
EPO Board of Appeal 3.3.05 on the correct exercise of discretion by Opposition Divisions (decision of November 15, 2016 – case T 66/14 "Treatment of biological waste/FRAUNHOFER-GESELLSCHAFT")

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Late-filed documents, which are submitted to show the knowledge of the person skilled in the art, may not be rejected with the reasoning that they are "not more relevant or more pertinent" than documents filed in due time. The principle of examination for *prima facie* relevance requires admission of the documents to be decided upon based on the objection that is supposed to be supported by the late-filed documents.

Moreover, when amendments are filed by the patentee, the amendments must be fully examined as to their compatibility with the requirements of the EPC. An objection under Article 83 EPC thus has to be admitted, even if the ground for opposition under Article 100 b) EPC was not raised by the opponent.

Facts of the case

The opposition was based on the grounds of inadmissible extension, lack of novelty and lack of inventive step. Document D1 was cited to substantiate lack of novelty, and the opponent argued that the document disclosed all features at least implicitly. Concerning inventive step, the opponent led an attack based on document D3. Before the oral proceedings and within the deadline for written submissions fixed pursuant to Rule 116(1) EPC, the opponent submitted further documents D6 to D11c. The opponent argued that documents D6, D7, D9 to D11c

confirmed that the features that document D1 does not explicitly mention are at least customary features in the art. Document D8 was used to supplement the attack on inventive step based on document D3.

The Opposition Division maintained the patent on the basis of an amended claim set filed during the oral proceedings. Documents D6 to D11c were not admitted into the proceedings, as they were considered to be "not more relevant or 'more pertinent' than documents D1 to D5 filed in due time". The Opposition Division did not admit an objection concerning lack of reproducibility either, which was raised by the opponent during the oral proceedings against the amended claim set, as the patentee had not been able to prepare itself for the opponent's attack in an appropriate manner prior to the oral proceedings.

The Opponent appealed the decision and argued that not admitting documents D6 to D11c and the objection of lack of reproducibility constituted fundamental procedural deficiencies.

Findings of the Board

The Opponent's appeal was successful and the case was remitted to the Opposition Division.

While the Board confirmed that documents D6 to D11c had indeed been filed late, despite having been filed prior to the date fixed pursuant to Rule 116(1) EPC, the Board examined whether the Examining Division

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had exercised its discretion correctly, i.e. in an equitable manner. As per well-established case law, late-filed evidence must be examined for *prima facie* relevance. The Board pointed out that this examination may not be carried out in isolation of the party's submission. Rather, the Opposition Division is to take into account the objection the evidence is supposed to reinforce. Thus, in the present case, the *prima facie* examination is to consider whether documents D6, D7 and D9 to D11c support the implicit disclosure of the features by document D1, and whether document D8 supports a finding of lack of inventive step in combination with document D3. It is not permissible to reject the documents with the reasoning that they are "not more relevant or more pertinent" than documents filed in due time, or, in other words, that their disclosure with respect to all features of claim 1 remains behind document D1.

The Board also admitted the objection of lack of reproducibility. Firstly, the Board

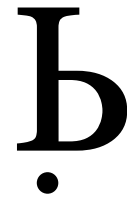
confirmed that new grounds for opposition filed after the expiry of the opposition period are to be examined as to whether they are *prima facie* relevant for maintenance of the patent. Hence, the new ground for opposition needs to be examined with respect to its relevance, and cannot be rejected for reasons of procedural efficiency. Furthermore, the Board added that in the present case the objection of lack of reproducibility does not even constitute a new ground for opposition in the sense of G 10/91, since amendments made in opposition or opposition appeal proceedings are to be fully examined as to their compliance with the requirements of the EPC. While there are some exceptions to this principle for certain requirements (unity, clarity), since reproducibility corresponds to a ground for opposition, an objection based on Article 83 EPC is to be admitted into the proceedings on principle if the amendment is based on features that did not exist in the claim set as granted.

Remarks

The present decision expands the possibilities of obtaining admission of late-filed objections and emphasizes the precedence of substantive examination over procedural efficiency:

For late-filed documents, the Board makes clear that a comparative approach, which is an argument often used by practitioners to argue against admissibility ("New document X should not be admitted as it less relevant than previously filed document A..."), is not in line with the principle that *prima facie*

relevance must be examined based on the objection raised by the party. Consequently, as an opponent it is recommendable to point out specifically a document's relevance against the background of the objection raised, in particular if the document is not used for a separate novelty attack, but e.g. for showing knowledge of the person skilled in the art, a certain feature for inventive step, etc. Ideally, this should already be done when the document is introduced.



Concerning new grounds for opposition, if a ground is found to be relevant *prima facie*, this ground should not be refused only because an interruption or adjournment becomes necessary. Finally, in any case, if an amended claim set is at stake whose features

were not included in the claim set as granted, the decision confirms that new objections can be raised even if the corresponding ground for opposition was not raised in the notice of opposition.