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File Number: T 622/89 - 3.3.3

Application No.: 81 108 616.4

Publication No.: 0 051 210

Title of invention: Process and apparatus for preparing uniform size
spheroidal polymer beads and suspension polymerization
product thus obtained

Classification: C08F 2/18

D E C I S I O N
of 17 September 1992

Proprietor of the patent: The Dow Chemical Company

Opponent: Bayer AG

Headword:

EPC Article 56

Keyword: "New citations - matter referred back"
"Costs"



Case Number : T 622/89 - 3.3.3

D E C I S I O N
of the Technical Board of Appeal 3.3.3
of 17 September 1992

Appellant :
(Opponent)
Bayer AG, Leverkusen
Konzernverwaltung RP
Patente Konzern
Bayerwerk
W-5090 Leverkusen (DE)

Representative :

Respondent :
(Proprietor of the patent)
The Dow Chemical Company
2030 Dow Center
Abbott Road
P.O. Box 1967
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Michigan 48640-1967 (US)

Representative :
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Decision under appeal :
Decision of Opposition Division of the European Patent Office dated 12 September 1989 concerning maintenance of European patent No. 0 051 210 in amended form for the Contracting States BE and SE and revocation of this patent for the Contracting States DE, FR, GB, IT and NL.

Composition of the Board :

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

Summary of Facts and Submissions

- I. European patent No. 51 210 was granted on 4 December 1985 on the basis of application No. 81 108 616.4 filed on 21 October 1980, having a priority date of 30 October 1980 derived from US application No. 202 265.
- II. On 9 May 1986 an opposition was lodged on the grounds of Articles 100(a) and (b) EPC, alleging lack of novelty (Article 54 EPC), lack of inventive step (Article 56 EPC) and insufficiency of disclosure (Article 83 EPC). The Opponent relied in all on seven cited documents, included amongst which were:
- (1) EP-A-0 046 535 (published 3.3.1982)
 - (2d) Zhuravlev et al., Sb. Nauch Tr. Kuzbas., Politekh. Inst. 1970, No. 26, 201-205 (CA 78 (1973) abstr. No. 16931a).
- III. By its decision given orally on 12 May 1989 and issued in writing on 12 September 1989, the Opposition Division revoked the patent insofar as it extended to DE, FR, GB, IT, and NL having regard to lack of novelty of Claim 11 in the light of the document (1), cited under the provisions of Article 54(3) EPC. In an interlocutory decision of 12 September 1989 it held, however, that no valid ground of opposition existed against the maintenance of the patent in the Contracting States BE and SE, provided that the description be amended to bring it into conformity with proposed amended claims which had been submitted. Both decisions were issued in writing in consolidated form on 12 September 1989, and are referred to below as "the decision in issue".
- IV. Appeals against that decision were filed by both parties. The Opponent's appeal was lodged on 23 September 1989, the

appeal fee was paid on the same day, its Grounds of Appeal were filed on 14 December 1989. The Patentee's appeal was lodged on 10 November 1989, the appeal fee was paid on the same day, and its Grounds of Appeal were filed on 12 January 1990.

- V. Together with its Statement of Grounds of Appeal, the Opponent filed the full text in Russian, together with an English language translation of the Russian document which had been considered by the Opposition Division merely in the form of a short Chemical Abstract identified as document 2(d) above, and also a further patent specification:

(2g) GB-A-1 410 832.

- VI. The Patentee submitted a fresh set of claims with its Grounds of Appeal, and a still further amended separate set of claims for DE, FR, GB, IT, NL and for BE, SE, respectively, on 6 September 1990, and implicitly requested that the decision in issue be set aside, and that the patent be upheld with Claim 11 amended for DE, FR, GB, IT and NL in a manner intended to overcome the objection of lack of novelty found by the Opposition Division. At the same time it requested that oral proceedings should be held if its requests were not granted. The Opponent requested the revocation of the patent in its entirety.

Reasons for the Decision

1. Both appeals are admissible.
2. Newly Cited Prior Art

The Board has given careful consideration to the newly cited prior art, document 2(g), and, while not at this stage formally admitting it into the proceedings, considers it sufficiently relevant to justify referring the matter back to the Opposition Division to consider the whole matter afresh, including the admissibility of this late filed document. In these circumstances the Board deliberately refrains from making any further comments on the merits of the case, so as not to inhibit the freedom of the Opposition Division in dealing with the opposition, and by the same token does not consider it necessary to appoint any oral proceedings despite the request by the Patentee.

3. Costs

Document 2(g) has been cited for the first time in the Opponent's grounds of appeal over three years after the expiry of the nine-month period for the filing of an opposition. There has been no attempt on its part to justify the late introduction of this document into the case, nor can any justification be seen by the Board, considering that this document is a British patent specification which ought to have come to light if an adequate search had been made during the term for filing an opposition. While considering the relevance of document 2(g), the Board exercises its discretion under Article 114 EPC in the sense of not disregarding it, following its earlier decisions (e.g. T 326/87 of 28 August 1990, published in OJ EPO 1992, 522). Applying

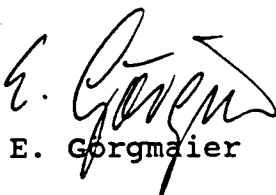
the provisions of Article 104 EPC the Board orders the Opponent to bear all the costs of the Patentee reasonably incurred during the further prosecution of the opposition before the Opposition Division, and any appeal therefrom.

Order

For these reasons, it is decided that:

1. The decision in issue is set aside.
2. The case is remitted to the Opposition Division for further examination of the opposition.
3. The Opponent shall bear all the costs of the Patentee reasonably incurred in the course of the further prosecution of the opposition before the Opposition Division, and of any appeal therefrom.

The Registrar:


E. Gorgmaier

The Chairman:


F. Antony