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D E C I S I O N
of 12 July 2001

Case Number: T 0291/99 - 3.2.6

Application Number: 92905163.9

Publication Number: 0521143

IPC: A61F 13/00

Language of the proceedings: EN

Title of invention:
Burn dressing with tea tree oil

Patentee:
Water-Jel Technologies, LLC

Opponent:
Levtrade International (Pty) Limited

Headword:
Indication of the facts, evidence and arguments with notice of
opposition/LEVTRADE INTERNATIONAL

Relevant legal provisions:
EPC Art. 101(1)
EPC R. 56(1), 55(c)

Keyword:
"Examination of opposition - admissibility (no)"

Decisions cited:
T 0538/89, T 0522/94, T 0328/87, T 0582/95; T 0222/85

Catchword:
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Case Number: T 0291/99 - 3.2.6

D E C I S I O N
of the Technical Board of Appeal 3.2.6
of 12 July 2001

Appellant: Levtrade International (Pty) Limited
(Opponent) 3 Skietlood Street
Isando 1600 (SA)

Representative: Ablewhite, Alan James
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57-60 Lincoln's Inn Fields
London WC2A 3LS (GB)

Respondent: Water-Jel Technologies, LLC
(Proprietor of the patent) 243 Veterans Boulevard
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New Jersey 07072 (US)

Representative: Keil & Schaafhausen
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Decision under appeal: Decision of the Opposition Division of the
European Patent Office posted 14 January 1999
rejecting as inadmissible the notice of
opposition filed against European patent
No. 0 521 143 pursuant to Rule 56(1) EPC.

Composition of the Board:

Chairman: P. Alting van Geusau
Members: H. Meinders
M. Tardo-Dino

Summary of Facts and Submissions

I. European patent No. 0 521 143 based on the PCT application US 92/00428 was granted on 2 April 1997. By a decision dated 14 January 1999 the Opposition Division declared inadmissible the opposition filed by the Appellant as opponent against this patent on 31 December 1997.

Independent claims 1 and 9 as granted related to a burn dressing product and claims 10 and 11 to a method of preparing the burn dressing product of claims 1 and 9, respectively.

II. The Appellant based its opposition solely on lack of novelty and lack of inventive step of the claimed product and the claimed method of preparing the product in respect of a product called the "Burnshield" burn dressing and of a substantially identical Australian product.

The Opposition Division considered that the opposition did not contain a sufficiently specific and clear indication of the date and location of the alleged sale, nor of the actual subject of that sale, nor of the actual composition of the sold "Burnshield" product. In particular, no proof for the allegations had been submitted, nor was it indicated which facts the evidence mentioned was intended to prove.

III. The Appellant filed an appeal against this decision and paid the appeal fee on 12 March 1999. The statement of grounds of appeal was filed on 18 May 1999.

He requested that the decision of the Opposition

Division be set aside, that the Opposition be declared admissible, that as a consequence the case should be remitted to the Opposition Division for further examination of its merits and that the appeal fee should be reimbursed on the grounds of gross procedural errors on the part of the Opposition Division. Provisionally oral proceedings were requested.

The Respondent replied to the appeal on 4 February 2000, requesting rejection of the appeal.

The Board summoned the parties to oral proceedings on 23 January 2001 and sent with the summons a communication to the parties according to Article 11(2) of the Rules of Procedure of the Boards of Appeal, setting out its preliminary opinion that the opposition appeared to be inadmissible for insufficient indication of the facts, evidence and arguments related to the prior sale (Rule 55(c) EPC).

With letter of 8 January 2001 the representative of the Appellant notified the EPO that his client did not wish to be represented at the oral proceedings. No comments were raised on the position taken by the Board. Thereupon the oral proceedings were cancelled by the Board.

IV. The Appellant's arguments can be summarised as follows:

For compliance with the requirements of Rule 55(c) EPC the notice of opposition need only contain a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an **indication** of the facts, evidence and arguments presented in support of these grounds. In its

opinion the notice of opposition clearly provided sufficient indication of the facts, evidence and arguments.

The notice of opposition itself stated that the "Burnshield" product in question had been sold since the 1980's by the company Levtrade International and its predecessors in title in South Africa and subsequently in Europe, Antarctica, the USA, India and South East Asia. A substantially identical product originating from Australia had been exploited commercially concurrently with the "Burnshield" product prior to 1990. The specific composition and the method of preparing of the "Burnshield" product had been set out as well.

Annexed to the notice of opposition were two copies of "Burnshield" product labels and a copy of a certificate of registration of the "Burnshield/Brandskerm" trade mark. Form 2300 used for the notice of opposition mentioned "Other evidence will be filed at a later date. Evidence of identity of Burnshield product and Australian product and proofs of sale."

The notice of opposition further contained an indication of the evidence which the Appellant requested to be allowed to file after expiry of the opposition period:

- "(i) An affidavit by a duly authorised person of the company Levtrade International (Pty) Limited with regard to its Burnshield product;
- (ii) Technical reports regarding the Burnshield product from internationally recognised research

laboratories;

(iii) Proof of prior sales constituting prior use of the invention as claimed in the claims of the above European patent.

(iv) Samples of the Burnshield product"

V. The Respondent argued that the notice of opposition did not fulfil the requirement of substantiation in respect of the object, the date as well as the circumstances of the alleged prior sale. The indication of the evidence to be supplied subsequently was not specific enough to enable the Patentee and the Opposition Division to examine the alleged ground for revocation without having recourse to independent inquiries. Therefore it also could not help in rendering the opposition admissible.

Reasons for the Decision

1. The appeal is admissible

2. *Request for oral proceedings*

2.1 The Appellant, with the statement of the grounds of appeal, had requested oral proceedings. In his letter of 8 January 2001 the representative of the Appellant notified the Board that the Appellant did not wish to be represented at the oral proceedings set for 23 January 2001 and that it stood by the written submissions previously provided.

2.2 The Appellant, Levtrade International (Pty) Limited, is

a legal person with its principal place of business within the territory of South Africa, which is not one of the contracting states to the EPC. According to Article 133(2) EPC the Appellant therefore should be represented by a professional representative in all proceedings.

- 2.3 Under these circumstances the Appellant cannot act on its own in oral proceedings and the Board therefore concludes that the letter of the Appellant of 8 January 2001 is effectively a withdrawal of the auxiliary request for oral proceedings.

3. *Admissibility of the opposition*

- 3.1 One prerequisite for an opposition to be admissible is that at least for one ground of opposition there is an indication of the facts, evidence and arguments presented in support of that ground (Rule 55(c) EPC).

According to the established case law of the Boards of Appeal in case of prior public use the requirements of Rule 55(c) EPC will only be satisfied if there is **sufficient** indication of the **relevant** facts, evidence and arguments so that the Opposition Division (and the patent proprietor) are able to properly understand the reasoning and the merits of the Opponent's case in relation to the grounds of opposition (see T 222/85, OJ 1988, 128). The Opposition Division should be able to determine the following details of the prior use:

what was made available to the public **when** and under **which circumstances** (see e.g. T 328/87, OJ 1992, 701 and T 522/94, OJ 1998, 421).

3.2 In its communication the Board had expressed its opinion that for the **circumstances** under which the prior sale allegedly took place there was no sufficient indication of the relevant facts, evidence and arguments.

3.3 The circumstances of a sale of a product involve the questions: who sold the product to whom, where and under which conditions. The consistent practice of the Boards of Appeal regarding prior use by sale of a product is that a single sale suffices for public availability of the product sold, provided that the recipient of the product was not bound by confidentiality. Thus, if prior sale of a product is alleged to have taken place, an indication of the absence of confidentiality must be given as well, or circumstances must be apparent from which it can be concluded that confidentiality is not an issue.

3.4 The notice of opposition does not mention **which parties** were involved in the alleged sales and under which circumstances the latter took place. The annexed copies of the product labels are not related to any particular sale, therefore do not provide further information on this question. The same applies to the annexed copy of the certificate of registration of the "Burnshield/Brandskerm" trademark. The question of **confidentiality** is nowhere addressed.

3.5 The Appellant pointed out that the notice of opposition further contained the indication that (only the passages possibly relating to the question of the circumstances of the alleged sale are repeated here):

"(i) An affidavit by a duly authorised person of the

company Levtrade International (Pty) Limited
with regard to its Burnshield product;

(ii)

(iii) proof of prior sales constituting prior use of
the invention as claimed in the claims of the
above European patent

(iv)"

would be filed later, after expiry of the opposition
period, with the approval of the Opposition Division.

The Appellant cited decision T 538/89 (not published)
in support of his contention that the material supplied
and the evidence indicated was sufficiently
comprehensible for the skilled person to allow an
examination of the substantive merits of the opposition
to be initiated.

3.6 However, the circumstances governing the case of
T 538/89 differ from those of the present case in that
a specific witness was named for the date and place of
prior use and that specific evidence in the form of
drawings and a spare parts list were provided, which
directly related to the subject of the prior use and
the circumstances of its availability to the public.

In the present case it is not even clear from the above
listing whether the affidavit relates to the prior sale
of the Burnshield product at all, nor which person is
providing the affidavit, nor which facts will be
discussed therein. In relation to the prior sale the
listing does not mention which specific means of

evidence (invoices, bills, names and addresses of buyers or retailers) would be submitted on request of the Opposition Division (see in this respect T 328/87, OJ 1992, 701, point 3.3.3 of the reasons).

The less facts that are given in the notice of opposition about the circumstances of a prior use, the more specific the indication of further evidence has to be to avoid the conclusion that the prior use is based on a mere **allegation**.

In the Board's judgment the notice of opposition and its annexes therefore do not sufficiently specify the evidence to be provided nor the facts this evidence is purported to prove in relation to the **circumstances** of the prior sale so as to fulfil the requirements of Rule 55(c) EPC.

- 3.7 Since the circumstances of the alleged sale of a "substantially" identical Australian product have been discussed in the notice of opposition to an even lesser extent than those for the "Burnshield" product, that alleged prior use lacks sufficient indication within the meaning of Rule 55(c) EPC as well.

The same applies to the method of preparing the "Burnshield" product allegedly carried out by the Opponent. The notice of opposition does not contain any indication of facts or evidence regarding the circumstances under which this method might have been made available to the public.

- 3.8 The Appellant argued that it was unrealistic of the Opposition Division to require precise details of the nature of the confirmatory evidence. If such precise

details had been available at the time of filing the opposition, the relevant evidence would have been filed with the opposition. In fact the Appellant had very little time to prepare the opposition and had provided the information it had to the best of its knowledge and had offered further evidence upon invitation of the Opposition Division.

The Board considers that the period for opposition (9 months) provides ample opportunity for competitors to review the patents granted in their technical field, for collecting the necessary information and for building a reasoned case against a patent which one considers should not have been granted. It is up to the Opponent to decide when the notice of opposition is filed, that does, however, not alter the fact that at the expiry of the period for opposition the indication of facts, evidence and arguments should fulfil the requirements of Rule 55(c) EPC.

4. *Procedural matters*

- 4.1 The Appellant further contended that the Opposition Division should have invited the Appellant to furnish the evidence it had referred to.

The notice of opposition must fulfil the requirements of Rule 55(c) EPC at the expiry of the nine-month time-limit for opposition; the Opposition Division is not required to notify deficiencies in this respect to the Opponent (Rule 56(1) EPC).

In fact, the time limit for filing the opposition expired on 2 January 1998. The notice of opposition was filed by fax on 31 December 1997. Even if the

Opposition Division would have wished to notify the Appellant of the deficiencies, it could not have done so before expiry of the opposition period, due to the fact that on 31 December (New Year's Eve) and 1 January (New Year's Day) the EPO is closed.

- 4.2 It is the consistent case law of the Boards of Appeal that the documents or other means constituting the evidence relating to an opposition may be filed subsequently, after expiry of the period for opposition (see T 538/89, point 2.6 of the reasons). However, that can only count for an opposition that is admissible, i.e. one in support of which the facts, evidence and arguments are sufficiently indicated within the opposition period in accordance with Rule 55(c) EPC.

As the Opposition Division correctly considered the notice of opposition deficient in respect of the facts and evidence relating to the circumstances of the prior use, there was no reason to invite the Appellant pursuant to Rule 59 EPC to file the evidence subsequently, within a time limit set by the EPO, either. This is all the more so when the notice of opposition does not specify what actually constitutes the relevant evidence. Inviting the Opponent, after expiry of the opposition period, to file such material would be equivalent to starting up independent enquiries by the Opposition Division itself, and in effect would prolong the period of opposition beyond the 9-month limit, to the detriment of the patent proprietor.

- 4.3 The Appellant also argued that the Opposition Division had issued the decision ruling the opposition inadmissible, without seeking the views of the

Appellant.

Insofar as this amounts to an objection that the requirements of Article 113(1) EPC (the right to be heard) are not fulfilled, the Board comes to the following conclusion:

The Respondent replied to the opposition on 16 June 1998, questioning explicitly its admissibility for lack of substantiation. This was communicated by the EPO to the Appellant on 10 August 1998. The 5 months that elapsed between this communication and the issue of the contested decision, which was based on the same reasoning as produced by the Respondent, gave the Appellant ample opportunity to present its comments.

The requirements of Article 113(1) EPC are thus also fulfilled (see T 582/95, not published).

5. Summarizing, the Board comes to the conclusion that at the expiry of the opposition period the notice of opposition was deficient in respect of the indication of facts and evidence relating to the circumstances of the prior sale. The Opposition Division therefore acted correctly in finding the opposition deficient as regards the requirements of Rule 55(c) EPC. The notice of opposition is therefore inadmissible (Rule 56(1) EPC).

6. *Request for reimbursement of the appeal fee*

6.1 The Appellant argued that the Opposition Division was wrong both in fact and in law when finding the opposition inadmissible, it had committed gross procedural errors and therefore it would be equitable

to reimburse the appeal fee.

6.2 It is a condition for reimbursement of the appeal fee that the appeal be allowed (Rule 67 EPC). However, that is not possible for the reasons pointed out above.

6.3 Further, as indicated above, the decision need not be set aside for a substantial procedural violation on the part of the Opposition Division such as not observing the right to be heard (Article 113(1) EPC) or not abiding by the Rules of the Implementing Regulations, such as Rule 59 EPC.

The issues involved in the present case of admissibility are basically related to questions of judging and evaluating the facts (see point II and points 3.1 to 3.7) rather than being of a procedural nature.

Order

For these reasons it is decided that:

1. The appeal is dismissed
2. The request for reimbursement of the appeal fee is refused.

The Registrar:

The Chairman:

M. Patin

P. Alting van Geusau