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D E C I S I O N
of 26 October 2001

Case Number: T 0875/98 - 3.3.3

Application Number: 86906668.8

Publication Number: 0287560

IPC: C08F 220/02

Language of the proceedings: EN

Title of invention:

Rubbery acrylic polymer, latex and preparation thereof

Patentee:

The B.F. GOODRICH Company

Opponent:

ROHM AND HAAS COMPANY

Headword:

-

Relevant legal provisions:

EPC Art. 54, 56, 104(1), 108, 113(1)
EPC R. 65(1)

Keyword:

"Admissibility of appeal (yes) - no undue burden"

"Inventive step (no) - obvious modification"

"Procedural violation (no) - no obligation to apply 'case law'"

Decisions cited:

J 0022/86, T 0220/83, T 0154/90, T 0574/91

Catchword:

A single decision issued by an opposition division does not establish a "case law" which must be adhered to in another opposition case even if the subject-matter of the two respective cases is closely related (Reasons 4).



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Chambres de recours

Case Number: T 0875/98 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 26 October 2001

Appellant:
(Opponent) ROHM AND HAAS COMPANY
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Respondent:
(Proprietor of the patent) The B.F. GOODRICH Company
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Representative:
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 29 June 1998
rejecting the opposition filed against European
patent No. 0 287 560 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: R. Young
Members: P. Kitzmantel
A. Lindqvist

Summary of Facts and Submissions

I. Mention of the grant of European patent No. 0 287 560 in respect of European patent application No. 86 906 668.8 in the name of The B.F. GOODRICH Company (hereinafter "BFG 1 patent"), which had been filed on 20 October 1986 as PCT/US 86/02252 (International publication number WO 88/02759), was announced on 21 August 1996 on the basis of four claims, Claim 1 reading as follows:

"1. A process for preparing a latex comprising water, 0.1 to 10 parts by weight of a surfactant, and a polymer having a Tg of from -20°C to -60°C, a percent hysteresis loss of less than 15%, and a raw polymer tensile strength of at least 2.068 MPa (300 psi) and an elongation of at least 350 percent, comprising interpolymerized units of (a) from 1 to 20 weight parts of at least one unsaturated dicarboxylic acid containing 4 to 10 carbon atoms (b) from 70 to 99 weight parts of at least one copolymerizable monomer of which a majority is an acrylate monomer(s), and (c) optionally, from 0.1 to 10 weight parts of a crosslinking monomer, all weights based on 100 parts by weight total of all monomers, which process includes the step of metering into a reactor a premix which substantially comprises water, at least one copolymerizable monomer, optionally a crosslinking monomer(s), surfactant and up to one-half of the total amount of at least one unsaturated dicarboxylic acid, wherein the reactor contains water, initiator, and at least one-half of the total amount of at least one unsaturated dicarboxylic acid, and subsequently conducting polymerization in the reactor at a temperature from 0°C to 100°C."

The further claims 2 to 4 are dependent on Claim 1.

II. Notice of Opposition requesting revocation of the BFG 1 patent in its entirety on the grounds of Article 100(a) EPC was filed by ROHM AND HAAS on 14 May 1997.

In particular, the Opponent argued that the claimed subject-matter was anticipated by the disclosure of document

D1: US-A-3 959 552,

or at least obvious over the disclosure of this document, and that a similar situation existed in relation to the disclosures of the documents

D2: US-A-3 157 562 and/or

D3: US-A-2 931 749.

III. By its decision issued in writing on 29 June 1998, the Opposition Division rejected the opposition.

That decision disregarded documents D2 and D3 on the ground that the opposition was unsubstantiated in respect of these documents. As to the merits of the case, the decision held that document D1 did not prejudice the maintenance of the BFG 1 patent as granted, because it neither disclosed the initial addition to the polymerisation reactor of at least 50% of the unsaturated dicarboxylic acid comonomer as required by Claim 1 of BFG 1, nor did it suggest that by this measure a polymer having the desired balance of properties could be obtained.

IV. By a letter dated 2 July 1998 (cf. page 1, second paragraph) the Opponent complained that "it is considered wholly inappropriate for the Opposition Division to have issued its Decision without first

having either invited the Opponent to reply [to the Proprietor's observation] or issued a preliminary decision."

In the Opponent's view, in handling the present BFG 1 case, the Examining Division (i) should have taken account of the shortly preceding revocation of the present Patentee's (B.F. Goodrich) parallel patent EP-B-0 264 869 (hereinafter "BFG 2 patent"), which was allegedly directed to substantially the same subject-matter, and (ii) - before issuance of a decision in the present BFG 1 case - should have waited for a period of time sufficiently long for the Opponent to react to any possible appeal of B.F. Goodrich in the BFG 2 case. A period of less than one month between the date of the notification of the fact that no such appeal had been filed and the issuance of the decision under appeal in the BFG 2 case deprived the Opponent of the reasonable space of time, which would have been necessary to file a further submission in the BFG 1 case.

Moreover, in the Opponent's opinion, in view of facts that came to light in the BFG 2 case, B.F. Goodrich should have amended the specification of the BFG 1 patent, on its own volition.

The Opponent, therefore, requested the re-opening of the opposition proceedings of the BFG 1 case and invited B.F. Goodrich to support this request, failing which it "shall apply for costs in any appeal it may file" (page 2, penultimate paragraph).

- V. By its communication dated 13 July 1998 the EPO issued the following information:

"In inter partes proceedings a decision terminating an opposition is legally binding and cannot be changed by the opposition division. You have the possibility to appeal within the current time limit."

- VI. On 1 September 1998 the Opponent (Appellant) lodged an appeal against the decision of the Opposition Division. Simultaneously the appeal fee was paid and the Statement of Grounds of Appeal was submitted.

Attached to this Statement were copies (i) of the decision of revocation of the BFG 2 patent (issued by an opposition division different from the one in the present BFG 1 case) and (ii) of the minutes of the oral proceedings held in that case, said documents also comprising the amended set of BFG 2 claims upon which the BFG 2 decision was based.

- VII. The Notice of Appeal comprises the following statement:
"The Decision is appealed against in its entirety. In particular, it is submitted that the Opposition Division was wrong in deciding that the subject-matters of the claims of the Patent were patentable."

- VIII. In the Statement of Grounds for Appeal the Appellant emphasized the allegedly substantially similar, if not identical subject-matters of BFG 1 and BFG 2, as well as the similarity or substantial identity of the arguments and the prior art brought forward in both cases.

In view thereof, the Appellant found "it incredible to believe that the Opposition Division could reach a decision to maintain BFG 1, which decision is diametrically opposed to the case law as presented in

the decision to revoke BFG 2" and it requested therefore "the Appeal Board to overturn the decision of the Opposition Division to maintain BFG 1 and, instead, revoke BFG 1 in its entirety" (cf. page 1, last and penultimate paragraphs of the Statement of Grounds of Appeal).

Furthermore, the Appellant requested "to refund the fee for appeal and to award the Appellant its costs incurred during these appeal proceedings", because, although both the Opposition Division and the Proprietor should have been aware "in view of the case law of BFG 2" of the non-patentability of the subject-matter of BFG 1, the Opposition Division rejected the opposition against the BFG 1 patent and the Proprietor "made no efforts whatsoever to attempt to rectify or withdraw BFG 1 during the few months after the decision to revoke BFG 2" (cf. page 2, last paragraph of the Statement of Grounds of Appeal).

IX. The Respondent (Proprietor of BFG 1 and BFG 2) presented its counterstatement in a submission dated 10 March 1999.

It argued essentially, that the appeal was not admissible, "because it does not contain a written statement setting out the grounds of appeal in the sense of and as required in Article 108 EPC" (cf. sentence bridging pages 1 and 2).

In particular, in the Respondent's view, the Statement of Grounds for Appeal did not comply with the requirement that it "should specify the legal factual reasons on which the case for setting aside the attacked decision is based" in a way "to enable the Board and the other party to understand immediately why the decision is alleged to be incorrect and on what facts the appellant bases [correction from "basis"] his

arguments, without the Board and the other party first having to make investigations of their own" (cf. page 2, second paragraph).

Contrastingly, the Respondent argued, the Opponent "has not analyzed the claimed subject-matter vis-a-vis the prior art cited nor has the opponent brought forward any arguments as to the patentability of the subject-matter specifically claimed or the contested decision", but has "turned over the burden of examining the case to the Board of Appeal and patentee" (cf. page 2, last two paragraphs).

Moreover, there was no "substantial similarity" between the subject-matter of the present BFG 1 patent and that of the BFG 2 patent, referred to by the Appellant, because BFG 2 related to a non-woven fibrous material, whereas BFG 1 related to a process for preparing a latex (cf. page 2, 4th and 5th paragraphs).

Furthermore, the decision issued in the opposition case BFG 2 did not constitute a "case law" to which the patentee or the Board of Appeal would be bound in any respect (cf. page 3, second paragraph).

- X. Oral proceedings were held on 28 March 2001 solely for the purpose of discussing and deciding upon the admissibility of the appeal.

In this respect the parties essentially repeated their respective written submissions, the Respondent, relying *inter alia* on T 220/83 (OJ EPO 1986, 249) and T 154/90 (OJ EPO 1993, 505), insisting that the appeal documents did not satisfy Article 108 EPC, and the Appellant, relying *inter alia* on J 22/86 (OJ EPO 1987, 280) and T 574/91 (not published in the OJ EPO), arguing that

its request to overturn the attacked decision on the basis of the facts and arguments of case BFG 2 was immediately apparent from the submitted appeal documents.

These oral proceedings resulted in the interlocutory decision that the appeal is admitted and that the proceedings would be continued in writing.

- XI. In a written communication dated 6 April 2001 (posted on 9 April 2001) the Rapporteur expressed the preliminary opinion that the claimed subject-matter was obvious over the disclosure of D1, especially in combination with D3, and invited the parties to comment on this opinion within a time limit of 4 months and to indicate whether or not they requested further oral proceedings on the merits of the case.

In its submission dated 14 June 2001 the Appellant stated *inter alia* that it did not request further oral proceedings provided the eventual decision resulted in complete revocation of the patent. The Appellant also pointed to lack of novelty arguments raised during the oral proceedings held on 28 March 2001.

The Respondent failed to react to the Rapporteur's communication within the time limit set and, on the Respondent's request, extended by 2 months until 19 October 2001 (including the 10 day delivery period stipulated in Rule 78(2) EPC).

- XII. The Appellant requested that

- the decision under appeal be set aside and that the European patent No. 0 287 560 be revoked in its entirety,
- the appeal fee be refunded,

- it be awarded the costs incurred during the appeal proceedings, and
- that oral proceedings be held if the Board considered to maintain the patent as granted or in any amended form.

XIII. The Respondent requested to dismiss the appeal and to maintain the European patent No. 0 287 560 as granted.

Reasons for the Decision

1. *Procedural*

This decision to revoke the patent in suit (BFG 1 patent) does not infringe the Respondent's right to be heard under Article 113(1) EPC because the Respondent did not avail itself of the opportunity to respond to the Rapporteur's communication of 6 April 2001, nor did it request oral proceedings on the merits of the case within the granted time limit (cf. point X, last paragraph supra).

2. *Admissibility of the appeal*

2.1 Rule 65(1) EPC states: "If the appeal does not comply with Articles 106 to 108 ..., the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired."

2.2 Article 108 EPC, reads:

"Notice of appeal must be filed in writing at the European Patent Office within two months after the date of notification of the decision appealed from. The

notice shall not be deemed to have been filed until the fee for the appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed."

2.3 In its interlocutory decision of 28 March 2001 the Board decided that, although the Notice and the Statement of Grounds of Appeal did not directly refer to any deficiency of the decision under appeal and instead made reference to a decision of revocation by a different opposition division of a patent (BFG 2 patent) allegedly relating to very similar if not identical subject-matter, the appeal met all requirements of Article 108 EPC, including that of its last sentence.

2.3.1 In arriving at this conclusion the Board considered the following decisions:

(i) Decision J 22/86 (Reasons, point 2) found that the requirement for a written statement setting out the grounds of appeal "is clearly not merely formal, but involves a presentation of the Appellant's case", but that "[i]n a wholly exceptional case such as the present, it may be immediately apparent to the Board of Appeal upon reading the decision under appeal and the Statement of Grounds of Appeal that such decision cannot properly be supported, even though the grounds contained in such statement can fairly be described as minimal." In this *ex parte* case (relating to the time limit under Rule 51(4) EPC) the statement in the Notice of Appeal: "It is requested that the application be restored to enable further processing to be carried out with the object of securing the grant of a patent" (cf. Summary of Facts and

Submissions, point IV) was considered to satisfy Article 108 EPC because it was immediately apparent upon reading the decision and the afore-mentioned statement that the appellant requested the decision to be set aside.

- (ii) In decision T 574/91 (Reasons, point 1) it was held that in the event that an appeal statement was lacking any analysis of the decision under appeal and only relied on new arguments the appeal was still admissible but limited to a review of the grounds of revocation of the patent.
- (iii) In contrast thereto, T 220/83 (Reasons, point 4, second paragraph) found an appeal to be inadmissible under Article 108 EPC because in that case the appellants did not "state in their grounds the legal and factual reasons why the contested decision should be set aside so as to ensure that the appeal may be assessed objectively". In this case the appeal statement had contented itself with the observation that the opposition division did not consider, as laid down in the Guidelines for Examination, certain statements in a prior art document.
- (iv) In T 154/90 (Reasons points 1.2.1 to 1.2.3) it was similarly decided that a statement requesting revocation of the patent by reference only to the grounds set out during the opposition proceedings did not satisfy the requirement of Article 108 EPC, last sentence, because by not stating the legal and factual reasons why the impugned decision should be set aside, the opponent left it entirely to the

board and the patentee to conjecture why it considered the decision relating to the maintenance of the patent to be defective.

2.3.2 The present case bears similarities to the situation underlying J 22/86 insofar as upon reading the appeal documents and the decision under appeal it is immediately apparent, without undue burden on the Board and on the Respondent, what are the legal and factual reasons why the impugned decision should be set aside. It is also evident that nothing more than a review of the arguments of the decision under appeal is requested (cf. T 574/91).

Contrary to the case underlying T 220/83 the legal and factual reasons why the contested decision should be set aside can be derived from the appeal documents, albeit, undesirably, in an indirect and somewhat concealed fashion.

In the present case there is also no need to refer to previous submissions before the first instance, as was the case according to T 154/90, but the Appellant's case could be ascertained on the basis of the documents submitted with the appeal.

2.3.3 The above conclusions result from the following analysis:

- (i) A comparison of the claims and worked examples of BFG 1 and BFG 2, which are referred to in the Statement of Grounds of Appeal, reveals that the definition of the binder emulsion used according to independent Claim 8 of BFG 2, as amended during the oral proceedings in that case (cf. amended claims according to the decision to

revoke BFG 2, attached to the Statement of Grounds of Appeal), is more or less identical to the latex prepared according to present Claim 1.

- (ii) The closest prior art identified in the BFG 2 decision (US-A-3 959 552; there D4) is also the closest prior art according to the decision under appeal (here D1).
- (iii) According to point 4 of the Reasons of the BFG 2 decision that patent was revoked because it was held obvious in view of US-A-3 959 552 to obtain a good balance of the properties tensile strength, elongation and hysteresis loss by the measure that "at least one-half of the itaconic acid is metered initially in the reactor".
- (iv) On the basis of the same US-A the decision under appeal arrived at the contrary conclusion and, therefore, rejected the opposition.
- (v) Thus, the information given in the Statement of Grounds of Appeal on the near identity of the subject-matters of BFG 1 and BFG 2 and the reference to the decision of revocation of the BFG 2 patent together clearly suggest that the Appellant wants the decision under appeal to be reviewed account being taken of the obviousness argumentation contained in the BFG 2 decision.
- (vi) For the Board and the Respondent to arrive at this conclusion it is merely necessary to compare Claim 1 of BFG 1 with Claim 8 of BFG 2, as amended, and to take note of the very kernel of the BFG 2 decision. This does not require any investigation, i.e. any exploration involving unspecified routing, but amounts to nothing more than to the recognition of the only framework or

"window" of information that is referred to in the Statement of Grounds of Appeal.

2.4 Since, apart from the requirements of Article 108 EPC, the appeal also satisfies all further admissibility requirements of the EPC, it is admissible.

3. *Substantive matters*

3.1 Novelty

3.1.1 Document D1

Claim 1 of this document relates to a process for the production of nonwoven material of improved dry-cleaning resistance, in which a nonwoven material is treated with an **aqueous dispersion** of a copolymer consisting of copolymerised units of

A. 1.0 to 2.5 % by weight of N-methylolacrylamide, N-methylolmethacrylamide, or a mixture thereof,

B. 1.0 to 5 % by weight of acrylamide, methacrylamide, or a mixture thereof,

C. 0.5 to 3 % by weight of at least one α, β -monoolefinically unsaturated dicarboxylic acid having 4 to 6 carbon atoms, e.g. itaconic acid (cf. Claims 2, 3), and

D. 89.5 to 97.5 % by weight of at least one acrylic or methacrylic ester having 1 to 18 carbon atoms in the alcohol component,

up to 50 % by weight of component (D) being replaceable by at least one α, β -monoolefinically unsaturated monomer other than those mentioned in (A) to (C).

According to column 5, lines 17 to 46 the copolymer can be prepared by stepwise introduction of the several ingredients into a vessel, wherein part of the α,β -monoethylenically unsaturated acid is fed initially and the rest towards the end of the feeding operation.

This method was used to prepare i.a. a copolymer dispersion from 90 parts by weight of butylacrylate, 5 parts by weight of acrylonitrile, 2 parts by weight of N-methylolacrylamide, 2 parts by weight of acrylamide and 1 parts by weight of itaconic acid (column 5, lines 50 to 60: "Copolymer A").

- 3.1.2 The monomer definitions used according to D1 are thus within those of present Claim 1 and there is also an essential overlap of their proportions.
- 3.1.3 The method for preparing the aqueous dispersions (= latices) of D1 nevertheless differs from the process according to present Claim 1 because the latter requires that "the reactor contains at least one-half of the total amount of at least one unsaturated dicarboxylic acid", whereas D1 contains no information as to what ranges of percentage from the total unsaturated dicarboxylic acid are covered by the term "part" used in its Claim 1.

The Board concurs with the conclusion in point 2, second paragraph of the decision under appeal, namely that the Appellant's contention that "part" would be understood by the skilled person as meaning an at least equal or major portion of the unsaturated dicarboxylic acid, is unsubstantiated and unsupported by the disclosure of D1.

- 3.1.4 The subject-matter of Claim 1 is therefore novel over document D1.

3.1.5 The same conclusion applies a *fortiori* to the subject-matter of dependent Claims 2 to 4.

3.2 Technical problem

3.2.1 According to page 2, lines 51 to 55 of the specification the latices which are prepared according to the process of Claim 1 are useful as coatings or binders for non-wovens. The films and articles prepared therewith are said to exhibit excellent low temperature flexibility, a good balance of tensile strength and elongation as well as excellent hysteresis characteristics. According to Claim 1 the polymers should exhibit a Tg of from -20°C to -60°C, a percent hysteresis loss of less than 15%, a raw polymer tensile strength of at least 2.068 MPa (300 psi) and an elongation of at least 350 percent.

3.2.2 However, the experimental data present in the patent specification are unable to show that these properties are any better than those of copolymers which have been prepared in the initial presence of less than one-half of the total amount of the unsaturated dicarboxylic acid component, i.e. according to a manner of addition outside the scope of present Claim 1.

This conclusion results from the following analysis of the experimental evidence which is contained in the patent in suit:

- (i) According to Example 3 (page 10, lines 14 to 39), the copolymer containing itaconic acid (IA) as unsaturated acid has a Tg of -44°C, although the acid was not initially present but had been added at a later stage as part of a premix with

other ingredients (cf. page 7, lines 35 to 57). A desired low Tg of between -20°C and -60°C is therefore achieved even when no unsaturated acid is present initially.

- (ii) The vast majority of all exemplified copolymers meet the tensile strength and elongation criteria specified in present Claim 1, irrespective of whether or not the reactor contains initially at least one-half of the total amount of at least one unsaturated dicarboxylic acid or less (Examples 1 to 9).

- (iii) There is also no conclusive evidence of an improvement of the property "percent hystereses loss" if, as required by present Claim 1, the reactor contains at least one-half of the total amount of at least one unsaturated dicarboxylic acid:
 - (iii-1) in the case of the first variant of Example 4, where all of the itaconic acid was placed in the reactor, the percent hystereses loss is reported to be 19.8% (i.e. above the desired maximum of 15%), while in the case of the fourth variant of Example 5 a percent hystereses loss of only 14.8% (i.e. below the desired 15% maximum) is achieved in spite of the initial presence in the reactor of only 25% of the itaconic acid (and 75% in the "Premix").

(iii-2) Furthermore, Examples 6, 7 and 8 show that several polymers, which have been prepared according to present Claim 1, do not meet the percent hystereses loss criterion of Claim 1:

In particular, values of percent hystereses loss in excess of 15% are exhibited by

- the polymer according to Example 6, Table E, which has been prepared from fumaric acid, maleic acid and citraconic acid,
- the polymer according to Example 7, Table F, wherein part of the n-butylacrylate is replaced by styrene and acrylonitrile, and
- the polymer according to Example 8, Table G, which comprises the use of NMA (N-methylol acrylamide) as crosslinking agent.

(iii-3) Moreover, Example 2, Table B evidences that the prior art acrylic polymer Rhoplex^(R)TR934 of Rohm and Haas (Acrylic C) meets all property requirements of present Claim 1, including a percent hystereses loss of less than 15%.

3.2.3 Since, therefore, no evidence is present which justifies the formulation of a problem directed towards the preparation of copolymers having improved properties, the problem underlying the subject-matter of present Claim 1 vis-à-vis D1 can only be seen in the

provision of a **further** method for the preparation of latex copolymers as disclosed in this document.

3.3 Solution of the technical problem

The solution of this objective technical problem is to be seen in the feature that the reactor initially contains at least one-half of the total amount of at least one unsaturated dicarboxylic acid.

In view of the experimental evidence reported in the patent specification the Board is satisfied that by this measure the afore-mentioned problem (cf. point 3.2.3 supra) has effectively been solved.

3.4 Obviousness

3.4.1 The issue of inventive step of the present subject-matter turns on the question whether it was obvious to modify the teaching of D1 (according to which a "part" of the unsaturated dicarboxylic acid was initially fed into the reactor) such that "the reactor contains at least one-half of the total amount of at least one unsaturated dicarboxylic acid".

3.4.2 It appears that in the absence of a particular technical effect which can be attributed to this modification the setting of a 50% minimum for the initial feeding step of the dicarboxylic acid does not involve an inventive step, because this measure appears arbitrary and/or within the ambit of routine experimentation of a skilled person.

3.4.3 This conclusion results from the fact that the general advice of D1 to initially introduce (only) a part of the α,β -unsaturated acid into the reaction vessel and to add the rest of this acid in a third feeding stage

(cf. column 5, lines 21 to 28, 36 to 44) implies an invitation to investigate the suitability of different feeding schemes, including those where initially more than one-half of the total amount of the α,β -unsaturated acid is present in the reactor at the beginning of the polymerisation reaction. As is apparent from the lack of further information in D1 in that respect, these investigations have been considered to be within the ordinary skill of an expert and not involving an inventive effort.

- 3.4.4 Reference is made in this respect also to document D3 which relates to the same technology. Although the decision under appeal did not consider this document because it held that the notice of opposition lacked sufficient substantiation, it is here considered under Article 114(1) EPC (cf. Section XI., above).

According to Claim 1 of D3 the binder of a non-woven fibrous product comprises a cross-linked emulsion copolymer of monoethylenically unsaturated monomeric units comprising 0.5 to 10% by weight of a compound selected from the group of acrylic acid, methacrylic acid, itaconic acid (i.e. an unsaturated dicarboxylic acid) and certain salts thereof with at least one ester of acrylic or methacrylic acid.

According to column 7, lines 49 to 65 the carboxyl-containing monomer may first be homopolymerized or copolymerized with one or more, but less than all, of the comonomers.

The latter technique, thus, comprises the alternative that all of the unsaturated dicarboxylic acid is initially fed to the reactor.

The transfer of this technique on the latex preparation method according to D1, which already suggests that part of the dicarboxylic acid may initially be introduced into the reactor, is considered to be obvious.

- 3.4.5 The subject-matter of present Claim 1 does not thus comply with the requirements of Article 56 EPC.
- 3.4.6 The same arguments and, consequently, the same conclusions apply to the subject-matter of the dependent Claims 2 to 4.
- 4. The Appellant's allegation of a procedural violation by the Opposition Division committed by its too early issuance of the decision under appeal and/or its failure to follow the decision concerning BFG 2 is unfounded.

The Appellant did not, in respect of this issue, rely on any stipulation of the EPC and, indeed, the EPC does not contain any rule of procedure which imposes on an opposition division an obligation to abide, in its decision concerning a certain case, by a decision in a different case. A single decision issued by an opposition division does not therefore establish a "case law" which must be adhered to in another opposition case even if the subject-matter of the two respective cases is closely related.

The issuance of the decision under appeal did not, therefore, contravene the requirements of Article 113(1) EPC and did not establish any procedural violation, let alone a "substantial" one.

- 5. The Appellant is, thus, not entitled to reimbursement of the appeal fee, because the conditions, under which the EPC foresees such a measure are restricted to cases

of interlocutory revision and to cases where an appeal is held allowable, and a reimbursement is equitable by reason of a substantial procedural violation (Rule 67 EPC).

6. Likewise beyond the framework of the EPC is the Appellant's contention, that the Respondent should be held responsible for not having, of its own volition, amended the BFG 1 patent in order to implement any possible restrictions allegedly necessary in view of the revocation of the BFG 2 patent. Equally unforeseen is the consequence that, because of the Respondent's failure to act accordingly, the Appellant should be awarded the costs incurred during these appeal proceedings.

According to Article 104(1) EPC, each party to the proceedings shall meet the costs it has incurred, unless, for reasons of equity, a different apportionment of costs incurred during taking of evidence or in oral proceedings is ordered.

The Respondent's conduct in this case conforms with the procedural requirements of the EPC and it cannot be reasonably accused of any reproachable "inactivity".

An apportionment of costs different from the one stipulated in the first part of the sentence of Article 104(1) EPC is therefore not justified by the facts.

Order


For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The patent is revoked.
3. The request for refund of the appeal fee is rejected.
4. The request for a different apportionment of costs is rejected.

The Registrar:


E. Gorgmaier

The Chairman:


R. Young