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D E C I S I O N
of 11 October 2002

Case Number: T 0063/99 - 3.3.6

Application Number: 93915063.7

Publication Number: 0677125

IPC: D21H 21/16

Language of the proceedings: EN

Title of invention:

Aqueous compositions for sizing of paper

Patentee:

Eka Chemicals AB

Opponent:

Hercules Incorporated

Headword:

Sizing composition/EKA CHEMICALS

Relevant legal provisions:

EPC Art. -

Keyword:

"Admissibility of late - filed requests (no) - abuse of procedure"

Decisions cited:

T 0070/98, T 0323/97

Catchword:

-



Case Number: T 0063/99 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 11 October 2002

Appellant: Eka Chemicals AB
(Proprietor of the patent) S-44580 Bohus (SE)

Representative: Tauchner, Paul, Dr.
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Respondent: Hercules Incorporated
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 25 November 1998
revoking European patent No. 0 677 125 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: L. Li Voti
Members: G. Dischinger-Höppler
C. Rennie-Smith

Summary of Facts and Submissions

- I The present appeal is from the decision of the Opposition Division posted on 25 November 1998 by which European Patent No. 0 677 125, based on European patent application No. 93 915 063.7, was revoked for lack of inventive step. The patent in suit concerns aqueous compositions for sizing of paper.
- II In the opposition proceedings the appellant (the patent proprietor) requested only that the patent be maintained as granted until it filed, with a letter of 9 November 1998, five auxiliary requests. At the oral proceedings before the Opposition Division held on 11 November 1998, the first auxiliary request was refused under Rule 57(a) EPC, the other auxiliary requests were found to comply with Article 123 EPC, and the main and second to fifth auxiliary requests were found to be novel (an issue not contested by the opponent) but not to involve an inventive step.
- III The Statement of Grounds of Appeal filed on 4 April 1999 stated "We hereby withdraw the First to Fifth Auxiliary Requests filed with our letter dated 09.11.98 which formed the basis for the decision of the Opposition Division" and contained only one request, designated as the main request, corresponding to the third auxiliary request considered by the Opposition Division.
- IV The respondent (opponent) filed arguments in reply by a letter dated 21 October 1999. Both parties requested oral proceedings. By a summons dated 19 December 2001 the parties were summoned to oral proceedings which took place on 11 October 2002. Under cover of a faxed

letter of 11 September 2002, the appellant filed an experimental report and five auxiliary requests of which the first was, apart from the omission of four words (the expression "an amphoteric polymer which is amphoteric starch" being reduced to "an amphoteric starch"), identical to the fourth auxiliary request filed on 9 November 1998 and the second was in every respect identical to the fifth auxiliary request filed on that date.

V At the commencement of the oral proceedings, the appellant first announced that all its previous requests were withdrawn and filed a new main and three auxiliary requests. After an observation from the Board that, if these new requests were to be found inadmissible, the appellant would have no requests on file, the appellant announced that only the previous main and third auxiliary requests were withdrawn and that the remaining four auxiliary requests filed on 11 September 2002 were to be treated as the fourth to seventh auxiliary requests. This meant that, the auxiliary requests filed on 11 September 2002 being broader in scope than those filed at the oral proceedings, the fourth to seventh auxiliary requests were broader than the main and first to third auxiliary requests. After discussion of the admissibility of the various requests, the appellant withdrew all its requests except the fourth and fifth auxiliary requests (corresponding respectively to the first and second auxiliary requests filed on 11 September 2002 and the fourth and fifth auxiliary requests filed on 9 November 1998) which thus became its main and first auxiliary requests.

VI The respondent challenged the admissibility of all the

requests and of the test report filed on 11 September 2002 and of all the requests filed at the oral proceedings.

VII The appellant's arguments, in so far as they relate to the admissibility of its requests and the experimental report, can be summarised as follows :

Although only the main request was filed with the Statement of Grounds of Appeal, the appellant had it in mind then to file auxiliary requests later.

As regards the lateness of the auxiliary requests filed with the letter of 11 September 2002, the appellant wanted to wait until the tests described in the experimental report were available. Those tests took time because of limited test facilities and the demands of other litigation. After comment from the respondent and the Board, the appellant admitted that these requests were not dependent on the test results.

Concerning the experimental report itself, the tests described were simple and would have been equally simple for the respondent to repeat so (by inference) filing the report a month before the oral proceedings was not too late for the respondent to deal with it.

As regards the changes in requests made at the oral proceedings, the appellant decided to withdraw the previous main and third auxiliary requests at the oral proceedings because the invention could be more easily explained by reference to the remaining requests; and, as to the lateness of the new requests filed at the oral proceedings, these were simply the result of a meeting the day before between the appellant and its

recently-appointed new representative.

Some of the auxiliary requests, having been filed in the opposition proceedings, were known to the respondent. Since the requests now limited what was claimed within the scope of the former main request, no new searches or prior art would be needed. No undue burden was placed on the respondent by the new requests.

VIII The respondent's arguments, as regards admissibility of the appellant's requests and experimental report, can be summarised as follows:

While in appeal proceedings there is no final time limit of one month before oral proceedings for filing new requests or evidence, the case-law lays down certain requirements: there must be a good reason for the lateness and the new material must be clearly relevant.

As regards the experiments, no reason at all was given in the appellant's letter of 11 September 2002 why the report was not produced earlier. The experiments in question were just laboratory tests which did not require complex facilities or disruption of production. As to their relevance in the proceedings, the tests do not go to any issue in the appeal.

As regards the requests filed with the appellant's letter of 11 September 2002, after relying for three and a half years on a sole main request and after specifically withdrawing all other earlier requests in its Statement of Grounds of Appeal, the appellant now sought to introduce new requests contrary to its

previous position. Some of the new requests were in fact the same as previous ones which had been withdrawn. These were now re-presented without any reason and with no supporting argument.

As regards the new requests produced at the oral proceedings, these are directed to paper-making with a new feature. The respondent was thus taken completely by surprise. It must view the case from a new angle, make new searches and consider new prior art. If these new requests should be admitted, the respondent would request adjournment of the oral proceedings and an apportionment in its favour of the costs of those proceedings.

The order of the requests had now become confusing (see paragraph V above).

IX The Appellant requested that the decision under appeal be set aside and the patent be maintained in accordance with the main or alternatively the first auxiliary request last filed during the oral proceedings.

The Respondent requested that the requests on file be held inadmissible and that the appeal be dismissed.

Reasons for the Decision

1. *The experimental report filed on 11 September 2002*

1.1 In view of the Board's decision, the admissibility of this late item of evidence is no longer a direct issue in the appeal but the Board would, on the well-established tests of justification for late filing and

relevance, have been disinclined to admit it. The appellant gave no reasons at all for its late filing until the oral proceedings. The last submission from the respondent was filed nearly three years previously. It must be remembered that the function of appeal proceedings is primarily to review the decision under appeal and not to conduct the case anew and thus all new evidence on appeal is in principle exceptional. Accordingly, if any new evidence is produced in appeal proceedings after they have been pending for three years and only one month before oral proceedings, there must be very good reasons why it could not have been filed earlier. The only reasons advanced at the oral proceedings were the lack of the appellant's own test facilities and, with less emphasis, the demands of other litigation. The lack of test facilities for a period of some three years is less than consistent with the appellant's own argument that the tests were simple (see paragraph VII above); and pleading other litigation is a shallow reason for an appellant to give for not prosecuting its own appeal expeditiously. However, whatever the merits of these reasons, the Board finds them insufficient to justify the prejudice to the respondent, which is either taken by surprise or made to suffer the delay of an adjournment, or the prejudice to parties to other appeals whose cases could be delayed by an adjournment.

- 1.2 Further, as the respondent argued, the relevance of the experimental report is questionable. The tests described in the report only show that ASA and AKD are different sizing agents which perform differently if applied in the same amounts. This was never in doubt and was not an issue in the proceedings. Tests are normally useful to show an unexpected effect over the

closest prior art which in this case was a document concerned with AKD sizing. No document relating to ASA sizing was ever considered as the closest prior art.

2. *The requests filed at the oral proceedings*

2.1 Again, there is no need for a decision on the admissibility of these requests since they were all ultimately withdrawn. However, the Board observes that requests filed at or shortly before oral proceedings always run a high risk of not being admissible. As is well-known, there is a difference in practice between inter partes and ex parte proceedings: in the latter, an appellant may be allowed to reformulate claims in order to save a patent application. However, even in ex parte proceedings, very late requests may be refused (see, for example, the Board's decision T 70/98 of 15 November 2001, unpublished in OJ EPO). In inter partes proceedings, even if the amendments made to claims in late-filed requests are minor, the other party or parties and the Board are disadvantaged. The Board's comments about surprise and the undesirability of adjournments in paragraph 1.1 above apply equally here.

2.2 The only reason given by the appellant for the very late filing of these requests - namely, that they resulted from a meeting the day before the oral proceedings between the appellant and its representative - is wholly unacceptable. Those conducting proceedings must plan their approach so as not to prejudice other parties. The fact that the representative who appeared before the Board had only been instructed relatively recently (his appointment was intimated to the Board in the letter of

11 September 2002) makes no difference. A change of representative, unless occasioned by force majeure, is never an acceptable reason for delay, late filing or adjournment (see "Case-law of the Boards of Appeal of the European Patent Office", 4th edition, 2001, pages 332 and 550 to 551). In any event, in the present case there was not a real change of representative - the previous representative, a member of staff of the appellant's patent department, engaged the additional services of an external adviser in the closing stages of the appeal but none the less remained involved: it was he who filed the requests of 11 September 2002, he who met the new representative before the oral proceedings and he also attended the oral proceedings.

3. *The requests filed on 11 September 2002*

3.1 Of these requests only two remained on file at the end of the oral proceedings. All the appellant's other requests having been withdrawn, the appeal proceedings thus turned on the admissibility of these two requests.

3.2 While the element of surprise may be less than in the case of requests filed at or shortly before oral proceedings, requests filed one month before such proceedings always run a risk of inadmissibility on the grounds of lateness; and in any event "Auxiliary requests should be filed as early as possible" (see "Guidance for Parties to Appeal Proceedings and their Representatives", OJ 1996, 342, paragraph 3.3). At the very least, a good reason must be advanced for the late filing. In the present case, no reason for the lateness of these requests was given when they were filed and the only reason given at the oral proceedings - namely, that the appellant had been waiting for the test

results - was subsequently admitted to be incorrect (see paragraph VII above).

3.3 While that absence of a reason for lateness might in itself be sufficient reason to find these requests inadmissible, the history of filing then withdrawing and then refileing requests made the appellant's behaviour worse than merely filing additional requests one month before the oral proceedings. The respondent had, from receipt of the Statement of Grounds of Appeal in April 1999 until September 2002, prepared its case on the basis of the one and only request filed with that Statement and in the knowledge that the appellant had clearly announced in that Statement that all other previous requests were withdrawn. Although the appellant said at the oral proceedings it had in mind to file further requests, that intention was never communicated to the respondent or to the Board. While the respondent, when faced with new requests in the final month of the appeal, may not have been required to conduct further or extensive new searches, its representative was certainly required to take fresh instructions and prepare new or additional arguments. Whether or not that would be easy (as the appellant claimed and as to which the Board expresses no opinion), the appellant should not have allowed the respondent to think that only one request, to which the respondent pleaded in full in its letter of 21 October 1999, was in issue and then produce a substantial number of new requests at a very late stage. Even if this had been done unintentionally, it would clearly have amounted to surprise.

3.4 However, the appellant's behaviour was, on its own admission made at the oral proceedings, not

unintentional. By stating that at the time of filing the Statement of Grounds of Appeal - in which all previous requests were explicitly withdrawn and no indication of further requests was given - the appellant had in mind to file further requests later, the appellant disclosed an approach to the appeal proceedings which can only meet with the strongest disapproval. Moreover, since two of the requests filed on 11 September 2002 were identical to requests filed before the Opposition Division, and thus among the requests explicitly abandoned by the appellant in its Grounds of Appeal, the respondent was led to believe these particular requests were no longer in issue only to find them resurrected over three years later. The Board has previously characterised the surprise reintroduction of requests as an abuse of procedure (see its decision T 323/97 of 17 September 2001, to be published in OJ EPO, paragraph 1.1 of the Reasons).

- 3.5 The Board also notes that these particular requests, indeed all the auxiliary requests filed by the appellant before the Opposition Division, were in fact filed **only two days before** the oral proceedings in that Division. Thus the appellant's argument that the respondent had seen these requests before is somewhat hollow.
- 3.6 While in opposition proceedings the main burden lies on the opponent to prosecute and prove its case and a patentee may understandably seek some indulgence for late requests in order to save its patent, on appeal the main burden is on the appellant (whether opponent or patentee) and the respondent is entitled to know the case against it from the Statement of Grounds of Appeal. Any subsequent change in the appellant's case

is made at the appellant's own risk and, however justifiable, **must be made well in advance of the oral proceedings** which, in the majority of cases, is the respondent's last opportunity to defend its own position. In this case, the appellant's approach was wholly unjustifiable and amounted to a manifest abuse of procedure.

- 3.7 The Board therefore finds these requests inadmissible. There being no other requests on file, the appeal must be dismissed.

Order

For these reasons it is decided:

1. The appellant's requests are inadmissible.
2. The appeal is dismissed.

The Registrar:

The Chairman:

G. Rauh

L. Li Voti