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**Datasheet for the decision
of 9 November 2020**

Case Number: T 0113/18 - 3.3.03

Application Number: 12765709.6

Publication Number: 2693274

IPC: G03G15/02, C08G65/18,
C08L71/03, G03G15/00,
G03G15/08, G03G15/16,
C08G65/333

Language of the proceedings: EN

Title of invention:
CONDUCTIVE MEMBER

Patent Proprietor:
Canon Kabushiki Kaisha

Opponent:
Kraus & Weisert
Patentanwälte PartGmbH

Relevant legal provisions:
EPC Art. 54(2), 54(3), 111(1), 153(4), 153(5)
EPC R. 159(1)(a), 159(1)(c), 165
RPBA 2020 Art. 11, 12(3)

Keyword:

Novelty (yes) - alleged anticipatory disclosure does not disclose claimed subject matter and is not prior art partial priority being acknowledged

Decisions cited:

G 0010/91, G 0001/15



Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0113/18 - 3.3.03

D E C I S I O N
of Technical Board of Appeal 3.3.03
of 9 November 2020

Appellant: Canon Kabushiki Kaisha
(Patent Proprietor) 30-2, Shimomaruko 3-chome,
Ohta-ku,
Tokyo 146-8501 (JP)

Representative: TBK
Bavariaring 4-6
80336 München (DE)

Respondent: Kraus & Weisert
(Opponent) Patentanwälte PartGmbH
Thomas-Wimmer-Ring 15
80539 München (DE)

Representative: Beckmann, Claus
Kraus & Weisert
Patentanwälte PartGmbH
Thomas-Wimmer-Ring 15
80539 München (DE)

Decision under appeal: **Interlocutory decision of the Opposition
Division of the European Patent Office posted on
20 October 2017 concerning maintenance of the
European Patent No. 2693274 in amended form.**

Composition of the Board:

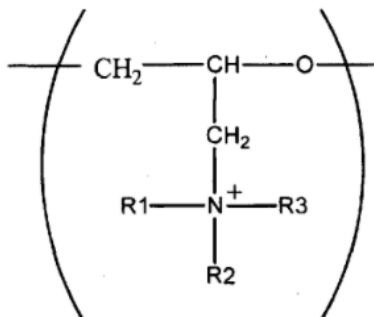
Chairman D. Semino
Members: F. Rousseau
C. Brandt

Summary of Facts and Submissions

- I. The appeal lies from the interlocutory decision of the opposition division according to which European patent No. 2 693 274 as amended according to the claims of the second auxiliary request filed with letter of 24 July 2017 and an amended description met the requirements of the EPC. The contested decision was also based as the main request on the rejection of the opposition and on a first auxiliary request filed also with letter of 24 July 2017.
- II. The patent in suit was filed 21 March 2012 and claims priority from Japanese patent application JP 2011 072404 filed on 29 March 2011. The claims of the patent as granted read as follow:

"1. A conductive member, comprising:
a conductive support; and
a conductive layer,
wherein the conductive layer contains a modified epichlorohydrin rubber having a unit represented by the following formula (1) and an anion:

Formula (1)



in the formula (1), R1, R2, and R3 each independently represent hydrogen or a saturated hydrocarbon group having 1 to 18 carbon atoms.

2. A process cartridge, which is attachably/detachably mounted to a main body of an electrophotographic apparatus, the process cartridge comprising the conductive member according to claim 1 as at least one member selected from a charging member and a developing member.

3. An electrophotographic apparatus, comprising the conductive member according to claim 1 as at least one member selected from a charging member and a developing member."

III. The decision was taken having regard amongst others to the following documents:

D1: WO 2011/081152 A1

D1a: US 2012/0296049 A1

D5: JP-A-2011 072404

D5a: partial English translation of D5

IV. The reasons for the contested decision, in so far as they are relevant for the present decision, can be summarized as follows:

Having regard to its partial translation D5a the Japanese patent application D5 from which the patent in suit claimed priority did not disclose that the unit of formula (1) was associated with an anion in general, but only with a chloride anion. Since the generalisation from chloride in the priority document to anion in the patent in suit was not directly and unambiguously derivable from the priority document, the

right of priority claimed was not valid and as a consequence document D1 published between the priority date and the filing date of the patent in suit was prior art pursuant to Article 54(2) EPC. Having regard to its translation D1a, D1 described with its Examples 1 to 10 a modified epichlorohydrin rubber falling within the definition of formula (1) of claim 1 of the contested patent. These examples being representative of the general teaching of D1, the skilled person would have combined them with the disclosure of paragraphs 2 to 5 of that document which disclosed conductive members in electrophotographic image forming member. In addition, from paragraph 5 it was evident that the conductive polymers of Examples 1 to 10 formed an outermost layer on a support. Although D1 was silent on a conductive support, a support in a conductive member consisted either of a single-layered conductive substrate or of a substrate that was surface-treated with a conductive agent. Said surface-treated substrate or coated substrate was held to cover the functional claimed feature of "a conductive support". Accordingly, the subject-matter of claim 1 of the patent as granted lacked novelty over D1 and the main request was not allowed for this reason only.

The conductive member of claim 1 of the second auxiliary request, which was limited with respect to the main request in that the anion was chloride, enjoyed the right priority, so that D1 no longer belonged to the state of the art, and was novel and inventive over the available prior art.

- V. The patent proprietor (appellant) lodged an appeal against the above decision. The patent proprietor submitted with their statement setting out the grounds

of appeal (letter of 26 February 2018) a set of claims labelled Auxiliary Request A.

- VI. With communication dated 1 March 2018 the statement of grounds of appeal was notified to the opponent (respondent), whereby it was stated that a reply was to be filed within four months. No reply was received.
- VII. In response to the summons issued with a communication of 8 June 2020 the respondent informed the Board with a letter of 14 July 2020 that no one would attend the oral proceedings on behalf of the respondent.
- VIII. The oral proceedings were thereafter cancelled by the Board and the decision was taken in writing.
- IX. The appellant (patent proprietor) requested that the decision under appeal be set aside and the patent be maintained as granted, i.e. that the opposition be rejected, or auxiliary on the basis of the set of claims labelled "Auxiliary Request A" submitted with the statement of grounds of appeal (letter of 26 February 2018).
- X. The respondent (opponent) did not file any request, nor any submission in the appeal proceedings.

Reasons for the Decision

- 1. The present proceedings are governed by the revised version of the Rules of Procedure which came into force on 1 January 2020 (Articles 24 and 25(1) RPBA 2020), except for Articles 12(4) to (6) RPBA 2020 instead of

which Articles 12(4) RPBA 2007 remains applicable (Article 25(2) RPBA 2020).

2. The respondent has informed the Board by letter of 14 July 2020 that it would not be represented at the oral proceedings. Moreover it did not file any request for oral proceedings. By means of this the respondent has decided that the Board should decide the present case based on the written submissions of the appellant and any submissions to be made by the latter during the oral proceedings. As the Board was in the position to decide according to the request of the appellant based on the written submissions by that party, the decision could be taken in writing and the oral proceedings were canceled, as not deemed necessary.

Main request

Novelty in view of D1

3. It is not disputed that, as indicated by the opposition division in the paragraph bridging pages 4 and 5 of the contested decision, the priority document D5 of the patent in suit discloses the rubber defined in operative claim 1 as far as the anion is chloride since the nucleophilic substitution reaction with an amine compound at the chloride site of the polymerized epichlorohydrin unit which is carried out to prepare the modified rubber of D5 leads to a quaternary ammonium group and a chloride ion, in line with the reaction mechanism indicated in paragraph [0025] of the patent in suit. It was also not disputed that the production of said modified rubbers with a chloride anion was described in an enabling manner in the priority document D5. Under these circumstances, it is concluded in application of the rationale of decision G

1/15 of the Enlarged Board of Appeal (OJ EPO 2017, A82) (see point 6.4 of the Reasons and Order) that the subject-matter of present claim 1 is entitled to partial priority from D5 at least in so far as the anion is chloride, i.e. that partial priority has the effect that the date of priority shall count as the date of filing for the purposes of Article 54(2) and (3) EPC at least in so far the anion is chloride.

4. It follows therefrom that D1 published on 7 July 2011, i.e. between the date of priority and date of filing of the patent in suit, is not prior art pursuant to Article 54(2) EPC at least for such subject-matter. It is furthermore undisputed that said PCT application did not meet some of the requirements for entry into the European phase defined in Rule 159(1)(a) and (c) EPC with the consequence that D1 is not prior art pursuant to Article 54(3) EPC either (Article 153(5) EPC and Rule 165 EPC).
- 5.
6. As far as the disclosure of D1 is concerned, it is undisputed that Examples 1 to 10 of D1 (reference being made to D1a, considered as a true translation of D1, as not disputed by the appellant), which the opposition division considered to disclose the subject-matter of claim 1 of the patent in suit when read in combination with paragraphs 2 to 5 of that document, describe rubber compositions falling within the definition of formula (1) of claim 1 of the contested patent. However, the modified polyether rubber of these examples are obtained by reacting polyether rubbers A, B and C, which are epichlorohydrin/ethylene oxide/allyl glycidyl ether terpolymers (see paragraphs [0104] to [0106]), with trialkylamines (see paragraphs [0108],

[0110], [0112], [0114], [0116], [0118], [0120], [0122], [0124], [126] and Table 1). This reaction in view of the same considerations as outlined in the analysis of priority (see section 3., above) leads to rubbers having units according to formula (1) of claim 1 in which the anion is chloride.

For this reason alone the attack of novelty based on Examples 1 to 10 of D1 in combination with passages from the description cannot succeed, as it results in subject-matter for which partial priority is validly claimed and for which therefore D1 is not state of the art.

7. In addition, in view of Table 1 on pages 12 and 13 indicating the characterization of the rubber prepared in those Examples (composition, molecular weight, money viscosity, volume resistivity and increase of value in volume resistivity caused by electric current) and paragraphs [0092] to [0102] explaining the methods by which the tests were carried out, it is observed that a conductive member comprising a conductive support and a conductive layer containing a modified epichlorohydrin rubber is not prepared in those examples, but a cross-linked rubber sheet obtained by moulding and cross-linking the obtained modified rubbers.

D1 has not been shown to disclose elsewhere a layer of one of the modified rubbers prepared in any of Examples 1 to 10 with a conductive layer comprised in a conductive member. The information provided in paragraphs 2 to 5 of that document referred to by the opposition division which according to the reasons for the decision would be read by the skilled person in combination with the disclosure of Examples 1 to 10 are under the heading "background art" and merely concern a

description of the prior art, although without any reference to a specific document. There is no indication that said mentioned unspecified prior art referred to in D1 would concern a rubber in accordance with claim 1 of the patent in suit or that its teaching should to be applied to the specific rubber compositions described in Examples 1 to 10 of D1. Also for that reason, it can be concluded that the reasons for the lack of novelty of claim 1 of the main request over D1 do not hold.

8. It is also added that the general teaching of D1 in paragraph [0088] concerning the conductive members which can be prepared with the conductive rubbers of D1 does not either explicitly or implicitly disclose a conductive member comprising a conductive support and a conductive layer. The Board has therefore no reason to conclude that the subject-matter of claim 1 of the granted patent is described in D1.
- 9.
10. Accordingly, the sole reason in the contested decision for not allowing the main request, namely that the conductive member of claim 1 lacked novelty over D1, fails to convince.

Remittal

11. In view of the above conclusion the appeal is allowable to the extent that the decision under appeal is to be set aside. As the next step under Article 111(1), second sentence, EPC, the board may either exercise any power within the competence of the opposition division or remit the case to it for further prosecution, taking

into consideration that the appellant also requested that the patent be maintained as granted.

- 11.1 In the present case the respondent did not react to the submissions by the appellant and therefore did not make known to the Board whether other objections were considered to prejudice maintenance of the patent in the form as granted. The respondent did not even submit any request. According to decision G 10/91 of the Enlarged Board of Appeal (OJ 1993, 420, point 18 of the Reasons), the appeal procedure *inter partes* is, in contrast to the merely administrative character of the opposition procedure, considered as a judicial procedure, which by its very nature is less investigative than an administrative procedure and in which opposing parties should be given equally fair treatment (see G 10/91, loc. cit., point 2). In view of the judicial nature and purpose of *inter partes* appeal proceedings and in the interests of an efficient and fair procedure, it is therefore necessary that all parties to opposition proceedings complete their submissions at the beginning of the appeal stage in so far as this is possible. This is reflected in Article 12(3) RPBA 2020, whose wording is in essence identical to that of Article 12(2) RPBA 2007, which specifies that the statement of grounds of appeal and the reply shall contain a party's complete appeal case. Accordingly, they shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the requests, facts, objections, arguments and evidence relied on.

- 11.2 Thus, in the present case, it would have been to the respondent to indicate its request, also setting out the reasons why such request would have been made. The

opponent ceased to take an active part in the proceedings after having received the opposition division's decision. In view of the character of the *inter partes* appeal proceedings, it cannot be expected, that the Board in breach of the principle of equal treatment of the parties, investigates whether other objections raised before the opposition division (which in any case were found not to be successful for the second auxiliary request limited to chloride as anion) would be likely to prejudice maintenance of the patent, and if so provide on its own, an elaborate and full reasoning, substituting itself for that opponent which remained passive.

- 11.3 As to the question whether the Board should remit the case to the opposition division for further prosecution, it is the boards' settled case law that parties do not have a fundamental right to have their case examined by two instances (Case Law of the boards of Appeal, 9th edition 2019, V.A.7.2.1). Article 111(1), second sentence, EPC leaves it instead to the board's discretion to decide on an appeal either by exercising any power conferred on the department of first instance or by remitting the case to that department taking into account the circumstances of the individual case, also bearing in mind the need for procedural economy (Case Law, *supra*, V.A.7.2.1), i.e. the need to avoid undue prolongation of the entire proceedings before the EPO (see explanatory remark concerning Article 11 RPBA 2020 in Supplementary publication 2 to OJ EPO 2020, page 54). It's the Board's position that the silence of the respondent cannot lead to an automatic remittal of the case to the opposition division to decide whether further objections are likely to prejudice maintenance of the patent remain, as it would deprive the Board of its

discretion conferred to it by Article 111(1) EPC, the purpose of which is to weight up all the circumstances of the present case, in particular the existence of additional contentious issues which in the present case have not been brought to the attention of the Board.

- 11.4 Accordingly, in the absence of any objection raised by the respondent against the main request, let alone any request by that party, the Board does not remit the case to the opposition division for further prosecution and has no reason to consider that the claims in accordance with the main request do not fulfil the requirements of the EPC. The Board therefore decides that the main request is allowable.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The opposition is rejected.

The Registrar:

The Chairman:



B. ter Heijden

D. Semino

Decision electronically authenticated