

Publication in the Official Journal ~~Yes~~ / No

File Number: T 442/89 - 3.3.2
Application No.: 83 304 717.8
Publication No.: 0 134 849
Title of invention: Treatment of zeolites

Classification: B01J 26/06

D E C I S I O N
of 30 April 1991

Proprietor of the patent: Mobil Oil Corporation
Opponent: Degussa Aktiengesellschaft

Headword: Admissibility/MOBIL OIL
EPC Articles 100, 108; Rules 55(c), 56(1), 64(b), 65(1)
Keyword: "Admissibility of appeal (yes) - Notice of appeal - Time limit"
"Admissibility of opposition (yes)"

Headnote



Case Number : T 442/89 - 3.3.2

D E C I S I O N
of the Technical Board of Appeal 3,3.2
of 30 April 1991

Appellant :
(Opponent)

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Respondent :
(Proprietor of the patent)

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Representative :

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Decision under appeal :

Decision of the Opposition Division of the
European Patent Office dated 7 July 1989
rejecting the opposition filed against European
patent No. 0 134 849 as inadmissible (pursuant to
Rule 56(1) EPC).

Composition of the Board :

Chairman : P.A.M. Lançon
Members : C. Holtz
M.M. Eberhard

Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 134 849, based on patent application No. 83 304 717.8, which was filed on 15 August 1983, was published on 22 July 1987.

- II. The Appellants (Opponents) filed an opposition on 15 April 1988, requesting the revocation of the patent in all designated States. They based their opposition on mainly two grounds:
 - (a) the invention according to Claim 1 was not sufficiently disclosed and,
 - (b) the method claim was neither new nor inventive in comparison with Claim 1 of US patent 3 644 220.

- III. By the decision of 7 July 1989 under appeal, the Opposition Division rejected the opposition as inadmissible under Rule 56(1) EPC. The Division noted essentially the following in its decision:
 1. The Notice of Opposition invoked grounds under Article 100(a) and (b). It did, therefore, satisfy Rule 55(c) in this regard.
 2. However, the substantiation of these grounds was found lacking for the following reasons:
 - (a) the submitted allegation of insufficiency of disclosure could neither be substantiated by an alleged lack of clarity as to the problem to be solved, nor by a mere reference to a passage being inconsistent with the claim, but which was

taken in isolation from the remainder of the disclosure (i.e. Example 1 not achieving the purpose of the invention);

- (b) The Appellants' reference to Claim 1 of the US patent in support of their contention that Claim 1 of the patent in suit was neither new nor inventive could not be accepted as a reasoned statement, because they had indicated that this document disclosed an almost identical method;
- (c) although the request could be interpreted as a request for revocation of the patent in its entirety, this did not clearly follow from the Notice, since the dependent claims as well as the independent process Claim 21 had not been attacked. Therefore, the extent of the opposition was not fully clear.

IV. On 13 July 1989 the Appellants lodged an appeal against the decision.

In their statement of grounds they point mainly to the following:

1. The admissibility of the opposition is only a formal issue, whereas the Opposition Division's reasoning pertains to substantive issues.
2. The fact that the Opposition Division had proceeded into considerations of substance with regard to the issue of sufficiency, showing that it had understood the Appellants' arguments, makes the opposition admissible.

3. It must be clear from the notice of opposition that novelty as well as inventive step were questioned.
 4. The Appellants have concentrated their opposition to Claim 1. It cannot be accepted as a fault that the other claims are not mentioned.
- V. The Respondents (Patentees) contend that the appeal, as well as the opposition, should be rejected as inadmissible.
1. On the question of admissibility of the appeal, it is submitted inter alia that a practice to supplement a Notice of Appeal by matter derived from the statement of grounds is unsatisfactory in that it could only apply in those random instances, such as the present, where such a statement had already been filed within the two-month period set for the filing of the Notice of Appeal. It is further pointed out that only the finding as regards sufficiency is contested by the Appellant, and that the appeal, which does not identify the extent to which amendment or cancellation of the decision is requested, cannot be interpreted as directed to the entire decision.
 2. On the question of admissibility of the opposition, the Respondents argue essentially as follows:
 - (a) The Opposition Division's reason for its finding concerning insufficiency of disclosure is stated by the Appellants to be "purely substantive". The only support offered for this statement is that the Opposition Division shows that it has understood the Appellants' argumentation.

It is to be noted that nowhere in the presentation of the objection of insufficiency, nor anywhere else in the Notice, is EPC Article 100(b) referred to. The Opposition Division had, therefore, to find, first, whether such an objection could be considered to fall under any of the three grounds set out in Article 100; and, second, whether - if it could be considered to fall under one of them - the facts, evidence and arguments required by Rule 55(c) were provided in support of that ground.

In its finding on both the first and second points the Opposition Division explicitly divorced itself from consideration of the technical validity of the objection by referring to the objection "even if proven" (emphasis added). It therefore cannot possibly be asserted that the Opposition Division treated the matter substantively.

In addition, in relation to the second point, the Division states as a point of principle that reference to a single inconsistency between disclosure and claim, taken in isolation, cannot without more amount to the substantiation required by Rule 55(c). No attempt was made by the Opposition Division to find whether such inconsistency did or did not extend beyond the single specific instance alleged by the Opponents, and accordingly there is no substantive component in the Division's finding. Nor do the Appellants make any attempt to identify a substantive component here.

Finally, and fundamentally, the Notice of Opposition makes no attempt to identify in the

disclosure of the patent a failure of communication such as would prevent the skilled person of good will from successfully carrying out the claimed process.

- (b) The statement that US-A-3 644 220 only discloses an almost identical method was correctly found by the Opposition Division not to constitute facts, evidence or argument in support of the allegation of lack of novelty. The grounds "similarly lack any comment on the Division's finding that lack of inventiveness has not been properly pleaded in view of the absence from the Notice of any argument as to why the features missing from Claim 1 of the patent should be obvious to the skilled person".
- (c) In relation to the Opposition Division's finding as regards the extent of the opposition, the Appellants' only comment is that it cannot be regarded as a fault if nothing has been said in the Notice of Opposition about the claims other than Claim 1. This failure to state which claims are opposed is, however, a fault, since Rule 55(c) obliges an opponent so to state, and was correctly regarded as a fault by the Opposition Division. The Appellants offer no reason at all why this fault should not bring the inevitable consequence provided by Rule 56(1).

VI. The Appellants request that the opposition be admitted for examination as to its merits.

The Respondents request that the Appeal be rejected as inadmissible under Rule 65(1) or, alternatively, that the Board uphold the decision under appeal in its entirety.

Reasons for the Decision

1. Admissibility of the appeal

- 1.1 Under Rule 64(b) EPC "The notice of appeal shall contain...a statement identifying the decision impugned and the extent to which an amendment or cancellation of the decision is requested." Under Rule 65(1) EPC, an omission in this respect shall lead to rejection for inadmissibility.

In the case at hand, the Notice of Appeal which, together with the appeal fee, was submitted within the prescribed time limit of two months from the date of the decision under appeal, consists of three pages, page 2 being headed "Begründung" (Grounds). This latter part contains the request that the opposition be declared admissible and examined on its merits.

Contrary to the opinion of the Respondents, the fact that grounds are filed together with the Notice of Appeal may be decisive for the outcome of the admissibility question as regards the time limit: if the request could not be implicitly understood from the Notice itself when read together with the decision under appeal, but is only to be found in the statement of grounds filed after expiry of the two-month period for Notice of Appeal, the Appeal would be inadmissible. If, on the other hand, the statement is submitted within this period, the appeal is not yet precluded. In accordance with the established practice of the Boards of Appeal, submissions to the Office should not be formally interpreted as to headings etc., but judged on their true content (cf. T 145/88 of 27 October 1989, to be published in the OJ EPO). In this respect the Notice of Appeal meets Article 108 EPC requirements.

1.2 The decision under appeal falls into three main parts with respect to the failure to meet Rule 55(c) EPC requirements found by the Opposition Division:

- (a) Insufficiency of disclosure (Claim 1 as opposed to Example 1)
- (b) Novelty and/or inventive step (Claim 1 of the patent in suit vs. the cited US patent Claim 1, column 8)
- (c) The extent of the opposition not clearly indicated.

That decision is, however, indivisible or unitary in the sense that the Board of Appeal only has two choices: to reverse (i.e. declare the opposition admissible) or confirm (i.e. declare the opposition inadmissible). The fact that (as referred to by the Respondents) there may have been four independent grounds for the decision under appeal (insufficiency of disclosure, novelty, inventiveness, and extent) does not necessarily mean that the appeal, in order to be admissible, has to address all four grounds.

1.3 As to the claim that the "extent" of the appeal is not clear, the Board fails to follow the reasoning of the Respondents. When deciding admissibility of appeals, the Board is not obliged to scrutinize whether each and every point discussed before the first instance has again been raised or not. If there are several independent reasons for the decision under appeal, it is sufficient for an Appellant to rely on only one of these. If his arguments on that point are convincing, the decision is reversible. This is also the main reason for the extent requirement; it serves the principle of economy of procedure, if parties concentrate on those elements which are most relevant in their view.

It is, therefore, concluded that the Notice of Appeal meets the requirements of Rule 64(b) EPC as to the extent of the appeal.

- 1.4 Since the Notice of Appeal also meets the other requirements prescribed by Articles 106-108 and Rule 64 EPC, the appeal is admissible.

2. Admissibility of the opposition

- 2.1 Rule 55(c) EPC reads: "The notice of opposition shall contain: ...a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds".

It is important to note at the outset that the specific merits of the invoked grounds are irrelevant to the admissibility issue. As the Board of Appeal said in T 222/85, OJ EPO 1988, 128, (point 5): "The sufficiency of the notice of opposition ... must be distinguished from the strength of the Opponent's case." The requirement that a party submit arguments or evidence in support of his request does not mean that he has to win his case in order to have it admitted. That would clearly be absurd. This Board has confirmed that decision in T 2/89 of 3 July 1989 (to be published in the OJ EPO), see in particular point 5.

- 2.2 The Appellants invoked the ground of insufficiency of disclosure in their notice of opposition, stating in essence the following:

The problem to be solved by the claimed process is not clear, since the process of Claim 1 of the patent purports

to increase a specific ratio, whereas according to example 1 of the patent specification the opposite effect is obtained by that same process.

The Board finds this objection by the Appellant clearly understandable. A reference is given to pertinent parts of the patent to be considered when this ground is examined on its merits. Even if Article 100(b) is not expressly mentioned, it is indicated in the notice of opposition that the objection of insufficiency of disclosure is raised. Thus, the ground is given. The Opposition Division seems also to have recognised this when it stated that the Opponent had invoked grounds, i.a. under Article 100(b) (point 2 of the decision under appeal).

The Opposition Division found that a reference taken in isolation from the remainder of the disclosure did not constitute a reasoned statement in support of an allegation of a lack of sufficiency of disclosure.

However, it is not necessary for the admissibility of an opposition to discuss all embodiments or try to balance the inconsistency of one embodiment against the possible consistency of the others. On the contrary, it would be exactly the task for an opponent to point only to those parts of the patent specification which in his opinion make the disclosure questionable. It does not matter, for the purpose of deciding on admissibility, whether it can be seen at first glance that the description is not short and also contains further 28 examples.

Again, the strength of the arguments brought forth in support of such a ground is irrelevant for the purposes of admissibility.

- 2.3 The Opposition Division further found that the extent of the request by the Appellants was not clear enough. The Board of Appeal, however, finds that, since the ground of insufficiency of disclosure (point 2.2) was related to the problem to be solved by the invention, the only possible conclusion as to the extent of the opposition must be that the entire patent has been challenged.
- 2.4 All requirements under Rule 55(c) are thus met.
- 2.5 Given this outcome, it is unnecessary to examine whether or not the other grounds for opposition (lack of novelty or inventive step under Article 100(a) EPC) meet Rule 55(c) requirements.
- 2.6 For the above reasons, the Opposition is considered admissible.

Order

For these reasons, it is decided that:

1. The contested decision is set aside.
2. The Opposition is declared admissible.
3. The case is remitted to the Opposition Division for further examination.

The Registrar:

The Chairman:

P. Martorana

P.A.M. Lançon