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D E C I S I O N
of 21 June 1999

Case Number: T 0656/96 - 3.2.3
Application Number: 88810118.5
Publication Number: 0280657
IPC: B24D 11/00, B24D 18/00, B24D 3/00

Language of the proceedings: EN

Title of invention:
Flexible abrasives

Patentee:
Abrasive Technology N.A., Inc.

Opponent:
Minnesota Mining and Manufacturing Company

Headword:
-

Relevant legal provisions:
EPC Art. 99(1), 100, 101(1), 111(1), 113(1)
EPC R. 67

Keyword:
"Oppositions - persons entitled - identity of opponent"
"Opposition grounds"
"Opposition admissibility (yes)"
"Basis of decisions - opportunity to comment (no)"
"Decisions re appeals - remittal (yes)"
"Reimbursement of appeal fee (yes)"
"Substantive procedural violation (yes)"

Decisions cited:

G 0004/92, G 0001/95, G 0007/95, T 0197/88

Catchword:

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Boards of Appeal

Chambres de recours

Case Number: T 0656/96 - 3.2.3

D E C I S I O N
of the Technical Board of Appeal 3.2.3
of 21 June 1999

Appellant: Abrasive Technology N.A., Inc.
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Respondent: Minnesota Mining and Manufacturing Company
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Minnesota 55133 (US)

Representative: Bowman, Paul Alan
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Decision under appeal: Decision of the Opposition Division of the European Patent Office dated 17 April 1996, posted on 14 May 1996, revoking European patent No. 0 280 657 pursuant to Article 102(1) EPC.

Composition of the Board:

Chairman: C. T. Wilson
Members: F. Brösamle
J. P. Seitz

Summary of Facts and Submissions

I. With decision of 14 May 1996 the opposition division came to the result that the opposition is admissible and revoked European patent No. 0 280 657 in the light of Articles 52(1) and 54 EPC since the subject-matter of claim 1 received on 6 March 1995 was seen to lack novelty with respect to

(D1) FR-A-2 565 870.

II. Above claim 1 reads as follows:

"1. A method of forming an abrasive member wherein a metal film (2) is fixedly attached to one surface of a non-conductive flexible sheet (1), a mask (13) of plating resistant material is applied to the exposed surface of the metal film (2), said plating resistant material having a multitude of discrete openings therein (14), and metal (3) is electrodeposited through said discrete openings (14) onto said metal film (2) in the presence of particulate abrasive material (4) so that the particulate abrasive material (4) becomes embedded in the metal deposits (3), characterised in that the voids between the metal deposits are substantially filled with resin (5) to reduce lateral movement of the metal deposits (3) and thereby reduce their tendency to chip off said sheet (1)."

III. On 16 July 1996 the patentee - appellant in the following - lodged an appeal against the above decision

paying the appeal fee in due time and filing the statement of grounds of appeal on 16 September 1996.

IV. Appellant's requests are as follows:

- (a) (by implication) to declare the opposition as inadmissible,
- (b) to set aside the impugned decision and to maintain the patent on the basis of the claims on file i.e. those underlying the impugned decision (**main request**), or
- (c) on the basis of **auxiliary requests I, II and III** filed with the statement of grounds of appeal,
- (d) reimbursement of the appeal fee under Rule 67 EPC and
- (e) by way of an auxiliary petition to refer the question of whether lack of novelty and lack of inventive step constitute the same ground of opposition to the Enlarged Board of Appeal in the light of G 4/92.

V. The opponent - respondent in the following - requested:

- (a) to declare the opposition as admissible and
- (b) by implication to dismiss the appeal or to set aside the impugned decision and to remit the case to the first instance for further prosecution.

VI. Following the Board's communication pursuant to

Article 110(2) EPC of 11 November 1998 in which the Board gave its provisional opinion on the issues raised by the parties in respect of the objection that the proceedings before the first instance suffer from a substantial procedural violation, both parties agreed that the case be remitted to the opposition division for further prosecution on the substantive matters.

VII. The arguments of the parties essentially can be summarized as follows:

(a) appellant:

- it is not clear from the notice of opposition that the respondent is a legal person;
- under these circumstances the opposition division was wrong to make a decision which is adverse to the appellant, namely assessing the opposition to be admissible;
- the sole ground raised by the respondent in his notice of opposition was that "the subject-matter of the European patent opposed is not patentable (Article 100(a) EPC) because: it does not involve an inventive step (Article 52(1); 56 EPC)";
- in the light of the favourable communication pursuant to Article 101(2) EPC of 23 May 1995 in which the existence of novelty was not contested the appellant informed the opposition division that he would not attend the oral proceedings;

- the opposition division in their final decision of 14 May 1996 revoked the patent on a ground - namely lacking novelty - "which was raised for the first time at the Hearing"; the appellant had therefore had no opportunity to present its comments;
- under these circumstances the proceedings suffer from a substantial procedural violation; the appellant requests therefore a reimbursement of the appeal fee under Rule 67 EPC.

(b) respondent:

- since the identity of the legal person "opponent" was clear in view of Articles 99(1) and 100 EPC and of Rules 1(1) and 55 EPC it is requested to declare the opposition as admissible;
- the appeal has to be dismissed since the requirement of Articles 123(2) and 84 EPC are not met and the objections under Article 113(1) EPC are unfounded;
- in the absence of auxiliary requests the opposition division had no other choice than to revoke the patent since the objection under Article 56 EPC is maintained; the documents filed after the time-limit for giving notice of opposition should also be considered.

Reasons for the Decision

1. The appeal is admissible.

2. Admissibility of the opposition
 - 2.1 In the "Notice of opposition..." EPO Form 2300.1 04.89 see remark III, the name of the opponent/respondent is cited, namely Minnesota Mining and Manufacturing Company and the address is set out as: "P.O. Box 33427, 3M Centre, Saint Paul, Minnesota 55133, U.S.A.". Under state of residence or of principal place of business "Minnesota" is indicated.

 - 2.2 With the above information the respondent to the Board's conviction has fulfilled the requirements of Articles 99(1) and 100 EPC and of Rule 55 EPC in combination with Rule 26, paragraph 2(c) EPC.

 - 2.3 As set out in the impugned decision under the above circumstances the opposition is therefore admissible so that the request to the contrary forwarded by the appellant must be refused.

3. *Basis of decisions Article 113(1) EPC*
 - 3.1 The oppositon of 25 May 1994, (see EPO Form 2300.2 4/89, remark VI-(a) and "Facts and Arguments", page 4, second paragraph), is based on the sole ground that the subject-matter of the European patent does **not involve an inventive step.**

 - 3.2 In the Communication pursuant to Article 101(2) EPC of 23 May 1995, the opposition division set out its provisional findings on the independent claims 1 and 14 as follows:

- "5). The subject-matter of independent claims 1 and 14 fulfils the requirements of Articles 52, 54 and 56 EPC.
- 5.1) Document D1, which is considered to form the closest prior art, discloses a method of forming an abrasive member and an abrasive member according to the preambles of claims 1 and 14. This fact is not in dispute.
- 5.2) The subject-matter of claims 1 and 14 differs from what is known from D1 in that the voids between the metal protuberances are substantially filled with resin to reduce the lateral movement of the protuberances and thereby reduce their tendency to chip off the sheet.
- 5.3) The distinguishing feature defines itself the involved effect and the technical problem to be solved by the invention:
the lateral movement of the protuberances is reduced and thereby also their tendency to chip off the sheet."

3.3 In the light of this provisional opinion the appellant could rely on the positive assessment of the issue of novelty by the opposition division, an issue which was not raised by the opponent and was indeed stated to be not in dispute.

Thereupon the appellant informed the opposition division and the respondent that he would not attend the oral proceedings, (see telefax of 15 March 1996,

page 10, last paragraph).

- 3.4 The Board would point out further that according to the decision G 7/95, OJ EPO 1996, 626 the issues of novelty and inventive step constitute different grounds of opposition. As was explained in G 10/91, OJ EPO 1993, 420 any **fresh ground for opposition** can be considered by the opposition division if, prima facie, it would in whole or in part seem to prejudice the maintenance of the European patent.
- 3.5 In the light of the opinion on novelty expressed in the communication of the opposition division, no prima facie case can be seen from the file, so that the appellant was entitled to consider that the question of novelty would play no part before the opposition division.
- 3.6 The appellant must therefore have been taken by surprise by the decision of the opposition division to revoke the patent in the oral proceedings in his absence on the grounds of lack of novelty, a ground on which he had not been asked, nor had any reason, to express an opinion.
- 3.7 According to decision T 197/88, OJ EPO 1989, 412, (see remark 4), and Opinion of the Enlarged Board of Appeal G 4/92, OJ EPO 1994, 149, (see remarks 8 to 10), taking a party by surprise is **a substantial procedural violation**.
- 3.8 The Board therefore comes to the conclusion that the impugned decision cannot be upheld. Rather the case has to be remitted to the first instance for further

prosecution as envisaged in Article 111(1) EPC and as agreed by the parties.

4. The Board refrains from expressing a final opinion as to whether the term "substantially" - see contested decision paragraph 1.3 - can be derived from "the example" in the originally filed description so that the further prosecution of the case in the first instance should include substantiation of the above remark, Articles 123(2) and 84 EPC.

The first instance will moreover have to decide whether or not the documents filed **after** the time-limit for giving notice of opposition have to be considered or not, Article 114 EPC.

5. The above findings stand irrespective of whether or not any auxiliary request was on file at the time the opposition division issued the decision of 14 May 1996. It was a clear infringement of Article 113(1) EPC to directly revoke the patent in the oral proceedings of 17 April 1996 so that the Board cannot share respondent's findings in this respect.

6. *Reimbursement of appeal fee*

- 6.1 According to Rule 67 EPC reimbursement of the appeal fee shall be ordered if such reimbursement is equitable by reason of a substantial procedural violation.

- 6.2 Taking a party by surprise in the manner expressed above has to be seen as a **substantial procedural violation** within the meaning of Rule 67 EPC so that it is equitable under these circumstances that the Board

orders reimbursement of the appeal fee.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance for further prosecution.
3. The request for reimbursement of the appeal fee is allowed.

The Registrar:

The Chairman:

N. Maslin

C. T. Wilson