BESCHWERDEKAMMERN DES EUROPÄISCHEN PATENTAMTS

BOARDS OF APPEAL OF THE EUROPEAN PATENT OFFICE

CHAMBRES DE RECOURS DE L'OFFICE EUROPEEN DES BREVETS

Internal distribution code:
(A) [X] Publication in OJ
(B) [ ] To Chairmen and Members
(C) [ ] To Chairmen

D E C I S I O N
of 17 November 1998

Case Number: T 1007/95 - 3.3.3

Application Number: 89102757.5

Publication Number: 0329154

IPC: B32B 29/00

Language of the proceedings: EN

Title of invention:
Process for the production of a decorative thermosetting laminate

Patentee:
Perstorp AB

Opponent:
Pfleiderer Industrie GmbH & Co. KG

Headword:
Appeal inadmissible/PERSTORP

Relevant legal provisions:
EPC Art. 108
EPC R. 65(1)

Keyword:
"Grounds for appeal unconnected with reasons for appealed decision - new document supporting a new ground for opposition - inadmissibility of appeal"

Decisions cited:
G 0009/91, G 0010/91, G 0001/95, G 0007/95, T 0220/83, T 0213/85, T 0145/88, T 0611/90, T 0514/92, T 1002/92, T 0389/95, T 0708/95

Headnote:
An appeal unconnected with the reasons given in the appealed decision (lack of inventive step) and directed only to a new ground for opposition (lack of novelty) based on a new document is contrary to the principles laid down in decisions G 9/91 and G 10/91, according to which an appeal should be within the same legal and factual framework as the opposition proceedings. It is tantamount to a new opposition and is thus inadmissible.

Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 1007/95 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 17 November 1998

Appellant: (Opponent)
Pfleiderer Industrie GmbH & Co. KG
Ingolstädter Str. 51
92318 Neumarkt (DE)

Representative:
Patentanwälte
Gesthuysen, von Rohr, Weidener, Häckel
Postfach 10 13 54
45013 Essen (DE)

Respondent: (Proprietor of the patent)
Perstorp AB
284 80 Perstorp (SE)

Representative:
Hansen, Bernd, Dr. Dipl.-Chem.
Hoffmann Eitle
Patentanwälte
Postfach 81 04 20
81904 München (DE)

Decision under appeal: **Decision of the Opposition Division of the European Patent Office posted 26 October 1995 rejecting the opposition filed against European patent No. 0 329 154 pursuant to Article 102(2) EPC.**

Composition of the Board:

Chairman: C. Gérardin
Members: B. ter Laan
A. Lindqvist

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 329 154 in respect of European patent application No. 89 102 757.5 filed on 17 February 1989 and claiming priority from an earlier application in Sweden (8800550 of 18 February 1988), was published on 10 November 1993 (Bulletin 93/45).

II. On 29 April 1994 a Notice of Opposition against the patent as granted was filed, in which the revocation of the patent in its entirety was requested for non-compliance with the requirements of Article 100(a) EPC in general, without any reference to the particular issue of novelty. From the grounds for opposition and the arguments presented subsequently in written submissions as well as during oral proceedings before the Opposition Division it was concluded that the reference to Article 100(a) EPC could only be interpreted as an objection of lack of inventive step.

In support of this objection the Opponent relied on eight documents (D1 to D8) submitted together with the Notice of Opposition as well as on a further document (D9) submitted less than three weeks before the oral proceedings.

III. By a decision announced orally on 17 October 1995 and issued in writing on 26 October 1995 the Opposition Division rejected the opposition on the ground that the claimed subject-matter involved an inventive step over documents D1 to D8. The late-filed document D9 had been duly examined, but disregarded pursuant to Article 114(2) EPC.

IV. On 22 December 1995 the Appellant (Opponent) lodged an appeal against the above decision and paid the prescribed fee. In a statement headed "Grounds of Appeal" filed on 29 February 1996 and in five later-filed written submissions the Appellant

(i) relied exclusively on six new documents (D10 to D15), only D10, an allegedly novelty destroying disclosure, being considered in detail, without discussing the reasons given in the impugned decision;

(ii) quoted Section (marginal number) 48 of Article 108 EPC of the "Patentgesetz" by R. Schulte, Carl Heymanns Verlag KG, Munich, 1994, page 685, according to which there was no need to challenge the validity of a decision when reference was made to a new circumstance which, if confirmed, would invalidate the contested decision, in particular when a new relevant document was presented;

(iii) indicated that it was well aware of the procedural principles set out in decisions G 9/91 (OJ EPO 1993, 408) and G 10/91 (OJ EPO 1993, 420), but that in the light of decision T 1002/92 (OJ EPO 1995, 605) late-filed material likely to prejudice the maintenance of a European patent should exceptionally be admitted into the proceedings;

(iv) pointed out that the decisions in the consolidated proceedings G 1/95 (OJ EPO 1996, 615) and G 7/95 (OJ EPO 1996, 626), although

making a distinction between lack of novelty and lack of inventive step as being different grounds for opposition, did not preclude novelty destroying material from being considered for the issue of inventive step; and

(v) argued that, consequently, the situation in the present case was similar in all respects to that underlying the decision T 611/90 (OJ EPO 1993, 050), where it had been decided that, as long as the appeal was based on the same ground as the opposition, the Statement of Grounds of Appeal could be unconnected with the reasons given in the appealed decision.

V. In its various counterstatements the Respondent (Patentee)

(i) protested against the piecemeal submission of new documents, objected to the admission into the proceedings of any of them, and did not consent to the issue of novelty being considered by the Board;

(ii) first requested that the appeal be dismissed, then, while still referring to its original request, filed an amended Claim 1, which was later specified to be the basis of an auxiliary request;

(iii) referred to the decisions T 220/83 (OJ EPO 1986, 249) and T 145/88 (OJ EPO 1991, 251), according to which a Statement of Grounds of Appeal should show that the contested decision was incorrect

and also state the legal and factual reasons why the decision under appeal should be set aside and the appeal allowed;

(iv) underlined that in T 611/90 a prerequisite for an appeal to be admissible was that it was based on the same opposition ground; that was not the situation in the present case, since according to G 7/95 lack of novelty and lack of inventive step each formed a separate ground for opposition.

VI. During oral proceedings held on 17 November 1998 the Board confirmed the terms of its two intermediate communications regarding the various issues to be discussed, in particular the preliminary issue of the admissibility of the appeal.

(i) The Appellant followed the same line as in its written submissions and additionally relied on two unpublished decisions, T 708/95 of 16 December 1996 and T 389/95 of 15 October 1997, to support its arguments. Regarding the statement headed "Grounds of Appeal" the Appellant conceded that it did not rely on the original documents D1 to D8 and that it did not deal with the reasons given in the decision under appeal. The Appellant also submitted a question of law to be referred to the Enlarged Board of Appeal.

(ii) As to the Respondent, it first objected to the reliance by the Appellant on the new decisions T 708/95 and T 389/95, since their introduction

into the proceedings was not only unfair, but also did not comply with the time limit for presenting new material fixed by the Board pursuant to Rule 71a(1) EPC. In substance the Respondent reiterated its arguments presented in writing and concluded that under no circumstances could an appeal be made admissible by the submission of a new document.

VII. The Appellant requested that the decision under appeal be set aside and the patent be revoked, alternatively, that the question of law be referred to the Enlarged Board of Appeal.

The Respondent requested that the appeal be rejected as inadmissible, alternatively, that the patent be maintained as granted or on the basis of the auxiliary request as filed on 19 August 1996.

Reasons for the Decision

1. The appeal complies with Articles 106 and 107 as well as with the first and second sentences of Article 108 and with Rule 64 EPC. Its admissibility therefore depends solely on whether the document headed "Grounds of Appeal" received on 19 February 1996 contains a "statement setting out the grounds of appeal" within the meaning of Article 108, third sentence, EPC.

From the direct literal meaning of the phrase "statement setting out the grounds of appeal" used in Article 108, third sentence, EPC, it is clear that, in order to satisfy the criterion for admissibility in the

statute quoted, grounds for an appeal must state why in the Appellant's view the contested decision cannot be valid, i.e. specify the legal and factual reasons why the decision should be set aside (cf. T 213/85, Reasons for the Decision, point 2; T 220/83, Reasons for the Decision, point 1; and T 145/88, Reasons for the Decision, point 1). Thus, whether a Statement of Grounds of Appeal can be regarded as such depends upon its substance, in particular its relation to the reasons and arguments in the decision under appeal, not upon its heading or form.

2. The examination of the document headed "Grounds of Appeal" reveals that no such relation exists, whether one considers the evidence relied upon or the objection raised.

2.1 The first part of that statement (points I to VI) concerns the following items:

I: the requests,

II: a list of the documents on file, which comprises the documents already considered by the Opposition Division (D1 to D8) followed by the new documents submitted (D10 to D14),

III: general considerations about (i) the primacy of Article 114(1) EPC over Article 114(2) EPC, (ii) the interrelated decisions G 9/91 and G 10/91, and (iii) the consequences thereof in the decision T 1002/92 on the admissibility of late-filed evidence,

IV: a detailed discussion of D1 in the same terms as the Opposition Division and leading to the same conclusion as the Opposition Division, this document thus being regarded as the starting point of the invention, i.e. the closest prior art over which the technical problem underlying the patent in suit should be defined,

V: the mere quotation of the reasons, arguments and conclusion taken from pages 9 and 10 of the decision under appeal,

and, without any further comment,

VI: the following conclusion: "Above cited view of the opposition division in the decision would have been completely reversed if document D10) had been known at the time this decision was taken."

2.2 This is followed by technical considerations intended to demonstrate why the patent cannot be maintained in view of the novelty destroying disclosure of D10 (points VI to VIII) and by general background information based on the disclosure of the other late-filed documents (point IX).

In point X the Appellant concludes as follows: "The patent-in-suit is to be revoked in its entirety based on the documents discussed above. The late-filed documents indeed prejudice the maintenance of the European patent-in-suit and therefore are fully admissible."

2.3 In its statement of 19 October 1998 (page 2, last

paragraph) the Appellant admitted that it had left it open whether the first instance decision was right or wrong on the basis of the citations then on file.

During oral proceedings the Appellant acknowledged again that the statement headed "Grounds of Appeal" neither showed that the contested decision was incorrect, nor stated the legal and factual reasons why, when considering the original documents D1 to D8 only, the decision under appeal should be set aside.

3. In the Appellant's view, however, although the statement headed "Grounds of Appeal" was not directly connected with the reasons of the impugned decision, the appeal could still be admissible provided the objections raised gave birth to an entirely new case, not yet examined before. To that end it relied upon the following case law.

3.1 In decision T 611/90 the opposition, in which the revocation of the contested patent had been requested on the grounds of lack of novelty and inventive step, led to an appeal in which an entirely fresh case was developed based on prior public use (cf. Summary of Facts of Submissions, points I and IV). In point 2 of the Reasons for the Decision the Board took the view that the fresh reasons presented were within the same opposition ground and considered the appeal admissible.

3.2 In decision T 708/95, similarly, following two oppositions filed against the patent as granted on the grounds that its subject-matter lacked both novelty and inventive step, one of the Appellants lodged an appeal and filed a statement which did not criticize the

decision rendered by the Opposition Division, but rather relied on new documents to support the previous objections (cf. Summary of Facts and Submissions, points II and IV). Although this constituted a so-called fresh case, the appeal was found admissible as being based on one of the opposition grounds raised initially (cf. Reasons for the Decision, point 1.2).

3.3 In decision T 1002/92 in the appeal proceedings the Appellant relied on a document which had been disregarded by the Opposition Division pursuant to Article 114(2) EPC and on several new documents to support its previous objections (cf. Summary of Facts and Submissions, points II, III(c), IV and VII(a)). Even if it appears from the Reasons for the Decision that the relevance of the late-filed evidence was the decisive criterion regarding its admissibility into the proceedings, these considerations concerned an appeal which was based on at least one ground for opposition already covered by the opposition statement and was thus found admissible (cf. Reasons for the Decision, points 3.3 to 3.5 and 4.2).

3.4 In decision T 389/95, whilst the opposition on the grounds of lack of novelty and inventive step was based on certain documents, the statement filed in support of the appeal made no reference to these citations, nor to the reasons on which the decision under appeal was based, but introduced new prior art and evidence to support an objection of prior public use (cf. Summary of Grounds and Submissions, points II and III). In that case too, the Board was satisfied that the appeal was admissible (cf. Reasons for the Decision, point 1), even if additional considerations were made in the

light of the decision G 10/91 which had been issued in the meantime.

3.5 As the written and oral submissions of the parties made clear, these decisions have in common that (i) the statement containing the Grounds of Appeal did not deal with the reasons given in the appealed decision, (ii) reference was made to at least one new document, and (iii) the objection raised did correspond to at least one of the grounds for opposition mentioned in the respective Notices of Opposition. In the case of the present appeal, however, the latter condition is not fulfilled, since lack of novelty was not a ground for opposition.

3.6 This difference makes the reference to the Commentary by R. Schulte clearly inappropriate, since in the above mentioned Section (marginal number) 48 (cf. point IV(ii)) the issue of admissibility of the appeal is determined by the relevance of the new document without consideration of the ground for opposition actually concerned. The latter is, however, of crucial importance in the light of more recent case law, as will appear hereinafter.

4. In its oral submissions the Appellant relied particularly on the conclusions reached by the Enlarged Board of Appeal in its Decision G 7/95.

4.1 The circumstances which led to the Decision of Referral to the Enlarged Board of Appeal in the case G 7/95, i.e. decision T 514/92 (OJ EPO 1996, 270), can be summarized as follows (cf. Summary of Facts and Submissions, points I, IV, V and VI):

4.1.1 The Notice of Opposition was based on the grounds that (i) the subject-matter of the European patent was not patentable (Articles 52(1) and 56 EPC) in view of documents D1 to D4, and (ii) the European patent did not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Articles 100(b) and 83 EPC).

4.1.2 In the appeal proceedings the Appellant for the first time raised an objection of lack of novelty based on one of the documents which had been in the proceedings from the beginning (document D4) and additionally filed four new documents.

4.1.3 The Patentee argued that this was a new and inadmissible ground for opposition raised three years after the end of the opposition period.

4.1.4 The Appellant put forward that the starting point of the objection against patentability, whether expressed in terms of lack of novelty or expressed in terms of lack of inventive step, was still the same, i.e. document D4, from which it followed that the new objection did not amount to a new ground for opposition. The other late-filed documents had only been cited to clarify the meaning of a particular passage in D4.

4.2 Consultation of the file T 514/92 in order to clarify the situation described in point 4.1.2 above brings to light that the Statement of Grounds of Appeal filed on 5 August 1992 contained a detailed discussion of both document D4 and the reasons given in the decision under appeal (cf. points 1 to 10). That was followed by the

opinion of an expert that the parameter allegedly conferring novelty over document D4 would have been obvious in the light of the newly cited documents or should even be regarded as implicitly disclosed in document D4 (cf. points 11 to 16).

Thus the Decision of Referral to the Enlarged Board of Appeal concerned an appeal case in which (i) a written statement setting out the grounds of appeal meeting the requirements of Article 108, third sentence, EPC had been filed, and (ii) the objection of lack of inventive step based on the same document, i.e. document D4 or the closest prior art, had been maintained throughout the whole opposition/appeal proceedings. It followed that the admissibility of the appeal was not an issue.

This also appears from the final decision T 514/92 of 16 April 1997 (not published in OJ EPO), which followed the Decision of the Enlarged Board of Appeal, wherein it is merely stated that "The appeal is admissible" (cf. Reasons for the Decision, point 1).

4.3 It was against this background that the following question of law was referred to the Enlarged Board of Appeal (Article 112(1)(a) EPC):

"In the case where a patent has been opposed under Art. 100(a), on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal

exclude the new allegation because it introduces a new ground of opposition?".

4.4 The answers given in the Enlarged Board's decision G 7/95 read as follows:

"7. This question refers to a case where an opposition has been substantiated on the ground of lack of inventive step having regard to certain documents identified in the notice of opposition, the opposition being based in particular upon one document, the closest prior art document. During the appeal proceedings the opponent raised the objection for the first time that the claimed invention lacked novelty in view of this closest prior art document.

7.1 It follows from what is stated above that an objection of lack of novelty is a different legal objection having a different legal basis from the objection of lack of inventive step. Therefore, the objection of lack of novelty cannot be introduced into the appeal proceedings without the agreement of the patentee, because it constitutes a "fresh ground for opposition" within the meaning of paragraph 18 of G 10/91.

7.2 Nevertheless, in a case such as that under consideration in the decision of referral in case G 7/95, if the closest prior art document destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results

in such subject-matter being unallowable on the ground of lack of inventive step.

7.3 Having regard to the particular facts of the case before the referring board in case G 7/95, it is not necessary for the Enlarged Board to answer the referred question insofar as it relates to a new allegation that the claims lack novelty in view of any other document than the previously cited closest prior art document."

4.5 Contrary to the Appellant's assertion G 7/95 does not provide the missing link between T 611/90, which corresponded to an appeal connected with the opposition proceedings by means of new evidence within the same ground for opposition, and the present appeal case.

4.5.1 As far as the answer in point 7.2 of G 7/95 is concerned, it cannot be applied to the present appeal because of a different legal and factual context.

The examination of the two decisions in case T 514/92 has brought to light that the initial objection of lack of inventive step was properly substantiated and maintained in the appeal proceedings, irrespective of the new objection of lack of novelty, so that the issue of admissibility did not arise. Moreover, the new objection of lack of novelty was based on the same document as the objection of lack of inventive step, i.e. document D4, in other words on technical elements present from the beginning of the opposition proceedings as first supporting the objection of lack of inventive step, but additionally construed in the appeal proceedings as an allegedly novelty destroying

disclosure.

In the present case, by contrast, there is no such relation between the appeal and the opposition proceedings, either regarding the evidence relied upon, or regarding the grounds. On the one hand, the technical elements relied upon by the Appellant to support the new objection of lack of novelty could not be considered in opposition proceedings, since they derive from D10, i.e. a new document submitted for the first time together with the Statement of Grounds of Appeal; on the other hand, the Appellant failed to indicate how these new technical elements could or should be construed additionally to support the original objection of lack of inventive step, in case the new objection of lack of novelty turned out not to be tenable. For these reasons, the present appeal cannot be regarded as "a case such as that under consideration in the decision of referral in case G 7/95".

4.5.2 Regarding the considerations in point 7.3 of G 7/95, they are formulated in sufficiently broad terms to encompass the situation underlying the present appeal. Although the Enlarged Board of Appeal expressly did not answer the referred question, the option left open must in any case be considered in the context of the situation underlying the decision T 514/92, where the admissibility of the appeal was not an issue.

4.5.3 It is self-evident that a prerequisite for any request by a party concerning the legal and factual framework of the appeal proceedings to be considered is that the appeal is admissible. In particular, neither the

introduction of a new ground for opposition, which according to G 10/91 requires the Patentee's consent, nor the admission into the proceedings of a late-filed document, which pursuant to Article 114(2) EPC is left to the discretion of the Board, can be decisive issues for the admissibility of an appeal. The fact that in the present case the Respondent, as envisaged in the answer in point 7.1 of G 7/95, did not give its consent to the introduction into the proceedings of the new objection of lack of novelty has thus no bearing on the issue of admissibility of the appeal.

5. The case law relied upon by the Appellant shows (i) that an appeal not connected with the reasons of the impugned decision may still be admissible provided the new facts and evidence concern the same ground for opposition, and (ii) that in the framework of an admissible appeal a new objection of lack of novelty may exceptionally be raised with the agreement of the Patentee, provided it is based on the same technical elements as the original objection of lack of inventive step. This link between the appeal proceedings and the opposition proceedings, either by means of the same ground for opposition or by means of the same technical elements, is nothing else than the requirement expressed in G 9/91 and G 10/91 that the appeal proceedings should be based on the same legal and factual framework as the opposition proceedings. In the absence of such a link, the appeal is tantamount to a new opposition.

For these reasons the present appeal is inadmissible.

6. The appeal being inadmissible, neither the request for the referral of a question of law to the Enlarged Board

of Appeal, nor the substantive issues can be considered.

Order

For these reasons it is decided that:

The appeal is rejected as inadmissible.

The Registrar: The Chairman:

E. Görgmaier C. Gérardin