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D E C I S I O N
of 7 November 1994

Case Number: T 0018/93 - 3.3.1

Application Number: 83108350.6

Publication Number: 0101621

IPC: G03C 7/32

Language of the proceedings: EN

Title of invention:

Silver halide color photographic material

Patentee:

FUJI PHOTO FILM CO., LTD.

Opponent:

Agfa-Gevaert AG

Headword:

Remittal/FUJI

Relevant legal provisions:

EPC Art. 114(2), 111(1), 111(2), 100(a)

Keyword:

"New relevant evidence admitted - late filing not amounting to a deliberate delay of proceedings"

"Novelty for the first time disputed on appeal - no new ground of opposition"

Decisions cited:

G 0009/91, G 0010/91, T 0326/87, T 0182/89, T 0951/91,
T 0938/91

Catchword:

Case Number: T 0018/93 - 3.3.1

D E C I S I O N
of the Technical Board of Appeal 3.3.1
of 7 November 1994

Appellant: Agfa-Gevaert AG
(Opponent) Patentabteilung
Postfach
D-51368 Leverkusen (DE)

Representative:

Respondent: FUJI PHOTO FILM CO., LTD.
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Decision under appeal: Decision of the Opposition Division of the European Patent Office of 20 October 1992 with written reasons posted on 26 November 1992 rejecting the opposition filed against European patent No. 0 101 621 pursuant to Article 102(2) EPC.

Composition of the Board:

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

Summary of Facts and Submissions

I. The appeal lies against the decision of the Opposition Division of the EPO, pronounced orally on 20 October 1992 and with written reasons delivered on 26 November 1992. It was filed on 23 December 1992 and the appropriate fee was paid at the same date.

The decision under appeal concerned the maintenance of European patent No. 0 101 621 in amended form. This patent was granted on 1 June 1988 on the basis of four claims in response to European patent application No. 83 108 350.6, filed on 24 August 1983, and claiming priority of 24 August 1982 from an earlier application in Japan. The decision was based on an amended set of 3 claims, the first of which read as follows:

"1. A silver halide color photographic material containing a DIR coupler and a polymer coupler latex, characterised in that said DIR coupler is capable, upon coupling, of releasing a development restrainer having a diffusibility of 0.4 to 1.0."

In the decision under appeal 8 documents were considered, among them

(1) GB-A-2 092 573

II. The Opposition Division held that the subject-matter of the amended set of claims was novel, since document (1), representing the closest state of the art, did not disclose that the development restrainer released by the DIR coupler had to have a diffusibility of 0.4 to 1.0 in order to increase image sharpness. The

Opposition Division also held that the subject-matter of the disputed patent involved an inventive step.

III. A Statement of Grounds of Appeal was received on 25 March 1993.

IV. In the Statement of Grounds of Appeal the Appellant (the Opponent) relied for the first time upon several further publications, particularly on

(10) US-A-3 148 062

(11) US-A-3 617 291

(12) US-A-3 620 745

(13) DE-A-2 610 546

(14) EP-A-0 200 502

On that basis he submitted that the novelty of the subject-matter of the present Claim 1 had to be reconsidered, since certain development restrainers released from the DIR couplers disclosed in documents (10) to (13), which were all incorporated in the disclosure of document (1) by reference, had in fact a diffusibility in the range of 0.4 to 1.0, as required by the patent in dispute. In his submission this followed mainly from document (14), which itself did not belong to the state of the art according to Article 54(2) or (3) EPC. He further disputed the findings of the Opposition Division in respect of the inventive step.

The Appellant requested that the decision under appeal be set aside and the patent revoked. By way of an auxiliary request, he requested oral proceedings. He further suggested remittal to the Opposition Division

in order to give the Respondent the opportunity to have the novelty of the subject-matter of the disputed patent considered by two instances.

- V. In his reply, the Respondent (the patent proprietor) submitted that the fresh evidence and the fresh objection raised on that basis should not be admitted into the appeal proceedings in view of Rule 55(c) and 56 EPC, in accordance with earlier jurisprudence of the Boards of Appeal and the Enlarged Board of Appeal, in particular T 182/89, G 9/91 and G 10/91. In respect of the latter decisions he expressly disapproved of the consideration of "the fresh ground" of lack of novelty. Moreover he suggested that the Board should disregard the late filed documents pursuant to Article 114(2) EPC, relying on decision T 326/87.

The Respondent requested as his main request that the appeal be dismissed and the patent maintained on the basis of the claims, the description and the drawings on which the decision under appeal was based. He also requested oral proceedings in the event that the Board would not dismiss the appeal on the basis of his written submissions. In reply to a communication of the Board of Appeal, in which the Board's intention to remit the case to the Opposition Division was indicated, he expressly confirmed that the request to appoint oral proceedings included the possibility that the Board would intend to admit documents (10) to (14) and to remit the case before the Opposition Division for further prosecution on that basis.

- VI. Oral proceedings took place on 7 November 1994. The sole issue of these proceedings, which was indicated in

a further communication accompanying the summons, was the admissibility of documents (10) to (14), and the line of argument based on it, to the appeal proceedings. The Appellant, who had informed the Board that he would not attend the oral proceedings, which were in his opinion unnecessary, was not represented.

During the oral proceedings the Respondent maintained his written submissions and argued that the Appellant had already specifically relied on those parts of document (1), which contained the reference to documents (10) to (13), in the notice of opposition. Since at least the diffusibility of one of the development restrainers mentioned in document (13) was given in the description of the contested patent, the objection raised in the Statement of Grounds of Appeal could - and therefore should - have been raised already in the opposition period, so that the Respondent and the Opposition Division could have dealt with it in the course of the opposition proceedings. In these circumstances the Appellant's late submissions amounted to an abuse of the appeal proceedings for "tactical" purposes.

- VII. The Respondent maintained his main request that the appeal be dismissed. By way of auxiliary request, he requested that the case be remitted to the Opposition Division for further prosecution. He also asked for an award of costs.

The Appellant's written requests remained standing.

At the end of the oral proceedings the decision of the Board to admit documents (10) to (14) to the appeal

proceedings and to remit the case to the Opposition Division for further prosecution on the additional basis of these documents was given.

Reasons for the Decision

1. The appeal is admissible.

2. Since the Appellant had disputed the need to appoint oral proceedings in the present case, the Board observes that the question here in dispute was not only whether or not the case should be remitted to the Opposition Division without taking a decision on its merits, but rather whether or not documents (10) to (14), and the novelty objection based on these documents in combination with document (1), should be admitted to the appeal proceedings. Since the admission of this evidence adversely affected the Respondent, the latter was entitled to oral proceedings on that point, before a decision to this effect was taken.

3. It is evident that the Respondent's main request could only be successful in the event that the Board would follow the Respondent's submission and refuse to admit documents (10) to (14) into the appeal, and to consider the novelty objection based on these documents in combination with document (1). Accordingly, this is the main issue to be decided in the present case.
 - 3.1 The Respondent relied exclusively, in this respect, on his written submissions, which were expressly maintained during the oral proceedings, in which he

submitted the legal proposition that the objection of lack of novelty should be regarded as a "new ground of opposition" not properly submitted and substantiated in accordance with Article 99(1) in conjunction with Rule 55(c) EPC during the nine-month opposition term, and that, following decision G 9/91 and opinion G 10/91 of the Enlarged Board of Appeal, such a new ground could not be admitted into the appeal without the Respondent's consent, which was refused in the present case.

The Board cannot, in general, agree with this line of argument, since it is based on a construction of the expression "ground of opposition" not in conformity with the meaning of this expression in the context of the above decision and opinion of the Enlarged Board of Appeal. More importantly, it does not take account of the fact that the issue of novelty had been implicitly dealt with by the notice of opposition, which referred to Article 100(a) EPC as a whole, i. e. to Articles 52 to 57 EPC, and only **in particular** to Article 56 EPC. Moreover, this issue had been specifically dealt with during the opposition proceedings, as can be seen from the minutes of the oral proceedings before the Opposition Division, both by way of argument and in the decision itself.

- 3.2 In particular, decision G 9/91 (OJ EPO 1993, 408) and Opinion G 10/91 (OJ EPO 1993, 420) have been issued as the result of consolidated proceedings and their content is substantially the same. Decision G 9/91 expressly refers in No. 13 of the reasons to "all the grounds of opposition, set out in Article 100(a) to (c)", i. e. to those three grounds which are expressly

set out there. Thus there is no basis to extend the concept derivable from the above reasoning to separate "grounds" within one and the same of these categories of grounds of opposition. In particular, objections against novelty and inventive step are both objections under Article 52(1) EPC. Article 54(1) EPC and Article 56 EPC contain only the definitions of the requirements of novelty and inventive step, which requirements moreover relate to the common issue of patentability with respect to the state of the art as defined in Article 54 EPC, paragraphs (2) to (5), and therefore to the same ground of opposition in the above sense (see also T 938/91 of 21 September 1993, No. 1 of the reasons). In addition, decision G 9/91 does not relate to a situation where the Opposition Division had already dealt with the issue of novelty and had given reasons for its finding on that point in the decision under appeal. Therefore the Respondent's submission is not supported by decision G 9/91.

- 3.3 Likewise, decision T 182/89 (OJ EPO 1991, 391), which was essentially confirmed by the above decision of the Enlarged Board of Appeal, also concerned a late submitted ground of opposition falling under one of the above three different categories of Article 100 EPC. Moreover, this decision only decided the question as to whether or not an Opposition Division or a Board of Appeal was **obliged** to examine grounds of appeal beyond the extent to which they are properly supported as required by Rule 55(c) EPC. It does not, therefore, support the Respondent's legal proposition that the Opposition Division, let alone the Board of Appeal should have no **power** under the EPC to consider the question of novelty in the present case.

3.4 Thus it cannot be derived from the above decisions that the Respondent's consent is necessary to give the Board of Appeal the power to deal with the issue of novelty in the present case. On the contrary, the Board holds that it follows from the function of the appeal proceedings, as explained in G 9/91, No. 18 of the reasons, namely to reconsider the decision taken by the first instance **on its merits**, that any matter so decided by the first instance must become an issue in the appeal proceedings as well.

4. There is, accordingly, no valid legal precedent that precludes the Board's considering the admissibility of documents (10) to (14) into the appeal proceedings and the issue of novelty based on them in combination with document (1).

4.1. Documents (10) to (13) are mentioned in document (1) on page 21, lines 25 to 28 and 38 to 40, where it is disclosed that DIR couplers disclosed in a number of patent specifications, including documents (10) to (13), may be used together with the polymer latex couplers described in Claim 1 of document (1). In the decision under appeal the Opposition Division assumed that all development restrainers released from the DIR couplers disclosed in that list of patent specifications would possess diffusibilities below 0.4, since no information as to the diffusibilities of the DIR couplers described in this list of documents was available (see No. 4.7 of the reasons). By the citation of documents (10) to (13) this finding was challenged in the light of document (14), which was alleged to disclose diffusibility values of two of the development

restrainers releasable from the DIR couplers mentioned in documents (10) to (13). In the light of this evidence, therefore, the information content of document (1) has been alleged to be different from that assumed in the decision under appeal. Since in the present case the importance of the diffusibility values of the development restrainers was already apparent from the outset of the opposition proceedings, as the lower limit of the diffusibility of 0.4 was already present in Claim 1 as granted, any available evidence in respect of diffusibility values of development restrainers implicitly disclosed in document (1) should in principle have been filed during the opposition period. Document (14) was published on 5 November 1986 and would therefore have been available during that period. Therefore, the Appellant's submission of the above evidence is late.

4.2 Pursuant to Article 114(2) EPC it is therefore within the discretionary power of the Board of Appeal to admit this evidence into the appeal. In exercising this power, two conflicting aims need to be balanced. The first one is that only valid patents should be maintained, i.e. patents which are likely to be maintained in the course of revocation proceedings before national courts. For this reason the Boards of Appeal will normally only admit such late filed evidence which is likely to be relevant to the question of validity. The second one is to conclude the opposition proceedings as swiftly as possible in the interests both of the parties and of the general public, and, for this reason, to forestall any unjustified delay of the opposition proceedings (see

e.g. T 326/87, OJ EPO 1992, 522 and T 951/91 of 10 March 1994, to be published in OJ EPO).

4.3 In the present case, the Respondent admitted during the oral proceedings that the knowledge of the diffusibilities of the DIR couplers disclosed in (1) by reference to documents (10) to (13) was highly relevant to the issue of novelty of the subject-matter of the present claims.

4.4 In the circumstances of the present case, where suitable DIR couplers were incorporated in document (1) by reference to more than 20 patent documents, it cannot, in the Board's judgment, be regarded as a deliberate attempt to delay the opposition proceedings that the Appellant did not make the necessary effort, at the outset of these proceedings, to list all development restrainers releasable by the DIR couplers disclosed in these patents, and to determine their diffusibilities, either by an exhaustive search in the patent literature, including even documents not belonging to the state of the art defined in Article 54 EPC, or by his own experiments, and relied instead on the line of argument developed in the notice of opposition, which was based on the assumption that it was sufficient to show that development restrainers having a diffusibility greater than 0,4 belonged to the state of the art and were to be expected to bring about the desired effect. For this reason the additional fact that the significance of the combined disclosure of Examples 1, 6 and 11 of document (13) and document (1), page 21, lines 38 to 42 in the light of the diffusibility value of 5-bromo-benzotriazole mentioned in the patent in suit in Table 2 on page 10 (where a

diffusibility of 0,9 is given for this compound) had been overlooked throughout the opposition proceedings cannot ipso facto be regarded as an indication of a deliberate withholding of available evidence for merely tactical purposes.

- 4.5 Having regard to the above considerations, the Board admits documents (10) to (14) into the appeal. Therefore, the Respondent's main request cannot be allowed.
5. Thus the Respondent's auxiliary request to remit the case to the Opposition Division has now to be considered. In a situation such as the present one, where there is fresh evidence and both parties agreed to have the case remitted, the Board should make use of the first possibility of action provided in Article 111(1) EPC, namely to decide the case, only in exceptional circumstances, which do not exist here. Accordingly, the Board makes use of the second possibility pursuant to Article 111(1) EPC and remits the case to the Opposition Division for further prosecution, taking into account documents (10) to (14). Having regard to the Appellant's submission in the Statement of Grounds of Appeal, according to which the remittal should be for the sole purpose of reconsidering the issue of novelty, the Board would like to observe that pursuant to Article 111(2) EPC, this particular remittal does not remove the Opposition Division's power to reconsider the whole matter of the present opposition, i.e. the question whether or not in the light of the now available evidence the ground of opposition of Article 100(a) EPC prejudices the maintenance of the contested patent, taking into

account any amendments proposed by the patentee. During this further prosecution the Opposition Division is therefore free to decide whether or not these documents would also require a reconsideration of the issue of inventive step. In addition, the Opposition Division is free to consider the relevance of document (9), and to decide whether this document should also be admitted into the proceedings. Furthermore, the Board finds it appropriate in the present case that the Opposition Division should itself decide on the merits of the Respondent's request for an award of costs (Article 104(1) and (2) EPC), after the Appellant has been given an opportunity to present his observations in respect of this request (Article 113(1) EPC).

Order

For these reasons it is decided that

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division for further prosecution on the additional basis of documents (10) to (14) submitted by the opponent.

The Registrar:

The Chairman:

E. Görgmaier

A. Jahn