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**D E C I S I O N
of 18 November 2004**

Case Number: T 0318/01 - 3.4.2

Application Number: 93301783.2

Publication Number: 0560579

IPC: H01M 2/02

Language of the proceedings: EN

Title of invention:

Mercury free miniature zinc-air cells

Patentee:

EVEREADY BATTERY COMPANY, INC.

Opponent:

VARTA Microbattery GmbH

Headword:

-

Relevant legal provisions:

EPC Art. 102(3), 111(1), 113(1), 113(2)

RPBA Art. 10

EPC Rule 58(4), 67, 68(1), 68(2)

Keyword:

"Series of fundamental procedural deficiencies resulting in unclear legal and factual framework of the case on appeal - remittal for further prosecution (yes) - substantial procedural violations - reimbursement of appeal fee (yes)"

Decisions cited:

G 0009/91, G 0010/91, G 0009/92, G 0004/93, T 0737/92,
T 0648/96, T 0425/97, T 0899/98, T 0740/00

Catchword:

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Case Number: T 0318/01 - 3.4.2

D E C I S I O N
of the Technical Board of Appeal 3.4.2
of 18 November 2004

Appellant:
(Opponent)

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Representative:

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Respondent:
(Proprietor of the patent)

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Representative:

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Decision under appeal:

**Interlocutory decision of the Opposition
Division of the European Patent Office posted
18 January 2001 concerning maintenance of
European patent No. 0560579 in amended form.**

Composition of the Board:

Chairman: A. G. Klein
Members: F. J. Narganes-Quijano
C. Rennie-Smith

Summary of Facts and Submissions

- I. European patent No. 0 560 579 was granted on the basis of a set of claims 1 to 22 in response to European patent application No. 93 301 783.2.

Notice of opposition was filed by "VARTA Battery Aktiengesellschaft", requesting revocation of the patent in its entirety on the grounds of lack of inventive step (Article 100(a) together with Articles 52(1) and 56 EPC).

- II. According to the cover pages (EP0 Form 2309) of the minutes of the oral proceedings held on 17 November 2000 before the opposition division, after deliberation the chairman announced the following decision: "Account being taken of the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates are found to meet the requirements of the European Patent Convention. The currently valid documents are those according to the auxiliary request."

According to point 5 of the text of the minutes "the opposition division allowed the auxiliary request (Annex II to the minutes)".

Annex II enclosed with the minutes includes amended description pages 2 to 5 and a set of amended claims 1 to 20, claim 1 being directed to a mercury free, alkaline miniature zinc-air cell and independent claims 14 and 20 being worded as follows - including expressions deleted by hand, and handwritten insertions shown underlined:

"14. A process for the manufacture of an anode cup (22) suitable for use in a cell as defined in claim 1, which process comprises deposition of a layer of copper ~~or an alloy containing copper~~, to form an underlayer (33), onto one surface of a conductive substrate (37), application by electroplating of indium (34) onto at least a portion of said underlayer (33), and forming the coated material into a cup-shaped body, such that the coated portion is on the inside of the cup-shaped body."

"20. A mercury free zinc-air cell employing a manganese dioxide-containing cathode (14) and a zinc-containing anode (26) ~~containing less than 6 % by weight of mercury~~ assembled within a conductive housing comprising a cathode cup (2) having at least one opening (8) to permit air to enter and said cathode cup (2) being electrically contacted to the manganese dioxide containing electrode (14); an anode cup (22) electrically and physically contacted to the zinc-containing electrode (26); said cathode cup (2) secured to and insulated from the anode cup (22); and said anode cup (22) comprising a conductive substrate (37) having on a portion of at least the inner surface contacted to the zinc-containing electrode (26) an underlayer (33) of copper and a top layer (34) of indium."

III. According to the cover pages (EP0 Form 2327) of the notification in writing dated 18 January 2001 of the interlocutory decision of the opposition division, the documents for the maintenance of the patent as amended include, among others, description pages 2 to 5 and

claims 1 to 20 filed "during oral proceeding on 17.11.2000". The second cover page listed, among other enclosures, "Auxiliary request (Annex 2)".

Page 2 of the section "Summary of facts and submissions" of the written decision refers to "the only auxiliary request (see Annex 2 to the Decision)", and in the last paragraph of section "Reasons for the decision" the opposition division concluded that "the auxiliary request complies with the patentability requirements of the EPC".

Annex 2 to the decision includes amended description pages 2 to 5 and a set of amended claims 1 to 20 including

- a claim 1 identical to claim 1 according to Annex II attached to the minutes,
- an independent claim 14 the wording of which differs from that of claim 14 of Annex II attached to the minutes (point II above) in the omission of the handwritten deletion of the expression "or an alloy containing copper", and
- an independent claim 20 the wording of which differs from that of claim 20 of Annex II attached to the minutes (point II above) in the omission of the handwritten deletion of the expression "containing less than 6 % by weight of mercury" and in the omission of the handwritten insertion of the expression "mercury free" in the introductory clause of the claim.

The amended description pages 2 to 5 of Annex 2 are identical with the amended description pages 2 to 5 of Annex II attached to the minutes, with the exception of some handwritten insertions and deletions shown on page 2 of Annex II that are absent in page 2 of Annex 2.

- IV. The appellant (opponent) lodged an appeal against the interlocutory decision of the opposition division maintaining the patent in amended form and requested setting aside of the decision and the revocation of the patent in its entirety.

The respondent (patent proprietor) requested that the appeal be dismissed.

Both parties also requested oral proceedings on an auxiliary basis. Each of the parties made substantive submissions in support of their respective requests.

- V. In a communication dated 1 April 2004 the Board drew the attention of the parties to a series of procedural irregularities and deficiencies that in the Board's preliminary opinion had occurred during the first-instance opposition proceedings. The Board added that:

"In view of the fundamental deficiencies and the procedural violations noted in [the communication], and in the absence of any special reason for doing otherwise, the Board intends to set aside the decision under appeal, to remit the case to the opposition division for further prosecution pursuant to Article 111(1) EPC and Article 10 of the Rules of Procedure of the Boards of Appeal, and to order the reimbursement of the appeal fee pursuant to Rule 67 EPC.

Since during the subsequent first-instance proceedings the parties would have the opportunity to have their respective requests, including the auxiliary request for oral proceedings, considered by the opposition division, in the Board's view there is no need to appoint oral proceedings at this stage of the procedure."

The Board invited the parties to file, if they so wished and within a period of two months, observations on the issues addressed in the communication, and in particular on the course of action that the Board intended to adopt.

- VI. In reply to the Board's communication, the appellant expressed its agreement with the course of action proposed by the Board. No observations were received from the respondent in reply to the Board's communication or to the appellant's reply to this communication.
- VII. By letter dated 2 August 2004 the appellant opponent requested that the opposition be transferred from "VARTA Batterie Aktiengesellschaft" to a related company in the same group "VARTA Microbatteries GmbH" and submitted documentary evidence in support of its request. A copy of the appellant's letter was sent to the respondent by letter dated 12 August 2004. In view of the supporting evidence filed, the confirmation thereof publicly available on the group's Internet homepage and in the absence of any comment on the appellant's request from the respondent, the parties were informed by an official communication dated 11 November 2004 of the transfer of the opposition from

the original opponent to "VARTA Microbatteries GmbH" which therefore acquired the status of opponent and appellant.

Reasons for the Decision

1. The appeal complies with the requirements mentioned in Rule 65(1) EPC and is therefore admissible.
2. *Procedural deficiencies during the first-instance opposition proceedings*

As already communicated to the parties (point III above), the following procedural deficiencies and irregularities in the first-instance opposition proceedings have occurred:

- 2.1 According to the minutes of the oral proceedings held on 17 November 2000 before the opposition division, and as suggested by the first cover page of the interlocutory decision dated 18 January 2001, i.e. the notification in writing pursuant to Rule 68(1) EPC of the decision given orally at the oral proceedings, the decision that the amended patent was found to meet the requirements of the EPC was announced at the end of the oral proceedings on the basis of the patent as amended according to the auxiliary request filed during the oral proceedings and shown in Annex II attached to the minutes (point II above). According to the list of enclosures on the second cover page of the written decision and the text of the written decision itself, the decision that the amended patent was found to meet the requirements of the EPC was based on the patent as

amended according to the auxiliary request shown in Annex 2 attached to the decision (point III above).

- 2.1.1 The amended patent documents according to each of Annex II and Annex 2 mentioned above include, among others, independent claims 1, 14 and 20 and an amended description page 2. A comparison of the text of the amended patent documents according to these two annexes shows, however, that the text of independent claims 14 and 20 and of description page 2 shown in Annex 2 attached to the written decision is not in agreement with the corresponding text of claims 14 and 20 and of description page 2 shown in Annex II attached to the minutes, the latter text showing handwritten amendments and deletions that had been omitted in the corresponding text shown in Annex 2 attached to the written decision (points II and III above). The text of independent claims 14 and 20 of Annex 2 appears to correspond in fact with the text of claims 14 and 20 of Annex I attached to the minutes and which according to points 1 and 4 of the minutes - and as confirmed in the section "Summary of facts and submissions" of the written decision - pertained to an auxiliary request filed and subsequently withdrawn by the respondent during the oral proceedings.

The substantial discrepancies between the text of the amended patent documents attached to the decision notified in writing to the parties and the corresponding text of the amended patent documents annexed to the minutes and on which the decision orally announced at the oral proceedings was based - and which texts constitute an integral part of the respective decisions - amount to a procedural deficiency in that

Rule 68(1) EPC, which unambiguously refers to one and the same decision being given orally prior to being notified in writing to the parties, has not been complied with (see decisions T 740/00, point 2.4 of the reasons, and T 425/97, point 2.2 of the reasons, none of them published in OJ EP0).

- 2.1.2 The Board observes that the EP0 file and in particular the written decision contain no information that might explain the discrepancies between the texts of the amended patent documents shown in Annex II attached to the minutes and in Annex 2 enclosed with the written decision and that it would be mere speculation on the part of the Board to attempt to determine whether the discrepancies between the corresponding texts of Annex II and Annex 2 are due to a mistake or an attempt to rectify some previous error not recorded in the file. It remains also a matter of speculation whether the true intention of the opposition division was to maintain the patent on the basis of the patent documents annexed to the written decision, as it appears may have been the case in view of the copy of a "Druckexemplar" also enclosed with the written decision present in the EP0 file, the text of which appears to be in agreement - except for a rather formal handwritten amendment made in order to match the text bridging the claim sheets - with the text of the amended patent documents shown in Annex 2 attached to the decision.

In any case, there is no record in the file that would indicate that the parties have had due opportunity to comment on the patent documents amended as shown in Annex 2 attached to the written decision (Article 113(1)

and Rule 58(4) EPC), or that those amended patent documents - which, unlike the amended patent documents shown in Annex II attached to the minutes, do not bear the signature of the respondent's representative - had been submitted or agreed by the respondent (Article 113(2) EPC). Consequently, and notwithstanding the aforementioned discrepancies, the right to be heard enshrined in Articles 113(1) and (2) EPC and in Rule 58(4) would not appear to have been complied with as regards the amended patent documents attached to the written decision, which would also amount to a procedural deficiency (see decision T 425/97, *supra*, point 2.1 of the reasons).

- 2.2 The opposition was filed against the patent in its entirety, the patent as granted including independent claims 1, 16 and 22. Nonetheless, during the opposition proceedings the submissions of the parties and the considerations of the opposition division focused almost exclusively on the subject-matter defined in claim 1. In addition, the reasons given by the opposition division in support of the maintenance of the patent only refer in general terms to the "subject-matter of the auxiliary request" without specifying which claim or claims were being actually considered. As a matter of fact, since the reasoning followed by the opposition division in its decision - especially as regards acknowledgment of an inventive step - essentially relies on the contribution brought by the additional "two limiting features" of the "auxiliary request", namely the "mercury-free" character of the cell and the fact that the copper and indium layers "do not comprise or consist of an alloy" (point 2 of the decision), and only independent claim 1 comprises both

limitations, but neither present independent claim 14 nor present independent claim 20, the reasons given by the opposition division in the decision under appeal only appear to apply to the subject-matter defined in amended claim 1.

Thus, the opposition division failed to address during the proceedings, and more specifically in the written decision, the issue of the ground for opposition of inventive step with regard to the subject-matter defined in independent claims 14 and 20 which are the counterpart of claims 16 and 22 as granted. The opposition division even failed to address, of its own motion if necessary (see decision T 648/96, point 2.4 of the reasons, not published in OJ EPO), the amendments to these claims (see decisions of the Enlarged Board of Appeal G 9/91 and G 10/91, OJ EPO 1993, 408 and 420, point 19 of the reasons) and in particular the admissibility under Rule 57a EPC and the allowability under Articles 123(2) and (3) EPC of the amendment of independent claim 22 as granted by way of omission of the term "miniature" in the opening phrase of independent claim 20 in both versions of the claim shown in Annex II of the minutes and in Annex 2 of the written decision.

Failure to address all these issues in the decision under appeal (Article 102(3) together with Rule 68(2) EPC) amounts to a procedural deficiency since the parties were deprived of their legitimate right to challenge the reasoning on which the decision was based, which is the purpose of the proceedings before the Boards of Appeal (see G 9/91 and G 10/91, *supra*, first

sentence of point 19, and decision T 899/98, not published in OJ EP0, point 8 of the reasons).

- 2.3 The Board also observes that during the first-instance proceedings the respondent submitted by letter dated 11 January 1999 that "whilst the Opponent has referred to each of [the documents cited in the notice of opposition] in isolation, the Opponent has failed to provide any explanation or reasoning as to how the skilled person would allegedly have combined these teachings so as to arrive at the subject matter of the claims. We are therefore left to draw our own conclusions as to what the skilled person would be taught from the teaching [of these documents]". With these submissions the respondent called into question if not in express, at least in implied terms the substantiation under Rule 55(c) EPC of the sole opposition ground of lack of inventive step invoked under Article 100(a) EPC by the respondent and therefore the admissibility of the opposition itself. However, the opposition division failed to address this issue during the proceedings, and in the written decision the opposition division merely stated, without giving any supporting reasoning, that the opposition was "formally admissible" (first paragraph of section "Reasons for the Decision").

In addition, although the course of action followed by the opposition division (see point 2.2 above) indicates that the opposition division considered the opposition ground of lack of inventive step as being sufficiently substantiated at least with regard to granted claim 1, neither the written decision nor the course of action followed by the opposition division allows the

conclusion that the opposition division also considered the sole ground for opposition invoked by the appellant against the patent as a whole as being sufficiently substantiated with regard to independent claims 16 and 22 as granted. The fact that the amendments brought to claims 16 and 22 as granted according to claims 14 and 20 shown in Annex II were eliminated in the version of these claims shown in Annex 2 might indeed hint at an attempt by the opposition division to restore claims 14 and 20 shown in Annex II to the version of these claims according to claims 16 and 22 as granted as if the latter claims had not been effectively opposed. However, the possibility that the opposition division might have arrived at the finding that claims 14 and 20 had not been effectively opposed is a conjecture that is not only at variance with the fact that such a finding has been neither notified to the parties (Article 113(1) EPC) nor addressed in the written decision (Rule 68(2) EPC), but also at variance with the fact that claim 20 according to Annex 2 still contains an amendment by way of deletion of the term "miniature" in the introductory phrase "A miniature zinc-air cell" in claim 22 as granted, an amendment which would in that event not have been admissible under Rule 57a EPC.

In view of the foregoing, it is not even clear to the Board whether or not the opposition division considered independent claims 16 and 22 as granted as effectively falling within the legal and factual framework of the opposition within the meaning of decisions G 9/91 and G 10/91, *supra*, points 4 to 6 of the reasons (see in this respect decision T 737/92, not published in OJ EP0, point 2.1 of the reasons).

2.4 It follows from the procedural irregularities and deficiencies noted above, and in particular from the failure by the opposition division to provide a clear and unambiguous text of the amended patent documents (point 2.1.1 above) and to establish the actual extent to which the patent has been effectively opposed (point 2.3 above), that the actual legal and factual framework upon which the decision was eventually based and delivered, and therefore also the legal and factual framework of the appeal (see T 737/92, *supra*, point 2.2 of the reasons), cannot be ascertained.

3. *Further prosecution - Articles 10 RPBA and 111(1) EPC*

3.1 In view of the number and severity of the procedural deficiencies in the first-instance opposition proceedings mentioned in point 2 above, the decision under appeal must be set aside.

3.2 In addition, the aforementioned procedural deficiencies constitute fundamental deficiencies within the meaning of Article 10 RPBA. These fundamental deficiencies affect not only the decision under appeal but also the legal and the factual framework of the case on appeal (point 2.4 above) to the extent that they cannot be remedied during appeal proceedings without impairing the parties' procedural rights. In particular, the discrepancies between the texts of the amended patent documents on which the oral and the written decisions are based precludes in the present case any consistent and proper application of the principle of prohibition of *reformatio in peius* set out in the decisions of the Enlarged Board of Appeal G 9/92 and G 4/93, OJ, EP0 1994, 875 (points 15 and 16 of the reasons), since the

application of this principle presupposes, in cases like the present one where the opponent is the sole appellant against an interlocutory decision maintaining a patent in amended form, a single and unambiguous text of the amended patent.

The fundamental procedural deficiencies therefore call for immediate remittal of the case to the first-instance department for further prosecution (Article 10 RPBA together with Article 111(1) EPC) on the basis of a valid and unambiguous text of the patent documents submitted or agreed by the respondent (Article 113(2) EPC) and on which the parties are entitled to have an opportunity to present their comments (Article 113(1) EPC). The remittal will ensure that the case is given a procedurally correct treatment and that all the procedural deficiencies noted in point 2 above are appropriately remedied to allow a procedurally proper first-instance decision.

- 3.3 In view of the outcome of the case, which became apparent to the Board at an early stage of the appeal proceedings, and since the effect of the Board's decision is that the decision under appeal is quashed and the proceedings restored to the position they were prior to the issue of the summons to oral proceedings before the opposition division, the Board abstains from commenting on the substantive merits of the case and the substantive submissions made by the parties during the appeal proceedings.

4. *Reimbursement of appeal fee - Rule 67 EPC*

Since the appeal is considered to be allowable to the extent that the decision under appeal is set aside as requested by the appellant and the case remitted for further prosecution, the appeal is deemed allowable within the meaning of Rule 67 EPC. In addition, the procedural deficiencies noted in point 2 above constitute substantial procedural violations within the meaning of Rule 67 EPC and the reimbursement of the appeal fee pursuant to this rule is clearly equitable in the circumstances of the case.

5. *Oral proceedings*

In view of the remittal of the case for further prosecution and the fact that neither party has expressed disagreement with the course of action proposed by the Board in its communication (point V above), no oral proceedings before the Board are considered necessary in these appeal proceedings.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the department of first instance for further prosecution.
3. The appeal fee is to be reimbursed.

The Registrar:

The Chairman:

P. Martorana

A. G. Klein