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D E C I S I O N
of 21 January 2005

Case Number: T 0959/00 - 3.3.3

Application Number: 94906456.2

Publication Number: 0628060

IPC: C08F 220/18

Language of the proceedings: EN

Title of invention:

Copolymers of unsaturated fatty esters, their use as viscosity improver and lubricating oil containing said copolymers

Patentee:

THE LUBRIZOL CORPORATION

Opponent:

Röhm GmbH & Co. KG

Headword:

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Relevant legal provisions:

EPC Art. 111(1), 113(1), 117(1)

EPC R. 67

Keyword:

"Alleged prior use - witness offered but no heard by
opposition division"

"Remittal to opposition division (procedural violation)"

Decisions cited:

G 0009/92, T 0005/81

Catchword:

-



Case Number: T 0959/00 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 21 January 2005

Appellant: THE LUBRIZOL CORPORATION
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Wickliffe,
Ohio 44092-2298 (US)

Representative: Crisp, David Norman
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London EC1N 2DY (GB)

Respondent: Röhm GmbH & Co. KG
(Opponent) Kirschenallee 2
D-64293 Darmstadt (DE)

Representative: Mai, Peter M.
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 28 July 2000
revoking European patent No. 0628060 pursuant
to Article 102(1) EPC.

Composition of the Board:

Chairman: R. Young
Members: W. Sieber
E. Dufrasne

Summary of Facts and Submissions

I. The mention of the grant of European patent No. 0 628 060, in respect of European patent application no. 94 906 456.2, based on International application no. PCT/US93/12528, filed on 22 December 1993 and claiming a FR priority of 28 December 1992 (FR 9215780), was published on 30 July 1997 (Bulletin 1997/31). The granted patent contained 19 claims, whereby independent Claim 1 read as follows:

"1. A copolymer comprising carboxylic acid ester groups comprising

a percentage a by mass of an ester of a carboxylic acid ester [sic] A₁ containing from 3 to 5 carbon atoms and exhibiting an ethylenic unsaturation alpha to the carboxylic functional group, with an alcohol of formula R₁OH containing from 1 to 3 carbon atoms;

a percentage b by mass of an ester of a carboxylic acid A₂ containing from 3 to 5 carbon atoms and exhibiting an ethylenic unsaturation alpha to the carboxylic functional group, with an alcohol of formula R₂OH containing on average from 11 to 15 carbon atoms; and

a percentage c by mass of an ester of a carboxylic acid A₃ containing from 3 to 5 carbon atoms and exhibiting an ethylenic unsaturation alpha to the carboxylic functional group, with an alcohol of formula R₃OH containing on average from 16 to 25 carbon atoms

in which a is between 12 and 20%, c is between 14 and 30% and b is between 72 and 45%, such that $a + b + c = 100\%$."

The remaining claims are not of importance for this decision and consequently they will not be considered in further detail.

II. A notice of opposition was filed on 29 April 1998 by Röhm GmbH (now Röhm GmbH & Co. KG), requesting revocation of the patent in its entirety on the grounds of Article 100(a) EPC, ie lack of novelty and lack of inventive step. The opposition was - *inter alia* - supported by the following documents:

D3: DE-A-3613992;

D4: EP-A-0 236 844; and

Annexes 1 to 8 relating to VISCOPLEX[®] products.

With regard to novelty, the opponent argued - *inter alia* - that the claimed subject-matter was not novel in view of the public prior use by the commercially available products VISCOPLEX[®] 8-200, 0-200, 8-400, 8-800, 8-801, 8-300 and 8-450. This objection was supported by written evidence provided in Annexes 1 to 8. As further evidence, the opponent offered a Mr Möller to be heard as a witness.

III. By a decision issued in writing on 28 July 2000, the opposition division revoked the patent. The opposition division held that the claimed subject-matter was novel, and in particular that, based on the documents of

Annex 1-8, there was no prior use in view of the products VISCOPLEX[®] 8-200, 0-200, 8-400, 8-800, 8-801, 8-300 and 8-450. However, the claimed subject-matter lacked an inventive step in view of documents D3 and D4.

- IV. On 25 September 2000, the proprietor (hereinafter referred to as the appellant) filed a notice of appeal against the above decision, the prescribed fee having been paid on 22 September 2000.

In the statement of grounds of appeal, filed on 28 November 2000, the appellant contested the finding of the opposition division that the claimed subject-matter was not based on an inventive step.

- V. In a letter dated 1 June 2001, the opponent (hereinafter referred to as the respondent) submitted its counterarguments with respect to inventive step.

Furthermore, it contested the position of the opposition division that the prior use in view of the VISCOPLEX[®] products was not sufficiently substantiated, and offered again for Mr Möller to be heard as a witness in accordance with Article 117(1) EPC.

- VI. With letter dated 29 May 2002, the appellant objected to the respondent's offer to use Mr Möller as a witness in the opposition appeal proceedings.

- VII. Following a communication from the board (issued on 15 April 2003), the respondent filed with letter dated 24 June 2003 - *inter alia* -the following document:

D5: "*Eidesstattliche Erklärung*" dated 10 June 2003 from Mr Möller concerning the composition of VISCOPLEX[®] products.

The respondent argued that the claimed subject-matter lacked novelty in view of the prior use.

VIII. In a communication issued on 23 April 2004, the board indicated that the issue of novelty, and in particular the issue of prior use would include hearing of the witness. Since, however, the opposition division had not heard the witness, the board would be the first instance in this respect. Thus, the parties were invited to formulate their requests with respect to hearing of the witness.

IX. In letters dated 26 May 2004 and 27 July 2004, the appellant requested that the case be referred back to the first instance in order to have the opportunity that any issues in relation to prior use would be considered by two instances.

X. The respondent requested in a letter dated 23 June 2004 that the witness be heard by the board in view of economy of procedure, commercial interest and possible infringement proceedings.

XI. On 21 January 2005, oral proceedings were held before the board. The discussion focussed on the question as to whether or not the case should be remitted to the first instance to consider the issue of prior use, in particular in relation to the question of hearing the witness.

The respondent essentially relied on its written submissions pointing to economy of procedure, commercial interest and possible infringement proceedings. Furthermore, the respondent gave reasons as to why the "*Eidesstattliche Erklärung*" was filed so late, eg the difficulties in convincing Mr Möller to give such a declaration and the fact that Mr Möller had already retired.

The appellant argued that the case should be remitted to the first instance in view of Article 10 of the Rules of Procedure of the Boards of Appeal, especially since the reasons given by the respondent were not special reasons which could justify doing otherwise. Furthermore, the representative of the appellant stated that, according to his knowledge, no infringement proceedings were pending.

- XII. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted. Furthermore, the appellant requested that the case be referred back to the first instance to consider any issues in relation to prior use.

The respondent requested that the appeal be dismissed. Furthermore, the respondent requested that the witness be heard by the board.

Reasons for the Decision

1. The proprietor's appeal complies with Articles 106 to 108 EPC and Rule 64 EPC and is therefore admissible.

2. *Prior use*

2.1 The opposition division decided that the claimed subject-matter was novel but revoked the patent for lack of inventive step (section III, above). Consequently, the respondent (opponent) is not adversely affected by this decision. Since, furthermore, the EPC does not provide for the possibility of a cross-appeal by a respondent, the respondent is not entitled to appeal against this decision (Article 107 EPC). However, in the circumstances of such a case, "A non-appealing party as a respondent has the opportunity to make what it considers to be appropriate and necessary submissions in the appeal proceedings to defend the result obtained before the first instance" (G 9/92, OJ EPO 1994, 875, point 11 of the reasons for the decision).

In the present case, the respondent maintained its objection that the claimed subject-matter was not novel in view of the products VISCOPLEX[®] 8-200, 0-200, 8-400, 8-800, 8-801, 8-300 and 8-450, ie an issue which was part of the opposition proceedings and thus is a part of the legal and factual framework of the present opposition appeal proceedings. The respondent offered again (as already during the opposition proceedings) for Mr Möller to be heard as a witness in accordance with Article 117(1) EPC. Thus, before dealing with the issue of inventive step which led to the revocation of the patent in suit, the board has to deal with the issue of novelty, and in particular with the issue of prior use in view of the above-mentioned VISCOPLEX[®] products.

2.2 Annexes 1 to 7 relate to sales data of the products VISCOPLEX[®] 8-200, 0-200, 8-400, 8-800, 8-801, 8-300 and 8-450 whereas Annex 8 allegedly discloses the composition of these products, namely the individual components and their ratio. However, Annex 8 does not identify each individual component by its chemical name but by an alias. For VISCOPLEX[®] 8-200, for example, Annex 8 shows the following composition (solids):

TG189-co-T190-F3 = 67,0-19,0-14

or

TG361-co-T190-F3 = 67,2-18,8-14

or

TG337-co-T190-F3 = 66,9-19,1-14

The opposition division concluded that it had neither been proven that TG189, T190 and F3 were the carboxylic acid esters required in Claim 1 of the patent in suit nor that the figures related to weight percentages.

2.3 It is conspicuous to the board that the opposition division did not reply to the opponent's offer to hear Mr Möller as a witness with respect to the alleged prior use. The board is also unable to trace in the decision under appeal any reference to a reason why it was considered unnecessary to hear Mr Möller.

2.4 Consequently, the requirements of due process were not observed, in relation to the opponent at least, in the decision under appeal. In the judgement of the board, the opposition division's failure to hear the witness and the absence of any reference to a reason in the decision under appeal why it was not necessary to hear

the witness amounts to a serious and fundamental procedural violation (Article 113(1) EPC).

3. *Remittal to first instance*

3.1 Although the violation of Article 113(1) EPC is serious and fundamental, the requirement of equity and thus repayment of the appeal fee (Rule 67 EPC) does not arise in the present case since the violation of Article 113(1) EPC does not seem to affect the *ratio decidendi* of the decision under appeal (see T 5/81, OJ EPO 1982, 249; point 4 of the reasons).

3.2 Nevertheless, the violation of Article 113(1) EPC is so serious that it cannot be ignored and even justifies referral of the case to the first instance for the following reasons:

3.2.1 It appears from D5 that the matters to which Mr Möller would have been expected to testify are precisely those forming the basis of the decision establishing novelty over the prior use, namely the nature of the chemical compounds behind the aliases TG189, T190 and F3 and the amounts of these compounds in the VISCOPLEX[®] products. These matters constitute new facts which were not considered by the opposition division. Under those circumstances, a case is normally remitted to the first instance in order not to deprive the parties of the opportunity to have all facts of a case considered by two instances.

3.2.2 Furthermore, the outcome of the assessment on novelty, in particular with respect to the prior use, may have consequences on the issue of inventive step, eg a

different closest state of the art may have to be taken into account. Consequently, the remittal to the first instance appears also to be necessary to restore the procedural situation at the point before a decision on inventive step was taken.

3.2.3 Hence, the board considers it appropriate to exercise its power under Article 111(1) EPC to remit the case to the first instance, especially because the appellant has expressly requested this.

3.2.4 In support of its request not to remit the case, the respondent mentioned economy of procedure, commercial interest and possible infringement proceedings. However, these arguments are not convincing for the following reasons. Firstly, the file history does not show a particular interest of the respondent in a speedy procedure. For example, no request for accelerated examination was filed. On the contrary, the respondent requested an extension of the time limit to file observations on the statement of grounds of appeal. Secondly, in the letter dated 1 June 2001, the respondent only indicated the filing of further evidence relating to the identity of TG189, T190 and F3. In fact, the relevant document, namely D5, was only filed in response to a communication of the board. Finally, as regards the possibility of infringement proceedings, the appellant's representative stated at the oral proceedings that, according to the best of his knowledge, no such proceedings were pending.

3.3 The appellant's reference to Article 10 of the Rules of Procedure of the Boards of Appeal does not alter the

board's decision to remit the case to the first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order for further prosecution taking into account the requirements of Article 113(1) EPC, in particular in relation to the question of hearing the witness.

The Registrar:

The Chairman:

E. Görgmaier

R. Young