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File No.: T 0548/92 - 3.4.1
Application No.: 85 303 318.1
Publication No.: 0 164 900
Classification: H05B 3/74
Title of invention: Heating apparatus

D E C I S I O N
of 5 August 1993

Applicant:

Proprietor of the patent: GE LIGHTING LTD

Opponent: Ceramaspeed Limited

Headword:

EPC: Art. 104; 111

Keyword: "Patent revoked on request of proprietor following late filing
of new document in appeal proceedings"
Apportionment of costs (fixed amount awarded to proprietor)"

Headnote
Catchwords



Europäisches
Patentamt

European
Patent Office

Office européen
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0548/92 - 3.4.1

D E C I S I O N
of the Technical Board of Appeal 341
of 5 August 1993

Appellant:
(Opponent)

Ceramaspeed Limited
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Worcestershire WR9 7DJ (GB)

Representative:

Jackson, Derek Charles
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Respondent:
(Proprietor of the patent)

GE LIGHTING LIMITED
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Representative:

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Decision under appeal:

Decision of the Opposition Division of the
European Patent Office dated 14 May 1992
rejecting the opposition filed against European
patent No. 01 649 00 pursuant to Article 102(2)
EPC.

Composition of the Board:

Chairman: G.D. Paterson
Members: R.K. Shukla
U.G.O.M. Himmler

Summary of Facts and Submissions

- I. A notice of opposition to this European patent was filed in December 1989, on the ground that its subject-matter does not involve an inventive step having regard to six prior published documents. In its decision dated 14 May 1992, the Opposition Division rejected the opposition, on the basis that certain features of Claim 1 of the patent identified as features (G) to (J), are not known from any document, and that such missing features provide a new technical effect. The claimed combination of features therefore involved an inventive step.
- II. The Opponent appealed. The grounds of appeal referred *inter alia* to four of the six prior documents previously relied upon, when contesting the correctness of the above decision. The Patentee acknowledged receipt of the Grounds of Appeal, stated that the appeal would be contested, and requested two months' extension for filing observations in reply. The Opponent then filed a further letter enclosing a new citation (D) US-A-3 258 631, and requested that this document should be admitted into the proceedings, because it was particularly relevant to features (F) and (I) of Claim 1 for the reasons set out in the letter.

The Patentee initially responded by requesting a further one month extension to take account of the new citation. Three weeks later, the Patentee filed a letter dated 24 March 1993 stating that the new citation was regarded as particularly relevant, and that the opposition would not have continued to be contested if the new document had been cited earlier. The Patentee therefore requested that the patent should be revoked, and that costs should be awarded to them.

III. Subsequently, the Opponent strongly disputed the request for an award of costs in letters dated 14 and 27 April 1993, and the Patentee supported his request for costs in a letter dated 16 June 1993.

Reasons for the Decision

1. The Patentee has requested in a letter dated 24 March 1993 that the patent should be revoked.

2. Costs

2.1 It is well established in many decisions of the Boards of Appeal that the late filing of a document in support of an opposition may lead to an apportionment of costs if such late filing causes additional expense to a party to the proceedings, which would have been avoided if the document had been filed in due time.

2.2 In the present case, the Board is satisfied that the new citation (D) is sufficiently relevant that, if the Patentee had not requested revocation of the patent, it would have been admitted into the proceedings as requested by the Opponent. In the Board's view, the disclosure of (D) could have affected the outcome of the proceedings.

2.3 The Patentee has stated in a letter dated 24 March 1993 that the opposition would not have continued to be contested if document (D) had been cited earlier. The Opponent has explained that document (D) was discovered during a search in a different matter, its relevance to the present case was recognised, and it was promptly cited in the present case. The Opponent has also questioned that the citation of document (D) was the

real cause of the Patentee requesting revocation of the patent, and has submitted that the Patentee's request for costs is opportunistic and unjustified.

2.4 The Board accepts the reason for the late filing of document (D) put forward by the Opponent. In the Board's view, it is necessarily a matter of conjecture whether or not the Patentee would have continued to contest the opposition if document (D) had been cited earlier by the Opponent. Nevertheless, if document (D) had been cited in the notice of opposition or at an earlier stage in the proceedings, the Patentee would have had an opportunity to decide at that earlier stage whether to contest or continue to contest, the opposition, or whether to save costs by not contesting it. In the Board's view it is therefore appropriate for reasons of equity to order an apportionment of costs in favour of the Patentee, as compensation for part of the latter's expenses in contesting the opposition prior to the citation of document (D) by the Opponent.

Order

For these reasons, it is decided that:

1. European patent No. 0 164 900 is revoked.
2. The opponent shall pay the patent proprietor the sum of five hundred pounds.

The Registrar:

M. Beer



The Chairman:

G.D.



Paterson

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