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File No.: T 0843/91 - 3.3.1
Application No.: 82 306 197.3
Publication No.: 0 080 355
Classification: G03C 7/32
Title of invention: Photographic elements containing aryloxy substituted
photographic couplers

D E C I S I O N
of 5 August 1993

Proprietor of the patent: Eastman Kodak Company (a New Jersey Corporation)

Opponent: Fuji Photo Film Co., Ltd.

Headword: -

EPC: Art. 133, 134, 106, 111(1), 111(2), 112(1), 125, 104
Rules 9 and 10

Keyword: "unauthorised representative (no)" - "letter criticising appeal proceedings not added to the opposition file after remittal (no substantial procedural violation)" - "binding effect of Board of Appeal decisions (*res iudicata; ratio decidendi*)" - "desirability of ending legal disputes (vexatious proceedings)" - "revision of a Board of Appeal decision in application of Art. 125 EPC (not decisive in the present case; insufficient evidence of generally accepted practice in all Contracting States)" - "referral to the Enlarged Board of Appeal (no)"

Headnote

A decision remitting a case to the Opposition Division with the order to maintain a patent on the basis of amended claims is binding in the sense that neither the wording nor the patentability of these claims may be further challenged in subsequent proceedings before the EPO. A finding of fact upon which this decision rests, i.e. a finding which is conditio sine qua non for the decision, is equally binding. Such a finding of fact is therefore not open

to reconsideration pursuant to Article 111(2) EPC (point 3.4.2 of the Reasons).

Case Number: T 0843/91 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 5 August 1993

Appellant: Fuji Photo Film Co., Ltd.
(Opponent) No. 210, Nakanuma
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Kanagawa (JP)

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Respondent: Eastman Kodak Company
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Representative: Baron, Paul Alexander Clifford
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Decision under appeal: Decision of the Opposition Division of the European
Patent Office dated 17 September 1991 rejecting the
opposition filed against European patent
No. 0 080 355 pursuant to Article 102(2) EPC.

Composition of the Board:

Chairman: K.J.A. Jahn
Members: R.K. Spangenberg
J.A. Stephens-Ofner

Summary of Facts and Submissions

I. European patent No. 0 080 355, granted in respect of European patent application No. 82 306 197.3, was revoked by the Opposition Division. The patent proprietor appealed. By decision T 215/88 - 3.3.1 dated 9 October 1990 the appeal was allowed and the case remitted to the Opposition Division with the order to maintain the patent in amended form on the basis of an amended Claim 1 filed on 7 February 1990 and Claims 2 to 7 as granted. On 8 February 1991 the patent proprietor filed an amended description. By its decision dated 17 September 1991 the Opposition Division maintained the patent on the basis of the above claims and the amended description.

II. In this decision it was stated that the Opponent's objections against the amended text only related to matters already considered and finally decided by the Board of Appeal in the decision T 215/88. Since such matter was not open to reconsideration by the Opposition Division, pursuant to Article 111(2) EPC, the Opponent's submissions, including a test report filed on 12 August 1991 and a reference to

"The Theory of the Photographic Process", fourth edition (Macmillan Publishers, 1977), pages 340 to 345 (document 6a)

had to be ignored.

It was further mentioned in that decision that a letter dated 14 November 1990, which was mentioned by the Opponent in his observations, was not available to the

Opposition Division, but could be disregarded because it could have related only to issues not relevant to those pending before the Opposition Division.

- III. On 17 October 1991 the Appellant (Opponent) gave notice of appeal against this decision and paid the appropriate fee. A Statement of Grounds of Appeal was received on 7 January 1992.

In this Statement of Grounds the Appellant raised several objections against the decision T 215/88 of this Board and submitted that the members who participated in this decision should be excluded, pursuant to Article 24 EPC, from deciding the present appeal since "they had participated in the decision under appeal" and because of their suspected partiality.

- IV. In reply, the Respondent (patent proprietor) submitted that the only question which remained to be decided in the present appeal proceedings was whether or not the patent as amended met the requirements of the EPC, taking into account decision T 215/88. In this respect, the Appellant's submissions to the Opposition Division dated 12 August 1991 did not substantiate the need for any further amendment of the patent. The Respondent further submitted that the present appeal be decided by the same persons who took the decision in the appeal T 215/88 since they were already familiar with the case.

- V. On 17 March 1993, during oral proceedings before the Board, in which, as prescribed by Article 24(4) EPC, the present members were replaced by their alternates,

the Appellant's requests to have the further prosecution of the appeal submitted to a competent Board of Appeal composed only of members who had not participated in the previous decision T 215/88, or, alternatively, that the previous Chairman and the previous Legal Member should be replaced, were rejected. The Reasons for this interlocutory decision were communicated to the parties on 19 July 1993.

VI. On 5 August 1993 oral proceedings were held, during which the Appellant submitted the letter dated 14 November 1990, i.e. the letter which had not reached the Opposition Division. He further submitted four "petitions", namely that: -

1. the decision under appeal be set aside and referred to the Opposition Division (in the Board's understanding this means that the case should be remitted to the Opposition Division for further prosecution aimed at formulating an amended text of the patent giving effect to the Board's earlier decision T 215/88);
2. the Appeal Decision T 215/88 be set aside;
3. in case that request 2 is not followed, that the Board of Appeal refer the following questions 1a), 1b) and 2 to EPO's Enlarged Board of Appeal:

1a) In the case that a party in proceedings pending before the EPO submits legal petitions with accompanying substantiation which are deliberately withheld from both the competent EPO Body and the Official File and the other party to the proceedings by virtue of an internal practice

adopted within the EPO, does such a practice constitute a substantial procedural violation?

- 1b) In case where such a substantial procedural violation occurs, does this render a subsequent decision in ongoing proceedings null and void?
 - 2.) Can a Board of Appeal decision in ongoing proceedings revise a previous Board of Appeal decision if this decision is based upon a serious procedural violation, e.g. petitions submitted by a person that is not a professional representative according to Article 134 EPC?
4. the disputed patent be revoked.

In respect of petition No. 1, he submitted that the decision under appeal was based on two substantial procedural violations, namely that the Opposition Division failed to consider the letter dated 14 November 1990 and the legal petitions made therein, and, secondly, that the submissions made on 12 August 1991 were "ignored". In his opinion it was contrary to Rules 9 and 10 EPC that a body other than either the Opposition Division or the Board of Appeal took notice of and acted in respect of documents submitted in ongoing proceedings concerning the grant or maintenance of a European patent and that, more generally, the practice of the EPO of withholding observations filed after a final decision of a Board of Appeal had been given, prejudiced the rights of the general public, e.g. in cases where a clearly novelty destroying document was submitted after such a final decision had been rendered. He further submitted that as a

consequence of the said procedural violations the decision under appeal had to be declared null and void, even if there would have been no causality between them and the outcome of the opposition proceedings.

Moreover, the Appellant disputed that decision T 215/88 could have binding effect in respect of the question whether or not certain examples, especially coupler No. 5, should be deleted from the description. In particular, the mention of coupler No. 5 in point 4.2 of this decision was not relevant, since it was in a different context, and was based on wrong considerations. Furthermore, the test report of 12 August 1991 clearly showed that a photographic element containing coupler No. 5 consumed more than 2 equivalents of silver halide. Thus, he argued, this coupler did not satisfy the definition of a "two-equivalent coupler" given in point 4.5 of decision T 215/88. In addition, he submitted that these considerations should, *prima facie*, apply to all couplers having a free para-position in the aryl moiety of the coupling-off group (COG). Thus all these couplers were not couplers according to Claim 1 as construed in T 215/88 and should be deleted.

In respect of petitions No. 2 and 3, the Appellant submitted that, as a matter of principle, the EPO should provide for a possibility to revise decisions of a Board of Appeal if it could be established that they had been taken in violation of procedural law, e.g. of the type on which his Article 24(1) and (3) complaint against all members of the present Board had been based. This alleged substantial procedural violation was the alleged permission by this Board in the

previous proceedings to allow an unauthorised person (Article 133 EPC) to "present a substantial or major part of the patentee's case". More particularly he submitted that this unauthorised representative had changed certain of the earlier requests made by the duly authorised representative, contrary to Article 133 and 134 EPC and the established jurisprudence of the Boards of Appeal, in particular T 80/84 (OJ EPO 1985, 269). Although he admitted, in response to certain questions put to him by the Board, that the EPC did not specifically allow for any such revision, he relied on Article 125 EPC and submitted that in his opinion such legal practice existed in all or most of the Contracting States of the EPC, since it did in at least one Contracting State (Germany), a fact which constituted *prima facie* evidence that this practice was generally recognised and followed in all or most of the other Contracting States. Since this question was of general interest for all cases where the proceedings before the EPO were not terminated, he found it justified to refer the related questions of law formulated in petition No. 3 to the Enlarged Board of Appeal.

In respect of petition No. 4, the Appellant submitted that, as was already pointed out in respect of petitions No. 1 and 2, as well as in the letter of 14 November 1990, neither the present claims nor the present description could form the basis for the maintenance of the disputed patent.

VII. On 2 July 1993 the Respondent submitted a test report intended to demonstrate that no cyan dye was formed during processing of a photographic element containing

coupler No. 5 as the sole coupler. In an accompanying letter and during the oral proceedings he argued that the definition of the expression "two-equivalent-coupler" in the decision T 215/88 expressly required that the **coupler** should not, during **subsequent reactions** in the photographic element, consume silver halide in excess of the two equivalents required for the formation of the desired image dye. Thus, the consumption of additional silver halide by other reactions in the photographic element was not excluded by this definition. However, the tests performed by the Appellant did not show more than that the overall silver halide consumption per mole of image dye formed was higher than 2 equivalents. In other words, in this test the difference in reactivity of two different couplers was determined. In order to demonstrate that the above definition was not satisfied, it would however have been necessary to demonstrate that the photographic element contained reaction products resulting from further reaction of the phenol resulting from the development reaction, i.e. that corresponding to the COG. In his opinion this further reaction should result in the formation of at least some cyan dye which could be detected spectrophotometrically. This being not the case, as demonstrated by his test results, there was no reason to delete the couplers mentioned by the Appellant from the description.

In respect of the Appellant's further requests, he submitted that the Appellant was not entitled to a rehearing of matter which had already been finally considered by the Board of Appeal. In addition he contested that any relevant procedural violations had occurred, which could have prejudiced the outcome of

the proceedings. Thus there was no reason to consider the questions which the Appellant wished to have referred to the Enlarged Board of Appeal.

VIII. The Appellant requested that petitions 1 to 4 submitted during the oral proceedings be allowed and that each party should bear its own costs.

The Respondent requested that the appeal be dismissed and the patent be maintained as amended by the decision of the Opposition Division dated 17 September 1991, pursuant to decision T 215/88. Since in his opinion the oral proceedings of 5 August 1993 were unnecessary and had been requested by the Appellant in abuse of procedural law, he further requested that all costs incurred by him for these proceedings be borne by the Appellant.

At the end of the oral proceedings the decision of the Board to dismiss the appeal as well as the Appellant's petitions 2, 3 and 4 and the Respondent's request for an award of costs under Article 104 EPC was announced.

Reasons for the decision

1. The appeal is admissible, since the Appellant's requests relate not only to setting aside a previous decision of a Board of Appeal, as was the sole request in the case decided in decision T 934/91 (for Headnote see OJ EPO 3/1993), where such an appeal was held to be inadmissible, but also to setting aside a decision of an Opposition Division relating to questions not yet finally decided by a Board of Appeal, i.e. the proper adaptation of the description to the claims.

2. The test report submitted by the Respondent on 2 July 1993 has been considered by the Board, and found not to be sufficiently relevant to admit it into these proceedings. The Board has therefore decided to disregard it in the exercise of its discretion pursuant to Article 114(2) EPC.

3. The Appellant's first petition is to set aside the decision under appeal for formal (procedural violation) and substantive reasons. The Board will consider these submissions in the order in which they have been made.
 - 3.1 Regarding the first submission that the decision under appeal should be set aside for the sole reason that it failed to deal with "legal petitions" contained in the letter of 14 November 1990, which had not reached the opposition file, the Board observes that the Appellant had repeated these petitions in his letter received on 12 August 1991, which were, in essence, to set aside decision T 215/88 or to submit the case to the President of the EPO for consideration as to whether a question of law should be referred to the Enlarged Board of Appeal. Accordingly, the Opposition Division had the opportunity to consider them, and in fact did so in the reasons of the decision under appeal. However, the Opposition Division held that it had to take decision T 215/88 as being final, and that its power was limited to the adaptation of the description to the claims allowed by the Board. In addition, it held that it was not necessary to submit the case to the President of the EPO, since the President had no power under Article 112 EPC to ask the Enlarged Board of Appeal to deal with a case which already had been decided by a Board of Appeal. Thus, the only matter

which could not have been considered by the Opposition Division because of the unavailability to it of the the letter of 14 November 1990 were the underlying reasons for these petitions. However, since the Opposition Division took the position that it could not allow these petitions in any case, regardless of the circumstances which may have justified them, the fact that the letter of 14 November 1990 had not reached the opposition file clearly cannot amount to a substantial procedural violation.

Furthermore, the Appellant's submission that **any** procedural defect in proceedings before the EPO, regardless of whether or not the defect was substantial in the sense that it caused the decision adversely affecting a party to such proceedings, should have the **automatic** consequence that the decision in such "defective" proceedings was null and void, so that the proceedings had to be resumed at the stage where the defect had occurred, is not supported by the relevant provisions of the EPC. On the contrary, according to Article 111(1) EPC, the Board of Appeal is expressly given discretion either to exercise any power within the competence of the department which was responsible for the decision appealed or to remit the case to that department for further prosecution. According to earlier decisions, e.g. T 611/90 (OJ EPO 1993, 50), the Board will only remit a case when fairness to the (i.e. **all**) parties so demands. In the present case the Board sees no such reason for remitting the case to the Opposition Division for consideration of the whole content of the letter of 14 November 1990, since this whole content can be considered by the Board itself, in exercising its power under Article 111(1) EPC, and

thereby obviating any possible infringement of the Appellant's right to be heard, which might or might not have occurred during the proceedings before the Opposition Division.

In these circumstances, the Board need not decide the question whether or not the administrative practices currently in force and relating to the filing of letters after a final decision in a case pending before a Board of Appeal had been taken are in accordance with Rules 9 and 10 EPC or whether they should be altered for any other reason. However, the Board observes that it does not find the Appellant's submissions in this respect convincing since, whilst it may be true that in some cases, such as for example the discovery of a novelty destroying document by the Opponent after a final decision of a Board of Appeal had been rendered, such a document should be placed on either the appeal file or the general file, in the general public interest, such action cannot, in itself, affect the Board's decision, which under the EPC is final (see also point 10 of the Reasons for the interlocutory decision of 17 March 1993 in the present appeal case). In addition, as a matter of simple logic, it does not follow from the desirability to place **some** types of information on the file after a final decision had been rendered that **all** informations, including complaints, whether well or ill-founded, about alleged procedural violations in the course of the oral proceedings leading to a final decision of a Board of Appeal, should also be put on the file. In this connection, and with specific relevance to the facts of this case, the Board observes that the alternates of the present members who had considered, pursuant to Article 24(4)

EPC, the Appellant's complaint based on Article 24(1) and (3) EPC, had specifically held that the procedural violation alleged in the letter of 14 November 1990 (i.e. the letter not put on the opposition file by the administrative services) was not a substantial one (see the interlocutory decision of 17 March 1993, point 9.4 of the Reasons).

3.2 The second procedural violation alleged by the Appellant concerns the fact that the decision under appeal states that the Appellant's submissions of 12 August 1991 had to be "ignored". However, the Board observes that it follows from the context of the decision under appeal that the Opposition Division has not failed to consider these submissions at all, but found that they related to matter finally settled in the decision T 215/88, and that they could therefore not be taken into account in respect of the sole matter which remained to be decided by them. This appreciation may be contested, and in fact has been contested during the present appeal proceedings, however, even if this appreciation of the facts would have turned out during these appeal proceedings to be erroneous (which is not the case), such an erroneous appreciation of facts would not in itself constitute a substantial procedural violation which might render a decision based on it null and void.

3.3 Thus the Board holds that the alleged substantial procedural violations did not occur. In the absence of any further formal reason why the decision under appeal should be set aside, the Board will now consider the technical merits of the Appellant's first request.

3.4 In this respect, the only question in dispute is whether those examples of couplers which contained a COG with a free (unblocked) para position should remain in the description. In this context there was also dispute about the extent to which decision T 215/88 was final.

3.4.1 In respect of this latter question, i.e. what matters had been finally adjudged in decision T 215/88, this decision ordered that

- "1. the appeal is allowed,
2. the decision under appeal is set aside, and
3. the case is remitted to the Opposition Division with the order to maintain the patent on the basis of the Appellant's main request."

The main request was to maintain the patent on the basis of an amended Claim 1 as well as Claims 2 to 7 as granted. Thus both the request and the order were totally silent in respect of the appropriate content of the description.

The above order might at first glance be construed to mean that the entire case was remitted to the Opposition Division for further prosecution as provided for in Article 111(1) EPC as one of two mutually exclusive possibilities for decisions in respect of appeals, namely either a final decision on every issue and every fact in the case, including any consequential amendments to the description, or remittal of the case for further prosecution, without anything having been finally decided. However, such a construction is, in the Board's judgment, wholly inappropriate, since it is

not in agreement with the reasons for the decision which clearly state that the subject-matter of the above claims met the requirements of the EPC. In addition, the Board observes that this construction of the above order would not correspond to the way in which the Opposition Division and the parties to the proceedings had understood it, nor, for that matter, it is sound in law (see also decision T 79/89, OJ EPO 1992, 283).

Accordingly, the Board holds that the above order has to be seen in context with the reasons for the decision as a whole, so as to mean that in respect of the patentability of the subject-matter of the above claims and their wording the Board has rendered a decision within the competence of the department which was responsible for the decision appealed, which decision is final (Article 106(1) EPC; see also the interlocutory decision of 17 March 1993 in this case, point 6.1, as well as the Board's considerations in respect of the Appellant's petition No. 2 in point 4 below). Only in respect of the remaining part of the order, which was not immediately relevant to the principal issue (patentability) before it, that is to say the proper adaptation of the description, did the Board exercise its power pursuant to the second possibility provided by Article 111(1) EPC by remitting the case to the Opposition Division. This construction of the above type of order is in clear agreement with other decisions of the Boards of Appeal, e.g. T 757/91 of 10 March 1992, point 2.2 of the Reasons and T 113/92 of 17 December 1992, point 1 of the Reasons.

3.4.2 It follows from the finality, i.e. the legally binding effect, of decision T 215/88 that neither the wording of the above claims nor the patentability of their subject-matter may be further challenged before the EPO in subsequent proceedings relating to the remitted matter (see again T 79/89 cited above).

In respect of the second part of the above order, concerning the remittal of the case, delegating the adaptation of the description to the Opposition Division, it follows from Article 111(2) EPC that the Opposition Division is only bound by the *ratio decidendi* of the remitting decision "in so far as the facts are the same", i.e. that the Opposition Division is, in principle, free to consider fresh matter, but matter that is relevant only to the adaptation of the description. It is only with such facts that Article 111(2) is intended to deal with.

In the Board's judgment, this means that all findings of fact on which the binding part of the above order (*res iudicata*) rests, are not open to reconsideration under this Article, and are thus equally binding. Were it otherwise, i.e. were it open to the parties to challenge these findings and for the Opposition Division to overturn them during subsequent proceedings on remittal for the adaptation of the description, this would render the decision as a whole, including the order, nugatory and futile and would thus, in effect, destroy its binding nature. Any construction of the term "facts of the case" contained in Article 111(2) which included findings of fact which constitute the basis of, in the sense of being a *conditio sine qua non* for the final part of the decision, would, contrary to

the clearly intended sole purpose of the remittal (the adaptation of the description), afford opponents a much belated (third) opportunity to attack the binding part of the decision by adducing new facts. No such opportunity is provided by the EPC, either expressly or by implication. Furthermore, its introduction by an extended construction of Article 111(2) would, in the Board's judgment, offend the general principle of legal certainty, i.e. the general interest of the public in the termination of legal disputes ("*expedit reipublicae ut sit finis litium*") as well as the right of the individual to be protected from the vexatious multiplication of suits and prosecutions.

- 3.4.3 In respect of the specific question whether the equivalency of coupler No. 5 had already been decided in case T 215/88, as found by the Opposition Division, the Board notes that this question was expressly dealt with in decision T 215/88. The Board found as fact that coupler No. 5 was a typical example of a two-equivalent coupler within the definition given for this term in the Reasons of the decision (see points 4.2 (recited in point 3.5.1 below) and 4.3). In addition, part of the Board's legal considerations were based upon this finding of fact (see point 6.2.4 of the Reasons), so that this finding was **decisive** (in the sense explained above) to the Board's order in its above decision to maintain the patent on the basis of certain claims as set out in the main request. Thus the Board holds that, contrary to the Appellant's present submission, this question of fact had already been finally decided in decision T 215/88, namely, that coupler No. 5 fell under the definition in Claim 1. This finding of fact

is, for the Reasons set out above, not open to further challenge.

- 3.4.4 Accordingly, the Opposition Division did correctly interpret decision T 215/88, and was right in refusing to entertain this question of fact any further.

- 3.5 However, the above finding of fact in decision T 215/88 relating to coupler No. 5 cannot be extended to comprise all other couplers having a free para position in the COG. Thus, decision T 215/88 does not contain any final finding of fact concerning the equivalency of these other couplers. The question whether the Appellant's submissions require deletion of some or all of these couplers from the description therefore still remains to be decided. In this context, the parties relied on different constructions of the definition of the term "two-equivalent coupler" that was contained in decision T 215/88.
 - 3.5.1 Decision T 215/88 contains the following statement in point 4.2 of the Reasons:

"...the question whether a coupler is correctly called "two-equivalent or "six-equivalent" depends on what actually happens during the development of the photographic element containing that coupler, and cannot be answered simply by looking at its chemical structure. This view is further confirmed by the comparison of coupler No. 5 according to the patent in suit with the fourth coupler of the phenol series in Table 17.2 of document (6), which is the phenol corresponding to the aryloxy coupling-off group of coupler No. 5. Nevertheless this coupler No. 5 produces

more yellow dye than coupler No. C-6 (cf. the patent in suit, page 16, examples 9 and 10) having the acetamido substituent in the para position, i.e. the phenol "coupler resulting from the development of coupler No. 5 obviously does not react itself as a coupler during development of the photographic element according to example 9 of the patent in suit. In these circumstances the term "coupler" cannot be attributed to this phenol, because it is only used in the art for moieties which actually form a dye during processing in a photographic element."

In point 4.5 of decision T 215/88 it was then held that:

"As a result of these considerations (i.e. the above and some others) ..., for the purpose of the construction of the true meaning of the present Claim 1, the expression "two-equivalent coupler" should be understood as meaning a coupler which consumes only two equivalents of silver halide for the formation of one molecule of image dye in the photographic element, without any additional silver halide consumption during subsequent reactions in that element."

- 3.5.2 The above definition is addressed to the person skilled in the art, who would consider it in the light of the common general knowledge. The relevant common general knowledge is that it is not the coupler itself which reacts with silver halide, but rather that two equivalents of silver halide produce one molecule of oxidised developing agent (Dox), which then reacts mainly with the coupler in its anionic form, thereby

producing a leuco dye which then yields the image dye by removal of the anion corresponding to the COG and a proton, i.e. without requiring further oxidation (see e.g. document (6a), page 340, Chapter B, headed "Reactions of Oxidised Developing Agent" and the specification of the disputed patent, page 2, lines 31 to 38).

Thus the person skilled in the art would have appreciated that the expression "two equivalents of silver halide" in the above context had the same meaning as "one molecule of oxidised developing agent" and that the definition in dispute excluded only such photographic elements which consumed further Dox "during **subsequent** reactions" in the photographic element. The meaning of that latter expression must, in the Board's judgment, be construed in the light of the explanations given in point 4.2 of decision T 215/88 (see point 3.5.1 above) as relating exclusively to reactions involving the formation of further dye subsequent to the removal of the COG. Thus the Appellant's construction of the above definition, according to which a photographic element containing such a coupler should in no circumstances consume, during conventional development, more than two equivalents of silver halide, is not appropriate, and cannot form the basis on which the allowable content of the description must be assessed.

- 3.6 Turning now to the question of whether the description comprises photographic elements which contain couplers not being two-equivalent couplers according to the above definition on its proper construction, the Board observes that the Appellant did not provide any

evidence concerning the couplers in question, but simply argued that in the light of the test results obtained with coupler No. 5 it was reasonable to assume, on the balance of probabilities, that the other couplers having a free para position would yield similar results. In the Board's judgment, this argument must fail. The reason for this is that the question of the equivalency of coupler No. 5 as well as the question whether or not it satisfies the definition of a two-equivalent coupler contained in the present Claim 1, has already been finally decided, as set out in points 3.4.2 to 3.4.4 above, and cannot therefore be challenged again in these proceedings. Thus the structural similarity between this and other couplers contained in the body of the description, even if it could be regarded as an indication of similar coupler activity, would, *prima facie*, rather support the conclusion that these couplers would also satisfy the above definition. Thus this structural similarity cannot be used as *prima facie* evidence to the contrary, as submitted by the Appellant.

3.7 For these reasons the Board is satisfied that a further amendment of the description is not required and the Appellant's first petition must fail.

3.8 However, since the Appellant has put forward a good deal of submissions and arguments relating to the question of the equivalency of those couplers which have a free (unblocked) para position, the Board wishes to observe that a consideration of these submissions and arguments would not in any case have lead to a different result.

The Appellant's tests demonstrate that a photographic element containing coupler No. 5 as the sole coupler, during development with the developing solution disclosed "in Examples of EP 0 080 355" (i.e. the disputed patent) as well as a widely used commercial developing system, the so-called Kodak C-41 process, consumes 3,5 or 4,6 equivalents of silver halide, respectively, for the production of one mole of image dye. By contrast, a coupler having the same structure, with the only exception that the COG is a heterocyclic moiety the structure of which excludes any further reaction with Dox, which coupler is said to be a "typical two-equivalent coupler", consumes only 2,0 or 2,2 equivalents of silver halide, respectively, for the formation of one mole of the same image dye. From these data the Appellant inferred that coupler No. 5 was not considered to be a two-equivalent coupler. In his opinion, even if one would admit that the definition given in decision T 215/88 on its proper construction (see point 3.5.2 above) would not exclude competing side reactions which are also capable of consuming Dox, such side reactions need not be considered, because in practice substantially the whole amount of Dox present during development of the photographic element would react with the coupler or couplers present, so that the overall consumption of silver halide observed by him was a direct measure of the equivalency of the couplers involved.

This assertion, which was strongly disputed by the Respondent is, in the Board's judgment, not in agreement with the common general knowledge represented e.g. by document (6a), namely the text book cited by the Appellant himself, where it is stated that Dox

cannot only be consumed by a reaction with the coupler anion, but also by competing side reactions, not resulting in dye formation (see page 340, left hand column, under the sub-heading (a), and the sentence bridging the left and right hand columns of page 341 in combination with the chapter "Side Reactions of QDI During Development" beginning on page 343). Thus, as it was submitted by the Respondent, the Appellant has determined the relative reactivities of the two tested couplers, rather than their equivalency. The Appellant, on whom the burden of proof on this issue rests, has therefore failed to demonstrate that his test results unequivocally show that any one of the couplers being mentioned in the description and having a free para position does not fulfill the relevant definition of a two-equivalent coupler.

4. Regarding the Appellant's second petition, namely to set aside decision T 215/88, the Board observes that the only decisions which can be contested according to Articles 21(1) and 106(1) EPC are those of the Receiving Section, the Examining Division, the Opposition Division and the Legal Division. Thus the decisions of the Boards of Appeal do not belong to those decisions that can be contested under the express provisions of the EPC (see also the interlocutory decision of 17 March 1993, points 6 to 6.3 of the Reasons), but are final, and it is impossible to set aside or to modify them in a subsequent decision relating to the same technical subject-matter. Thus these provisions of the EPC do not empower the Board to consider this petition.

During the oral proceedings held on 5 August 1993, the Appellant additionally relied on Article 125 EPC. However, his assertion that German law provided for a possibility to revise a decision of a court of final jurisdiction if it would suffer from a major procedural defect, was not supported by any evidence. According to the Board's own knowledge, German law would allow such a revision only in very specific situations not directly comparable with that underlying the Appellant's petition ("Restitutionsklage" and "Nichtigkeitsklage"). In addition, the Appellant, on whom the burden of proof rests, has not provided any evidence that provisions similar to those that he purported to exist under German law also existed in all other, or at least in the majority, of the Contracting States of the EPO, and were thus "generally accepted" within the meaning of Article 125 EPC. In the absence of such evidence, the Board cannot accept the Appellant's submission that German law constitutes *prima facie* evidence of the laws of other Contracting States. Therefore, the Appellant's submissions under this heading are rejected.

Additionally in point 9.4 of the Reasons of the interlocutory decision of 17 March 1993 it is stated that the contribution of the "unauthorised representative" was made under Article 117 EPC, so that the substantial procedural violation (of Article 133 and 134 EPC) alleged by the Appellant and forming the basis of his second petition did not take place during the oral proceedings held before this Board in the case T 215/88.

Accordingly, petition No. 2 fails.

5. Since petition No. 2 cannot be allowed, petition No. 3, i.e. the reference of the questions of law recited in point VI above, needs finally to be considered.
- 5.1 The answer to the first two of these questions (Nos. 1a and b) has no influence on the decision to be taken in the present case, since, as has already been found in points 3 to 3.3 above, no substantial procedural violation took place. The general question whether the EPO is obliged to put any fresh document on the file to which it belongs is, in addition, purely administrative and not a legal one, and therefore lies outside the Board's competence. Consequently the Board has decided that there is no need to refer questions 1a and 1b to the Enlarged Board of Appeal.
- 5.2 Question No. 2 relates to the power of a Board of Appeal to revise (i.e. to set aside or to modify) a decision taken by the same or another Board of Appeal in cases where the previous decision was taken in violation of procedural law. However, the alternate Board (Article 24(4) EPC) in its interlocutory decision of 17 March 1993 has already found that the substantial procedural violation alleged by the Appellant and forming the basis of his petition did not take place (see point 9.4 of this decision). Thus there is no basis for remitting the question of law suggested by the Appellant in the present case. Moreover, although this question might be very important in cases where the presence of a procedural defect can be established, the Board's finding that decision T 215/88 is final and cannot be challenged in the present proceedings is in full agreement with the Reasons given in point 6 of the

interlocutory decision of 17 March 1993 and with the case law of the Boards of Appeal which was considered and summarised in the said interlocutory decision. Since, in addition, the Appellant's submission that Article 125 EPC should be applicable in such a case was not accompanied by any evidence, either as to German law, or, more importantly, as to the laws of other Contracting States, the Board's finding on petition No. 2 (see point 4 above) must lead to the conclusion that in the present case there is no question of law capable of being referred to the Enlarged Board of Appeal.

6. Since the Board has already held that it has neither the power to set aside its decision in case T 215/88, nor that there was any reason under the EPC why the present text of the description, which has been approved by the Respondent, could not form the basis for the maintenance of the patent as amended, no ground for the requested revocation of the disputed patent exists.

Therefore, the Appellant's fourth petition must also fail.

7. Although it is true that the Appellant has tried to re-open, in the course of the oral proceedings of 5 August 1993, issues which had already been argued and decided in the oral proceedings on 17 March 1993 before the alternate Board, the former oral proceedings were not limited to such issues and cannot, therefore, be said to have been unnecessary and therefore in abuse of applicable procedural law. On the contrary, it is clear that the Appellant was entitled to oral proceedings

pursuant to Article 116(1) insofar as the issue of the adaptation of the description to the claims already allowed was concerned.

For the above reason the Board holds that the Respondent's request that all costs of the oral proceedings of 5 August 1993 be borne by the Appellant is not well-founded and has, therefore, to be dismissed.

Order

For these reasons it is decided that:

1. The appeal is dismissed.
2. The Appellant's petitions 2, 3 and 4 are dismissed.
3. The Respondent's request for an award of costs under Article 104 EPC is dismissed.

The Registrar:

E. Görgmaier

The Chairman:

A. Jahn