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D E C I S I O N
of 18 September 2001

Case Number: T 0611/00 - 3.3.6

Application Number: 93915731.9

Publication Number: 0648257

IPC: C10L 1/18

Language of the proceedings: EN

Title of invention:
Oil additives and compositions

Patentee:
ExxonMobil Chemical Patents Inc.

Opponent:
Clariant GmbH

Headword:
Fresh case/EXXONMOBIL

Relevant legal provisions:
EPC Art. 104

Keyword:
"Relevance of new evidence filed on appeal - (yes)"
"Fresh case-remittal to first instance - (yes)"
"Apportionment of costs - (no) - possibility of recovering costs in further first instance proceedings"

Decisions cited:
-

Catchword:
-



Case Number: T 0611/00 - 3.3.6

D E C I S I O N
of the Technical Board of Appeal 3.3.6
of 18 September 2001

Appellant: Clariant GmbH
(Opponent) Patente, Marken, Lizenzen
Am Unisys-Park 1
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Representative: -

Respondent: ExxonMobil Chemical Patents Inc.
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Decision under appeal: Interlocutory decision of the Opposition Division
of the European Patent Office posted 10 April
2000 concerning maintenance of European patent
No. 0 648 257 in amended form.

Composition of the Board:

Chairman: P. Krasa
Members: L. Li Voti
C. Rennie-Smith

Summary of Facts and Submissions

I. European patent No. 0 648 257, based on application No. 93 915 731.9, was granted on 26 February 1997. After opposition proceedings based on alleged lack of novelty and inventive step pursuant to Articles 52, 54, 56 and 100a EPC, the patent was by a decision of the Opposition Division dated 10 April 2000 maintained in amended form. The appellant (opponent) filed a notice of appeal against this decision and paid the appeal fee on 19 June 2000. Grounds of appeal were received on 26 July 2000.

II. The evidence in the first instance proceedings consisted of ten documents of which nine were cited by the appellant in its notice of opposition and the tenth was filed by the respondent (proprietor) during the opposition proceedings (see paragraphs 5 and 10 of the "Summary of facts and submissions" in the decision under appeal). In its grounds of appeal the appellant cited a further document

(11) US-A-4404000

and substantially based its renewed attacks on novelty and inventive step on this document. With a subsequent letter of 18 October 2000, the appellant cited yet another new document

(12) JP-A-58-23885 (translation)

and relied on this also in relation to its attack on novelty. Although the appellant requests that the two new documents be admitted in the appeal proceedings, it has provided neither any reasons for their late filing

nor any arguments why they should be held admissible (although it is to be implied from its other submissions that the appellant considers the documents sufficiently relevant as to prejudice the maintenance of the patent).

- III. The respondent, in its written response to the grounds of appeal filed on 12 February 2001, stated that it does not object to the introduction of the two new documents and observed that it had itself introduced a new document (10) during the first instance proceedings in order to ensure a thorough examination of the patent in suit. However, it argued that, since the new evidence amounts to a new case against the patent on appeal, the case should be remitted to the first instance. As first and second auxiliary requests the respondent also filed two sets of amended claims.

- IV. The appellant requests the admission of documents (11) and (12) into the proceedings and revocation of the patent in suit. It has not requested oral proceedings.

- V. The respondent's main request is for remittal of the case to the Opposition Division for examination of the new matter introduced on appeal by the appellant. Alternatively it requests maintenance of the patent on the basis of one of the amended sets of claims forming its first and second auxiliary requests. If its main request is granted, the appellant additionally requests an apportionment of costs such that the appellant pays the respondent its costs of this appeal. It asks for oral proceedings only if the board is not inclined to grant its main request.

Reasons for the Decision

1. The appeal itself is admissible. However, the admissibility of the new documents (11) and (12) involves serious issues of procedural conduct. Although the appellant only relies on the same grounds of opposition - lack of novelty and inventive step - as it did at first instance, it has, by basing its appeal on completely new evidence, presented a wholly fresh case on appeal. If the new evidence is admissible, the respondent will then have to deal, in effect, with a second opposition to the patent. The purpose of appeal proceedings is to review and reconsider the decision under appeal and not to give an opponent the opportunity to mount a second and different attack on the patent in suit.

2. The Board is not however required to hold that all evidence introduced for the first time on appeal is inadmissible. To ignore a highly relevant document which may affect the validity of the patent in suit could lead to the curious situation where a patent is maintained which, if the document were taken into account, would have been revoked. The Board thus has to balance two demands of public interest, that of procedural fairness and that of preventing unwarranted monopolies. It is for this reason that one consistent theme of the considerable case-law of the Boards on the subject of late-filed evidence is that a Board has a discretion in every such case which should be exercised in the light of the particular circumstances of the case. In exercising this discretion the Board has to consider a number of questions including:

- Why was the new evidence filed late?

- Could it have been found and filed earlier?
- Is the new evidence, or any part of it, so relevant that it cannot be excluded even though produced at a late stage of the proceedings?
- If the new evidence, or part of it, is admissible, is it necessary, in fairness to the party required to respond to it, that the case be remitted to the first instance so that it is open to consideration at two levels of jurisdiction as if it had been filed at the proper time?
- Has the party required to respond to the new evidence incurred costs which should be paid by the party producing the late evidence?

3. The appellant has offered no reasons for the late filing of documents (11) and (12) and the Board can see nothing which could excuse the delay in producing them. The new documents, a US patent (11) and a Japanese patent application (12), were both published in 1983 and were therefore readily available public documents at the time of the opposition period. Moreover document (11) is the corresponding US patent to EP-A-0074208 which was cited in the International Search Report but not relied on during the opposition proceedings, although the appellant did rely in those proceedings on two other documents, (1) and (9), which also corresponded to citations in that Report. The Board therefore concludes without difficulty that, in the present case, the late-filed documents could and should have been filed during the opposition period.

4. As to whether, notwithstanding such lateness, either or

both of the documents should be admitted on the grounds of relevance, the Board considers that (12) represents a serious attack on novelty and both (11) and (12) appear to be closer prior art than that previously considered as regards inventive step. Further, although the respondent has quite understandably criticised the appellant's lateness in filing the new evidence, it has not objected to its admission into the proceedings. Accordingly, on the criterion of relevance and in the absence of objection from the respondent, these two new documents should be considered.

5. The Board, having found that the new documents should be taken into account, must ensure that the Respondent receives fair procedural treatment in the further conduct of the case. The respondent's request that the case be remitted to the first instance must therefore be allowed. The respondent will thereby have the opportunity to defend the patent against the new evidence as if it had been filed in the original opposition proceedings and, should it be adversely effected by the Opposition Division's decision, the further opportunity to appeal if it so wishes.

6. As regards the respondent's request for an apportionment of costs under Article 104 EPC, the Board can see the force of this request particularly in view of the appellant's unexplained, and seemingly inexcusable, behaviour in producing two relevant documents, readily available during the opposition period, at such a late stage - in one case with the grounds of appeal, and in the other case nearly two months after the time for filing the grounds of appeal had expired. However, the appellant has made no written response to the request for costs and, since the

present appeal can be disposed of by allowing the respondent's main request, no oral proceedings are necessary and to hold oral proceedings just on the issue of costs would itself increase the costs disproportionately. The bulk of the respondent's costs incurred on the appeal will have related to its arguments against the fresh case now made on the basis of documents (11) and (12) and those arguments can and no doubt will be deployed in the further first instance proceedings. Thus the respondent will recover such costs if it successfully requests the Opposition Division to order an apportionment in its favour of all the costs of those further proceedings which, but for the appellant's behaviour, would have been unnecessary.

Order

For these reasons it is decided that:

1. The late-filed documents (11) and (12) are formally admitted into the proceedings.
2. The decision under appeal is set aside.
3. The case is remitted to the first instance for further examination of the opposition.
4. The request for apportionment of costs is refused.

The Registrar:

The Chairman:

G. Rauh

P. Krasa