



Veröffentlichung im Amtsblatt	Ja/Nein
Publication in the Official Journal	Yes/No
Publication au Journal Officiel	Oui/Non

Aktenzeichen / Case Number / N° du recours : T 222/85  
Anmeldenummer / Filing No / N° de la demande : 79 300 610.7  
Veröffentlichungs-Nr. / Publication No / N° de la publication : 5033

Bezeichnung der Erfindung:  
Title of invention: Ungelled polyesters and their use in coating  
Titre de l'invention : compositions

Klassifikation / Classification / Classement :

### ENTSCHEIDUNG / DECISION

vom / of / du

21 January 1987

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /  
Titulaire du brevet : PPG INDUSTRIES, INC. (respondent)

Einsprechender / Opponent / Opposant : N.V. DSM (appellant)

Stichwort / Headword / Référence : Inadmissible/PPG

EPO / EPC / CBE Art. 99(1) and Rules 55(c), 56(1) and 57(1)

Kennwort / Keyword / Mot clé :

"Notice of Opposition - Admissibility"  
"Communication under Rule 57(1) EPC"  
"Sufficiency of notice of opposition"

#### Leitsatz / Headnote / Sommaire

- I. A communication under Rule 57(1) EPC indicating the admissibility of an opposition is not a decision of the Opposition Division, and the sending of such a communication does not prevent the subsequent rejection of the notice of opposition as inadmissible under Rule 56(1) EPC, for example if the admissibility is challenged by the proprietor of the patent in such proceedings.
- II. The requirement under Rule 55(c) EPC, that the notice of opposition shall, inter alia, contain "an indication of facts, evidence and arguments presented in support of the ground" is only satisfied if the contents of such notice are sufficient for the opponent's case to be properly understood on an objective basis.



**Case Number : T 222 /85**

**DECISION  
of the Technical Board of Appeal 3.3.2  
of 21 January 1987**

**Appellant :** N.V. DSM  
(Opponent) Van der Maeszenstraat 2  
NL-6411 LP Heerlen

**Representative :** Leherte, Georges Maurice Lucien Marie  
Octrooibureau DSM  
P.O. Box 9  
NL-6160 MA Geleen

**Respondent :** PPG INDUSTRIES, INC.  
(Proprietor of the patent) 1 PPG Place  
USA-Pennsylvania 15272

**Representative :** Shipton, Gordon Owen  
W.P. THOMPSON & CO.  
Coopers Building  
Church Street  
GB-Liverpool L1 3AB

**Decision under appeal :** Decision of Opposition Division of the European  
Patent Office dated 27 June 1985 rejecting  
the opposition filed against European patent  
No. 5033 pursuant to Rule 56(1) EPC.

**Composition of the Board :**

**Chairman :** P. Lançon  
**Member :** G. D. Paterson  
**Member :** G. Szabo

### Summary of Facts and Submissions

- I. European patent No. 5033 was granted on 16 February 1983 with 21 claims in response to the European patent application No. 79 300 610.7 filed on 12 April 1979 claiming the priority of the earlier application (US 897 963) of 19 April 1978. Claim 1 is worded as follows:

"An ungelled polyester characterised by a hydroxyl value of 10 to 160 and a weight average molecular weight of 20 000 to 300 000 as determined by gel permeation chromatography using a polystyrene standard, said polyester being formed from reacting:

(A) 10 to 70 percent by weight of a difunctional active hydrogen component having two active hydrogens per molecule selected from hydroxyl, primary amine and secondary amine, said active hydrogen component comprising:

- (1) 10 to 60 percent by weight of an acyclic diol having a carbon to oxygen ratio of at least 2,
- (2) 0 to 60 percent by weight of cyclic diol,
- (3) 0 to 20 percent by weight of a compound selected from diamines and hydroxyl-containing amines;

(B) 25 to 85 percent by weight of a dicarboxylic acid component comprising:

- (1) 5 to 85 percent by weight of an acyclic dicarboxylic acid containing from 2 to 36 carbon atoms
- (2) 0 to 80 percent by weight of a cyclic dicarboxylic acid;

(C) 0 to 30 percent by weight of an active hydrogen component having at least three active hydrogens per molecule, the active hydrogens being selected from hydroxyl, primary amine, secondary amine and carboxylic acid;

(D) 0 to 20 percent by weight of a monoamino monocarboxylic acid; the percentages by weight being based on total weight of (A), (B), (C) and (D), the percentages of the reactants being adjusted such that the weight percentages of cyclic moieties in said polyester plus the weight percentages of amide moieties formed in said polyester multiplied by 4 is up to 35 and the weight percentages of the reactants being further adjusted such that these reactants contain 0.01 to 1.0 gram-mole of reactants having an active hydrogen functionality of 3 or more per 500 grams of reactants."

- II. The Appellant filed a notice of opposition against the European patent by way of a telex message on 15 November 1983, which was confirmed by a letter received on 19 November 1983, requesting the revocation of the whole patent. The opposition fee was paid on 15 November 1983.

The notice of opposition sets out the following, under the heading "grounds":

"The subject-matter of EP-5033, as defined in Claims 1 to 21 covers polyesters, coating compositions and paint compositions as currently described in the state of the art and/or applied in the field of art.

The hydroxyl value,

items (a) and (b),

optional items (c) and (d),

the weight percentages of cyclic moieties plus amide moieties, and

the weight percentages of reactants with a functionality of 3 or more,

as stated in Claim 1 of patent No. 5033 are quite conventional and generally known from the state of the art as represented by (for instance):"

and there then followed a list of 16 prior published patent specifications. There then follows three paragraphs which allege that the feature of "high molecular weights" is an obvious aim, that methods of reaching high molecular weights are commonly known as disclosed for instance at two identified pages of a textbook, and that "according to opponent's measurements many known polyesters satisfy" the new parameter definition of molecular weight used in the opposed patent.

Finally, it stated:

"The polyesters, coating compositions and paint compositions as claimed in EP-5033 thus lack any novelty or inventive step, and are therefore not patentable in view of the articles of the EPC, in particular Articles 54 and 56."

III. The notice of opposition was communicated to the patentee by a communication (Form 2316) dated 29 November 1983.

A further communication (Form 2317) was sent to the patentee on 15 December 1983 pursuant to Rule 57(1) EPC,

stating that an "admissible notice of opposition" had been filed within the opposition period by the opponent, and inviting observations from the patentee within a specified period. The patentee duly filed observations on the notice of opposition on 17 May 1984, in which he firstly challenged the admissibility of the opposition and requested its rejection under Rule 56 EPC, on the basis that the notice of opposition did not set forth "any indication of the facts, evidence or arguments upon which their allegation" of lack of novelty or inventive step is based.

- IV. In a Decision dated 27 June 1985, the Opposition Division rejected the notice of opposition as inadmissible in accordance with Rule 56(1) EPC, on the ground that the notice of opposition did not comply with the provisions of Rule 55(c) EPC. In particular the Opposition Division considered that the notice of opposition did meet the requirements of Rule 55(a) and (b) EPC, as well as the first and second provisions of Rule 55(c) EPC, but did not meet the third provision of Rule 55(c) EPC, namely that a notice of opposition shall contain "an indication of the facts, evidence and arguments presented in support of" the grounds on which the opposition is based. The Decision set out all the relevant parts of the notice of opposition as summarised in paragraph II above, and considered whether, in respect of the grounds of opposition (lack of novelty and obviousness) relied upon, the notice of opposition contained an adequate "indication of facts, evidence and arguments" as required by Rule 55(c) EPC. In relation to each feature of the claimed subject-matter as set out in the notice of opposition, the Opposition Division concluded that the "indication of facts was inadequate to support any of the grounds invoked". The reason for the decision was therefore stated to be that, "the Opposition Division

cannot evaluate the facts, evidence and arguments presented in support of the grounds of opposition invoked, due to the lack of verifiable indications concerning them".

- V. The Appellant thereafter filed a notice of appeal on 23 August 1985 and paid the appeal fee on the same day. He filed a Statement of Grounds of Appeal on 23 October 1985. The Respondent filed his submission in reply on 22 March 1986.
- VI. The Appellant submitted in the Statement of Grounds substantially as follows:
- (i) The notice of opposition had set out various features of Claim 1 which were "quite conventional and generally known" as shown for instance in the listed documents. It had also been stated that the feature relating to "high molecular weights" only differed from known molecular weight by an "unusual" parameter (i.e. comparing polyester to a polystyrene standard).
  - (ii) The Opposition Division had not considered the indication of facts, evidence and arguments in its inherent coherence, but had torn apart the essential elements of said indication into separate items. The facts clearly expressed the absence of any "essential aspect" in the claimed features and the "inherent existence" of the only remaining feature, i.e. the "high molecular weights", in the state of the art.

- (iii) Contrary to the reasoning of the Opposition Division, the submitted facts enabled examination by the patent proprietor and the Opposition Division of the alleged grounds for revocation **without recourse to independent enquiries**, and therefore satisfied the requirements of the Guidelines, D.IV-1.2.2.1(f). In view of the fact that the claimed subject-matter was only distinguished from the state of the art by virtue of an unusual parameter, in accordance with current practice the burden of proof was on the patentee to show that such parameter was not encompassed by the state of the art.
- (iv) The consideration as to the adequacy of the facts in supporting the opposition was a matter coming under Articles 101 and 102 EPC (examination of the opposition) and not under Rules 55 and 56 EPC (admissibility). Since the opposition might entail (partial) loss of rights it was the responsibility of the EPO to see that only patentable inventions were granted and maintained.
- (v) Once the opposition had been declared admissible, by way of the communication dated 15 December 1983, there is no basis in the EPC to reverse such decision and declare the opposition inadmissible.

VII. The Respondent argued substantially as follows:

- (i) The "inherent coherence" in the submissions of the opponent amounted to no more than the allegation that the high molecular weight was the only distinguishing feature in the claim. Mere



allegations were, however, not facts, evidence or arguments, and the Opposition Division properly examined these with respect to the requirements of Rule 55(c) EPC individually.

- (ii) The requirement that the grounds of opposition must be investigated without recourse to independent inquiries should be read in context with the following statement in the Guidelines, which suggested that "unsubstantiated assertions do not meet this requirement. Nor as a rule is mere reference to patent documents enough; unless the document is very short the opponent must indicate on which parts his opposition is based". Furthermore, the opponent's submission that the burden of proof should be on the patentee to show that only distinguished features by unusual parameters were not in the prior art had no basis whatsoever in the EPC or in practice. Neither was there any ground put forward for considering the parameter "unusual".
- (iii) The Opposition Division proceeded, as required, on the basis of Rules 55 and 56 EPC, and could not go into any consideration of the matter under Articles 101 and 102 EPC in the absence of any clear facts indicated in the notice of opposition.
- (iv) As to obligations to grant and maintain valid patents, the opportunity existed for as long as nine months for an opposition against an already examined and granted patent but then the requirements must be strictly met. If this was not possible there were still further opportunities for revocation proceedings in the Designated States.

(v) The Formalities Officer did not issue a "decision" by the issuance of his communication. There was therefore no reversal of a "decision". The Appellant himself requested the Opposition Division to issue an appealable decision by his letter of 25 April 1985, thus recognizing that prior to then no decision had been issued.

VIII. The Appellant requested that the impugned decision be set aside and that the whole patent be revoked in all Designated States. Furthermore, he requested the reimbursement of the appeal fee.

The Respondent requests the rejection of the appeal.

#### Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rule 64 EPC and is, therefore, admissible.
2. The first question to be decided is whether, having regard to the communication (Form 2317) which was issued on 15 December 1983, the Opposition Division had power to decide that the notice of opposition was inadmissible because it did not meet the requirements of Rule 55(c) EPC. As set out in paragraph III above, such communication had been preceded by a communication (Form 2316) dated 29 November 1983, by which the notice of opposition had been sent to the patentee, and this communication had stated the period for the patentee to file observations thereon would not be fixed until "the notice of opposition had been examined for admissibility". Thereafter, the communication dated 15 December 1983 referred to the notice of opposition as being "admissible". Thus it must be deduced that between 29 November and 15 December 1983, the notice of opposition had been examined for admissibility.

The appellant has contended (see paragraph VI(v) above) that thereafter there is no basis in the EPC for declaring the notice of opposition to be inadmissible.

3. In the judgement of the Board, the Opposition Division did have power under the EPC to reject the opposition as inadmissible pursuant to Rule 56(1) EPC, after the sending of the communication dated 15 December 1983 pursuant to Rule 57(1) EPC, for the following reasons:

In accordance with Rule 57(1) EPC, the sending of Form 2317 whereby the patentee is *inter alia* invited to file his observations is only a "communication", and is not a "decision" that the opposition is admissible. By way of contrast, if the Opposition Division notes under Rule 56(1) EPC that a notice of opposition does not comply with the provisions of Rule 55(c) for example, the opposition would be rejected as inadmissible under Rule 56(3) EPC by way of a "decision".

The contents of a "communication" never constitute a "decision". This distinction is important, because only a "decision" can be the subject of an appeal - see Article 106(1) EPC. Thus in the present case the communication which was sent on 15 December 1983 in accordance with the provisions of Rule 57(1) EPC, even though it was sent after the notice of opposition had presumably been examined for admissibility, only represented a preliminary view, on an *ex parte* basis, and was not binding upon the department of the EPO which sent it. In contrast, the contents of a "decision" are always final and binding in relation to the department of the EPO which issues it, and can only be challenged by way of appeal.

In the present case, the subsequent objection by the patentee (in his observations filed on 17 May 1984) that the notice of opposition was inadmissible, had the effect of raising this objection as an issue in the opposition proceedings.

Thereafter the Opposition Division was obliged to consider and to decide this issue, as between the parties, and to issue a decision thereon, which could then be the subject of an appeal by the party who was adversely affected thereby.

4. The second question to be decided is whether, having regard to the contents of the notice of opposition filed on 15 November 1983, the Opposition Division correctly rejected it as inadmissible, in its Decision dated 27 June 1985. In order to answer this question it is necessary to consider what the EPC requires to be contained in a notice of opposition, as a minimum.

The relevant requirements of the EPC are as follows:

Article 99(1): "Notice of opposition shall be filed in a written reasoned statement".

Rule 55(c): "The Notice of opposition shall contain:

- (1) a statement of the extent to which the European patent is opposed;
- (2) and of the grounds on which the opposition is based;
- (3) as well as an indication of the facts  
evidence  
and arguments  
presented in support of these grounds".

Article 99(1): The notice must be filed "within 9 months of

publication of mention of grant", so within the 9 months period its contents must be such as to satisfy Rule 55(c). This is made clear also by Rule 56(1) EPC, which requires rejection of a notice unless any deficiencies *inter alia* in respect of Rule 55(c) are remedied within the 9 month period.

These requirements must be considered in the particular context of the opposition procedure set out in Articles 99 to 105 and the corresponding Regulations set out in Rules 55 to 63, as well as in the overall context of the EPC.

In the overall context, it is clearly in the public interest that opposition proceedings should be prosecuted as rapidly as their complexity permits.

In the particular context, after filing of the Notice of Opposition the next substantive step in the proceedings is examination of the opposition in accordance with Article 101 and Rules 57 and 58, prior to a decision on the opposition in accordance with Article 102. In particular, Rule 57(1) EPC requires that the patentee be invited "to file his observations and to file amendments, if appropriate", in response to his receipt of the notice of opposition.

It is thus clear that the purpose of requirement (3) of Rule 55(c) EPC (in combination with requirements (1) and (2)) is to ensure that the notice of opposition sets out the opponent's case sufficiently so that both the patentee and the Opposition Division know what that case is.

It is important that, whereas the requirements of Rule 55(1)(a) and (b) EPC and the requirements (1) and (2) of Rule 55(c) can be considered as formal in nature, requirement (3) of Rule 55(c) EPC in combination with Article 99(1) EPC is substantive in nature, and calls for reasoning which goes

to the merits of the opponent's case. A well-drafted notice of opposition should contain reasoning that is full but concise. And in general the less reasoning that a notice of opposition contains, the greater the risk that it will be rejected as inadmissible.

The question whether a particular notice of opposition meets the minimum substantive requirements of Article 99(1) and Rule 55(c) EPC can only be decided in the context of that particular case (since various relevant factors, such as the complexity of the issues raised, vary from case to case).

When in relation to the grounds of lack of novelty or obviousness, prior published documents are relied upon, then, depending upon the circumstances of each individual case, requirement (3) of Rule 55(c) will only be satisfied if there is sufficient indication of the relevant "facts, evidence and argument" (i.e. relevant to the extent of the patent which is opposed), for the reasoning and merits of the opponent's case in relation to the grounds of opposition relied upon to be properly understood by the Opposition Division and the patentee. This must be assessed on an objective basis, from the point of view of a reasonably skilled man in the art to which the opposed patent relates.

5. The sufficiency of the notice of opposition in this respect must be distinguished from the strength of the opponent's case. On the one hand, an unconvincing ground of opposition might have been clearly presented and argued. Conversely, a deficient submission may be rejected as inadmissible even though if properly drafted it would have succeeded. The desirability that European patents are granted for patentable inventions only must in this context be balanced against the

desirability of an efficient procedure in opposition proceedings, and in appropriate cases the consequences of non-compliance with the requirements of Article 99(1) EPC and Rule 55(c) EPC must be enforced.

6. In the absence of any specific guidance in the present case as to what particular statements in the cited documents are alleged to destroy the novelty of the claimed invention or to form the basis for an argument on obviousness, the Opposition Division and the Respondent are at a loss as to where to start with their examination of the Appellant's allegations in respect of the parameters set out in Claim 1. In the Board's judgement, the notice of opposition is therefore insufficient at the level of facts and evidence in this respect. What the Appellant did was no more than to invite the Opposition Division to carry out further searches in these documents *ex officio*, in the hope that it would formulate some arguments of its own accord on the basis of its findings. This task, however, was that of the Appellant within the available time for filing the notice of opposition. Oppositions must be filed and pursued in good faith so as to avoid procrastination and uncertainty. Keeping back any relevant information from the Opposition Division, which is already available to the opponent, is not in accordance with this principle.
  
7. As regards the further feature of the specified high molecular weight range, the Appellant failed to submit evidence substantiating the allegation that according to his measurements, some known polymers would also satisfy such conditions. Nor did the Appellant present any evidence suggesting that the "unusual" definition of the molecular weight cannot be equated or derived from the disclosures or definitions for such materials in the prior art, or, how it could be established as a fact that there was overlap. It was the burden of the Appellant to show that these features

must be given a certain interpretation on the basis of submitted evidence. The mere branding of a definition as unusual is therefore ineffectual and irrelevant in these proceedings, and the subsequent demand that the patentee should prove novelty in this respect, is an inversion of the proper legal burden in these proceedings.

8. In the Board's view, the Decision of the Opposition Division was correct. Without facts and proper evidence, the allegations have no real basis and are only speculations. In addition, there is no reasoning in the notice of opposition to indicate why such numerous documents, which may or may not between them contain all the relevant features of the claims, should suggest any lack of inventive step, let alone lack of novelty. After all, inventions are usually combinations of known features or components. Any suggestion that the mere presence of some or all of these features in various different documents should, in the absence of reasoning, mean anything at all in relation to the invalidity of the patent, is contrary to the principles of patent law and practice. The Board therefore considers that the notice is insufficient in respect of arguments as well.
9. In view of the above, in the Board's judgement the notice of opposition was incurably deficient, and the Decision of the Opposition Division in rejecting the opposition as inadmissible must therefore be confirmed.



**Order**

**For these reasons,**

**it is decided that:**

**the appeal is rejected.**

**The Registrar**



**The Chairman**



*Handwritten notes:*  
H.P.  
9/10/2.