extended beyond the content of the application as filed, because two features of claim 1 of the patent as granted were not disclosed in the application as filed (Article 100(c) EPC).

III. During the procedure before the Opposition Division, the proprietor filed observations in reply to the notice of opposition, in which inter alia the above grounds of opposition were contested. In a communication accompanying a summons to oral proceedings, the Opposition Division inter alia stated its provisional opinion that "the subject-matter of claim 1 does not go beyond the content of the application as filed", and that "the subject-matter of claim 1 is not obvious in view of the prior art" for the reasons there set out. The communication also stated that document D2 was not part of the state of the art according to Article 54 EPC.

During the oral proceedings which were held on 25 November 1994, according to the minutes, the opponent inter alia declared that "the objections raised for addition of subject-matter were now dropped", and accepted that document D2 was not part of the state of the art.

IV. In its decision dated 19 January 1995, the Opposition Division stated in paragraph 4.2 of the "Facts and Submissions" that during the oral proceedings the opponent had stated that the ground of opposition based on an inadmissible extension beyond the content of the original disclosure was no longer maintained, and that he maintained only his request for revocation on the ground of lack of inventive step. No reference is made in the "Reasons for the Decision" to the originally alleged ground of opposition that the subject-matter of claim 1 had been inadmissibly extended beyond the content of the application as filed.

V. The Opposition Division rejected the opposition. In its decision dated 19 January 1995, the Opposition Division reasoned in substance as follows:

...

VI. The opponent lodged an appeal against the decision of the Opposition Division, and requested revocation of the patent.

In its Statement of Grounds of Appeal, the opponent submitted again that the subject-matter of claim 1 extended beyond the content of the application as filed and cited further documents DE-A-2 908 580 (D5) and DE-C-3 342 558 (D6) in support of the ground of lack of inventive step. In reply, the proprietor submitted that the ground of "additional subject-matter" (Article 100(c) EPC) had been abandoned during the Opposition Division proceedings, and should not be re-introduced into the appeal proceedings.

VII. In a communication accompanying a summons to oral proceedings, the Board expressed its provisional opinion as follows:

(a) the ground of opposition under Article 100(c) EPC had not been maintained by the opponent during the proceedings before the Opposition Division, and was not of sufficient relevance that it should be considered during the appeal proceedings.

(b) The ground of lack of inventive step was unlikely to prejudice maintenance of the patent as granted. The newly cited documents D5 and D6 did not appear to be sufficiently relevant to be admissible in the appeal proceedings.

VIII. Oral proceedings were held on 2 February 1996.

In support of its request, the opponent argued in writing and orally essentially as follows:

...

IX. In support of its request, the proprietor argued in writing and orally substantially as follows:

(a) In connection with the ground for the opposition under Article 100(c) EPC, this ground was abandoned at the oral proceedings before the Opposition Division, and it should not be allowed to be re-introduced at the appeal stage. In accordance with Opinion G 10/91, OJ EPO 1993, 420, at paragraph 18, a fresh ground of opposition may be considered in appeal proceedings only with the approval of the patentee, and the proprietor does not give such approval in the present case. The opponent should therefore not be allowed even to argue the point during the oral proceedings. Furthermore, in accordance with paragraph 18 of Opinion G 10/91, in the event that the Board was to allow this ground to be raised in the appeal, the case should be remitted to the first instance to decide this point; all the more so since by abandoning this ground before the Opposition Division, the opponent had denied the proprietor a first instance hearing on the ground in question.

In any event, the feature of the claimed apparatus according to which structural components are firmly secured to each other along a vibration transmission path was

disclosed in the application as originally filed, especially in the paragraph bridging pages 9 and 10.

(b) In connection with the ground of lack of inventive step, ...

X. During the oral proceedings, oral argument concerning the ground of opposition under Article 100(c) EPC was heard from both parties. At the conclusion of the oral proceedings, the decision was announced that the appeal is dismissed, and the request for an apportionment of costs is rejected.

Reasons for the decision

1. Admissibility of the ground of opposition under Article 100(c) EPC sought to be re-introduced into the appeal proceedings

(a) This ground of opposition was raised and fully substantiated in the notice of opposition, and was contested fully in writing by the proprietor in paragraphs 2.1 to 2.18 of the observation in reply to the notice of opposition which are set out in a letter dated 26 July 1994. At the oral proceedings before the Opposition Division, this ground of opposition was not maintained, as recorded in the minutes and the decision of the Opposition Division, and as accepted by the opponent during the oral proceedings before the Board of Appeal.

In these circumstances, the decision of the Opposition Division understandably does not deal with this ground of opposition as part of the "Reasons for the Decision", especially as it had previously given its provisional opinion (in the light of the parties'

written arguments) in the communication accompanying the summons to oral proceedings, to the effect that this ground of opposition did not prejudice the patent. If a properly substantiated ground of opposition is not maintained by the opponent during the procedure before the Opposition Division (for example, as in the present case, a statement to that effect is made by the representative of the opponent during oral proceedings), the Opposition Division is under no obligation to consider this ground further, or to deal with such ground of opposition in its reasoned decision, unless the ground is sufficiently relevant to be likely to prejudice maintenance of the patent. This follows from the principles set out in paragraphs 15 and 16 of Opinion G 10/91.

(b) Paragraph 18 of Opinion G 10/91 is concerned with the application of Article 114(1) EPC in the context of opposition appeal procedure, when a "fresh ground of opposition" is raised for the first time during appeal proceedings. It is clear from paragraph 16 of G 10/91, for example, that the Enlarged Board was essentially concerned with the circumstances in which "a ground of opposition not covered by the statement pursuant to Rule 55(c) EPC" could be considered and decided in proceedings before an Opposition Division (paragraphs 15 and 16) or before a Board of Appeal (paragraphs 17 and 18).

In the present case, as summarised in (a) above, the ground of opposition raised by the opponent under Article 100(c) EPC was fully substantiated in the opponent's statement pursuant to Rule 55(c) EPC, and furthermore was fully answered in writing by the proprietor in his letter dated 26 July 1994.

In the Board's view, therefore, the ground of opposition under Article 100(c) EPC which is sought to be introduced by the opponent in these appeal proceedings is not a "fresh ground of opposition" within the meaning of Opinion G 10/91. Consequently, this ground of opposition may be considered and decided by the Board of Appeal in the present case without the agreement of the proprietor, in the exercise of its discretion.

(c) In the light of the above considerations the Board was prepared to hear further argument directed to this ground of opposition during the oral proceedings held on 2 February 1996, before deciding whether the ground was sufficiently relevant to justify its re-introduction into the proceedings. Having heard such further argument, the Board still has the same view which was set out in its communication accompanying the summons to oral proceedings (and which was also set out in the Opposition Division's communication accompanying its summons to oral proceedings), namely that this ground is not sufficiently relevant to prejudice maintenance of the patent. While this view would justify the rejection of the ground as inadmissible, nevertheless, in order to avoid too formalistic an approach to these proceedings, and having regard to the limited extent of this ground, the Board has decided to admit the ground and to reject it on the substantive reasons set out below.

(d) Of course, if the Board had decided that this ground of opposition was sufficiently relevant to be likely to prejudice maintenance of the patent, consideration would have been given to the proprietor's submissions to the effect that, by abandoning the ground during the Opposition Division proceedings, the opponent had denied the proprietor a first instance oral hearing and decision on this point, and therefore, if the

ground was to be re-introduced, the case should be remitted to the first instance, with an apportionment of costs, if appropriate. However, having regard to what is set out in (c) above, these points do not need further consideration.

2. Alleged extension of subject-matter - Article 100(c) EPC

...

3. Inventive step

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4. Therefore, the appeal has to be dismissed.

5. Costs

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Order

For these reasons it is decided that:

1. The appeal is dismissed.

2. The request for an apportionment of costs is rejected.

* 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.