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D E C I S I O N
of 30 November 1994

Case Number: T 0817/93 - 3.4.2
Application Number: 86117950.5
Publication Number: 0228072
IPC: B01D 61/14, B01D 71/68,
B01D 71/64, C08J 3/11, C08L 81/06,
C08L 79/08

Language of the proceedings: EN

Title of invention:
Filtration membrane and method of making the same

Patentee:
GELMAN SCIENCES, INC.

Opponent:
Akzo Nobel Faser AG
Hoechst Aktiengesellschaft, Werk Kalle-Albert
Sartorius AG
Fresenius AG

Headword:

Relevant legal provisions:
EPC Art. 113(1), 114(1)
EPC R. 67

Keyword:
"Examination by Opposition Division of its own motion"
"New ground for opposition not substantiated until late in proceedings"
"Remittal to Opposition Division"
"Reimbursement of appeal fee"

Decisions cited:
T 0493/88, G 0009/91, G 0010/91

Catchword:



Case Number: T 0817/93 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 30 November 1994

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Decision under appeal: Decision of the Opposition Division of the European Patent Office dated 22 June 1993, posted on 14 July 1993 revoking European patent No. 0 228 072 pursuant to Article 102(1) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

- I. European patent No. 0 228 072 (application no. 86 117 950.5) was granted on the basis of a set of claims of which Claim 1 reads as follows:

"A hydrophilic microfiltration membrane made from a polymer which in bulk form is hydrophobic and has an equilibrium water absorption ranging from 2 to 4% and which is blended with a polymer additive in an amount effective to make the membrane when formed and dried inherently water wettable, with a pore size range such that the membrane does not retain or reject dissolved proteins or salts from aqueous feed solutions."

- II. Opposition to the granted patent was filed by Akzo Faser AG (01), Hoechst AG (02), Sartorius AG (03) and Fresenius AG (04). The oppositions of 01 and 02 were based on Article 100(a) EPC, specifically lack of novelty and inventive step. 03's opposition was also based on Article 100(a) EPC and on EPO Form 2300, page 2, the boxes relating to lack of novelty and inventive step were crossed. In the grounds for the opposition however objection was also raised to Claims 7, 10 and 12 in that these were product-by-process claims which contravened Articles 83, 84 EPC. The box on EPO Form 2300.2 relating to Article 100(b) EPC had however not been crossed. 04 also used EPO Form 2300 and crossed the boxes relating to Article 100(a) and (b); however non-compliance with Article 83 EPC, corresponding to Article 100(b) EPC was not specifically mentioned in 04's grounds of opposition.

- III. In the Patentee's response to the various Notices of Opposition, it was observed in relation to 03's

opposition that no argumentation had been submitted substantiating why the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (page 22 of response dated 5 November 1992).

- IV. A communication from the Opposition Division accompanying a summons to oral proceedings contained the following paragraph 4:

"Additionally, it will be discussed whether the contested patent meets the requirements of Article 100(b) EPC.

Note: In the written procedure facts, evidence and arguments in support of this ground appear not to have been indicated."

- V. Oral proceedings were appointed for 22 June 1993.

- VI. In a communication dated 9 June 1993, 03 submitted the results of a comparative test which sought to demonstrate that a membrane prepared according to Example 3 of the patent in suit did not meet the requirement of Claim 1 that it should not retain or reject dissolved proteins or salts from aqueous solutions. It was concluded therefore that the object of the invention was not met (by this example).

- VII. According to the minutes of the oral proceedings, the Patentee disputed the admissibility of 03's communication dated 9 June 1993 and of 01's communication dated 15 June 1993 on the ground that there had been insufficient time to read and translate the arguments contained therein. The request was rejected by the Opposition Division, it being argued that these communications contained no new basic

arguments not already discussed in the written procedure.

VIII. The patent was revoked on the ground for opposition under Article 100(b) EPC. In its reasons the Opposition Division acknowledged that in none of the Notices of Opposition was it mentioned that the contested patent, as a whole, did not meet the requirement of Article 100(b), that is Article 83 EPC, but had formed the opinion that this question was very relevant. In a note stated to be not part of the decision, the Opposition Division expressed doubts as regards novelty and conformity with Article 123(2) EPC.

IX. The present appeal lies against this decision. In the grounds for the appeal, the Appellant (Patentee) requested that the decision of the Opposition Division be reversed and the case remitted to the Opposition Division for further prosecution on the basis of the claims as granted, or on the basis of an auxiliary set of claims filed with the grounds. It was further requested to reimburse the appeal fee or to set a term for oral proceedings if none of the foregoing requests could be granted on the facts as they stood.

In a subsequent communication dated 31 October 1994 the Appellant further requested inter alia that the fresh ground of opposition under Article 100(c) EPC be not considered. With a communication dated 3 November 1994 the Appellant requested that an experimental report of 03 filed belatedly with the communication dated 13 October 1994 be disregarded as being of no relevance.

At oral proceedings, appointed at the auxiliary request also of the Respondents 01, 03 and 04, the Appellant in substance confirmed the various requests but expressed

preparedness to discuss the Article 100(c) ground as well as that of Article 100(b).

- X. The gist of the Appellant's argumentation in support of the various requests is as follows. The Article 100(b) ground of opposition was mentioned but not substantiated by 04, and was invoked by 03 only in respect of the product-by-process claims. Even 03's late-filed communication dated 9 June 1993 only referred to Article 100(a). The Opposition Division acknowledged this lack of substantiation in its communication accompanying the summons to oral proceedings (paragraph 4) so that this ground for opposition should have been deemed inadmissible under Rule 56(1) EPC.

The Opposition Division, in effectively raising this issue of its own motion under Article 114(1) EPC did not act in accordance with the opinion G 10/91 of the Enlarged Board of Appeal (OJ EPO, 1993, 420) or with Opposition Procedure in the EPO (OJ EPO 1989, 417), point 25.

But even if the present case could be considered to be an exceptional one wherein it was proper for the Opposition Division to invoke the ground for opposition under Article 100(b) of its own motion, the Opposition Division did not act in accordance with the Guidelines for examination in the European Patent Office, Part D-VI,3.2 and Part E-III,5 as well as Opposition Procedure in the EPO, point 3d, last paragraph, in that its communication merely stated that Article 100(b) would be discussed, without any further explanation as to the reason for this.

While the Guidelines, Part D-V,4.3 indicates that the burden of proof may in particular circumstances shift to the patent proprietor, in the present case the

proprietor did not know what was required to be proved until the oral proceedings, where for the first time it became apparent that the ground of opposition under Article 100(b) was linked to the feature "such that the membrane does not retain or reject dissolved proteins or salts from aqueous feed solutions".

The Opposition Division was moreover wrong in finding that the late-filed documents contained no new basic arguments not already discussed in the former written procedure and therefore rejecting the request to disregard these. 03's communication dated 9 June 1993 and the accompanying comparative test report raised the question of insufficiency for the first time, and left inadequate time (seven working days before oral proceedings) before the necessary translations and forwarding to the Patentee could be effected.

The objection under Article 123(2) EPC was mentioned for the first time in the decision under appeal and ought therefore to be discussed after remittal of the case to the Opposition Division.

Reimbursement of the appeal fee is justified because the appeal might not have been necessary if the Opposition Division had issued a clear and unambiguous communication with the summons to oral proceedings.

XI. The Respondents all requested that the appeal be dismissed. The consensus of opinion moreover was that it was proper to discuss at least the ground for opposition under Article 100(b) at the oral proceedings.

Reasons for the Decision

1. The appeal is admissible.

2. The Board can in substance agree with the submissions of the Appellant as summarised in paragraph IX above. The ground of opposition under Article 100(b) EPC, on which the decision revoking the patent was based, was not substantiated until the oral proceedings held on 22 June 1993, or, if 03's test report is considered to be relevant to Article 100(b) EPC, a few days before this date. Until this time, the proprietor of the patent could not know the case which had to be answered. Moreover in the Board's view the Opposition Division was incorrect in dismissing the patent proprietor's protest against the late-filed submissions of 01 and 03 for the reason given that these contained no new basic arguments (point 3 of the minutes of the oral proceedings). At least 03's test report appeared to seek for the first time to demonstrate insufficiency and to require response from the patent proprietor. The Opposition Division, in rejecting the request for the late-filed documents to be disregarded, should have allowed the proprietor time for the said response. As it was, the patent proprietor had to have recourse to appeal in order to defend the patent so that the procedure, so far as it concerned Article 100(b) EPC, reduced to one of single instance. In order that the patent proprietor, or for that matter any of the parties, is not deprived of the opportunity to argue the case at two levels of jurisdiction, the Board deems it appropriate to make use of its power under Article 111(1) EPC and remit the case to the Opposition Division for further prosecution.

3. The Board would not wish to fetter the Opposition Division in any way in this further prosecution. However in the Board's opinion, the question of compliance with Article 123(2) EPC as regards the feature "does not retain or reject dissolved proteins or salts from aqueous feed solutions" appears to require to be resolved before examination of the ground of opposition under Article 100(b) EPC. Moreover it appears from the opposition proceedings that the said feature is considered to have a role to play in defining the scope of Claim 1 and therefore in evaluating novelty and inventive step. It may therefore be possible for the ground of opposition under Article 100(a) EPC to be examined at the same time.

Moreover, account should be taken of the fact that observations by a third party under Article 115(1) are on file; see its communication dated 29 October 1994.

4. In coming to its conclusion, the Board noted the submission by 02 in the communication dated 1 June 1994, point 2.1, that page 4, third paragraph of 04's grounds for opposition, dated 26 May 1992, was a substantiation of the ground for opposition under Article 100(b) EPC. In the Board's view, it is inventive step that is being discussed here and even with hindsight it is difficult to see a connection with the said ground.

As regards 03's invoking Article 83 in respect of product-by-process claims, the Board's opinion is that such claims may be attacked on the grounds of lack of clarity, lack of novelty or lack of inventive step, but not under Article 83 for the sole reason that they are product-by-process claims. 03's statement of grounds for opposition is therefore not seen as containing a substantiation of the ground under Article 100(b) EPC.

During the oral proceedings (appeal proceedings) 01 referred to the decision in appeal case T 493/88 (OJ EPO 1991, 380) as justifying the Opposition Division's introduction of the ground under Article 100(b) EPC of its own motion. In the Board's view the facts of that case and the present one are very different and in any case T 493/88 has now to be read in the light of the decision and opinion of the Enlarged Board of Appeal in cases G 9/91 and G 10/91 respectively.

5. In fact no criticism can be levelled at the Opposition Division for using its discretion to introduce the said ground, because this is in accordance with Article 114(1) EPC and indeed with G 9/91 and G 10/91. The criticism is that the patent proprietor was presented with a ground for opposition which was not substantiated until it was too late to provide a proper defence thereto and was not given further opportunity to do so at the opposition stage. The requirement of Article 113(1) EPC was therefore not met. Since the appeal is successful to the extent that the decision under appeal is to be set aside and since in view of the foregoing, reimbursement of the appeal fee is equitable because of a substantial procedural violation, the requirements of Rule 67 EPC are met and the Appellant's request for reimbursement of the appeal fee is allowed.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution.

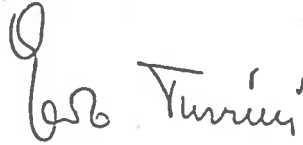
- 3. The request for reimbursement of the appeal fee is allowed.

The Registrar:



P. Martorana

The Chairman:



E. Turrini

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