

**Internal distribution code:**

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

**D E C I S I O N**  
of 22 September 1994

**Case Number:** T 0719/93 - 3.4.2

**Application Number:** 84304148.4

**Publication Number:** 0129444

**IPC:** B01D 53/04

**Language of the proceedings:** EN

**Title of invention:**

Methods for obtaining high-purity carbon monoxide

**Patentee:**

KAWASAKI STEEL CORPORATION, ET AL

**Opponent:**

Linde Aktiengesellschaft, Wiesbaden

**Headword:**

-

**Relevant legal norms:**

EPC Art. 104(1), 114, 117(1)  
EPC R. 63

**Keyword:**

"Late-filed documents"  
"Apportionment of costs"

**Decisions cited:**

T 0117/86

**Catchword:**

-



Case Number: T 0719/93 - 3.4.2

**D E C I S I O N**  
of the Technical Board of Appeal 3.4.2  
of 22 September 1994

**Appellant:** Linde Aktiengesellschaft, Wiesbaden  
(Opponent) Zentrale Patentabteilung  
D-82049 Höllriegelskreuth (DE)

**Representative:** -

**Respondent:** KAWASAKI STEEL CORPORATION ET AT  
(Proprietor of the patent) 1-28, Kitahonmachi-dori 1-Chome  
Chuo-Ku, Kobe-Shi  
Hyogo-Ken (JP)

**Representative:** Cropp, John Anthony David  
Mathys & Squire  
10 Fleet Street  
London EC4Y 1AY (GB)

**Decision under appeal:** Interlocutory decision of the Opposition Division  
of the European Patent Office dated 15 June 1993  
concerning maintenance of European patent  
No. 0 129 444 in amended form.

**Composition of the Board:**

**Chairman:** E. Turrini  
**Members:** C. Black  
L. C. Mancini

### Summary of Facts and Submissions

1. European patent No. 0 129 444 was maintained in amended form by a decision of the Opposition Division. The decision took into account the disclosure in documents identified as D1 and D2.
  
- II. The Opponent lodged an appeal against this decision, citing four new documents, identified in the proceedings as D3, D4, D5 and D6.
  
- III. In response, the Patentee (Respondent) objected that none of these documents had been mentioned in the opposition proceedings and that if the appeal were at all allowable, the case should be referred back to the Opposition Division with an order for costs in favour of the Patentee. Further, D3 was a patent publication of the Appellant published in 1983 and D4 was a document in a field which was obviously of active interest to the Appellant. There was no valid reason why these documents could not have been produced earlier. The Board should disregard these documents under Article 114(2) EPC, dismiss the appeal and award costs in favour of the Patentee.  
  
The appeal should moreover be dismissed as a blatant abuse of the provisions of the EPC, again with award of costs to the Patentee.  
  
The Patentee also contested the pertinence of the newly cited documents.
  
- IV. Both parties had requested the appointment of oral proceedings as an auxiliary measure, and these were set for 29 September 1994.

V. In a communication pursuant to Article 11(2) EPC of the rules of procedure of the Boards of Appeal, the Board noted that apart from a reference to document D1 in paragraph 7 of the grounds for the appeal the Appellant's argumentation relied wholly on the late-filed documents D3 to D6. The Board agreed with the Respondent that documents D3 and D4 were publications which the Appellant would have been aware of at an earlier stage of the proceedings and expressed the provisional opinion that the Respondent's assessment of the pertinence of D3 and D4 could be followed. These documents were at most no more relevant than the documents relied on by the Opposition Division and in the absence of convincing counter-arguments it was probable that they would be left out of consideration. D5 and D6 could be admitted since these were extracts from reference works which could be considered as reflecting general knowledge in the art.

The Board, emphasising that this was a provisional opinion, indicated that if it were to be persuaded that D3 and D4 were more relevant than it appeared, then it would be appropriate to remit case to the Opposition Division to continue examination of the opposition as provided for in Article 111(1) EPC.

Finally, as regards the decision under appeal, the Board saw no reason to disagree with the conclusion of the Opposition Division based on the cited documents then under consideration.

VI. In a communication dated 1 September 1994, the Appellant withdrew the appeal. Accordingly the oral proceedings were cancelled.

### Reasons for the Decision

1. The sole Appellant having withdrawn the appeal, which as filed was admissible, the appeal proceedings are terminated insofar as the substantive issues settled by the contested decision at first instance are concerned (see the decision of the Enlarged Board of Appeal in the case G 8/91, OJ EPO, 1993, 346). The patent is therefore to be maintained in amended form as decided by the Opposition Division.
2. There remains, however, to be decided the question of the Respondent's requests during the appeal for an award of costs.
3. The facts of the present case are very similar to those in Decision T 117/86 (OJ EPO 1989, 401), in that in both cases the Statement of Grounds of Appeal did not directly challenge the reasoning set out in the decision of the Opposition Division rejecting the opposition but relied on new documents in support of the contention that the opposed patent lacked an inventive step. One difference is that in T 117/86, it was the opposition that was withdrawn rather than the appeal, but as stated by the Board of Appeal (hereinafter referred to as "Board") in point 2 of its decision, withdrawal of the opposition by the Appellant is to be treated as withdrawal of the appeal. Further, in case T 117/86 there was an exchange of communications between the Board and the parties, in the course of which the Appellant sought to justify the late filing of new documents. The Board however did not accept the Appellant's argument in this respect, so that the end result is equivalent to that in the present case.

4. In point 3 of said decision, the Board explained why "taking of evidence" as referred to in Article 104(1) EPC included the production of new documents (and/or an affidavit) by the Appellant and the filing by the Respondent of a statement in writing in reply. In points 4 to 6 the Board further explained why an apportionment of costs in the Respondent's favour was justified for reasons of equity.
  
5. For the same reasons as set out in Decision T 117/86, the present Board has decided to order an apportionment of costs by which the Appellant shall pay to the Respondent fifty percent of the costs which were incurred by the Respondent's representative and charged to the Respondent in preparing and filing the reply to the appeal dated 14 April 1994.
  
6. For completeness and accuracy, the Board points out that in addition to the reference to document D1 in the grounds for the appeal (see paragraph V above), document D2 is referred to in paragraph 8 of the grounds. This does not alter the Board's opinion since the grounds for the appeal rely almost wholly on the newly introduced documents.

Order

For these reasons it is decided that:

1. The patent is maintained in amended form in accordance with the decision of the Opposition Division.
2. The costs in the appeal procedure shall be apportioned so that the Appellant shall pay to the Respondent fifty per cent of the costs which were incurred by the Respondent's representative and charged to the Respondent in preparing and filing the Respondent's reply to the appeal dated 14 April 1994.

The Registrar:

The Chairman:

P. Martorana

E. Turrini

