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Interlocutory D E C I S I O N
of 10 November 1994

Case Number: T 0937/91 - 3.2.5

Application Number: 85302866.0

Publication Number: 0160504

IPC: B42D 15/00

Language of the proceedings: EN

Title of invention:

Numbered documents and methods of and means for production thereof

Patentee:

THOMAS DE LA RUE & COMPANY LIMITED

Opponent:

GAO Gesellschaft für Automation und Organisation mbH

Headword:

-

Relevant legal provisions:

EPC Art. 52(2), 100, 112(1)(a), 114(1)

Keyword:

"Extent of obligation and power to examine grounds for opposition"

"Referral to the Enlarged Board of Appeal"

Decisions cited:

G 0009/91, G 0010/91

Headnote:

The following question is referred to the Enlarged Board of Appeal:

"In a case where a patent has been opposed on the basis of Article 100(a) EPC, but the opposition has only been substantiated on the grounds of lack of novelty and inventive step pursuant to Articles 54 and 56 EPC, can a Board of Appeal introduce the ground that the subject-matter of the claims does not meet the conditions of Article 52(2) EPC of its own motion into the proceedings?"



Case Number: T 0937/91 - 3.2.5

INTERLOCUTORY DECISION
of the Technical Board of Appeal 3.2.5
of 10 November 1994

Appellant:
(Opponent)

GAO Gesellschaft für Automation und
Organisation mbH
Euckenstrasse 12
D-81369 München (DE)

Representative:

Klunker, Schmitt-Nilson, Hirsch
Winzererstrasse 106
D-80797 München (DE)

Respondent:
(Proprietor of the patent)

THOMAS DE LA RUE & COMPANY LIMITED
De La Rue House
3/5 Burlington Gardens
London W1A 1DL (GB)

Representative:

Skone, James Robert Edmund
GILL JENNINGS & EVERY
Broadgate House
7 Eldon Street
London EC2M 7LH (GB)

Decision under appeal:

Interlocutory decision of the Opposition Division
of the European Patent Office given orally on
11 September 1991 and posted on 27 September 1991
concerning maintenance of European patent
No. 0 160 504 in amended form.

Composition of the Board:

Chairman: C. V. Payraudeau
Members: C. G. F. Biggio
A. Burkhart

Summary of Facts and Submissions

- I. An opposition was filed against the European patent No. 0 160 504 on the ground that its subject-matter was not patentable within the terms of Articles 52 to 57 EPC. However, only the objections of lack of novelty and lack of inventive step in the sense of Articles 54 and 56 EPC respectively, were substantiated during the opposition proceedings with respect to the independent claims.
- II. During the oral proceedings held before the Opposition Division the opponent introduced the new ground that the subject-matter of the European patent extended beyond the application as filed (Article 100(c) EPC). This objection was duly taken into account under Article 114(1) EPC by the Opposition Division, which, in an interlocutory decision, rejected on this ground the Patentee's main request to maintain the patent as granted.
- The Opposition Division further held that the grounds for opposition mentioned in Article 100(a) and (c) EPC did not prejudice the maintenance of the patent as amended by the proprietor during the opposition proceedings.
- III. The amended Claim 1, on which basis the patent was found to meet the requirements of the Convention, reads as follows:

"1. A document, which is one of a series of documents which are identical in content except for a number made up of a set of alphabetical or numerical characters, which number uniquely identifies each document within the series, characterised in that at least two

characters of the identifying number differ from each other, in addition to any differences in the letters and digits which they represent, in one or more visible physical characteristics, and in that the identifying number appears twice on the document with the variation between at least two of the characters in each number being different, and in which the variation of physical characteristics of the characters of one of the two numbers is reversed in direction in the other of the two numbers."

IV. The Appellant (Opponent) lodged an appeal against this interlocutory decision requesting that the decision under appeal be set aside and that the patent in suit be revoked.

V. In a communication accompanying the summons to the oral proceedings requested by both parties, the Board expressed the preliminary opinion that the subject-matter of Claim 1 seemed *prima facie* to be a mere presentation of information which was not patentable under Article 52(2)(d) EPC.

VI. In response to the communication of the Board the Respondent (Patentee) referred to the Opinion G 10/91 (OJ EPO 1993, 420) of the Enlarged Board of Appeal and argued that according to this Opinion the present Board was only entitled to consider grounds for opposition on which the decision of the Opposition Division had been based. The only exception to this principle as stated by the Enlarged Board was the case where the patentee agreed that a fresh ground for opposition be considered. As the Respondent did not agree to the introduction of such a fresh ground for opposition, the present Board was not entitled to raise an objection under Article 52(2) EPC.

VII. In a second communication, the Board expressed the preliminary view that the word "grounds" as appeared from the context of the decision G 9/91 and the opinion G 10/91 could be understood as meaning the three separate grounds under Article 100(a), 100(b) and 100(c) EPC, respectively. In the present case the "new" objection was covered by the ground for opposition filed under Article 100(a) EPC and could be therefore validly raised without deviating from the interpretation of the Convention given by the Enlarged Board of Appeal. However, the Board would refer the question to the Enlarged Board of Appeal if there was any doubt as regards the interpretation of the decision G 9/91 and the opinion G 10/91 in this respect.

VIII. Oral proceedings were held.

The Chairman informed the parties that the question, whether or not the Board had the right to raise an objection under Article 52(2) EPC, would have to be dealt with before issues of substantive law could be addressed, and invited the representatives to give their opinion on this point.

IX. The Appellant essentially argued as follows:

In the notice of opposition it had been put forward that the subject-matter of the patent was not patentable under Articles 52 to 57 EPC. Although admittedly only lack of novelty and lack of inventive step had been argued during the opposition proceedings, Article 52(2) fell formally within the ambit of Articles 52 to 57 and the new objection based on this Article could validly be made by the Board.

- X. The Respondent, in answer, developed his written argumentation and submitted that the opinion G 10/91 was based on the principle that the purpose of the appeal procedure in inter partes cases was essentially to give the losing party the possibility of challenging the decision of the Opposition Division on its merits.

From this principle, it followed that "fresh" grounds for opposition resulting in a completely new case having to be examined, should not be introduced at the appeal stage. In the present appeal, the new objection raised by the Board under Article 52(2) EPC was of a totally different nature than the opposition grounds of lack of novelty or inventiveness on which the appealed decision had been based. Its examination would necessitate the reopening of the case on this new ground and this would be contrary to the principle established by the said opinion of the Enlarged Board of Appeal.

Reasons for the Decision

1. The central issue to be decided is whether the Board is entitled to raise of its own motion a fresh objection without the approval of the patentee.
2. In its decision G 9/91 (OJ EPO 1993, 408), the Enlarged Board of Appeal ruled that "The power of an Opposition Division or a Board of Appeal to examine and decide on the maintenance of a European patent under Articles 101 and 102 EPC depends upon the extent to which the patent is opposed in the notice of opposition pursuant to Rule 55(c) EPC". In the opinion G 10/91 (OJ EPO 1993, 420) given with the same grounds as the decision G 9/91, the Enlarged Board added that "Exceptionally, the Opposition Division may in application of Article 114(1)

EPC consider other grounds for opposition which, prima facie, in whole or in part would seem to prejudice the maintenance of the European patent. Fresh grounds for opposition may be considered in the appeal proceedings only with the approval of the patentee".

In the decision and opinion, the concept of "grounds for opposition" is not further elaborated.

3. A possible interpretation of this concept would be to consider that each of the three grounds for opposition mentioned respectively in the paragraphs (a), (b) and (c) of Article 100 EPC represents a separate ground for opposition in the sense of the above decision and opinion. For example, all objections tending to demonstrate that the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57 EPC would be considered as being a single ground for opposition. In such a case, when the opposition was originally based on the ground under Article 100(a) EPC, the Board of Appeal would be entitled to raise fresh objections concerning the nature of the invention, the exceptions to patentability such as inventions which are contrary to "ordre public" or morality, the novelty, the inventive step or the industrial application, whatever the original objections were. On the other hand, no fresh objections could be raised as to the reproducibility of the invention (Article 100(b) EPC) or the extension of the subject-matter of the European patent beyond the content of the application as filed (Article 100(c) EPC). The same reasoning would apply to the respective grounds under Article 100(b) and (c) EPC.
4. Such an interpretation might, at first sight, seem to correspond to the intention expressed by the Enlarged Board in the above-mentioned decision and opinion. However, there does not seem to be any logical

connection between, for example, the objection that the subject-matter of a claim is not new or not inventive under Articles 54 and 56 and the objection that the invention is contrary to "ordre public" or concerns a plant or an animal variety, which could justify the conclusion that they are one and the same "ground".

5. On the other hand, it may happen that, although the opposition was initially only based on the ground of lack of novelty and/or inventive step, an objection relating to the reproducibility of the invention (Article 100(b) EPC) or to the extension of the subject-matter (Article 100(c) EPC) is raised during the appeal proceedings in answer to a reasoning on novelty or inventive step. It would appear that the Boards of Appeal could not refuse considering such "fresh" grounds, even if the patentee does not give his consent, since they are not belated, being directly related to the original substantiated grounds for opposition. Thus, there is no clear demarcation between the grounds according to Article 100(a), (b) and (c) EPC and it would appear therefore that to make the power of the Boards of Appeal dependent on the formal distinction of Article 100 EPC would create a source of uncertainty.

6. Another possible interpretation would therefore be to consider that only the effective grounds (i.e. novelty, inventive step, morality, industrial application, etc., and reproducibility or extension of the subject-matter beyond the application as filed) substantiated in the Notice of Opposition filed pursuant to Rule 55(c) EPC or, but only in exceptional cases, raised "ex officio" by the Opposition Division, should be considered in appeal proceedings. In other words, the Board of Appeal would not be allowed to raise any objection not already

at least impliedly contained in the Notice of Opposition or in the decision under appeal. All other grounds should be examined only with the approval of the patentee.

7. This "narrow" interpretation would result however in a limitation of the obligation of the European Patent Office to examine the facts of its own motion provided for by Article 114(1) EPC which seems to go far beyond a reasonable interpretation of this Article. For example, in cases like the present one, this would lead to the situation that the Board would have to examine the inventiveness of the subject-matter of a claim without having first decided whether it relates to an invention or not. This interpretation does not seem therefore to be legally tenable.
8. The Board is not aware of any decision of the other Boards of Appeal, given after the date of the decision G 9/91 and opinion G 10/91, which addresses the above problem. The Board considers therefore that there is a need for an interpretation of this decision and opinion by the Enlarged Board of appeal in order to ensure a uniform application of the law.

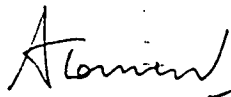
Order

For these reasons it is decided that:

Under Article 112(1)(a) EPC, the following question is referred to the Enlarged Board of Appeal:

"In a case where a patent has been opposed on the basis of Article 100(a) EPC, but the opposition has only been substantiated on the grounds of lack of novelty and inventive step pursuant to Articles 54 and 56 EPC, can a Board of Appeal introduce the ground that the subject-matter of the claims does not meet the conditions of Article 52(2) EPC of its own motion into the proceedings?"

The Registrar:



A. Townend

The Chairman:



C. Payraudeau

an
B. Stockhaus
Zi. 1004

Das Verfahren

T 937 / 91 - 3.2.5

**hat sich
ohne Entscheidung
erledigt**