

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

File Number: T 204/91 - 3.3.1
Application No.: 84 307 948.4
Publication No.: 0 148 579
Title of invention: Thermosetting coating composition

Classification: C09D 3/58

D E C I S I O N
of 22 June 1992

Proprietor of the patent: E.I. DU PONT DE NEMOURS AND COMPANY
Opponent: Shell Internationale Research
Maatschappij B.V.

Headword: Admissibility of opposition/SHELL
EPC Rules 55(c) and 56(1) EPC
Keyword: - meaning of "indication" in Rule 55(c) EPC
- content of Notice of Opposition sufficient

Headnote



Case Number : T 204/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 22 June 1992

Appellant :
(Opponent)

Shell Internationale Research
Maatschappij B.V.
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Representative :

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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 10 December 1990
rejecting the notice of opposition as
inadmissible.

Composition of the Board :

Chairman : K.J.A. Jahn
Members : J.A. Stephens-Ofner
R.K. Spangenberg

Summary of Facts and Submissions

- I. European patent No. 0 148 579 was granted to E.I. Du Pont de Nemours and Company, of Wilmington, Delaware, U.S.A. on 2 August 1989.
- II. Shell Internationale Research Maatschappij B.V. of The Netherlands filed a notice of opposition to the afore-said patent on 24 April 1990. The notice relied on four documents and indicated that the whole of each cited document was being relied upon under both grounds of opposition against all of the claims of the opposed patent insofar as Documents 2 to 4 were concerned, and against Claims 1 to 9 as well as Claims 12 to 16, insofar as Document 1 was concerned. An Appendix filed with the notice of opposition enlarged upon the allegations of lack of novelty and of obviousness, by reference to the whole of Documents 1 and 2, as well as certain passages of Documents 3 and 4.
- III. By its decision dated 10 December 1990, the Opposition Division held that the opposition was inadmissible under Rule 56(1) EPC because the notice of opposition failed to meet the requirements of Rule 55(c) EPC. Its decision was, in a large measure, based on the paucity of the references to relevant sections of each of the cited documents both in the notice of opposition (which contained none), as well as in the Appendix. It was stated in the reasons accompanying the decision that since none of the cited documents was very short, the paucity of references, of which the decision gave certain examples, was of such a degree as to give an insufficient indication of the facts, evidence and arguments presented in support of each of the grounds of opposition pleaded by the Opponent. The decision expressly relied upon the "Guidelines for

Examination in the European Patent Office", which state in Chapter D IV, paragraph 1.2.2.1(f): "unless the document is very short the opponent must indicate on which part of a document his opposition is based".

- IV. The opponent appealed against the above decision, filing his Notice of Appeal, accompanied by the payment of the appropriate fee, on 8 February 1991, and his Statement of Grounds of Appeal on 9 April 1991.
- V. The Appellant's grounds boil down to two main propositions: the first, that the Guidelines upon which the Opposition Division's decision relied were no more than that, since they did not form part of the EPC, and that it followed that the Opposition Division erred in basing its decision solely upon those Guidelines, instead of the provisions of Rule 55(c) EPC. Secondly, and in amplification of the first proposition, he argued that the Boards of Appeal have, in cases such as T 234/86, T 453/87 (erroneously cited as T 435/87) and T 222/85, provided a clear-cut interpretation of the meaning of Rule 55(c) EPC, upon which and on nothing else, any legally valid decision as to admissibility needed to be based.
- VI. The Respondent made no comment on the Statement of Grounds of Appeal. Indeed he had made no substantive response either to the Notice of Opposition, save to say in a letter filed 4 September 1990, that he doubted whether the Notice mentioned in II above and its Appendix, were adequate to comply with Rule 55(c) EPC.

Reasons for the Decision

1. The appeal is admissible.
2. The Board accepts the Appellant's submission of law that questions of admissibility of oppositions must be decided on the basis of Rule 55 EPC, and not solely by reference to the Guidelines which, as their name suggests, exist merely to guide, as distinct from the Rules which constitute legally binding requirements under the EPC.
3. However, the Board does not accept that the Opposition Division's decision was based solely on the Guidelines, particularly in view of the express reference made in paragraph 4 and 5 of it to Rule 55(c) EPC, as well as to its express quoting of the relevant part of that Rule which states: 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".
4. It follows that the outcome of this appeal depends upon whether or not the notice of opposition, as well as its Appendix did afford an indication of the facts, evidence and arguments presented by the Opponent in support on the grounds of novelty and obviousness that was sufficient in the sense laid down by the Boards' jurisprudence as was partially outlined by the Appellant by his reference in his Statement of Grounds of Appeal to certain decisions of the Boards.
5. That jurisprudence, and the basic function of notices of opposition, and of the significance of Rule 55(c) EPC, are clearly and comprehensively summarised in Decision T 326/87, Polyamide Compositions/DU PONT (to be published

in OJ EPO, for Headnotes see OJ EPO 9/1991), paragraph 2.1.1 of the reasons, where the Board, in explaining the official note on "Opposition Procedure in the EPO" published in OJ EPO 1989, 417, gave strong judicial backing to the legal principle stated in that note, namely, that: "under Rule 55(c) EPC, the notice of opposition must contain an indication of the facts, evidence and arguments presented in support of the Grounds of Opposition. This requirement is to be interpreted as meaning that the notice of opposition must at least indicate clearly to the proprietor the case he has to answer...". This principle is the same upon which the Appellant in this case relies in citing decision T 222/85 (OJ EPO 1988, 128) where the Board stated that Rule 55(c) EPC was satisfied where there was a sufficient indication of relevant facts, evidence and arguments, for the reasoning and merits of the opponent's case to be properly understood by the Opposition Division and by the Patentee. It follows from the above cases that the term "indication" in Rule 55(c) EPC needs to be construed as requiring more than a mere hint at a number of possible attacks upon the patent, as well as the likely support for each such possible attack, which indication (or hint) might possibly be augmented by the subsequent late filing, possibly even at the appeal stage, of further evidence, arguments or other matter, even including fresh grounds of objection.

On the contrary, the scope and depth of "indication" needs to be such as to enable the Patentee and the Opposition Division to see clearly just what attack is being mounted against the patent, and what evidential support is being adduced for that attack. In other words, the Patentee and the Opposition Division have to be put in a position of understanding clearly the nature of the objection being submitted as well as the evidence and arguments in its support. This requires the elaboration of the relevant

circumstances of the case to such an extent that the Patentee and the Opposition Division are able to form a definitive opinion on at least one ground of opposition raised, without the need to make further investigations (cf. T 453/87-3.3.1 of 18 May 1989, not published in OJ EPO, point 2.2 of the reasons).

6. The Board has serious doubts as to whether the mere citation of two documents of some length - Document (1) consists of 11 pages and Document (2) of 9 pages - in the circumstances of the present case can be regarded as a clear indication of the case the Patentee has to answer. However, no decision on that matter needs to be taken here, since, in the Board's judgment, the question of admissibility can be decided on another ground.

7. The notice of opposition contains in Annex I an objection against the novelty of the subject-matter of Claim 1 which is based on the resin PK 612 mentioned in Document (4), which, according to page 7, line 11 of that document had been applied in solution. The Opposition Division only considered page 7 in the hand-written pagination of that document and concluded that this reference was not an indication which could support the said objection. However, the reference was clearly directed to the page carrying the typed page-number 7, where in fact the subject-matter referred to is mentioned, together with a reference to Table I of that document, where the chemical structure of the resin PK 612 is explained. In cases like the present one, where there is uncertainty as to which pagination should be adhered to, the Opposition Division should have considered both possibilities. On that basis, the Opposition Division was in the position to form a definitive opinion on at least one ground of opposition without the need to make further investigations. At least in respect of Document (4), therefore, the Annex to the

notice of opposition did not leave the Opposition Division at a "total loss" (cf. T 222/85 referred to above). Accordingly, the Board finds that the Opposition Division was wrong in holding the opposition to be inadmissible under Rule 56(1) and Rule 55(c) EPC.

Order

For these reasons, it is decided that:

1. The appeal is allowed; the opposition is admissible.
2. The case is remitted to the Opposition Division for the further prosecution of the opposition.

The Registrar:

The Chairman:

E. Görgmaier

K.J.A. Jahn