

Publication in the Official Journal Yes / No

File Number: T 580/89 - 3.3.3
Application No.: 82 305 285.7
Publication No.: 0 076 691
Title of invention: Anhydride polymers and imide polymers and processes for preparing them

Classification: C08F 8/32

DECISION
of 29 August 1991

Proprietor of the patent: ROHM AND HAAS COMPANY
Opponent: BASF Aktiengesellschaft

Headword: Power to examine/ROHM AND HAAS
EPC Articles 101, 102, 112(1), 114(1), 123; Rules 55(c), 66(1)
Keyword: Extent of power to examine an opposition

Headnote

The following questions are referred to the Enlarged Board of Appeal:

1. Is the power of an Opposition Division or, by reason of Rule 66(1) EPC, of a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC dependent upon the extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC?
2. If the answer to the first question should be affirmative, are there any exceptions to such dependence?



Case Number : T 580/89 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 29 August 1991

Appellant :
(Opponent)

BASF Aktiengesellschaft, Ludwigshafen
- Patentabteilung - C6 -
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Respondent :
(Proprietor of the patent)

ROHM AND HAAS COMPANY
Independence Mall West
Philadelphia
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Representative :

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ROHM AND HAAS (UK) LTD
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Lennig House
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Decision under appeal :

Interlocutory decision of the Opposition Division
of the European Patent Office dated
28 August 1989 concerning the maintenance of
European patent No. 0 076 691 in amended form.

Composition of the Board :

Chairman : F. Antony
Members : C. Gérardin
W. Moser

Summary of Facts and Submissions

I. The mention of the grant of patent No. 76 691 in respect of European patent application No. 82 305 285.7 filed on 5 October 1982 and claiming priority of 7 October 1981 of an earlier application in the United States, was published on 10 September 1986 on the basis of 11 claims.

Claims 1 and 7 were directed to a process for producing a polymer containing glutaric anhydride units and Claims 2 to 6 to a polymer containing glutaric anhydride units obtainable by the process of Claim 1. Claims 8 to 10 concerned a process of imidising the polymer according to Claims 2 to 6 to form a polymer containing imide units, and Claim 11 related to an imide polymer obtainable by the process according to any of Claims 8 to 10.

II. On 18 April 1987 the Opponent filed a Notice of Opposition against the grant of the patent and requested revocation thereof on the ground of lack of inventive step to the extent it concerned polymers with anhydride units (i.e. Claims 1 to 7).

This objection, which was emphasised and elaborated in later submissions as well as during oral proceedings, was based on 6 documents (documents (I) to (V) and (VII)).

III. In an interlocutory decision dated 28 August 1989 the Opposition Division held that there were no grounds of opposition to the maintenance of the patent on the basis of the following set of 11 claims:

Claims 1 to 7: process of imidising thermoplastic non-crosslinked polymer;

Claim 8: imide polymer obtainable by the process according to any preceding claim;

Claim 9: process for producing thermoplastic, non-crosslinked polymer containing glutaric anhydride units; Claims 10 and 11: polymer containing glutaric anhydride units obtainable by the process of Claim 9.

In that decision it was recalled that the patentability of Claims 1 to 8 was not in dispute. Novelty of the subject-matter of Claim 9 was acknowledged with respect to the teaching of document (VII), regarded as the closest state of the art, since neither the onset of decomposition temperature of at least 250°C, nor the Vicat temperature of 50 to 175°C was disclosed therein. This combination of features was inventive as well in view of the advantageous properties of thermoformability, high thermal stability and processability conferred to the anhydride polymers.

IV. On 25 August 1989 a third party had presented observations under Article 115 EPC which, as evidenced by an official communication dated 5 September 1989, did not reach the file until after the decision dated 28 August 1989 was taken, and was accordingly not referred to therein. In the said observations it was first specified that the subject-matter of Claims 9 to 11, concerning a polymer with anhydride units and the preparation thereof, was not novel; additionally, it was mentioned that the subject-matter of Claims 1 to 8, relating to a polymer with imide groups and the preparation thereof, for a part was not novel and for a part did not involve an inventive step with regard to the teaching of the following documents:

- (1) GB-A-1 437 176
- (2) GB-A-926 269
- (3) US-A-3 840 499
- (4) US-A-3 801 549.

V. The Appellant (Opponent) thereafter filed a Notice of Appeal on 8 September 1989 and paid the prescribed fee at the same time. The arguments presented in the Statement of Grounds of Appeal filed on 23 December 1989 relied exclusively on documents (1) to (4) and concerned mainly Claims 9 to 11, whose subject-matter was said to be not novel or, in any case, not inventive.

Further, the subject-matter of Claims 1 to 8, which admittedly had not been attacked in the Notice of Opposition, was said to be not patentable over the teaching of documents (2) to (4).

VI. On 30 March 1990 the above-mentioned third party filed additional observations under Article 115 EPC wherein objections of lack of novelty and inventive step of the subject-matter of Claims 1 to 8 as well as 9 to 11 were raised. These additional objections were based on documents (1) to (4) and on the following further documents:

(5) Die Angewandte Makromolekulare Chemie, 1970,
Volume 11, pages 91 to 108

(6) Encyclopedia of Polymer Science and Technology, 1964,
Volume 1, page 118

(7) US-A-4 246 347.

VII. In a Counterstatement of Appeal filed on 23 April 1990, whose content was confirmed in a later letter received on 2 August 1990, the Respondent offered to dispose of the appeal by deleting the opposed Claims 9 to 11. Regarding Claims 1 to 8, the Respondent argued that the EPO should not decide on these non-opposed claims, since this would entail an examination contrary to Article 114(1) EPC as interpreted in the decision T 9/87.

VIII. On 6 July 1990 the third party submitted further observations wherein the obligation of the EPO to examine the facts of its own motion according to Article 114(1) EPC was underlined. In this respect, reference was made to the decision T 156/84, wherein the Board had reached the conclusion that the principle of examination by the EPO of its own motion took precedence over the possibility of disregarding facts or evidence not submitted in due time. This followed from the EPO's duty vis-à-vis the public not to grant or maintain patents which it was convinced were not legally valid. This approach was confirmed by the recent decision T 197/88.

IX. The Appellant requested that the decision under appeal be set aside and the patent be revoked.

The Respondent requested that the patent be maintained on the basis of Claims 1 to 8.

Reasons for the Decision

1. The appeal complies with Articles 106 to 108 and Rules 1(1) and 64 EPC; it is admissible.
2. The current wording of the claims does not give rise to any objections under Article 123 EPC.

Claim 1 corresponds in substance to a combination of Claims 1 and 8 of the patent as granted, respectively Claims 1, 6 and 7 of the application as originally filed; the symbols (a), (b) and (c) have been introduced for clarity purposes and have no influence on the scope of the claim.

As to the dependent Claims 2 to 8, they correspond to Claims 9, 3, 4, 5, 6, 10 and 11 of the patent as granted, respectively Claims 8, 2, 3, 4, 5, 10 and 9 of the application as originally filed, with their numbers and, where appropriate, appendancies adjusted.

3. As appears from points V and VI above, the documents (1) to (4) relied upon by the Appellant in the Statement of Grounds of Appeal were not filed within the nine-month opposition period. The same applies to documents (5) to (7) which were only submitted by the third party during the appeal procedure (see point VI). All these documents must thus be regarded as late filed within the meaning of Article 114 EPC.

The Board has examined the documents (1) to (7) in order to determine their relevance, i.e. their evidential weight compared with that of the documents filed in time. The Board has come to the conclusion that at least some of the former were sufficiently relevant to raise new issues, especially issues which were explicitly excluded in the Notice of Opposition.

4. The argument presented by the Respondent that the EPO should not decide on the non-opposed Claims 1 to 8 (cf. paragraph VII supra) brings up the fundamental point of law whether or not the power of the EPO to examine an opposed European patent under Article 101 EPC is determined by the extent to which the latter is opposed pursuant to Rule 55(c) EPC in the Notice of Opposition.
5. In decision T 9/87 (OJ EPO 1989, 438), it is held that the examination of an opposition under Article 101 EPC was limited by the statement in the Notice of Opposition of the extent to which the European patent is opposed, and that neither an Opposition Division nor a Board of Appeal

had the power to examine and decide on the maintenance of a European patent except to the extent to which it is opposed. This position is derived from the consideration that opposition proceedings constitute an exception to the general rule that a European patent after grant is no longer within the competence of the EPO. That exception is interpreted in a narrow sense, as follows: "during a limited period of time, a centralised action for revocation ... may be brought before and decided by the EPO"; thus "the extent to which the ... patent is opposed, in combination with the grounds of opposition, provides a definition ... of the extent of competence of the EPO in relation to the examination of the opposed ... patent under Article 101 EPC" (cf. point 3 of T 9/87).

Hence it follows from the afore-mentioned decision that a statement of the extent to which a European patent is opposed pursuant to Rule 55(c) EPC does not only represent a requirement for the admissibility of an opposition, but determines also the extent of competence or power of the EPO with regard to the examination of an opposed European patent under Article 101 EPC.

Subsequently, this jurisprudence was applied and to some extent modified in the decisions T 648/88 of 23 November 1989 (OJ EPO 1991, 292), T 192/88 of 20 July 1989 (unpublished), and (cf. point 7 infra) T 293/88 of 23 March 1990 (to be published).

On the other hand, the decisions T 156/84 (OJ EPO 1988, 372) and T 197/88 (OJ EPO 1989, 412), mentioned by the third party, merely emphasised the importance of the general principle laid down in Article 114(1) EPC.

6. The Board has some doubts whether it can indeed be derived from Article 101 EPC that the examination of an opposition

to a European patent should be confined to the extent to which it is opposed in a Notice of Opposition pursuant to Rule 55(c) EPC. In the absence of such derivability, decision T 9/87 would appear to interpret Article 114(1) EPC as subject to Rule 55(c) EPC (and not to Article 101 EPC). However, such an interpretation could be regarded as questionable from a systematic point of view, because it would lead to the result that a provision of a higher normative level (i.e. Article 114(1) EPC) was held subject to a provision of a lower or inferior normative level (i.e. Rule 55(c) EPC).

On the other hand, it should not be overlooked that Article 101(2) EPC expressly stipulates that "the examination of the opposition ... shall be conducted in accordance with the provisions of the Implementing Regulations", this being an implicit, but unequivocal reference to, *inter alia*, Rule 55(c) EPC, which might possibly constitute a basis for the above-discussed derivability.

7. In decision T 293/88 (cf. point 5 above) it is held that an Opposition Division may also investigate, within its own discretion under Article 114(1) EPC, the validity of dependent claims which have not been objected to by an opponent at any stage, provided those claims are in the same category as those attacked in the opposition proceedings and their validity is moreover necessarily and directly prejudiced.

Thus, according to that decision, there exists an exception to the jurisprudence established in decision T 9/87 (cf. point 5 above) if the unattacked claims belong to dependent, narrower aspects of the same subject-matter.

Therefore, if it should be held that, in principle, the power of the EPO to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC is dependent upon the extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC, then the further question as to possible exceptions to this dependence would inevitably arise.

8. All these issues being quite controversial, the Board is of the opinion that the question whether or not an Opposition Division or, on the basis of Rule 66(1) EPC, a Board of Appeal has the power to examine and decide on the maintenance of a European patent (Articles 101 and 102 EPC), regardless of the extent to which it is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC, is an important point of law within the meaning of Article 112(1) EPC which calls for a referral to the Enlarged Board of Appeal.

Order

For these reasons, it is decided that:

The following questions are referred to the Enlarged Board of Appeal:

1. Is the power of an Opposition Division or, by reason of Rule 66(1) EPC, of a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC dependent upon the extent to which the patent is opposed in the Notice of Opposition pursuant to Rule 55(c) EPC?

2. If the answer to the first question should be affirmative, are there any exceptions to such dependence?

The Registrar:

The Chairman:


E. Gorgmaier


F. Antony

03695

W. Noser
C.G.