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D E C I S I O N
of 19 December 2000

Case Number: T 0715/95 - 3.3.6

Application Number: 90200063.7

Publication Number: 0381254

IPC: C10J 3/16

Language of the proceedings: EN

Title of invention:

Process for obtaining synthesis gas either from solid fuels derived from urban solid waste, or from industrial solid waste

Patentee:

ENIRICERCHE S.p.A.

Opponent:

Metallgesellschaft AG, Frankfurt/M

Headword:

Synthesis gas process/ENIRICERCHE

Relevant legal provisions:

EPC Art. 104, 111(1)

Keyword:

"Late-filed documents amounting to a fresh case on appeal -
admissible in part"

"Remittal to first instance (yes)"

"Apportionment of costs (yes)"

Decisions cited:

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Catchword:

-



Case Number: T 0715/95 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 19 December 2000

Appellant: Metallgesellschaft AG, Frankfurt/M
(Opponent) - ZA Recht und Patente -
Reuterweg 14
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Representative: -

Respondent: ENIRICERCHE S.p.A.
(Proprietor of the patent) Corso Venezia 16
I-20121 Milano (IT)

Representative: Fusina, Gerolamo
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted
1 August 1995 concerning maintenance of European
patent No. 0 381 254 in amended form.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
C. Rennie-Smith

Summary of Facts and Submissions

- I. European Patent No. 381 254 ("the Patent"), based on application No. 90 200 063.7 and concerning a process for obtaining synthesis gas from municipal waste, was granted to its Proprietor (the Respondent) on 31 March 1993. The Opponent (Appellant) opposed the Patent on the ground of lack of inventive step under Articles 100(a) and 56 EPC. The Opposition Division, in its decision posted on 1 August 1995, maintained the Patent in an amended form.

- II. The Appellant filed Notice of Appeal and paid the appeal fee on 22 August 1995 and, in its Statement of Grounds of Appeal filed on 20 November 1995, claimed the Patent lacked inventive step under Article 56 EPC, did not sufficiently clearly and completely disclose the claimed invention under Article 83 EPC, and that claim 1 of the Patent as maintained in amended form was not clear and contained an unallowable amendment under Articles 84 and 123 EPC respectively, all the objections other than inventive step being subsequently withdrawn during the oral proceedings. With the Grounds of Appeal the Appellant filed thirteen new documents - documents (4)-(16) - and relied on these in the appeal proceedings to the exclusion of the three documents it had relied on at first instance.

- III. The Respondent in its written arguments refuted those of the Appellant, objected to the admissibility of the late-filed documents and filed a request in which claim 1 was amended by the deletion of a limiting feature.

- IV. At the oral proceedings held on 19 December 2000, the

Board raised two preliminary issues: first, the admissibility of the late-filed documents and, second, the deletion of the limiting feature in claim 1 of the Respondent's request which, as *reformatio in peius* by a patentee, is currently the subject of a referral to the Enlarged Board of Appeal pending as G 1/99 (see OJ 1999, 554 for the referring decision).

V. As to the admissibility of the late-filed documents, the Appellant's submissions were, in summary, as follows.

- The reason why documents (4)-(16) were not filed during the opposition period was that they were not disclosed by the search made at that time. That search was not conducted by the Appellant itself. Following the first instance decision, the Appellant made a further search to find better "ammunition" to challenge the Patent and, having thereby discovered documents (4)-(16), now relied on them.
- The Appellant would be prepared to restrict its case to documents (14) (US-A-3 671 209), which it considers the most relevant, and (10) (US-A-3 920 417), which it considers the next most relevant.
- The Appellant would be prepared to pay costs which might be awarded to the Respondent in connection with the late-filed documents.

The Respondent maintained its objection to the admissibility of any of the new documents, arguing that they could have been filed during the opposition period

but requesting that, if any of these documents should be admitted, the case be remitted to the first instance.

- VI. The Appellant requested that documents (4)-(16) filed with the Statement of Grounds of Appeal be admitted, that the decision under appeal be set aside and that the Patent be revoked. The Respondent requested that the case be remitted to the first instance for further examination of the opposition.

Reasons for the Decision

1. The appeal itself is admissible. However, the admissibility of the new documents (4)-(16) raises serious questions of procedure. While the Appellant, at least after abandoning its other objections, only relies on the same ground of opposition - lack of inventive step - as it did at first instance, it has, by basing its inventive step attack in the appeal proceedings on completely new evidence, presented a wholly new case on appeal which bears little or no resemblance to the case it presented during the opposition proceedings. If the new evidence is admissible, the Respondent has thus to deal, in effect, with a second opposition to the Patent. The purpose of appeal proceedings is to review and reconsider the decision under appeal and not to give an opponent the opportunity to mount a second and different attack on the patent in suit.

2. The Board is not however required to rule that all new evidence introduced for the first time on appeal is inadmissible. To ignore a highly relevant document

which may affect the validity of the patent in suit could lead to the curious situation where a patent is maintained which, if the document were taken into account, would have been revoked. The Board thus has to balance two demands of public interest, that of procedural fairness and that of preventing unwarranted monopolies. It is for this reason that one consistent theme of the considerable case-law of the Boards on the subject of late-filed evidence is that a Board has a discretion in every such case which should be exercised in the light of the particular circumstances of the case. In exercising this discretion in the present case, the Board has to consider a number of questions including:

- Why was the new evidence filed late?
 - Could it have been found and filed earlier?
 - Is the new evidence, or any part of it, so relevant that it cannot be excluded even though produced at a late stage of the proceedings?
 - If the new evidence, or part of it, is admissible, is it of such weight that the case should be remitted to the first instance so that it is open to consideration at two levels of jurisdiction as if it had been filed at the proper time?
 - Has the party required to respond to the new evidence incurred costs which should be paid by the party producing the late evidence?
3. The Board finds the Appellant's reasons (see V. above) for the late filing of documents (4)-(16) wholly

unsatisfactory. The adequacy or otherwise of a first search is a matter solely within the control of that party and for which that party is alone responsible. If, after the first instance decision an opponent, realising his initial search was inadequate, conducts a second search and as a result seeks to rely on new prior art, he must almost inevitably face an objection of admissibility to his new evidence. In the present case there were no circumstances advanced by the Appellant or apparent to the Board which could excuse the delay in producing the evidence in question. The new documents comprised twelve published US, German and European patent documents and a textbook published in 1983. All were readily available from the public sources habitually used by patent searchers. That they were not located and filed during the nine month opposition period can only reflect, as the Appellant effectively admitted in the oral proceedings, that its first search was inadequate.

4. The fact the Appellant did not make the initial search itself can make no difference. In entrusting a third party to make a search on its behalf, the Appellant was responsible for giving the searcher sufficient instructions to ensure the search revealed all the relevant material the Appellant might need and for ensuring the searcher was competent. Any failings in that respect by the Appellant's agent must be seen as failings of the Appellant just as if it had conducted the search itself and neither the Respondent nor the Board can be expected to make any concessions to the Appellant because it selected a poor searcher or failed to instruct the searcher sufficiently.
5. The Board therefore concludes without difficulty that,

in the present case, the late-filed documents could and should have been filed during the opposition period.

6. The next matter to be considered is whether, notwithstanding such lateness, some or all of the documents should be admitted on the grounds of relevance. This question is made somewhat easier by the Appellant's concession, during the oral proceedings, that it could restrict its case to documents (14) and (10). The Board considers that those two documents are indeed highly relevant to the issue of inventive step and, as the Appellant submitted, the most relevant of the late-filed documents and more relevant than any of documents (1)-(3) which were the only documents it relied on at first instance and were thus the only evidence considered by the Opposition Division. The new documents (14) and (10) deal with municipal waste which documents (1)-(3) did not. The Respondent, while quite properly objecting to the admissibility of all the new evidence on procedural grounds, could not satisfy the Board during the oral proceedings that documents (14) and (10) were not more relevant than the earlier documents. Accordingly, on the criterion of relevance, those two new documents should be considered.

7. As regards those two documents therefore, the Board has to balance the Respondent's right to fair procedural treatment against the Appellant's submission (accepted by the Board) that the documents are sufficiently relevant that they must be taken into account. The Respondent's request, made during the oral proceedings, that the case be remitted to the first instance if any of the new documents be found admissible, and the Appellant's indication, also during the oral proceedings, that it was willing to pay any costs the

Board might order, together point to a conclusion which will largely satisfy the demands of both procedural fairness and relevance. By remitting the case to the first instance pursuant to Article 111(1) EPC, the Respondent will have the opportunity to defend the Patent against the new evidence as if it had been filed in the original opposition proceedings and the further opportunity to appeal if it so wishes. The apportionment of costs ordered by the Board pursuant to Article 104 EPC (see 8-9 below) will mean that the Respondent recovers any unnecessary expenditure incurred by the Appellant's procedural misconduct. The only consideration which might militate against remittal is the delay in the final outcome of the proceedings which will thereby result. This is regrettably unavoidable but is mitigated in the present case by two factors - the acceptance by the Respondent, in the form of its request for remittal, of this course of action; and the fact that, as long as the Respondent maintains a request containing an extended claim of the type now under consideration by the Enlarged Board of Appeal in case G 1/99 (see IV. above), this case will, whether it remains before the Board or is remitted to the first instance, have to be stayed pending the Enlarged Board's decision on such requests.

8. As to the apportionment of costs, it is equitable that the Appellant pay such of the Respondent's costs as have been occasioned by the late filing of the documents now considered admissible. Since those documents will now be considered substantively in further first instance proceedings which would have been unnecessary if the new documents had been filed by the end of the nine month opposition period, it is only appropriate that the Appellant pays all the

Respondent's costs of those additional first instance proceedings.

9. As regards the present appeal, the oral proceedings were largely occupied by argument as to the admissibility of all the late-filed documents, the debate dealing in more detail with the two documents now found admissible than the others and, prior to the oral proceedings, the Respondent's efforts were substantially directed to the merits the costs of which, to the extent the new evidence is admissible, would be incurred in any event in the first instance proceedings which will now follow. The Board therefore considers an apportionment of 50% of the costs of the oral proceedings will reflect its decision that all but the two most relevant of those documents are inadmissible and that, accordingly, the Appellant should pay the Respondent's additional costs incurred by the late filing of the documents held to be inadmissible.

Order

For these reasons it is decided that:

1. The late-filed documents (10) and (14) are formally admitted into the proceedings.
2. The decision under appeal is set aside.
3. The case is remitted to the first instance for further examination of the opposition.
4. The costs shall be apportioned so that the Appellant

shall pay the Respondent

- (a) 50% of the costs incurred by the Respondent in connection with the oral proceedings in this appeal

- (b) 100% of the costs incurred by the Respondent in connection with the further first instance proceedings.

The Registrar

The Chairman

G Rauh

P Krasa