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**D E C I S I O N**  
**of 28 September 2000**

**Case Number:** T 0382/97 - 3.3.6

**Application Number:** 88113746.7

**Publication Number:** 0314890

**IPC:** C11D 17/04

**Language of the proceedings:** EN

**Title of invention:**

Dispenser for an article comprising a water soluble bag containing a pelletized functional material, and methods for its use

**Patentee:**

ECOLAB INC.

**Opponent:**

UNILEVER N.V. / UNILEVER PLC

**Headword:**

Dispenser/ECOLAB

**Relevant legal provisions:**

EPC Art. 54, 56, 99(1), 108, 114(2)  
EPC R. 57a, 71a, 55(c), 64(b)

**Keyword:**

"Main request: novelty - no"  
"First auxiliary request: inventive step - yes"  
"Procedural violation - no"

**Decisions cited:**

G 0009/91, G 0010/91, T 0463/95, T 0755/96, T 0633/97

**Headnote:**

I. Whereas Rule 57a EPC establishes explicitly the patent owner's right to amend its patent according to the criteria laid down in this rule, it does not entitle a patent proprietor to submit amendments of its patent at any time, i.e. also during oral proceedings, without the need to give good reasons for such late filing. Rules 57a and 71a EPC together govern the procedural preconditions for the admissibility of amendments of a patent by its proprietor before the Opposition Division. However amendments not complying with the time limit set under Rule 71a EPC may be admitted if good reasons can be acknowledged for their late submission (point 6.6 of the Reasons for the Decision).

II. A patent owner's right to amend its patent in accordance with Rule 57a EPC cannot be equated automatically with a right to file additional auxiliary requests. Any amendment has to be carried out in the most expedient manner which has to be established by the Opposition Division taking into due account the interest of all parties concerned (point 6.7 of the Reasons for the Decision).



Case Number: T 0382/97 - 3.3.6

**D E C I S I O N**  
**of the Technical Board of Appeal 3.3.6**  
**of 28 September 2000**

**Appellant:** ECOLAB INC.  
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**Decision under appeal:** Decision of the Opposition Division of the  
European Patent Office posted 4 February 1997  
revoking European patent No. 0 314 890 pursuant  
to Article 102(1) EPC.

**Composition of the Board:**

**Chairman:** P. Krasa  
**Members:** G. Dischinger-Höppler  
J. H. P. Willems

## Summary of Facts and Submissions

- I. This appeal is from the decision of the Opposition Division to revoke European patent No. 0 314 890 relating to a dispenser for an article comprising a water soluble bag containing a pelletized functional material and methods for its use on the basis of the granted claims (the patent proprietor's then pending main request).
- II. In a notice of opposition, based on lack of novelty and on lack of inventive step, a number of documents had been submitted, inter alia
- (1) US-A-3 198 740,
  - (3) US-A-4 155 971 and
  - (11) US-A-4 426 362.

In its decision, the Opposition Division, which introduced under Article 114(1) EPC the documents

- (12) US-A-3 595 438,
- (13) US-A-4 020 865 and
- (14) US-A-4 063 663

into the proceedings, held in particular that it was obvious for a person skilled in the art to use the detergent products of documents (1) or (3) in a dispenser as disclosed in document (14).

Amended sets of claims submitted by the Appellant (Proprietor) in auxiliary requests 1 to 3 during the oral proceedings before the Opposition Division were not admitted to the proceedings as being filed late and not at first sight formally admissible.

III. With its statement of grounds of appeal, the Appellant maintained these main and auxiliary requests. Following a communication dated 8 September 2000 wherein the Board indicated that it also intended to consider the auxiliary requests 1 to 3 and consequently also to address the question of admissibility of the amendments made to the claims thereof, the Appellant filed in a letter of 14 September 2000 (received on 15 September 2000) four further auxiliary requests (4<sup>th</sup> to 7<sup>th</sup>) containing amended claims without giving reasons for the justification of this submission under Rule 57 a EPC, and one further auxiliary request (8<sup>th</sup>) wherein remittal of the case for further prosecution to the Opposition Division was sought.

IV. Oral proceedings were held before the Appeal Board on 28 September 2000, in the course of which the Appellant, upon objections under Article 54 EPC, again filed new auxiliary requests containing further amended claims, namely in a 9<sup>th</sup>, 10<sup>th</sup> and 11<sup>th</sup> auxiliary request.

The Board expressed its reservation concerning the unsubstantiated filing of numerous additional auxiliary requests, but emphasized that it was open to consider amendments in accordance with Rule 57a of the claims of already admitted requests. Thereupon, the Appellant maintained its main request and declared the claims of the 9<sup>th</sup> to 11<sup>th</sup> auxiliary requests as being amendments to the claims of auxiliary requests 1 to 3. In addition,

the Appellant maintained its request for remittal of the case as fourth auxiliary request. All the other requests were withdrawn.

Independent Claim 1 of the main request reads:

"1. A dispenser for dispensing by the action of a liquid an article of manufacture wherein said article comprises: (a) a sealed water soluble container; and (b) at least 200 grams of a pelletized water soluble or dispersible functional composition contained within said water soluble container, wherein said water soluble container fits within said dispenser, and the pelletized functional composition comprises: (i) 5-90 wt-% of an alkali metal silicate; and (ii) 1-90 wt-% of a sequestering agent."

The claims of the auxiliary requests are all restricted to three independent method Claims 1 to 3, those of the first auxiliary request reading:

"1. A method of dispensing functional material from a dispenser by directing water onto an article contained in said dispenser in order to form a concentrate and directing said concentrate to a use location wherein said article comprises: (a) a sealed water soluble container; and (b) an institutional multiple use amount of at least 200 grams of a pelletized water soluble or dispersible functional composition comprising: (i) 5-90 wt-% of an alkali metal silicate; and (ii) 1-90 wt-% of a sequestering agent.

2. A method for delivering an aqueous alkaline wash chemical, the method comprising: (a) placing into a dispensing device an article comprising: (i) a

container comprising a sealed, water-soluble film; and (ii) an institutional multiple use amount of at least 200 grams of a pelletized, water soluble or dispersible wash chemical comprising a silicate, an alkali metal hydroxide or mixtures thereof contained within the container; (b) directing water onto the article contained within the dispenser to open and to dissolve the film and to form a supply of an alkaline wash concentrate; and (c) directing the supply of alkaline wash concentrate from the dispenser.

3. A method of dispensing multiple volumes of an aqueous solution of a wash chemical from a dispenser comprising the steps of: (a) depositing a sealed water soluble article containing a wash chemical into said dispenser; (b) repeatedly directing water onto an article contained in said dispenser in response to a concentration monitoring device in order to form a concentrate; and (c) repeatedly directing said concentrate to a use location wherein said article comprises; (i) a sealed water soluble container made of a flexible film, and (ii) an institutional multiple use amount of at least 200 grams of a pelletized water soluble or dispersible wash chemical comprising a silicate, an alkaline metal hydroxide or mixtures thereof contained within said sealed water soluble container made of a flexible film."

V. During the appeal proceedings, the parties only relied on the above cited documents (1), (3), (11), (12), (13) and (14) from among those previously considered.

VI. The Appellant in writing and orally submitted in essence the following arguments:

- Any objection under Article 54 EPC was not to be admitted by the Board since this ground of opposition had been withdrawn during the opposition proceedings by the Respondents (Opponents).
- Considering the description of the patent in suit, Claim 1 of the main request related to a dispenser containing a water-soluble container filled with a pelletized functional composition. Such a dispenser was not anticipated by the cited prior art.
- The development in dispenser technology led away from any use of pelletized material in a dispenser.
- The closest prior art was represented by the dispenser containing a solid block composition disclosed in document (11).
- This document (11) also showed that the problem of uneven dissolution due to caking was not solved by prior art dispensers using detergent powders as disclosed in documents (12) to (14).
- Nothing in the art suggested filling a dispenser with an individual water-soluble film bag containing a pelletized detergent material.

Concerning the 4<sup>th</sup> auxiliary request, the Appellant submitted for the first time in its letter of 14 September 2000 that refusing to admit auxiliary requests 1 to 3 filed during the oral proceedings before the Opposition Division amounted to a



substantial procedural violation which justified the request for remittal of the case to the first instance.

VII. The Respondent requested that none of the auxiliary requests filed during the appeal proceedings be considered, supported the opinion set out in the contested decision relating to lack of inventive step and presented the following further arguments:

- The subject-matter of Claim 1 of the main request was anticipated by the teaching of document (14) since it merely related to a dispenser suitable for dispensing a pelletized composition.
- Document (14) represented the closest prior art as it related to the same problems as the patent in suit.
- It was obvious to combine the detergent containing water-soluble bags for domestic washing machines of documents (1) or (3) with the dispenser technology used in institutional apparatuses, in particular since document (11) hinted at the using of pellets in dispensers.
- The prior art did not contain any warning against using water-soluble bags in institutional washing machines.

VIII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted (main request), alternatively according to auxiliary requests 1 to 3 submitted during the oral proceedings and designated as 9<sup>th</sup>, 10<sup>th</sup> and 11<sup>th</sup> auxiliary request or that the decision under appeal be set aside

and that the case be remitted to the Opposition Division for further prosecution (auxiliary request 4).

The Respondent requested that the appeal be dismissed.

## **Reasons for the Decision**

### *Substantial matters*

#### 1. *Main request*

##### 1.1 The claimed subject-matter

The claims relate to a dispenser for dispensing a particular article of manufacture (Claims 1 to 9) as well as to several methods for its use (Claims 10 to 12).

The Appellant submitted that, while not being a ground for opposition, the wording of product Claims 1 to 9 might be considered not to clearly define the claimed dispenser which according to the description of the patent in suit unequivocally included as part of it an "article" which comprises the sealed water-soluble container (a) filled with the pellets (b). In this respect, the Appellant in particular relied on lines 5 and 6 of page 2 and on lines 54 to 56 of page 8 in combination with figure 2 and its description.

The definition of the "article" is given on page 3, lines 47 to 49 as comprising a sealed water soluble bag containing a pelletized functional composition. Denoted with reference sign 16, this article is shown in Figure 2, to which this statement refers. However, it is clear

from the Figure that the article 16 does not designate the combination of a dispenser with an inserted sealed water soluble bag but only the latter as such. The same fact results from the statement on page 8, lines 54 to 56 reading "the article 16 can be used in various types of dispensers" and is corroborated by several further statements of similar meaning made in the description of the patent in suit: e.g. on page 6, lines 29 to 30 ("article 16 can be used in a variety of dispensers"), on page 7, lines 17 to 18 ("the article 16 should ... be ... inserted into the dispenser"), or on page 8, lines 50 to 51 ("placing the article 16 inside the dispenser"). This is not in contradiction to the very beginning of the description on page 2 where the "Field of the Invention" is defined (see heading of the respective paragraph) and which starts with the statement that "the invention relates to a dispenser comprising a water soluble container containing a pelletized water soluble or dispersible functional composition". The invention itself is defined for the first time - and with the same wording as in granted Claim 1 - on page 3, lines 11 to 20 of the patent in suit.

Consequently, the Board concludes that the subject-matter of Claim 1 is a dispenser suitable for dispensing by the action of a liquid an article of manufacture wherein said article comprises container (a) and pellets (b) of a particular detergent composition.

## 1.2 Novelty

The Respondent's notice of opposition was inter alia based on the ground of lack of novelty. Contrary to its

allegation put forward during the oral proceedings, the Appellant could not provide evidence that this ground of opposition had been withdrawn during opposition proceedings. In contrast, in point 2 of the reasons for the appealed decision, the Opposition Division discusses the novelty issue in detail. Therefore, this issue is no newly raised ground for opposition and the Board has the power to investigate it.

Document (14) describes an apparatus for attachment to a washing machine comprising

- a container for powdered detergent,
- a screen member mounted above a lower outlet port of and within the container to retainably carry the powdered detergent,
- water supplied spray-forming nozzle means for directing a uniform spray at the detergent held by the screen member and
- a conduit connecting the outlet port with the washing machine for directing the detergent solution into the washing machine (see Claim 1 and Figure 1).

The dispenser of Claim 1 is not defined by any particular constructional features by which it could objectively be distinguished from the prior art. The Appellant did not provide any arguments why this dispenser apparatus, whilst being suitable for dispensing by the action of a liquid a powdered detergent, was not also suited to dispense by the same action an article composed of a pelletized water

soluble detergent comprised within a sealed water soluble bag. Moreover, one of the objects of the patent in suit is to enable customers to use for non-powdered detergents just those dispensers which are already in use for powdered detergents (page 2, lines 34 to 36). Therefore, the Board is convinced that the apparatus of document (14) complies with that demand.

For these reasons, the Board concludes that the dispenser of Claim 1 cannot be distinguished from that of document (14) and is consequently not novel.

2. *First auxiliary request*

2.1 Claims 1 to 3 correspond to Claims 10 to 12 as granted. They are therefore formally admissible.

Concerning the wording of Claim 1, the following is to be noted:

According to the patent in suit (page 3, lines 31 to 49) the pelletized composition (b) is contained within the sealed water soluble container (a) (see 1.1 above). This is confirmed by the wording of independent Claims 2 and 3. In the patent in suit no room is left for any other interpretation. Therefore, this same meaning must be given to Claim 1 even though this fact is not quite clear from the wording of the claim itself.

2.2 Novelty

None of the cited prior art documents discloses a method of dispensing a functional material by the action of a water spray onto an article within a

dispenser which article comprises a sealed water soluble container and a pelletized water soluble functional composition comprising a silicate and/or alkali metal hydroxide. This was not contested by the Respondent.

The Board, therefore, concludes that the subject-matter of independent Claims 1 to 3 is novel.

### 2.3 Inventive Step

It therefore remains to be assessed whether or not the claimed methods are based on an inventive step.

#### 2.3.1 Technical background

The patent in suit relates to the technical field of institutional and industrial cleaning, warewashing and laundering by using solid detergents, wherein two kinds of detergent dispensers are known, namely those which are said to be preferably used in the art and suitable for powdered detergents and those suitable for solid cast detergents in the form of a solid detergent block.

In both cases, the detergent is contacted with a water spray in order to form a detergent solution (page 2, lines 17 to 22). All these institutional detergent dispensers are basically different from single use domestic detergent units, such as, for example, those described in documents (1) or (3), due to their qualification for multiple dispensing action. Therefore, institutional dispensers are designed to contain a multiple use amount of detergent.

Institutional dispensers for powdered detergents are

e.g. known from documents (12), (13) and (14). An institutional dispenser for a solid cast detergent is e.g. described in document (11).

Both kinds of dispensers are said to have drawbacks (see patent in suit, page 2, lines 23 to 36 and 44 to 48). Dispensers using powdery detergents can involve hazards for the user in that the highly alkaline detergent powders are easily spilled and exhibit dusting when being handled. Moreover, the powders have the tendency to clump and cake when contacted with water and thereafter dried which results in uneven dissolution and diminished dispensing efficiency. These problems have been solved in dispensers using solid block detergents which, however, are substantially different from those conventionally used with powdery material so that the customer must replace the old equipment with a new one. In addition, these dispensers cannot be refilled until the detergent block has been completely utilized.

### 2.3.2 Closest prior art

The parties disagreed on the issue of the most relevant prior art. While the Appellant found that document (11) should be used as a starting point for assessing inventive step, the Respondent argued that document (14) represented the closest prior art since it was concerned with the same objects as the patent in suit, namely with respect to the hazards related to the use of powdery detergents (column 2, lines 14 to 56) and to the ability of being refilled. Concerning the latter object, the Respondent referred to the access port mentioned in column 4, lines 50 to 57 of document (14) from which a person skilled in the art would infer that

the dispenser was refillable.

However, as can be best seen from the technical background recited in document (11), the development in dispenser technology, after trying to improve the powder dispensers of documents (12) and (13) by the constructional amendments suggested in document (14) (column 2, lines 20 to 57), has turned to a completely different approach and has eventually ended up in the design of a dispenser containing a block of solid detergent to overcome the drawbacks of powder dispensers (document (11), column 5, lines 24 to 43). Therefore, the Board considers document (11) as the most promising starting point, since the skilled person would, in all probability, not try to improve an old prior art whose deficiencies were already overcome by a new development.

### 2.3.3 Technical problem and its solution

The problem existing with dispensers for solid block detergents of document (11) can be seen in the fact that they are not continuously refillable and that customers using powdery detergents cannot use their existing equipment (see point 2.3.1). The problem solved by the claimed subject-matter can be seen in overcoming these deficiencies while retaining the advantages of the solid block detergents in comparison with powdered detergents. According to the three alternatives given in the independent Claims 1 to 3, it is proposed to solve this problem by a method of dispensing a functional material, such as an alkaline wash chemical, in the form of pellets, contained in a sealed water soluble container (in particular Claims 2 and 3) from a conventional dispenser by using this



dispenser in the conventional manner.

It is evident that these methods ensure that the dispensers can be refilled at any time and that the existing equipment for dispensing powdery detergents can be used. It is further evident that the drawbacks of dusting powders cannot occur due to the enclosure of the pelletized detergent material in a sealed water-soluble bag. Finally, the Board considers it to be credible that pelletized detergent material is, as a matter of principle, less subject to clumping and caking upon water treatment than is powdery material. On the other hand, dissolution rate generally decreases with increasing particle size. Nonetheless, it has been shown in the examples of the patent in suit that it is possible to obtain the desired final concentrations of detergent solution within a sufficient short period of time (about 2 to 3 minutes). Thus, the Board concludes that the claimed subject-matter solves the existing technical problem.

2.3.4 It remains to be decided whether, in view of the available prior art documents, it was obvious for someone skilled in the art to solve the above technical problem by the means claimed.

2.3.5 The Respondent argued that document (11) hinted at the use of pelletized material since it disclosed not only a container holding a solid block detergent but also a second container holding a second solid detergent in the form of pellets, such as a chlorine source or a defoamer detergent composition (column 12, line 58 to column 13, line 6). Therefore, it was obvious for a skilled person also to consider it appropriate to fill an institutional dispenser with pelletized detergent

material. Moreover, the inclusion of such material in a water soluble container in order to reduce any inconveniences and hazard generated by dusty material was obvious from documents (1) or (3).

2.3.6 The Board is not convinced by this line of argument for the following reasons:

Apart from the disadvantages arising from the handling of powdered detergents, document (11) seeks to overcome further problems which still exist when modern detergent powders are used in the dispensers of documents (12) to (14) (column 3, lines 64 to column 4, line 59). It is said that due to the demands for higher sanitary standards and shorter wash times, such detergents were increasingly complex compositions which were more hazardous to the user and more difficult to dissolve in an uniform manner, the latter inconvenience owing to the different solubility of the varying components contained. In addition, such compositions are said to be less stable because some of the components required for satisfactory performance might be incompatible with the other ingredients of the detergent mixture. Moreover, where the components differed in particle size and density, segregation of the different constituents could occur during shipping and handling.

Problems are said to arise particularly where the compositions were required to contain instable components such as a chlorine source or a defoamer which are lost in advance because of their premature decomposition.

Document (11) therefore suggests using such instable

components in relatively smaller amounts in a second container, either in the form of a second solid block or as a plurality of pieces (e.g. pellets), thereby separated from the main amount of the detergent composition which is contained in solid block form in a first container (column 5, lines 24 to 43 and column 16, lines 12 to 21).

By this configuration, problems with generally incompatible detergent constituents as well as problems with powdered detergents are said to be overcome and, in particular, uniformity in concentration over the entire charge of detergent held by the dispenser, is said to be ensured (column 19, lines 19 to 33).

The Board, therefore, does not agree with the Respondent's submission that document (11) in column 12, line 58 to column 13, line 10 taught that the composition contained in the second container, e.g. in pelletized form, might as well constitute any detergent composition, but rather concludes from the whole teaching of document (11) that pelletized material is only considered in a very particular instance, namely for instable or incompatible additives such as a chlorine source or a defoamer, which have to be separated from the main detergent composition. It is not suggested in document (11) that the main detergent composition should also be used in pelletized form; instead it is proposed to use it in the form of a solid block to provide a simple, efficient, non-hazardous and reliable technique for producing highly concentrated detergent solutions (column 5, lines 26 to 38). Thus, whereas the authors of document (11) were aware of the pelletizing technology, they did not apply it to the main detergent composition.

Therefore, the Board holds that document (11) rather teaches away from using the detergent composition in particulate or pelletized form.

Concerning the Respondent's second argument, the Board agrees that sealed water-soluble containers for holding powdered or pelletized detergent compositions are known in the art (see document (1), Claim 1; document (3), column 1, lines 46 to 67). These products are, however, designed to contain one single dose of detergent and for domestic application are directly dropped into the water (document (1), column 1, lines 42 to 46; document (3), column 1, lines 33 to 40). Therefore, these documents are not concerned with problems occurring with detergent dispensers configured for multiple dosage.

The Appellant argued that a person skilled in the art realizing the problems of uneven dissolution of solid detergents in multiple use dispensers would not have simply considered the water soluble containers of documents (1) and (3) to be likewise suitable in a dispenser, but - due to the presence of this container as a further ingredient influencing the overall solubility - rather expected even more problems with achieving acceptable dissolution.

The Board notes that the enclosure of powdered detergents in water soluble bags for overcoming powder-inherent hazards has been known since the publishing date of document (1) in 1965. Nevertheless, none of the prior art documents hint at the possibility of applying this technique in a dispenser. This can be seen from document (11) which, 19 years later, gives a detailed review of the developments of dispensers for powdery

detergents and addresses this same problem (column 4, lines 44 to 54), but suggests quite another solution, namely a solid block detergent dispenser.

The Board, therefore, concludes that neither document (11) nor document (1) or (3) contain the information required for making obvious the subject-matter of Claims 1 to 3 for a person skilled in the art.

This also applies to documents (12) to (14) which use powdered detergents but do not even address the problems of dust and hazards related thereto.

- 2.4 No other result is obtained if one starts from document (14) as the closest prior art as suggested by the Respondent.

The problem actually solved in view of document (14) consists in the Board's view in the prevention of powder-born hazards and inconveniences. For the same reasons as set out in section 2.3.6 above, the solution proposed in Claims 1 to 3 of the auxiliary request is not made obvious by the cited prior art. The Respondent has, in particular, not provided any evidence that a skilled person would have combined the technical teachings of documents (1) or (3) with that of citation (14) to solve the technical problem as defined above. In this context it must again be considered that document (14), which was published more than 12 years after document (1), did not even mention the problem. The Respondent's further argument that neither document (14) nor any other prior art warned against the using of water soluble bags is not convincing either since not to mention something which has never been drawn into consideration cannot, in the Board's opinion, be

taken as a suggestion for doing it.

- 2.5 The Board is satisfied that the other documents on file do not provide any incentive for the claimed solution either. Since, during oral proceedings before the Board, the parties did not rely on any of these documents, there is no need to discuss these other documents.
3. The Board holds therefore, that none of the cited prior art documents, either individually or in combination renders obvious the claimed solution of the existing technical problem, and concludes that the methods of Claims 1 to 3 are based on an inventive step within the meaning of Article 56 EPC.
4. Since the above findings correspond to the allowance of the Appellant's first auxiliary request, its second, third and fourth auxiliary requests need not be considered.

*Procedural matters*

5. Admissibility of late filed auxiliary requests
  - 5.1 In the present case, the Appellant submitted four amended sets of claims as auxiliary requests 4 to 7 by the letter dated 14 September 2000. It maintained that these auxiliary requests should be admissible since they were submitted in reply to the "opinion" by the Board dated 8 September 2000. According to the Appellant, a submission of these auxiliary requests at an earlier date had not been possible because of the change of the Appellant's representative who received the complete documents of the file only late.

5.2 The communication of the Board read as follows:

"The parties are informed of the following:

1. The oral proceedings will be based upon Claim 1 to 12 as granted (Appellant's main request) as well as upon Claims 1 to 12 according to three auxiliary requests as filed during oral proceedings held before the Opposition Division on 21 January 1997 and resubmitted with the Appellant's statement of grounds of appeal dated 5 June 1997.
2. As appears from the file, admissibility of the amendments made to the claims of the auxiliary requests has not yet been addressed. Therefore, one of the issues to be dealt with during the oral proceedings scheduled for 28 September 2000 will relate to the question whether the amendments made to the claims of the auxiliary requests fulfill the requirements of Article 123(2) EPC."

It is clear from this quotation that the communication pointed merely to a specific topic to be considered at the forthcoming oral proceedings but, contrary to the Appellant's submission, did not contain any "opinion" of the Board, let alone an objection under Article 123(2) EPC against the claims of the three auxiliary requests referred to in the communication.

5.3 In this situation, if the Appellant nevertheless felt the need to improve claims of its then pending three auxiliary requests in view of the requirements of Article 123(2) EPC, it could and it should have done this by amending them. It was however not appropriate

to simply file four new additional auxiliary requests without commenting either on the need for filing more than one additional request for satisfying Article 123(2) EPC, or on the admissibility of those already pending and remaining unchanged. By such conduct, the Appellant not only left it to the Respondent (and also to the Board) to guess why the former three auxiliary requests should be deemed to be admissible but also unduly multiplied at a rather late stage of the proceedings the Respondent's workload in connection with his case. It is to be noted that the filing of additional auxiliary requests while maintaining already pending auxiliary requests unchanged can hardly be considered as being an **amendment** (of already existing requests) but amounts simply to submitting new requests which, on principle, is not desirable - in particular not at a late stage of appeal proceedings.

5.4 In this connection, it is appropriate to observe that, whereas amendments to a patent may be admissible even at a rather late stage of appeal proceedings, provided that they are appropriate and justified in view of the particular circumstances of a case, this does not mean that a party is completely free as to which steps are to be taken to that end. Rather to the contrary, such late amendments should create as little extra work as possible not only for the other parties but also for the Board (see also T 0794/94 of 17.09.1998, No. 2.2.1 of the Reasons for the Decision; not published in the OJ EPO).

5.5 The Board cannot accept the Appellant's argument that submitting the new auxiliary requests 4 to 7 at an earlier date was not possible due to a change of



representative, for the following reason: The mere change of a representative is, in the Board's judgment, no valid ground which as such could justify the late filing of requests since it would be an arbitrary move of the respective party. Thereby a party could influence which procedural moves have to be considered as belated and which as timely. It is evident that such a situation would be contrary to any reasonable conduct of procedure.

Only if the change of representative was necessitated by exceptional and extraordinary proved circumstances, this might give rise to different conclusions. In the present case, no such reasons were given by the Appellant which, therefore, cannot succeed with this argument.

6. Substantial procedural violation

6.1 In its letter of 14 September 2000, the Appellant for the first time alleged that the Opposition Division committed a substantial procedural violation by not admitting three auxiliary requests submitted during oral proceedings for being late filed.

6.2 During the opposition proceedings of the present case, the Opposition Division had indicated in an annex to the summons to oral proceedings, dated 8 August 1996, its provisional opinion on the case. It raised several objections concerning the patentability of the subject-matter of the then pending claims. The Opposition Division reminded the parties "that according to Rule 71a EPC, further submissions must be filed at the EPO at the latest one month before the date fixed for Oral Proceedings".

According to Rule 71a (2) EPC such a time limit also applies to requests made by a patentee, in particular where it has been notified of grounds prejudicing the maintenance of the patent. In view of the fact that **both** parties were referred to Rule 71a EPC and to the possibility to file further submissions, the Board finds that the Appellant had also been invited to submit amendments to its patent - contrary to the Appellant's allegation that it was not invited to do so.

Nonetheless, the Appellant submitted three auxiliary requests only at the beginning of the oral proceedings (Minutes of the proceedings dated 4 February 1997, first paragraph). In its final decision, the Opposition Division dismissed these auxiliary request not merely for being late-filed but also gave as material grounds that these requests were not at first sight admissible in the sense that the amendments made to the claims of these requests were formally allowable.

- 6.3 The Appellant argued that the only requirement for a patentee to amend his patent as laid down in Rule 57a EPC were substantive issues which were not subject to any time limits.

Further, he referred to decisions T 463/95 and T 755/96 in support of his case.

- 6.4 In the present case and unlike the case dealt with in T 463/95 (dated 29 January 1997, unpublished in the OJ EPO, reasons No. 2), the amendments made to the claims of the auxiliary requests filed during the oral proceedings before the Opposition Division are not based on granted claims only. This decision is,

therefore, not applicable to the present case.

Nor is T 755/96 (OJ EPO 2000, 174) applicable, if only for the reason that it relates to an ex-parte case where no interest of an opposing party was to be considered.

6.5 In the present inter-partes case, in order to avoid a party being taken by surprise by unexpected submissions, the Opposition Division correctly requested that any submissions be made by the parties one month in advance of the oral proceedings. The Appellant simply did not comply with this request without giving good reasons. Only at the beginning of the oral proceedings, i.e. almost at the latest moment at all, he came up with the three auxiliary requests under consideration.

6.6 The Appellant tried to justify its disregard of the time limit set by the Opposition Division by referring to Rule 57a EPC which, as it stated, "was created as a *lex specialis* for amendments during opposition proceedings" and did not "specify the point in time up to which the amendment is allowed" (letter of 14 September 2000, page 3, last full paragraph).

The Board agrees that Rule 57a EPC establishes explicitly the patent owner's right to amend its patent according to the criteria laid down in that rule. However, the Board cannot accept the Appellant's argument that the absence of a time limit in Rule 57a EPC entitles a patent proprietor to submit amendments of its patent at any time, i.e. also during oral proceedings, without the need to give good reasons for such late filing. Rules 57a and 71a EPC together

govern, in the Board's judgment, the procedural preconditions for amendments of a patent by its proprietor before the Opposition Division, which amendments must, of course, comply with the requirements of Articles 123(2) and (3) EPC: Rule 57a EPC creates the legal basis for such an amendment and Rule 71a EPC gives the appropriate point in time for such an amendment. It has to be emphasized in this connection that of course amendments not complying with a time limit set under Rule 71a EPC may nevertheless be admissible, if good reasons can be acknowledged for their late submission.

6.7 Finally, the Board notes that the patent owner's right to amend its patent in accordance with Rule 57a EPC cannot be equated automatically with a right to file additional auxiliary requests. Any amendment has to be carried out in the most expedient manner which has to be established by the Opposition Division taking into due account the interest of all parties involved.

6.8 For all the reasons set fourth in points 6.2 to 6.7 above, the Board concludes that the Opposition Division did not commit a substantial procedural violation.

## Order

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

The decision under appeal is set aside and the case is remitted to the first instance with the order to maintain the patent in amended form with Claims 1 to 3 according to the first auxiliary request submitted during oral proceedings, with a description to be adapted thereto and with figures 1 to 3 as granted.

The Registrar:

The Chairman:

G. Rauh

P. Krasa