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D E C I S I O N
of 9 November 2004

Case Number: T 0740/98 - 3.3.1

Application Number: 90101890.3

Publication Number: 0385120

IPC: C09B 62/503

Language of the proceedings: EN

Title of invention:
Fiber reactive asymmetric dioxazine compounds and their use as fiber reactive dyes

Patentee:
SUMITOMO CHEMICAL COMPANY LIMITED

Opponent:
DyStar Textilfarben GmbH & Co Deutschland KG

Headword:
Dioxazines/SUMITOMO

Relevant legal provisions:
EPC Art. 123(2), 112(1)(b), 111(2), 112(3)
RPBA Art. 15, 16

Keyword:
"Applicability of G 1/03 - (yes)"
"Allowability of disclaimer - requirement of accidental anticipation - added subject-matter (yes)"

Decisions cited:
G 0001/03, G 0005/88, G 0007/88, G 0008/88, G 0005/93, G 0009/93, T 0004/80, T 0433/86, T 0170/87

Catchword:
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Europäisches Patentamt | European Patent Office | Office européen des brevets

Beschwerdekammern | Boards of Appeal | Chambres de recours

Case Number: T 0740/98 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 9 November 2004

Appellant: (Proprietor of the patent)	SUMITOMO CHEMICAL COMPANY LIMITED 5-33, Kitahama 4-chome Chuo-ku Osaka-shi Osaka 541-0041 (JP)
Representative:	VOSSIUS & PARTNER Postfach 86 07 67 D-81634 München (DE)
Respondent: (Opponent)	DyStar Textilfarben GmbH & Co Deutschland KG Industriepark Höchst D-65926 Frankfurt (DE)
Respondent:	Muley, Ralf, Dr. DyStar Textilfarben GbmH & Co.Deutschland KG Patent- und Lizenzen Industriepark Hoechst /Gebaüde B598 D-65926 Frankfurt (DE)
Decision under appeal:	**Interlocutory decision of the Opposition Division of the European Patent Office posted 14 May 1998 concerning maintenance of European patent No. 0385120 in amended form.**

Composition of the Board:

Chairman: P. P. Bracke
Members: J. M. Jonk
C. Rennie-Smith

Summary of Facts and Submissions

I. The Appellant (Patentee) lodged an appeal against the interlocutory decision of the Opposition Division indicating that the patent in suit No. 0 385 120 (European patent application No. 90 101 890.3) as amended was found to meet the requirements of the EPC.

II. In its decision, the Opposition Division held with respect to the then pending main request that the subject-matter of Claim 1 as granted extended beyond the content of the application as filed (Article 123(2) EPC), because the second disclaimer in that claim, which read:

"and with the further provision that when Q is F, R is hydrogen and either one of V and R_3 is hydrogen, the other is different from R_1",

and which was introduced during the proceedings before the Examining Division, was not allowable because document (1) did not form a novelty objection to the claimed subject-matter.

III. By a Communication of 5 July 2004 the Board referred with respect to the allowability of the disclaimer in Claim 1 as granted, to the decision of the Enlarged Board of Appeal G 1/03 indicating that a disclaimer might be allowable in order to delimit a claim against an anticipation under Article 54(2) EPC if it was an accidental anticipation, i.e. if the anticipation was so unrelated to and remote from the claimed invention that the person skilled in the art would never had taken it into consideration when making the invention.

IV. Oral proceedings before the Board were held on 9 November 2004.

V. During these oral proceedings the Appellant accepted that the disclaimer in question would not be allowable in the light of G 1/03, if the standards set out therein were applicable.

However, it argued that the standards set out in this decision, which was dated 8 April 2004, could not be applied in the present case, because it was published after the date when the disclaimer had been allowed by the Examining Division. The disclaimer had thus been allowed in the knowledge of the Guidelines and the earlier established jurisprudence of the Boards of Appeal, and in the legitimate expectation that it would be allowable under Article 123(2) EPC. In this context, it referred to the Guidelines for Examination in the EPO of December 1994 with respect to the allowability of disclaimers, and to a number of decisions of the Enlarged Board of Appeal, namely G 5/93, G 5/88, G 7/88 and G 8/88, in which it was decided that, if subsequent decisions of the Enlarged Board of Appeal overturned previous case law, then the previous case law applied to all cases which were initiated before the decision of the Enlarged Board of Appeal was made available to the public.

VI. The Respondent (Opponent) argued that the general legal principle of legitimate expectations could not be based on the Guidelines for Examination or decisions of the Boards of Appeal, since they were not binding. The decisions of the competent departments of the EPO had

to be taken on the basis of the provisions of the EPC and actually depended on the facts of each particular case. Furthermore, it noted, with respect to the decisions of the Enlarged Board of Appeal mentioned by the Appellant, that in those decisions the legitimate expectations which were protected were those of users of the EPO who had no reason to question the validity of an administrative agreement or official document prior to the Enlarged Board decision. The Respondent concluded, therefore, that the standards set out in G 1/03 were applicable and that in view of this decision the disclaimer in question was not admissible in the light of Article 123(2) EPC.

VII. The Appellant requested that the decision under appeal be set aside and that the patent be maintained as granted or, as auxiliary request, as maintained by the Opposition Division.

The Respondent requested that the appeal be dismissed.

VIII. At the conclusion of the oral proceedings the Board's decision was pronounced.

Reasons for the Decision

1. The appeal is admissible.

Main request

2. *Application of G 1/03*

2.1 The first issue to be dealt with in this decision is the question, whether the standards set out in G 1/03 are to be applied in the present case.

2.2 The Appellant submitted that the disclaimer had been allowed by the Examining Division in conformity with the Guidelines for Examination (1994) and the then established jurisprudence of the Boards of Appeal, exemplified by T 4/80 (OJ 4/1982, 149) and T 433/86 of 11 December 1987 (unpublished). Consequently, the standards set out in the subsequent decision G 1/03 could not be applied, since its use would offend against the principle of good faith and the protection of legitimate expectations of users of the EPO as applied in G 5/88, G 7/88 and G 8/88 (published together in OJ 1991, 137) and G 5/93 (OJ 1994, 447).

2.3 However, the legal system established under the EPC does not treat either the Guidelines or established jurisprudence as binding.

The absence of any general obligation to treat earlier decisions as binding follows from Article 112(1)(b) EPC and Articles 15 and 16 of the Rules of Procedure of the Boards of Appeal. Article 112(1)(b) EPC relates to the ability of the President of the EPO to refer a point of law to the Enlarged Board of Appeal where two Boards of Appeal have given different decisions on that question. Article 15 of the Rules of Procedure of the Boards of Appeal stipulates in its first paragraph that the

grounds for a deviation from an earlier decision of any Board shall be given and the President of the EPO shall be informed, and in its second paragraph that, if a Board gives a different interpretation of the EPC to that provided for in the Guidelines, it shall state the grounds for its action if it considers that this decision will be more readily understood in the light of such grounds. Furthermore, Article 16 of the Rules of Procedure of the Boards of Appeal stipulates that, should a Board consider it necessary to deviate from an earlier opinion or decision of the Enlarged Board of Appeal, the question shall be referred to the Enlarged Board of Appeal.

In fact, the EPC only comprises two provisions giving a decision of a Board of Appeal or the Enlarged Board of Appeal a binding effect, namely those of Articles 111(2) and 112(3) EPC, respectively. However, these provisions solely concern further procedures in the particular cases in question and, consequently, do not relate to decisions in other cases, even other cases with the same issues.

Therefore, as a rule, any principle of protection of legitimate expectations of the users of the EPO relied on by the Appellant cannot be based on earlier Guidelines or jurisprudence.

2.4 The Appellant suggested in his submission set out under point 2.2 above that, according to the established jurisprudence of the Boards of Appeal existing at the date of the decision of the Examining Division, exemplified by said T 4/80 and T 433/86, an

unconditional exclusion of related state of the art was allowed.

However, in T 4/80 the relevant anticipation did not belong to the state of the art under Article 54(2) EPC. Furthermore, with respect to said T 433/86 the Board agrees with the Appellant that indeed a disclaimer was allowed in order to exclude closely related prior art, but in T 170/87 of 5 July 1988 (published in OJ 1989, 441, i.e. shortly after the date of the decision T 433/86), a disclaimer was not allowed because the subject-matter to be disclaimed was considered relevant to the assessment of inventive step.

Therefore, the jurisprudence relied on by the Appellant in support of his submission cannot even be regarded as "established", let alone so established as to create legitimate expectations which justify protection by deviating from the standards for allowing a disclaimer set out in G 1/03.

2.5 With respect to the decisions G 5/88, G 7/88 and G 8/88 (published together in OJ 1991, 137) and G 5/93 (OJ 1994, 447) of the Enlarged Board of Appeal relied on by the Appellant in order to defend its point of view that in the present case a protection of legitimate expectations with respect to the allowability of the disclaimer in question would be justified, the Board observes that these decisions concerned quite different situations, namely, situations in which there was no reason to expect that, for example, an Administrative Agreement between the President of the EPO and the President of the German Patent Office or a commonly accepted interpretation of a provision of the EPC would

be held invalid. Furthermore, G 9/93 (OJ 1994, 891) considered by the Board to be relevant too, concerned a case in which the Enlarged Board of Appeal overruled its earlier decision G 1/84 (OJ 1985, 299) in the question of oppositions filed against their own patents by proprietors.

In those particular situations, it is quite understandable that the Enlarged Board of Appeal built into its decisions a saving for innocent users of the EPO who were thus entitled to rely on the previous practice of the EPO.

In G 1/03, which is relevant to the present case, the Enlarged Board of Appeal apparently did not see any need for such a saving. This is wholly unsurprising: whereas in those cases just mentioned the Enlarged Board, exceptionally, changed the previous law or practice, in G 1/03 it clarified the law which had, as a result of previous and differing jurisprudence, been uncertain.

2.6 Thus, in view of these considerations, the Board concludes that the standards set out in G 1/03 are applicable.

3. *Allowability of the disclaimer under Article 123(2) EPC*

3.1 In applying G 1/03 the Board comes to the conclusion that the questionable disclaimer in present Claim 1 contravenes Article 123(2) EPC, since it adds subject-matter extending beyond the application as filed. This finding was not disputed by the Appellant.

3.2 For this reason the present main request is rejected.

Auxiliary request

4. According to this request, maintenance of the patent in suit in the form maintained by the Opposition Division has been requested. However, in view of the fact that in the present case the Patentee is the sole Appellant against the interlocutory decision of the Opposition Division maintaining the patent in amended form, the Board notes that neither the Board nor the non-appealing Opponent has the power to challenge the maintenance of the patent as thus amended (no *reformatio in peius*). The request is therefore redundant since it seeks what must, the main request being rejected, in any event happen.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar: The Chairman:

N. Maslin P. P. Bracke