

BESCHWERDEKAMMERN  
DES EUROPÄISCHEN  
PATENTAMTS

BOARDS OF APPEAL OF  
THE EUROPEAN PATENT  
OFFICE

CHAMBRES DE RECOURS  
DE L'OFFICE EUROPEEN  
DES BREVETS

**Internal distribution code:**

- (A) [ ] Publication in OJ  
(B) [X] To Chairmen and Members  
(C) [ ] To Chairmen

**D E C I S I O N**  
of 4 December 1996

**Case Number:** T 0125/93 - 3.3.3

**Application Number:** 87304792.2

**Publication Number:** 0247898

**IPC:** B32B 27/32

**Language of the proceedings:** EN

**Title of invention:**  
Sealable films

**Patentee:**  
EXXON CHEMICAL PATENTS INC.

**Opponent:**  
HOECHST Aktiengesellschaft Werk Kalle-Albert

**Headword:**  
-

**Relevant legal provisions:**  
EPC Art. 111(1), 114(1)

**Keyword:**  
"Referral back to Opposition Division on account of relevant prior art filed late by the Patentee"

**Decisions cited:**  
G 0009/91; G 0010/91; T 0039/93

**Catchword:**  
The legal consequences of the introduction of new facts - here a relevant prior art document - into an appeal, resulting in a shift in the factual framework of the appeal, apply also when the party responsible for the shift is the Patentee. (Reasons, points 2.3, 2.4).



Europäisches  
Patentamt

European  
Patent Office

Office européen  
des brevets

Beschwerdekammern

Boards of Appeal

Chambres de recours

Case Number: T 0125/93 - 3.3.3

**D E C I S I O N**  
of the Technical Board of Appeal 3.3.3  
of 4 December 1996

**Appellant:**  
(Opponent)

HOECHST Aktiengesellschaft  
Werk Kalle-Albert  
Zentrale Patentabteilung KA  
D-65174 Wiesbaden (DE)

**Representative:**

**Respondent:**  
(Proprietor of the patent)

EXXON CHEMICAL PATENTS INC.  
1900 East Linden Avenue  
Linden  
New Jersey 07036-0710 (US)

**Representative:**

UEXKÜLL 6 STOLBERG  
Patentanwälte  
Beselerstrasse 4  
22607 Hamburg (DE)

**Decision under appeal:**

Interlocutory decision of the Opposition Division  
of the European Patent Office dated 16 November  
1992, issued in writing on 4 December 1992  
concerning maintenance of the European patent  
No. 0 247 898 in amended form.

**Composition of the Board:**

**Chairman:** C. Gérardin  
**Members:** R. Young  
J. A. Stephens-Ofner

## Summary of Facts and Submissions

- I. The mention of the grant of European patent No. 0 247 898, in respect of European patent application No. 87 304 792.2, filed on 29 May 1987 and claiming a GB priority of 30 May 1986 (GB 8613161) was announced on 22 November 1990 (Bulletin 90/47).
  
- II. Notice of Opposition was filed on 21 August 1991, on the grounds lack of novelty, lack of inventive step or, in the alternative, insufficiency, and unallowable extension of subject-matter (Articles 100 (a), (b) and (c) EPC). The opposition was supported, inter alia, by the documents  
  
D2: GB-A-2 055 688, and  
D3: GB-A-2 028 168.
  
- III. By a decision which was given at the end of oral proceedings held on 16 November 1992 and issued in writing on 4 December 1992, the Opposition Division found that the patent could be maintained in amended form.
  
- IV. On 23 January 1993, a Notice of Appeal against the above decision was filed by the Appellant (Opponent), together with payment of the prescribed fee. A Statement of Grounds of Appeal was filed on 8 April 1993.
  
- V. The Respondent (Patentee) contested the submissions of the Appellant, in responses filed on 15 October 1993 and 12 April 1995 respectively.
  
- VI. Oral proceedings were appointed for 4 December 1996, in a summons issued by the Board on 14 August 1996.

VII. On 21 November 1996, a submission was received from the Respondent (Patentee) which referred, for the first time, to a document D5: Japanese Patent Application 60-210647 (Serial No. 59-66 532), published on 23 October 1985, together with a copy of an English translation thereof, which was stated to contain examples falling within the scope of the claims of the patent in suit. The submission was accompanied by an amended version of Claim 1.

A supplementary submission of the Respondent, filed on 26 November 1996, was accompanied by amended Claims 1 and 12 and revised pages 2 and 3 of the patent specification.

VIII. Oral proceedings were held on 4 December 1996, during which the procedural aspects of the case relating to the late submission of D5 were discussed.

IX. The Appellant requested:

- (1) that document D5 be admitted to the proceedings;  
and
- (2) that the case be remitted to the Opposition Division for further prosecution.

The Respondent requested, in writing, that the patent be maintained on the basis of Claims 1 and 12 filed on 26 November 1996, Claims 2 to 11 and 13 to 15 of the patent as granted and an adapted description according to the pages filed on 26 November 1996. It made no specific request during the oral proceedings in relation to items IX.(1) and (2) above, or at all.

## Reasons for the Decision

1. The appeal is admissible.

2. *Procedural issues*

2.1 The Respondent (Patentee) filed document D5 shortly before the date appointed for oral proceedings. It is clearly relevant enough, for the reasons given by the Respondent itself (section VII., above) to be considered highly likely to prejudice the maintenance of the European patent in suit. Indeed, its very relevance was the reason for its introduction, albeit belatedly, by the Respondent. The particular issue to which it was said by the Respondent to be relevant was novelty, a ground amongst others already pleaded, supported and decided upon by the Opposition Division.

2.2 The reasons for the belated discovery by the Respondent of the D5 were, to some extent, explored during the oral proceedings, but since the Appellant did not make any request for an apportionment of costs pursuant to Article 104 and Rule 63 EPC, they are irrelevant to the sole procedural issue that calls for decision: the admissibility of the document, and the effect of it, if admitted, upon the further conduct of the appeal proceedings.

2.3 Since the relevance of the document is beyond doubt (and accepted by both parties), and since its provenance (here, unusually, the Patentee) is irrelevant to its likely effect upon the validity and therefore the maintenance of the patent in suit, the

Board, in the exercise of its discretion, admits it to the proceedings pursuant to Article 114(1) EPC, with the concomitant effect of altering the factual framework of the case under appeal compared with that upon which the decision under appeal had been based.

2.4 The legal consequences of such a shift in the factual framework are by now well settled, see, e.g. T 0039/93 of 14 February 1996 (to be published in OJ EPO), summarising numerous other decisions of the Boards and of the Enlarged Board, the latter in cases G 0009/91 and G 0010/91 (OJ EPO 1993, 408 and 420, respectively). They apply also when the party responsible for the shift is the Patentee.

2.5 These consequences were not called into question by either party. The Appellant requested remittal to the Opposition Division for further prosecution, and the Respondent made no specific request in response, expressly admitting that no other course of action was legitimately open in the light of the jurisprudence referred to above.

2.6 Nor can the Board detect any "special reasons" of the kind adverted to by the Enlarged Board in §18 of the Reasons of G 0010/91, so that the only course it can legitimately pursue is to accede to the express request of the Appellant, as well as the implied one of the Respondent, and, in the exercise of its powers under Article 111(1) EPC, refer the case back to the Opposition Division for further prosecution of the case **including D5**. Such further prosecution will, obviously, need to be conducted within the entire legal framework of the case, i.e. having regard to all the issues so far pleaded.

3. Since the case is remitted, the Board has refrained from deciding whether the claims forming the basis of the written request of the Respondent (Section IX., above) are formally and substantively admissible.

**Order**

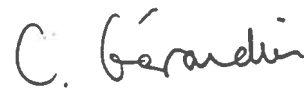
for these reasons it is decided that:

1. The decision under appeal is set aside.
2. Document D5 is admitted to the proceedings.
3. The case is remitted to the Opposition Division for further prosecution.

The Registrar:

  
E. Görgmaler

The Chairman:

  
C. Gérardin

