

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

Aktenzeichen / Case Number / N° du recours : T 550/88 - 3.3.1

Anmeldenummer / Filing No / N° de la demande : 82 304 950.7

Veröffentlichungs-Nr. / Publication No / N° de la publication : 0 075 478

Bezeichnung der Erfindung: Borated hydroxyl-containing composition and lubricants
Title of invention: containing same
Titre de l'invention :

Klassifikation / Classification / Classement : C10M 139/00

ENTSCHEIDUNG / DECISION

vom / of / du 27 March 1990

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /

Titulaire du brevet : Mobil Oil Corporation

Einsprechender / Opponent / Opposant : Mobil Oil Corporation

Stichwort / Headword / Référence : National prior right/MOBIL

EPÜ / EPC / CBE Art. 54(3), 99(1), 137, 138, 139; Rules 55(c), 56(1), 57(1), 58(2).

Schlagwort / Keyword / Mot clé : "Lack of novelty under Art. 54(3) EPC as only ground of opposition" - "National prior rights as only support for such ground" - "National prior rights not state of the art under Art. 54(3) EPC" - "Opposition inadmissible" - "Amendments proposed in view of national prior rights not allowable".

Leitsatz / Headnote / Sommaire

I. A national prior right is not a "European patent application" within the meaning of Article 54(3) EPC, and is accordingly not comprised in the state of the art.

II. A notice of opposition, if it is to be admissible, should state the legal and factual reasons why the alleged grounds of opposition should succeed. If the only facts and evidence which are indicated in a notice of opposition cannot as a matter of law support the alleged grounds of opposition, the opposition is inadmissible. This is the case, where the facts and evidence presented in support of the ground of lack of novelty is only by reference to national prior rights.

III. Amendments in opposition proceedings which are proposed only in view of the existence of prior national rights are neither necessary nor appropriate within the meaning of Rule 58(2) EPC and are accordingly not allowable (deviating from Guidelines C-III, 8.4 and Legal Advice 9/81, OJ EPO 1981, 68).

IV. Amendments proposed in response to a notice of opposition are not allowable if the opposition is inadmissible.

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Mobil Oil Corporation

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EPÜ / EPC / CBE Art. 54(1), 54(3), 100(a), 137, 138, 139,
Rules 55(c), 56(1), 57(1), 58(2).

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Art. 54(3) EPC" - "Opposition inadmissible" -
"Amendments proposed in view of national prior
rights not allowable".

Leitsatz / Headnote / Sommaire

Headnote follows



Case Number : T 550/88 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 27 March 1990

Appellant : Mobil Oil Corporation
(Opponent) 150 East 42nd Street
New York. NY 10017
USA

Representative : ~~Colmer, Stephen Gary~~
Mobil Court
3 Clements Inn
GB-London WC2A 2EB

Respondent : Mobil Oil Corporation
(Proprietor of the patent) 150 East 42nd Street
New York. NY 10017
USA

Representative :

Decision under appeal : Decision of Opposition Division of the European
Patent Office dated 19 September 1988 rejecting
the notice of opposition against European patent
No. 0 075 478 on the basis of Rule 56(1) EPC.

Composition of the Board :

Chairman : K. Jahn
Members : G.D. Paterson
R.K. Spangenberg

Summary of Facts and Submissions

- I. The Appellant, the proprietor of European patent No. 075 478, filed a Notice of Opposition against its own patent. The notice referred to Article 100(a) EPC and stated that a possible objection to the validity of the European patent had recently been recognised which appeared to require amendment, namely the existence of six national patents and/or applications in the name of a third party, each of which had a priority date before the filing date of the European patent but had been published after such filing date. Amendment of the text of the European patent was requested in each of the six designated Contracting States where the above-mentioned six national patents and/or applications existed with earlier priority dates ("national prior rights").
- II. Following some correspondence, the Opposition Division issued a Decision dated 19 September 1988 which held that the opposition was inadmissible on the basis of Rule 56(1) EPC, on the grounds first that no ground of objection under Article 100(a) had been unequivocally alleged, and second and more importantly, that since no document which was published before the filing date of the European patent had been cited, and since the cited patents and/or applications were all prior national rights which are not part of the state of the art under Article 54 EPC, the Notice of Opposition was in any event deficient in not stating the grounds on which the opposition is based.

The Decision also referred to the Guidelines C-III, 8.4, and stated that this was understood to mean that the submission of separate claims in separate designated Contracting States (where prior national rights were known to exist) is allowed only after admissible opposition proceedings are in being.

III. The Appellant filed a Notice and Grounds of Appeal in which the grounds for the finding of inadmissibility set out in the Decision under appeal were contested, especially on the basis that the existing prior national rights were comprised in the state of the art in accordance with Article 54(3) EPC. Reliance was placed in particular upon the wording of Article 54(3) EPC "...the content of European patent applications as filed...", which language was said to cover and to be intended to cover both applications made under the EPC and prior "European" national applications.

IV. Following a communication on behalf of the Board, the Appellant filed observations in reply, and oral proceedings were held on 27 March 1990, at the conclusion of which it was announced that the appeal was dismissed.

Reasons for the Decision

1. In this appeal, which is admissible, the principal question to be decided is whether a prior national right is "comprised in the state of the art" under Article 54(3) EPC.

In the Board's judgment, it was very clearly implicit in the notice of opposition that this was the Appellant's main contention, and the finding in the Decision under appeal that the notice was inadmissible because it contained no unequivocal allegation to this effect was unnecessarily formalistic. The admissibility of a notice of opposition is a question of substance, not form.

2. As to the principal question, the Appellant contended that if such prior national rights were not part of the state of the art under Article 54(3) EPC, this would lead to

anomalous results, in that possibly invalid European patents would be knowingly maintained in opposition proceedings, which was difficult to reconcile with the principle stated by the Enlarged Board of Appeal in Decision G 1/84 (OJ EPO 1985, 299) in paragraph 3, that "the elaborate provisions in the EPC for substantive examination and opposition are designed to ensure that only valid European patents should be granted and maintained in force, so far as it lies within the power of the EPO to achieve this".

In the Board's judgment, for the reasons set out below, on the proper interpretation of Article 54(3) EPC, prior national rights are not comprised in the state of the art, and only prior filed European patent applications made under the EPC (and published on or after the filing date of a European patent application) can be considered as comprised in the state of the art under Article 54(3) EPC.

In the Board's view this result is indeed somewhat anomalous. However, it seems clear that this anomaly is intended under the EPC, and that accordingly, it does not lie within the power of the EPO to consider prior national rights as comprised in the state of the art, for the reasons discussed below.

3. Unfortunately for some proprietors of European patents, the EPC does not contain any specific provisions enabling a European patent to be amended by a centralised procedure before the EPO. It was against this background that the Enlarged Board of Appeal in Decision G 1/84 held that "a notice of opposition against a European patent is not inadmissible merely because it has been filed by the proprietor of the patent" (as in the present case) - see paragraphs 1 to 3 thereof. Nevertheless the normal

requirements in respect of the admissibility of such an opposition are of course applicable, as well as the normal requirements in respect of the allowability of amendments offered in the course of an opposition.

4. Rule 55(c) EPC requires that a notice of opposition shall contain inter alia a statement of:

- (i) "the grounds on which the opposition is based", and
- (ii) "an indication of the facts, evidence and arguments presented in support of these grounds".

4.1 As to (i), as stated previously it is quite clear from the notice of opposition as a whole that only one ground of opposition is intended to be raised, namely that of lack of novelty under Article 54(1) and (3) EPC, and in the Board's judgment there is a sufficiently clear statement in the notice of opposition to that effect.

4.2 As to (ii), the facts and evidence presented in support of this ground can only be constituted, if at all, by the references to the six national prior rights. The question therefore arises whether such national prior rights can as a matter of law constitute "facts or evidence" which are relevant to the ground of lack of novelty under Article 54(1) and (3) EPC. If not, such facts and evidence do not support the ground of opposition which has been alleged, and therefore do not satisfy the requirement of Rule 55(c) EPC.

Contrary to the Appellant's submissions, for the purpose of Rule 55(c) EPC a notice of opposition which contains a statement of grounds of opposition, and which indicates facts, evidence and argument which are alleged to support such grounds, is not necessarily admissible. As mentioned in paragraph 1 above, the admissibility of an opposition

is not merely a question of its form, but is a question of substance.

In this connection, in relation to the admissibility of an appeal having regard to the contents of a statement of grounds of appeal, it was stated in Decision T 145/88 that "it is the established case law of the Boards of Appeal that grounds of appeal (to be admissible) should state the legal and factual reasons why the decision under appeal should be set aside and the appeal allowed". Furthermore, the admissibility of a statement of grounds of appeal was "considered to depend upon its substance and not upon its heading or form". In the Board's view, the same principles are clearly applicable, *mutatis mutandis*, to the admissibility of a notice of opposition: in particular, a notice of opposition (to be admissible) should state the legal and factual reasons why the grounds of opposition which have been alleged should succeed. Conversely, if the only facts and evidence indicated in a notice of opposition cannot as a matter of law support the grounds of opposition alleged, the opposition is inadmissible. In such a case, the notice of opposition necessarily contains nothing which could possibly lead to the patent being revoked.

The Appellant relied upon Decision T 234/86 (OJ EPO 1989, 79), in which it was held that "the EPC nowhere requires that an argument brought in support of opposition must be conclusive in itself for the opposition to be admissible". This is of course correct and unassailable, but this Decision does not touch on the question whether facts and evidence which are irrelevant in law to the alleged ground of opposition can properly support it under Rule 55(c) EPC.

4.3 In the present case, whether the existence of national prior rights can as a matter of law support the ground of lack of novelty under Article 54(1) EPC depends upon the proper interpretation of Article 54(3) EPC; and in particular upon whether national patent applications are included within the meaning of the term "European patent applications" as used in Article 54(3) EPC.

In the first place, within Article 54(3) EPC itself, such European patent applications are referred to as having been "published under Article 93 EPC". This clearly indicates that the term is intended to refer only to a patent application made under the EPC, and is not intended to include a national application in a Contracting State. This interpretation has been assumed in the jurisprudence of the Boards of Appeal from an early date - see e.g. Decision T 4/80 (OJ EPO 1982, 149, paragraph 4).

Furthermore, throughout the EPC the term is consistently used in the above limited sense. In Article 139(1) EPC, for example, the term "European patent application" is used to contrast with a national patent application. And in Article 139(2) EPC, which is within Part VIII of the EPC entitled "Impact on national law", it is specifically provided that a national patent application "...in a Contracting State...shall have with respect to a European patent in which that Contracting State is designated...the same prior right effect as (it) has with regard to a national patent". Thus it is provided that the prior right effect of a national patent application (as opposed to a European patent application) upon a European patent is a matter for national law.

The Appellant relied upon Article 137(1) EPC, which refers to a European patent application which is the subject of a request for conversion to a national patent application,

and which limits the "formal" requirements of national law to which such an application may be subjected. He also relied upon Article 138(1)(a) EPC which sets out as one of the allowable grounds of revocation of a European patent under national laws the same ground as set out in Article 100(a) EPC, namely "not patentable within the terms of Articles 52 to 57 EPC". Article 138(1)(a) EPC is stated specifically to be subject to Article 139 EPC, already referred to. In the Board's view, these references to Part VIII do not assist the Appellant, but rather confirm that the effect of a prior national right upon a European patent is a matter purely for national law, whereas the effect of a prior European application upon a European patent is specifically provided for in Article 54(3) EPC (which may also be a ground of revocation under national laws by virtue of Article 138(1)(a) EPC). In other words, the combined effect of Articles 138(1) and 139 EPC is to provide an additional possible ground of revocation under national laws based upon the existence of a prior national right, which is not available under Article 54 EPC.

- 4.4 It was submitted by the Appellant that Article 54(3) EPC should be interpreted in the context of the current harmonised state of corresponding national legislation; in particular, in each of the Contracting States where prior national rights existed relating to the European patent in suit (Belgium, France, Germany, Holland, Sweden and the UK), legislation corresponding to Article 54(3) EPC was in force, so that the prior right effect of both European and national applications constituted a ground of revocation. It was therefore in the interest of a harmonised European patent law to interpret Article 54(3) EPC so as to include a prior right effect for both national and European applications.

However, in the Board's view it is clear that the wording of Article 54(3) EPC is intended deliberately to exclude national applications from having the prior art effect therein stated in respect of a European patent. At the time when the EPC entered into force it was still uncertain as to whether the national laws of Contracting States would include the same prior right effect as set out in Article 54(3) EPC. Even now, the national law in Switzerland provides for a different prior right effect ("prior claim") from that set out in Article 54(3) EPC ("whole contents"). The omission of prior national rights from Article 54(3) EPC was made in the context of such international uncertainty.

Furthermore, if Article 54(3) EPC included prior national rights, the result would be a legal inconsistency particularly so far as Switzerland is concerned, having regard to Article 139(2) EPC: in an opposition to a European patent before the EPO in which a national prior right was relied upon under Article 54(3) EPC, the conflict would be resolved in accordance with the "whole contents" system of Article 54(3) EPC, whereas in revocation proceedings under national law in Switzerland in respect of the European patent (CH) the same conflict would be resolved pursuant to Article 139(2) EPC in accordance with the prior claim system. (Swiss Patent Law, 1954, as amended in 1976 and in force since 1 January 1978, Article 7a).

- 4.5 In his written submissions the Appellant relied upon the Guidelines C-III, 8.4 and Legal Advice 9/81 (OJ EPO 1981, 68), to the extent that both of them indicate that in opposition proceedings, if evidence of the existence of prior national rights is produced, appropriate amendments of the claims should (in the Guidelines "must") be allowed. On this basis, if the notice of opposition had

contained at least one other properly supported ground of opposition (e.g. lack of novelty or inventive step in view of a prior published document), then even if the alleged ground was of "straw", the amendments proposed by the Appellant should be allowed. In his submissions during the oral proceedings, the Appellant did not attempt to support either the Guidelines or the Legal Advice in this respect - in the Board's view, rightly.

The Guidelines and the Legal Advice would allow, and in fact require, amendments to be made having regard to the existence of prior national rights in a case such as the present, even though such prior national rights do not constitute a ground of opposition, provided the notice of opposition is otherwise admissible, for example as mentioned above because a ground "of straw" was alleged and supported (in the present case no such other ground of opposition was alleged). In the Board's judgment the Guidelines and the Legal Advice are based upon an interpretation of the EPC which differs from the established jurisprudence of previous decisions of the Boards of Appeal, namely that amendments in opposition proceedings should only be considered as "appropriate" and "necessary" within the meaning of Rule 58(2) EPC if they can fairly be said to arise out of the grounds of opposition (see e.g. Decision T 295/87 dated 6 December 1988, to be published, Decision T 406/86, OJ EPO 1989, 302, Decision T 127/85, OJ EPO 1989, 271).

In the Board's view, amendments in opposition proceedings which are proposed only in view of the existence of prior national rights are neither necessary nor appropriate within the meaning of Rule 58(2) EPC and are accordingly not allowable.

4.6 Finally, the Appellant submitted, on the basis of the current wording of Rule 57(1) EPC, which was amended by a decision of the Administrative Council which entered into force on 1 October 1988, that the proposed amendments were permissible even if the opposition was held to be inadmissible. The current wording requires the Opposition Division to invite the patent proprietor to file amendments, where appropriate, upon receipt of a notice of opposition, whereas the previous version of the Rule contained the same requirement but preceded it with the words "If the opposition is admissible,...". The amendment to the Rule was said to imply that a proprietor should be invited to file amendments even if the opposition was inadmissible, and in any event the current Rule did not preclude amendment in an inadmissible opposition.

It is observed that the previous version of Rule 57(1) EPC could have been read as requiring that an opposition should only be communicated to the proprietor after a decision on its admissibility had been taken. However, as is recognised in Decision T 222/85 (OJ EPO 1988, 128), such a reading would wrongly preclude the proprietor from objecting to the admissibility of the opposition. The current version clarifies this point.

In the Board's judgment, amendments to the text of a patent are not permissible in opposition proceedings unless the opposition is admissible. This follows in particular from Article 101(1) EPC, under which an Opposition Division can only examine the grounds of opposition and thereafter decide the opposition "if the opposition is admissible". Furthermore, as discussed in paragraph 4.5 above, amendments in opposition proceedings would not be "appropriate" under Rule 57(1) EPC unless they arise out of an admissible ground of opposition. An Opposition Division could not even begin to consider the

appropriateness of amendments if the opposition is not admissible. The allowability of amendments proposed by the patent proprietor in response to a notice of opposition forms part of the substantive examination of the opposition, which only takes place if the opposition is admissible.

5. Thus in spite of the careful and thorough submissions on behalf of the Appellant, in the Board's judgment the opposition is inadmissible and the proposed amendments are not allowable. Since the appeal is therefore not allowable, the appeal fee cannot be refunded under Rule 67 EPC, as the Appellant had requested.
6. The Appellant suggested that two questions of law, respectively concerning admissibility and the interpretation of Article 54(3) EPC could be referred to the Enlarged Board of Appeal, but no formal request was made in this respect, and in any event the Board would not make such a referral because the answers to both points of law seem clear, and neither point of law is therefore sufficiently important.

Order

For these reasons, it is decided that:

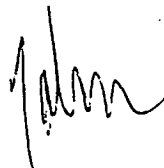
The appeal is dismissed.

The Registrar:



M. Beer

The Chairman:



K. Jahn

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