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D E C I S I O N
of 21 February 1994

Case Number: T 0153/93 - 3.3.1

Application Number: 84301052.1

Publication Number: 0121993

IPC: C09D 11/00

Language of the proceedings: EN

Title of invention:
Recording liquid

Patentee:
Canon Kabushiki Kaisha

Opponent:
BASF Aktiengesellschaft, Ludwigshafen

Headword:
Recording liquid/CANON

Relevant legal norms:
EPC Art. 106(1), 107, 111(2)

Keyword:
"Admissibility of appeal (yes)"
"Res judicata, binding effect of finding of facts; appeal dismissed"

Decisions cited:
G 0009/91, G 0010/91, G 0001/86, T 0934/91, T 0843/91

Catchword:
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Case Number: T 0153/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 21 February 1994

Appellant:
(Opponent.)

BASF Aktiengesellschaft, Ludwigshafen
Patentabteilung C6
Carl-Bosch-Strasse 38
D-67056 Ludwigshafen (DE)

Representative:

Respondent:
(Proprietor of the patent)

Canon Kabushiki Kaisha
30-2, 3-chome, Shimomaruko
Ohta-ku
Tokyo (JP)

Representative:

Beresford, Keith Denis Lewis
Beresford & Co.
2-5 Warwick Court
High Holborn
London WC1R 5DJ (GB)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office dated 17 December
1992 concerning maintenance of European patent
No. 0 121 993 in amended form.

Composition of the Board:

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

Summary of Facts and Submissions

- I. By its decision dated 30 June 1992 the Board of Appeal ordered the maintenance of patent no. 0 121 993 standing in the name of Canon Kabushiki Kaisha of Japan on the basis of Claims 1 to 5 according to the main request as amended in the course of oral proceedings. Its Order remitting the case to the Opposition Division made no mention of any necessary adaptation of the description.
- II. The Opposition Division by its decision of 17 December 1992 found that certain amendments to the description submitted by the Patentee with its letter of 10 November 1992 resulted in a description which, together with the claims as ordered to be maintained by the Board of Appeal, met the requirements of the EPC in accordance with Article 102(3) EPC.
- III. By notice of appeal requesting the revocation of the patent and filed on 12 February 1993, the Opponent, BASF, lodged an appeal against this decision and paid the requisite fee in due time. In the Statement of Grounds of appeal, filed on 26 April 1993, the Opponent challenged the novelty of Claims 1 to 4 as ordered to be granted by the Board of Appeal. He also challenged the clarity of the claims under Article 84 EPC by reference to the expression "a normal background lawn" in the above claims.

Both novelty and clarity under Article 84 EPC had been pleaded, fully argued and decided upon by the Board of Appeal. Its findings on these issues, amongst others, formed the basis of its decision remitting the case to the Opposition Division with the order to maintain the patent with Claims 1 to 5 as amended in the course of oral proceedings.

- IV. By a communication dated 7 July 1993 the Board expressed its preliminary view that the appeal might be inadmissible in the light of its earlier decision in case T 934/91 (for Headnote see OJ EPO 3/1993) in which it dealt exhaustively with the concepts of *res judicata* and *ratio decidendi* and the meaning of an appealable decision under Article 106(1) and Article 107 EPC.
- V. In response to the above communication the Opponent maintained that his appeal was admissible, relying on the particular form in which the Opposition Division's decision had been given, whilst the Patentee submitted that novelty as well as clarity under Article 84 EPC were both issues that had already been decided by the Board of Appeal and were therefore *res judicata*. He also requested an opportunity to reply in more detail in the event that the Technical Board were to rule the appeal to be admissible and requested oral proceedings in case any decision adverse to them were taken by the Board. He subsequently withdrew the first part of the above request.

Reasons for the Decision

1. The appeal meets the formal requirements of Articles 106 to 108 EPC. Since the appeal does not lie against a decision of the Opposition Division made in response to a request made to it to set aside an earlier decision of a Board of Appeal, as was the case in T 934/91 referred to above, but is one issued pursuant to a remittal by the Board of Appeal, followed by a legally valid decision-making process as to the suitability of the amendments to the description, the appeal is admissible.

2. The Boards of Appeal are courts see G 1/86, OJ EPO 1987, 447, paragraph 14 of the Reasons, and their proceedings are judicial, see G 9 and G 10/91, OJ EPO 1993, pp. 408 and 420 respectively. Their decisions are final because neither Article 21 nor Article 106, nor any other provision of the EPC provides for any appeal from their decisions. Referrals to the Enlarged Board pursuant to Article 112 EPC are, of course, not appeals. Accordingly, decisions of Boards of Appeal are *res judicata*, that is to say "matters finally settled by a court of competent jurisdiction, rendering that matter conclusive **as to the rights** of the parties and their privies" (see Black's Law Dictionary, fifth edition). Their judgments therefore constitute an absolute bar to any subsequent action involving the same matter or course of action as between the parties and their privies.

The previous finding of the Board of Appeal that Claims 1 to 5 as amended in the course of oral proceedings were novel, were clear and were inventive, are therefore *res judicata*. Furthermore, the findings of fact i.e. the clarity of the term "normal background lawn" as well as the construction of the disclosure of DE-A-2 924 861 in its entirety, are findings of fact that were part of that decision and are likewise binding upon the parties in all subsequent proceedings before the EPO, including its judicial arm, the Boards of Appeal, see, in particular, decision T 843/91 dated 5 August 1993 (to be published). In paragraph 3.4.2 of the Reasons of that decision, the Board of Appeal held that all findings of fact that were a *conditio sine qua non* of the finally binding parts (*res judicata*) of the decision, with the result that new facts, evidence or arguments seeking to cast doubt upon these facts could not be considered either by the Opposition Division or the Board of Appeal (self-binding effect). The Board

went on to say that remittal proceedings should not afford opponents a much belated opportunity to attack the remitting decision by introducing new facts, as it was in the general interest of the public that legal disputes be terminated ("*expedit republica ut sit finis litium*"), and that individuals (and firms) had the right to be protected from the vexatious multiplication of suits.

3. In the present case the Opponent is not even seeking to challenge the Board's earlier decision to remit by the roundabout manner condemned in T 843/91 but is, instead, boldly seeking to re-open the twin issues of novelty and of clarity, relying on the same facts and arguments, with the sole exception of the argument concerning Example 6 of one of the prior publications, upon which the remitting Board's decision had been based. As has been explained above, the findings of clarity and of novelty are *res judicata*, and the findings of fact upon which this finding depends are binding both on the Opposition Division and this Board of Appeal. Furthermore, new but related facts and arguments e.g. the argument relating to Example 6 of the above-mentioned publication cannot, at this stage, be relied upon either to challenge those findings of fact, for the reasons set out in the previous paragraph.
4. The Board would also observe, *obiter*, that in its judgment it would not be open for an Opponent to rely upon totally new evidence or grounds of invalidity, either during remittal proceedings or on an appeal from them, in an attempt to challenge afresh the validity of claims already finally adjudged to be valid by a Board of Appeal, regardless of the relevance or cogency of

such evidence or grounds. Any such further challenge by an Opponent and/or others to the validity of the patent may only be made in other jurisdictions i.e. in the national courts.

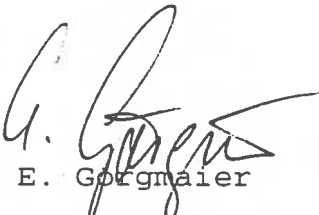
5. Accordingly, the appeal is dismissed.

Order

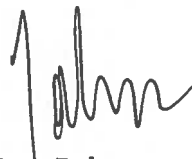
For these reasons, it is decided that:

The appeal is dismissed.

The Registrar:


E. Gorgnauer

The Chairman:


A.K.A. Jahn

