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D E C I S I O N
of 11 October 2000

Case Number: T 0385/97 - 3.3.2

Application Number: 91905092.2

Publication Number: 0516711

IPC: A61C 9/00

Language of the proceedings: EN

Title of invention:

Preloaded Thermoplastic Dental Impression Tray

Patentee:

MINNESOTA MINING AND MANUFACTURING COMPANY

Opponent:

OMEGA Patentverwertungsgesellschaft mbH

Headword:

Dental impression tray/MINNESOTA MINING AND MANUFACTURING CO.

Relevant legal provisions:

EPC Art. 114(1), 113(1)

Keyword:

"Remittal: yes"

Decisions cited:

G 0009/91, G 0010/91

Headnote:

If first instance departments and/or parties have failed to take account of highly relevant matter which is clearly available in the file and which relates to a ground of opposition, the Board's competence extends to rectifying the position by consideration of that matter provided the parties' procedural rights to fair and equal treatment are respected

(Reasons 3.2).



Case Number: T 0385/97 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3.3.2
of 11 October 2000

Appellant: OMEGA
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Respondent: MINNESOTA MINING AND MANUFACTURING COMPANY
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 6 February 1997
rejecting the opposition filed against European
patent No. 0 516 711 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: P. A. M. Lançon
Members: U. Oswald
C. Rennie-Smith

Summary of Facts and Submissions

- I. The Respondent's application for a European patent, entitled "Preloaded thermoplastic dental impression tray" and based on International application No. PCT/US91/01245, was published on 9 December 1992. It designated the contracting states CH, DE, DK, ES, FR, GB, IT, LI, NL and SE and claimed a priority date of 23 February 1990. Opposition to the resulting European patent No. 0516711 ("the Patent") was filed on 13 January 1995 by the Appellant. In its decision posted on 6 February 1997, the Opposition Division rejected the opposition and upheld the patent as granted. By its Notice of Appeal dated 9 April 1997, the Appellant appealed against that decision.
- II. The Patent as granted and upheld contained two independent claims - claim 8 for a pre-loaded impression tray and claim 1 for a method for preparing a dental model using such a tray.
- III The opposition as filed contained only one ground of opposition, namely lack of inventive step (Articles 100(a) and 56 EPC). No other ground of opposition was mentioned during the opposition proceedings until the oral proceedings which were held on 15 November 1996. The minutes of those oral proceedings record:
- "The opponent states that although novelty of the claimed subject-matter is questionable, he restricts his submissions to lack of inventive step, especially with regard to recent decisions of the Enlarged Board of Appeal."

The subsequent written decision of the Opposition Division said similarly (in "Facts and Submissions", paragraph 10):

"During the oral proceedings the Opponent pointed out that the novelty of the claimed subject-matter was questionable. He restricted his submissions to lack of inventive step, especially with regard to recent decisions of the Enlarged Board of Appeal (G1 and G7 of 1995) and because the Patentee objected that novelty was a novel ground of opposition."

and continued later (in "Reasons", paragraph 2) as follows:

"2. Art. 54 EPC.

The novelty was not disputed.

The Opposition Division considers the method of claim 1 to be novel since none of the documents disclose:

"**heating** a thermoplastic impression material **in the tray** until the material melts or softens". (*Emphasis in the original*)

None of the cited documents discloses a preloaded impression tray comprising a solid (softening temperature between body temperature and 75°C) thermoplastic impression material. Therefore the subject-matter of claim 8 is also novel."

The documents cited in the opposition proceedings, and by reference to which the Patent was thus found to be novel in the passage just quoted, were:

(1) DE A-3810907

(2) EP A-0173085

(3) EP A-0174713

(4) JP A-1268613.

Save as mentioned above, the minutes and the written decision show only that inventive step was argued by the parties and considered by the Opposition Division and that, as already mentioned, the opposition failed.

IV. In its Grounds of Appeal filed on 5 June 1997, the Appellant introduced a new document

(5) "Zum derzeitigen Stand der Abformung in der Zahnheilkunde", a "Habilitationsschrift" by Dr. med. dent. Bernd Wöstmann, Medizinische Fakultät der Westfälischen Wilhelms-Universität, 1992, contents pages and pages 1-37 (text) and 233-265 (bibliographic references)

and argued that, in the light of common general knowledge at the priority date of the Patent as evidenced by document (5), the Patent was not novel over the previously-cited prior art.

V. In its written reply to the Grounds of Appeal filed on 9 October 1997, the Respondent observed "...it is evident that the Appellant, once again, tries to question the novelty of the claimed subject-matter" but did not object to the introduction of novelty as a ground of opposition. The Respondent's reply then adduced arguments disputing the Appellant's contentions with regard to document (5).

VI. By a communication faxed to the parties on 6 October 2000, the Board, after observing that novelty appeared from the written appeal proceedings to be an issue, drew the parties' attention to

(6) EP A-0359135 for the designated contracting states DE, FR, GB and IT, filed on 7 September 1989 and published on 21 March 1990.

Document (6) was cited on page 3, lines 8 to 21 of the description in the application as originally filed (see 3.1 below) and forms prior art as far as those four contracting states are concerned by virtue of Article 54(3) EPC. The Board's communication concluded with the opinion that document (6) appeared to call into question the novelty of the impression tray the subject of independent claim 8 of the Patent.

VII. Oral proceedings were held on 11 October 2000, having been requested by both parties. The Respondent made a number of submissions on procedural issues which can be summarised as follows:

- Novelty should not be admitted as a ground of opposition. It did not form such a ground in either the written or oral proceedings at first instance. The minutes of those oral proceedings (see the passage quoted in III above) showed no argument was heard as regards novelty. The Respondent would accept that, if novelty had been raised by the Opposition Division of its own motion, it could then be considered as a ground of opposition on appeal. However, novelty was only considered for the first time in the Opposition Division's written decision, issued after the oral

proceedings were concluded, which should not form part of "the proceedings" for this purpose. Thus the Enlarged Board of Appeal decisions G 9/91 (OJ 1993, 408) and G 10/91 (OJ 1993, 420) apply and novelty can only be raised on appeal with the patentee's agreement which has not been given. While it is true the Respondent answered the allegations in the Grounds of Appeal regarding novelty based on document (5), that was done simply because a party answers an attack and should not be taken as agreement that novelty should become a ground of opposition. While oral proceedings in the appeal may be a late moment to challenge the admissibility of a ground of opposition, admissibility may be challenged at any time and to hold otherwise would be a denial of the Respondent's rights.

- Document (6) had been raised too late in the proceedings. The Respondent accepted it had been cited in the description of the application but it had not been cited or considered in the opposition proceedings. While the Board was not confined to consideration of evidence submitted by the parties (Article 114(1) EPC), the "ex officio" principle has to be balanced against fairness to a party which may be prejudiced by the late introduction of new evidence into the proceedings.

- If document (6) should be held admissible, the Respondent should have time to consider it, either by an adjournment of the appeal proceedings or by remittal of the case to the first instance. The Board's fax raising document (6) arrived less than three working days before the oral proceedings.

The Respondent's professional representative had been able to contact the Respondent's US patent attorney but the persons within the Respondent company who had considered document (6) at the time the description in the application was prepared had simply not been available within the short space of time between the fax and the hearing. The three auxiliary requests produced at the oral proceedings (see X below) reflected document (6) but were submitted with the Respondent's instructions only to the extent that they should be considered if absolutely necessary and had not been prepared in consultation with those who possessed the relevant technical knowledge. Without an opportunity to take full and complete instructions, the representative could not assess the commercial significance to the Respondent of the amendments document (6) might require. The Respondent's representative had come to the oral proceedings prepared to argue novelty, if necessary, in relation to document (5) and the other documents cited earlier in the proceedings but was not fully instructed or prepared in relation to document (6).

- Document (5) should not be admitted into the proceedings. This document was put forward by the Appellant as evidence of general knowledge at the priority date of the Patent but referred to such a large number of other documents, some of which pre-dated and some of which post-dated the priority date, that it would be impossible to establish the level of knowledge at that date with any reliability.

VIII. The Appellant argued that novelty should be admitted as a ground of opposition and documents (5) and (6) should be admitted in evidence. Its arguments on these procedural issues can be summarised as follows:

- The Opposition Division was entitled, having regard to Article 114(1) EPC, to exercise an ex officio function and consider issues not raised by the parties. While there was some ambiguity in the minutes of the opposition oral proceedings and the subsequent written decision, novelty had been questioned with respect to document (1). Even if there was some doubt as to the extent novelty had been raised by the Opponent, it was clear the Opposition Division had considered novelty of its own motion, both as regards document (1) and other documents and, in the light of the Opposition Division's conclusions, the introduction of further documents going to novelty should be allowed on appeal.
- Document (5) had been produced in response to the Opposition Division's decision which had held that the subject-matter of both independent claims of the Patent was novel over the then cited documents. Document (5) showed that, had those documents been considered in the light of general knowledge at the priority date, novelty would have been found lacking.
- Although, since document (6) had only been raised very recently by the Board's fax, the Appellant would not object to remittal of the case to the first instance if document (6) were admitted, remittal would be time-consuming.

- As regards the content of document (6), this was so close to the subject-matter of the Patent that there was no technical parameter available to allow a delimitation over document (6). The only difference between the Patent and document (6) was one of "labels" - the Patent referred to a dental impression tray and document (6) to a gumshield for use in contact sports.

IX. Both parties were asked by the Board if they could give any more detail as to the consideration, if any, of novelty during the oral proceedings before the Opposition Division but they could not. The Appellant confirmed that, despite the unclear record in the minutes and the written decision, it had (as Opponent) referred to novelty which had then been considered by the Opposition Division of its own motion. The Respondent could add nothing since a different representative had appeared at those earlier proceedings.

X. The Respondent maintained its main request that the appeal be dismissed and the Patent maintained but also made a number of procedural requests as follows:

- (i) that novelty should not be admitted as a ground of opposition
- (ii) that, if novelty be held admissible, document (6) should not be admitted in the proceedings
- (iii) that, if document (6) be held admissible, either the proceedings be adjourned to allow consideration of document (6) or alternatively that the case be remitted to the first instance

(iv) that document (5) should not be admitted in the proceedings.

The Respondent also submitted three new sets of claims as auxiliary requests to be considered in the event all its other requests should be refused. For the reasons referred to in 4.3 below, these were returned unconsidered by the Board.

The Appellant requested that the decision under appeal be set aside and the Patent revoked.

Reasons for the Decision

1. The appeal is admissible.
2. *Novelty as a Ground of Opposition*
 - 2.1 It is clear document (6) was not considered during the written proceedings at first instance. It is however far from clear what happened during the oral proceedings. The statement in the written decision that "novelty was not disputed" cannot be read literally, if only because both the minutes and the decision record that the Opponent said novelty was questionable. It seems more likely that "not disputed" means no, or no substantial, argument was heard on the issue. However, it seems beyond doubt that novelty was mentioned and perhaps discussed, albeit briefly. To accept the Respondent's contention that it was only raised for the first time in the written decision, without the parties being given an opportunity to submit arguments thereon, would be to presume the Opposition Division sprang a surprise on the parties (and on the patent proprietor

in particular). While the Board would be astute to condemn this if it could be shown to have happened, it should also be wary of concluding it to have happened in the absence of clear and satisfactory evidence that it did.

2.2 In the present case, the Board has insufficient information to establish exactly what happened and must, to the extent necessary, decide what most likely happened while remaining fair to the parties and the Opposition Division. It seems clear novelty was mentioned at the oral proceedings - that is confirmed by the minutes, the written decision and the Appellant's representative. It seems probable that, the Appellant having mentioned novelty, the Opposition Division considered it of its own motion and, which is also confirmed by the written decision, found novelty established over the documents before it. If the Opposition Division did so without giving the parties any, or any sufficient, opportunity to be heard on the issue then that would have been not just a mistake but contrary to Article 113(1) EPC. However, as already indicated, the Board cannot from the information available conclude that this in fact happened. It can however be said with more certainty that, to the extent novelty was raised and considered, this occurred at a very late stage of the opposition proceedings. It would, as it now transpires, have been helpful if the Opposition Division had in its decision made clearer the extent to which novelty was considered and if, as appears to be the case, it was considered of its own motion, how this was put to the parties and what their reactions were.

2.3 Thus, doing the best it can with the limited

information available, the Board concludes that novelty was an issue considered in the first instance proceedings. The consequences of that finding are twofold. First, it justified the Appellant raising the issue in its grounds of appeal. If the Respondent disagreed with that, it could and should have said so in terms in its reply to the grounds of appeal. That reply having been prepared so much closer in time to the Opposition Division oral proceedings than now, it is perhaps significant that no objection was taken then to the admissibility of a new ground of opposition, if indeed the Respondent so viewed it at the time.

2.4 Second, the Respondent's argument that novelty was first raised only in the Opposition Division's written decision and that it was not therefore raised in "the proceedings" cannot be sustained. As for the argument that the Respondent has not agreed to the later introduction of novelty on appeal, the absence of any objection to that in the Respondent's written reply robs this argument of much of its force. The Respondent was correct in saying admissibility can be challenged at any time but a patent proprietor must expect such a challenge to be less likely to succeed if it is only made at the last opportunity and particularly if, as in the present case, the proprietor has already advanced substantive arguments on the issue in the written proceedings. One purpose of written proceedings is for the parties to set out their cases fully and clearly including, if they so wish, alternative arguments: to the extent they do not, they must accept that inferences may be drawn.

2.5 In the present case, it is also important to consider how the admissibility of novelty as a ground of

opposition came to be challenged. The Respondent's representative told the Board at the oral proceedings he had been prepared to argue novelty as an issue save as regards document (6). It follows that, had the Board itself not raised document (6), or if it had been raised earlier, the Respondent might not have sought to exclude novelty as an issue. That it did do so cannot be the subject of any complaint particularly since, as already mentioned, an unfortunate degree of uncertainty had been created by the minutes and written decision of the Opposition Division (see also 3.2 below). However, the real issue is not the admissibility of novelty as a ground of opposition but the admissibility in evidence of document (6) and, if that document is admissible, how the proceedings should continue hereafter.

3. *Admissibility of document (6)*

3.1 Document (6) is explicitly referred to in the description of the Patent (page 2, lines 48 to 54; page 4, line 23), references which were present in the application as filed (page 3, lines 8 to 21; page 8, lines 14 to 16). This document was clearly considered by the Respondent (then the Applicant) to be relevant prior art which needed to be distinguished from the invention claimed in the application and indeed that distinction was made:

"European Pat. Application No. 0 359 135 was not published until 21 March 1990. It describes a mouthpiece (a mouthguard) for use in contact sports. The mouthpiece is made of inner and outer layers of thermoplastic EVA resins. The outer layer is required to be impact resistant so that it will survive strong impacts. The outer layer is also said to have a melting

point preferably above 60°C, more preferably from 63 to 68°C. If made of EVA, the outer layer is required to have a melt flow rate ("MFR") less than 65 g/10 min. The mouthpiece is formed by heating it to a temperature that will melt the inner layer but not the outer layer. This reference does not disclose or suggest dental impressing to make a dental model." (Application page 3, lines 8 to 21; Patent page 2, lines 48 to 54.)

3.2 Apart from that distinction as to the intended use of the products to which document (6) and independent claim 8 of the Patent are directed, the similarity - above all, in technical terms - is such that it is, to say the least, surprising that document (6) was not considered during examination, was not relied on by the Appellant (then the Opponent) during the opposition proceedings, and was not raised by the Opposition Division of its own motion. That document (6) was so comprehensively overlooked is clear from the opinion the Appellant now takes of the document, namely that its difference from the product of the Patent is only one of "labels". Having been so extensively overlooked, indeed almost inadvertently "concealed", in all the earlier proceedings, it was not unduly surprising that the Board only noticed and considered its relevance at a late stage of the appeal proceedings. Once it had done so, it had no alternative but to draw it to the parties' attention. If first instance departments and/or parties have failed to take account of highly relevant matter which is clearly available in the EPO file and which relates to a ground of opposition, the Board's competence extends to rectifying the position by consideration of that matter provided, of course, the parties' procedural rights to fair and equal treatment are respected. This is not only consistent

with Enlarged Board decisions G 9/91 (OJ 1993, 408) and G 10/91 (OJ 1993, 420) referred to by the Respondent but incumbent on the Board as the last instance in proceedings concerning the grant or maintenance under opposition of European patents.

4. *Adjournment or remittal*

4.1 The Board appreciates that, in the exceptional circumstances of this case, the parties (and the Patent's proprietor in particular) must have a sufficient opportunity to consider a document which, even if not strictly-speaking "new" to the proceedings, has been unconsidered for so long that its "re-introduction" without adequate time for the parties to give full instructions to their representatives might amount to "surprise". The Respondent's third procedural request - to adjourn the proceedings or remit the case to the first instance - was thus entirely reasonable. Its representative had done his best to take instructions following receipt of the Board's faxed communication drawing attention to document (6) but had not been able to take instructions from those best-placed to deal with the matter. The Appellant, while not agreeing to the Respondent's request, very properly acknowledged the fairness of the request by indicating it would not object to the remittal of the case to the first instance.

4.2 As to whether the Board should simply adjourn the appeal proceedings to allow the Respondent time to consider document (6) and give full instructions to its representative or remit the case to the first instance, the Board considers remittal to be the fairer course of action. The apparent, indeed extraordinary, absence of

any previous substantive consideration of document (6) and the fact that remittal will give the parties two instances before which to argue the matter are factors which more than outweigh the further delay mentioned, but not relied on with any great force, by the Appellant.

4.3 In the light of that decision to remit the case, the Board considered it inappropriate to look at the three auxiliary requests which had been prepared without the Respondent's full instructions. When the case is considered further at first instance, the Respondent may wish, having had an opportunity to consider document (6) fully, to make different requests. The Board accordingly returned the three auxiliary requests to the Respondent at the close of the oral proceedings.

5. *Admissibility of document (5)*

5.1 The position as regards the admissibility of document (5) is perhaps more straightforward. The Board having found novelty was raised in the opposition proceedings, the introduction by the Appellant in its grounds of appeal of a new document in response to the Opposition Division decision appears prima facie reasonable. The Respondent had, and took, the opportunity to present its written case on document (5) and its representative was prepared to argue novelty in the light of document (5) at the oral proceedings before the Board. The only real objection of the Respondent to document (5), that it did not in fact (as the Appellant submitted) show the state of general knowledge at the priority date of the Patent, is an argument that goes to the substance of the novelty issue rather than to the admissibility or non-admissibility of the document on any procedural

ground. To admit document (5) into the proceedings, while leaving the parties entirely free to debate its significance and impact on the case, cannot in the circumstances prejudice the Respondent, especially since that debate can be conducted before two instances. Accordingly, while expressing no opinion on the significance or otherwise of document (5), the Board considers it should be admitted into the proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. Documents (5) and (6) are admitted into the proceedings.
3. The case is remitted to the first instance for further prosecution.

The Registrar:

The Chairman:

A. Townend

P. Lançon