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Aktenzeichen / Case Number / N^o du recours : T 352/89 - 3.3.3

Anmeldenummer / Filing No / N^o de la demande : 80 303 930.4

Veröffentlichungs-Nr. / Publication No / N^o de la publication : 0 028 911

Bezeichnung der Erfindung: Power transmission belt manufacture

Title of invention:

Titre de l'invention :

Klassifikation / Classification / Classement : F16G 5/06

ENTSCHEIDUNG / DECISION

vom / of / du 15 January 1991

Anmelder / Applicant / Demandeur :

Patentinhaber / Proprietor of the patent /
Titulaire du brevet : Mitsuboshi Belting Ltd.

Einsprechender / Opponent / Opposant : Degussa AG

Stichwort / Headword / Référence : Belt/MITSUBOSHI

EPO / EPC / CBE Articles 113, 116, 123(2)

Schlagwort / Keyword / Mot clé : "Opportunity for the parties to comment on the grounds forming the basis of a decision (affirmed) - sufficient term and extensions" - "denial of right to oral proceedings (no) - absence of clear and unconditional request"

Leitsatz / Headnote / Sommaire



Case Number : T 352/89 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 15 January 1991

Appellant : Misuboshi Belting Ltd.
(Proprietor of the patent) No. 1-2, Hamazoedori 4 - Chome Nagata-Ku
Kobe-shi Hyogo (JP)

Representative : Jones, Michael Raymond
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Respondent : Degussa AG, Frankfurt
(Opponent) Zweigniederlassung
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Representative :

Decision under appeal : Decision of Opposition Division of the
European Patent Office dated 5 May 1989 revoking
European patent No. 0 028 911 pursuant to
Article 102(1) EPC.

Composition of the Board :

Chairman : F. Antony
Members : R. Lunzer
W. Moser

Summary of Facts and Submission

- I. European patent No. 0 028 911 was granted on 26 March 1986 on the basis of application No. 80 303 930.4 filed on 5 November 1980, having a priority date of 8 November 1979 derived from Japanese Application No. 145280/79.
- II. On 6 December 1986 an opposition was lodged by the Respondent on the ground of Article 100(a) EPC, alleging lack of novelty (Article 54 EPC), and/or lack of inventive step (Article 56 EPC).
- III. The Appellant's (patentee's) counter-statement in answer to the opposition contained in a letter dated 14 August 1987, and received by the EPO on 15 August 1987 dealt with the substantive issues, and concluded with a request to have....

"the opportunity to present further arguments and/or alternative amendments in writing or at oral proceedings..."

before any adverse decision were issued.
- IV. In its reply, dated 16 October 1987, to the Appellant's counter-statement, the Respondent added a further objection to the validity of the patent under Article 100(c) EPC, alleging that the claims of the patent as granted contained matter which was not disclosed in the application as originally filed, contrary to the provisions of Article 123(2) EPC.
- V. By a communication dated 19 July 1988, the Opposition Division indicated that before the issues of novelty and inventive step (hereinafter referred to as "the substantive issues") could be considered, the serious

objections raised under Article 123(2) EPC ought to be dealt with, failing which revocation would seem unavoidable. Specifically, the objections raised were the following:

- (i) Both in Claim 1 and Claim 11 of the patent as accepted, there was reference to the inclusion of "about 0.3 phr of cross-linking agent", whereas in the application as originally filed, there was a general reference to the inclusion of cross-linking agents, while the quantitative limitation of 0.3 phr was only to be found in connection with the single substance, 2-mercaptoimidazoline, mentioned in the Examples at page 6, line 20 and at page 7, line 23. Moreover, the "method" referred to in Claim 11 was not originally disclosed.
- (ii) In Claim 3 of the patent as granted the rubber in the tension section was defined as, "a diene rubber having a molecular double bond and being free of halogen", whereas in the application as originally filed, reference was made only to chloroprene rubber.

The Opposition Division gave the Appellant four months in which to respond, and concluded its communication with an observation to the effect that the claims ought to be in an acceptable form before it could accede to the acknowledged request for oral proceedings.

- VI. The four month period would have expired on 29 November 1988. However, by a letter dated 4 November, the Appellant requested an extension of another two months, (i.e. to 29 January 1989) and this was granted by a communication dated 21 November 1988.

VII. By a further letter dated 5 January 1989, the Appellant sought a second two month extension of the time limit, and on 20 January an extension of a further two months (to 29 March 1989) was granted.

VIII. By a letter dated 15 March 1989 the Appellant sought a third two month extension. By a communication dated 11 April 1989, the Opposition Division informed the Appellant that the requested extension of time would not be granted, and drew attention to the provisions of Article 114(2) EPC. It did not indicate that an adverse decision was about to be issued, nor did it comment on the Appellant's previous request for oral proceedings.

IX. On 5 May 1989 a formal decision revoking the patent, on the ground that it contained subject-matter which extended beyond the contents of the application as filed, contrary to Articles 100(c) and 123(2) EPC, was issued by the Opposition Division. That decision did not deal with the substantive issues. As for the request for a hearing alleged to have been made in the letter of 14 August 1987, referred to in paragraph III above, the Opposition Division held (Decision page 5) that the Appellant had requested in the alternative the opportunity to present further arguments and/or amendments in writing, or at oral proceedings. The Opposition Division, having thus been given a choice, had opted in favour of giving the Appellant the opportunity to submit amendments or arguments in writing.

X. An appeal against the decision of the Opposition Division was lodged on 24 May 1989, the appeal fee was paid on 26 June 1989, and the Grounds of Appeal were filed on 14 September 1989. The Appellant requested the reversal of the decision under appeal and the maintenance of the patent in suit in the form as granted. As an auxiliary

request it asked that the patent be maintained in an amended form indicated in its grounds of appeal.

XI. A communication from the Board of Appeal dated 4 September 1990 indicated that there was very little prospect of the main request succeeding, but that it might be possible to refer the matter back to the Opposition Division if, e.g., the main request were to be withdrawn, and the auxiliary request were to become the sole request. By a letter dated 23 October 1990, the Appellant expressed its willingness so to do. The claims according to the only remaining request read as follows:

"1. A belt having a compression section; and a load-carrying section comprising a cushion layer in which are embedded load-carrying cords, the cushion layer having a high strength bond with the cords; wherein one of the cushion layer and compression section is formed of a modified rubber blend comprising:

- (a) about 100 parts by weight chloroprene rubber,
- (b) 0.1 to 5.0 phr of silane coupling agent,
- (c) 10-60 phr silica,
- (d) about 0.3 phr 2-mercaptoimidazoline and
- (e) 2-60 phr carbon black.

2. A belt as claimed in claim 1, further having a tension section, the cushion layer being formed of the modified rubber blend defined in claim 1 and at least one of the compression section and tension section being formed of the modified rubber blend defined in claim 1.

3. A belt as claimed in claim 1, wherein the compression section and the cushion layer are formed of the modified rubber blend defined in claim 1.

4. A belt as claimed in any preceding claim, wherein said silane coupling agent is vinyl-tris(β -methoxy ethoxy) silane, γ -glycidoxypropyltrimethoxy silane, N- β -(aminoethyl) γ -aminopropyltrimethoxy silane, γ -mercaptopropyltrimethoxy silane, or bis-(3-[triethoxysilyl]-propyl-) tetrasulfane.
5. A belt as claimed in any preceding claim wherein said silane coupling agent is in the range of 0.3 to 2.0 phr.
6. A belt as claimed in any preceding claim, wherein the phr of said silica is in the range of 20-45 phr.
7. A belt as claimed in any preceding claim, wherein the phr of said carbon black is in the range of 10-40 phr.
8. A belt as claimed in any preceding claim, wherein said belt includes at least on section provided with distributed transversely extending short reinforcing fibres.
9. A belt as claimed in any preceding claim, wherein said belt is a banded belt having a band and plurality of belt elements retained in parallel spaced relationship by said band and defined at least in part by said blend."

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC and is, therefore, admissible.
2. Procedural matters
 - 2.1 The Appellant's letter of 14 August 1987, and more particularly the last paragraph thereof, does not contain

any unambiguous request for oral proceedings. From a strictly grammatical point of view, there was only an alternative request for an opportunity to present further arguments or amendments either in writing or at oral proceedings. If the Opposition Division was in doubt as to the intended meaning of the passage referred to (as might be implied from the penultimate sentence of its Communication dated 18 July 1988), the most appropriate action would perhaps have been, in the interest of both fairness and procedural economy, to have contacted the Appellant to ascertain its real intentions. While under Article 116 EPC the Appellant would have been entitled to oral proceedings even without first submitting formally acceptable claims, it was not so entitled in the absence of a clear and unambiguous request for such proceedings; cf. Decisions T 299/86 (headnote only published in OJ EPO 1988, 88) and T 433/87 (unpublished).

- 2.2 As to a further opportunity to present arguments and/or amendments in writing, the Appellant was entitled to this under Article 113 EPC because it was only through the official Communication of 18 July 1988 that it was first informed of the Opposition Division's objections under Article 123(2) EPC. However, the Appellant was given more than ample opportunity to deal with the matter, in that a term of four months was initially given for its reply, and this was extended twice to a total of eight months. In the age of the telephone, telex, and telefax, the distance between Europe and Japan does not even justify such generous extensions in the absence of convincing justification on the part of the Appellant. The public interest calls for opposition proceedings to be dealt with expeditiously. Repeated extensions of time limits, other than when justified by exceptional circumstances, run counter to this clear objective.

2.3 In summary, the Board is firmly of the view that there has been no substantial procedural violation within the meaning of Rule 67 EPC.

3. Formal admissibility of amendments

The objections of the Opposition Division under Article 123(2) EPC to the claims in the patent as granted are set out in paragraphs V(i) and V(ii) above. In the claims now before the Board, with a view to meeting the above objections, Claim 11 has been deleted, while Claim 1 has been amended so that it is now limited to the use of about 0.3 phr of 2-mercaptoimidazoline. Claim 2 of the patent as granted (relating to the use of that compound) has been consequentially deleted, and present Claim 2 (corresponding to Claim 3 of the patent as granted) has been amended by limiting the rubber to a modified rubber blend as defined in Claim 1. These amendments overcome the objections taken by the Opposition Division. The present claims were substantially modified, when compared with the claims as originally filed, in the course of examination. Insofar as there are other amendments to the original claims which were accepted by the Examining Division, and were not objected to by the Opposition Division, the Board concurs in finding that they do not offend against the provisions of Article 123(2). The amendments in the description correspond to the above-mentioned amendments in the claims, and serve to adapt the description thereto; they are therefore admissible.

4. Need to deal with substantive issues

4.1 As indicated in IX. above, the Opposition Division decided not to deal with the substantive issues. The Board can not, and does not, criticize that decision. It must always lie within the discretion of the first instance to deal

with any matter coming before it in the manner which it considers to be most expeditious for resolving the points at issue.

- 4.2 Nevertheless, where, as in the present case, the substantive issues had been canvassed already by the parties, the Opposition Division ought to take into account the probability that if it issues a decision revoking a patent based solely on a clearly remediable defect in the claims, and it does not deal with the merits of the case, an appeal which remedies the defect is likely to succeed, with the probable result that the matter will come back again.
- 4.3 In the present case, it was foreseeable that the matter would probably be referred back to the Opposition Division at a later stage. In contrast, had the Opposition Division dealt with the substantive issues, and reached a conclusion one way or the other on the merits of the alleged invention, the Board of Appeal probably would have had an adequate basis to deal with all issues in the present opposition. This would have been very desirable, especially in relation to an application for a patent filed more than ten years ago.
- 4.4 In its own interest, in the interest of the public, and not least in the interest of the parties, the Opposition Division ought always to consider carefully whether it might usefully give a ruling on substantive matters, even when it sees that there is an alternative route for disposing of an opposition.
- 4.5 Considering all the circumstances of the case, the Board exercises the discretion conferred on it by Article 111 EPC, and with some reluctance remits the case to the Opposition Division for further examination. It is

recommended that, to minimize further delay, the Opposition Division should deal with the case as expeditiously as possible.

Order

For these reasons, it is decided that:

1. The decision under appeal is set aside.
2. The matter is referred back to the Opposition Division with the order to continue the examination of the case based on the following documents:
 - Claims 1 to 9 filed on 14 September 1989;
 - pages 2, 3 and 5 of the description filed on 14 September 1989; and
 - page 4 of the description and drawings as granted.

The Registrar:

The Chairman

E. Görgmaier

F. Antony