Part II

A. The UK patent disclosing feature (a) was presumably published before 1986 since it was cited against the earlier European application which claimed a priority of 5 February 1985. Thus this document forms part of the state of the art under Art. 54(2) EPC and can be used in both a novelty and an obviousness attack against the granted European patent.

The UK patent discloses feature (a) and assuming that it relates to a method of manufacturing a vessel for a vacuum flask with this type of glass it destroys the novelty of claim 1. (If it only discloses glass and not in relation to vacuum flask manufacture it can only be used in obviousness attack).

However, validity of claim 2 which incorporates inventive combination of (a) and (b) is not adversely affected.

With respect to earlier German application (withdrawn) and published on 7 August 1986, i.e. in between the priority date and the filing date of the European patent, this does not form part of state of art Art. 54(2) because right of priority has

effect that date of priority shall count as date of fi... purposes of Art. 54(2) in accordance with Art. 89 EPC. ... effect of German document.

However earlier European application (withdrawn) was publish... under Art. 93 after this date but itself has a date of filing earlier than that of the later European patent. Accordingly, it comprises part of the state of the art in accordance with Art. 54(3) but only in so far as the commonly designated Contracting States Art. 54(4). The earlier application designated only AT, CH and FR, and thus comprises state of art Art. 54(3) against European patent in AT, CH and FR but <u>not</u> DE, GB or NL.

The earlier application disclosed the temperature of feature (b) but different values for feature (a). The earlier application does not therefore disclose the advantageous combination of (a) and (b) but only an "equivalent" thereof. Thus the novelty of claims 1 and 2 is not adversely affected by the earlier European application. Furthermore, according to Art. 56, second sentence, documents within the meaning of Art. 54(3) cannot be considered when deciding whether there has been an inventive step and thus the earlier European application cannot be used as basis for an obviousness attack against the later European patent.

No other documents have been cited against the later European patent and thus only the UK patent needs to be considered. The patent was granted on 14 February 1990 and thus an opposition can be filed within 9 months i.e. up to 14 November 1990 (Wednesday) Art. 99(1). The subject matter of claim 1 lacks novelty over the UK patent and this forms a valid ground for opposition under Art. 100(a) - not patentable within terms of Art. 52-57, specifically Art. 54(1). Prospective licensee could file this opposition but better if patent proprietor files it himself in order to ensure that fully valid patent is maintained. Proprietor filing his own opposition has been approved by Board of Appeal decision - Art. 99(1) states that "any person" may apply.

Thus file opposition and request deletion claim 1 but maintenance of claim 2 as new and inventive over UK patent and fully entitled to priority and thus novel over earlier European patent application. All relevant art will then have been fully considered by EPO therefore licence can go ahead.

B.1. Although the brochure has not yet been published, the state of the art for the purposes of Art. 54(1) is held to comprise "everything made available to the public" Art. 54(2). A "tacit understanding" is stated to exist between the patentee and Abel Art. 55(1)(a) provides that a disclosure will not be considered if it occurred no earlier than six months preceding the filing of the application if it was due to or in consequence of "an evident abuse in relation to the applicant". This would be the situation if it can be shown that a breach of confidentiality had taken place. 19 January 1984 was within 6 months of the filing date of the European

application and thus the patentee will need to provide evidence to show that there was, at that time i.e. Januai 1984, a confidentiality agreement between them and Abel. S an agreement need not be in writing but could be a "tacit understanding of secrecy". Thus attack should be rebutted and evidence in support of "abuse" Art. 55(1)(a) provided.

Evidence may be provided in form of written statements taken from, for example the sender and the recipient of the letter forwarding the brochure to Abel - taken in accordance with Rule 72 EPC.

B.2. One ground for opposition Art. 100(a) is lack of inventive step under Art. 56 and this has been alleged by Opponent II. However, if the patentees assessment of the art relied on is borne out on closer inspection then this ground can be effectively rebutted on the grounds that publications are not related to the invention and to not render it obviousness.

Opponent II's second argument is based on the requirement of Art. 84 for the claims to clearly and concisely define the matter for which protection is sought. However, this argument is not a valid ground of opposition under Art. 100 EPC and cannot be raised in opposition proceedings. Accordingly this ground can be simply dismissed on this basis.

In view of the lack of good opposition arguments raised (one weak and one inadmissible) it is perhaps not so surprising that Opponent II has now withdrawn (perhaps on professional advice). Nevertheless, opposition proceedings will continue with the patentee and Opponent I as parties, and since the Opposition Division is entitled to examine the facts of its own motion under Art. 114(1) EPC, it will be necessary to comment on Opponent II's arguments to ensure that no further consideration of them is taken, either by the Opposition Division or by the other opponent.

In this way validity of European patent should be upheld.

C.1. The Opposition Division has stated that the opposition filed by Opponent I was inadmissible although no reasons for inadmissibility are stated in the exam question. Nevertheless Opponent I's appeal to the decision is apparently based solely on the grounds of opposition originally filed and is not directed towards the reason for the Opposition Division's decision concerning its admissibility. Since the opposition was deemed to be inadmissible any grounds raised therein cannot be argued until the decision concerning admissibility is overturned i.e. grounds are only considered if the opposition is admissible Art. 101(1) EPC. No appeal against admissibility has been made and thus other grounds of appeal will not be considered - no opposition is deemed to have been filed by Opponent I. Thus legal validity of patent is not at risk from Opponent I. Weak arguments presented are not likely to be reconsidered by Appeal Board "of its own motion" under Art. 116 EPC because already considered by Opposition Division.

C.2. Opponent II has introduced a new document during appe
proceedings under Art. 106(3) since decision to maintai
patent unamended under Art. 102(2) is in the form of an
interlocutory decision which is separately appealable - as
provided by recent notice of EPO President concerning
opposition proceedings. Art. 114(2) states that the EPO may
disregard facts or evidence which are not submitted in due
time. However, this facility is discretionary and late-filed
documents which are highly relevant to the patentability of
the invention in question may still be considered by the
Appeal Board during proceedings. Thus it is not sufficient to
assume Appeal Board will not consider document.

If there is no doubt that the combination of the new document with the document disclosing the pre-characterising part of claim 1 renders claim 1 obvious then it is advisable to submit the amended claim as soon as possible to ensure its consideration by the Appeal Board, rather than waiting for the oral proceedings. However, if there is any doubt (usually there is where two documents must be combined) then would still be wise to submit arguments in support of main claim e.g. two documents would not have been combined by man skilled in the art, and then a subsidiary set of arguments and claims which incorporate the restricted claim. This then provides a certain fall-back position which must be considered before a final decision under Art. 111 is reached. If alternate claims are not submitted until actual oral proceedings there is a risk that Decision may be reached before opportunity to submit amendments arises, although in accordance with Art. 113 all parties should have an opportunity to present their comments on any evidence on which a decision is based.