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DECISIONS OF THE BOARDS OF APPEAL

**Decision of Technical Board of Appeal 3.2.1 dated
15 September 1999**

T 1028/96 - 3.2.1

(Language of the proceedings)

Composition of the board:

Chairman: F. Pröls

Members: M. Ceyte

J. van Moer

Patent proprietor/Appellant: E. I. Du Pont De Nemours and Company

Opponent/Respondent: Fa. Karl Thiel

Fabromont AG

Fa. Christian Heinrich Sandler GmbH & Co. KG

Headword: Suspected partiality/DU PONT DE NEMOURS

Article: 19(2), 24 EPC

Rule: 10 EPC

RPBA Art. 1(2), 2(1), 3(2)

Keyword: "Allegation of suspected partiality against chairman of the board of appeal" - "Competence of the board in its original composition, i.e. with the member objected to, to examine the admissibility of the objection of

suspected partiality for the purpose of opening the Article 24(4) procedure (yes)" - "Applicability of Article 24(1) where a member of the board in opposition appeal proceedings participated as such in the decision on the appeal against the refusal of the application by the examining division (no)" - "Applicability in such case of the ground of suspected partiality set out in Article 24(3) (yes, in certain circumstances)"

Headnote

I. In certain special circumstances members of a board of appeal in opposition appeal proceedings may be "suspected of partiality" as set out in Article 24(3) EPC if they participated as such in the decision on the appeal against the decision of the department of first instance to refuse the application in suit (see point 6.5 of the reasons).

II. The board in its original composition, ie with the member(s) objected to, is competent to examine the admissibility of an objection under Article 24(1) or (3) for the purpose of opening the procedure under Article 24(4) EPC (see point 1 of the reasons).

Summary of facts and submissions

I. European patent application No. 86 106 603.3 (publication number: 0 203 469) was refused by decision of the Examining Division.

The reason for the refusal was i.a. that the method of measuring cohesion described in the independent claims was unclear as the distance between the lowermost stationary rods and the bottom of the cylinder for the fiberfill was not specified.

II. On appeal, by decision T 519/91 of 19 June 1992, Board of Appeal 3.2.1 set aside the decision to refuse and remitted the case to the Examining Division with the order to grant a patent on the basis of an amended set of claims.

Independent claims 1 and 7 as granted are as follows:

"1. Refluffable fiberballs consisting essentially of entangled polyester fiberfill characterized in that the fiberfill is spirally crimped, and coated with a slickener and has a cut length of about 10 to about 60 mm, and is entangled randomly within the fiberballs, which have an average dimension of 1 to 15 mm with at least 50% by weight of the balls having a cross-section such that its maximum dimension is not more than twice its minimum dimension, the fiberballs having a cohesion measurement, as defined in the description under the corresponding heading, of less than 6 Newtons (N).

"7. Process for shaping polyester fiberfill into fiberballs that are suitable for transportation by air-blowing, involving separating the fiberfill into a plurality of discrete tufts that are tumbled on the interior cylindrical wall of a stationary cylindrical vessel with blades that rotate about an axial bladed shaft that is mounted horizontally, characterized in that the polyester fiberfill has a spiral crimp, has a cut length of about 10 to about 60 mm and has been slickened, and that the tufts are tumbled by air, that is stirred by the blades whereby the tufts are repeatedly turned and impacted by the air against the interior cylindrical wall so as to entangle the fibers and so as to condense and reshape the tufts into fiberballs of randomly entangled fibers having an average dimension of 1 to 15 mm, at least 50% by weight of the balls having a cross-section such that its maximum dimension is not more than twice its minimum dimension, and the fiberballs having a cohesion measurement, as defined in the description under the corresponding heading, of less than 6 Newtons (N)."

In order to meet the objection raised by the Examining Division with respect to the statement as to how the cohesion measurement is performed, the appellant (applicant) filed cohesion measurements made on a number of fiberball samples.

III. The patent was opposed by the opponents and an intervener (now called opponent 03) on the grounds of lack of patentability and insufficiency of disclosure.

In support of the second ground of opposition, they submitted that the patent in suit did not provide the skilled person with sufficient information as to how cohesion measurements are performed essentially because the distance of the pairs of horizontal rods with respect to the bottom of the cylinder for the fiberfill was not disclosed in the patent specification.

IV. By its decision posted on 28 October 1996, the Opposition Division revoked the European patent arguing that the claimed subject-matter was not inventive over the opposed prior art documents.

V. The appellant (patent proprietor) lodged an appeal against the decision on 21 November 1996 and paid the prescribed fee at the same time.

The statement of grounds of appeal was filed on 28 February 1997.

VI. The appeal was assigned to Technical Board of Appeal 3.2.1 on the basis of the business distribution scheme of the Boards of Appeal. The chairman of the above Board had participated as such in decision T 519/91 on the case in the proceedings for grant.

VII. Oral proceedings were held on 23 February 1999. In the course of the hearing the respondents I to III (opponents 01 to 03) requested that the chairman be excluded on the grounds set out in Article 24(1) EPC or for reasons of suspected partiality (Article 24(3) EPC).

The chairman adjourned the oral proceedings and after deliberation the Board came to the conclusion that the procedure under Article 24(4) EPC should be applied.

For the purpose of taking the Article 24(4) EPC decision, the chairman objected to was replaced by his alternate. In accordance with Article 3(2) of the Rules of Procedure of the Boards of Appeal (RPBA) an invitation was issued to the chairman objected to in order to give him the opportunity to present his comments as to whether there were any reasons for his exclusion.

With letter dated 10 March 1999, the chairman asserted essentially that despite the allegations of partiality he saw no objective reason to be excluded from taking part as a member of the Board in the further appeal proceedings.

VIII. With letters dated 17 July 1999 and 31 August 1999, respondents III and I respectively also raised an objection against the technically qualified member and the legally qualified member of the Board for the reason of "suspected partiality" mentioned in Article 24(3) EPC. The two members concerned each subsequently filed a declaration pursuant to Article 24(2) in which they considered that they should not take part in the decision on the possible exclusion of the original chairman.

The two members objected to were replaced by their alternates (Article 24(4) EPC).

IX. Fresh oral proceedings were held on 15 September 1999 before the Board in its present composition, where all the members of the former Board had been replaced by their alternates.

The respondents requested that the original chairman objected to be excluded from the pending appeal proceedings either on the grounds set out in Article 24(1) EPC or for reasons of "suspected partiality" as specified in Article 24(3) EPC.

Additionally they requested that a question be referred to the Enlarged Board of Appeal, if the request as to exclusion of the original chairman was to be rejected.

The appellant (patent proprietor) requested that the request as to the exclusion of the original chairman from the further appeal proceedings be rejected.

X. In support of their requests the respondents submitted *inter alia* the following comments in written and oral form:

(i) In respect of the exclusion of the original chairman, Article 24(1) in its German version provides that members of the Board of Appeal may not take part in a particular case if they participated in the final decision of the lower instance ("abschließende Entscheidung in der Vorinstanz"). The wording "Vorinstanz" is ambiguous and may be construed as including the decision taken by a Board of Appeal in the first stage i.e. the grant proceedings. Furthermore, this provision must be interpreted on the basis of its purpose, i.e. that the involvement of the chairman in a previous decision, such as a decision of the Board on the case in the grant proceedings would inevitably affect his approach to the case, because he would be inclined to decide in the same way as in the previous decision. Therefore, the chairman must be excluded in all cases whatever the previous decision may be, also in opposition proceedings before the Board if he was involved as chairman of the Board in the proceedings for grant.

This general prohibition as to the participation of members of a Board of Appeal who took part in a previous decision is clearly mentioned in Article 9(1) of the Community Patent Convention (CPC) as revised, Luxembourg, 15 December 1989. This provision makes no distinction between a decision in the proceedings for grant and a decision in the opposition proceedings.

Finally, the EPC did not expressly require that a member of a Board who participated in a decision on the case in the grant proceedings must be excluded from

participation as chairman of the Board on appeal in the subsequent opposition proceedings. This is in direct contrast with the provisions of Article 19(2) EPC which deals with the composition of an Opposition Division and includes such an exclusion, namely that "an examiner who has taken part in the proceedings for the grant of the European patent shall not be the chairman" (of the Opposition Division). Indeed this provision should apply all the more to the second-instance proceedings with the consequence that a member of the Board who participated in a decision on a case in the grant proceedings should not be appointed as chairman of the Board to decide on the case in the subsequent opposition proceedings.

(ii) The respondents also took the view that the original chairman should be excluded on the ground of "suspected partiality" as specified in Article 24(3) EPC:

- since the request based on Article 24(1) EPC did not necessarily lead to an apportionment of costs, the manner in which the chairman announced that respondent I had to bear the costs of the oral proceedings if they needed to be postponed was considered by the respondents as an attempt to threaten or intimidate them;

- in the view of the respondents, the chairman without any judicial necessity requested that the objection under Article 24(1) EPC be filed in writing and did not allow such an objection to be drafted during a break in the oral proceedings;

- the fact that the objection under Article 24(1) was left undecided after 40 minutes' deliberation was considered by the respondents as a further indication of apparent partiality of the chairman;

- finally, the participation of the chairman in the grant proceedings before the Board was also a plausible concrete ground for suspecting him of partiality or prejudgment, because as chairman of the Board in the subsequent opposition proceedings he was confronted with the same issue of insufficiency of disclosure (Article 83 EPC). In

particular, the chairman's preliminary remarks at the opening of the hearing as to the relevance of the evidence filed in this respect by the appellant was considered as an indication that the chairman would have difficulty in rehearing and deciding the case without having a preconceived or anticipatory judgment.

(iii) The respondents asserted that the request as to the exclusion of the original technical member and the original legal member applied not only to the decision to be taken on the possible exclusion of the chairman, but also to the further opposition proceedings on the case before the Board.

XI. The above submissions were contested by the appellant (patentee). It argued in essence that the term "decision under appeal" specified in Article 24(1) has to be taken in its clear literal sense as meaning what it says: the decision under appeal i.e. in the present case the decision of the Opposition Division in which obviously the original chairman objected to, did not participate.

In the present case the original chairman merely took part in the final decision to grant the patent, but not the original technical member and the original legal member. They have thus no preconceived or anticipatory judgment as to how the case should be decided. There are therefore no reasons to exclude them from the further appeal proceedings.

In order to take the decision on the possible exclusion of the original chairman, the present Board decided that the two members concerned should be replaced by their alternates. In the view of the appellant a deficiency arose from the fact that such decision was taken before the oral proceedings, so that the parties had no possibilities to comment i.a. on the declarations filed by the two members concerned pursuant to Article 24(2) EPC.

Reasons for the decision

1. Competence of Board 3.2.1 in its original composition

The respondents submitted that if an objection under Article 24, paragraph 1 or 3, EPC is made by a party, the Article 24(4) procedure automatically applies without it being necessary to consider whether this objection is admissible. Thus such objection should be examined by the Board without the participation of the member objected to who should be replaced by his alternate.

The present Board is unable to accept such reasoning:

Article 24(3), second sentence, EPC provides that "an objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step" and "No objection may be based upon the nationality of members". These provisions clearly require a preliminary examination for admissibility.

Generally speaking, in the EPC, the purpose of the preliminary examination for admissibility is to determine whether the objection may go forward for substantive examination and decision. If the objection is not admissible, the Board of Appeal may not examine whether it is allowable or well founded. In so far as the objections under Article 24 are concerned, the issue of admissibility is also a prerequisite for substantive examination but this prerequisite, if satisfied, only leads to the opening of the procedure defined in Article 24(4): the member objected to is replaced by his alternate and the Board in this new composition must decide on the admissibility and if need be on the allowability of the objections under Article 24.

Expressed in other words, the Board in its original composition must look at admissibility for the purpose of opening the procedure under Article 24(4). If, from the former Board's point of view, the objection is admissible, then the procedure under Article 24(4) applies. Thus, the issue of admissibility before the former Board is only relevant to the opening of the procedure under Article 24(4) and has no

bearing on the future decision of the further Board nominated in accordance with Article 24(4) EPC.

As suggested in decision T 289/91, OJ 1994, 649 (dealing with the admissibility of opposition), admissibility, which is a fundamental prerequisite for a decision on the substance, must be examined by the Board of its own motion (point 2.1 of the reasons). If the Board in its original composition had no power to examine admissibility and thus had to play a completely passive role, this would clearly be inconsistent with the procedural principle referred to above. Furthermore, the former Board is also a deciding instance. It would be incompatible with this to consider that the Board in question had no power to decide upon the opening of the Article 24(4) procedure, i.e. had no choice but to automatically apply such procedure.

Finally, if the Board of Appeal in its original composition were not entitled to examine admissibility, i.e. if there were no raised threshold over which a party must cross in order to have its objection examined by a further Board without the participation of the member objected to, this would clearly open possibilities of unduly delaying the opposition proceedings before the Boards of Appeal and burden the Boards of Appeal with the Article 24(4) procedure which would automatically apply as long as an objection of suspected partiality is raised. As emphasised in decision G 4/97, OJ EPO 1999, 270 - opposition on behalf of a third party/GENENTECH - opposition should be a simple speedily conducted procedure in which, on the one hand, relevant objections to patentability are given appropriate consideration, and on the other hand, a decision on the validity of the patent is reached as quickly as possible, in the interests of the parties as well as the public interest (see point 3.2.3 of the reasons).

Therefore, in the present case it lay within the competence of the Board in its original composition i.e. with the participation of the chairman objected to, to consider the admissibility of the objections under Article 24, paragraphs 1 and 3, EPC for the purpose of opening the procedure under Article 24(4) EPC.

2. Formal conditions for admissibility

It is true that Article 24(3) EPC prescribes only two conditions for admissibility ("An objection shall not be admissible if, while being aware of a reason for objection, the party has taken a procedural step" and "No objection may be based upon the nationality of members") so that the above threshold could easily be crossed over by a party calling the composition of the Board into question. However, even if it is not expressly stated in Article 24(3), the EPC requires, as a general rule, that objections be reasoned, i.e. indicates facts and arguments which are alleged to support such objection. From this requirement it follows, firstly, that an objection based on purely subjective unreasonable doubts which exist only in the mind of the objecting party should be rejected as inadmissible. It also follows that if facts and arguments filed cannot support the objection of suspected partiality raised, the objection is likewise inadmissible. Thus the threshold to be crossed over by a party calling the composition of the Board into question also comprises this formal precondition.

3. Competence of the Board in its present composition to examine and decide on the objections under Article 24, paragraphs 1 and 3, EPC raised against the original chairman

With letters dated 17 July 1999 and 31 August 1999 respondents III and II respectively also raised an objection on the ground of suspected partiality against the original technical member and the original legal member of the Board.

Article 24(2) EPC provides that either for one of the reasons mentioned in its paragraph 1, or for any other reason a member of a Board may inform the Board that he should not take part in a particular case. Accordingly the two members objected to filed a declaration in which they considered that they should not take part in the decision on the requested exclusion of the original chairman from the further appeal proceedings.

In such circumstances the procedure of Article 24(4) was applied: the remaining chairman of the Board (i.e. the alternate of the original chairman objected to) designated in accordance with Article 1(2) RPBA the alternates of the two members objected to, then the present Board in this new composition decided that the two members objected to should not take part in the decision on the possible exclusion of the original chairman.

Since the original technical member and the original legal member recused themselves, the Article 24(4) decision of the present Board to exclude them is believed to be a purely internal decision which may be taken without i.a. the parties' observations on the declarations pursuant to Article 24(2) EPC. It is observed that "No formal procedure is prescribed by the EPC in relation to the making of such a decision and no formal decision, is in practice issued" (see Paterson, *The European Patent System*, London 1992, paragraph 2-20).

Therefore, the Board in its present composition, in which all the members of the former Board are replaced by their alternates, concludes that it is entitled to examine and decide on the objections under Article 24, paragraphs 1 and 3, EPC raised against the original chairman.

4. Admissibility of the objections under Article 24, paragraphs 1 and 3, EPC

4.1 Before considering the issue of admissibility it is necessary to give some details of the procedure for designating the members of a Board.

The membership of the individual Boards of Appeal is designated in accordance with a business distribution scheme which is drawn up pursuant to Rule 10(1) EPC and which is published in the first issue of the Official Journal. In that case the relevant issue was OJ EPO 1996, 86.

In the proceedings for grant or opposition proceedings the individual appeals are assigned to specific technical Boards of Appeal according to the classification of the technical subject-matter of the application or patent concerned. In accordance with Article 1(2) RPBA and Article 3(1) of the business distribution, the chairman of each Board designates the members of the Board who are responsible for the examination of each appeal assigned to his Board when it is received by the Registry of the Boards of Appeal. This however does not necessarily mean that the chairman hearing the appeal must be the chairman of that particular Board, since the chairman in question may be replaced by his alternate "for reasons including sickness, excessive workload and commitments which cannot be avoided" (Article 2(1) RPBA).

On 21 November 1996, the appellant (patent proprietor) lodged an appeal against the decision of the Opposition Division to revoke the European patent. The notice of appeal was communicated to the respondents by a communication dated 2 December 1996, in which it was stated that the technical Board 3.2.1 was responsible for this appeal.

In accordance with the current practice of the Boards of Appeal the parties were first informed of the actual composition of the Board at the time when the summons to oral proceedings were issued (15 May 1998). In the view of the present Board, it cannot be demanded of a party that it requests inspection of the appeal file for the purpose of finding out the actual composition of the Board.

4.2 As to the possible time at which the objections under Article 24 EPC could be raised, the following is to be observed:

Respondents I and II filed observations in response to the communication of the Board pursuant to Article 11(2) RPBA which was issued together with the summons to oral proceedings, and thus, as parties to the appeal proceedings, performed a procedural act or step as mentioned in Article 24(3) within the period of time

between the summons to oral proceedings and the oral proceedings held on 23 February 1999.

In the course of the hearing, the respondents I to III requested that the original chairman of the Board be excluded from the further appeal on the grounds set out in Article 24(1) EPC or on the ground that the chairman concerned is "suspected of partiality" as specified in Article 24(3) EPC.

Therefore the objections raised were twofold: firstly an Article 24(1) EPC objection based on the previous involvement of the chairman concerned in the Board which took the decision to grant the patent in suit and secondly an Article 24(3) EPC objection which was raised on the ground of the alleged negative reaction of the chairman concerned vis-à-vis the first Article 24(1) EPC objection. In particular the chairman's announcement that respondent I had to bear the costs of the oral proceedings if they should be postponed as a result of the Article 24(1) objection was considered by the respondents as an attempt to threaten or discourage them from raising such objection.

The Article 24(3) objection was thus a direct consequence of the events arising during the hearing, i.e. the preliminary remarks of the chairman and his attitude in relation to the first Article 24(1) objection. This logically means that before the oral proceedings the respondents could not be aware of the reason for objection under Article 24(3). It was only during the oral proceedings that the respondents immediately reacted to the above events by raising the second Article 24(3) objection.

From the above it follows that the requirement of Article 24(3), second sentence, EPC that an objection on the ground of suspected partiality is admissible if the party, while being aware of the reason for objection, has not yet taken a procedural step, is in the present case complied with.

4.3 As to the indication of facts and arguments

As has already been explained, the Article 24(3) objection was based on the preliminary remarks and the alleged negative attitude of the original chairman vis-à-vis the first Article 24(1) objection. This means that the Article 24(3) objection is also indirectly supported by the sole ground of the Article 24(1) objection, i.e. the involvement of the original chairman in the Board which took the decision to grant the patent in suit.

From the foregoing and having regard to the facts and arguments specified in point X(ii) supra, the present Board is satisfied that the second objection under Article 24(3) has been clearly presented and sufficiently reasoned: it is not only supported by purely subjective, unreasonable doubts; it relies upon an undisputed objective reason which is clearly relevant or connected to the objection raised under Article 24(3), that is the involvement of the original chairman in the Board which took the decision to grant the patent in suit.

4.4 Therefore, in the Board's judgment, the objection under Article 24(3) EPC is admissible.

If as in the case the objection under Article 24(3) of the respondents' request is admissible, the admissibility applies also to the whole content of the respondents' request, i.e. to the first objection under Article 24(1) based on the sole ground that the original chairman concerned participated in the Board which took the decision to grant the patent.

5. Allowability of the objection under Article 24(1) EPC

The respondents have drawn attention to the use of the expression "an deren abschließender Entscheidung in der Vorinstanz" in the German text of Article 24(1) EPC which was said to be ambiguous. However the expressions "decision under

appeal" and "décision qui fait l'objet du recours" in the English and French texts respectively of Article 24(1) are clearly unambiguous.

The Board therefore relies upon the unambiguous, literal sense of the term "decision under appeal" which means what it says, that is in the present case the decision of the Opposition Division to revoke the patent in suit. The original chairman was obviously not a member of this Opposition Division.

The respondents further rely upon the corresponding Article 9(1) of the Community Patent Convention (CPC), not yet in force, which states the following:

"1. Members of the Revocation Divisions may not take part in any proceedings ... or if they have participated in the final decisions on the case in the proceedings for grant or opposition proceedings."

It cannot be disputed that the wording of Article 9(1) CPC is broader than "decision under appeal" of Article 24(1) EPC, since e.g. in the case of an appeal in opposition proceedings, a member of the Board who has participated in "a final decision in the proceedings for grant" is in accordance with Article 9(1) CPC to be excluded.

Obviously the use of "final decision in the case in the proceedings for grant or opposition proceedings" in Article 9(1) CPC gives no cause to understand also the more restrictive wording "decision under appeal" of Article 24(1) EPC as meaning the same. It can only be concluded that when the legislator wished to distinguish between "decision under appeal" and "final decision in the proceedings for grant or opposition proceedings" it did so. Furthermore, by contrast to the CPC, there are no provisions in the EPC allowing an appeal to be filed against "a final decision in the opposition proceedings" as stipulated in Article 9(1) CPC.

Therefore, in the Board's judgment, the objection under Article 24(1) EPC is not well founded and is therefore rejected.

6. Allowability of the objection under Article 24(3) EPC

The question which arises is whether a member of a Technical Board of Appeal in opposition proceedings may be "suspected of partiality" if he participated in the previous Board's decision to set aside the refusal decision of the Examining Division and to grant the patent in suit.

6.1 The present Board agrees with the view held in decision T 261/88, OJ 1992, 627, that disqualifying partiality presumes a preconceived attitude on the part of a member of a Board of Appeal. More precisely, in the present Board's view a member of a Board may be "suspected of partiality" as specified in Article 24(3) EPC if the member in question may have a preconceived or anticipatory judgment as to how the case should be decided. Such preconceived or anticipatory judgment which could affect the member's approach to the case may result in certain special situations from the participation of said member in a previous decision on the case. In truth this prejudiced prejudgment may result from the laudable desire of the member to be logical and coherent in his successive decisions. Addressing this risk of prejudice, the EPC legislator has decided that a member of the Board of Appeal may not take part in any appeal if he participated in the decision under appeal (Article 24(1) EPC).

As pointed out, the Community Patent Convention, in its Article 9(1), even goes further and extends the exclusion to the participation "in the final decision on the case in the proceedings for grant or opposition proceedings."

Thus, there is under the EPC in respect of the previous participation of a member in the decision to grant the patent no absolute prohibition contrary to the Community Patent Convention. However, the general requirement of Article 24(3) EPC that a member of the Board should not be suspected of partiality also applies to the case to be decided and is to be dealt with according to the principle laid down in decision G 5/91 of the Enlarged Board of Appeal (OJ EPO 1992, 617 - Appealable

decision/Discovision). According to this decision, the issue of suspected partiality can only be decided upon "in the light of the particular circumstances of each individual case...such considerations involve factual questions of degree rather than points of law" (see point 6 of the reasons). Furthermore, as suggested in the above decision of the Enlarged Board, the issue to be dealt with in such a case is not that of whether the member of the Board objected to was in fact partial, what is decisive is solely whether objective or reasonable reasons exist to suspect a member of partiality (see point 3 of the reasons).

6.2 The appellant correctly points out that Article 24 EPC gives no precise indication in the case of a previous participation of a Board's member in the decision to grant the patent.

In the Board's view the involvement of a member in an earlier decision to grant the patent may not give rise to suspected anticipatory or preconceived judgment on the part of the member concerned if e.g. the Examining Division refused the patent application on the ground of added subject-matter (Article 123(2) EPC) and if in the subsequent opposition proceedings and on appeal therefrom an opponent only alleged a lack of inventive step. In such case, it appears reasonable to suppose that the member of the Board who participated in the former decision would be unprejudiced or impartial and could thus decide without being tainted by his previous judgment.

In contrast there could be special situations where a member of a Board in opposition proceedings has to decide upon a crucial issue which was in essence already decided in the grant proceedings before the former Board comprising the member in question. Therefore, in the context of that particular case, it is necessary to investigate whether the original chairman of the Board in the opposition proceedings was confronted with, in the view of this Board, critical issues for the assessment of inventive step or sufficiency of disclosure which are in essence the same as, or comparable with those examined and decided in the proceedings for

grant. If this is the case, the original chairman concerned may have an anticipatory judgment as to how the case in the opposition appeal proceedings should be decided and should thus be disqualified on account of suspected partiality.

6.3 As already stated, in the grant proceedings the patent application was refused by a decision of the Examining Division. The reason for the refusal was i.a. that the method of measuring the cohesion was unclear, since the distance between the lowermost stationary rods and the bottom of the cylinder for the fiberfill was not disclosed.

In order to meet the objections of the Examining Division as to how the cohesion measurement is performed the appellant contracted an independent research institute to perform cohesion measurements on a number of fiberball samples provided by him, the institute being given no other information than was contained in the patent application i.e. without the distance in question. The institute duly built a test apparatus and performed the measurements, the results of which correlate, within the experimental error to be expected in the circumstances, with the results obtained by the appellant (applicant). After it had produced its results the institute was then asked to comment on the specific objection raised by the Examining Division. With respect to the spacing of the lowermost pair of rods from the bottom of the cylinder it was indicated that this was more or less determined by a combination of the other factors given, in particular the length of the pulling rectangle, the vertical spacing between pairs of rods and the length of the column of fiberballs once this has been compressed (see decision T 519/91 supra, point 3.2 of the reasons).

The former Board of Appeal in grant proceedings (whose chairman was the original chairman objected to) found the evidence presented by the Appellant (applicant) "convincing" (see T 519/91, supra, point 3.2 of the reasons).

6.4 In the subsequent opposition proceedings before the Opposition Division, the opponents submitted in support of the ground of insufficiency of disclosure

(Article 83 EPC) that the patent in suit did not provide the skilled person with sufficient information as to how the cohesion measurement is performed, essentially because the distance between the bottom and the lowermost stationary rods in the apparatus was not disclosed. They provided evidence allegedly showing that a variation of the distance in question leads to large discrepancies in the measured values.

In its decision of revocation, the Opposition Division came to the conclusion that the claimed invention was not inventive over the opposed prior art documents. However it held that the claimed invention met the requirements of Article 83 EPC. Reference was made to former decision T 519/91 of Board 3.2.1 stating that the cohesion measurement is disclosed in a manner sufficiently clear for it to be carried out by a skilled person. The Opposition Division saw no reason to deviate from that view.

On appeal in opposition proceedings, the respondents challenged the patentability of the claimed invention and reiterated their submissions as to the insufficiency of disclosure (Article 83 EPC). In their view the former decision T 519/91 in the grant proceedings has no binding effect in the present appeal in opposition proceedings. Attention was drawn to decision T 167/93, OJ EPO 1997, 229. Here it was decided that a decision of a Board on appeal from an Examining Division has no binding effect in subsequent opposition proceedings or on appeal therefrom since the principle of *res judicata* does not apply in such a case.

In the communication of the Board pursuant to Article 11(2) RPBA which was sent with the summons to oral proceedings, it was i.a. stated that when considering the issue of inventive step the cohesion measurement was apparently the most important aspect of the patent in suit.

6.5 From the foregoing it is apparent that the Board in opposition proceedings, comprising the original chairman objected to, had to decide upon, in the view of this Board, a crucial issue which was already decided in the grant proceedings by the

former Board having the same chairman, that is whether the description and the drawings provide the skilled person with sufficient information as to how the cohesion measurement is performed and more precisely whether the skilled person when reading the description and the drawings was in a position to perform the cohesion measurement without any indication about the spacing of the lowermost pair of rods from the bottom of the cylinder. Expressed in other words the original chairman objected to in the opposition proceedings before the Board was in this special situation compelled to confirm or not his previous own judgment. It is precisely the situation the legislator wished to avoid by excluding a member of a Board who has participated in the decision under appeal so as to guarantee the impartiality and objectivity of members of the Boards, cf Article 24(1) EPC or Article 9(1) CPC.

Thus in the present Board's judgment the respondents had reasonable grounds to believe that the same chairman could have difficulty in re-examining and deciding the case without having a preconceived or anticipatory judgment.

For these reasons, the present Board concludes that the objection under Article 24(3) EPC should be allowed.

It should be stressed that the facts of the case are very particular. The critical elements are (i) that the original chairman objected to was chairman in the decision of the former Board in the proceedings for grant, (ii) as chairman of the Board in the subsequent opposition proceedings he was confronted with substantially the same crucial issue for the assessment of sufficiency of disclosure (Article 83 EPC).

6.6 Article 19(2) EPC requires i.a. that an examiner who has taken part in the proceedings for the grant of the European patent shall not be the chairman of the Opposition Division. The Board does have some sympathy for the respondents' argument that, in the circumstances set out above, such prohibition should apply all the more to the second instance in view of its judicial function at supreme level within

the European patent system. As has already been explained this fact was one of the critical elements which led the present Board to the conclusion that the objection under Article 24(3) EPC should be allowed.

7. Finally, since the present Board comes to the conclusion that the original chairman is to be excluded on the ground of suspected partiality, essentially because he participated in the decision of the former Board to grant the patent in suit, it may be left undecided whether his alleged attitude in the course of the oral proceedings might give rise to a further well-founded objection under Article 24(3) EPC.

8. As to the exclusion of the original technical member and the original legal member from the further opposition proceedings on the case before the Board, the following is to be observed:

The appellant is correct when it states that the exclusion of the two members in question as stated in the present Board's communication of 8 September 1999 applied only to the proceedings on the possible exclusion of the original chairman.

However, the two members recused themselves and the legal member made it clear in his declaration that he was resolutely opposed to taking part as a member of the Board in the further appeal proceedings. The present Board finds the reasoning given therein convincing.

Furthermore, a decision of a Board in the further opposition proceedings, in which two members are present who were previously excluded from a part of the proceedings on account of suspected partiality may also give rise to an understandable apprehension or suspicion on the part of the public that the Board in such composition was not impartial. As a matter of principle an impartial judgment must not only be done; it must also be seen to be done.

Therefore in the present Board's judgment, the exclusion of the original technical member and of the original legal member of the Board also applies to the opposition appeal proceedings on the case before the Board.

Order

For these reasons it is decided that:

1. The original chairman of the Board is excluded from taking part in the further opposition appeal proceedings on the case.
2. The exclusion of the original technical member and of the original legal member of the Board also applies to the further opposition appeal proceedings on the case.